



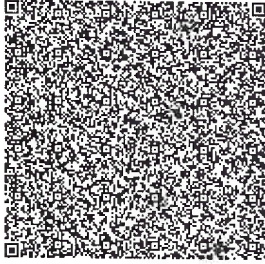
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INDIA NON JUDICIAL

Government of National Capital Territory of Delhi

e-Stamp

Certificate No. : IN-DL82732045505963P
Certificate Issued Date : 16-May-2017 10:22 AM
Account Reference : IMPACC (IV)/ dl889403/ DELHI/ DL-DLH
Unique Doc. Reference : SUBIN-DL88940366179258872280P
Purchased by : V K AGARWAL
Description of Document : Article 12 Award
Property Description : Not Applicable
Consideration Price (Rs.) : 0
(Zero)
First Party : V K AGARWAL
Second Party : Not Applicable
Stamp Duty Paid By : V K AGARWAL
Stamp Duty Amount(Rs.) : 100
(One Hundred only)



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NATIONAL INTERNET EXCHANGE OF INDIA

Flat No. 6B, 6th Floor, Uppals M6 Plaza,

Jasola District Centre,

New Delhi – 110 025

DD IP Holder LLC. v. Abdul Hannan/Ahmed

AWARD

Statutory Alert:

1. The authenticity of this Stamp Certificate should be verified at "www.shcilestamp.com". Any discrepancy in the details on this Certificate and as available on the website renders it invalid.
2. The onus of checking the legitimacy is on the users of the certificate.
3. In case of any discrepancy please inform the Competent Authority.

M. Agarwal

1. The Parties

The Complainant is M/s DD IP Holder LLC, 130 Royall Street, Canton, Massachusetts 02021, United States of America

The Respondent is Mr. Abdul Hannan/Ahmed, 10-1-17, 4th Floor, Dana Chambers, Masab Tank, Hyderabad 500 034, India.

2. The Domain Name and Registrar

The disputed domain name is <www.DunkinDonuts.in>. The said domain name is registered with the Registrar - Net 4 India Limited, D-25, Sector 3, Noida, Uttar Pradesh 201301, India

The details of registration of the disputed domain name (as per Exhibit B to the Complaint) are as follows:

- (a) Domain ID: D2846315 – AFIN
- (b) Date of creation: February 22, 2008
- (c) Expiry date: February 22, 2017

3. Procedural History

- (a) A Complaint dated February 20, 2017 has been filed with the National Internet Exchange of India. The Complainant has made the registrar verification in connection with the domain name at issue. The print outs so received are attached with the Complaint as Exhibit B. It is confirmed that the Respondent is listed as the registrant and provided the contact details for the administrative, billing, and technical contact. The Exchange verified that the Complaint satisfied the formal requirements of the Indian Domain Name Dispute Resolution Policy (INDRP) (the “Policy”) and the Rules framed thereunder.

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- (b) The Exchange appointed Dr. Vinod K. Agarwal, Advocate and former Law Secretary to the Government of India as the sole arbitrator in this matter. The arbitrator finds that he has been properly appointed. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Exchange.
- (b) In accordance with the Policy and the Rules, an attempt was made by the National Internet Exchange of India through courier to notify the Respondent about the Complaint. However, the courier informed that the Respondent is not available on the given address. The new address of the Respondent is not known. Therefore, the Complaint could not be served on the Respondent. Hence, the present proceedings have to be ex parte.

4. Factual Background

From the Complaint and the various annexure to it, the Arbitrator has found the following facts:

Complainant's activities

The Complainant is a company incorporated according to the laws of the State of Massachusetts, United States of America. The Complainant was founded in Quincy, Massachusetts in the year 1950. According to the Complaint, the Complainant is engaged in the business of coffee shops and the sale of coffee beans, ground coffee, baked goods such as donuts, muffins, sandwiches and related products. The Complainant has nearly 11,000 restaurants in 33 countries of the world, including many cities in India, such as, Bangalore, Hyderabad, Noida (UP), Mumbai, etc.

W. K. Agarwal

The “DUNKIN’ DONUTS” mark has acquired a high degree of public recognition and distinctiveness among customers around the world and symbolizes valuable goodwill for the Complainant. The Complainant is well known to its customers as well as in business circles as “DUNKIN’ DONUTS”.

Respondent’s Identity and Activities

Respondent has not provided the correct address. Therefore, the Respondent could not be contacted. Hence, the Respondent’s activities are not known.

5. Parties Contentions

A. Complainant

The Complainant contends that each of the elements specified in the Policy are applicable to this dispute.

In relation to element (i), the Complainant contends that the trademark “DUNKIN DONUTS” is commonly known throughout the world. The Complainant extensively promotes its mark “DUNKIN DONUTS” through print, web, television, and trade show advertising. The Complainant has also been the subject of extensive media coverage including stories in Forbes Magazine, The Economic Times, MarketWatch.com, and many other outlets.

The Complainant is also the registrant and proprietor of domain name registrations at international and domestic levels. Some such illustrations are: <www.DunkinDonuts.com>; <www.DunkinIndia.com>, etc.

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The trademark “DUNKIN DONUTS” of the Complainant is registered in many countries including the United States of America. So far as India is concerned, the mark “DUNKIN DONUTS” was registered for the first time on April 13, 1994 in Class 29 vide registration No. 625155. Thereafter, the trademark “DUNKIN DONUTS” was registered on September 15, 2003 in Class 42 vide Registration No. 1236836. Once again the trademark “DUNKIN DONUTS” was registered on August 05, 2010 in Class 30 vide Registration No. 2004615.

The Complainant contends that the disputed domain name contains the complete trademark, that is, Dunkin Donut. The addition of the “.in” gTLD in a domain name is insignificant. It does nothing to distinguish or alleviate confusion between the Complainant’s trademark and disputed domain name <DunkinDonut.in> .

Therefore, the disputed domain name is similar or identical to the registered trademark of the Complainant.

In support of its contentions, the Complainant has relied on the decisions in the cases of *Nike Inc. and Nike Innovative C.V. v. Zhaxia*, (Case No. INDRP/804 – July 12, 2016); *Metropolitan Trading Company v. Chandan Chandan* (Case No INDRP/811 – September 22, 2016); *Lego Juris A/s v. Robert Martin* (Case No INDRP/125) and *AB Electrolux v. GaoGou of Yerec*, (Case No. INDRP/630).

In relation to element (ii), the Complainant contends that the Respondent (as an individual, business, or other organization) has not been commonly known by the mark “DUNKIN’ DONUTS”. The Respondent does not own any trademark registration for “DUNKIN’ DONUTS”. The

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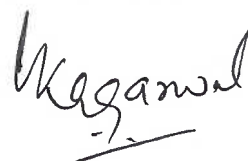
Complainant has never assigned, granted, licensed, sold, transferred, or in any way authorized the Respondent to register or use <DunkinDonuts.in> domain name or the DUNKIN DONUTS Mark.

Further, the Respondent is not making a legitimate, fair or bona fide use of the said domain name for offering goods and services. The Respondent registered the domain name for the sole purpose of creating confusion and misleading the general public. The Respondent's website under the <DunkinDonuts.in> domain refers to pay-per-click page displaying links which divert visitors to other websites which are not associated with the Complainant and, in some cases, are owned by the competitors of the Complainant. The Complainant has stated that the use of a domain name that appropriates a well-known trademark to promote competing or infringing products cannot be considered a "*bona fide offering of goods and services*".

Therefore, the Respondent has no legitimate justification or interest in the disputed domain name.

In support of its contentions, the Complainant has relied on the decisions in the cases of *Vedant Fashions Pvt. Ltd., v. Ravi*, (Case No. INDRP/824 – October 10, 2016); *Sopra Steria Group v. Xu Xiantao*, (Case No INDRP/796 – June 06, 2016), *TV Sundram Iyengar and Sons Pvt. Ltd., v. Rohit Kumar*, (Case No. INDRP/792 – July 19, 2016). Also *Rediff.com India Limited v. Abhishek Verma and iAdvance Media*, (Case No. INDRP/001 – April 03, 2006).

Regarding the element at (iii), the Complainant contends that the main



object of registering the domain name <www.DunkinDonuts.in> by the Respondent is to mislead the customers of the Complainant. The Respondent has not demonstrated any preparations to use the domain name or a name corresponding to the domain name in connection with any bona fide offering of goods or services. The Respondent is not commonly known by the domain name or is engaged in any business activity associated or related with the trademark “DUNKIN’ DONUTS” of the Complainant.

The Complainant’s trademark DUNKIN DONUTS was well-known to Respondent when he registered the disputed domain name. In the case of *General Motors India Private Limited and General Motors LLC v. Anish Sharma*, (Case No. INDRP/799 – June 02, 2016) it has been held that, “owing to the popularity of the trade name GM, GM India, General Motors in India as well as in whole world, it is presumed that the respondent is also in possession of the knowledge of the existence of the trade name. Despite this knowledge, registering such a domain name [gmirecruitment.in] amounts to bad faith.” Therefore, Respondent intentionally used the domain with knowledge of, and in violation of Complainant’s trademark rights.

The Complainant has also relied on the decision in the case of *Delhivery Private Limited v. Alex Wang*, (INDRP/791 June 23, 2016) wherein it has been held that “Parking of such domain names to obtain revenue through web traffic and sponsored results is a common practice of domain hijackers and constitutes bad faith.”

The disputed domain name was registered by the Respondents in the year 2008. The Complainant has questioned the said registration of the domain name in the year 2017, that is, after about 9 years. To this delay, the Complainant has stated that it must be noted that application of the doctrine of laches has been soundly rejected in domain name disputes. See, e.g.,

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National Association for Stock Car Auto Racing, Inc. v. Racing Connection/The Racin' Connection, Inc., (WIPO Case No. D2007-1524) wherein the Panel has concluded that the equitable defence of laches does not properly apply in this Policy proceeding. The remedies under the Policy are injunctive rather than compensatory in nature, and the concern is to avoid ongoing or future confusion as to the source of communications, goods, or services.”

Thus, the facts here strongly demonstrate that Respondent has registered and used the <DunkinDonuts.in> domain in bad faith.

B. Respondent

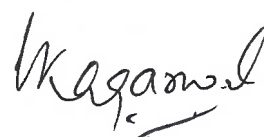
The Respondent did not submit any evidence or argument indicating his relation with the disputed domain name <www.DunkinDonuts.in> or any trademark right, domain name right or contractual right.

6. Discussion and Findings

The Rules instructs this arbitrator as to the principles to be used in rendering its decision. It says that, “a panel shall decide a complaint on the basis of the statements and documents submitted by the parties in accordance with the Policy, the Arbitration and Conciliation Act, 1996, the Rules and any rules and principles of law that it deems applicable”.

According to the Policy, the Complainant must prove that:

- (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’s has no rights or legitimate interests in respect of the domain name that is the subject of Complaint; and
- (iii) The Registrant’s domain name has been registered or is being used in bad faith.



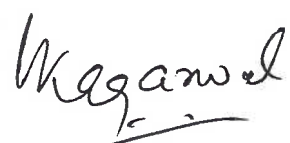
A. Identical or Confusingly Similar

The disputed domain name <DunkinDonuts.in> was registered by the Respondent on February 22, 2008. The registration of the said disputed domain name has expired on February 22, 2017. In other words, by the time this Award will be implemented, the registration of the disputed domain name has already expired.

The Complainant is an owner of the registered trademark “DUNKIN’ DONUTS” in many countries including India for the last more than 25 years. The Complainant is also the owner of a number of domains as stated above and referred to in the Complaint. Most of these domain names and the trademarks have been created by the Complainant much before the date of creation of the disputed domain name by the Respondent. The disputed domain name is <DunkinDonuts.in>. Thus, the disputed domain name is very much similar to the name and the trademark of the Complainant.

The Hon’ble Supreme Court of India has recent held that the domain name has become a business identifier. A domain name helps identify the subject of trade or service that an entity seeks to provide to its potential customers. Further that, there is a strong likelihood that a web browser looking for “DUNKIN’ DONUTS” products in India or elsewhere would mistake the disputed domain name as of the Complainant.

In the case of *Wal Mart Stores, Inc. v. Richard MacLeod*, (WIPO Case No. D2000-0662) it has been held that “When the domain name includes the trademark, or a confusingly similar approximation, regardless



of the other terms in the domain name” it is identical or confusingly similar for purposes of the Policy.

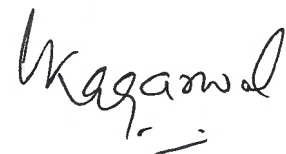
Therefore, I hold that the domain name <www.DunkinDonuts.in> is phonetically, visually and conceptually identical or confusingly similar to the trademark of the Complainant.

B. Rights or Legitimate Interests

The Respondent may demonstrate its rights to or legitimate interest in the domain name by proving any of the following circumstances:

- (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 in connection with a *bona fide* offering of goods or services; or
- (ii) the Registrant (as an individual, business or other organization) 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 Respondent’s response is not available in this case. There is no evidence to suggest that the Respondent has become known by the disputed domain name anywhere in the world. The name of the Registrant/Respondent is Mr. Abdul Hanna/Ahmed. Based on the evidence adduced by the Complainant, it is concluded that the above circumstances do not exist in this case and that the Respondent has no rights or legitimate interests in the disputed domain name.



Further, the Complainant has not consented, licensed or otherwise permitted the Respondent to use its name or trademark "DUNKIN' DONUTS" or to apply for or use the domain name incorporating said mark. The domain name bears no relationship with the Registrant. Further that, the Registrant has nothing to do remotely with the business of the Complainant.

As has been contended by the Complainant, the Respondent is not making a legitimate, fair or bona fide use of the said domain name for offering goods and services. The Respondent registered the domain name for the sole purpose of creating confusion and misleading the general public.

I, therefore, find that the Respondent has no rights or legitimate interests in the domain name under INDRP Policy, Paragraph 4(ii).

C. Registered and Used in Bad Faith

Any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration or use of the 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's 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

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that the Registrant has engaged in a pattern of such conduct; or

- (iv) by using the domain name, the Registrant has intentionally attempted to attract the 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 contention of the Complainant is that the present case is covered by the circumstances mentioned herein above. There are circumstances indicating that the Respondent has intentionally attempted to attract, for commercial gain, internet users to its web site, by creating a likelihood of confusion with the Complainant's mark. It may also lead to deceiving and confusing the trade and the public.

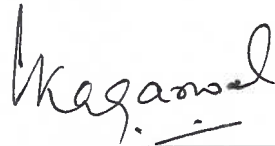
According to the Complaint, various pages of the domain contain the message "Buy This Domain. The Domain dunkindonuts.in may be for sale by the owner". The disputed domain name has also been offered by a representative of the Respondent for sale to the Complainant for a sum of US \$ 25,000. The Respondent rejected Complainant's offer to settle this dispute for the price of US\$1000. The Respondent's request for US\$25000 as a procurement price was clearly far and beyond its registration costs. Therefore, it is a case of bad faith.

The foregoing circumstances lead to the presumption that the domain name in dispute was registered and used by the Respondent in bad faith.

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7. Decision

In light of the foregoing findings, namely, that the domain name is confusingly similar to the mark in which the Complainant has rights, that the Respondent has no rights or legitimate interests in respect of the domain name, and that the domain name was registered in bad faith and is being used in bad faith, in accordance with the Policy and the Rules, the Arbitrator orders that the domain name <www.DunkinDonuts.in> be transferred to the Complainant.



Vinod K. Agarwal

Sole Arbitrator

Date: 18th May, 2017