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IN-DL95312860973262U

**BEFORE DR. PANKAJ GARG, SOLE ARBITRATOR, AT
NEW DELHI**

**COMPLAINT NO. INDRP
CASE NO. 1504/2022**

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ALL STAR C.V.

...COMPLAINANT

VERSUS

HIOX SOFTWARES PRIVATE LIMITED

.....RESPONDENT

CORAM:

HON'BLE DR. PANKAJ GARG

AWARD

16.04.2022

The matter is taken up today by this Tribunal for passing an award in terms of the notice issued by this Tribunal on 16.02.2022.

The service of the hard copy as well as the soft copy of the Complaint and the Notice of this Tribunal upon the Respondent has already been completed.

It is the case of the Complainant that-



“The Complainant is the owner and controller of the CONVERSE brand. The Complainant has, through its own use and use by associate companies and licensees, built a significant reputation and has built up a vast amount of goodwill in the CONVERSE brand worldwide in relation to a range of goods and services.

The Complainant carries on an established business in respect of a large variety of goods, including footwear, clothing, headgear and bags. The Complainant is a famous manufacturer of shoes, apparel and bags. The Complainant, including through its authorised partners, sells products under the CONVERSE brand in many countries, including but not limited to: India; the United States; Canada; Brazil; Mexico; Germany; England; France; Italy; Spain; Greece; Holland; Denmark; Sweden; Norway; Czech Republic; Russia; China; Hong Kong; Japan; Korea; Thailand; Malaysia; Indonesia; Australia. Converse footwear is manufactured at several plants, including in India, Indonesia, China and Vietnam.

The Complainant has produced and sold shoes for over a century. The Complainant was founded in 1908 in Massachusetts, United States, as a rubber company, and began producing shoes in 1909. Since that time, the Complainant has developed its Converse brand into a worldwide, famous brand selling footwear, apparel, and bags around the world.



Annual revenue from the Complainant's worldwide sales more than tripled between 2007 and 2019 from US \$564 million to a peak of more than US \$2 billion:

Fiscal year	US Dollars (Millions)
2007	564
2008	730
2009	916
2010	983
2011	1,131
2012	1,324
2013	1,449
2014	1,684



2015	1,982
2016	1,956
2017	2,042
2018	1,886
2019	1,906

The Complainant's worldwide promotional and advertising expenditures for 2007 to 2019 of NIKE companies, including affiliates such as the CONVERSE brand, throughout the world are outlined below:

Fiscal year	US Dollars (Millions)
2007	1,912
2008	2,308
2009	2,351
2010	2,356
2011	2,344



2012	2.607
2013	2,745
2014	3,031
2015	3,213
2016	3,278
2017	3,341
2018	3,577
2019	3,750

The Complainant's CONVERSE brand and, in particular, it's Chuck Taylor All Star sneaker, is widely regarded and consistently ranked as one of the "coolest" and most iconic sneakers of all time. For example:

- . *In 2018, Converse was voted as the no.4 sneaker brand by the public on ranker.com.*
- . *In 2017, Converse Chuck Taylor All Star sneaker was ranked as one of the 11 most iconic sneakers of all time by CNN.*
- . *In 2017, Converse Chuck Taylor All Star sneaker was ranked the #3 greatest sneaker of all time as voted for by an international poll*



comprising of industry experts and the general public for a London Exhibition on sneakers.

- . In 2015, Converse Chuck Taylor All Star sneaker was ranked #3 on a list of the most important sneakers of all time by businessinsider.com.*
- . In 2011, Converse Chuck Taylor All Star sneaker was ranked as the top sneaker of all time by Vanity Fair's fashion director, Michael Carl.*

Every year large sums of money are spent in advertising the products sold under the CONVERSE brand. Such advertisements appear in magazines having international circulation such as Sports Illustrated, Newsweek and many others. The Complainant's CONVERSE brand is and has been seen being worn and/or promoted by a large number of culturally significant people including, but not limited to, the former First Lady of the United States of America, Michelle Obama, movie star Kristen Stewart, the lead singer of world-renowned band Nirvana, Kurt Cobain, popular Netflix show Stranger Things, Millie Bobby Brown, and international popstars Rihanna, Katy Perry, and Taylor Swift. Products sold under the Complainant's CONVERSE brand are thus known to consumers around the world. The CONVERSE brand has also been adopted by a number of Bollywood celebrities.



Because of the extensive worldwide sales and advertising over the years, the Complainant's CONVERSE brand is recognised around the world by the trade and the public.

As can be seen from the above, the Complainant has made extensive and continuous use of its CONVERSE brand around the world. In consequence of such use, the Complainant's CONVERSE brand has acquired and maintained a substantial reputation and significant goodwill.

The Complainant's extensive use of its CONVERSE brand has educated the public to understand that, when they see goods and services being offered under the CONVERSE brand, that the goods and services originate from the Complainant.

In addition to their established goodwill, the Complainant is the proprietor of numerous trade mark registrations for the CONVERSE brand since 1968 around the world and has registered trade mark rights in India since 1979. This very clearly demonstrates that the Complainant has rights in the CONVERSE brand.

The Complainant submits that the registration and use of the Disputed Domain Name is abusive. To support their claim, they will now proceed to address each of the substantive grounds in Paragraph 4 of the INDRP

Policy.



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

The Complainant submits that they have trade marks registered in India from 1979 as well as goodwill in the CONVERSE brand since that date, as outlined above in paragraphs. The Complainant submits that the INDRP does not explicitly mention *where* the trade mark rights need to be registered, but merely requires rights to be present at the time of filing the INDRP complaint. In the first instance, the Complainant submits that its registered trade mark rights in India dating back to 1979, together with the goodwill that it enjoys, clearly predate the registration of the Disputed Domain. Further or in the alternative, the Complainant submits that there have been recent decisions where the complaining party has relied on UK and EUTM rights, which were held to be sufficient for the purposes of establishing ‘rights’ in a INDRP dispute concerning the domain <what3words.in> (see What3Words Limited v. Vinit Saxena. INDRP Case No. 1229/2020). As set out at Annex 4 (above), the Complainant also owns earlier UK and EU rights.

The Complainant has a number of other domain dispute decisions that have been issued which relate to domain names including the word CONVERSE which act to support that the Complainant has a significant portfolio of trade mark rights, a reputation in the CONVERSE brand and



that a likelihood of confusion does exist in relation to the dispute domain name. Extracts from some of the decisions are as follows:

WIPO Case No. D2011-1405 - <conversezone.com> - *'The Complainant clearly has rights in the CONVERSE Marks'*.

WIPO Case No. D2007-0926 - <conversehightops.com> - *'The CONVERSE mark is notoriously associated with athletic footwear products....'*

WIPO Case No. D2005-0350 - <conversebasketball.com> - *'Complainant has long-established and registered trademark rights in the MARK, which is well known and associated with basketball shoes'*.

WIPO Case No. D2018-0414 - <converseusa.com> - *'It is uncontroverted that the Complainant has established rights in the CONVERSE Trademark based on its numerous registrations for the CONVERSE Trademark and long term use all over the world'*.

The Complainant submits that the Disputed Domain Name is identical to the Complainant's CONVERSE brand as it incorporates the CONVERSE term verbatim. The Complainant requests that the Panel omit the suffix extension 'in' as this is merely a technical requirement for domain names in India (see *Urban Outfitters, Inc. v. Machang*. INDRP Case No.

601/2014).



In conclusion, the Complainant maintains that the Disputed Domain Name is identical to that of the Complainant's trade marks.

B. The Respondent has no rights or legitimate interests in the Disputed Domain Name

The Complainant submits that the Respondent does not have any rights or legitimate interests in the Disputed Domain Name. Under Policy, Paragraph 6 of the INDRP Policy, the Complainant acknowledges that a Respondent may demonstrate a right or legitimate interest in the domain name if it can be established that:

The Respondent's use of the Disputed Domain Names or a name corresponding to the Disputed Domain Names is in connection with a bona fide offering of goods or services;

The Respondent has been commonly known by the Disputed Domain Names, even if they have acquired no trade mark or service mark rights;
or

The Respondent is making a legitimate non-commercial or fair use of the Disputed Domain Names, without intent or commercial gain to misleadingly divert consumers.

The Complainant will proceed to rebut each of the above-mentioned defenses. The burden of proof will then shift to the Respondent to put



forward evidence that they do have rights or legitimate interests in the Disputed Domain Name.

Based on the Complainant's reputation, there is no believable or realistic reason for registration or use of the Disputed Domain Name other than to take advantage of the Complainant's rights.

Before any notice to the Respondent of the dispute, the Respondent's use of, or demonstrable preparations to use the Disputed Domain Name or a name corresponding to the Disputed Domain Name in connection with a bona fide offering of goods or services;

The Complainant submits that the Disputed Domain Name, since the date of its registration by the Respondent on 12 October 2021, has been listed for sale on Dan.com domain name marketplace for an undisclosed amount, allowing internet users to "make an offer". By using the Disputed Domain Name in such a way, it is clear that the Respondent knew of the Complainant's CONVERSE brand and has registered the Disputed Domain Name to try and profit from its sale, by taking active steps to list the Disputed Domain Name at an auction site and invite internet users to bid on the Disputed Domain Name. Such use does not constitute a bona fide offering of goods and/or services.



The Respondent (as an individual, business, or other organization) has been commonly known by the Disputed Domain Name, even if the Respondent has acquired no trade mark or service mark rights

The Complainant submits that to the best of their knowledge, the Respondent has never legitimately been known as 'CONVERSE' at any point in time. These facts lead the Complainant to conclude that the only reason why the Respondent registered the Disputed Domain Name was to take advantage of the Complainant's goodwill and valuable reputation and make a financial gain for themselves.

The Respondent is making a legitimate non-commercial or fair use of the Disputed Domain Name, without the intention of commercial gain by misleadingly or diverting consumers or to tarnish the trade mark or service mark at issue.

The Complainant submits that nothing about the Disputed Domain Name suggests that the Respondent is making a legitimate non-commercial or fair use. As mentioned above, the Disputed Domain Name has been listed for sale since the date of its registration by the Respondent, which shows that the Respondent is attempting to capitalize on the brand value of the Complainant's CONVERSE brand. Therefore, the Respondent cannot

come within Policy, Paragraph 6(c) of the INDRP Policy.



Considering the comments submitted above, the Respondent does not satisfy any of the above-mentioned grounds.

C. The domain name was registered and is being used in bad faith.

The Complainant submits that the Disputed Domain Name has been registered and used in bad faith in accordance with Policy, Paragraph 7.

The Complainant reiterates their comments that the CONVERSE brand is established worldwide. Therefore, the Complainant submits that the Respondent had knowledge of the Complainant's CONVERSE brand and that the Disputed Domain Name was registered with the Complainant in mind.

Bad Faith: INDRP Policy, Paragraph 7(a)

As discussed in Part 2 of the Complaint, and evidenced at **Annex 5**, the Complainant submits that the Respondent has registered the Disputed Domain Name primarily for the purpose of selling, renting, or otherwise transferring it to the Complainant, for valuable consideration in excess of the Registrant's documented out-of-pocket costs directly related to the Disputed Domain Name. There are no other indicators which could suggest otherwise.

Bad Faith: INDRP Policy, Paragraph 7(c)



The Complainant submits that the Respondent has registered the Disputed Domain Name in bad faith by intentionally attempting to attract Internet users to the content hosted at the Disputed Domain Name, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website (as per INDRP Policy Paragraph 7(c)). The Complainant reiterates their submissions at paragraph 13.24. and 13.25. of this Complaint, that the Respondent has registered the Disputed Domain Name in order to make a financial gain for themselves by taking active steps to list the Disputed Domain Name at a well-known domain name auction site. (see *Annex 5*).

Bad Faith: INDRP Policy, Paragraph 7(b)

Based on the above submissions, the Complainant maintains that the Respondent has registered and used the Disputed Domain Name in bad faith.

It is the case of the Defendant that-

The defendant in its E-mail dated 16.02.2022 specifically submits that-

"Dear Sir

We HIOX INDIA, accredited registrar for .in domain name and domain converse.co.in has been registered with us by one of our customer.



This domain name converse.co.in has been registered with us on 13.10.2021 by paying 352.82Rs using CC Avenue payment gateway.

In this case, we can provide you with the details of customer and payment details. Kindly find the details below

1. Profile Details

Name : Prahlad K

Email id : iprahladsharma@gmail.com

Mobile No : 7799344000

Address : No 302, Plot No 76 And 77, Hyderabad, Andhra Pradesh, India - 500010.

2. CCAvenue Payment details

Amount : 352.82Rs

Date : 2021-10-13 02:56:55.527

CCAvenue Ref No : 110306621984

CCAvenue Order No : 42462010132021025617

Customer IP: 183.83.161.243

Pay Mode: Unified Payments-UPI

Bank Ref #: 128696562124

These are the details available with us pertaining to this domain name converse.co.in. Kindly let us know if any further details required.

Thanks & Regards

Senthil kumar G J"

Further more Mr. Prahlad Kumar in its E-mail dated 18.03.2022 specifically states that-

"Dear Team

Firstly, apologies for the late reply as my wife was under going treatment.



I have not used any logo or trademark which points directly or indirectly to converse brand. This domain was actually purchased to launch an app which compete with twitter.

The word converse is dictionary and generic word. If you have any materialistic proof what so ever to show that I used domain name to represent your brand, i am happy to handover it to you.

But since I bought it for launching app which actually did not fulfill under this name but launched on other names previously in playstore. I can list that to you if you required it.

How can you become owner of converse as a dictionary word, tomorrow someone becomes owner of water, sky and earth will they not be allowed to use these words even corona.

Now since you are asking, i can file official reply to it if you still needed it.

Regards.

Prahlad Kumar”

For the purpose of examination that whether the reliefs sought by the Complainant can be allowed or not, it is much necessary to appreciate the legal position along with the facts submitted by the Complainant. In this regard it is much necessary to discuss the provisions of Section 29 of the Trade Marks Act, 1999 (for short ‘T M Act, 1999’). Section 29 of the T

M Act, 1999 reads as under:-



“29. Infringement of registered trade marks.—

(1) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of—

(a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or

(b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or

(c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark, is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

(3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public.

(4) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which—



*(a) is identical with or similar to the registered trade mark;
and*

*(b) is used in relation to goods or services which are not
similar to those for which the trade mark is registered; and*

*(c) the registered trade mark has a reputation in India and
the use of the mark without due cause takes unfair advantage
of or is detrimental to, the distinctive character or repute of
the registered trade mark.*

*(5) A registered trade mark is infringed by a person if he uses
such registered trade mark, as his trade name or part of his
trade name, or name of his business concern or part of the
name, of his business concern dealing in goods or services in
respect of which the trade mark is registered.*

*(6) For the purposes of this section, a person uses a registered
mark, if, in particular, he—*

(a) affixes it to goods or the packaging thereof;

*(b) offers or exposes goods for sale, puts them on the market,
or stocks them for those purposes under the registered trade
mark, or offers or supplies services under the registered
trade mark;*

(c) imports or exports goods under the mark; or

*(d) uses the registered trade mark on business papers or in
advertising.*

*(7) A registered trade mark is infringed by a person who applies
such registered trade mark to a material intended to be used for
labelling or packaging goods, as a business paper, or for
advertising goods or services, provided such person, when he
applied the mark, knew or had reason to believe that the*



application of the mark was not duly authorised by the proprietor or a licensee.

(8) A registered trade mark is infringed by any advertising of that trade mark if such advertising—

(a) takes unfair advantage of and is contrary to honest practices in industrial or commercial matters; or

(b) is detrimental to its distinctive character; or

(c) is against the reputation of the trade mark.

(9) Where the distinctive elements of a registered trade mark consist of or include words, the trade mark may be infringed by the spoken use of those words as well as by their visual representation and reference in this section to the use of a mark shall be construed accordingly.”

Section 29 of The TM Act speaks the owner/proprietor of the registered trade mark claiming the infringement of the said mark by another person, who is neither a registered Proprietor in relation to the goods and services, for which the mark is registered, nor has permission to use such mark in the course of his trade. Under the provisions of Section 29(1), infringement results if the mark is identical with or deceptively similar to the already registered trade mark and is in relation to the goods and services, for which the trade mark has been registered.

Under Section 29(2)(b), infringement occurs where the impugned mark is similar to the registered mark and the goods and the services, for which is used is identical with or similar to the goods and services, for which the



registered mark is used. Under Section 29(2)(c), infringement occurs where the impugned trade mark is identical to the registered trade mark and the goods or services, for which the impugned mark is used is also identical to the goods and services covered by the registered trade mark.

An additional ingredient in the above three situations for the infringement is that the use of impugned trade mark is likely to cause confusion on the part of the public or is likely to have an association with the registered trade mark. Under Section 29(3), when the impugned trade mark is identical to the registered trade mark and the goods/services, for which it is used, are also identical to the goods or services, for which the registration has been granted, then the adjudicating authority shall presume that it is likely to cause confusion on the part of the public.

Thus, under Section 29(1), (2) and (3) for infringement to result-

- (a) The impugned mark has to be either similar to or identical with the registered mark;
- (b) The goods or services, for which the impugned mark is complained, has to also either be identical with or similar to the goods or services, for which the registration has already been granted.



The scenario is different as regards Section 29(4) of The TM Act, 1999. For infringement to result under Section 29(4), the following conditions are required to be fulfilled:-

- (i) The person using the impugned mark is neither a registered Prop. in relation to the goods and services, for which the mark is registered, nor is using it by way of permitted use;
- (ii) The impugned mark must be used in course of trade;
- (iii) The impugned mark has to be either similar to or identical with the registered mark;
- (iv) The impugned mark is used for goods and services different from those, for which the registration has been granted;
- (v) The registered trade mark has a reputation in India;
- (vi) The use of impugned mark is without due cause and takes unfair advantage of or is detrimental to-

- The distinctive character of the registered trade mark; or

- The reputation of the registered trade mark.



The question to be adjudicated by this Forum is whether the person using the impugned mark has obtained it *bona fide*ly or whether the permission given for the impugned trade mark/mark does not violate the conditions, as discussed hereinabove. For the purpose of analyzing this, the expression “mark” has to be understood. The mark has been defined under Section 2(m) of The TM Act to include a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of good, packaging or combination of colour and any combination thereof. Thus, for the purpose of Section 29(4), the use of mark which is a part of domain name would also attract infringement. What is important is that the registered trade mark must be shown to have been used by the infringer. It should be shown without such adoption or use as resulted into infringer taking unfair advantage of the registered trade mark or is detrimental to the distinctive character or reputation of the registered trade mark.

Section 2(zg) of The TM Act defines a well-known trade mark in relation to any goods or services to mean a mark, which has become so popular to the substantial segment of the public, which uses such goods or receives such services that the use of such mark in relation to either goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services



and a person using the mark in relation to the first mentioned goods and services.

In *Apple Computer Inc. Vs. Apple Leasing and Industries*, 1999 SCC Online Del. 308 it is held that where improper use of the name or trade mark is considered, then the confusion created between the two trade mark has to be considered. Further, coming to Section 29(5) of The TM Act, it is seen that it relates to a situation where the infringer uses his trade mark as his trade name or part of his trade name and the business concerned of the infringer is for the same goods or services, in respect of which the trade mark is registered. In view of this Tribunal, the provisions of Section 29(5) cannot be said to render Section 2(4) of The TM Act, 1999 as infructuous. Even when the infringer is the registered user of the same mark, then the question arises for the purpose of adjudication is whether the registration of the mark was obtained in good faith or whether it is being used in good faith or whether it is creating a confusion in the public or whether it is a creature of the infringer or not or whether it is copied by the infringer from the mark of the Complainant.

In the opinion of this Tribunal, the impugned domain name is a trademark backed domain name and it not only violates the provisions of the Trade Marks Act, 1999 but also violates Clause 4 of the INDRP policy issued by the NIXI. The impugned domain name conflicts with the legitimate rights and interests of the Complainant on the following premises:-



- a) The impugned domain name is identical and confusingly similar to a named trademark as well as a service mark, in which the Complainant has a right;
- b) Respondent has no right or legitimate interest in respect of the impugned domain name;
- c) The Respondent impugned domain name has been registered and is being used in bad faith by using the registered trademark of the Complainant and giving a pecuniary loss to the Complainant by using the name and trademark of the Complainant.

The evidences filed by the Complainant have been proved by the Complainant, therefore, the statements and documents filed by the Complainant are accepted as correct deposition. In view of the facts and settled law, with the deposition and documents of the Complainant placed before this Tribunal, the Complaint deserves to be allowed for an Award on merits in favour of the Complainant, as prayed in the Complaint by the Complainant.

DECISION

- a) In view thereof, it is directed that the domain name www.converse.co.in be transferred in favour of the Complainant by the Registry. As a result, the Respondent and Prahlad Kumar, their agents, servants, dealers, distributors and any other person(s) acting for and on its behalf are permanently restrained from using the domain name www.converse.co.in or any other deceptively similar



trademark, which may amount to infringement of Complainant registered trademark and also from doing any other thing, which is likely to create confusion and deception with the goods/services of the Respondent for any connection with the Complainant.

- b) The Complaint is allowed in the above terms.
- c) National Internet Exchange of India (NIXI) is advised to take incidental or ancillary action involved in the transfer of the domain name, as directed.
- d) A cost of Rs. 30,000/- is imposed upon Prahlad Kumar to be paid to Complainant.




(DR. PANKAJ GARG)
SOLE ARBITRATOR

Place: New Delhi

Date: 16th April, 2022