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INDIA NON JUDICIAL Government of Uttar Pradesh

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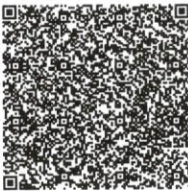
Signature.....

ACC Name: RAHUL VERMA, ACC Code: UP14003004

ACC Add: Sub-Registrar, Noida, Mob. 9810434882

License No.: 115/10, Tehsil & Distt.- Dadri, G. B. Nagar, UP

Certificate No.	: IN-UP17271417303052S
Certificate Issued Date	: 18-Dec-2020 03:06 PM
Account Reference	: NEWIMPACC (SV)/ up14003004/ NOIDA/ UP-GBN
Unique Doc. Reference	: SUBIN-UPUP1400300427972047711616S
Purchased by	: PUNITA BHARGAVA
Description of Document	: Article 12 Award
Property Description	: Not Applicable
Consideration Price (Rs.)	:
First Party	: PUNITA BHARGAVA
Second Party	: Not Applicable
Stamp Duty Paid By	: PUNITA BHARGAVA
Stamp Duty Amount(Rs.)	: 100 (One Hundred only)



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BEFORE THE NATIONAL INTERNET EXCHANGE OF INDIA
.IN REGISTRY

Arbitral Award in Case No. 1290
Ms. Punita Bhargava, Sole Arbitrator
Disputed domain name: <nikeindia.in>

In the matter of

NIKE INNOVATE C.V.

One Bowerman Drive

Beaverton, Oregon

97005 6453

United States of America

... Complainant

v.

Nike India

B-75 South Avenue

Delhi 110084

... Respondent

1. The Parties

The Complainant in this proceeding is Nike Innovate C.V. of the address One Bowerman Drive, Beaverton, Oregon, 97005 6453 United States of America and is represented by Joel McDonald of Stobbs of Building 1000, Cambridge Research Park, Cambridge, CB25 9PD, United Kingdom. The Respondent in this proceeding is Nike India of the address B-75 South Avenue, Delhi 110084, India.

2. Disputed Domain Name and Registrar

This dispute concerns the domain name <NIKEINDIA.IN> (the 'disputed domain name') registered on December 28, 2019. The Registrar with which the disputed domain name is registered is GoDaddy.com LLC.

3. Procedural History

The arbitration proceeding is in accordance with the .IN Domain Name Dispute Resolution Policy (Policy), adopted by the National Internet Exchange of India (NIXI).

NIXI vide its email dated November 2, 2020 requested availability of Ms. Punita Bhargava to act as the Sole Arbitrator in the matter. The Arbitrator indicated her availability and submitted the Statement of Acceptance and Declaration of Impartiality and Independence in compliance with the .INDRP Rules of Procedure (Rules) on November 3, 2020.

In accordance with Rules, NIXI vide its email of November 5, 2020 appointed the Arbitrator and also notified the Respondent of the Complaint. The Arbitrator sent an

email to the Respondent on November 6, 2020 informing it of the commencement of the proceeding and providing it time of two weeks to file its reply.

No reply was received from the Respondent within the time prescribed and so the Arbitrator sent an email to all concerned parties on December 8, 2020 that the Arbitrator would proceed to pass its award ex-parte taking into consideration all the material presented before it.

The language of this proceeding is English.

4. Background of the Complainant and its rights in the NIKE brand as submitted by it

The Complainant is the brand owner and a subsidiary of Nike, Inc., and carries on an established business in respect of a large variety of goods, including footwear, clothing, headgear, bags, eyewear, watches and other electronic product and sports equipment and is the world's leading manufacturer of sports shoes and sports apparel.

The Complainant, including through its authorised partners, operates retail stores and sells products under the NIKE brand in many cities, including but not limited to Atlanta, Boston, Chicago, Denver, Honolulu, Los Angeles, Las Vegas, Miami, New York, Orange County, Portland, San Francisco, Seattle in the United States; Rio de Janeiro and Sao Paulo in Brazil; Berlin, Munich and Frankfurt in Germany; London and Manchester in England; Paris and Marseille in France; Rome and Milan in Italy; Madrid and Barcelona in Spain; Amsterdam in Holland; Copenhagen in Denmark; Prague in Czech Republic; Moscow in Russia; Beijing and Shanghai in China; Hong Kong; Tokyo in Japan; Seoul in Korea; Bangkok in Thailand; Jakarta in Indonesia; Sydney in Australia; Mexico City in Mexico.

The NIKE brand was adopted by the Complainant in 1971 and has been registered and used by it in many countries of the world. The list of registrations for the NIKE brand around the world is provided as Annex 4 of the Complaint.

The Complainant's NIKE brand is among the most widely recognized and popular brands in the world. The NIKE brand has consistently ranked amongst the highest valued brands in the world for many years in a row by Interbrands's annual publication for the 100 'Best Global Brands'. In BrandFinance's annual report, 'Global 500' the NIKE brand has consistently ranked among the most valuable brands. The NIKE brand is widely regarded and consistently ranked as one of the "coolest" and most popular apparel and lifestyle brands among consumers

internationally. The Complainant has also consistently appeared in Fortune Magazine's annual ranking of "The World's Most Admired Companies" and continues to appear in FastCompany's annual ranking of "The World's Most Innovative Companies".

The Complainant's total sales figures for sale of products under NIKE brands by all NIKE companies, including affiliates throughout the world from fiscal year 1979 through fiscal year 2018 is in excess of US\$ 485,490,000,000.

The Complainant's total advertising expenditures of NIKE companies, including affiliates throughout the world from fiscal year 1979 through fiscal year 2018 is in excess of US\$ 52,061,000,000. Every year large sums of money are spent in advertising the products sold under the NIKE brand for which advertisements appear in magazines having international circulation such as Sports Illustrated, Time, Newsweek and many others. The NIKE brand is displayed by NIKE-sponsored athletes and teams who compete in major sporting events including the FIFA World Cup, the Copa America, the CONCACAF Gold Cup, the Olympics, The Wimbledon Tennis Championships, The French Open, The U.S. Open, The British Open, the MLB World Series, the NFL Super Bowl, the NHL Stanley Cup, the Tour de France, major golf championships, and major international basketball, baseball, hockey, and football tournaments. All of these events are watched by millions of viewers around the world on television. Products sold under the NIKE brand are known to sports lovers around the world and it has a long history of having numerous sponsorships deals with globally well-known, elite athletes who have participated in and appeared at high profile sporting events with clothing and/or footwear prominently displaying the NIKE brand.

Based on the above, the Complainant submits its NIKE brand deemed famous and well-known throughout the world.

5. Respondent's default

Despite notice of the present proceeding in terms of the Rules and an opportunity to respond, no response has been received from the Respondent in this matter by the Arbitrator.

6. Grounds for Complaint

The Complainant contends that the disputed domain name is confusingly similar to its NIKE brand as it wholly incorporates its NIKE brand in its entirety and couples it with the word INDIA which refers to a section of one of the Complainant's core markets. Therefore, this domain is identical / highly similar to the Complainant's NIKE brand.

The Complainant also states that it has been successful in a number of other domain complaints, including under the Policy, which relate to domain names including the word NIKE, which act to support that the Complainant has a significant portfolio of trade mark applications and registrations, a reputation in the NIKE brand and that a likelihood of confusion exists in relation to the disputed domain name. In INDRP/804 (NIKE.CO.IN) it was held "The complainants have statutory and proprietary rights over the trade mark NIKE per se and along with prefixes and suffixes". The Complainant also relies on several other decisions which hold that NIKE is a well-known mark with strong reputation.

The Complainant contends that the Respondent has no rights or legitimate interest in respect of the disputed domain name. The Respondent is identified as Nike India but it has no connection with the Complainant or its owner Nike, Inc. This is supported by the use of a Gmail account, nikeindiashoes@gmail.com, for their e-mail address. Such practice is not adopted by Nike, with all Nike e-mail addresses of the Complainant using the nike.com domain string. Further, the Respondent has no rights in relation to the NIKE brand elements which form part of the domain name NIKEINIDA.IN. The Complainant contends that the combination of the NIKE brand and the term "INDIA" creates the false impression that the domain name is being used by the Respondent for the sale of genuine and authorised products bearing the Complainant's NIKE brand in India. Bearing in mind the reputation of the NIKE brand and the Complainant's operations in a wide range of activities since as early as 1971, there is no believable or realistic reason for the registration or use of the disputed domain name other than to take advantage of the Complainant's rights. The Complainant contends that the Respondent's registration of the disputed domain name despite the Complainant's wide-spread reputation in the NIKE brand demonstrates that the Respondent did not legitimately register the domain name. Further, the disputed domain name is not being used in relation to a bona fide offering of goods and services and the Respondent is not making legitimate or fair use of the disputed domain name. Even if the domain name was being used to sell legitimate goods, the Respondent is not using the disputed domain name in connection with a 'bona fide' offering of goods. The fact that the sites do not accurately disclose the Respondent's relationship (or lack thereof) with the Complainant, means consumers may believe the Complainant owns the disputed domain name.

Finally, the Complainant contends that the registration of the disputed domain name is an obvious example of a bad faith registration in accordance with the Policy. It submits that the combination of the Complainant's NIKE brand with the term INDIA will cause a false association between the disputed domain name and the

Complainant's NIKE brand and will lead the average Internet user to believe that the disputed domain name is owned by the Complainant and could relate to the sale of genuine NIKE goods i.e., when consumers see the disputed domain name, they will believe that the Complainant owns the disputed domain name. The Complainant submits that although the disputed domain name does not resolve to an active website, the doctrine of passive holding shows that a finding of use in bad faith can be found when no website appears at the domain name. This is especially true when the domain owner has taken steps to conceal its identity. The Respondent in the present case has not given any details as to its identity. The Complainant has a legitimate interest in the disputed domain name and the registration of the disputed domain name is evidence of the Respondent's intention to disrupt the Complainant's business. The Complainant submits also that the registration of a domain name that is confusingly similar to a trade mark by an entity that has no relationship to that mark is sufficient in itself for a finding of bad faith. It submits that given the level of fame of the Complainant's NIKE brand and the fact that the disputed domain name contains the identical NIKE element, is clear evidence of the Respondent's bad faith. The Complainant relies on the Policy to submit that the Respondent has registered the disputed domain name to prevent the Complainant from owning the same or to force the Complainant to pay for its own intellectual property and that there is no way in which the Respondent could use the disputed domain name without violating the Policy.

7. Discussion and Findings

The Arbitrator has reviewed the Complaint and the Annexures filed by the Complainant as well as the decisions cited by the Complainant. The Arbitral Tribunal has been properly constituted.

The Policy requires that the Complainant must establish three elements *viz.* (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; and (iii) the Registrant's domain name has been registered or is being used in bad faith. These are discussed hereunder:

(i) Identical or Confusingly Similar

As regards this the first element, the Complainant has established that it has rights in the NIKE brand. The Complainant has been using the NIKE brand since 1971 and products under the NIKE brand are sold world over. The NIKE brand is also registered in numerous countries around the world as also in India in various classes under registration nos. 2588974, 1211922, 1240800, 1058160, 1058161, 1058162, 566685, 526647, 1418321, 349453, 346173,

453268, 453267. NIKE is also regarded as and has been held to be a well-known and famous mark and is one of the most valued brands in the world. The Complainant has also enforced its rights in the NIKE brand and has been successful in seeking transfer or cancellation of domain names registered by others which incorporated the NIKE designation.

There is no dispute as to the Complainant's ownership of its registered and well-known trademark NIKE.

The Arbitrator notes that the dominant part of the disputed domain name is NIKE i.e., the disputed domain name wholly incorporates the Complainant's NIKE brand and this is also the distinctive part of the same. The Respondent has simply taken the Complainant's NIKE brand and has combined it with INDIA, a geographic descriptor, and this is not sufficient to escape a finding of confusing similarity under the first element. INDIA does not serve to distinguish the disputed domain name from the Complainant's NIKE brand in any way. Rather, INDIA is indicative of the Complainant's business here and increases the element of confusion. It has been routinely held that the mere addition of a descriptive term or a non-significant element does not prevent a finding of confusing similarity. See Starbucks Corporation v. Registration Private, Domains by Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico, WIPO Case No. D2019-1991. It has also been held that when a domain name wholly incorporates a complainant's registered mark, this is sufficient to establish identity or confusing similarity. See F. Hoffmann-La Roche AG v. Jason Barnes, ecnopt, WIPO Case No. D2015-1305, Swarovski Aktiengesellschaft v. mei xudong, WIPO Case No. D2013-0150, Wal-Mart Stores, Inc. v. Domains by Proxy, LLC / UFCW International Union, WIPO Case No. D2013-1304.

It is a well settled legal position that for the purpose of comparing a trademark with a disputed domain name, the country code top-level domain (ccTLD) can be excluded.

The Arbitrator accordingly finds that the first element is satisfied and that the disputed domain name is confusingly similar to the Complainant's registered trademark.

(ii) Rights or Legitimate Interests

As regards the second element, the Complainant must establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name. With respect to this requirement, a complainant is generally

required to make a prima facie case that a respondent lacks rights or legitimate interests and once such prima facie case is made, the burden of proof shifts to the respondent to come forward with evidence demonstrating rights or legitimate interests in the disputed domain name. Paragraph 6 of the Policy contains a non-exhaustive list of the circumstances which, if found by the Panel to be proved, shall demonstrate the respondent's rights or legitimate interests to the disputed domain name.

Based on the undisputed contentions made by the Complainant as stated above, it has made a prima facie case that none of these circumstances are found in the case at hand and therefore, the Respondent lacks rights or legitimate interests in the disputed domain name. The mere registration of a domain name does not give rise to a 'legitimate interest'. It is also been held that if the respondent fails to come forward with relevant evidence, the Complainant is deemed to have satisfied the second element. See Volkswagen AG v. Nowack Auto und Sport – Oliver Nowack WIPO Case No. D2015-0070 and OSRAM GmbH. v. Mohammed Rafi/Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org WIPO Case No. D2015-1149.

Since the Respondent in the present case has failed to come forward, the Arbitrator finds that the Respondent has no rights or legitimate interests in the disputed domain name.

(iii) Registered or Used in Bad Faith

As regards the third element of bad faith, based on the contentions of the Complainant describing its extensive registrations of the NIKE brand, long standing use thereof and associated business, the Arbitrator accepts that the NIKE brand is indeed well-known throughout the world and exclusively associated with the Complainant. It's rights significantly predate the registration of the disputed domain name by the Respondent. Therefore, it is the view of the Arbitrator that the Respondent was clearly aware of the Complainant's NIKE brand at the time of registration of the disputed domain name and has sought to create a misleading impression of association with the Complainant in its choice of the disputed domain name. This supports a finding of bad faith. See Starbucks Corporation, supra. The Arbitrator accepts the Complainant's contention that an average Internet user will believe that the disputed domain name is owned by the Complainant and relates to sale of its goods in India; such users may end up looking for a website to which the disputed domain name resolves. This cannot confer any legitimacy to the Respondent and is indicative of bad faith on part of the Respondent. Further, the Arbitrator accepts that the disputed domain name is not being used in

relation to a bona fide offering of goods and services and the Respondent is not making legitimate or fair use of the disputed domain name. Even if the domain name was being used to sell genuine goods, the Respondent is not using the disputed domain name in connection with a bona fide offering of goods. In addition, the disputed domain name is held passively and such use does not prevent a finding of bad faith. See *Volkswagon AG, supra*. The Arbitrator also accepts that the Respondent has registered the disputed domain name to prevent the Complainant from owning the same or to compel the Complainant to pay for it and that there is no way in which the Respondent could use the disputed domain name without violating the Policy. Thus, the Arbitrator concludes that the Respondent's conduct constitutes bad faith registration or use of the disputed domain name within the meaning of the Policy.

Accordingly, the Arbitrator finds that the Complainant has established all three elements as required by the Policy.

8. **Decision**

For all the foregoing reasons, the Complaint is allowed and it is hereby ordered in accordance with paragraph 10 of the Policy that the disputed domain name be transferred to the Complainant. There is no order as to costs.

This award has been passed within the statutory deadline of 60 days from the date of commencement of arbitration proceeding.



Punita Bhargava

Sole Arbitrator

Date: December 28, 2020