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FH 056756

INDRP ARBITRATION

THE NATIONAL INTERNET EXCHANGE OF INDIA [NIXI]

ADMINISTRATIVE PANEL DECISION

7 9 FEB 2020 SOLE ARBITRATOR: ANKUR RAHEJA, FCS LLB MCA

Disputed Domain Name: <century21.co.in>

In the matter of:

Century 21 Real Estate LLC

...Complainant

175 Park Avenue

Madison, New Jersey 07940,

U.S.A.

Versus

Alchemist Ltd.

...Respondent

Sector - 9, Chandigarh - 160009

India

ARahy  
31-07-20

## **ARBITRATION AWARD**

**Disputed Domain Name: <century21.co.in>**

### **1. The Parties:**

Complainant is Century 21 Real Estate LLC. (“Complainant”), USA represented by Ms. Shwetasree Majumder, Ms. Tanya Varma, Ms. Pritika Kohli of M/s Fidus Law Chambers, Noida, India. Respondent is Alchemist Ltd. (“Respondent”), India.

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

The domain name at issue is <century21.co.in>, created on 29th January 2006, registered with Endurance Domains Technology LLP.

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

The Complaint was originally filed with .IN Registry. Arbitrator received an email, inquiring if Nixi can avail of its services as an arbitrator for the dispute pertaining to the domain name <century21.co.in>. Arbitrator confirmed availability and sent the signed Statement of Acceptance and Declaration of Impartiality and independence as required by rules.

Arbitral Proceedings commenced on 28th May 2020 by issue of a notice by the Arbitrator by email to the Respondent, directing Respondent to file his response

to the Complaint by 12th June 2020, which was successfully delivered on the WHOIS Email ID.

In the meantime, Nixi served a soft copy of the Complaint with Annexure, while service of the hard copy was exempted due to COVID-19 Pandemic. Though it is pertinent to note that otherwise also WHOIS address for the Disputed Domain Name is incomplete, so in any case, the delivery of the hard copy of the Complaint upon the Respondent, was not feasible.

That on failure of the Respondent to file any response to the first notice, another opportunity was provided to the Respondent on 13 June 2020 but he failed to comply with the same as well. No personal hearing was requested / granted / held. The language of these proceedings is in English.

The decision was pronounced beyond 60 days, due to COVID-19 pandemic and the surrounding uncertainty.

#### **4. Factual Background:**

The Complainant is a wholly owned indirect subsidiary of Realogy Group LLC, formerly known as Realogy Corporation, USA, and is a limited liability company, organized and existing under the laws of the state of Delaware. The Complainant is a prominent and globally renowned franchisor in the field of real estate. The Complainant, under its trademark CENTURY 21, provides marketing, communications, and technology solutions that enable its franchisees and their independent agents to provide real estate services such as such as buying, selling and renting houses, etc., which services have been provided under the trademark CENTURY 21 since as early as 1971.

The Complainant and its international Master Franchisees have collectively franchised over 8000 independently owned and operated franchised broker offices in approximately 80 countries and territories worldwide, encompassing the United States, Europe, Latin America, the Middle East and Asia, and they are actively working to continue increasing the Complainant's presence and market share globally. The Complainant has duly executed CENTURY 21 Sub-franchise Agreements with Master Franchisors all over the world.

In 2007, the Complainant, through its authorized licensee Realogy Group LLC, entered into a Sub-Franchise Agreement with DGS Realtors Pvt. Ltd in India. Thereafter, the agreement was terminated by Realogy Group LLC effective 2nd June 2009, resulting in disputes between the parties before courts in India and before the American Arbitration Association. During the course of these proceedings M/s Alchemist Ltd. expressed a desire to obtain a license to use the Century 21 marks and system and consequently entered into negotiations with DGS Realtors Pvt. Ltd. and to this end provided confidential good and valuable consideration to DGS Realtors Pvt. Ltd.

The Complainant is the registered proprietor of the trademark CENTURY 21, both as a standalone word mark and also in the form of a stylized mark, where CENTURY 21 is the common element/prefix in a wide range of composite word and logo marks (together referred as CENTURY 21 trademarks), in over 100 jurisdictions all over the world, including in India. The Complainant owns and operates a website under the domain [www.century21.com](http://www.century21.com), which has been registered since 2nd March 1995.

The Delhi High court in an order dated 28th May 2015, in the matter of Century 21 Real Estate LLC v. Sambit Basu and Ors. CS (OS) 1671/2015 [(Now Century 21 v. Kankana Das & Ors CS (COMM) 506/2017)], which has now been

decreed in favour of the Complainant on 23rd July 2018, recognised the Complainant's long-standing rights in the trademark CENTURY 21 and its well-known character and repute. The court also specifically recognised the Complainant's worldwide well-established reputation and fame.

## **5. Parties Contentions**

### **A. Complainant**

In December 2012, Realogy Group LLC, of which the Complainant is a wholly owned indirect subsidiary, entered into a Master Sub-Franchise Agreement [hereinafter 'the Agreement'] with the Respondent whereby the Respondent was granted the exclusive right to use and sublicense the CENTURY 21 trademarks and Century 21 System to franchisees in India on such terms and conditions as set forth in the Agreement.

In the meantime, during the process of the ongoing negotiations, the Respondent had registered the disputed domain name [www.century21.co.in](http://www.century21.co.in) on 29th January 2006 which is the subject matter of the present complaint. The Respondent being the sub-franchisor of the Complainant was known as CENTURY 21 INDIA and offered real estate brokerage and franchising services through the disputed domain [www.century21.co.in](http://www.century21.co.in).

Subsequently, Respondent breached several provisions of the Agreement, Complainant terminated the Agreement and sent a letter dated 26th January 2016 to the Respondent. On 1st March 2016, the Respondent replied and requested the Complainant to grant a period of three months to cure the breach. Vide letter dated 13th April 2016 the Complainant sent a reply to the

Respondent's response of 1st March 2016, wherein, the Complainant clarified that the Respondent had to cure the breach by March 2016, which it failed to do.

Further, in the letter dated 13th April 2016, the Complainant also indicated that in accordance to Clause 14 of the Agreement, the Respondent is called upon to do a number of things, including immediate transfer of the domain name www.century21.co.in to the Complainant. Even after termination of the Agreement, the Respondent continued to host the website on the disputed domain www.century21.co.in. However, subsequent to the termination of the agreement the disputed domain www.century21.co.in started to redirect to www.century21.in.

Subsequently, the Complainant sent follow up letters on 18th September 2018 and on 15th November 2019, respectively, to the Respondent for the transfer of the disputed domain www.century21.co.in, however no response was received. As of present date no website is hosted on the disputed domain, however the domain registration continues to be renewed every year, clearly showing that the Respondent is misusing the Complainant's trademark and domain even after being put to notice of the Complainant's rights in the same.

## **B. Respondent**

The Respondent did not submit any response.

## **6. Discussion and Findings:**

The Arbitrator has reviewed all the documents placed before it by the parties. The Complainant in its complaint has invoked Para 4 of the INDRP, wherein the

Complainant is supposed to satisfy all three conditions provided under Para 4 of the .IN Domain Name Dispute Resolution Policy (INDRP).

## **A. Identical or Confusingly Similar**

1. The Complainant is the registered proprietor of the trademark CENTURY 21, both as a standalone word mark in over 100 jurisdictions, including India. It has been long held that the trademark registration constitutes prima facie evidence of the validity of trademark rights. In India, the mark CENTURY 21 and its variants are registered in respect to goods and services covered under numerous classes, as follows:

- a. Class 16 (applied in 1989);
- b. Class 36 (applied in 2013);
- c. Class 35 & 38 (applied in 2014);

2. The disputed domain name is confusingly similar to a trademark in which Complainant has rights and incorporates the trademark of the Complainant in its entirety. This is sufficient to establish identity or confusingly similarity for the purpose of the Policy.

3. Therefore, the Arbitrator concludes that the disputed domain name is confusingly similar to Complainant's mark.

## **B. Rights or Legitimate Interests**

1. As the Arbitrator concludes that Complainant has not satisfied the third condition of the policy, the Arbitrator declines to analyze the said condition

(Rights or Legitimate Interests) of the Policy [Tickets Worldwide LLP v. India Portals; INDRP/1187 - Tickets.in; 17 March 2020].

2. Also in the INDRP matters of INDRP/978 - MasterPay.co.in & INDRP/957 - ApanaGhar.in, a similar stance was taken and one of the elements was not analyzed in terms of the .IN domain dispute resolution policy (INDRP)... “the Arbitrator need not address the element of bad faith registration and use, as the Complainant has failed to prove the second / previous clause as to legitimate use by the Respondent.”

3. Similar position was laid down in the UDRP matters of Creative Curb v. Edgetec Int'l Pty. Ltd., FA 116765 (Forum Sept. 20, 2002) finding that because the complainant must prove all three elements under the Policy, the complainant's failure to prove one of the elements makes further inquiry into the remaining element unnecessary. Also in Scribe Opco, Inc. d/b/a BIC Graphic v. Ryan Ramsey, it was held that given the Complainant's Complaint fails on the third element, the Panel does not address whether Respondent has rights or legitimate interests in the disputed domain name [WIPO Case No. D2019-2543].

4. Accordingly, the Arbitrator need not address the element of legitimate interests, as the Complainant has failed to prove the third clause as to bad faith registration or use by the Respondent.

### **C. Registered or Used in Bad Faith**

1. Complainant submits that in December 2012 Realogy Group LLC, of which the Complainant is a wholly owned indirect subsidiary, entered into a Master Sub-Franchise Agreement with the Respondent whereby the Respondent was granted the exclusive right to use and sublicense the



CENTURY 21 trademarks and Century 21 System to franchisees in India on such terms and conditions as set forth in the Agreement.

2. The matter seems to be quite a complex one, as being a civil / business dispute between the parties and not purely a cybersquatting matter, i.e. the kind of matters generally dealt under the domain dispute policies. In the matter of MasterCard International Incorporated v. Champion Software Technologies Ltd. [INDRP/972 & INDRP/978], it was clearly laid down that INDRP Proceedings are for clear cases of cyber squatting, not for resolving trademark infringement and / or trademark dilution disputes or other matters more appropriately dealt with through the courts.

3. In *Bracemart, LLC v. Drew Lima*, FA 1494699 (Mar. 28, 2013), where the Panel rightly held that; “the contentions of the Parties and the evidence submitted show that there exists a business and/or contractual dispute between Complainant and Respondent concerning the true nature of their relationship to one another. Such dispute falls outside the scope of the UDRP, and can better be dealt with before a court of the competent jurisdiction, in a proceeding where witnesses under oath can be examined and full evidence can be taken”. Further, as a practical matter, the UDRP procedure is not well suited to the resolution of the kinds of complicated factual disputes that are presented in this proceeding (See: *Quarterview v. Quarterview Co. Ltd.*, eResolution Case Numbers AF-0209a and AF-0209b). The existence of significant factual and legal issues makes this case inappropriate for resolution under the Policy (See *Adaptive Molecular Technologies Inc. v. Priscilla Woodward and others*).

4. The facts as submitted by Complainant cannot lead to any conclusions of Bad Faith as per Complainant’s own admission, the domain name has been

registered in terms of mutual understanding and even used for promotion of Complainant's services only:

a. The disputed domain name has been registered by the Respondent in terms of a mutual understanding as per Complainant's own admissions: *"... during the process of the ongoing negotiations, the Respondent had registered the disputed domain name www.century21.co.in on 29th January 2006 which is the subject matter of the present complaint."*

b. Though it requires more investigation into the facts, beyond the scope of these proceedings, as to how the negotiations that began in 2009 or the agreement that was entered in 2012 could have allowed a registration of Domain Name in 2006. Though in any case, if it was with the Consent of the Complainant, then it cannot be a Bad Faith Registration.

c. Moreover, the relevant Trademark Registrations that Complainant holds in India as to service classes were applied 2013 onwards, though it just held registration under Class 16 for goods - *printed matters, stickers, labels, posters, magazines, newsletters, directories relating to real estate, travel and insurance brokerage services, all being goods*, the details as to Trademark Registrations have been provided as Annexure with the Complaint.

d. Further the disputed domain was mostly reflecting the services for the Complainant initially by redirecting to another domain name <century21.in>, that is use of the disputed domain name was made for the purpose of rendering services for the Complainant only. Though

Complainant alleges that the disputed domain name started redirecting post the termination of agreement, which as per archive.org is not true.

e. The disputed domain name was already redirecting as per the archives dated: December 18, 2014 (Time: 12:10:21) and January 9, 2016 (Time: 16:16:38), while the Agreement has been terminated vide letter dated 26 January 2016. In the matter of Tickets Worldwide LLP v. India Portals [INDRP/1187] and Eterno Infotech Pvt. Ltd. v. Zheng Wei [INDRP/782], it was held that evidence from Internet Archive - Archive.org is considered a reliable source of evidence.

f. Further Complainant alleges that passive holding of Domain Name should be held as Bad Faith. The said archives evident that the Domain Name was being redirected since 2014 end to Respondent's another domain name [www.century21.in](http://www.century21.in), while the Agreement was terminated on 26th January 2016 but it kept on redirecting till 2017 and there have been no use since 2018.

g. It is quite evident that post the termination of the Agreement, the disputed domain name kept on redirecting to above said domain name, which could be due to varied reasons, which this forum cannot investigate. And obviously the Respondent has not made any specific change in the use of the Domain Name, post the termination of the Agreement, to take advantage of the Complainant's rights otherwise.

h. The Complainant also submits that it has communicated to the Respondent as to breach and termination of the Agreement on 26th January 2016, to which Respondent replied on 1st March 2016 to rectify the breach. Though such communication had no reference to the

disputed domain name. But only later starting 13th April 2016, the Complainant started communicating as to transfer of the Domain Name and also issued reminder letters dated 18th September 2018 and 15th November 2019.

i. That it is evident never any such acknowledgment as to the Domain Name transfer has been made by the Respondent. Moreover, the Agreement entered between the parties in 2012 never specifically makes any reference to the Domain Name, as the Respondent was already owning the Disputed Domain Name since 2006. Further even the Trademark applications in India were applied under class 35, 36 and 38, post 2012 only, with user detail as 2013 onwards only.

j. Lastly, the Complainant nowhere clearly provides the fact as to how possibly the negotiations were happening between the parties since 2006, when by it's own submissions the negotiations seem to have happened between 2009 to 2012. That is, after the previous Agreement between Complainant and DGS Realtors Pvt Ltd was terminated in 2009.

5. Therefore, it can be concluded that the said matter is a civil / business dispute between the parties and not purely a cybersquatting matter. Recently, held in Bennett, Coleman and Co. Ltd. V Sarv Webs Pvt Ltd. [INDRP/1195]:

... the present case based on rights in the NOW family of marks appears suitable to be resolved through a trademark infringement or unfair competition claim rather than a complaint of abusive cybersquatting. As held in Intel Corporation v. Intelsitio Mexico, [WIPO Domain Name Decision: D2012-0718J and Audi AG v. Stratofex [WIPO Case No. D2012-1894] "INDRP proceedings are generally for clear cases of

cybersquatting as Policy is of narrow compass and is intended to deal with cases of abusive cybersquatting”.

6. The origin of this basis can be found in the Second Staff Report on UDRP (24 October 1999) at Para 4.1 clause(c):

“calls for administrative resolution for only a small, special class of disputes. Except in cases involving ‘abusive registrations’ made with bad-faith intent to profit commercially from others’ trademarks (e.g., cybersquatting and cyberpiracy), the adopted policy leaves the resolution of disputes to the courts (or arbitrators where agreed by the parties) and calls for registrars not to disturb a registration until those courts decide”.

7. That is, in cases of such business disputes, the Panels have found that such matters are outside the scope of the domain dispute policies such as INDRP and UDRP, while only cases of abusive registration are intended to be subject to these proceedings. In the matter of Jason Crouch and Virginia McNeill v. Clement Stein Case [WIPO Case No. D2005-1201], the Panel held that where the dispute concerning the domain names is part of and ancillary to much larger disputes involving questions of contractual obligations, fiduciary duties, and tortious conduct, it would be inappropriate to use the Policy to attempt to carve out and resolve the relatively minor, but interconnected, domain name dispute. Thus, business disputes in which the domain name is inseparable from "much larger, complex disputes between the parties, involving alleged breaches of contract, breaches of fiduciary duty, and tortious conduct" are more likely to be categorized as "legitimate disputes" that are outside the scope of the Policy [Jason Crouch and Virginia McNeill v. Clement Stein, D2005-1201]. Over such matters, alternative courts have jurisdiction, being a business / contractual dispute. Therefore, the same is outside the scope of these INDRP proceedings.

8. It is generally agreed that disputes that involve the "ownership of the business and its assets," or distill down... to just one dispositive issue that does not implicate cybersquatting at all" or "hinge mostly on a business or civil dispute between the parties" or "ownership of a domain name after breakup of a business venture" are left to courts of law. Questions of trademark infringement, dilution and invalidity are clearly not within the purview of any ICANN proceeding and are best left for court adjudication". The more practical course for parties is to present their arguments to a court of law. [source: *Domain Name Arbitration by Mr. Gerald M Levine*].

9. Also AutoNation Holding Corp. v. Rabea Alawneh, D2002-0581 (WIPO May 2, 2002) ("holding that assertions of trademark infringement are entirely misplaced and totally inappropriate for resolution through an ICANN proceeding. The scope of an ICANN proceeding is extremely narrow: it only targets abusive cybersquatting, nothing else"); Further, in Commercial Publ'g Co. v. EarthComm., Inc. FA 95013 (Nat. Arb. Forum July 20, 2000) (stating that the Policy's administrative procedure is "intended only for the relatively narrow class of cases of "abusive registrations". Cases where registered domain names are subject to legitimate disputes are relegated to the courts). Also a similar position taken in Everingham Bros. Bait Co. v. Contigo Visual, FA 440219 (Nat. Arb. Forum Apr. 27, 2005) and Fuze Beverage, LLC v. CGEYE, Inc., FA 844252 (Nat. Arb. Forum Jan. 8, 2007).

10. In the matter of Luvilon Indus. NV v. Top Serve Tennis Pty Ltd. [WIPO Case No DAU2005-0004], it was held that the Policy's purpose is to combat abusive domain name registrations and not to provide a prescriptive code for resolving more complex trade mark disputes... The issues between the parties are not limited to the law of trade marks. There are other intellectual property

issues. There are serious contractual issues. There are questions of governing law and proper forum if the matter were litigated. Were all the issues fully ventilated before a Court of competent jurisdiction, there may be findings of implied contractual terms, minimum termination period, breach of contract, estoppels or other equitable defenses. So far as the facts fit within trade mark law, there may be arguments of infringement, validity of the registrations, ownership of goodwill, local reputation, consent, acquiescence, and so on.

11. Therefore, it can be concluded that the said matter is purely a civil / business dispute between the parties, involving complex issues and hence outside the scope of this Policy !

**7. Decision:**

1. For the foregoing reasons, in accordance with INDRP Policy and rules thereunder, the Complaint is denied and the disputed domain name **<century21.co.in>** to remain with the Respondent.

2. No order as to costs.



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Ankur Raheja, FCS LLB MCA  
Sole Arbitrator, NIXI, India  
Date: 31st July 2020  
Place: Agra, India