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BEFORE THE SOLE ARBITRATOR HARSHAVARDHAN SANCHETI  
.IN REGISTRY  
(NATIONAL INTERNET EXCHANGE OF INDIA)  
.IN DOMAIN NAME DISPUTE RESOLUTION POLICY (INDRP)  
ARBITRATION AWARD  
DATED: 6 NOVEMBER 2017

FDC Limited  
B-8 MIDC Industrial Area  
Waluj 431136  
Maharashtra  
India

...Complainant

v

Christian Schmidt  
Terra Preta GmbH  
Gustav Muller Straße 1  
10829 Berlin,  
Germany

...Respondent

**1. The Parties**

2. The Complainant is FDC Limited, B-8 MIDC Industrial Area, Waluj 431136, Maharashtra, India represented by S.S. Rana & Co., Advocates, 317 Lawyers Chambers, High Court of Delhi, New Delhi.
3. The Respondent is Terra Preta GmbH, whose registration was made in the name of Mr. Christian Schmidt, but who is represented through its Managing Director, Mr. Dirk Krishchenowski.

**2. The Domain Name**

4. The disputed Domain Name is WWW.FDC.IN ("Domain Name"). On 16<sup>th</sup> February 2005 the domain FDC.IN was registered by the Respondent, with the Registrar, Key-Systems GmbH (R48-AFIN), I m Oberen Werk 1, 66386 St. Ingbert, Germany.

**3. Procedural History**

5. These are mandatory arbitration proceedings in accordance with the .IN Domain Name Dispute Resolution Policy ("INDRP"), adopted by the National Internet Exchange of India ("NIXI").
6. The INDRP Rules of Procedure ("the Rules") were approved by NIXI on 28<sup>th</sup> June 2005 in accordance with the Arbitration and Conciliation Act, 1996. By registering the Disputed Domain Name with the NIXI Accredited Registrar, the Respondent gave its consent to the resolution of the domain name disputes pursuant to the IN Dispute Resolution Policy and Rules framed thereunder. Similarly, by its letter dated 3 August 2017 and accompanying Complaint, Complainant gave its consent to the arbitration of this dispute.
7. In accordance with Rules 2(a) and 4(a), NIXI formally notified Respondent of the Complaint and appointed Advocate Harshavardhan Sancheti as the Sole Arbitrator for adjudicating upon the dispute in accordance with the Arbitration and Conciliation Act, 1996 and the Rules framed thereunder, INDRP Policy and Rules framed thereunder. The Arbitrator submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by NIXI. On 25<sup>th</sup> August 2017 this Tribunal was constituted.
8. On behalf of the Respondent Mr Dirk Kirschenowski of Terra Petra GmbH filed a Reply on 2<sup>nd</sup> September 2017. The Complainant filed a Rejoinder on 8<sup>th</sup> September 2017. The Respondent thereafter filed a further response on 14<sup>th</sup> September 2017.

9. The Complainant sought leave from the Tribunal and filed further written submissions on 26<sup>th</sup> September 2017. The Respondent was provided with an opportunity to provide a final written submission but declined to do so.
10. In light of the four separate rounds of pleadings and the extensive nature of the submissions filed by the parties, the Tribunal has exercised its discretion under Rule 5(c) of the Rules to extend the mandate of the Tribunal by two weeks to do complete justice to the parties' respective contentions.
11. Both the parties have been granted opportunity to place evidence in support of their case as chosen by them. The documents and evidence placed before the Tribunal have been admitted and considered in the arbitral proceedings in accordance to the Arbitration and Conciliation Act 1996. No in person hearing has been requested by the parties or considered necessary by the Tribunal.

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

12. The Complainant, "FDC Limited" has been in the pharmaceutical business in India since 1936, first as a partnership and then underwent incorporated in 1940 as a private limited company under the name Fair Deal Corporation Private Limited. The company subsequently went through two name changes, first in 1986 to FDC Private Limited, and then to FDC Limited in 1988 as it became a deemed public company under the provisions of Section 43A (1-A) of the Companies Act, 1956.
13. The Complainant was originally in the business of importing pharmaceutical dosage forms, specialized infant foods and surgical goods. It subsequently developed into a substantial presence, expanding into a range of pharmaceutical products, manufacturing generic medicine and also undertaking research at facilities in various locations in India. It had an approximate annual turnover of 1046 INR crores in 2015-6.
14. In addition to its operations in India, the Complainant also has subsidiaries in the United Kingdom, FDC International Limited and FDC Pharma, based in Southampton. FDC International and FDC Pharma market generics in their livery across the European Union. The Complainant owns the domain fdcindia.com since the year 2000.
15. The Respondent is a company founded in 2005 as a sole proprietorship and incorporated in 2012 in the City of Potsdam, Germany. The managing director is Dirk Krischenowski. It's main purpose is to develop and sell various soil and fertilizer products to the public in the European Union only. It markets itself as a frontrunner in innovative soil substrates and products. The



Respondent owns various domain names to cover its past, present and future products.

**5. The Dispute**

16. The Complainant alleges:

- (1) The Disputed Domain Name is identical or confusingly similar to a trade mark in which the Complainant has statutory/common law rights.
- (2) The Respondent has no rights or legitimate interests in respect of the disputed domain name.
- (3) The disputed Domain Name has been registered/being used in Bad Faith.

17. Respondent denies these allegations and accuses the Complainant of reverse domain name hijacking.

**6. Parties Contentions**

18. The Complainant contends that it has secured various registrations for the trade mark FDC, and variations thereof in India, and that the name and the trade mark FDC qualifies as a well-known mark and is protectable as such under the provisions of the Trade Marks Act, 1999. The Domain Name completely incorporates the Complainant's registered trade mark FDC, and as such the Domain Name is bound to cause confusion and deception in the minds of the public that the Respondent has some connection, association or affiliation with the Complainant. It relies upon paragraph 4(i) of the INDRP, as sufficient basis to apply for transfer of the Domain Name from the Respondent to the Complainant.

19. Complainant also argues that Respondent has no rights or legitimate interests in the Domain Name as the Domain Name has been placed on sale. Moreover, since the Domain Name is not being used in connection with a bona fide offering of goods and services in accordance with paragraph 7(i) of the JIN Policy, Respondent cannot assert in such circumstances that it is within its rights to use the Domain Name. Further, Complainant rejects the notion that Respondent 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 within the meaning of paragraph 7(iii) of the INDRP.

20. Finally, Complainant argues that Respondent's decision to incorporate the domain name FDC.IN after Complainant had registered FDC as a trade mark as well as company name, and decision to list the captioned domain name for sale constitute bad faith within the meaning of paragraph 6(i) of the INDRP Policy. Further, Respondent is intentionally preventing Complainant from



registering the Domain Name and intentionally attempt to attract, for commercial gain, internet users to its website by creating a likelihood of confusion with the Complainant's trade mark FDC in accordance with paragraph 6(iii) of the INDRP.

21. Respondent on the other hand states that, until 2015, it offered a product called Fluor and Calcium which it implies it marketed under the initials FDC but ended the offering due to lack of demand. Since 2016, it has been offering the domain FDC.IN for sale. It states that it had clarified that FDC is a generic term which could be used for many purposes, and has identified a number of other purposes which the initials replicate. It notes that the sales website holds open the option to the Complainant to make an offer to purchase the concerned domain name, and that the listed price is 3000 euros, with a minimum offer available of 1000 euros, which is "not an outrageous amount" for a generic 3 letter domain name.
22. Respondent accepts that the domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights. However it states that the registrant has been the owner of the domain name for more than 10 years and has offered an equal named product in the past. It states that the domain name was registered and used in good faith. It also states that it has rights or legitimate interests in the domain name, because it used the domain name or a name corresponding to the domain name for a good faith offering of services. It points to the absence of advertising on the website, as well as the general name recognition enjoyed by Terra Preta GMBH as evidence of its good faith.
23. Finally, Respondent criticizes Complainant for failing to register other relevant domain name as well a top level domain name as evidence that Terra Preta is not preventing FDC from being present on the Internet in a variety of alternative forms. In its submission of 14 September 2017, it has criticized the Complainant for engaging in "Reverse Domain Name Hijacking" by making a cybersquatting claim against a domain name's rightful owner. It argues that owning generic domain names is not an argument to justify allegations of bad faith. To the Complainant's contention that it owns a large number of generic domain names, it points to the fact it has registered trademarks for those names in Germany, including FDC.

## **7. Discussion and Findings**

24. The INDRP requires any complaint to satisfy the premises set out in paragraph 4 (i) to (iii):

- (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 interests in respect of the domain name;
- (iii) the Registrant's domain name has been registered or is being used in bad faith.

25. It is common ground between both parties that the Registrant's domain name is identical to a name, trademark or service mark in which the Complainant has rights. This is the position alleged at para.21 of the Complaint and this is the position of the Respondent at p.5 of its submission of 2 September 2017 whereby it states, "Yes, I agree to this" to the claim that the Registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has a right. Accordingly the first element of the test to be established in these proceedings is proved by admission of both parties.

26. The second element that must be satisfied by Complainant, is that the Respondent has no rights or legitimate interests in respect of the domain name. This requirement is a reflection of the WIPO Final Report that the scope of the procedure be confined to disputes between a Complainant with trade marks and a respondent with no rights or interests in the domain name.<sup>1</sup> The report concluded:

The scope of the procedure is limited so that it is available only in respect of deliberate, bad faith, abusive, domain name registrations or "cybersquatting" and is not applicable to disputes between parties with competing rights acting in good faith.

27. It may be brought onto the record immediately in these proceedings that the Complainant has statutory and common law rights in the mark "FDC". This interest is a direct reflection of their brand name and is protected by appropriate trademarks under Indian law and a wealth of evidence submitted in these proceedings.

28. In this regard, the real question that falls to be decided under this limb of the analysis is whether the Registrant *has any rights or legitimate interests in respect of the domain name*.

29. The consistent pattern in the UDRP jurisprudence, as well as arbitral awards under INDRP has been to accept that once a Complainant has made a *prima facie* case that a Respondent lacks legitimate interest or right, there is no

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<sup>1</sup> World Intellectual Property Organization (WIPO), *The Management of Internet Names and Addresses: Intellectual Property Issues*, Report of the WIPO Internet Domain Name Process (30 Apr 1999), available at <http://www.icann.org/amc/en/processes/process1/report>, paragraph 135.

corresponding requirement upon the Complainant to prove a negative. Instead the burden shifts to the Respondent to prove its right or legitimate interest in the domain name.<sup>2</sup>

30. The Respondent claims that it has an equally legitimate right to use the domain name. It claims that it registered the domain name on 16 February, 2005 and continued to offer a product until 2015, well before any notice of dispute thus demonstrating its good faith. Although Respondent does not expressly invoke the provision, it is clear that it intends to rely upon para. 7(i) of the INDRP, which provides as follows:

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

31. The question that arises before the Tribunal is whether the Respondent has demonstrated "use or demonstrable use" of the domain name with a bona fide offering of goods or services.

32. The UDRP jurisprudence establishes clearly that mere assertion of such use does not suffice. For example in *World Wrestling Federation Entertainment, Inc v Ringside Collectibles*<sup>3</sup>, the panel stated:

Respondents seeking to show preparations to make a legitimate use must give Panels some evidence; acceptance evidence may include business plans or documented expenses, but will of course vary with the nature of the use and the particulars of the domain name...the failure to present any credible evidence of demonstrable preparations to offer auction services is fatal to Respondent's claim of a legitimate interest in domain names.

33. The Tribunal remains in a state of uncertainty as to whether or not the Respondent ever marketed a product with the initials ("FDC"). It notes the Complainant's allegation that "Fluor and Calcium" does not abbreviate into the letters "FDC" in English, and there is no explanation for this abbreviation in German either from the Respondent. Ultimately, it has not been necessary for the Tribunal to decide the question.

34. It is sufficient for the Tribunal to observe that the Respondent has failed to produce any evidence that it marketed its product "Fluor and Calcium" through the domain name or that there was any connection between the domain name and its business during 2005 to 2015. There is also no evidence that the Respondent ever made any preparations or attempts to use the domain name FDC.IN for any purpose relating to marketing any product. The Tribunal can only conclude that no such evidence exists.

<sup>2</sup> *Croatia Airlines d d v Modern Empire Internet Ltd*, WIPO Case No D2003-0455 (21 August 2003); See also *Slickdeals LLC v. Srujan Kumar*, INDRP/907.

<sup>3</sup> WIPO Case No D2000-1306 (24 Jan. 2001)



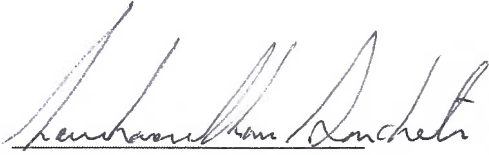
35. Accordingly, the Tribunal concludes that the Registrant has no legitimate right or interest in the domain name. The Tribunal must also draw this inference from the suggestion from the Respondent that it is open to the Complainant to purchase the domain name in name question. This suggestion undermines any claim that the Respondent might make that the domain name was of utility to the Respondent for the purposes of any bona fide offering of goods or services.
36. The final prong of the test set out in para. 4 of the INDRP is for the Complainant to show that the domain name has been registered or is being used in bad faith.
37. In light of the fact that the above domain name is currently for sale for €3000, and Respondent has directly invited Complainant to purchase the domain name directly, it is relatively straightforward for the Tribunal to conclude, in accordance with para.6(i) of the INDRP that the Respondent had registered or acquired the domain name for the purpose of selling or renting the domain name to the Complainant.
38. It has been brought to the Tribunal's notice by the Complainant that the Respondent has also registered the domain names GSK.IN; LIC.IN; NSE.IN; PUMA.IN; UCO.IN; EIH.IN; SAIC.IN; KDL.IN; KEC.IN; SSL.IN; BSL.IN; PSL.IN; CREDIT-CARD.IN; GTL.IN; GTN.IN; HARMONY.IN; LILLY.IN; SCI.IN and SPT.IN.
39. The Tribunal can only infer from this that the Respondent has "engaged in a pattern of such conduct" since the domain names in question relate to well established and well-known brands, whether in India or globally. For the purpose of this dispute, this is further evidence under para.6(ii) of the INDRP of registration and use of a domain name in bad faith.
40. In short, Complainant's case is amply made out in these proceedings. The continued use of the domain name FDC.IN by the Respondent is a violation of the INDRP.

### Decision

1. In light of the circumstances and facts discussed above, the Tribunal decides "the disputed domain name is identical and confusingly similar to the registered trademarks and also the trade name of the Complainant in which Complainant has rights and the Respondent has no right or legitimate interests in respect of the Domain Name and the Respondent's Domain Name has been registered and is being used in bad faith."



2. The Tribunal orders that the Domain Name FDC.IN be transferred from Respondent to the Complainant.
3. Costs follow the outcome. The Respondent to pay the cost of the proceedings at INR rupees fifty thousand only.



Harshavardhan Sancheti  
Sole Arbitrator, NIXI, India  
06.11.2017  
Place: Kolkata