



सत्यमेव जयते

# INDIA NON JUDICIAL

## Government of National Capital Territory of Delhi

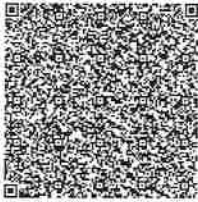
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Certificate No. : IN-DL09127539336169V  
 Certificate Issued Date : 22-May-2023 03:39 PM  
 Account Reference : SELFPRINT (PU)/ dl-self/ NEHRU/ DL-DLH  
 Unique Doc. Reference : SUBIN-DLDL-SELF88481868528926V  
 Purchased by : IRA LAW PREETIKA KASHYAP  
 Description of Document : Article 12 Award  
 Property Description : ARBITRATION AWARD  
 Consideration Price (Rs.) : 0  
 (Zero)  
 First Party : BINNY KALRA  
 Second Party : BINNY KALRA  
 Stamp Duty Paid By : BINNY KALRA  
 Stamp Duty Amount(Rs.) : 100  
 (One Hundred only)

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₹100

SELF PRINTED CERTIFICATE TO BE  
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[WWW.SHCILESTAMP.COM](http://WWW.SHCILESTAMP.COM)

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Please write or type below this line

ARBITRATION AWARD  
IN REGISTRY  
(C/O NATIONAL INTERNET EXCHANGE OF INDIA)

Before the Sole Arbitrator, Binny Kalra

Disputed domain name <caterpillarshoes.net.in>

In the matter of:

Caterpillar Inc.

Complainant

v

Uwe Dietrich

Respondent

*Binny Kalra*

### Statutory Alert:

1. The authenticity of this Stamp certificate should be verified at 'www.shcilestamp.com' or using e-Stamp Mobile App of Stock Holding. Any discrepancy in the details on this Certificate and as available on the website / Mobile App renders it invalid.
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**ARBITRATION AWARD**  
.IN REGISTRY  
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Before the Sole Arbitrator, Binny Kalra

Disputed domain name <**caterpillarshoes.net.in**>

In the matter of:

Caterpillar Inc.

5205, N.O'Connor, Boulevard Suite 100,

Irving, TX 75039

United States of America

Through its Authorized Signatory

Complainant

v

Uwe Dietrich

Hermannstrasse 389,

Monzernheim, Denmark – 55234

Email: [leethalewqly@outlook.jp](mailto:leethalewqly@outlook.jp)

Respondent

**INDRP Case No: 1678**

**1. The Parties:**

The complainant is Caterpillar Inc. who is represented in these proceedings by M/s Priya Rao & Associates, Gurgaon, India. The complaint does not provide the address of the complainant and these particulars have been noted for the purpose of this award from the power of attorney filed with the complaint. The respondent's address is per point 5 of the complaint.

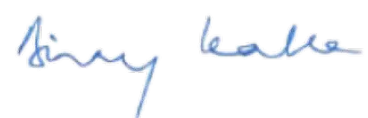
**2. The domain name, Registrar, and Policy:**



The subject matter of the complaint is the domain name <caterpillarshoes.net.in> (hereinafter referred to as the "Disputed Domain Name"). The Registrar for the Disputed Domain Name is Hosting Concepts B.V. d/b/a/ OpenProvider. The present arbitration is being conducted in accordance with the Arbitration and Conciliation Act, 1996, the .IN Domain Name Dispute Resolution Policy ("Policy") and the INDRP Rules of Procedure ("Rules").


### **3. Procedural History:**

- 23<sup>rd</sup> March 2023            The .IN Registry transmitted information of appointment of the arbitrator and circulated the complaint and its annexures to the parties, while also asking the complainant to update the complaint with the missing details of the registrant/respondent.
- 23<sup>rd</sup> March 2023            The panel wrote to the parties, directing the complainant to comply with the following note in NIXI's email: "It is noted that the domain complaint lacks complete details of the Respondent/Registrant. Enclosed are the WHOIS details of the domain. It is accordingly, requested that the Complainant should update the domain complaint with Registrant missing details and send it via return mail, addressing it to Ld. Arbitrator with copy to all including [legal@nixi.in](mailto:legal@nixi.in), in continuation of the instant email. Please also ensure that the domain complaint word limit and the documents pages numbers limit are as per the limit prescribed under Rule 3 of the INDRP Rules of Procedure."
- 24<sup>th</sup> March 2023            The panel received a communication from complainant's counsel stating that the amended complaint had been sent to NIXI on 21<sup>st</sup> March 2023.
- 24<sup>th</sup> March 2023            Notice of commencement of arbitration proceedings was issued by the panel and a period of 15 days until 8<sup>th</sup> April 2023 was given to the respondent to file a statement of defence and



supporting documents if it wished to participate in the proceedings.

- 27<sup>th</sup> March 2023 The panel received a communication from an individual on behalf of OpenProvider stating: "This domain CATERPILLARSHOES.NET is not registered with us. Please delete us from the CC on this email."
- 28<sup>th</sup> March 2023 The panel wrote to the complainant and NIXI asking them to identify the correct domain registrar and to supply their contact details. NIXI replied that the registrar is Hosting Concepts B.V. d/b/a/ OpenProvider as per the available WHOIS details.
- 31<sup>st</sup> March 2023 The panel again wrote to the parties and NIXI, noting that the WHOIS details did not set out the registrar's email ID. The complainant was directed to confirm this and/or to supply any further details. The complainant was again asked to confirm that the complaint adhered to the 5000-word limit and the annexures to the 100-page limit per Rule 4(a) of the INDRP Rules of Procedure and to provide a soft copy of the complaint.
- 3<sup>rd</sup> April 2023 The complainant's counsel replied that the WHOIS details were provided by NIXI and that they did not wish to add anything to the same. The complainant's representative provided a soft copy of the complaint and annexures to the panel.
- 3<sup>rd</sup> April 2023  
10<sup>th</sup> April 2023 The panel again followed up with the complainant's representative for confirmation of its compliance with Rule 4(a) of the INDRP Rules of Procedure and to receive the complaint in word format.
- 10<sup>th</sup> April 2023 The complainant's representative shared an email dated 3<sup>rd</sup> April 2023 forwarding a copy of the complaint in word format. At this stage the complainant's representative informed the panel that the annexures exceeded the 100-page limit by 43 pages, but it requested that these be allowed as the extra pages are important to the case.



10<sup>th</sup> April 2023

The Panel informed the parties that, as the Respondent/Registrar had not filed its statement of defence within the prescribed period or prayed for condonation, its right to file a statement of defence stood forfeited, pursuant to Rule 12 of the INDRP Rules of Procedure.

#### **4. Complainant's case:**

The complainant's case including claims and contentions as to its business and rights in the trademark CATERPILLAR, are encapsulated below:

- 4.1 The term "complainant" includes its predecessor(s)-in-interest, subsidiary companies, licensees, franchisees, sub-franchisees, distributors, associates and affiliates and group companies. The Complainant's CATERPILLAR mark was first used in India in 1948. The Complainant has obtained its earliest registrations under Nos. 10297 and 10296 dated 3<sup>rd</sup> December 1948 and 17<sup>th</sup> November 1955 in classes 12 and 7 respectively. These marks relate to tractors and machines, amongst others.
- 4.2 In para 1.10 of the complaint, the complainant has set out a list of 9 countries in which the trademarks CAT and CATERPILLAR have been recognized as well-known marks by way of judicial pronouncements. In para 1.12, the complainant has set out the worldwide turnover that its marks have attained in the period between 2005 and 2022. In para 1.13, the complainant has set out a list of its subsidiaries having the word/mark CATERPILLAR in India and elsewhere.
- 4.3 Per para 1.9 of the complaint, the mark CATERPILLAR has been recognized as a well-known trademark by the Delhi High Court in the case of *Caterpillar v. Mehtab Ahmed*, 2002 C'I'MR 345. The mark is also recognized as a well-known mark by the Trademark Registry [annexure h of the complaint, S. no. 9].



4.4 According to the complainant, sometime in December 2022 it received complaints about the disputed domain offering CATERPILLAR and CAT branded footwears for sale and was advised that consumers were not receiving the products they had purchased at the domain <www.caterpillarshoes.net.in>. On reviewing the Disputed Domain Name, the complainant found out that the respondent was selling footwear bearing the marks Caterpillar and Cat logo without authorization.

## **5. Respondent's case:**

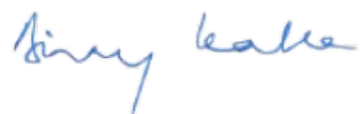
Despite being served with a notice of the Arbitration Proceedings in respect of the Disputed Domain Name and being given adequate time to respond, the respondent has failed to submit any response, communication, or evidence to the panel in this matter.

## **6. Legal grounds:**

The complainant submits that it has established the three legal grounds that are required by the .IN Domain Name Dispute Resolution Policy, namely:

- i. The Disputed Domain Name is identical to the name and trademark CATERPILLAR in which the complainant has legitimate rights. In light of the complainant's prior adoption, registrations, use and reputation of the CATERPILLAR name/mark, the mark CATERPILLAR is exclusively associated with the complainant.
- ii. The website at the Disputed Domain Name sells identical products as the complainant without authorization. The respondent has no legitimate rights to use the Disputed Domain Name.
- iii. The registration of the Disputed Domain Name is in bad faith and is actuated by the mala fide desire to take undue advantage of the complainant's reputation and goodwill in the well-known CATERPILLAR mark.

## **7. Discussion and findings:**



The Panel has seen the complaint and annexures and sets out its observations and conclusions below.

**A. Whether the Disputed Domain Name is identical and/or confusingly similar to a name, trademark or service mark in which the Complainant has rights?**

The panel accepts that:

- the complainant is the owner of the mark / name CATERPILLAR for footwear, bags, sunglasses, sports goods, heavy machinery, batteries, amongst other goods. The most pertinent class for the present dispute is class 25 covering 'footwear', in which the complainant has 3 word mark registrations for 'CATERPILLAR'. One such registration is for 'footwear' bearing registration no. 2164472 in class 25.
- The complainant has a corporate name, domain name and trademarks, of which CATERPILLAR is an essential and dominant feature. The complainant also owns several registrations comprising of CAT/CATERPILLAR in different classes.
- Several of the complainant's registered marks pre-date the start of the respondent's business in 2012, as per the website at the Disputed Domain Name <caterpillarshoes.net.in>.
- The Disputed Domain Name is identical to several of the complainant's trademarks and has the potential to cause confusion and harm the complainant's legal rights.
- The complainant has filed persuasive documents to establish that it has trademark registrations in a number of jurisdictions and a successful history of enforcing its domain names against third parties, inter alia as contained in para 1.9 of the complaint.
- The Disputed Domain Name wholly contains the mark CATERPILLAR. It is therefore confusingly similar to the complainant's domain name.

**B. Whether the Respondent has any rights or legitimate interests in respect of the Disputed Domain Name?**

The panel accepts the complainant's submission that the respondent has no legitimate rights to use the Disputed Domain Name which is identical to the complainant's registered trademarks. The suffix 'shoes' is merely descriptive and does not detract

from the use of an identical mark by the respondent in the Disputed Domain Name. Thus, for all intents and purposes the Disputed Domain Name is identical to the complainant's registered mark CATERPILLAR. Moreover, the respondent sells identical products as the complainant, namely footwear, without authorization.

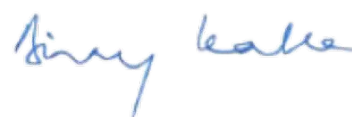
Since the respondent has chosen not to file a response, the panel is drawing an adverse inference against the respondent. The panel concludes that the respondent does not have any rights or legitimate interests in the Disputed Domain Name.

**C. Whether the Disputed Domain Name has been registered or is being used in bad faith**

It is noted that per clause 7 of the INDRP, the 4 key factors to assess bad faith are:

- a) 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
- b) 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
- c) 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; or
- d) The Registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor.

The respondent in this case has clearly used an identical or confusingly similar domain name to the complainant's mark, for identical products. The respondent uses an identical





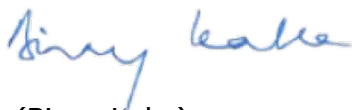
logo and colour scheme as the complainant's registered word mark on its website at the Disputed Domain Name. The respondent has played on a variant of the suffix 'shoes' in the complainant's domain name catfootwear.com. In the panel's view, 'shoes' and 'footwear' are interchangeable words. The respondent's failure to file a statement of defence fortifies the panel's conclusion that the respondent's adoption and use of the Disputed Domain Name is in bad faith. Considering the totality of the factors as discussed in this section, the panel finds that the complainant has established the grounds for the transfer of the Disputed Domain Name.

**Decision:**

Accordingly, the Panel directs that the disputed domain name <www.caterpillarshoes.net.in> be transferred to the complainant.

Further, in view of the fact that the respondent has actively sought to cause confusion and gain financially by the use of the Disputed Domain Name, the panel deems this a fit case to impose costs on the respondent. Accordingly, the respondent is directed to pay to the complainant the cost of filing the complaint in the sum of Rs. 30,000.

Signed:



(Binny Kalra)

Arbitrator

Date: 23 May 2023