

भारतीय गैर न्यायिक

एक सौ रुपये

Rs. 100

रु. 100



सत्यमेव जयते

ONE  
HUNDRED RUPEES

भारत INDIA  
INDIA NON JUDICIAL

தமிழ்நாடு தமில்நாடு TAMILNADU

AX 076042

11792  
18 FEB 2015

**D. SARAVANAN**  
Advocate & Arbitrator  
"Orient Chambers", 4th & 5th Floor,  
No. 90 / 73, Armenian Street;  
Chennai - 600 001.

**S. SHANMUGA SUNDARAM**  
STAMP VENDOR  
L. No: B4 / 109 / 88  
HIGH COURT CAMPUS,  
CHENNAI-600104. (TAMILNADU)

BEFORE THE SOLE ARBITRATOR MR.D.SARAVANAN  
.IN REGISTRY  
(C/o. NATIONAL INTERNET EXCHANGE OF INDIA)

Disputed Domain Name: [www.bestbuyindia.co.in](http://www.bestbuyindia.co.in)

BBY Solutions, Inc.  
7601, Penn Avenue South,  
Richfield,  
Minnesota 55423,  
USA

.. Complainant

Vs.

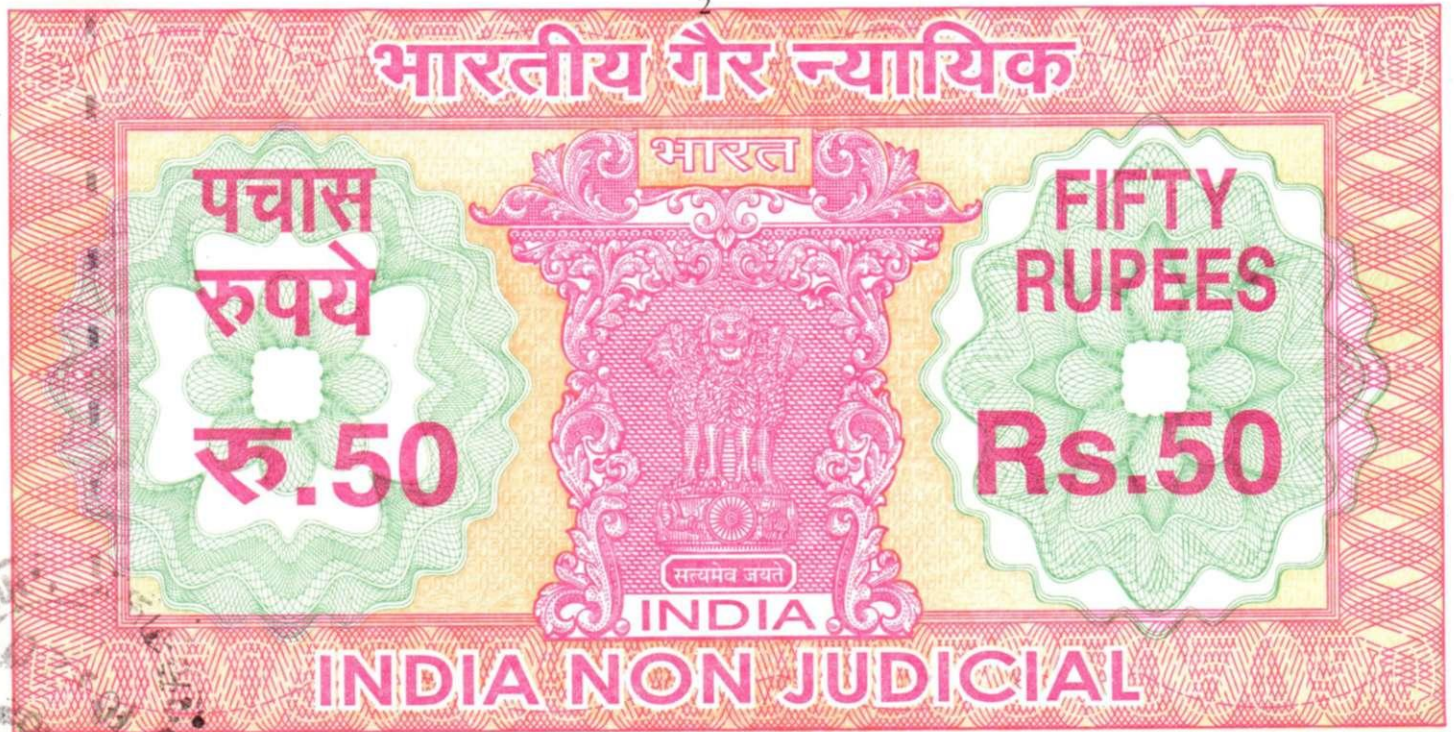
Ravi Batta,  
501 Krishna Regency,  
Mumbai- 400705,  
Maharashtra.

.. Respondent

..2.







தமிழ்நாடு தமில்நாடு TAMILNADU

AK 105421

1322  
19 FEB 2015

**D. SARAVANAN**  
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**P.S. SHANMUGA SUNDARAM**  
STAMP VENDOR  
L. No: B4 / 109 / 88  
HIGH COURT CAMPUS,  
CHENNAI-600104. (TAMILNADU)

-2-

1. The Parties:

The complainant is BBY Solutions, Inc. having its office at 7601, Penn Avenue South, Richfield, Minnesota 55423, USA.

The respondent is Ravi Batta having his address at 501 Krishna Regency, Mumbai 400705, Maharashtra.

2. The Domain Name and Registrar:

The disputed domain name: [www.bestbuyindia.co.in](http://www.bestbuyindia.co.in)

The domain name is registered with GoDaddy.com

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### 3. Procedural History:

February 02, 2015	:	Date of Complaint.
February 04, 2015	:	The .IN REGISTRY appointed D.SARAVANAN as Sole Arbitrator from its panel as per paragraph 5(b) of INDRP Rules of Procedure.
February 05, 2015	:	Consent and Declaration of the Arbitrator was given to the .IN REGISTRY according to the INDRP Rules of Procedure.
February 07, 2015	:	.IN Registry has notified the appointment of arbitrator to both the parties.
February 12, 2015	:	Notice was sent to the Respondent by e-mail directing him to file his response within 10 days, marking a copy of the same to the Complainant's representative and .IN Registry.
February 20, 2015	:	Response of the Respondent received through email.
February 20, 2015	:	Notice was sent to the Complainant by e-mail directing him to file his rejoinder within 10 days, marking a copy of the same to the Complainant's representative and .IN Registry.
February 26, 2015	:	Rejoinder of the Complainant received through email.
February 27, 2015	:	Reply of the respondent to the rejoinder dated 26.02.2015 of the complainant received through email.
February 27, 2015	:	Reply of the complainant to the reply dated 27.02.2015 of the respondent received through email.





#### 4. Factual Background:

##### 4.1 The Complainant:

The complainant is BBY Solutions, Inc. having its office at 7601, Penn Avenue South, Richfield, Minnesota 55423, USA

##### 4.2 Complainant's Activities:

(i) The complainant was founded by Mr. Richard Schulze in 1996 and was called Sound of Music before the name changed to Best Buy in 1983.

(ii) The complainant is the world's largest consumer electronics retailer, offering advice, service and convenience, at competitive prices to the consumers who visits its websites. The complainant currently employs more than 1,40,000 people and earns annual revenue of more than \$40 billion.

(iii) The complainant operates under the **BEST BUY, BEST BUY MOBILE, GEEK SQUAD, MAGNOLIA, PACIFIC SALES** brands in the US; the **BEST BUY, GEEK SQUAD, CELL SHOP, CONNECT PRO, FUTURE SHOP** brands in Canada; **BEST BUY, FIVE STAR** in China; **BEST BUY, BUY EXPRESS, GEEK SQUAD** in Mexico. The complainant sells cellular phones from Verizon wireless, AT&T mobility, sprint PCS, Boost Mobile and T-Mobile in regular stores and standalone Best Buy Mobile stores in shopping malls. The complainant in **Annexure - F** has filed a copy of advertisement of the Complainant distributed throughout the U.S. in newspapers every Sunday. The Complainant has in **Annexure G** filed copies of advertisement of its mark on various websites of the complainant.

##### 4.3 Complainant's Trading Name:

(i) The Complainant owns, uses and is registered proprietor of the trademark BEST BUY in several jurisdictions of the world in various classes.

(ii) The complainant is the registered proprietor of the trade mark BEST BUY in India under number 1266519 dated February 12, 2004 in class 35. The said mark has been renewed from time to time and is valid and subsisting. The registration certificate is furnished in **Annexure E**.



(iii) The complainant's domain name www.bestbuy.com was created on 02.03.1994 and is equally popular among the viewers all over the world including India.

(iv) The websites www.bestbuy.com, www.bestbuymobile.com, www.bestbuy.ca, www.bestbuy.com.mx, etc give easy access to consumers regarding the complainant's mark.

(v) The list of trademarks registered by the complainant is furnished in **Annexure D** and an exhaustive list of all the domain names owned by complainant worldwide is in **Annexure H**.

#### **4.3.1 Respondent's Identity and activities:**

The Respondent is **Ravi Batta** having his address at 501, Krishna Regency, Mumbai-400705, Maharashtra.

#### **5. Dispute:**

The dispute arose when the Complainants upon a search in WHOIS Database became aware of the domain name www.bestbuyindia.co.in registered by the respondent. The complainant sent a cease and desist letter dated 05.12.2014 calling upon the respondent to immediately stop usage of the domain name. The said letter is furnished by the complainant in **Annexure K**.

#### **6. Parties contentions:**

##### **A. Complainant:**

##### **(1) Identical and/or confusingly similar:**

(i) The complainant states that it is the proprietor of the well known trade mark BEST BUY worldwide. It has been in continuous, extensive and uninterrupted use since 1983 world over. The respondent in its domain name www.bestbuyindia.co.in has completely copied the complainant's mark in its entirety while adding only the word India thereby giving an impression to the members of the trade and customers



that the respondent may be an Indian affiliate of the complainant wherein no such affiliation exists.

(ii) The complainant refers to **Rediff.com India Limited versus Mr. Abhishek Varma & Anr. Case No. INDRP/1** wherein it was held that by registering the domain name www.rediff.in, the registrant has intentionally attempted to attract internet users to the Registrant's proposed website by creating a likelihood of confusion with the complainant's name or mark.

(iii) The complainant also refers to **Kingston Technology Co. versus Web Master, Skype Network Limited, Case No. INDRP/033** wherein it was held that the respondent's domain name www.kingston.co.in consists entirely of their trademark, except for .co and .in i.e. ccTLD, thereby the cyber piracy is in apparent form; the respondent's registration and use of domain name is a clear case of cyber squatting whose intention is to take advantage of the complainant's substantial reputation and its prominent presence on the internet in order to confuse the public to the detriment of the complainant.

(iv) The complainant also refers to **Hindustan Petroleum Corporation Limited versus M. Ram Swamy, Case No. INDRP/059, Kentucky Fried Chicken Corporation versus Webmaster Casinos Ltd, Case No. INDRP/066, Ingersol-Rand Co. Frankly Gully d/b/a Advcomren, WIPO Case No. D2000-0021, Boehringer Ingelheim Pharma GmbH & Co. KG versus Philana Dhimkana WIPO Case No. D2006-1594.**

(2) **Respondent has no rights or legitimate interests in the domain name:**

(i) The complainant states that the respondent bears no relationship to the business of the complainant and is neither a licensee nor has obtained authorization of any kind whatsoever to use the complainant's marks.

(ii) The complainant states that its domain name www.bestbuy.com was created on 02.03.1994 and the use of the mark BEST BUY had commenced as early as 1983. However, the respondent's domain name www.bestbuyindia.co.in was created on 18.02.2012 which is almost three decades after the complainant had commenced the





use of the mark, corporate name BEST BUY and two decades after the complainant registered its domain name www.bestbuy.com . The complainant being the prior user of the registered and well known trade mark BEST BUY is the lawful owner of the trade mark/ corporate name BEST BUY and the respondent does not have any legitimate interest in the impugned domain name which copies in entirety the trade mark/ domain name of the complainant.

(iii) The complainant also states that the respondent by deliberately misleading the internet users and by diverting the complainant's consumers to its websites is trying to derive profits from the well known trademark, corporate name and domain name of the consumers.

(iv) The complainant relies on **Societe Des Prodi Its Nestle SA, Switzerland versus Nescafe Limited, Case No.INDRP/100** wherein it was held by the Tribunal that if the respondent has registered the domain name with full knowledge of the complainant's marks and uses it for the purpose of diverting the traffic, such facts and circumstances create a rebuttable presumption that the respondent has no rights in the domain name and is not using it for legitimate purpose.

(v) The complainant also relies on **Croatia Airlines d.d versus Modern Empire Internet Ltd WIPO Case No.D2003-0455** wherein it was held that "use of domain name that is identical or confusingly similar to a trademark is not a bonafide use".

(vi) The complainant also places it reliance on **eBay Inc. versus Akram Mehmood WIPO Case No.DAE2007-0001, Drexel University versus David Brouda Case No.D2001-0067; Kangaroo Kids Education Ltd. versus Anupam Devi, Case No. INDRP/146; Factory Mutual Insurance Company versus Rhianna Leatherwood WIPO Case No.D2009; Owens Corning versus NA, WIPO Case No.D2007-1143; etc.**

(3) **Registration or use of domain name in bad faith:**

(i) The complainant states that the respondent by diverting the consumers to its website, the respondent is trading upon the immense goodwill and reputation enjoyed by the complainant for its BEST BUY mark.



(ii) The complainant also states that the website of the respondent provides similar services as that of the complainant which manifests the respondent's clear intention to attract consumers for commercial gain by creating a likelihood of confusion with that of the complainant's mark as to the source, sponsorship, affiliation or endorsement of respondent's services. The use and registration of a similar domain name by the respondent in an effort to gain commercial benefits is evidence of bad faith. The complainant also states that the respondent intends to create initial user confusion and divert users to its domain and to trade off the goodwill associated with the complainant's mark.

(iii) The complainant refers to **Television Food Network, G.P. versus Arif Siddiqui Case No. INDRP/138** wherein the Tribunal held that "there is a likelihood that Internet users will be confused as to source, sponsorship, affiliation or endorsement of the respondent's website and the services advertised on it considering the complainant's prior use and adoption of an identical mark/ domain name. The aforesaid circumstances suggest bad faith registration and use of the domain." The complainant also refers to **Microsoft Corporation versus Chun Man Kam, Case No. INDRP/119; Compagnie Gervais Danone versus Yunengdonglishangmao (Beijing) Youxiangongsi Case No. D2007- 1918; Exxon Mobil Corp versus Prop. Mgmt. Prof'l, FA 1059655.**

#### **B. Response by the respondent:**

The respondent vide its email communications has stated that he had purchased the domain name [www.bestbuyindia.co.in](http://www.bestbuyindia.co.in) from Godaddy.com more than two years ago as a part of designing a basic website and to understand how an ecommerce system works in India. The respondent states that he was not aware of the existence of a company named bestbuy based in USA. The respondent states that he had searched "best, buy, in, India" on Google to know the best price of any product sold in India and eventually he coined the term bestbuyindia to be a good domain name for a website to start an ecommerce activity. The respondent states that he had applied for





the domain name www.bestbuyindia.co.in from www.godaddy.com and have been fairly awarded the domain after paying the necessary registration fee and thereafter an annual renewal fee for a couple of years. The respondent states that he never sold anything through that site as it was never his core work but he was only curious to know how an online business is set up and how it works. The respondent also states that in the landing page he has clearly stated that it is only for demonstration purpose and no orders will be placed. The respondent states that no money earned from the website and that there is no payment gateway involved. The respondent states that he is a man with good intentions and that he was not aware that bestbuy was trademarked in India. The respondent states that for his genuine effort and non maligned intention he is worthy to recover the expenses incurred by him i.e. Rs.3,500. The respondent also states that he is ready to transfer the domain name to the complainant subject to his costs are fully recovered. Having stated, the respondent has sent an email on 27.02.2015 agreeing to part with the domain name and transfer it to the complainant, if the complainant do not want to pay the sum.

#### **C. Rejoinder by the Complainant:**

The complainant denies each and every allegations of the respondent. The complainant states that it is incorrect for the respondent to say that the trademark bestbuy is not registered in India whereas it is registered under registration no.1266519 dated February 12, 2004 in class 35. The complainant states that it is ready to consider the proposal of the respondent for amicable settlement. However, the complainant is not agreeable to pay any monetary cost. The complainant states that if the respondent is agreeable to transfer the domain name without any cost, the complainant is ready to give up its claim for damages. The complainant states that the respondent is agreeing to transfer the domain name acknowledging the complainant to be the proprietor of the trademark bestbuy and also accepting that the respondent was not aware of the rights of the complainant in the mark at the time of registering the mark.



## 7. Discussion and Findings:

It has to be asserted as to whether the Constitution of Arbitral Tribunal was proper? And Whether the Respondent has received the notice of this Arbitral Tribunal?

Having gone through the procedural history, this Tribunal comes to the irresistible conclusion that the Arbitral Tribunal was properly constituted and Respondent has been notified of the complaint of the Complainant and that the Respondent submitted his responses.

Under paragraph 4 of the IN Domain Name Dispute Resolution Policy (INDRP), the Complainant must prove each of the following three elements of its case:

- (i) The Respondent's domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) The Respondent has no rights or legitimate interest in respect of the domain name; and
- (iii) The Respondent's domain name has been registered or is being used in bad faith.

### (a) Identical or confusing similarity:

Having gone through the list of complainant's trade mark registrations for the mark best buy worldwide in **Annexure D**, the list of domain names owned by the complainant in **Annexure H**, the complainant has proved beyond dispute that it is the proprietor of the mark Best Buy. The disputed domain name is www.bestbuyindia.co.in. The tribunal finds the only difference between the complainant's mark and the disputed domain name is the addition of the word "India". It has been held in number of cases that addition of common geographic terms to the trade marks resulting in domain names are confusingly similar to the





trademarks and will not remove the distinctiveness of the trade mark. The respondent in his responses has neither disputed nor provided any defence for the allegation that the mark of the complainant in the domain name are identical. Hence this Arbitral tribunal comes to the conclusion that the trade mark of the complainant and the disputed domain name are identical.

The Arbitral Tribunal concludes that the Complainant has established paragraph 4(i) of the .IN Domain Name Dispute Resolution Policy.

**(b) Respondent's Rights or Legitimate Interests:**

The Complainant contends that the Respondent has no rights and legitimate interest in the disputed domain name. The Complainant contends that it has neither licensed the respondent nor has authorized the respondent to use the mark. The respondent has not also proved otherwise. The complainant through **Annexure E** establishes that the mark Best Buy was registered in India in 2004. The respondent admits to have registered the domain name 2-3 years ago from domain name registrar [www.godaddy.com](http://www.godaddy.com) without knowing the fact that the Bestbuy was trade marked in India. It is not the case of the respondent that he is the licensee of the complainant. The complainant has proved that it is the proprietor of the trademark. Hence, this tribunal holds that the respondent does not have any rights in the domain name.

The Arbitral Tribunal concludes that the Complainant has established paragraph 4(ii) of the .IN Domain Name Dispute Resolution Policy.

**(c) Registration and Use in Bad faith:**

i) The Complainant alleges that the respondent has registered the domain name to direct the consumers to its website and to trade upon the immense goodwill and reputation of the complainant. The respondent in his response denies the allegation of the complainant. The respondent contends that he had purchased the domain from Godaddy.com. The respondent contends that he was not aware of the trademark of the complainant. The respondent also contends that he had registered the domain name solely to understand how an ecommerce system works in India



and that he has never sold anything through domain name and has not earned any revenue. The respondent also contends that the domain name is only for demonstration purpose and had also agreed to transfer the domain name to the Complainant. Such contention may appear that there is no bad faith. However, on considering the case deeply, in spite of Complainant's cease and desist letter dated 05.12.2014 under **Annexure K**, the respondent has not only contested the challenge at one stage but also stipulated a condition of payment of costs for transferring the domain name. Thus, the offer of transfer of domain name was not made voluntarily. Paragraph 6 of the .IN Domain Name Dispute Resolution Policy enumerates the presence of circumstances in particular under paragraphs 6(i), 6(ii) & 6(iii) to be found out by the Arbitrator to arrive at a conclusion that the registration and use of domain name in bad faith. However, Paragraph 6 enlarges the scope of circumstances by prescribing no limitation to such circumstances. In the light of the above, the vexatious challenge and stipulating a condition for transferring the domain name would constitute bad faith.

The Arbitral Tribunal concludes that the Complainant has established paragraph 4(iii) of the .IN Domain Name Dispute Resolution Policy.

ii) The Tribunal also finds that the respondent has categorically agreed to transfer the domain name to the complainant. Hence, the tribunal is of the view that the domain name should be transferred to the complainant.

#### 8. Decision:

For all the foregoing reasons, in accordance with paragraph 10 of the Policy, the Arbitral Tribunal orders that the disputed domain name <www.bestbuyindia.co.in> be transferred to the Complainant.

Dated at Chennai (India) on this 13<sup>th</sup> day of March, 2015.

  
(D.SARAVANAN)  
Sole Arbitrator