



महाराष्ट्र MAHARASHTRA

BF 409457

नंबर ... १२६०९ ... रुपये १०० x ११२१५५
दिनांक ... १४/३/०९
नाम ... शिरीष रजामगर
पत्ता ... ४२४ शनिवार पेठ, पुणे
हस्ते ... शिरीष रजामगर
सौ. जयश्री बेलसरे, स्टॅम्प व्हेंडर, ला.नं. - १०१/३६/१९९५
४२५ व, शनिवार पेठ, पुणे-३०

AWARD

KMB



IN ARBITRATION

Pantaloan Retail (India) Limited
Knowledge House, Shyam Nagar
Off Jogeshwari Vikhroli Link Road
Jogeshwari (East)
MUMBAI. 400060. INDIA

THE COMPLAINANT

AND

Online Consumer Alliance
5, Walker Street, Somerville
MA. USA. 02144.

THE RESPONDENT

IN THE MATTER OF DISPUTED DOMAIN NAME: - bare, in

CASE NO. - NOT ALLOTTED BY NATIONAL INTERNET EXCHANGE OF INDIA
(NIXI)

BEFORE MR.S.C.INAMDAR, B.COM. LL.B., F.C.S.

SOLE ARBITRATOR

DELIVERED ON THIS 5th DAY OF APRIL TWO THOUSAND NINE.

I] SUMMARISED INFORMATION ABOUT THE DISPUTE: -

01. Names and addresses

Of the Complainant: -

**M/S PANTALOON RETAIL (INDIA)
LIMITED.**

Knowledge House, Shyam Nagar,
Jogeshwari Vikhroli Link Road, Jogeshwari
(East), MUMBAI. INDIA. 400060.
(Through Mr.C.P.Toshmwal - C.F.O.)

02. Name and address of

The Respondent: -

ONLINE CONSUMER ALLIANCE

5, Walker Street, Somerville, MA
USA. 02144.

03. Calendar of Major events:

Sr. No.	Particulars	Date (Communications in electronic mode)
01	Arbitration case was referred to me	19/02/2009
02	Acceptance was given by me	19/02/2009
03	Notice of arbitration was issued	20/02/2009
05	Submission of reply by the Respondent	09/03/2009
06	Issue of notice to the Complainant to submit his rejoinder	09/03/2009
07	Submission of rejoinder by the Complainant	14/03/2009
08	Issue of notice to the Respondent to submit his rejoinder on the Complainant's say	14/03/2009
09	Respondent's submission of rejoinder	30/03/2009
11	Issue of award	05/04/2009

I] PRELIMINARY: -

- 1) M/s Pantaloon Retail (India) Limited having its office at Knowledge House, Shyam Nagar, Off Jogeshwari Vikhroli Link Road, Jogeshwari (East), Mumbai 400060 have filed compliant with National Internet Exchange of India (NIXI) disputing the registration of domain name **bare.in (The Complainant)**.
- 2) Since the Complainant is holder of various trademarks / service marks with the word Captain Morgan it has disputed registration of domain name **'bare.in' (the disputed / domain name)** in the name of **Online Consumer Alliance**, 5, Walker Street, Somerville, MA, USA 02144. **(The Respondent)**.
- 3) Major events took place as enumerated in the above table.

II] PROCEDURE FOLLOWED IN ARBITRAION PROCEEDINGS: -

01. In accordance with INDRP read with INDRP Rules of Procedure, copies of all communications between me and parties and vice-versa were marked to disputing parties and copy to NIXI.
02. Sufficient opportunities were given to both the Complainant and the Respondent to submit their say and rejoinders.
03. After opportunity was given to both the parties to the dispute to submit rejoinders evidence was closed.
04. Both the parties cooperated in arbitration proceedings by expeditiously submitting their say / rejoinders from time to time.

III] SUMMARY OF THE COMPLAINT:

- (A) The Complainant has raised, *inter-alia*, following important objections to registration of disputed domain name in the name of the Respondent and contended as follows in his Complaint: -

- a) The Complainant is a registered proprietors of the following trademarks on which the complaint is based: -

Sr. No.	Trade mark No.	Date of application	Trade mark	Class	Goods
01	744392	16-06-1997	BARE ACCESSORIES (LABEL)	18	LEATHER GOODS
02	744393	16-06-1997	BARE ACCESSORIES (LABEL)	25	APPARELS, CLOTHING
03	744394	16-06-1997	BARE	14	JEWELLERY
04	744995	16-06-1997	BARE	18	LEATHER GOODS
05	744396	16-06-1997	BARE	24	TEXTILE GOODS
06	744397	16-06-1997	BARE	25	APPARELS, CLOTHING
07	744398	16-06-1997	BARE	26	TEXTILE GOODS
08	744399	16-06-1997	BARE NECESSITIES	25	APPARELS, CLOTHING
09	744400	16-06-1997	BARE DENIM	24	TEXTILE GOODS
10	744401	16-06-1997	BARE DENIM	25	APPARELS, CLOTHING
11	744402	16-06-1997	BARE LEISURE (LABEL)	25	APPARELS, CLOTHING

12	744403	16-06-1997	WEAR BARE GET LUCKY (BARE LABEL)	25	APPARELS, CLOTHING
13	744406	16-06-1997	BARE SPORTS	25	APPARELS, CLOTHING
14	744407	16-06-1997	BARE WORK (LABEL)	24	APPARELS, CLOTHING
15	744408	16-06-1997	BARE WORK	25	APPARELS, CLOTHING
16	744404	16-06-1997	BARE STORE	24	APPARELS, CLOTHING
17	744405	16-06-1997	BARE STORE	25	APPARELS, CLOTHING

- b) The Complainant has launched about 31 products including shirts, trousers, T-shirts, etc. under the brand name BARE. One of its subsidiary Future Brands Limited is working on the development and promotion of the brand BARE.
- c) The Complainant has been carrying on a well-established business and operating multiple retail formats. It has established a renowned chain of retail outlets under the name and style of Big Bazaar, Pantaloon, Food Bazaar, Central, aLL etc and has been running more than 1000 stores in India. . It also has portal www.futurebazaar.com.
- d) The Complainant has been awarded many prestigious awards like Most Admired Retail Company of the year, Retail Face of the Year, Coco-Cola Golden Spoon Awards and many more.

e) In 1992 the Complainant launched the brand BARE in denim and apparel category and also got registration for above trademarks.

f) The domain name in question is identical and confusingly similar to a trademark BARE.

g) The said brand BARE has been used openly, continuously and exclusively since its inception and has acquired formidable reputation and goodwill in relation to the said goods. The said brand name has been exclusively associated and identified with the Complainant.

h) Due to original, honest adoption, continuous and extensive use in respect of the said brand and trade mark the Complainant has acquired actionable intellectual property rights in their trade mark and entitled to protect trademark from being infringed, tarnished, diluted, misused and or falsified by others.

i) Apparently the Respondent has registered the domain name in bad faith. Though he has booked the disputed domain name in February 2005, it has not been activated till now. Thus the Respondent has primarily registered or acquired the domain name for the purpose of selling, renting, or otherwise transferring the domain name registration.

j) The Complainant has finally requested for transfer of the Registrant's domain name in its favour.

IV] REPLY TO THE COMPLAINT / STATEMENT OF DEFENSE: -

In response to the contentions of the Complainant, the Respondent has submitted the main contentions of the Respondent are as follows: -



- a. The term bare is a generic term used worldwide.
- b. The trademarks issued to the Complainant are graphical in nature.
- c. Many firms in the world use the word bare consistently, extensively and distinctively - for instance baresports.com
- d. The Complainant has failed to remove the generic term from public domain. The generic term bare has not become associated with the Complainant.
- e. No obvious mention of the word alleged trademark bare is found on the website of the Complainant.
- f. The list of companies that utilize the word bare as a component of their trademark is extensive. (The Respondent has provided few of such names in his response.)
- g. The Complainant's sunrise registration request was either rejected or not submitted.
- h. The domain name bare.in was legitimately registered after sunrise period i.e. after 17 February 2005:
- i. The Complainant has not registered domain names for their alleged trademarks.
- j. The Complainant operates parking site SEDO for the domain names it has registered.
- k. The word bare being generic in nature, we registered the domain name with the plans to provide Users help to keep to do lists of items to do back home. The key attraction was its use in the phrase "bare in mind."
- l. While we have not launched the website we have done substantial design and functional outlining for the site.
- m. According to IN Dispute Policy there should be circumstances indicating that the Registrant has registered domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name to the Complainant or to his competitor for

- consideration in excess of out of pocket expenses directly related to the registration of domain name. We have made no such attempt,
- n. We have not registered mark (should have been domain name) to prevent the Complainant from reflecting the mark in their domain name.
 - o. We have not launched the website yet, so there can be no attempt of attracting the internet users to the website of the Registrant by creating likelihood of confusion.

VI] COMPLAINANT'S REJOINDER: - The Complainant has raised, inter-alia, the following issues in support of his complaint: -

1. Apart from retail business, the Complainant has also been making revolution in the consumer e-commerce business by providing customers with a streamlined, efficient, and world class personalized e-shopping experience with the support of the best technology platform.
2. The Complainant acquired registration of the marks "BARE" which have been in open, continuous, extensive and exclusive use and have acquired a secondary meaning to connote and denote to the relevant section of public, the merchandise of the Complainant.
3. Annual sales in INR in Lakhs of the Complainant have risen from 6210.32 in 2006-07 to 7025.16 in 2007-08 and further to 4805.01 till December 2008.
4. The Complainant has made tremendous efforts and has spent considerable amounts of money for the publicity and promotion of the merchandise bearing the mark BARE.
5. The Complainant has been awarded "International Retailer of the Year 2007" award by the US based National Retail Federation and "Te Emerging Market Retailer of the Year 2007" award at the World Retail Congress held in Barcelona.
6. The Respondent has registered the impugned domain name in bad faith and with a malafide intention to trade upon the reputation and goodwill acquired by the Complainant. The registration of the disputed domain name in the Respondent's name

is bound to divert internet traffic and cause confusion and / or deception in the minds of unwary consumers and / or internet users.

7. The Courts have taken cognizance of the fact that a domain name in addition to being an address for computers on the internet, is a business identifier potentially accessible from any geographical location and therefore the same requires world wide exclusivity.
8. The term bare is not a generic of commonly used term. It is exclusively identified with the Complainant's business, products and / or services.
9. It is denied that the Complainant has not registered the domain name for his registered trademark. The Complainant is the registered owner of the domain names www.baredenim.in and www.barestore.in
10. The Respondent's absence of business activities in India and not using the disputed domain name for more than three years explains the illegitimate interest in registering the impugned domain name.
11. The Respondent thus has registered domain name with an intention to sell, rent, or otherwise transfer the domain name.
12. By registering the domain name the Respondent is intentionally attempting to attract internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's name/mark/brand/domain names.
13. In view of the Complainant's continuous, extensive use of the trade mark /brand BARE, its exclusive association with the goods of the Complainant, the Complainant has acquired reputation and goodwill subsisting in the said mark / brand. Also in view of large scale investments made by the Complainant for the promotion of the said mark/brand the balance of convenience lies in favour of the Complainant.
14. The Complainant therefore prays that the impugned domain name registration be transferred to the Complainant.

VII] RESPONDENT'S REJOINDER: -The Respondent, in his rejoinder has, among others, raised following important points in support of his defense: -



1. The Complainant has lied in saying that domain names baredenim.in and barestore.in have been registered and in use since 16th February 2005. As per exhibits attached they were registered on 27.12.2009 and 23.12.2008 respectively.
2. The Complainant promotes the terms like baredenim or barebasics but not the generic term bare. Though the complainant uses the bare extensively, it is always with a modifier like bare denim, bare store etc. Thus they require a modifier to associate the term bare with their products or goods. At few places it is visual element of brand and not the brand itself. This does not demonstrate that the generic term bare has been removed from the public domain.
3. Te Complainant has failed to provide any response to the data that demonstrates there are no mentions of the Complainant's services in the first 50 search results for bare.
4. It is spurious statement of the Complainant that their recognition as retailer somehow entitles them to the generic term bare.
5. The Respondent has furnished information and screenshots of his other websites like letterbar.com, howtocraiglist.com etc. He has also furnished some spreadsheets in support of his contention of having done considerable spadework for launching website. Based on this the Respondent claims that he has legitimate interests in the domain name.
6. The domain name is currently not in use and hence it can not be inferred that the domain has been registered in bad faith. The onus lies on the omplainant to prove the same.
7. The Respondent has certainly not listed domain for sale nor made any indication that it is up for sale. The Complainant has not proved the same.
8. The Registrant certainly not registered the domain in bad faith. The Complainant has simply made assertion without any evidence to that effect. This has been consistently demonstrated that mere registration of domain is insufficient to demonstrate bad faith. The Respondent has cited decisions / observations in UDRP cases - Home Interiors & Gifts Inc. V/s Home Interiors D 2000-0010 and Telstra Corporation Limited v/s zurls D 2001-0046 in support of his contention.



9. Since the website is not in use, it cannot demonstrate bad faith. According to WIPO case law, bad faith of unused website required "the impossibility of conceiving a good faith use of the domain name.'
10. There are several number of users in existence who use the generic term bare for products beyond the intended use by Respondent.

ISSUES & FINDINGS: -

On the basis of policies and rules framed by NIXI in respect of dispute resolution as also on the basis of submissions of both the parties I have framed following issues. My finding on each issue is also mentioned against it respectively.

SR. NO.	ISSUE	FINDING
01	Whether the Complainant could establish his nexus with the registered -trade marks and as such whether he is entitled to protect their rights / interests in the same?	Yes
02	Whether the Registrant registered domain name primarily for selling, renting or otherwise transferring it?	Yes
03	Whether the Registrant's domain name is identical or confusingly similar to a name or trademark in the Complainant has rights?	Yes
04	Whether the Respondent is holder of any registered trademark or service mark and accordingly has any right or legitimate interest in respect of disputed domain name?	No
05	Whether the Registrant / Respondent has registered domain name in bad faith?	Yes
06	Whether the Registrant is using the domain name before notice to him / has demonstrated considerable preparation to use in good faith?	No



07	Whether the Registrant has commonly been known by the domain name?	No
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VII] BASIS OF FINDINGS: -

ISSUE NO.1:

Whether the Complainant could establish his nexus with the registered trade marks and as such whether he is entitled to protect their rights / interests in the same?

FINDING: -

Yes. The Complainant has provided a list of several trademarks/brands registered in his name. Moreover he has established that his products have been sold in the market with the trade names for many years. The Complainant has also registered domain name www.bare.co.in. Thus he is entitled to protect his rights or interests in the same.

ISSUE NO.2

Whether the Registrant registered domain name primarily for selling, renting or otherwise transferring it?

FINDING

Yes. The Registrant has not been successful in establishing his nexus with the word bare in any way. His claim of having devised concept of launching a portal with the catchy words 'bare in mind' appears to be remote and conceptual. The Registrant has no registered trade mark / brand in his name with the words bare. Under the circumstances, inference can be drawn that the Registrant has registered domain name primarily for selling, renting or otherwise transferring it.



ISSUE NO.3

Whether the Registrant's domain name is identical or confusingly similar to a name or trademark in the Complainant has rights?

FINDING

Yes. The Registrant has registered trade marks inter-alia under serial numbers 744394,744396,744397 & 744398 with the words BARE. The Complainant has also registered several trade marks having the word bare in combination with other words like bare sports, bare denim etc. All these trade marks are valid on the date of filing of the Complaint. As such the disputed domain name registered by the Registrant is identical to the registered trademarks of the Complainant.

ISSUE NO.4

Whether the Respondent is holder of any registered trademark or service mark and accordingly has any right or legitimate interest in respect of disputed domain name?

FINDING

No. The Registrant has neither cited nor proved any trademark in his favour bearing the word bare. Therefore he has no right or legitimate interest in respect of disputed domain name.

ISSUE NO.5

Whether the Registrant / Respondent has registered domain name in bad faith?



FINDING

Yes. The Registrant has no trademark registered in his name. His name is not identical or similar to the disputed domain name. According to his own contention he registered the domain name with an object of developing a website for the purpose of helping users keep to do lists of items to do back home. Similarly cumulative effect of findings at Sr. No.1 to 4 above, suggest that the Registrant has failed to establish his bona fides in registering the disputed domain name in his name.

ISSUE NO.6

Whether the Registrant is using the domain name before notice to him / has demonstrated considerable preparation to use in good faith?

FINDING

No. The Registrant has admitted in his say that though substantial design and functional outlining of the website has been done, he has not yet launched it. He has furnished screenshots of some spreadsheets in support of his contention of having done demonstrable efforts to launch the website. However they are short of convincing about his seriousness in proposed launching the website. In any case it is an admitted position that the Registrant has not launched website.

ISSUE NO.7

Whether the Registrant has commonly been known by the domain name?

FINDING

No. The Registrant has neither claimed nor proved that he has commonly been known by the domain name.



BASIS OF AWARD: -

The award is based on the evidence led by the parties, issues arising from them and findings out of it. My observations and comments on the same are as follows: -

1. The Respondent has not established any nexus between disputed domain name and his own name, brand, trade mark or business name with the word bare.
2. The contention of the Respondent that there are several other users on internet who have registered domain names with the word 'bare' as part of their domain name, does not per se entitles the Respondent to the disputed domain name. The Complainant may take appropriate action against other registrants having domain names with the word bare at his own choice.
3. Several trade marks of the Complainant have modifier as claimed by the Respondent. However Trademarks bearing No. 744395, 744396, 744397 & 744398 do not contain any such modifier. The Respondent has failed to consider or purposefully neglected these marks.
4. The claim of the Respondent having done demonstrable work for launching website is short of convincing about seriousness in length and expenditure both.
5. Since at present website has not yet been launched there is no possibility of attracting the internet users by creating confusion in their minds. However once the website is launched there is every possibility of creating such confusion in the minds of internet users about it being website of owner of the trademarks i.e. the Complainant in the present case.
6. The Registrant has no trade mark or there is no similarity in his name with the domain name. Still he has chosen to register the domain name with the words bare. His contention about its nexus with the catchy words proposed to be used 'bare in mind' appear to be remote and far from convincing.
7. On the other hand the Complainant has produced list of various trade marks / brand names / trade names with the words bare. It has been in the business since last many years and has established its branded goods or products. It has also been awarded various awards by various organizations as leading retailer. Its turnover

figures are considerable. It has established its nexus with the domain name and eligibility to protect rights and interests.

8. The objection raised by the Respondent about modifiers used by the Complainant can be set aside due to four trade marks without such modifiers. ,
9. The Respondent has admitted that the website has not been yet launched. His claims about demonstrable preparations are not convincing and appear to be only in preliminary stage.

IX] AWARD: -

On the basis of findings and foregoing discussion I pass the following award: -

01. The Complainant is entitled to the disputed domain name - '**bare.in**'. The Respondent shall transfer the same to the Complainant.
02. The Complainant shall pay to the Registrant / Respondent, documented expenses for registration of disputed domain name against evidence having incurred such expenses by the Respondent.
03. The parties will bear their respective costs of arbitration.

Dated: - 05.04.2009


(S.C. INAMDAR)
ARBITRATOR