

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

Damas Jewellery LLC

Jumeirah Lake Towers, DMCC

Damas Building, Block 3

1st Floor, P.O. Box. 1522

Dubai

United Arab Emirates

.... Complainant

Versus

Domain Admin

Dubai- 0000

United Arab Emirates

.... Respondent

1. The Parties

The Complainant is **Damas Jewellery LLC** with its principal place of business at Jumeirah Lake Towers, DMCC, Damas Building, Block 3, 1st Floor, P.O. Box. 1522, Dubai, United Arab Emirates (hereinafter referred to as the **Complainant**).

The Respondent is **Domain Admin**, of Dubai-000, United Arab Emirates (hereinafter the **Respondent**).

2. The Domain Name and Registrar

The disputed domain name is < damas.in >. The Registrar with which the Domain Name is registered is **Endurance Domains Technology LLP**

3. Procedural Timeline

- May 16, 2018 :** The .INRegistry appointed Mr. C.A. Brijesh as Sole Arbitrator from its panel as per paragraph 5(b) of INDRP Rules of Procedure.
- May 17, 2018 :** Arbitrator accorded his consent for nomination as Arbitrator and submitted Statement of Acceptance and Declaration of Impartiality and Independence to the .IN Registry.
- May 17, 2018 :** Parties to the dispute are informed of the constitution of the Arbitration panel and the effective date of handover. Further, NIXI forwarded a soft copy of the Complaint along with the annexures to the Respondent with a copy marked to the Complainant's Authorised Representative and Arbitral Tribunal.
- May 18, 2018 :** 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, within 10 days.
- May 18, 2018 :** NIXI informed the Arbitral Tribunal that the courier agency refused to accept the consignment for delivery to the Respondent due to incomplete address. Since electronic copy of the Complaint along with annexures were forwarded to the Respondent at its email address mentioned in the Whois records on May 17, 2018 and there was no bounce back/delivery failure notification, the said email was considered as deemed service to the Respondent by the Arbitral.
- May 29, 2018 :** Arbitral Tribunal, as a last opportunity, and in interest of justice granted the Respondent additional time of 7 days to file its response, if any.

June 02, 2018: The Tribunal received an email from the Respondent stating that the disputed domain belongs to one of its customers and that it is providing domain and hosting services for the said customer. The Respondent further enquired about the extant issue.

June 05, 2018: In view of the email received by the Respondent, the Arbitral Tribunal addressed an email to the Respondent with a copy marked to the Complainant's Authorised Representative and NIXI, directing the Respondent to refer to the email addressed to it dated May 17, 2018 and to file its response, if any, within 3 days.


June 08, 2018: The Tribunal received Respondent's response in the matter.

June 12, 2018: The Tribunal addressed an email to NIXI marking a copy to the Complainant's Authorised Representative taking cognizance of the Respondent's reply vide email of June 08, 2018 and intimated the parties 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, a subsidiary of Damas International Limited and a part of the Damas Group of companies states, *inter alia*, that it is engaged in the business of manufacturing, processing and sale of jewellery and watches under the trade mark DAMAS, which forms a part of its trade name, corporate name, business name, and trading style since the year 1907. With its international presence in 6 countries and 250 stores in the Gulf Cooperation Council (GCC) region, the Complainant, claims to be one of the Middle East's leading manufacturer and

retailer of jewellery and watches. The Complainant claims to hold authorized dealership of "Forevermark" in the GCC region and also acts as distributor or agent or owner for several international jewellery and watch brands such as Roberto Coin®, Faberge®, Fope®, Mikimoto®, Leo Pizzo®, Magerit®, Marco Bicego®, Armin Strom®, Louis Moinet® and Parmigiani®. The Complainant further states that it has won 'De Beers Award' for jewellery designs in the years 2000, 2004 and 2007 and was awarded the "Best Performing Brand" in "Jewellery Business Category" by the Dubai Services Excellence Scheme in the year 2016. The Complainant operates through its websites <www.damasjewellery.com>, <www.mydamas.com> wherein, its products are available. Apart from the aforesaid, the Complainant's products are available on various other online shopping and e-commerce portals, which are accessible to consumers around the world including India.

The Complainant claims to have painstakingly built its reputation worldwide including India and invested substantial amounts of resources in advertising its products under the mark DAMAS in various media, internet, other print and visual media. Further, it has also been claimed by the Complainant that renowned bollywood celebrities such as, Kangana Ranaut, Nargis Fakri, Esha Gupta, have been the brand ambassadors for the Complainant. In the year 2016, Penélope Cruz, a hollywood celebrity, launched Complainant's brand SAMA and in March 2017, Royal Highness of Jordan, Princess Nejla announced her collaboration with the Complainant. A perusal of ANNEXURE D substantiates Complainant's aforesaid claims.

4.2. Complainant's use of 'DAMAS'

Complainant has been using the mark DAMAS in connection with its on going business since the year 1907 and claims to be the registered proprietor of trade marks and domain names comprising DAMAS in numerous countries all over the world including India. Complainant has registered a number of domain names under generic Top-Level Domains ("gTLD") and country code Top-Level Domains ("ccTLD") containing the term "DAMAS", for instance, <damasjewellery.com> (created on March 04,2000), <damasdubai.com> (created on March 21, 2000), <mydamas.com> (created on June 20, 2005),

<damasjewellery.in> (created on December 07,2014). The Complainant uses these domain names to connect to websites through which it informs potential customers about its products and services under the mark DAMAS and its combinations thereof. A perusal of **ANNEXURE C** confirms Complainant's aforesaid claims.

The Complainant further states that, as a result of such advertisement, publicity, promotion and active marketing by the Complainant, the mark DAMAS have come to be associated exclusively with the Complainant alone and no one else. Further, the knowledge and awareness of the Complainant's mark DAMAS is not restricted to the countries in which the Complainant's goods are available but has also spilled over and reached the countries even where the goods are not been sold by the Complainant.

4.3 Complainant's Trade Mark DAMAS

Complainant claims to be the owner/applicant of the trade mark DAMAS and its combinations thereof, in several classes in relation to, jewellery, accessories in over 25 countries including India, United Arab Emirates, Bahrain, Oman, Kuwait, Turkey, Malaysia, Morocco, Tunisia Europe, Asia and the US. In India, the earliest registration for the mark comprising DAMAS stands registered in the name of Complainant since March 15, 2000 under Trademark Registration No. 910451 in Class 14. The aforesaid claims have been substantiated by the Complainant through **ANNEXURE A** and **ANNEXURE B**.

4.4 Respondent's activities and its use of DAMAS

The impugned domain name <damas.in > was registered in the name of Respondent on August 12, 2017 as is clearly discernible from the Whois records annexed as **ANNEXURE E**. The Respondent claims the impugned domain name to be first registered in its name in March 11, 2013 and further states that, due to non-renewal of the said domain, the Respondent re-registered the domain name <damas.in> in its name on August 12, 2017. However, the aforesaid claim of the Respondent has not been substantiated by way of any documentary evidence.

The Respondent maintains a website www.damas.in and claims to be promoting and providing support for organic farming under the name **D**evelop **A**nd **M**anage

Agriculture System in every house in the State of Kerala by way of the aforesaid website.

It is submitted by the Complainant that the domain <damas.in>, points to a blank webpage reflecting an error message *"This site can't be reached, www.damas.in's server IP address could not be found."* thereby diverting the traffic and creating a dent in the Complainant's business. To corroborate the same, the Complainant has filed screenshot of the impugned webpage as **ANNEXURE F**. However, a perusal of the website www.damas.in along with the attachment 'DAMAS_website' provided by the Respondent vide its email of June 8, 2018 confirms www.damas.in to resolve into a web page with information such as 'Home' 'About us' and 'Contact us, featuring in a single page. DAMAS is not used on the website at all which indicate that Respondent is not using the same as a trade mark or trade name. In addition, the Respondent has stated that, the website www.damas.in does not pertain to any of the trade mark/ services as that of the Complainant.

The Complainant states that the Respondent has registered 8,105,998 domain names in its name. To corroborate the same, the Complainant has filed reverse WHOIS report with the search string 'DOMAIN ADMIN' as **ANNEXURE G**. However, the Respondent in its reply contends the same to be misleading as there are only 7 domain names registered with the email of the Registrant (13980137@hidewhois.org) and usage of the phrase DOMAIN ADMIN is wrong since many of the domain names are generally registered under the said phrase or DOMAIN ADMINISTRATOR. A perusal of the screenshot under the name 'Domains_under_Email' provided by the Respondent confirms the aforesaid claim of 7 domain names.

No further information / evidence is available on Respondent's business activities and/or its use of the domain comprising the mark/name DAMAS except for what has been communicated to this Panel vide email of June 08, 2018.

5. Contentions of Parties as summarised in the pleadings

5.1 Complainant

a) **The Domain Name is identical or confusingly similar to the Complainant's trade marks (Paragraph 4(i) of the .IN Policy)**

- i. Complainant submits that it has secured registrations for the trade mark DAMAS and variants thereof in various countries of the world in different classes and the name/mark DAMAS is internationally recognised and is inherently distinctive. As mentioned above, the mark DAMAS is registered in India since the year 2000. Internationally, the same is registered in numerous countries of the world.
- ii. Complainant submits that the disputed domain name is identical and/or confusingly similar to the Complainant's prior registered and well-known mark DAMAS in which the Complainant has rights as the domain name <damas.in> incorporates the term DAMAS in its entirety and differs only in respect of addition of the country code Top Level Domain (ccTLD) extension ".in" which is insignificant. In view of the aforesaid, the complainant has relied on the case *Tata Motors Ltd. v. Mr. Baliram Devtwal [INDRP Case No.898]* wherein it was observed that "*the mere addition and difference in top level domain names of the words like '.in' does not differentiate the domain name from the registered trademarks or websites of the Complainant.*"
- iii. Complainant by placing reliance on the case *HOLA S.L. v. Viraj Malik [INDRP Case No. 731]* submits that "*for a domain name to be regarded as confusingly similar to the complainant's trademark; there must be a risk that internet users may actually believe there to be a real connection between the domain name and the complainant and/or its goods and services.*"
- iv. The Complainant has thus contended that mark DAMAS establishes an identity and connection with the Complainant alone and no one else. In addition, the members of trade and public all over the world including India are acquainted with the Complainant's well known trade mark DAMAS and therefore, any use of an identical/confusingly similar

mark/domain name by the Respondent will cause confusion amongst the Internet users as to the origin or source of the domain name.

b) The Respondent has no rights or legitimate interests in respect of the Domain Name (Paragraph 4 (ii) and Paragraph 7 of the .IN Policy)

- i. It is the contention of the Complainant that the Respondent has no rights or legitimate interests in the disputed domain name.
- ii. Further, the Complainant contends that the impugned domain name <damas.in> was created on August 12, 2017 which is subsequent to the Complainant's domain name <damasjewellery.com> which was created on March 04, 2000. By this time, the Complainant claims to have already made use of the mark DAMAS and the domain names <damasjewellery.com>, <mydamas.com> and the said mark DAMAS had garnered considerable goodwill and reputation amongst consumers across the world including India. Further, the said trademark is also part of the Complainant's corporate name/ business name/ trading style and house mark.
- iii. Complainant contends that the Respondent is neither commonly / popularly known in the public by DAMAS nor has it applied for any registration of the mark DAMAS or any similar mark or has registered his business under the said name with the Ministry of Corporate Affairs, India.
- iv. The Complainant has further asserted that the Respondent has illegally and wrongfully adopted the mark DAMAS, which is a well-known and famous mark of the Complainant. Given the Complainant's established goodwill and reputation and rights in the mark DAMAS, no one else can have legitimate rights or interest in the same. It is thus clear that Complainant has become distinctive identifier associated with the term DAMAS and that the Respondent does not have any legitimate interest nor any proprietary rights in the mark DAMAS.

c) **The domain name was registered or is being used in bad faith (Paragraph 4(iii) and Paragraph 6 of the .IN Policy)**

- i. Complainant asserts that the domain name <damas.in> was registered and is being used in bad faith as the Respondent was aware of the Complainant's registrations as the same are a matter of the public record and due to the extensive use and wide publicity of Complainant's mark DAMAS across the world including India.
- ii. The Complainant further contends that the Respondent has deliberately registered or acquired the domain name damas.in primarily for the purpose of misleading the users or for selling, renting, or otherwise transferring the domain to the Complainant or to a competitor of the Complainant or to any third party, for a valuable consideration.
- iii. It is submitted by the Complainant that the Respondent's registration of the disputed domain name is in violation of the .INRegistry which included the provisions in the INDRP for domain name registration, maintenance and renewal. The Policy requires the parties registering domain names to satisfy the following aspects:
 - a. The statements made by the Registrant in the application form are complete and accurate.
 - b. To the Registrant's knowledge, the registration of the domain name will not infringe upon or violate the rights of any third party.
 - c. The Registrant is not registering the domain name for an unlawful purpose, and
 - d. The Registrant will not knowingly use the domain name in violation of applicable laws or regulations.
- iv. The Complainant further states that the Respondent was under an obligation to conduct a trademark search, which would have clearly revealed the trademark registrations in favor of the Complainant. Breach of this provision of the Policy therefore infringes the legal rights of the Complainant.

- v. The Complainant states that bad faith is apparent from the facts and circumstances of the case and therefore the Respondents is disentitled to maintain and/or renew the impugned domain name.
- vi. The Complainant thus asserts that it is the prior adopter, registered proprietor and user of the mark and domain name comprising DAMAS and the said mark has garnered voluminous goodwill and reputation across the world so much so that the consumers across the world associate the mark DAMAS and the products sold thereunder with the Complainant alone and no one else. Therefore, use of the name by the Respondent as a domain name or in any other form constitutes violation of Complainant's rights.

5.2 Respondent

As per the INDRP Rules of Procedure, NIXI forwarded a copy of the Complaint along with all annexures to the Respondent on May 17, 2018 with a copy marked to Complainant and this Arbitral Tribunal.

On May 18, 2018, this Tribunal issued a notice to the Respondent directing it to file a response within 10 days. Absent any response from the Respondent, Arbitral Tribunal, as a last opportunity, and in interest of justice granted the Respondent additional time of 7 days to file its response, if any.

On June 08, 2018, the Respondent forwarded an email to this Tribunal stating that the impugned domain 'damas.in' is used for promoting and providing support for organic farming in every house in one of the provinces in Kerala and further mentioned that the impugned domain name does not pertain to any of the Trade Marks or products & services as that of the Complainant.

In addition, the Respondent has justified its adoption for the mark DAMAS as an abbreviation for 'Develop And Manage Agriculture System' and attached the screenshot of Google results for the same.

The Respondent has further claimed that impugned domain <damas.in> was first registered on 11 March 2013, and renewed in the year 2016. However, no

documentary evidence has been provided by the Respondent to substantiate its aforesaid claim.

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 <damas.in> was registered on August 12, 2017.


Complainant is the proprietor of the registered trade mark DAMAS in diverse classes and has applications/registrations for the mark DAMAS in various jurisdictions of the world. The mark DAMAS is registered in India since the year 2000 which is much prior to the alleged adoption of the Respondent in 2013. Internationally, Complainant's mark DAMAS is registered in numerous countries of the world. To substantiate the same, Complainant has placed on record copies of extracts from the online records of the Trade Marks Registry for the trade mark DAMAS in India as well as of other jurisdictions. Further, Complainant also claims to own several domain names comprising DAMAS such as < damasjewellery.com >, < damasdubai.com >, < mydamas.com > etc., as well as India specific domain name < damasjewellery.in >. It is pertinent to note that the domain 'damasjewellery.in' was registered on March 04, 2000 which is 17 years prior to Respondent's domain name registration. It claims to have been

substantially and continuously using the mark/name DAMAS in relation to its business/products/services.

The disputed domain name incorporates the mark DAMAS 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. 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 additions or deletions of other words to such marks.

As can be seen from above, Complainant has registered the domain name <damasjewellery.com > (created on March 04, 2000), <damasdubai.com > (created on March 21, 2000), <mydamas.com> (created on June 20, 2005), <damasjewellery.in> (created on December 07,2014); trade mark/name DAMAS and is doing/operating business/website under the said domain names. Respondent on the other hand registered the domain <damasin> much subsequent to Complainant i.e. on August 12, 2017.

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

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

6.2 Rights and legitimate interests

Complainant has asserted that 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 misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

The Respondents states that the impugned domain <damas.in> was created on March 11, 2013 and further states that, due to non-renewal of the said domain, the Respondent re-registered the domain name <damas.in> in its name on August 12, 2017. However, 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 that the impugned domain was registered on March 11, 2013. At any rate, the date of alleged registration is subsequent to adoption of the mark DAMAS by the Complainant.

Further, the google search results provided by the Respondent vide its email of June 08, 2018 clearly demonstrates that it is known by ‘Develop and Manage

Agriculture System' and not by DAMAS and is not commonly known by the disputed domain name. There is no use of DAMAS anywhere on the website and no material has been produced by the Respondent to substantiate that it is commonly known by the mark/name DAMAS.

In addition, 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 DAMAS in various jurisdictions in the world and has secured registration in India which predates registration of the impugned domain name by Respondent and thus has sufficiently demonstrated its rights in the trade mark DAMAS.

Further, it is a settled position that if Respondent does not have trade mark right in the word corresponding to the disputed domain name and in the absence of evidence that Respondent was commonly known by the disputed domain name, the Respondent can have no right or legitimate interest [See *Shulton Inc. vs. Mr. Bhaskar*, INDRP/483- <'oldspice.in'>].

In view of the foregoing, it is evident that the 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 following clearly establishes bad faith:

- (i) From the evidence on record, it is clear that such registration of domain name by Respondent is intended at preventing Complainant from reflecting its mark DAMAS in a corresponding domain names. See *Volvo Trademark Holding AB v. Mr Sachin*, INDRP/869 (<volvo-bus.in>).
- (ii) 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. See *Colgate – Palmolive Company and Colgate – Palmolive (India) Ltd. v. Zhaxia*, INDRP/887 (<colgate.in>). The factum of diverting users to a domain comprising Complainant's trade mark (business name without consent constitutes bad faith (see: *DELL Inc. v. Varun Kumar Laptop Service Center* (INDRP/920 (<dellservicescenterghaziabad.in>))
- (iii) By registering the domain name in question, the Respondent is making an attempt to associate itself with the Complainant and mislead the consumers to be an initiative of the Complainant.

- (iv) Interestingly, the screenshot of the website filed by the Complainant evidences that the website of the Respondent is not functional. The Respondent has filed a screen shot of the website, however, from the same it cannot be discerned as to the date of creation of the website and no evidence to this effect is on record.
- (v) The State of Kerala is the first state in India to declare 100% literacy and the people are known to have fondness for gold. The trade mark DAMAS is well-known for jewellery all over India as well as in Kerala. Hence adoption of the impugned domain name 'damas.in' with a webpage to cater to the said State may mislead the consumers and smacks malafide and bad faith.

In view of the foregoing, the panel is of the view that Respondent has registered the domain name <damas.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 reputed mark DAMAS 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 <damas.in> to the Complainant.

The parties shall bear their own cost.

Dated: July 17, 2018



C.A. Brijesh
Sole Arbitrator