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*C.A. Brijesh*

*Ramji Sayer*



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Page 1 of 11

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Regn. No.-35.

Co. Courts. Gurgaon.

**BEFORE THE SOLE ARBITRATOR C.A. BRIJESH  
.IN REGISTRY  
C/o NIXI (NATIONAL INTERNET EXCHANGE OF INDIA)  
NEW DELHI, INDIA**

**BREITLING SA**

PO Box 1132  
Schlachthausstrasse 2  
Grenchen, CH-2540  
Switzerland

.... Complainant

**versus**

**GaoGou**

YERECT INTERNATIONAL LIMITED  
Suite 1100 South Tower,  
175, Bloor Street, East  
Toronto, Canada, M4W 3R8

.... Respondent

**1. The Parties**

The Complainant is BREITLING SA, PO Box 1132, Schlachthausstrasse 2, Grenchen, CH-2540, Switzerland through its Authorised Representatives, Ambalika Banerjee of Anand & Anand, First Channel, Plot No.17A, Sector 16A, Film City, Noida.

The Respondent is GaoGou of YERECT INTERNATIONAL LIMITED, Suite 1100 South Tower, 175, Bloor Street, East, Toronto, Canada, M4W 3R8. The Respondent is represented by himself.

**2. The Domain Name and Registrar**

The disputed domain name is <breitling.co.in>. The said domain name is registered with 'Webiq Domains Solutions Pvt. Ltd.'.

*[Signature]*

### 3. Procedural Timeline

- March 25, 2015 :** The .IN Registry appointed C.A. Brijesh as Sole Arbitrator from its panel as per paragraph 5 (b) of INDRP Rules of Procedure.
- March 26, 2015 :** Arbitrator has accorded his consent for nomination as Arbitrator and submitted Statement of Acceptance and Declaration of Impartiality and Independence to the .IN Registry.
- March 30, 2015 :** Parties to the dispute are informed of the constitution of the Arbitration panel and the effective date of handover.
- April 1, 2015 :** Arbitral proceedings were commenced by sending notice to the Respondent through e-mail, with a copy marked to the NIXI, directing the Complainant's Authorized Representative to forward a soft copy of the Complaint alongwith the Annexures to the Respondent by April 06, 2015.
- April 06, 2015 :** Complainant forwards a copy of the Complaint alongwith all the annexures to the Respondent with a copy of the mail marked to Arbitral tribunal.
- April 07, 2015:** Arbitral Tribunal addresses a notice to the Respondent, with a copy marked to the Complainant's Authorized Representative, directing the Respondent to file its response, if any, to the Complaint within ten days.
- April 21, 2015:** No response was received from Respondent. Accordingly, the pleadings in the arbitration proceedings were closed. The language of the proceedings shall be English.

### 4. Factual Background:

#### 4.1 Complainant's Activities

The Complainant states, *inter alia*, that it is a privately owned company based in Switzerland in Grenchen, Canton of Solothurn, Switzerland which manufactures specialized chronographs and watches, as well as related accessories under the trade mark BREITLING. The Complainant claims that it was founded in Saint-Imier, Bernese Jura by Leon Breitling in 1884. The Complainant states the watches are made by it in Switzerland using Swiss components. Chronographs are watches with both timekeeping and stop watch functions. The trade name and the trade mark BREITLING is used worldwide by it in respect of *manufacture and sale of watches and clocks precious metals and their alloys and*





*goods in precious metals or coated therewith (except cutlery, forks and spoons), jewellery, precious, stones, all horological products and their parts and other chronometric instruments, clothing and footwear, headgear, games and playthings, gymnastic and sporting articles not included in other classes, decorations for Christmas trees.*

The Complainant states that its goods under the trade name and the trade mark BREITLING are extensively sold and marketed directly by the Complainant themselves or through its related/group companies or dealerships or authorized importers worldwide and has sales units in various countries of the world including India. It further claims that it has expended a great amount of time, money and effort in the promotion and advertisement of the trademark BREITLING and the products there under. Besides, the Complainant claims to be known as BREITLING SA due to which the Complainant has established an impeccable reputation and goodwill for the trade mark BREITLING worldwide including India. It states that the trade mark BREITLING has been widely publicised through magazines, journals and newspapers, exposure *via* the Internet, word of mouth publicity and articles appearing in various trade publications, newspapers, etc. due to which the same has come to be associated with the Complainant and none else.

It claims that it has always been associated with ingenuity and excellence in its design and engineering and that the Complainant (including its predecessors) has had a long history in manufacturing and designing horological products and always been renowned for the quality in production of each of its items. Further, as per the Complainant, BREITLING branded horological goods have been very popular among celebrities. Few of the ambassadors of the brand indicated by the Complainant are Ariel Sharon (Former Israeli PM), Andy Schleck (Cyclist, B-1), Brad Pitt (Actor), Bruce Willis (Actor), David Beckham (Football/Soccer Star), Ehud Olmert (Israeli Prime Minister), Leonardo DiCaprio (Actor). List comprising the said and additional names has been annexed as **Annexure – D**.

The products under the trademark BREITLING of the Complainant have won several awards around the world since its inception. As per the news article annexed as **Annexure - E**, Complainant received the 'Watch of the Year' award at the 4th edition of Watch World Awards held at Westin Hotel, Gurgaon in 2013.

The Complainant claims to have an online presence in about 142 countries. It further states that the Complainant is the owner of the top level domain names 'breitling.com', breitling.org, breitling.info amongst others as well as several other country code top level domain names such as breitling.at, breitling.ch, breitling.asia, breitling.sg etc.



#### 4.2 Complainant's use of BREITLING

The Complainant states that BREITLING is used by it as a trade mark and trade name for a range of specialized chronographs and watches, as well as related accessories. Consequent to such use, the Complainant claims that it has established an impeccable reputation and goodwill for the trade mark BREITLING worldwide including India. It is the Complainant's assertion that the mark BREITLING has established a distinct imagery in the minds of Indian as well as International population associated solely to the Complainant. Evidencing the goodwill/reputation garnered by the Complainant's use of BREITLING, Complainant has annexed publicity material in the form of magazines, trade publications, newspapers as **Annexure C (Colly.)**.

The Complainant states that it owns several registrations worldwide for its reputed and well-known trademark **BREITLING** across classes for a very wide range of goods and services including *inter-alia manufacture and sale of watches and clocks precious metals and their alloys and goods in precious metals or coated therewith (except cutlery, forks and spoons) jewellery, precious, stones, all horological products and their parts and other chronometric instruments, clothing and footwear, headgear, games and playthings, gymnastic and sporting articles not included in other classes, decorations for Christmas trees.*

The Complainant also states that it has statutory rights in the trade mark **BREITLING** by way of prior registrations in countries such as *India, United States, Bulgaria, Denmark, Germany, Mexico, Korea, Turkey, Ireland, Cyprus, Lithuania, Latvia, Sweden, under Madrid Agreement (covering the countries Uzbekistan, Armenia, Austria, Bosnia And Herzegovina, Bulgaria, Belgium, Netherlands and Luxembourg, BELARUS, Cuba, China, Czech Republic, Germany, Egypt, Spain, France, Hungary, Italy, Kyrgyzstan, Croatia, Kazakhstan, Korea, Lithuania, Latvia, Morocco, Monaco, Madagascar, Macedonia, Montenegro, Mongolia, Poland, Portugal, Romania, Serbia, Russia, Sudan, Slovenia, Slovakia, San Marino, TAJIKISTAN, Ukraine, Vietnam,, Finland, Tunisia, Great Britain, Norway, Malta, Spain.* Copies of few such registration certificates have been annexed as **Annexure – H**.

The Complainant further states that the mark **BREITLING** is registered in its favour in India under Registration Nos. 613185 (since December 02, 1993) and 687274 (since November 17, 1995) in Classes 14 and 18, respectively. Documents evidencing the said registrations including registration Nos. 687275 & 687276 in Classes 25 and 28, respectively have been enclosed as **Annexure - I** by the Complainant.

Significantly, in connection with its business, the Complainant claims to be operating the websites under the domains *breitling.com, breitling.org, breitling.info* in connection with its business and the homepages of the said websites have been annexed to the Complaint as **Annexure - F**.



#### 4.3 Respondent's Activities

The Respondent in the present instance has registered the domain name "BREITLING.CO.IN" on April 30, 2011, which as claimed by Complainant is identical to the Complainant's reputed trademark and trade name BREITLING. Complainant has annexed the WHOIS record of the domain name "BREITLING.CO.IN" alongwith the Complaint as **Annexure – J**. Complainant also claims that Respondent is a habitual offender and has cited the following domain name cases decided against the Respondent in domain name proceedings:

- i. Respondent had blocked/registered the domain 'mastercardinternational.biz' and the domain name proceedings were initiated against Respondent with the WIPO, pursuant to which, the domain was transferred in favour of Mastercard International Incorporated. Complainant has annexed the copy of the said decision alongwith the Complaint as **Annexure K**.
- ii. Further, Respondent had blocked/registered the domain 'hidglobal.biz', and the domain name proceedings were initiated against Respondent, pursuant to which, the domain 'hidglobal.biz' was transferred in favour of HID Global Corporation. Complainant has annexed the copy of the said decision alongwith the Complaint as **Annexure L**.

#### 5. Contentions of Parties as summarised in the Pleadings

##### 5.1 Complainant

a) The domain name is identical or confusingly similar to a trade mark in which the Complainant has rights

- i) Complainant submits that the disputed domain name includes the Complainant's trade name and trade mark BREITLING which is identical to its trademark.
- ii) According to the Complainant, BREITLING is being used as a trade name since the year 1884.
- iii) Complainant further submits that the impugned domain name "BREITLING.CO.IN" is identical to its registered trademark BREITLING.
- iv) Complainant submits that it has several country code top level domain name registration which incorporates the trademark BREITLING.
- v) The domain attempts to associate itself to the Complainant's domain under the trademark BREITLING and thus, causing loss to the Complainant as well as enhance the possibility of



confusion and deception amongst the public. It submits that consuming public will associate the impugned domain to be the Indian domain of the Complainant.

- vi) The Complainant submits that the sole purpose of registering the disputed domain name is to cause confusion as to the source, sponsorship, affiliation, or endorsement of the activities through the website.
- vii) The Complainant has placed reliance on Breitling SA, Breitling USA Inc. v. Acme Mail, WIPO Case No. D2008-1000 (domain name <breitling.com>) and Breitling SA, Breitling USA Inc. v. Whois Privacy Protection Service, Inc. / Breitling USA, Inc. Case No. D2008-0302 (domain name <breitling.com>) in which it was held that deceptively similar domains had been blocked by third parties and since all three criteria were satisfied, the domains were transferred in favour of Complainant.

**b) The Respondent has no rights or legitimate interest in respect of the domain name**

- i) It is the Complainant's contention that Respondent cannot have any rights in the disputed domain name, as it has sole and exclusive interest in the mark/name BREITLING.
- ii) Complainant further submits that the Respondent is not engaged in any such activity/business and is merely blocking the website of the Complainant, thus not making a fair use of the domain.
- iii) Complainant has placed reliance on the case Xerox Corporation v/s Mr. Mani Kannon where several independent proceedings were instituted against the Respondent for registering domain names comprising the trade mark XEROX. Copies of the decisions have been annexed alongwith the Complaint as **Annexure - O**.
- iv) Complainant further submits that Respondent has neither been licensed / permitted by the Respondent to use BREITLING nor is commonly known to the public by the disputed domain name.

**c) The domain name was registered and is being used in bad faith**

- i) The Complainant submits that Respondent would have been well aware of Complainant and its business and also has knowledge of the Complainant's trademark at the time of registering the domain on April 30, 2011 particularly since it has been using BREITLING as a trade name since the year 1884.





- ii) It is further submitted by Complainant that an actual or potential visitor to the Respondent's present or future webpage would be induced into believing that the Complainant has licensed the trade mark BREITLING or that it has some connection/affiliation with Complainant. Thus, it can be inferred that the domain has been registered in bad faith and such registration/use of the domain may lead to loss of profits, dilution of mark, future litigation, loss of reputation etc.

## 5.2 Respondent

As per the INDRP Rules of Procedure, the Complainant has forwarded a copy of the Complaint alongwith all annexures to the Respondent on April 06, 2015 under the directions of this Arbitral Tribunal. On April 07, 2015, this Tribunal had issued a notice to the Respondent directing it to file a response within 10 days. The Respondent did not file any response to the Complaint/notice and hence is proceeded *ex-parte*.

## 6. Discussion and Findings

As per paragraph 4 of the .IN Domain Name Dispute Resolution Policy (INDRP), 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:

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

Based upon the pleadings, it is required to be examined as to whether the parties have been able to justify/rebut the aforesaid premises:

### 6.1 Identical or confusing similar trade/service mark

As per the WHOIS records, the Respondent has registered the disputed domain name "BREITLING.CO.IN" on April 30, 2011. The domain is due to expire on April 30, 2015.

The Complainant is the registered proprietor of the trade mark BREITLING in many countries including India, as indicated above. Further, the Complainant also owns domain names comprising BREITLING in its name. To substantiate the same, the Complainant placed on record copies of registration certificates obtained for the trade mark BREITLING



in India as well as abroad including list of domain names in its name which have been annexed as **Annexure – G**.

Moreover, looking at the stature of the Complainant, its global presence as also its strong presence on the internet, it is hard to believe that the Respondent was not aware of the same.

The disputed domain name incorporates the mark/name BREITLING in its entirety. It has been held in *Inter-Continental Hotels Corporation vs. Abdul Hameed (INDRP/278)* as well as in *Indian Hotels Company Limited v. Mr. Sanjay Jha (INDRP/148)* that when a disputed domain name incorporates a mark in entirety, it is adequate to prove that the disputed domain name is either identical or confusingly similar to the mark. Similarly, in the case of *Farouk Systems Inc. v. Yishi*, WIPO Case No. d2010-006, it has been held that the domain name wholly incorporating a Complainant's registered mark may be sufficient to establish identity or confusing similarity, despite the addition or deletion of other words to such marks.

In addition, the Complainant has registered the domain name "breitling.com" on June 01, 1995 and is doing/operating business/website there under. The Respondent on the other hand registered the same much subsequent to the Complainant on April 30, 2011 and is not doing/operating any business/website thereunder.

In view of the foregoing discussions, the Complainant has satisfied this tribunal that:

- i) it has both statutory and proprietary rights in respect of the mark BREITLING; and
- ii) the domain name in question "BREITLING.CO.IN" is phonetically, structurally as well as visually identical/similar to the Complainant's prior registered trade mark/name BREITLING.

## 6.2 Rights and legitimate interests

The Complainant has asserted that the Respondent has no rights or legitimate interests in the disputed domain name. Paragraph 7 of the INDRP enumerates three circumstances (*in particular but without limitation*) and if the Arbitrator finds that the Registrant has proved any of the said circumstances, the same shall demonstrate its rights to or legitimate interest in the disputed domain name. The said paragraph is reproduced herein under:

*"Registrant's Rights to and Legitimate Interests in the Domain Name – 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 the purposes of Paragraph 4 (ii):*



- i) *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;*
- ii) *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*
- iii) *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."*

The Respondent has not filed any response in this case. There is no evidence to suggest that the Respondent has used or made demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with *bonafide* offering of goods; or is commonly known by the disputed domain name'; or has made fair use of the domain name.

Further, as observed by the Panel, in the case of *Intercontinental Hotels v. Abdul Hameed (INDRP/278)*, it is well established, that trade mark registration is recognised as *prima facie* evidence of rights in a mark. Infact, the said Principle stems from Section 31 of the Trade Marks Act, 1999. Complainant, in the instant case, is the owner of the registered trade mark BREITLING in India and has sufficiently demonstrated its rights in the trade mark BREITLING in India.

From the review of the webpage pertaining to the disputed domain, it is evident that the domain name "BREITLING.CO.IN" is not used by the Respondent inasmuch as it does not resolve into a website [www.breitling.co.in](http://www.breitling.co.in) for offering of any goods/services. In my view, needless to say, lack of a website, even after four years of registration of the domain indicates lack of *bona fide* and interest. Such a conduct not just points towards the fact that the Respondent has no legitimate interest in the domain name but that the same has been registered by the Respondent for monetary gain.

Further, the Complainant has not licensed or otherwise permitted the Respondent to use its name/mark BREITLING or to apply for or use the domain name incorporating the same. Infact, in the case of *American Home Products Corporation v. Ben Malgioglio, WIPO Case No. D2000-1602*, it has been held that a passive holding of a domain is an evidence of a lack of legitimate rights and interests in that domain.

### 6.3 Bad faith

Paragraph 6 of the INDRP enumerates the circumstances evidencing registration and use of domain name in bad faith. The said paragraph is reproduced herein under:

*“Evidence of Registration and use of Domain Name in Bad Faith - For the purposes of Paragraph 4(iii), the following circumstances, in particular but without limitation, if found by the Arbitrator to be present, shall be evidence of the registration and use of a domain name in bad faith:*

- (i) circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of 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 Registrant's documented out-of-pocket costs directly related to the domain name; or*
- (ii) the Registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Registrant has engaged in a pattern of such conduct; or*
- (iii) by using the domain name, the Registrant has intentionally attempted to attract Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.”*

The contention of the Complainant is that the Respondent has, despite being well aware of the Complainant and its prior rights in the mark/name BREITLING, has registered the disputed domain.

Further, the Respondent has not created any website under the disputed domain name for offering any goods/services even after a lapse of 4 years of registration. On the contrary, though not stated in the Complaint filed before this Arbitral Tribunal, the webpage reflects that *‘The domain name is listed for sale’. Click here to inquire about this domain name’*. On clicking on the said link, another webpage opens where the visitor has option to fill up the name, email address as well as the offer amount for purchase of the disputed domain name. Thus, it is crystal clear that the Respondent has registered the disputed domain name in bad faith for obtaining illegal monetary gain.

Further, there is lack of evidence on record suggesting *bonafide* adoption and nexus/connection of the disputed domain name by Respondent. In fact, the Complainant has brought out that Respondent is a habitual offender and registered domains like *‘mastercardinternational.biz’* and *‘hidglobal.biz’* in the past which were later transferred by the WIPO in favour of the respective proprietors. Thus, it is squarely established that such registration of the disputed domain name by the Respondent has resulted into denying the





Complainant its lawful right to register and use the disputed domain name "BREITLING.CO.IN" towards promoting its products/business.

In view of the foregoing, the Panel is of the view that Respondent has registered the domain name "BREITLING.CO.IN" in bad faith.

## **7. Award**

In light of the foregoing findings, it is established beyond doubt that (1) the domain name is confusingly similar to the mark/name BREITLING which is proprietary to the Complainant, (2) the Respondent has no rights or legitimate interests in respect of the disputed domain name, and (3) the domain name was registered in bad faith.

Thus, in accordance with the Policy and the Rules, this Arbitral Tribunal directs the Respondent to immediately transfer the disputed domain name "BREITLING.CO.IN" to the Complainant.

The parties shall bear their own cost.



**C.A. Brijesh**  
Sole Arbitrator

Dated: May 27, 2015.