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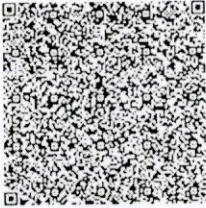
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ARBITRATION AWARD

Before the Sole Arbitrator, Dr. Karnika Seth

IN INDRP Case No. 1658

K Seth
Chaitanya, Alor

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

Disputed Domain Name: www.thombrowne.co.in

Dated: 10 MARCH, 2023

IN THE MATTER OF:

THOM BROWNE JAPAN, INC.

201, 5-4-6 Minami-Aoyama, Minatoku, Tokyo,

107-0062, Japan

..... Complainant

Vs.

APEX CONSULTING

HONG KONG

..... Respondent

1. Parties

- 1.1 The Complainant in the arbitration proceeding is THOM BROWNE JAPAN, INC having its registered office address 201, 5-4-6 Minami-Aoyama, Minatoku, Tokyo, 107-0062, Japan. The Complainant's authorized representative is Dodd & Co.
- 1.2 According to 'WHOIS' database the Respondent is Yitao, Apex Consulting, having its address at 33, Tongji East Road, Chancheng Distict, FoShan City, Guangdong Province, China, 528000. E-mail id of registrant is sunong@live.com. Registrant has registered the disputed domain name with Dynadot LLC.

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2. **The Dispute-** The domain name in dispute is www.thombrowne.co.in registered by the Respondent on 13th April, 2018. 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.	1 February, 2023
2.	Date on which consent was given to act as an Arbitrator in the case.	2 February, 2023
3.	Date of Appointment as Arbitrator.	3 February, 2023
4.	Soft Copy of complaint and annexures were received from NIXI through email.	3 February, 2023
5.	Date on which notice was issued to the Respondent	3 February, 2023
6.	Date on which Award passed	10 March, 2023

4. **Procedural History**

- 4.1 This is 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

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<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 3 Feb 2023 at the email address sunong@live.com calling upon the Respondent to submit his reply to the complaint within fifteen (15) days of receipt of the Arbitrator's email.
- 4.5 Despite 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, Thom Browne Japan, Inc., is incorporated under the laws of Japan. The Complainant is a subsidiary of Thom Browne, Inc., a New York-based company. The Complainant is a luxury fashion brand founded in 2003 in New York by Thom Browne. Clothing, footwear, accessories, and fragrances are all part of the Complainant's product line.

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- 5.2 To safeguard its trademark rights, Complainant has filed several trademark applications and holds trademark registrations in various countries around the world including but not limited to the US, Switzerland, European Union, China, United Kingdom, Mexico Chile, Brazil, Peru and Malaysia. (The Complainant has filed Annexure C to support its claim). Further, the Complainant has also registered the trademark in India to attain statutory rights in India, the mark THOM BROWNE is registered under different classes, interalia, class 03 and 09 on 18th August, 2010 vide registration number 2010913 and under class 18, 25 and 35 on 28th December 2010, vide registration No. 2076535 as shown at para 6.3 of the Complaint. (To prove its claim Complainant has annexed few registration certificates as Annexure D in the Complaint).
- 5.3 The Complainant has adopted the trademark 'Thom Browne' in the year 2003 and since then, the Complainant has been using the THOM BROWNE logo and trademark continuously and extensively for use in connection with its goods in the fashion industry. The Complainant is also the owner of its website, www.thombrowne.com, which was registered on 11-12- 2003 (the Complainant has filed Annexure E to support its claim).
- 5.4 According to 'WHOIS' database, the Respondent registered the disputed domain name www.thombrowne.co.in to advertise identical trademark for clothes and fashion accessories. The Respondent herein is the Yitao, Apex Consulting, has its address at 33, Tongji East Road, Chancheng District, FoShan City, Guangdong Province, China, 528000. The said disputed domain was registered on 13th April, 2018. (Who is record of the disputed domain name has been annexed by the Complainant as Annexure H to support its claim).

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However, as per the Complainant, it has neither granted any authorisation to register the disputed domain name nor it has any association with the Respondent.

6. Parties Contention

6.1 Complainant's Submissions

- 6.1.1 The Complainant has been using its "THOM BROWNE" mark extensively and continuously for luxury fashion brand and accessories, not only in India but across various other countries. Due to its established reputation across various other countries and in India, the word "THOM BROWNE" has been exclusively associated with the Complainant and no one else.
- 6.1.2 The Complainant has acquired statutory rights in the THOM BROWNE marks in India (as per Annexure D of the Complaint). In addition, the Complainant also holds numerous trade mark registrations around the world including United States, Switzerland, European Union, Mexico, Turkey, Chile, Brazil, Peru, China, and Malaysia etc. (as per annexure C of the Complaint).
- 6.1.3 The Complainant submits that netizens from all over the world, including India, visit the Complainant's website. The Complainant also ships the product all over the world, including India. (The Complainant has filed Annexure F to support its claim). The Complainant mark THOM BROWNE has also been a subject of articles in leading fashion magazine such as Elle, Vogue Femina and others (The Complainant has filed Annexure G to support its claim).
- 6.1.4 The disputed domain name is identical to the Complainant's domain name and is clear imitation of "THOM BROWNE" trademark, as there is no addition of words except for the top-level domain.co.in, which misleads the users into believing that the website

www.thombrowne.co.in is the India specific website of the Complainant.

6.1.5 The Complainant alleges that the Disputed Domain Name <thombrowne.co.in>, resolves to a website www.thombrowne.co.in that contains links with key words such as Mens Winter Coat, Mens Winter Fashion, Mens Clothing, Fashion Glasses etc. and these links redirect users to third-party websites. (The Complainant has filed Annexure I to support its claim).

6.1.6 The Complainant submits that a Reverse Whois Lookup on www.reversewhois.io/ for the Respondent's email address sunong@live.com shows that there are over 200 domain names that have been registered with the same Registrant e-mail-ID. These include domain names incorporating renowned brands such as <applestore.in>, <christiandior.co.in>, <diageo.co.in>, <dunhill.co.in>, <ferrerorocher.co.in> etc. (Complainant has attached Annexure J to support its claim).

6.1.7 The Complainant alleges that the Complainant has neither authorized the Respondent to use the Complainant's trademarks nor to register the Disputed Domain Name nor given any license to use the Complainant's mark.

6.1.8 The Complainant alleges that the Respondent has no legitimate interest in the domain name or the mark "THOM BROWNE", respondent has adopted it only with an intention to gain undue advantage from the goodwill associated with the Complainant's THOM BROWNE mark.

6.1.9 The Complainant alleges that the Respondent's adoption of Disputed Domain Name, i.e., thombrowne.co.in is mala fide. The Complainant submits that "THOM BROWNE" is a unique mark and is a renowned brand worldwide. Thus, it is impossible for the

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Respondent to have adopted the Disputed Domain Name, entirely containing the THOM BROWNE mark, in good faith.

6.1.10 The Complainant further submits that various arbitral panels ruled against the Respondent in similar domain name disputes. The Complainant has given list of domain name dispute cases against the Respondents.

6.1.11 The Complainant alleges that the Respondent has intentionally attempted to divert internet users to third-party websites by portraying that there is some association or affiliation of the third-party websites with the Complainant and its offerings. The Respondent has attempted to usurp the Complainant's hard-earned goodwill in the THOM BROWNE mark.

6.1.12 The Complainant submits that if the disputed domain name continues to register in the name of Respondent, it will cause irreparable loss to the Complainant.

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 13(b) that the Arbitrator must ensure that each party is given a fair opportunity to present the case. Rule 13(b) reads as follows:

"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 the arbitration in case any party does not comply with the stipulated time limit to file its response. Rule 17 reads as follows:

“In the 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 with law.”

6.2.4 In present arbitration, despite due service, 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 evidence 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 17 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, and
- b) The Respondent has no rights or legitimate interest in the domain name, and
- 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 has filed documents of its registered trademarks in India and other countries to prove its rights in the trademark “THOM BROWNE”. The Trademark “THOM BROWNE” (word) is

registered in India in class 03 and 09 on 18th August, 2010 vide registration number 2010913 and under class 18, 25 and 35 on 28th December 2010, vide registration No. 2076535. The Complainant has filed supporting proof of registration of “THOM BROWNE” trademark in other countries too (annexed as Annexure C of the complaint). The Complainant has filed sufficient proof to substantiate that the Trademark “THOM BROWNE” is registered in India. Therefore, it is established that the Complainant has statutory protection for the trademark “THOM BROWNE” in India. The Arbitrator finds that the disputed name www.thombrowne.co.in , is clearly identical and deceptively similar to the Complainant’s trademark in which the Complainant has exclusive trademark rights.

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 purposes of UDRP standing. (*Hoffmann-La Roche Inc. v. Wei-Chun Hsia*, WIPO Case No. D2008-0923, *Tesco Stores Limited v. Mat Feakins*, WIPO Case No. DCO2013-0017, *Fifth Street Capital LLC v. Fluder (aka Pierre Olivier Fluder)*, WIPO Case No. D2014-1747, *Dell Inc. v George Dell & Dell Net solutions*, 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 “THOM BROWNE”, the Complainant’s trademark in entirety and adding the ccTLD “.co.in” will not distinguish it from Complainant’s website and is likely to

deceive and confuse consumers. It is well recognized that incorporating a trademark in its entirety, 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))

As the Respondent's disputed domain name is exactly same as Complainant's registered trademark and the Respondent failed to file any reply to rebut the contentions of the Complainant, the Arbitrator finds that the Respondent's domain name is identical to Complainant's registered trademark and is likely to deceive the customers.

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

Under paragraph 6 of the policy, a Respondent or a Registrant can prove rights or legitimate interest in the domain name. The Complainant has filed sufficient evidence to prove disputed domain name is identical to the "THOM BROWNE" trademark, in which Complainant enjoys substantial reputation and goodwill including web shots of its website (annexed as **Annexure F** to complaint) and registration of trademark in India and several other countries (annexed as **Annexure C & D** to the complaint). The Respondent has failed to submit its reply to prove any rights or legitimate interests in the disputed domain name/trademark "THOM BROWNE". The same is also identical to the Complainant's registered trademark, "THOM BROWNE" in use in India since 2010. Complainant has also submitted that it has not authorized Respondent to use its THOM BROWNE mark and Respondent has

failed to rebut the same. The burden of proof thus shifts to Respondent to demonstrate the rights or legitimate interests it holds in the mark as per WIPO Overview 3.0, section 2.1. Despite notice, the Respondent has not rebutted the contentions of the Complainant and has not produced any documents or submissions to show its interest or right in the disputed domain name. Thus, Respondent has failed to establish legitimate interest and/or rights in the disputed domain name.

Further, the Complainant submitted that the Respondent has no rights or legitimate interests in the disputed domain name and has registered the domain name only to take unfair advantage of Complainant's global reputation and goodwill. The fact that the disputed domain name has not been put to legitimate non-commercial fair use or commercial/business use shows Respondent holds no legitimate rights or interest in the disputed domain name pursuant to ICANN Policy 4(b).

It is the Respondent's responsibility to determine whether the Respondent's domain name registration infringes or violates someone else's rights. Since the Complainant's said website and trademarks were in existence and extensively used when disputed domain was registered by the Respondent (registered on 13th April 2018), the Respondent has to prove whether he discharged this responsibility at the time of purchase of disputed domain name. However, despite notice Respondent failed to reply and also failed to discharge this onus.

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The Respondent also failed to file any reply to show that it is making any legitimate, non-commercial or fair use of domain name without intent for commercial gains nor is likely to divert consumers or tarnish trademark by registering the disputed domain name. Infact, the Respondent has posted links to third party sites with words, *Mens Winter Coat*, *Mens Winter Fashion*, *Mens clothing*, *Fashion glasses* to redirect visitors of the website to a business that directly competes with Complainant and is likely to misrepresent to such visitors that there is some association or affiliation of Complainant with the Respondent. In view of the aforesaid facts, the Arbitrator finds that the Respondent has no 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 (Paragraph 4 (c))

For the purposes of Paragraph 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 has secured registration of the mark "THOMBROWNE" in India (word mark) in class 03 and 09 on 18th August, 2010 vide registration number 2010913 and under class 18, 25 and 35 on 28th December 2010, vide registration No. 2076535. The Respondent has produced no evidence of authorization from Complainant or justification for registering the disputed domain name or proof of its honest adoption and legitimate active use. The Complainant also submits that it adopted its mark much prior to that of Respondent and that the Respondent has intentionally adopted disputed domain name www.thombrowne.co.in and is actively using

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it to post third party links which run an identical competing business to that of Complainant, thereby diverting customers which amounts to bad faith registration.

Further, the Complainant provided sufficient evidence showing widespread use, goodwill and trademark registrations of the 'THOM BROWNE' mark in India and other countries which long predates Respondent's registration of the disputed domain name which incorporates completely the registered trademark THOM BROWNE 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 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 Mohammadsalehi, Uranos*, and case no. DIR2020-0006.)

Thus, Arbitrator finds that Respondent's adoption of mark identical with Complainant's Trademark and its active use on disputed website to post links to third parties that run a competing business 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). It is a 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 registration (*PepsiCo Ins. Vs. Wang Shaung*, INDRP case no.400, December 13, 2012). The Complainant has also

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filed evidence to prove that the Respondent has registered various domain names of popular brands with a view to commit cybersquatting (Annexure J to the Complaint). Few arbitral awards have been cited where in arbitral panels have ruled against the Respondent (Para 7.3.6 of the Complaint).

For the afforested 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, *Atos IT Services UK Limited v Above.com Domain Privacy/Nish Patel* WIPO case No. D2013-0655, *Michael Patrick Lynch v. Steve Nicol (Stephen Joel Nicol)*, WIPO Case No. D2015-0933).

8. **DECISION**

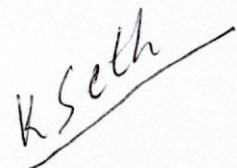
On the basis of the above said findings the Sole Arbitrator finds that:

- 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 www.thombrowne.co.in to the Complainant.

The Award is passed on this 10 March, 2023

Place: Noida



Dr. Karnika Seth

Sole Arbitrator