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Development Corporation  
Ltd. 2nd Floor, Kubera  
Chambers, Dr. Rajendra  
Prasad Road, Shivajinagar,  
Pune 411 005.  
D-5/STP(V)/C.R.1014/01/  
08/205-208/08



NAME : S. C. Inamdar  
ADDRESS : Ganeshrupa Arts  
27/A, Shaniwar Bety  
THROUGH : पुणे 411030  
SIGNATURE :  
RECEIPT No. 94  
FOR W.M.D.C. LTD.  
AUTHORIZED SIGNATOR:

## AWARD

### IN ARBITRATION

**DISPUTED DOMAIN NAME: captainmorgan.co.in**

### DISPUTE BETWEEN

**Diageo Scotland Limited**

Edinburgh Park, 5 Lochside Way  
Edinburgh EH12 9DT  
SCOTLAND.

**THE COMPLAINANT**

**AND**

**Ashish Sethi**

Hrushikesh, F/102, A-Wing  
Lokhandwala, Andheri (W)  
Mumbai. 400053.

**INDIA**

**THE RESPONDENT**

1

**IN THE MATTER OF DISPUTED DOMAIN NAME: -**

**captainmorgan.co.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 16<sup>th</sup> DAY OF FEBRUARY TWO THOUSAND NINE.**



**I] SUMMARISED INFORMATION ABOUT THE DISPUTE: -**

**01. Names and addresses**

**Of the Complainant: -**

Diageo Scotland Limited  
Edinburgh Park, 5 Lochside Way  
Edinburgh EH12 9DT  
SCOTLAND

**02. Name of the Authorised**

**Representative of Complainant:**

M/s Lall and Sethi, Advocates  
M-19A, South Extension - II  
New Delhi. 110049. INDIA  
Phone:+91-11-4289-9999  
Fax: + 91-11-4289-9900  
Email: [cmlall@indiaip.com](mailto:cmlall@indiaip.com)

**03. Name and address of**

**The Respondent: -**

Ashish Sethi  
Hrushikesh, F/102, A-Wing  
Lokhandwala, Andheri (W)  
Mumbai. 400053. INDIA  
Telephone: - +91-24449144  
Fascimile: +91-24449144  
Email: [ashkingrulz@gmail.com](mailto:ashkingrulz@gmail.com)

**05. Calendar of Major events:**

<b>Sr. No.</b>	<b>Particulars</b>	<b>Date (Communications in electronic mode)</b>
01	Arbitration case was referred to me	20/01/2009
02	Acceptance was given by me	20/01/2009
03	Complaint physically received by me	23/01/2009
04	Notice of arbitration was issued	23/01/2009
05	Submission of reply by the Respondent	31/01/2009
06	Issue of notice to the Complainant to submit his rejoinder	31/01/2009
07	Submission of rejoinder by the Complainant	09/02/2009
08	Issue of notice to the Respondent to submit his rejoinder on the Complainant's say	09/02/2009
09	Respondent's submission of rejoinder	13/02/2009
10	Closure of evidence	14/02/2009
11	Issue of award	16/02/2009

**PRELIMINARY: -**

- 1) Diageo Scotland Limited is a subsidiary of the Diageo Plc. which is an internationally renowned brewer, distiller, bottler, blender, exporter and distributor *inter-alia* of alcoholic beverages. **(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 **'captainmorgan.co.in'** (the disputed / domain name) in the name of Mr.Ashish Sethi, Mumbai, India. **(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 each other including 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.
05. The Complainant was represented by M/s Lall & Sethi, Advocates, New Delhi while the Respondent represented himself. The Complainant filed Vakalatnama / Letter of Authority in favour of M/s Lass & Sethi.



5

### 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 subsidiary company of Diageo Plc. having its registered office in Scotland. It has about 80 companies world over. The use of trade name Captain Morgan can be dated back to 1944. The Complainant is one of the most famous and largest sellers of alcoholic beverages, especially rum.
- b) In 1983 the Complainant for the first time, introduced Captain Morgan Original Spiced Rum which was the introduction of the concept of flavored rum.
- c) The Complainant is the registered proprietor of the trade mark CAPTAIN MORGAN in India, and thus has exclusive proprietary and statutory rights in it. It has registered following trade marks in India: -

1. CPTAIN MORGAN -708544 DATED 02.04.1996
- 2: CAPTAIN MORGAN JAMAICA RUM (Label) - 137799  
Dated 24.02.1949
3. CAPTAIN MORGAN (Label) - 917273 dated 11.04.2000
4. CAPTAIN MORGAN PARROT BAY - 1275242 dated  
26.03.2004.

In addition his has registered / applied for registration of rights / trade marks in several countries of the world. The Complainant has provided a list of all the countries where it has sought / is seeking registration of trade marks.



- d) The Complainant's products under the trade mark CAPTAIN MORGAN are also sold in India by directly importing. Over a period of time the Complainant has acquired immense fame and goodwill in various parts of the world.
- e) The fame and goodwill acquired by the Complainant can be gauged by the net sales in Million of EU cases. The data provided by the Complainant states that the sales which stood at 4.1 in 2001 rose to 8.2 in 2008. He further states that due to this CAPTAIN MORGAN is the number 3 spirit brand by volume in U.S. and number 7 worldwide. It has been rated as 6<sup>th</sup> in the list of top 100 premium spirits brands on worldwide level by IMPACT, a magazine for Global News and Research for the Drinks Executive. (February 2008 edition).
- f) Write ups on the brand CAPTAIN MORGAN can be found on various websites on the internet. The Complainant has also attached some of the printouts of such write ups.
- g) The Complainant also has launched websites [www.captainmorgan.com](http://www.captainmorgan.com) and [www.captain-morgan.com](http://www.captain-morgan.com) and thus has created enormous presence on the internet. Apart from these websites he has also registered various country codes top level domain names in several countries.
- h) Though the Respondent has registered the disputed domain name, the website is still under construction. This itself is substantial evidence that the Respondent has no intention of using the impugned domain name.
- i) The registration of disputed domain name by the Respondent, without consent, authorization or license, is violation of the Complainant's rights. There is also imminent threat that the Respondent will transfer or sell this domain name to a third party for monetary gains.

- j) The adoption and registration of the disputed domain name the Respondent is likely to cause confusion and deception among the members of trade and public and by virtue thereof constitutes infringement of the Complainant's registered trade mark.
- k) The activities of the Respondent are causing and will continue to cause irreparable harm and injury to the Complainant.
- l) The present dispute squarely falls within the scope of paragraphs 4 & 6 of INDRP Policy and fulfils the premises for filing the complaint against the Respondent.
- m) The Complainant has referred to several case laws.
- n) The Complainant has requested that the impugned domain name may be either cancelled or immediately transferred to the Complainant.

**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 Respondent is working on a tribute site on Admiral Sir Henry Morgan (Hari Morgan in Welsh), who was the most notorious and successful privateers from Wales and the most dangerous pirates that lurked in the Spanish Main. He was called CAPTAIN MORGAN. Hence the Registrant has bought the disputed domain name which shall contain chapters on captain's early life, career, adventures and retirement.



8

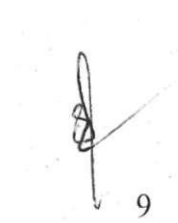


- b. The words and personality "Captain Morgan" has appeared in popular culture at several places. The Respondent has furnished many such instances.
- c. Captain Morgan has appeared in various films and literature. The Respondent has mentioned several such films and literature because it is hugely popular Welsh figure.
- d. The Respondent has affirmed that he does not intend to use the goodwill of Diageo Scotland by using name of their products. He also does not intend to misrepresent Diageo's products. He is interested in creating a tribute site based on Captain Henry Morgan.
- e. He has only purchased the disputed domain name and that he has not even started the website.
- f. He does not intend to use goodwill of Diageo Scotland Ltd. by using name of their products. He is interested only in creating a tribute site based on Captain Henry Morgan.

**VJ DOCUMENTS FURNISHED BY THE RESPONDENT: -**

In support of its contentions the Respondent has furnished, inter-alia, copies of the following documents: -

**NIL**



9

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

1. The Complainant obtained the registration of the domain name "captainmorgan.in" as far back as February 18, 2005. The Respondent obtained registration of "captainmorgan.co.in" many months later on November 5, 2007. Any research on the internet prior to registration of "captainmorgan.co.in" by the Respondent would have been disclosed the existence of the prior identical domain name registration and use by the Complainant.
2. The Respondent registered the impugned domain name as far back as on November 5, 2007 but till date has not launched a website as claimed in his reply.
3. The assertion that the Respondent intends to launch a tribute website on Admiral Henry Morgan is irrelevant as motives in registration a domain name are irrelevant.
4. The so called reasons for the registration of the Respondent of the domain name are merely an afterthought by the Respondent as the Respondent's response pointing out the various instances of Henry Morgan are all taken (almost verbatim) from the Wikipedia website.
5. A mere search on the internet would have disclosed to the Respondent that CAPTAIN MORGAN is a well-known brand of the Complainant. If one searches for CAPTAIN MORGAN on the GOOGLE search engine, the very first site disclosed is [www.captainmorgan.com](http://www.captainmorgan.com) which is the website of the Complainant.
6. Not a single film or piece of literature mentioned in the reply has any reference to CAPTAIN MORGAN. Yet, the Respondent has chosen not to register "henrymorgan.co.in" or "admiralmorgan.co.in" or indeed



10

"admiralhenrymorgan.co.in" but "captainmorgan.co.in" a name, admittedly immortalized by the Complainant and its product.

7. No explanation is forthcoming why the Respondent then chose not to register "captainhenrymorgan.co.in".

8. Even a search on the website of the well-known Encyclopedia Wikipedia for "CAPTAIN MORGAN" ([http://en.wikipedia.org/wiki/Captain\\_Morgan](http://en.wikipedia.org/wiki/Captain_Morgan)) displays the result as under :

*Captain Morgan is a brand of rum produced by Diageo. It is named after the 17th-century Caribbean privateer from Wales, Sir Henry Morgan. Captain Morgan's slogan is "Got a little Captain in You?"*

9. The Respondent's reply, though entirely lifted from the [wikipedia.org](http://en.wikipedia.org/wiki/Captain_Morgan) website, is the result of a search result for "HENRY MORGAN" Attached to this rejoinder is a screen shot of the [Wikipedia.org](http://en.wikipedia.org/wiki/Henry_Morgan) website when a search is conducted on HENRY MORGAN (domain address [http://en.wikipedia.org/wiki/Henry\\_Morgan](http://en.wikipedia.org/wiki/Henry_Morgan)) which will demonstrate that (i) the Respondent mischievously conducted a search for "HENRY MORGAN" and not "CAPTAIN MORGAN".

10. The Respondent has given no background about his profession or vocation. He does not describe himself as a writer or author or indeed a person who dedicates websites on popular historic figures.

11. Even though Captain Morgan is a brand of the Complainant based upon a historic figure, it is liable to be protected. It is submitted that even commonly used words have been protected in similar Arbitration proceedings, details of which are given as under:

- i. **Mothercare UK Limited vs. Mr. Rajkumar Jalan**  
([http://www.inregistry.in/policies/dispute\\_resolution/dispute\\_decisions/mothercarein.pdf](http://www.inregistry.in/policies/dispute_resolution/dispute_decisions/mothercarein.pdf))
- ii. **Consim Info Private Limited vs. Anand Sanwal, Mobius Development Group**  
([http://www.inregistry.in/policies/dispute\\_resolution/dispute\\_decisions/tamilmatrimonycoin.pdf](http://www.inregistry.in/policies/dispute_resolution/dispute_decisions/tamilmatrimonycoin.pdf))

  
11

iii. **Direct Information Pvt. Ltd. vs. Daniel Fuerhrer**  
([http://www.inregistry.in/policies/dispute\\_resolution/dispute\\_decisions/hotels.pdf](http://www.inregistry.in/policies/dispute_resolution/dispute_decisions/hotels.pdf))

iv. **Jagdish Purohit vs. Daniel Fuerhrer**  
([http://www.inregistrv.in/policies/dispute\\_resolution/dispute\\_decisions/jobs.pdf](http://www.inregistrv.in/policies/dispute_resolution/dispute_decisions/jobs.pdf))

12. In order to succeed in the Complaint, the Complainant has established all three elements under Paragraph 4 of INDRP Policy:

- a. Respondent's impugned domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has prior rights.
- b. Respondent has no rights or legitimate interests in respect of the domain name.
- c. Respondent's domain name has been registered or is being used in bad faith

**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.

<b>SR. NO.</b>	<b>ISSUE</b>	<b>FINDING</b>
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

**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: -**

The Complainant has established that he is holder of several trade marks containing the words captainmorgan. He has registered several such trade marks in various countries across the world including India, of which he has provided list and some proofs. The Respondent has not denied or challenged the same.

**ISSUE NO.2**

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

## **FINDING**

The Respondent has failed to establish any nexus, title, rights or privileges in the words captainmorgan in any way. He has not yet commenced the website despite a period of about one and half years has lapsed since his registration. He has also failed to demonstrate any considerable preparations in respect of launching the website, except mentioning about appearance of the words Captain Morgan in literature and some films. As such I am constrained to infer that his primary intention was to sell, rent or otherwise to transfer the same for a valuable consideration.

## **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**

The Complainant has established very clearly his rights in trademark(s) captainmorgan in various countries including India. He has also established that he is one of the renowned manufacturers and sellers of alcoholic beverages, especially rum, since 1944 with the name captain morgan. Against this the Respondent has not denied the said claims of the Complainant nor has he produced any evidence in respect of his rights in the said trade marks. As such his adoption of the domain name captainmorgan.co.in is identical and confusingly similar to a trademark of the Complainant in which the Complainant has rights.

## **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**

The Respondent has neither claimed nor established that he is holder of any registered trademark or service mark and therefore 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**

Due to cumulative findings on Issue No.1 to Issue No.4, I am constrained to infer that the Registrant/ Respondent has registered domain name in bad faith.

## **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**

The Registrant / Respondent has stated that he has registered domain name with the intention of creating a tribute to Captain Henry Morgan. He has clearly mentioned that he has just purchased the domain name and not even started website. He has not furnished any details of considerable preparation to use the domain name. As such it is established that he has not been using the domain name before notice to him.

## **ISSUE NO.7**

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

## **FINDING**

No. The name of the Registrant / Respondent has nothing to do with the disputed domain name. He has neither claimed the same nor has furnished any evidence to that effect.

### **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 - "**captainmorgan.co.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 of such expenses incurred by the Respondent.
03. The parties will bear their respective costs of arbitration.

Pune.

Dated: - 16.02.2009

  
(S.C.INAMDAR)  
ARBITRATOR