



सत्यमेव जयते

## INDIA NON JUDICIAL

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#### e-Stamp

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Certificate Issued Date : 10-Dec-2015 12:47 PM  
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Unique Doc. Reference : SUBIN-DL71970380060836864153N  
Purchased by : SUDARSHAN KUMAR BANSAL  
Description of Document : Article 12 Award  
Property Description : Not Applicable  
Consideration Price (Rs.) : 0  
(Zero)  
First Party : SUDARSHAN KUMAR BANSAL  
Second Party : Not Applicable  
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Stamp Duty Amount(Rs.) : 100  
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#### IN. Registry (National Internet Exchange of India)

FD Management, Inc. & Anr. .... Complainants

Vs.

Song GuangXiu .... Respondent

#### ARBITRATION AWARD

*S.K. Bansal*

#### Statutory Alert:

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IN. Registry  
(National Internet Exchange of India)

FD Management, Inc.  
200 First Stamford Place  
Stamford, CT 06902  
USA

And

Elizabeth Arden, Inc.  
200 Park Ave South  
New York, NY 10003  
USA

... Complainants

Vs.

Song GuangXiu  
No. 2803, 2-1, HengDaMingDu  
Beijing South Road  
Huai'an, Jiang Su 223003  
China

... Respondent

**ARBITRATION AWARD**

The Complainants, FD Management, Inc. and Elizabeth Arden, Inc., are aggrieved by the Respondent's registration of the domain name elizabetharden.in and have accordingly made this complaint before the .IN Registry C/o National Internet Exchange of India in accordance with the IN Domain Name Dispute Resolution Policy (.INDRP for short) approved by the National Internet Exchange of India (NIXI) and the .INDRP Rules of Procedure and approved by NIXI.

1. The case of the Complainants on the basis of which the complaint has been preferred, in gist, is as under:-

(a) FD Management Inc. (The Complainant No. 1 for short) is a corporation organized and existing under the laws of the State of Delaware, USA while Elizabeth Arden Inc. (The Complainant No.2 for short) is a corporation organized and existing under the laws of State of

*S.K. Bame*

Florida, USA. Complainant No.1 claims Complainant No.2 to be its trademark licensee.

(b) The Complainant No.1 claims itself to be the owner of the trademark ELIZABETH ARDEN for its numerous goods and services and claims the said trademark to be registered under various numbers in the USA and as per the particulars mentioned in the complaint and as per the registration certificates copies whereof have been filed. The Complainant No.1 claims the trademark ELIZABETH ARDEN to be registered in India under trademark registration No. 1807656 in Class 03 and which prior to its registration was advertised in the Trade Mark Journal No. 1443 dated 01.07.2010. This trademark was filed for registration on 16.04.2009 for wide range of products falling in Class 03. The Complainant No.1 claims to have acquired USA registrations for the word/mark ELIZABETH ARDEN by way of assignment and as per the assignment deeds and registration mentioned therein copies whereof have been filed. The Complainant No.1 also claims to own common law rights in its said ELIZABETH ARDEN Trade Mark and the goodwill associated with it and claims to have been using the said trademark through its predecessor for over 100 years and claims the said trademark to have become amongst the world's most renowned trademarks in the beauty and cosmetics industry. The Complainant No.1 claims to have invested extensive resources in the protection and promotion of its said trade mark and claims to be using the said trade mark on its website <<http://www.elizabetharden.com/>> besides through other modes.

(c) According to the Complainants the impugned domain name [www.elizabetharden.in](http://www.elizabetharden.in) is registered in the name of the Respondent as per the Whois database of the .IN Registry and which domain name is identical to the words of the of the trademarks ELIZABETH ARDEN identified in the said trademark registrations of the Complainant and other than the ".in" ccTLD, the impugned domain name contains the words of each of ELIZABETH ARDEN trademarks and only those words

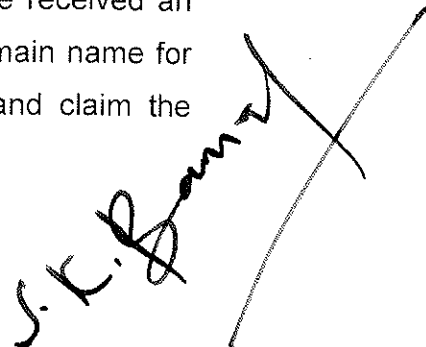
*S.K. Bame*

and the impugned use of the impugned domain name by the Respondent would likely to cause confusion amongst the consumers who would come across the impugned domain name or the website affiliated therewith. The Complainants claim the Respondent to have no rights or legitimate interests in the impugned domain name and of the Complainants' first use to predate the Respondent's impugned registration of the impugned domain name which occurred on 7<sup>th</sup> October 2014.

(d) The Complainants upon its information and belief state that there is no evidence of the Respondent having used or made demonstrable use of the impugned domain name in connection with the bona fide offering of goods or services or of the Respondent to be commonly known by the impugned domain name. The Complainant upon its information and belief also state that there is no evidence of the Respondent making a legitimate non-commercial or fair use of the impugned domain name without the intent for commercial gain by misleading, diverting customers or tarnishing the trademarks or service mark at issue. It is further stated by the that the Respondent's lack of current business interests or intent for use of a future business make the impugned domain name a clear evidence of lack of legitimate interests in its use.

(e) The Complainant claims upon its information and belief that the disputed domain name has been registered or acquired by the Respondent primarily for the purpose of selling, renting or otherwise transferring its registration to Complainant No.2 whose trade name also bears the word/trademark ELIZABETH ARDEN.

(f) The complainants allege Complainant No.2 to have received an email dated 3<sup>rd</sup> April 2015, offering to it the impugned domain name for sale and purchase which clearly establishes bad faith and claim the disputed domain name to be registered in bad faith.

A handwritten signature in black ink, appearing to read "S.K. Sharma", is written diagonally across the bottom right corner of the page. The signature is written over a horizontal line that spans the width of the page.

(g) Accordingly, the Complainants have filed this Complaint with the prayer that the impugned domain name be transferred to the Complainant No.1.

(h) Alongwith the Complaint the Complainants have filed documents being **Annexure A to F** which would be dealt with in the course of this award.

2. The .IN Registry appointed me as an Arbitrator to adjudicate this complaint in accordance with the Arbitration and Conciliation Act, 1996; .IN Domain Name Dispute Resolution Policy; Rules of Procedure and/or bye-laws, rules and guidelines made therein and notified the factum thereof to the Complainant through its attorneys and authorized representatives, as well as the Respondent vide its email of 20<sup>th</sup> November 2015.

3. Thereafter, I issued a notice to the Respondent vide email dated 23<sup>rd</sup> November 2015 with a copy of the complaint and Annexures wherein the Respondent was also notified of me being appointed as an Arbitrator and wherein the Respondent was given an opportunity to submit his written response to the complaint stating its reply and defense together with documents supporting its position within ten days thereof. The Respondent never replied to the said notice and nor submitted its response and documents within the stipulated time. In the interest of justice another opportunity of five (5) days to file the response was given to the Respondent vide my notice dated 3<sup>rd</sup> December, 2015, with copy to the authorized representatives of the Complainant, wherein it was stated that in the event of the Respondent not so filing, the complaint would be decided on the basis of the material on record filed by the Complainant. The Respondent never filed any response.

4. Consequently I proceed to adjudicate this Complaint on the basis of the material available on the record.

*J.K. Bame*

5. The Trade Mark ELIZABETH ARDEN is duly registered in India in the name of FD Management Inc., (Complainant No.1) under the Trade Marks Act, 1999 (The Act for short) under Trade Mark Registration No.1807656 in class 3 as of 16.04.2009 and which registration is valid/renewed upto 16.04.2019. The class 3 products covered by this registration are fragrance products for personal use, namely, perfume, eau de parfum, eau de toilette, eau de cologne, body mist, scented body lotions, creams, oils and gels; essential oils; cosmetics, namely, face, eye, lip, and cheek makeup; and non-medicated skincare products for personal use, namely, face and skin creams, lotions, serums and gels; masks; cleansers, toners, moisturizers and clarifiers; eye creams and gels; bath and body soap; bath and shower gel; body scrub; body rinse; bubble bath; bath salt and bath oil; bath and body powder; deodorant and antiperspirant. This registration was applied for on 16.04.2009 and prior to its grant the application was advertised in Trade Mark Journal No.1443 dated 01.07.2010 at page No.582. The Complainant has placed on record as **Annexure-D** the status report of this trade mark as obtained from the e-records of the Indian Trade Mark Office which mentions of the Trade Mark to be registered as well as copy of the aforesaid publication in the Trade Mark Journal. Consequently the aforesaid Indian Trade Mark Registration stands established.

5.1. This Indian Trade Mark registration confers valuable rights in the registered Trade Mark upon the Registrant, Complainant No.1 in this case. This registration has a presumptive validity attached to it as also it is a presumptive evidence of title in favor of the Registrant [**See American Home Products Corporation Vs. Mac Laboratories Pvt. Ltd. & Anr. reported in AIR 1986 SC 137; National Bell Co. Vs. Metal Goods Mfg. Co (P) Ltd. & Anr. reported in AIR 1971 SC 898; Section 2(i) (v), 28 and 29 of the Act**].

5.2. The Complainant has mentioned in the complaint of the numerous Trade Mark registrations for the word/mark ELIZABETH ARDEN held by it in the U.S.A. and the earliest registration mentioned

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by it is under No.545592 dated 24.07.1951. The other US Registrations are under Nos.545890 dated 31.07.1951; 557022 dated 01.04.1952; 1577216 dated 16.01.1990; 1579710 dated 30.01.1990; 1656519 dated 10.09.1991; 3069443 dated 14.03.2006; 3651009 dated 07.07.2009; 3695951 dated 13.10.2009; 4023348 dated 06.09.2011. The Complainant has placed on record as **Annexure-C** copies of some such USA Registration Certificates and a perusal thereof shows that these registrations cover a wide number of classes namely classes 3, 18, 24, 35 & 42 and goods/services covered thereby. The Complainant has filed as **Annexure-E**, copies of deeds of assignments evidencing assignment of ELIZABETH ARDEN trade mark registrations under No.545592, 545890, 577022, 1577216, 1579710, 1656519 to it and its consequent acquisition of rights therein.

6. The Complainant has filed as **Annexure-F** a print out from its website under its domain name <http://www.elizabetharden.com>. This print out shows cosmetics and beauty products bearing the Trade Mark ELIZABETH ARDEN. The look and tenor of this print out establishes the complainant to be in commercial use of its cosmetics and beauty products under the Trade Mark ELIZABETH ARDEN and of its domain name bearing the word/mark ELIZABETH ARDEN atleast on the online market place.

7. The complainant has filed as **Annexure-A** a print out of the search results from the Whois database of the .IN Registry pertaining to the impugned domain name ELIZABETHARDEN.IN registered in the name of the Respondent with the sponsoring registrar Webiq Domains Solutions Pvt. Ltd., (R131-AFIN) and to be created on 07.10.2014.

8. From the aforesaid documents being **Annexure C & D** it can safely be taken that the trade mark ELIZABETH ARDEN to be in existence at least since the year 1951 in the U.S.A. and since the year 2009 in India. In contrast the creation of the impugned domain name as per **Annexure-A** is only in the year 2014. Thus the Complainants said

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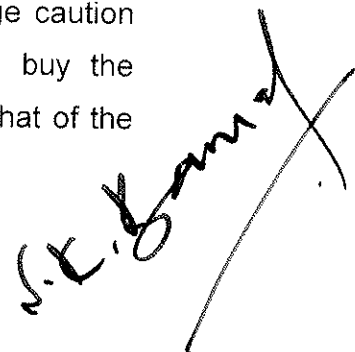
trade mark is clearly a prior and senior mark and pre dates the Respondent's registration of the impugned domain name with the sponsoring Registrar.

9. Undoubtedly the Complainants website under its domain name <http://www.elizabetharden.com> from which **Annexure-F** has been extracted has worldwide reach and access. The market and trade can be presumed to be well aware of the Complainant and its commercial activity in relation to its beauty and cosmetic products under the trade mark ELIZABETH ARDEN and domain name <http://www.elizabetharden.com> of which the word/mark ELIZABETH ARDEN forms a material and memorable part.

10. The Respondent has not contested the Complainants aforesaid rights and use including the Complainant's claim of the said Trade Mark to be a renowned Trade Mark and to have been extensive use.

11. In view of the aforesaid it can be clearly held that the Complainant has proprietary and enforceable rights in its said trade mark ELIZABETH ARDEN and this is more so as the Respondent has not contested the Complainants aforesaid rights and use including the Complainant's claim of the said Trade Mark to be a renowned Trade Mark and to have been extensive use and duly protected and promoted.

12. In my considered view there is a complete identity- phonetic, visual, structural and conceptual between the Complainants trade mark ELIZABETH ARDEN and the impugned domain name elizabetharden.in of the Respondent. The word/mark ELIZABETH ARDEN is the prominent, memorable and distinguishable feature in the respective rival and competing trade mark and domain name and which would be used and remembered by an average consumer exercising average caution and with reference to which the average consumer would buy the Complainants goods or access the Complainants website or that of the Respondent and do business with it.





12.1.a Having regard to the complete similarity/identity between the Complainants trade mark ELIZABETH ARDEN and the impugned domain name elizabetharden.in of the Respondent, an average consumer with imperfect memory would be led into believing that some nexus association or connection exists between the Complainant and the Respondent or of the impugned domain name to be in fact of the Complainant or sponsored or affiliated with the Complainant or an extension of the Complainant's business, while in fact it is not so. This would invariably give rise to consumer deception.

12.1.b Not only that any consumer or internet user seeking access to the Complainant or its products with reference to the Trade Mark ELIZABETH ARDEN online, would be misled to the Respondent's website, in case they erroneously or inadvertently suffix the "second level" domain name viz. ELIZABETH ARDEN with the cc TLD (country code top-level domain) .in instead of gTLD (generic top-level domain) .com. The user/consumer would be deceived by being led to somewhere else or in not reaching the Complainant.

12.1.c The Respondent (even if it was to be taken has not been using the impugned domain name for the moment ) may or can always use it at a future point of time by itself or can even sell the disputed domain name to another legal entity who may so use it in the course of trade. In such an event the consumer can be led to the Respondent or its assignee in the place of the Complainant and would be in a state of wonderment. For assessing Trade Mark violations it is permissible to consider any future contemplated use of the violative domain name even if it is not being carried out precisely at the date of the proceedings [See Laxmikant V. Patel Vs. Chetan Bhat Shan & Anr. reported in AIR 2002 SC Page 275]

12.2. Consequently the user/consumer can be led into believing that the Complainant has no rights or business in its trade mark or is merely

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trafficking therein to make illegal money. The Complainant would also have no control over the Respondent or its assignee or over the standard or quality of the goods/services being offered by them under the impugned domain name. Any inferior services offered by the Respondent would invariably adversely affect the Complainant's business under the said word/mark ELIZABETH ARDEN. All these activities would invariably and irreparably tarnish the goodwill, reputation and standing of the Complainant and its business; diminish the capacity of the Complainants said trade mark to identify and distinguish the Complainants goods/services and would considerably dilute the strength and value of the Complainants said trade mark. Not only that even the consumers would suffer as they would not get what they expected and instead would be deceived. The impugned domain name would inevitably result in bringing loss and injury upon the Complainants as well as the consumer.

13. Even a close similarity of the domain names can lead to the presumption of association between the two competing entities by the public and qualifies as deception or why else would the Respondent choose such a deceptively similar domain name **[Marks & Spencer Vs. One-In-A Million reported in 1998 FSR 265]**.

14. A right in the Trade Mark can be violated even by the use of the Trade Mark as a part of a rival domain name and that a probability/likelihood of consumer deception is the test and not actual consumer deception. A right in the Trade Mark and especially in the registered Trade Mark has to be protected and this is so even if the rival mark/domain name has so far not being used or only contemplated to be used **[See Bharti Airtel Limited Vs. Rajiv Kumar-2013 (53) PTC 568(Del); Tata Sons Limited Vs. D. Sharma & Anr.-2011 (47) PTC 65(Del.); Dr. Reddy's Laboratories Limited Vs. Manu Kosuri & Anr.-2001 PTC 859 (Del); Mars Incorporated Vs. Kumar Krishna Mukherjee & Ors.- 2003 (26) PTC 60 (Del)]**

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15. In my considered view, the Respondents very adoption of the impugned domain name and its registration is in bad faith actuated by malafide and fraud. There is no element of good faith, good intention or honesty involved. The Respondents are guilty of trafficking and cyber piracy which in themselves are a facet of bad faith and that the Respondent has no legitimate right or interest in the impugned domain name.

16. The Complainant has placed on record as **Annexure-B** an e-mail sent on 03.04.2015 to Complainant No.2 offering to the Complainant No.2 the purchase of the impugned domain name. Even though this E-mail does not mention of the Respondent nevertheless it can be construed to be of the Respondent or under the Respondent's authority as it mentions the impugned domain name clearly. Vide this **Annexure-B** the Respondent in my considered view is guilty of trafficking and cyber piracy besides bad faith and malafide.

17. Trafficking has been recognized by the Hon'ble Supreme Court of India in its decision of **American Home Products Corporation vs. Mac Laboratories Pvt. Ltd. reported in AIR 1986 SC 136** as a "cardinal sin" of Trade Mark law. In the very same judgement the Hon'ble Supreme Court has held trafficking to involve obtaining registration of Trade Marks without any intention to use it in relation to any goods but merely to make money out of it by selling it to others the right to use it as also the Hon'ble Supreme Court quoted with approval the observations of Lord Brightman in the case of (1984) 1 All ER 426 viz.

".....To my mind, trafficking in a trademark context conveys the notion of dealing in a trade mark primarily as a commodity in its own right and not primarily for the purpose of identifying or promoting merchandise in which the proprietor of the mark is interested. If there is no real trade connection between the proprietor of the mark and the licensee or his goods, there is room for the conclusion that the grant of the licence is a trafficking in the mark. It is a question of fact and

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degree in every case, whether a sufficient trade connection exists".

*(emphasis supplied)*

18. The Courts have repeatedly held that the basic principles of Trade Mark law as also the laws of passing off to apply to disputes in respect of internet domain names **[See Satyam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd., 2004 (28) PTC 566 (SC)]**

19. "Cyber-piracy" has been defined as "the act of registering a well known name or mark" (or one that is confusingly similar) as a website's domain name, usually for the purpose of deriving revenue" **[See The BLACKS LAW DICTIONARY 444 (9<sup>th</sup> ed. 2009)]**. Thus encompassed in the concept of "trafficking" is the concept of cyber-piracy.

20. A clear perusal of **Annexure-B** as mentioned above, the Respondent seeks to make money by the sale of the impugned domain name and has no bonafide use or offerings on the impugned domain name.

21. While considering the concept of malafide the Hon'ble Supreme Court in its celebrated case of **Parbodh Sagar v/s The Punjab State Electricity Board and Ors reported in 2000 (5) JT 378** has held – ".....that the expression "malafide" is not a meaningless Jargon and it has its proper connotation. Malice or malafide can only be appreciated from the records of the case in the facts of each case. There cannot possibly be any set of guidelines in regard to the proof of malafides. Malafides, where it is alleged, depends upon its own facts and circumstances." In light of the aforesaid pronouncement it can be safely held that the concept of or what amounts to bad faith, malafide or dishonesty is not one that lends itself to a exhaustive definition and for the determination of which there can be no rigid strait jacket formula and nor prescribed hard and fast rules or set guidelines. They have to be judged with reference to the facts and circumstances of each case. **The Oxford dictionary of law 6<sup>th</sup> Edition 2006** defines malafide as - [Latin:

*N.K. Bhandari*

bad faith] Describing an act performed fraudulently or dishonestly. In Gramax Plasticure Limited V/s Don & Low Nonwovens Limited 1999 RPC 367 at page 379 bad faith has been defined to include dishonesty and dealings which fall short of the standards of acceptable commercial behavior observed by reasonable and experienced men in the particular area being examined. In Road Tech Computer Systems Limited v/s Unison Software (UK) reported in 1996 FSR 805 at page 817 bad faith has been defined to mean dishonest, lack of good faith : not necessarily for a financial motive but still dishonesty.

22. The Respondent has not furnished any explanation or reason on his adoption of an identical prior trade mark/domain name ELIZABETH ARDEN of the Complainant. The Respondent was well aware of or ought to have been aware of or could have become aware of the Complainant's said Trade Mark. The Respondent who has registered the impugned Domain Name must be an internet user or having knowledge and interest in the internet and awareness of the concepts of E-commerce and online markets actuated through the internet medium triggered through domain names. The word/mark ELIZABETH ARDEN is neither a dictionary word and nor forms part of the ordinary language usage in India. The word/mark ELIZABETH ARDEN has no connection or association with characteristics or attributes of the goods/services related to the beauty and cosmetic industry. The adoption of the impugned domain name could not have been made randomly or by mere chance. The Respondent never even cared to file a response to the present complaint. The Respondent's impugned conduct speaks for itself (*res ipsa loquitur*) and falls short of the standards of acceptable commercial behavior. Obviously the motive of the Respondent was to derive some benefit from the Complainant's trademark ELIZABETH ARDEN including by way of sale of its impugned domain name a fact mentioned in Annexure-B.

23. The Hon'ble Delhi High Court in its celebrated decision of M/s Hindustan Pencils Pvt. Ltd. v/s M/s India Stationary Products

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**Company & Anr. Reported in 1989 PTC 61** affirmed the observation of Romer J, in the matter of an application brought by J.R. Parkington and Coy. Ltd., 63 R.P.C. 171 at page 181 that "in my judgment, the circumstances which attend the adoption of a trademark in the first instance are of considerable importance when one comes to consider whether the use of that mark has or has not been a honest user. If the user in its inception was tainted it would be difficult in most cases to purify it subsequently". In the same judgment the Hon'ble High Court has held that if a party for no apparent or valid reason adopts the mark of another business it can be assumed that such an adoption was not honest and the Court would be justified in concluding that the defendant/Respondent by such an act wanted to cash upon the name and reputation of the Complainant and that was the sole primary and real motive of the defendant/Respondent in so adopting such a mark. In the same judgment the Hon'ble Court further held that the violator business who uses or adopts someone else marks must be aware of the consequence which must follow. The Respondent cannot derive any benefit from its own wrongs.

24. In my considered view the Complainant has discharged its onus/burden of proof. The wrongs of the Respondents are also apparent from the fact that it has not traversed nor challenged the complaint facts against him. Such a non-traverse has to be taken against the Respondent (**Uttam Singh Dugal & Company Limited V/s Union Bank of India & Ors – reported in AIR 2000 SC 2740**).


25. Trade Marks have been accepted to be a valuable business asset to be protected against their wrongful use even as part of a rival domain name and Trade Mark violations have to be removed.

In the aforesaid view of the matter I am of the confirmed view that the complaint must be allowed.

*J. T. Dugal*

Accordingly it is decided that the disputed domain name www.elizabetharden.in be transferred to the Complainant No.1 – FD Management Inc., 200 First Stamford Place, Stamford, CT 06902, USA.

Signed at New Delhi, India on this 10<sup>th</sup> day of December, 2015.

  
Sudarshan Kumar Bansal  
Sole Arbitrator