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JAYASHANKAR KOTANATH  
DISPUTED MOMAIN NAME: "BLUELEAF.IN"

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AJAY GUPTA ARBITRATOR AJAY GUPTA ARBITRATOR AJAY GUPTA ARBITRATOR AJAY GUPTA ARBITRATOR AJAY GUPTA ARBITRATOR

INDRP ARBITRATION CASE NO.1514  
THE NATIONAL INTERNET EXCHANGE OF INDIA (NIXI)

ADMINISTRATIVE PANEL DECISION  
SOLE ARBITRATOR: AJAY GUPTA

**ITC LIMITED**

VERSUS

**JAYASANKAR KOTANATH**

.....

DISPUTED DOMAIN NAME : "BLUELEAF.IN"



INDRP ARBITRATION CASE NO.1514  
THE NATIONAL INTERNET EXCHANGE OF INDIA (NIXI)

ADMINISTRATIVE PANEL DECISION  
SOLE ARBITRATOR: AJAY GUPTA

ITC LIMITED  
ITC Limited Virginia House,  
37, J. L. Nehru Road Kolkata -700071,  
West Bengal

...Complainant

VERSUS

JAYASANKAR KOTHANATH  
7, Rashmi Nilaya, Ramagondanahalli  
Bangalore, Karnataka-560066 (KARNATAKA).

... Respondent

Disputed Domain Name: BLUELEAF.IN



## **The Parties**

The **Complainant** ITC Limited in this arbitration proceedings are carrying on business in diverse fields, inter alia, of Hotels, Information Technology, Paper Boards, etc., and also in marketing and/or manufacturing of cigarettes and other tobacco products and its contact address is ITC Limited Virginia House, 37, J. L. Nehru Road Kolkata-700071 (WEST BENGAL) - India.

In this arbitration proceeding, the Respondent is Jayasankar Kothanath, 7, Rashmi Nilaya, Ramagondanahalli, Bangalore-560066 (KARNATAKA) [INDIA] as per the details given by the WHOIS database maintained by the National Internet Exchange of India (NIXI).

## **The Domain Name and Registrar**

The disputed domain name is "BLUELEAF.IN" The Registrar with which the disputed domain name is registered is Dynadot LLC (Registrar JANA ID: 472), 210 Ellsworth Avenue #345 San Mateo, California 94401 United States of America and also at PO Box 345 San Mateo, California Versus Postal Code: 94401, United States of America Email: [info@dynadot.com](mailto:info@dynadot.com)

## **Procedural History [Arbitration Proceedings]**

This arbitration proceeding is 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 28<sup>th</sup> June 2005 in accordance with the Indian Arbitration and Conciliation Act, 1996. By registering the disputed domain name with the NIXI accredited Registrar, the Respondent agreed to the resolution of the disputes under the IN Dispute Resolution Policy and Rules framed thereunder.

The history of this proceeding is as follows :

- (a) In accordance with Rules 2(a) and 4(a), NIXI on 07.03.2022 formally notified the Respondent of the complaint, and appointed Ajay Gupta as the Sole Arbitrator for adjudicating upon the dispute in accordance with the Arbitration and Conciliation Act, 1996, and the Rules framed thereunder, .IN Domain Resolution Policy and the Rules framed thereunder. That the Arbitrator submitted the Statement of Acceptance and Declaration of Impartiality and Independence dated 07.03.2022, as required by NIXI.
- (b) That commencing the arbitration proceedings an Arbitration Notice Dated 08.03.2022 was sent to the Respondent on 08.03.2022 by this panel under Rule 5(c) of INDRP Rules of Procedure with direction to file a reply of the complaint, if any, within 10 days. The said mail/ Arbitration notice was received by the respondent who acknowledges the receipt of the same on 08.03.2022 itself and conveyed to this panel that he would reply soon. As the complainant had not filed the complete details of the respondent, the complainant was directed by NIXI on 07.03.2022 to file the amended copy of the complaint. This panel vide its mail dated 09.03.2022 also directed the Complainant to serve an amended copy of the complaint to the respondent, this tribunal, and others. As the Complainant despite directions of this panel did not serve the amended complaint to the respondent and this panel, this panel vide its mail dated 14.03.2022 once again directed the complainant to file and serve the amended complaint to the respondent, this panel, and others by 16.03.2022. That complying with the directions of this panel the complainant vide its mail dated

16.03.2022 mailed a copy of the amended complaint to the respondent and this panel.

- (c) This panel vide its Arbitration Notice dated 08.03.2022 had directed the Respondent to file the reply of complaint, if any, within 10 days of the notice and therefore respondent was supposed to file the reply of the complaint by 18.03.2022. However, since the complainant failed to file the amended complaint in time and filed the same on 16.03.2022, this panel in the interest of justice vide its mail dated 19.03.2022 granted a further period of 10 days to the respondent to file the reply of the complaint.
- (d) The Complainant vide its mail dated 21.03.2022 to this panel, submitted that the amended complaint was filed by the complainant on 16.03.2022 by way of email, and also attached the covering letter dated 17.03.2022 and tracking details confirming delivery of amended complaint on the respondent on 18.02.2022 as proof of service.
- (e) The Respondent vide mail dated 27.03.2022, submitted and attached the reply of the complaint in the form of response to the statement and allegations made in the complaint along with annexures, the same is taken on record for consideration of this panel.

### **Background of the Complainant.**

The Complainant, in the present arbitration proceedings to support their case, has relied and placed on records documents as Annexures and made the following submissions :

The Complainant submits that the Complainant is a well-established business house with more than 100 years of history. The Complainant is carrying on business in diverse fields, inter

alia, of Hotels, Information Technology, Paper Boards and Specialty Papers, Printing and Packaging, Personal Care Products, Matches and Agarbatti, Agri-Business; Packaged Foods and Beverages, and other Fast-Moving Consumer Goods (FMCGs). The Complainant is one of India's foremost private sector companies and had a total income of Rs. 51,775.53 crores during the financial year 2020-21 and the market capitalization as of 31st March 2021 was about Rs. 2,68, 948 crores. The Complainant further submits that the complainant has been in the business of marketing and/or manufacturing cigarettes and other tobacco products for more than 100 years due to which it has amassed a colossal reputation in relation to high-quality cigarettes manufactured and marketed under a range of well-reputed trademarks such as "GOLD FLAKE", "CLASSIC", "NAVY CUT", "FLAKE", "BRISTOL", "SCISSORS" and "CAPSTAN" etc. Cigarettes bearing the Complainant's trademarks are also exported to numerous countries across the world including, inter alia, UAE, Qatar, Kuwait, Saudi Arabia, Oman, and Bahrain. The products of the Complainant have traveled beyond the borders of the country, and the Complainant is well known and reputed both within and outside the country.

**Complainant Submissions about the trademark "BLUELEAF" and its statutory and common law rights Adoption :**

The Complainant has made the following submissions regarding trademark registration and domain name and filed records/documents in the form of annexures to support its complaint.

The Complainant submits that the Complainant is the first and bonafide adopter of the trademark 'BLUELEAF' for use in connection with goods covered under Class 34 in India for manufactured tobacco and cigarettes. The Complainant is the

owner of the trademark "BLUELEAF" in Class 34 for "manufactured tobacco and, raw tobacco, smokers' articles, matches, cigarettes, cigarette accessories including cigarette holders, cigars, cigarillos, cigar accessories including humidors, cigar ashtrays, cigar matches, cigar cutters, cigar cases, cigar holders" covered under Class 34 in India. The trademark "BLUE LEAF" of the Complainant was adopted in the year 2008 in India in an honest and bona fide manner to distinguish the goods of the Complainant from those of competitors and was applied for registration in respect of the aforesaid goods included in Class 34. The Complainant launched cigarettes bearing the trademark BLUE LEAF under its reputed trademark CLASSIC, in or around May 2009 and since then has launched iterations thereof from time to time.

The Complainant submits that the trademark BLUE LEAF is inherently distinctive of the products and business of the Complainant and is associated with no one else, other than the Complainant. Being conscious of its intellectual property rights, the Complainant proceeded to obtain registration in its trademark BLUELEAF and its variants from time to time. The Complainant submits that each of these registrations is valid and subsisting in favour of the Complainant, the Complainant has secured trademark protection for BLUE LEAF formative trademarks in numerous countries, including registrations in Oman, Qatar, Saudi Arabia, Kuwait, Bahrain, Nepal, Lebanon, Bangladesh, and Sri Lanka.

The Complainant further submits, that the valuable goodwill and market reputation accruing to the said trademark BLUELEAF accrues solely to the benefit of the Complainant and no other person/entity would be entitled to use the same as a domain name, trademark, trade name, or in any other manner. These





rights are fortified in India by the provisions of The Trade Marks Act, 1999 as well as by common law. Consequently, any use of a domain name identical or deceptively similar to the Complainant's trademark would, inevitably and to the detriment of the Complainant, have the effect of creating a wrongful association with the Complainant, leaving the Complainant completely powerless to control the effects of such an association or use the domain name for its legitimate use qua its business. Such adoption, therefore, would immediately and certainly create confusion among consumers familiar with the Complainant, not just in India but also in other countries.

**Submissions of Complainant about the Respondent and its use of the domain name**

The Complainant submits that on or around December 2021, the Complainant came across the domain name 'BLUELEAF.IN' during an online search conducted by its marketing team. The Complainant has been the earlier registrant of the domain name 'BLUELEAF.IN', was surprised to find that the disputed domain name had been created and registered by the Respondent as recently as November 14, 2021. The Complainant submits that the extent of the respondent's malafide was exposed by the contents and layout of the webpage, which evidences that the Respondent through Dan.com LL has been using the website as a parking page while it scouts for potential buyers so that the domain name can be sold in the future for a humongous profit perhaps to the Complainant or a competitor of the Complainant and cause serious prejudice to its business interests and that of the public at large. The Complainant submits that it is also evident that the domain name by itself is being used as a product for sale and not for any bona fide offering of goods/services thereunder. The Complainant further submits that a WHOIS



search revealed that the Respondent was behind the registration of the disputed domain name, which, in turn, has prompted the present action by the Complainant, and it is apparent that the disputed domain name was registered solely with the intent of making illegal profits from the sale thereof and most likely in the knowledge that the Complainant is the true and rightful owner of the trademark BLUELEAF and that the Respondent would potentially gain from parking it and eventually selling it for gain either to the Complainant or to a competitor.

### **The Respondent's Reply**

The Respondent has made the following submissions in reply/response to the complaint :

- (a) It is submitted by the respondent that the complainant is claiming that they are in the business of marketing and/or manufacturing cigarettes and other tobacco products and marketed under a range of well-reputed trademarks such as "GOLD FLAKE", "CLASSIC", "NAVY CUT", "FLAKE", "BRISTOL", "SCISSORS" and "CAPSTAN" etc. but complainant has not used or marketed the disputed name "Blueleaf" anywhere. The respondent submits that as the domain registrant respondent has not used the domain name blueleaf.in to market any of the products or services mentioned in class 34.
- (b) It is submitted by the respondent that the complainant states that the disputed domain name is of utmost importance to them as far as their Indian customers are concerned. The respondent, however, submits that the complainant doesn't operate any website that consists of the name blueleaf in any of the countries, especially in India.

- (c) It is submitted by the respondent that the complainant claims that they have trademarks in multiple countries but the complainant does not have any websites that consist of the name blueleaf or similar in any of the countries, especially in India. The Respondent further submits that as the online medium for marketing and branding the complainant has not listed 'blueleaf' on their brand page or anywhere on the website itcportal.com.
- (d) It is submitted by the Respondent that the Complainant has failed to provide any evidence that its trademark is well known. It is submitted that on google search results or other search engine results there are many companies named "blueleaf" listed, but there are no results of the complainant's trademarked name appearing, which establishes the fact that the Complainant was never keen on getting registered any domain name consist the word blueleaf in India's country code extension (.in) or any other extensions for its Indian operations.
- (e) It is submitted by the respondent that some of the websites show India, however, none of them represents or are operated by the complainant. The following are the website mentioned by the respondent :

Blueleaf <https://www.blueleaf.com>

Blue Leaf Consulting  
<https://www.blueleafconsult.com>

Blue Leaf Services <http://www.blueleafservices.info/>

Blueleaf: Home <https://www.blueleaftech.in>

Blue Leaf India Property Management Company  
<https://blueleafindia.com>

BlueLeaf Conservation : Home  
<https://blueleafconservation.com>

Blue Leaf Corporate Solutions Pvt. Ltd.  
<http://www.blueleafcorp.com/>

Blue Leaf Hospitality <https://blueleafmiami.com>

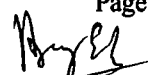
Blue Leaf <https://blueleaftrading.com/>

BLUELEAF INNOVATIONS  
<https://blueleafinnovations.com/home>

Blue leaf Garden <http://www.sbablueleaf.com/>

- (f) It is submitted by the respondent that under the Trademark Act 1999 a mark for goods or services can be registered under 45 different classes or categories. As stated in the Complaint, the Complainant's trademark was registered under Class 34 of the Trademark Act 1999 which pertains to Tobacco, smokers' articles, matches. Whereas the Respondent has no intention whatsoever to venture into the Tobacco, smokers' articles, matches industry. The respondent submits that, it is important to note that the goodwill claimed by the Complainant pertains exclusively to the food and Tobacco, smokers' articles, matches business, and not in any other Categories/Classes of the Trademark Act.
- (g) It is further submitted by the respondent that there are more than 20 trademarks that include the word "blueleaf" registered in India, as well as over 100 trademarks that include "blueleaf" on WIPO Database. The respondent submits that following are some of the trademarks registered in India with the same keyword 'blueleaf':

|                                                                                                                                                                                        |                                                                                                                                                                                                   |
|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <b>BLUELEAF</b><br>Class 44 Registered<br>Filing: 4329023<br>Obtained on: 2019-10-23<br>Registration: 4329023<br>Obtained on: 2019-10-23<br><b>L. UMAMAHESWARI</b>                     | <b>Blueleaf</b><br>Class 21 Registered<br>Filing: 2344827<br>Obtained on: 2012-06-08<br>Registration: 2344827<br>Obtained on: 2012-06-08<br><b>POOJA MANUFACTURING</b>                            |
| <b>BLUE LEAF</b><br>Class 24 Registered<br>Filing: 4908983<br>Obtained on: 2021-03-17<br>Registration: 4908983<br>Obtained on: 2021-03-17<br><b>ASHUTOSH GUPTA</b>                     | <b>BLUE LEAF</b><br>Class 7 Registered<br>Filing: 4393021<br>Obtained on: 2019-12-30<br>Registration: 4393021<br>Obtained on: 2019-12-30<br><b>PREETHI KITCHEN APPLIANCES<br/>PRIVATE LIMITED</b> |
| <b>BLUE Leaf</b><br>Class 25 Registered<br>Filing: 4063068<br>Obtained on: 2019-01-21<br>Registration: 4063068<br>Obtained on: 2019-01-21<br><b>T. GOPINATH</b>                        | <b>BLUE LEAF</b><br>Class 19 Registered<br>Filing: 3304139<br>Obtained on: 2016-07-08<br>Registration: 3304139<br>Obtained on: 2016-07-08<br><b>SHRI KRISHNA PLYWOOD PVT.<br/>LTD.,</b>           |
| <b>BLUE LEAF</b><br>Class 32 Registered<br>Filing: 2251827<br>Obtained on: 2011-12-19<br>Registration: 2251827<br>Obtained on: 2011-12-19<br><b>K.MAHADEVAN</b>                        | <b>BLUE LEAF</b><br>Class 11 Registered<br>Filing: 1711489<br>Obtained on: 2008-07-17<br>Registration: 1711489<br>Obtained on: 2008-07-17<br><b>TAYAL SUSHILA ELECTRICAL<br/>INDIA PVT LTD</b>    |
| <b>BLUE LEAF</b><br>Class 25 Registered<br>Filing: 1179716<br>Obtained on: 2003-03-03<br>Registration: 1179716<br>Obtained on: 2003-03-03<br><b>MANOJ KUMAR</b>                        | <b>BLUE—LEAF</b><br>Class 30 Registered<br>Filing: 1334379<br>Obtained on: 2005-01-25<br>Registration: 1334379<br>Obtained on: 2005-01-25<br><b>MARUTIRAMA ENGINEERS AND<br/>EXIM PVT.LTD</b>     |
| <b>BLUE LEAF WEDDING</b><br>Class 45 Registered<br>Filing: 4183813<br>Obtained on: 2019-05-22<br>Registration: 4183813<br>Obtained on: 2019-05-22<br><b>NIRAV RAMNIKBHAI VACHHANI`</b> | <b>BLUE LEAF WEDDING</b><br>Class 35 Registered<br>Filing: 4183814<br>Obtained on: 2019-05-22<br>Registration: 4183814<br>Obtained on: 2019-05-22<br><b>NIRAV RAMNIKBHAI VACHHANI</b>             |
| <b>BLUE LEAF SILVER</b>                                                                                                                                                                | <b>BLUE LEAF PLATINUM</b>                                                                                                                                                                         |



|                                                                                                                                                                                                                 |                                                                                                                                                                                           |
|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Class 7 Registered<br>Filing: 1544724<br>Obtained on: 2007-03-29<br>Registration: 1544724<br>Obtained on: 2007-03-29<br>PREETHI KITCHEN APPLIANCES<br>PRIVATE LIMITED                                           | Class 7 Registered<br>Filing: 1544722<br>Obtained on: 2007-03-29<br>Registration: 1544722<br>Obtained on: 2007-03-29<br>PREETHI KITCHEN APPLIANCES<br>PRIVATE LIMITED                     |
| PREETHI BLUE LEAF DIAMOND<br>Class 7 Registered<br>Filing: 3066359<br>Obtained on: 2015-09-28<br>Registration: 3066359<br>Obtained on: 2015-09-28<br>PREETHI KITCHEN APPLIANCES<br>PRIVATE LIMITED              | blue leaf by SBA<br>Class 37 Registered<br>Filing: 2488776<br>Obtained on: 2013-03-04<br>Registration: 2488776<br>Obtained on: 2013-03-04<br>E. SARAVANAN                                 |
| BLUE LEAF BUILDERS &<br>DEVELOPERS<br>Class 37 Registered<br>Filing: 2295424<br>Obtained on: 2012-03-06<br>Registration: 2295424<br>Obtained on: 2012-03-06<br>SANESH.P                                         | Blue Leaf Intechpvt. Ltd.<br>Class 42 Registered<br>Filing: 3109344<br>Obtained on: 2015-11-26<br>Registration: 3109344<br>Obtained on: 2015-11-26<br>BLUE LEAF INTECH PRIVATE<br>LIMITED |
| PREETHI BLUE LEAF (DEVICE<br>OF MIXIE)<br>Class 7 Registered<br>Filing: 1544728<br>Obtained on: 2007-03-29<br>Registration: 1544728<br>Obtained on: 2007-03-29<br>PREETHI KITCHEN APPLIANCES<br>PRIVATE LIMITED | Blue Petel Diamond (device of<br>leaf)<br>Class 14 Registered<br>Filing: 2273703<br>Obtained on: 2012-01-30<br>Registration: 2273703<br>Obtained on: 2012-01-30<br>PARESH JAIN            |

- (h) The Respondent submits that following are some of the registered companies in India that use the word blueleaf as their company name.

BLUELEAF BIRCH PRIVATE LIMITED  
 BLUELEAF TRAVELS PRIVATE LIMITED  
 BLUELEAF MEGAMART PRIVATE LIMITED  
 BLUELEAF ENTERPRISES PRIVATE LIMITED  
 BLUELEAF INNOVATIONS PRIVATE LIMITED  
 BLUELEAF DIGITAL INDIA PRIVATE LIMITED  
 GREENSKY BLUELEAF (OPC) PRIVATE LIMITED  
 BLUELEAF MULTI PRODUCTIONS PRIVATE LIMITED  
 BLUELEAF CYBERSPACE SYSTEMS PRIVATE LIMITED  
 BLUELEAF INVESTMENT SOLUTIONS PRIVATE LIMITED



BLUELEAF ARYAN COMMUNICATIONS PRIVATE LIMITED  
BLUELEAF SOFTWARE TECHNOLOGIES PRIVATE LIMITED

- (i) The Respondent submits that the word "blueleaf" either alone or in combination with other terms has been adopted by innumerable businesses around the world. The respondent submits that the disputed domain name here in is Blueleaf.in and the word Blueleaf is only a generic word irrespective of the fact that the complainant owns the trademark. That respondent submits that on this ground itself, the Complaint be rejected.
- (j) It is submitted by the respondent that buying an expired domain doesn't prove that the domain owner targeted the Complainant. It is because that domain name expired and, therefore, is no longer of interest to the previous registrant. It is submitted by the respondent that most registrants will set important domain names to "auto-renew" if critical to their business. The Respondent submits that the concept of "bad faith" under the Policy is not coextensive with the concept of Trademark infringement under the Trademark Act 1999 and therefore, the Complaint is only to be dismissed.
- (k) It is submitted by the respondent that the respondent registered the domain in good faith, after understanding the generic nature of the term. However, as an unexpected situation, the respondent could not launch the website under the domain name "blueleaf. In" as planned.

- (l) The Respondent submits that the Complainant miserably fails to establish any "likelihood of confusion" that may be created among the customers of the Complainant for the simple reason of the Respondent is the Registrant of the disputed domain name "blueleaf. In". It is submitted by the respondent that the analysis of "likelihood of confusion" has to be done at the anvil of two factors namely i) similarities between the marks and ii) similarities between the goods. As aforesaid, the Respondent has successfully proved otherwise on these two grounds. Therefore, it is submitted that the present Complaint against the Respondent herein is an apt case to be dismissed.
- (m) The Respondent submits that he reiterates his promise that the Respondent will never be venturing into the business of the Complainant to be considered as a competitor to the Complainant. The Respondent submits that he has no intention, interest, or passion to venture into the Tobacco, smokers' articles, matches business carried out by the Complainant. The Respondent submits that the purpose of disrupting the business of a competitor does not exist for the simple reason that the proposed business of the Respondent using the disputed domain name "blueleaf.in" is entirely in a different industry than that of the Complainant.
- (n) It is submitted by the respondent that the demands of the Complainant for the cancellation of the Respondent's domain name or the transfer of the Respondent's domain name registration to the Complainant may kindly be dismissed.



## **The issues involved in the dispute**

The Complainant in its complaint has invoked paragraph 4 of the INDRP, which reads:

### **Types of Disputes**

Any person who considers that a registered domain name conflicts with his legitimate rights or interests may file a Complaint to the .IN Registry on the following premises :

The disputed domain name is identical or confusing similar to a trademark in which the Complainant has statutory /common law rights.”

The Respondent has no rights or legitimate interests in respect of the disputed domain name.

The disputed domain name has been registered or is/are being used in bad faith.

The above-mentioned 3 essential elements of a domain name dispute are being discussed hereunder in light of the facts and circumstances of this complaint.

### **Parties Contentions**

**The disputed domain name is identical or confusingly similar to a name, trademark, or service mark in which the Complainant has rights.**

### **Complainant**

The Complainant submits that the disputed domain name comprising the mark BLUE LEAF is functionally identical to the registered trade mark (word) 'BLUE LEAF' of the Complainant, in which it has exclusive statutory rights as set out hereinabove. Disregarding the ccTLD, in this instance ".in", the remainder of

the disputed domain name is identical to the Complainants' trade mark 'BLUE LEAF' which has been in use for more than a decade. It is submitted by the complainant that the Internet users who would come across the said domain name are likely to believe that it is associated with the products of the Complainant. It is further claimed by the Complainant that the complainant plainly and squarely satisfies the first ground on account of such identity.

### **Respondent**

1. The respondent submits that the complainant doesn't operate any website that consists of the name blueleaf in any of the countries, especially in India.
2. The respondent submits that the complainant claims that they have trademarks in multiple countries but the complainant does not have any websites that consist of the name blueleaf or similar in any of the countries, especially in India. The Respondent further submits that as the online medium for marketing and branding the complainant has not listed 'blueleaf' on their brand page or anywhere on the website itcportal.com.
3. It is submitted by the Respondent that the Complainant has failed to provide any evidence that its trademark is well known. It is submitted that on google search results or other search engine results there are many companies named "blueleaf" listed, but there are no results of the complainant's trademarked name appearing, which establishes the fact that the Complainant was never keen in getting registered any domain name consists the word blueleaf in India's country code extension (.in) or any other extensions for its Indian operations.



4. It is submitted by the respondent that some of the websites show India, however, none of them represents or are operated by the complainant.
5. It is further submitted by the respondent that there are more than 20 trademarks that include the word "blueleaf" registered in India, as well as over 100 trademarks that include "blueleaf" on WIPO Database.
6. The Respondent submits there are some of the registered companies in India that use the word blueleaf as their company name.
7. The Respondent submits that the word "blueleaf" either alone or in combination with other terms has been adopted by innumerable businesses around the world. The respondent submits that the disputed domain name here in is Blueleaf.in and the word Blueleaf is only a generic word irrespective of the fact that the complainant owns the trademark. That respondent submits that on this ground itself, the Complaint be rejected.
8. The Respondent submits that the Complainant miserably fails to establish any "likelihood of confusion" that may be created among the customers of the Complainant for the simple reason of the Respondent is the Registrant of the disputed domain name "blueleaf.in". It is submitted by the respondent that the analysis of "likelihood of confusion" has to be done at the anvil of two factors namely i) similarities between the marks and ii) similarities between the goods. As aforesaid, the Respondent has successfully proved otherwise on these two grounds. Therefore, it is submitted that the present Complaint against the Respondent herein is an apt case to be dismissed.



## **Panel Observations**

This Panel on pursuing the documents and records submitted by the Complainant observes that the Complainant is well-established in the business of marketing and/or manufacturing cigarettes and other tobacco products. The complainant has established that the blueleaf, which is the Complainant's very trade name, is popularly known exclusively about the Complainant. It is further observed by this panel that the Complainant has common law as well as statutory rights in its trade/service mark "blueleaf". It is also observed by this panel that the Complainant has successfully secured registrations for the BLUELEAF marks not only in India but also in Oman, Qatar, Saudi Arabia, Kuwait, Bahrain, Nepal, Lebanon, Bangladesh, and Sri Lanka. It has been proved by the Complainant that it has trademark rights and other rights in the mark "blueleaf" by submitting substantial documents in support of it.

The Respondent's submissions about other websites, companies having the name blueleaf have no force since the complainant has common law as well as statutory rights in its trade service mark "blueleaf". This panel observes that the respondent in his response to para 4(a) of INDRP Policy has used extraneous matter to rebut the allegations of the complaint. The submissions of respondents about blueleaf as a generic word hold no ground because the products of the complainant under class 34 are registered not only in India but also in other countries. The respondent's submissions about the likelihood of confusion on the similarity between the marks and similarity between goods are not acceptable since the respondent himself failed to disclose the goods or services and their bonafide use, for which he has registered the disputed domain name.

It is further observed by this panel that the fact that the Disputed domain "www.blueleaf.in" comprises the Complaint's trademarks "BLUELEAF" in their entirety has the potential to cause consumer confusion and will cause the user to mistakenly believe that it originates from, is associated with or is sponsored by the Complainant and further suffix "in" is not sufficient to escape the finding that the domain is confusingly similar to Complainant's trademark.

This panel, therefore, is of opinion that the disputed domain name "blueleaf.in" being identical/confusingly similar to the trademark of Complainant will mislead the public and will cause an unfair advantage to Respondent. The Panel is of the view that there is a likelihood of confusion between the disputed domain name and the Complainant, its trademark, and the domain names associated. The disputed domain name registered by the Respondent is confusingly similar to the trademark "BLUELEAF" of the Complainant.

It is the responsibility of the Respondent to find out before registration that the domain name he is going to register does not violate the rights of any proprietor/brand owner and the respondent has miserably failed in following this condition.

This Panel, therefore, in light of the contentions raised by the Complainant concludes that the disputed domain name is confusingly similar to the Complainant marks. Accordingly, the Panel concludes that the Complainant has satisfied the first element required by Paragraph 4(a) of the INDR Policy.

**The Respondent has no rights or legitimate interests in respect of the disputed domain name.**

## **Complainant**

The Complainant submits that the Respondent has no legitimate rights or interest in the impugned domain name. The home page under the said URL notifies that the said domain name is for sale by its owner. The Respondent is not, in any way, associated with the Complainant and has never either sought or received any authorization from the Complainant to use the mark BLUE LEAF as its domain name. The Respondent does not, through the impugned domain name, make any legitimate offering of goods or services under the name BLUE LEAF. There is no suggestion whatsoever that the Respondent used the disputed domain name to offer bona fide goods or services known/associated with the name BLUE LEAF.

The Complainant submits that there is no evidence whatsoever of the Respondent/Registrant (as an individual, business, or other organization) to have been commonly known by the domain name. The domain name has been registered only in November 2021 while the Complainant has statutory rights on the trademark 'BLUELEAF' since June 24, 2008 and is also the earlier registrant of the said domain name.

The Complainant submits that the Respondent has been using the website as a parking page hosted by Dan.com while it scouts for potential buyers so that the domain name can be sold in the future for a humongous profit perhaps to the Complainant or a competitor of the Complainant and cause serious prejudice to its business interests and that of the public at large. It is also evident that the domain name by itself is being used as a product for sale and not for any bona fide offering of goods/services thereunder and consequently, the Respondent/Registrant has no rights or legitimate interests in respect of the domain name. The

Complainant has placed Reliance on WIPO Case No. D2018-1244 CareFusion Corporation Vs James H Park.

The Complainant submits that the Respondent is not making a legitimate non-commercial or fair use of the domain name, without the intention of commercial gain. While its use of the domain name which is identical to the registered trademark of the Complainant 'BLUE LEAF' as a commodity in itself would result in tarnishing of the Trade Mark 'BLUE LEAF' of the Complainant.

### **Respondent**

The Respondent in response to the complaint has not submitted/replied to the Complainant's contentions that the Respondent/ Registrant has no rights or legitimate interests in respect of the domain name. There are no submissions or evidence put on records by the respondent to prove that he has any rights or legitimate interests in respect of the domain name.

### **Panel Observations**

This Panel holds that the second element that the Complainant needs to prove and as is required by paragraph 4(b) of the INDRP is that the Respondent has no legitimate right or interests in the disputed domain name.

This panel observes that the Complainant by placing documents/records and evidence along with the complaint has been able to prove that the Complainant is well-established in the business of marketing and/or manufacturing cigarettes and other tobacco products and has established that the blueleaf, which is the Complainant's very trade name, is popularly known exclusively about the Complainant. The Complainant has also established that the trademark BLUE LEAF is inherently distinctive

of the products and business of the Complainant and has secured trademark protection for BLUE LEAF by registering trademarks in India and many other countries.

It is observed by this panel that the Respondent has failed to rebut the allegations of the Complainant that the Respondent has no legitimate rights or interest in the impugned domain name. This panel while going through the documents placed on record by the complainant observed that the home page under the said URL notifies that the said domain name is for sale by its owner. It is observed by this panel that the domain name by itself is being used as a product for sale and not for any bona fide offering of goods/services.

The Respondent has failed to rebut the allegations of the complainant that the respondent is not, in any way, associated with the Complainant and has never either sought or received any authorization from the Complainant to use the mark BLUELEAF as its domain name. It is observed by this panel that the Respondent does not, through the impugned domain name, make any legitimate offering of goods or services under the name BLUE LEAF.

It is further observed by this panel that the respondent has failed to rebut the allegations of the complainant that there is no evidence whatsoever of the Respondent/Registrant as an individual, business, or other organization to have been commonly known by the domain name.

Once the Complainant makes a prima facie case showing that the Respondent does not have any rights or legitimate interest in the domain name, the burden to give evidence shifts to the Respondent to rebut the contention by providing evidence of its



rights or interests in the domain name. The Respondent while submitting the response to the complaint has failed to place any evidence to rebut the allegations of the Complainant.

It is further observed by this panel that para 6 of the .IN Domain Name Dispute Resolution Policy (INDRP) states :

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 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.

This panel while considering the response of the respondent and evaluating all the evidence, observe that respondent also failed to full fill any of the requirements as mentioned in para 6 of INDRP Policy which demonstrates the registrant's rights to or legitimate interests in the domain name for the purposes of Clause 4 (b).

For these reasons, the Panel holds that the Complainant has proved that the Respondent does not have any rights or legitimate interests in the disputed domain name.

**The disputed domain name has been registered or is being used in bad faith.**

### **Complainant**

The Complainant submits that the Respondent has registered/ caused to be registered the disputed domain name in bad faith, i.e. primarily for selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark 'BLUE LEAF', or to a competitor of the Complainant, for a valuable consideration. This is corroborated by the fact that a link on the top of the disputed page, at least until January 05, 2022, informed the public at large that the impugned domain name is available for sale for USD 18,000 which is nearly INR 13,55,553/- (Rupees Thirteen Lakh Fifty-Five Thousand Five Hundred Fifty-Three Only) and also invited counteroffers. Today the webpage has invitations to make an offer by quoting a price for the sale of the disputed domain. The fact that the information regarding the sale of the disputed domain name has been made available publicly and that Respondent through Dan.com invites/solicits offers on the same indicates that Respondent intends to receive the highest possible price for the impugned domain name. Several previous rulings by the Panel have repeatedly held that such acts demonstrate that the offending parties do not have legitimate rights or business interest in the disputed domain name and that they are demonstrative of bad faith. In this case, as well, it is apparent that the Respondent has wrongfully acquired/registered the domain name [www.blueleaf.in](http://www.blueleaf.in) in its favour in bad faith.

The Complainant submits that the disputed domain name was initially registered by the Complainant from 28.08.2009 until 28.08.2021. However, on account of a technical glitch, the Complainant was unable to renew the disputed domain name and was surprised to find that the disputed domain name had been created and registered by the Respondent as recently as November 14, 2021. The Complainant has placed Reliance upon the decision of the Hon'ble High Court of Kerala in Pen Books Pvt. Ltd. Vs. Padmaraj, Emily Estate, Kalpatta: 2004 (29) PTC 13 7, where the Plaintiff (Pen Books Pvt Ltd) had initially registered the domain name penbooks.com in 1999 but, due to some technical snags could not launch the website. The validity period of registration of the said domain name expired on 02.03.2001, when Plaintiff sought to launch the website again in 2002, it found that the domain name penbooks.com stood registered in the name of the defendant (Padmaraj) and it was advertised on the Internet for sale. The Hon'ble High Court of Kerala found the registration in the name of the defendant (Padmaraj) to be an abusive registration of domain name in violation of the rights of trademark Page I 17 18 and service marks of the plaintiff amounting to, what is popularly known as, Cyber Squatting (emphasis supplied). Considering the Uniform Domain Name Disputes Resolution Policy, the Court found that the domain name having been registered by the defendant to sell or transfer the same was to be treated as having been registered in bad faith.

The Complainant has referred to Paragraph 7(a) of the INDRP which establishes bad faith registration where the Registrant has registered or acquired the domain name primarily for 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 Respondent's documented out-of-pocket costs directly related to the domain name. Reliance is placed on WIPO Case No. D201 7-2182 Carrefour v. Atome Tech, Anderson Ano11zo and WIPO Case No. D2017-1193 Bhal'ti Enterprises (Holtling) Private Limited Vs Privacydotlink Customer 28 79670/Houghton Richards Brokerage. Reliance is also placed upon Pfizer Products Inc. vs Mr. Altamash Khan and Anr. [2006 (32) PTC 208 (DEL)] wherein the Hon'ble Delhi High Court while protecting the rights of Pfizer Products Inc. in respect of its trademark VIAGRA had inter alia held in paragraph 13. "It is apparent that the sole object of the defendant No. I for applying for the domain name viagra.in was its sale to an interested party. If the sale in such a situation was to be for valuable consideration in excess of the registrants' documented out-of-pocket costs directly related to the domain name, it would be evidence of the registration being in bad faith as envisaged in paragraph 6 of the IND RP. If not, in any event, the domain name viagra. in is, if not identical, confusingly similar to the trademark VIAGRA and the domain name viagra.com of which the plaintiff is the proprietor. And, to make matters worse for defendant No. I, it has no right or legitimate interest in respect of the domain name viagra.in".

The Complainant further states that, by using the disputed domain name the Respondent, intentionally intends to attract, for commercial gain, internet users to its website by creating a likelihood of confusion with the Complainant's popular products offered for sale bearing the trademark BLUELEAF, and implying some kind of affiliation with or endorsement by the Complainant. This act of the Respondent satisfies Paragraph 7( c) of the INDRP which imputes bad faith on a Respondent who, by using the domain name, intentionally attempts to attract internet users to

its website or other online location by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location. It is the Complainant's case that both violations of Paragraphs 7(a) and 7(c) stand clearly made out by the conduct of the Respondent herein. Reliance is placed on WIPO Case No. D2011-0624 Eli Li/Iv and Company v. Private Whois Service

The Complainant further submits that the Respondent's acts also have the effect of using the Complainant's trademark 'BLUE LEAF' to attract unwary users to the impugned webpage and not just prompting the Complainant to move to secure/purchase the said domain name for fear of misuse but also earning revenue for the Respondent through the potential sale of the same to third parties/users/competitors, such modus operandi has been recognized as illegal by previous Panel decisions.

The Complainant submits that the Complainant has not licensed or otherwise permitted the Respondent to use its trademark BLUE LEAF, nor has it permitted the Respondent to apply for or use any domain name incorporating the trademark.

The Complainant submits that the domain name [www.blueleaf.in](http://www.blueleaf.in) was adopted by the Respondent despite being well aware of the prior existence of the Complainant and the goodwill attached to its business concerning the trademark BLUELEAF. The concerned trade and public are acquainted with the Complainant's trademark and upon finding any goods or services under the said name in conjunction with the said domain name, they would likely presume that the same has originated from the Complainant. The Complainant was the earlier and bona fide registrant of the said domain name but could not put the domain name to use given

special circumstances due to regulatory restrictions on the advertisement of tobacco products. The Apex Court in *Hardie Tmdil1g Ltd. • Pagell9 20 &Anr. Vs Addiso11s Paint & Chemicals Ltd. !AIR 2003 SC 3377*/has recognized such special circumstances when the rights of the brand owner stand protected despite the inability to use a mark on account of regulatory restrictions. As stated above, the Respondent does not have any legitimate interest in using the said domain name and only intends to illegally benefit from the goodwill and market reputation of the Complainant and profit from the resale of the said domain name. It is likely that an unwary person while coming across the said domain name is likely to presume a commercial connection between the Complainant and Respondent. It is also likely that any material on such disputed domain may be antithetical to the reputation and business practices of the Complainant and use of the same by the Respondent will cause disrepute and grave harm to the Complainant since the disputed domain name will be presumed to be that of the Complainant. The Complainant ought to have complete control over the use of the trade mark "BLUE LEAF" as a domain name . The Complainant submits that the conduct of the Respondent reflects the dishonesty involved in their course of action.

### **Respondent**

The submission by the Respondent in response to clause 4(c) of the INDRP Policy is that the concept of "bad faith" under the Policy is not coextensive with the concept of Trademark infringement under the Trademark Act 1999 and therefore, the Complaint is only to be dismissed. The Respondent further submits that he reiterates its promise, that the Respondent will never be venturing into the business of the Complainant to be considered as a competitor to the Complainant. The Respondent

submits that he has no intention, interest, or passion to venture into the Tobacco, smokers' articles, matches business carried out by the Complainant. The Respondent submits that the purpose of disrupting the business of a competitor does not exist for the simple reason that the proposed business of the Respondent using the disputed domain name "blueleaf.in" is entirely in a different industry than that of the Complainant. The Respondent further submits that as the domain registrant the respondent has not used the domain name blueleaf.in to market any of the products or services mentioned in class 34. It is submitted by the respondent that the respondent registered the domain in good faith, after understanding the generic nature of the term. However, as an unexpected situation, the respondent could not launch the website under the domain name "blueleaf. In" as planned.

### **Panel Observation**

Paragraph 7 of the INDRP provides that the following circumstances are deemed to be evidence that Respondent has registered and used a domain name in bad faith :

- (a) Circumstances indicating that the Respondent has registered or has acquired the domain name primarily for 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 Registrar's documented out of pocket costs directly related to the domain name; or
- (b) the Respondent has registered the domain name to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that

the Respondent has engaged in a pattern of such conduct;  
or

- (c) by using the domain name, the Respondent has intentionally attempted to attract internet users to its website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its Website or location or a product or services on its website or location."

It is observed by this panel that a link on the top of the disputed page, informed the public at large that the impugned domain name is available for sale for USD 18,000 which is nearly INR 13,55,553/- (Rupees Thirteen Lakh Fifty-Five Thousand Five Hundred Fifty-Three Only) and also invited counteroffers. It is observed by this panel that the information regarding the sale of the disputed domain name has been made available publicly and that Respondent through Dan.com invites/solicits offers on the same indicates the Respondent has registered and used the disputed domain name "blueleaf" in bad faith.

It is rightly established by the complainant that the respondent has registered/ caused to be registered the disputed domain name in bad faith, i.e. primarily for selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark 'BLUELEAF', or to a competitor of the Complainant, for a valuable consideration.

The Respondent has failed to specifically rebut any of the allegations leveled by the complainant against the respondent, concerning the Complainant's contentions that the Respondent's domain name has been registered or is being used in bad faith, primarily for selling, renting, or otherwise transferring the disputed domain name for a valuable consideration. The only



submission by the Respondent in response to clause 4(c) of the INDRP Policy that the concept of "bad faith" under the Policy is not coextensive with the concept of Trademark infringement under the Trademark Act 1999 has no force because the respondent has failed to submit on record any ground or evidence in support of same. The Respondent has not made any submissions to rebut the allegations about selling, renting, or otherwise transferring the disputed domain name and the respondent is silent on this aspect in the response submitted by him. The respondent's submissions that he has no interest or to venture into the business of the complaint and respondent has not entered into marketing the products as mentioned in class 34 hold no grounds since he has miserably failed to disclose the goods, products, or service in which he is dealing or intend to deal in future. The respondent submitted that he registered the disputed domain name in good faith and could not launch the website blueleaf.in due to an unexpected situation is not believable as he had no product, good, or service to offer and put the disputed domain name for sale as evident from the record.

This panel holds, that since the respondent has failed to disclose the goods, products, or services he is dealing with or intends to deal with in the future, the disputed domain name has been registered in bad faith for selling, renting, or otherwise transferring the disputed domain name for a valuable consideration.

There is evidence that points to the existence of circumstances as mentioned in clause 7(a) of the INDRP Policy. The Respondent's registration of the domain name meets the bad faith elements outlined in para 4 (C) of INDRP Policy. Therefore, the Panel concludes that the registration by Respondent is in bad faith. Consequently, it is established that the disputed domain name

was registered in bad faith or used in bad faith and the Respondent has wrongfully acquired/registered the domain name www.blueleaf.in its favour in bad faith.

### **Remedies Requested**

The Complainant has prayed to this Administrative Panel that the disputed domain <www.blueleaf.in> be transferred to the Complainant and the Respondent be directed to pay the costs of the present proceedings.

### **Decision**

The following circumstances are material to the issue in the present case:

The Complainant through its contentions based on documents/ records and evidence has been able to establish that the Complainant is well-established in the business of marketing and/or manufacturing cigarettes and other tobacco products. The complainant has established that the blueleaf, which is the Complainant's very trade name, is popularly known exclusively concerning the Complainant. The Complainant has also established that the trademark BLUE LEAF is inherently distinctive of the products and business of the Complainant and has secured trademark protection for BLUELEAF by registering trademarks in India and many other countries.

The Respondent, however, has failed to provide any evidence that it has any rights or legitimate interests in respect of the domain name, and the Respondent is related in any way to the Complainant. The Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the Disputed Domain Name.

The Complainant has rather brought sufficient evidence on record in the form of annexures, where it is clearly shown that the contents of the Webpages under the Domain Name on the top of the home page under the said URL being "www.blueleaf.in" notifies that the said domain name is for sale and makes an invitation to users to make an offer in United States Dollars. It is also established by the complainant that the domain name by itself is being used as a product for sale and not for any bona fide offering of goods/services thereunder. This panel while considering the complaint and records in the form of annexures as submitted by the complainant and responses of the respondent, has concluded that there exist circumstances as stated in para 7(C) of INDRP Policy.

Taking into account the nature of the disputed domain name and in particular, the ".in" extension alongside the Complainant's mark which is confusingly similar, which would inevitably associate the disputed domain name closely with the Complainant's group of domains in the minds of consumers, all plausible actual or contemplated active use of disputed Domain Name by the Respondent is and would be illegitimate.

The Respondent also 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 Complainant has given sufficient evidence to prove extensive trademark rights on the disputed domain name. Whereas, the Respondent's adoption and registration of the disputed domain name is dishonest and done in bad faith.

This panel is of the view that it is for the Complainant to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such a prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name but the Respondent has miserably failed to do that. Thus, it is clear that the Respondent's registration and use of the domain name [blueleaf.in] are in bad faith. The Respondent has no rights or legitimate interests in respect of the domain name and also the domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

### **RELIEF**

In accordance with INDRP Policy and Rules, the Panel directs that the disputed domain name [blueleaf.in] be transferred from the Respondent to the Complainant; with a request to NIXI to monitor the transfer. There is no order to the cost, the parties of the complaint to bear their costs.

New Delhi, India  
Dated: 31st March, 2022

  
**[AJAY GUPTA]**  
Sole Arbitrator