

Non Judicial



**Indian-Non Judicial Stamp  
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Date : 17/03/2017

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**Seller / First Party Detail**

Name: C A Brijesh

H.No/Floor : 8th

Sector/Ward : 27

LandMark : Millennium plaza tower a

City/Village : Gurugram

District : Gurugram

State : Haryana

Phone: 9599015568



**Buyer / Second Party Detail**

Name : Na Na Na

H.No/Floor : Na

Sector/Ward : Na

LandMark : Na

City/Village: Na

District : Na

State : Na

Phone : 0

Purpose : For passing of an arbitral award under the INDRP

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**BEFORE THE SOLE ARBITRATOR C.A. BRIJESH**

**.IN REGISTRY**

**C/o NIXI (NATIONAL INTERNET EXCHANGE OF INDIA)**

**NEW DELHI, INDIA**

**Charming Charlie LLC**

5999 Savoy Drive

Houston, TX - 77036

USA

**.... Complainant**

**Versus**

**Normand Clavet**

19 rue Nationale

Paris – 75004

France

Ph: +33.0132855309

E-mail: [wename@outlook.com](mailto:wename@outlook.com)

**.... Respondent**

### **1. The Parties**

The Complainant is Charming Charlie, a Delaware limited liability company having its office at 5999 Savoy Drive Houston, TX – 77036 USA, through its Authorised Representative, Julie Anne Matheson of Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P., having its office at 901 New York Avenue, NW, Washington, DC 20001, USA.

The Respondent is Normand Clavet of 19 rue Nationale, Paris - 75004, France. The Respondent is self-represented.

### **2. The Domain Name and Registrar**

The disputed domain name is <charmingcharlie.in>. The said domain name is registered with Endurance Domains Technology Pvt. Ltd. (R173-AFIN)

### **3. Procedural Timeline**

**January 12, 2017 :** The .INRegistry appointed C.A. Brijesh as Sole Arbitrator from its panel as per paragraph 5(b) of INDRP Rules of Procedure.

**January 12, 2017 :** Arbitrator accorded his consent for nomination as Arbitrator and submitted Statement of Acceptance and Declaration of Impartiality and Independence to the .IN Registry.

**January 18, 2017 :** Parties to the dispute are informed of the constitution of the Arbitration panel and the effective date of handover. Further, NIXI forwarded the soft copy of the Complaint alongwith the



annexures to the Respondent with a copy marked to the Complainant's Authorised Representative and Arbitral Tribunal.

**January 20, 2017 :** Arbitral Tribunal addressed an email to the Respondent, with a copy marked to the Complainant's Authorised Representative and NIXI, directing the Respondent to file its response, if any, in ten days.

**February 1, 2017 :** The Tribunal addressed an email to the parties intimating that an award shall be passed on the basis of the material available on record.

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 fashion accessories retailer engaged in women's contemporary clothing, jewellery and accessories, operating and functioning under the trade name CHARMING CHARLIE LLC. The Complainant traces its history to 2004 and operates its website [www.charmingcharlie.com](http://www.charmingcharlie.com), since early 2004, wherein it advertises its products and services. Complainant also claims to have advertised its products in magazines such as *Glamour*, *People*, *Redbook*, *InStyle* and *Cosmopolitan*. With sales of over \$500 million, the Complainant claims to have entered the global sphere in 2014 with opening of its first international store in Canada. Currently, the Complainant, a global brand has its stores in United States, Canada, the





Philippines and the United Arab Emirates and the Complainant claims to operate more than 350 stores globally with over 200 stores in the United States. The Complainant claims to have received accolades which support its claims of having gained recognition in the industry, such as the Ernst & Young's "Entrepreneur of the Year" award in the Retail category in 2010, *The Accessories Council's* "Specialty Retailer" ACE Award in 2013, amongst others. Complainant has been featured on Forbes Magazine's annual list of "Ones to Watch".

#### **4.2 Complainant's Use of 'CHARMING CHARLIE'**

The Complainant has been functioning under the corporate name CHARMING CHARLIE LLC since 2004. Further, Complainant states that the mark CHARMING CHARLIE is extensively used, applied for and registered in diverse classes in various jurisdictions around the globe. In India, Complainant filed an application for registration of mark CHARMING CHARLIE on April 26, 2011 under No. 2135497, which is currently pending. There exist several registrations for the trade mark CHARMING CHARLIE including the International Registration under No. 1076065 since April 18, 2011 in the name of the Complainant. To substantiate the claim, the Complainant has provided a list of worldwide trade mark registrations as well as extracts of WIPO records and US Trade mark registration. A perusal of annexures marked as **Exhibit 8** and **Exhibit 9** substantiate Complainant's aforesaid claims.

Further, in connection with Complainant's business/products/services, it states to have registered the domain <charmingcharlie.com> in 2003. Further, in 2016, the Complainant also sought to register India specific domain names such as



<charming-charlie.in>, <charmingcharlieindia.in> and <charmingcharlies.in> and thereafter registered the same, which showcase that Complainant's goods and services can be accessed by internet users from anywhere in the world, including India. WHOIS details pertaining to <charmingcharlie.com> marked as Annexure **Exhibit 6** is on record and a perusal of the said document corroborates claim of the Complainant in this regard.

Further, the Complainant has referred to awards, accolades and achievements received in various years in its favour, as well as advertisements and events, which are all marked as **Exhibit 4** and **Exhibit 7** which corroborate the long standing repute and goodwill vested in the mark CHARMING CHARLIE of the Complainant.

Based on the aforesaid, it is the Complainant's assertion that due to extensive and continuous use of the mark/name CHARMING CHARLIE by the Complainant since 2004, the name CHARMING CHARLIE has attained substantial reputation, goodwill and distinctiveness and is solely associated with the business/services/products offered by the Complainant in the global market and by the public at large.

#### **4.3 Respondent's activities and its use of CHARMING CHARLIE**

The domain name <charmingcharlie.in> was created on October 27, 2015 as is clearly discernible from the WHOIS records, registered in the name of the Respondent. **Exhibit 2** confirms the same. The Respondent purportedly gained control/possession of the impugned domain name sometime in August, 2016. As per the said **Exhibit 10**, demonstrating the WHOIS history of the said domain name, the same was registered in the name of one "Houston Charming Charlie



Corp.”, where after, it was registered in the name of “li chenggong”. Further, the Registrant upon website [www.charmingcharlie.in](http://www.charmingcharlie.in) has depicted links under the nomenclature “Charming Charlie Store”, “Charming Charlie S”, “Stores that Buy Jewelry”, “Charming Charlie Shop online”, “Charming Jewelry” amongst others. Further, the Complainant claims that on the said website, there is an offer for sale of the domain name to the public. The same is corroborated by screenshot of the impugned website **Exhibit 11**. A perusal of the document marked clearly affirms the aforesaid.

Complainant states that Respondent has registered not only the impugned domain name <charmingcharlie.in> but the domain name <charmingcharlie.co.in> as well. Complainant claims to have made inquiries regarding proposed purchase of the aforesaid domain names from Respondent, who responded by offering to sell domain names for USD 30,000. Reference is made to **Exhibit 12** for the aforesaid.

Given that the Respondent has not furnished a response to the Complaint, no further information is available on its business activities and/or its use of the domain comprising the mark/name CHARMING CHARLIE.

## **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 of the Complainant in which Complainant has the statutory and/or common law rights.**





- i. Complainant submits that it has secured registrations for the trade mark CHARMING CHARLIE and variants thereof in various countries of the world in different classes and the name/mark CHARMING CHARLIE is internationally recognised and is inherently distinctive.
- ii. Further, it is Complainant's assertion that the domain name <charmingcharlie.in> is confusingly similar to its mark CHARMING CHARLIE as the only difference between the two lies in the removal of space between words CHARMING CHARLIE in the domain name and in the non-distinguishing ccTLD “.in” and is bound to cause confusion and deception in the minds of the public that the Respondent has some association or affiliation with the Complainant which is not the case.
- iii. Complainant thus submits that the addition of the “.in” does nothing to materially distinguish the same from the mark/name CHARMING CHARLIE of the Complainant.

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

- i. It is the contention of the Complainant that the Respondent has no rights or legitimate interests in the disputed domain name.
- ii. The Complainant contends that the Respondent's use of the Domain name is such that the impugned domain name <charmingcharlie.in> redirects users to a website featuring sponsored-link advertisements directly related to Complainant's business. Such conduct endorses the fact that neither the Respondent's use amounts to bona-fide offering of



goods or services nor a legitimate non-commercial or fair use of domain name under INDRP.

iii. The Complainant has asserted that as per the WHOIS or the records, the Respondent is not commonly known by the said domain name. Further, Complainant has not authorized Respondent to use mark CHARMING CHARLIE.

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

- i. Complainant asserts that Respondent's registration and use of domain name constitute bad faith as the use amounts to intentionally attracting internet users to competing third-party websites for commercial gain by creating confusion with the CHARMING CHARLIE mark. Further, the Respondent's use may amount to creating confusion so as to suggest affiliation of CHARMING CHARLIE with Respondent's website or suggest that CHARMING CHARLIE sells products on third-party websites.
- ii. Further, the Complainant submits that Respondent's such registration is aimed at preventing the Complainant from reflecting the mark CHARMING CHARLIE in a corresponding domain name and that the Respondent is doing so by offering to sell the Domain Name for consideration in excess of its out-of-pocket costs. Such conduct also suggests that the domain name was created in bad faith.
- iii. Moreover, the Complainant asserts that in case the Respondent is associated with entity "Houston Charming Charlie Corp.", which was





registrant of domain name <charmingcharlie.in> in 2014, then it is guilty of having provided false information, in as much as, as per Complainant, "Houston Charming Charlie Corp." is not a legitimate business. Reliance is placed by the Complainant on case laws, to submit that UDRP panels have found use of false registration information to be evidence of bad faith registration of domain name.

iv. It is submitted by the Complainant that in light of its federal registrations for mark CHARMING CHARLIE, its global recognition coupled with its long user, use by Respondent such that the domain name comprises Complainant's mark CHARMING CHARLIE in totality, a presumption can be made that Respondent was aware of Complainant's rights in mark CHARMING CHARLIE, before registering the impugned domain name. Hence, by attempting to register the domain name despite of prior knowledge, Respondent has acted in bad faith.

## **5.2 Respondent**

As per the INDRP Rules of Procedure, NIXI has forwarded a copy of the Complaint alongwith all annexures to the Respondent on January 18, 2017 with a copy marked to the Complainant and this Arbitral Tribunal.

On January 20, 2017, this Tribunal issued a notice to the Respondent directing it to file a response within ten days. However, no response was received from the Respondent.

Absent a response from the Respondent thereto or any intimation by the Respondent of its desire to furnish a response, the matter has 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 rights in respect of the domain name;
- 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 confusingly similar trade/service mark**

As per the WHOIS records, the disputed domain name <charmingcharlie.in> was registered on October 27, 2015.

The Complainant is the proprietor of the registered trade mark CHARMING CHARLIE in diverse classes and has applications/registrations for the mark CHARMING CHARLIE in various jurisdictions of the world. To substantiate the same, the Complainant has placed on record copies of registration certificates for the trade mark CHARMING CHARLIE in USA as well as WIPO. Complainant has also filed a representative list of its trademark registrations obtained in numerous countries. In India, the Complainant's trademark application filed on April 26, 2011 is currently pending. Further, the Complainant also claims to own the domain name <charmingcharlie.com>, as well as India specific domain names



<charming-charlie.in>, <charmingcharlieindia.in> and <charmingcharlies.in>. It claims to have been substantially and continuously using the mark/name CHARMING CHARLIE in relation to its business/products/services.

The disputed domain name incorporates the mark CHARMING CHARLIE 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 vs. 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 case of *Farouk Systems Inc. vs. 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 additions or deletions of other words to such marks.

As can be seen from above, the Complainant has claimed to have registered the domain name <charmingcharlie.com> (created on November 4, 2003) and <charming-charlie.in>, <charmingcharlieindia.in> and <charmingcharlies.in>; trade mark/name CHARMING CHARLIE and is doing/operating business/website under the said domain names. The Respondent on the other hand registered the domain <charmingcharlie.in> much subsequent to the Complainant.

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





- i. The domain name in question <charmingcharlie.in> is phonetically as well as visually identical to the Complainant's prior registered trade mark CHARMING CHARLIE and that the ccTLD ".in" does nothing materially to distinguish the same from Complainant's mark CHARMING CHARLIE; and
- ii. It has both prior statutory and proprietary rights in respect of the mark CHARMING CHARLIE.

## 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 Interest 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 interest 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 with a bona fide offering of goods or services;



- ii. The Registrant (as an individual, business, or other organisation) 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 misleading divert consumers or to tarnish the trademark or service mark at issue.”

The Respondent ought to have been aware of the reputed mark/name CHARMING CHARLIE of the Complainant. There is no documentary 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/services; or is commonly known by the disputed domain name; or has made fair use of the domain name. On the other hand, Respondent is using the website under domain name <charmingcharlie.in> to host links leading to various third party websites, which Complainant has asserted are links directly competing with its business. Screenshot of the website filed by Complainant depicts links to ‘Charming Charlie Store’, ‘Charming Charlie S’, ‘Charming Charlie Shop Online’, ‘Charming Jewelry’, ‘Stores that buy Jewelry’ amongst others, pertaining to third parties. Furthermore, sponsored listings to websites can be found on perusal of the screenshot filed by Complainant. Complainant has alleged that such use amounts to diversion of internet traffic to pay-per-click website showing competing links. Complainant has also alleged that Respondent is receiving “click-through” commissions once users click on advertisements displayed on Respondent’s website.



Further, as observed by the panel in the case of *International 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. Complainant, in the instant case, is the owner of the registered trademark CHARMING CHARLIE in various jurisdictions in the world; has a '.com' registration for the same since 2003; and has filed an application for registration in India which predates registration of said domain name by Respondent and thus has sufficiently demonstrated its rights in the trade mark CHARMING CHARLIE.

In view of the foregoing, it is evident that Respondent has no rights or legitimate interests in the disputed domain name.

### 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 offer for sale displayed on the website under the disputed domain name as well as the email correspondence exchanged with the Respondent, as per which it has offered to sell the domain names <charmingcharlie.in> and <charmingcharlie.co.in> for USD 30,000, clearly depicts Respondent intent to sell for valuable consideration in excess of the Registrant's documented out-of-pocket costs directly related to the domain name. As mentioned above, it appears that the Respondent is receiving "click-through" commissions once users click on advertisements displayed on Respondent's website. From the evidence on record, it is clear that such registration of domain name by Respondent is intended at preventing Complainant from reflecting its CHARMING CHARLIE mark in a corresponding domain name, so as to sell the domain name for valuable consideration in excess of its out-of-pocket costs. Further, it has been noted in



*Boehringer Ingelheim Vetmedica GmbH v. Jiaai, EAC International* (INDRP/793) that operating a website that has pay-per click links that seeks to exploit or gain from the reputation associated with another's trade mark is recognized as bad faith use of a domain name. From the records, it also appears that by registering the impugned domain name, the Respondent has attempted to attract internet users thereby creating likelihood of confusion with the Complainant's mark/source of origin.

In view of the foregoing, the panel is of the view that Respondent has registered the domain name <charmingcharlie.in> in bad faith.

#### **7. Award**

From the foregoing findings, it is established beyond doubt that (1) the domain name is confusingly similar to the mark CHARMING CHARLIE 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 is registered in bad faith.

Thus, in accordance with the Policy and Rules, this Arbitral Tribunal directs the Respondent to immediately transfer the disputed domain name <charmingcharlie.in> to the Complainant.

The parties shall bear their own cost.

**Dated:** March 17, 2017



**C.A. Brijesh**  
Sole Arbitrator