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Certificate No.

Certificate Issued Date

Account Reference

Unique Doc. Reference

Purchased by

Description of Document

Property Description

Consideration Price (Rs.)

First Party

Second Party

Stamp Duty Paid By

Stamp Duty Amount(Rs.)

: IN-DL74682758506240T
: 20-Apr-2021 09:55 AM
: SELFPRINT (PU)/ dl-sell/ NEHRU/ DL-DLH
: SUBIN-DL DL SELF49819004489025T
: IRA LAW PREETIKA KASHYAP
: Article 12 Award
: ARBITRATION AWARD
: 0
: (Zero)
: BINNY KALRA
: NONE
: BINNY KALRA
: 100
: (One Hundred only)

सत्यमेव जयते



SELF PRINTED CERTIFICATE
TO BE VERIFIED BY THE RECIPIENT

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Binny Kalra

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**ARBITRATION AWARD
.IN REGISTRY**

(C/O NATIONAL INTERNET EXCHANGE OF India)

Before the Sole Arbitrator, Binny Kalra

Disputed domain name <**VELCROENGINEERING.IN**>

In the matter of:

Velcro BVBA
Industrielaan 16
9800, Deinze
Belgium

Complainant

v.

Velcro Engineering India Private Limited
63, Swami Para
Budhana Gate
Meerut - 250001
India

Respondent

INDRP Case No: 1357

1. The Parties:

The Complainant is Velcro BVBA, a company incorporated under the laws of Belgium, who is represented in these proceedings by M/s Sujata Chaudhri IP Attorneys, 2106 Express Trade Towers 2, 1st Floor, B-36, Sector 132, Expressway, NOIDA, Uttar Pradesh 201301, India. The Respondent is Velcro Engineering India Private Limited, a company incorporated in India, who is represented by Mr Sudhir Soam identified as the admin contact in the WHOIS data for the subject domain name of the Respondent.

2. The domain name, Registrar, and Policy:

The disputed domain name is www.velcroengineering.in (hereinafter referred to as the "**Disputed Domain Name**"). The Registrar for the Disputed Domain Name is ZNet Technologies Private Limited having its address at D-10/52, Opp. Chitrakoot



Stadium, Chitrakoot, Vaishali Nagar, Jaipur – 21, India. The present arbitration is being conducted in accordance with the Arbitration and Conciliation Act, 1996, the .IN Domain Name Dispute Resolution Policy (“**Policy**”) and the INDRP Rules of Procedure (“**Rules**”).

3. Procedural history:

- 9 March 2021: Statement of acceptance along with a declaration of impartiality and independence was sent to the .IN Registry
- 10 March 2021: The .IN Registry transmitted information of appointment of the arbitrator and circulated the complaint and its annexures to the parties.
- 10 March 2021: The Complainant submitted updated annexures i.e. the complete WHOIS details and the INDRP Rules of Procedure and Policy documents as required by NIXI
- 10 March 2021: Notice of commencement of arbitration proceedings was sent by the Panel to the parties and a period of 21 days, until 31 March, 2021, was given to the Respondent to submit a statement of defense
- 31 March 2021: The Respondent sent an email communication stating that it did not wish to contest the domain name dispute and requested 2 weeks’ time to transfer its mail data from the disputed domain name.
- 1 April 2021: The Panel wrote to the Complainant to inquire if it was agreeable to a settlement of the domain name dispute in view of the communication dated 31 March 2021 from the Respondent.
- 7 April 2021: The Complainant responded to the Panel’s communication of 1 April 2021 and confirmed its



acceptance of a settlement and requested that after completion of the two weeks' period sought by the Respondent, an award be issued that "the disputed domain name and all rights thereto, be transferred to the Complainant's subsidiary, Velcro USA Inc."

The award was accordingly reserved.

4. Complainant's case:

The exhaustive submissions of the Complainant in its complaint are paraphrased and summarized below. The Complainant claims the following:

- i. It has a global business which is carried on through subsidiary companies, such as Velcro USA Inc., Velcro Canada Inc., Velcro de Mexico S.A de C.V., Velcro Europe S.A., Velcro Australia Pty. Ltd., Velcro (China) Fastening Systems Company Limited, and Velcro Hong Kong Ltd. Incorporation, and unless the context otherwise requires, references to the Complainant will include the Complainant's subsidiaries, its predecessors-in-interest, and its affiliated companies. The details of some of these companies have been filed by the Complainant as Annexure-5.
- ii. It is an industry leader in hook and loop fasteners and a global organization with a presence in more than 40 countries around the world, and approximately 2500 employees worldwide.
- iii. The trademark VELCRO was coined by the founder of the Complainant who was also the inventor of the first hook and loop fastener in the 1940s. The said word is derived from the French words "velours", meaning velvet, and "crochet", meaning hook and the word VELCRO has no meaning in English, Hindi, or any Indian vernacular languages. The Complainant relies on Annexure 2 as evidence of its adoption of the mark VELCRO.



- iv. VELCRO has been used as part of a corporate name since 1952 when a Swiss corporation named Velcro SA was established. The Complainant first used VELCRO® as a trademark in the year 1958 and continues to use VELCRO® and marks that incorporate VELCRO® as trademarks for its hook and loop fasteners, collectively referred to as the "Complainant's VELCRO® Marks" in the complaint.
- v. It manufactures and sells over 35,000 fasteners that are also used in the engineering industry. The worldwide revenue figures attributable to the Complainant's VELCRO® Marks in 2010 were approximately INR 25,00,00,00,000 and in 2018, these figures increased to over INR 27,00,00,00,000.
- vi. The use of the Complainant's VELCRO® Marks is made on its web site at www.velcro.com, on social media and in promotional materials. The Complainant relies on Annexure 3 as evidence of its use of the VELCRO® Marks.
- vii. The Complainant registered the domain name VELCRO.COM in the year 1994 and has an active website which displays the Complainant's VELCRO® Marks. The corresponding documents are at Annexure-6. A printout showing the statistics of unique visitors to the web site at www.velcro.com for a 6 month period between July 2020 to December 2020 is at Annexure-7. The Complainant also owns country-code top level domain names such as VELCRO.CO.IN, VELCRO.IN, VELCRO.COM.BR, VELCRO.COM.CN, VELCRO.FR, VELCRO.DE, VELCRO.IT and VELCRO.CO.UK, the last mentioned having been registered in 1996. The corresponding documents are at Annexures 8 and 9.
- viii. Goods sold under the Complainant's VELCRO® Marks have been promoted and advertised in publications, including, well-known Indian newspapers, and on social media. Some samples of such promotion are at Annexure-10. The Complainant's VELCRO® Marks have also received extensive media coverage in publications globally, including in India, which have created an exclusive



association in the minds of the public between the VELCRO® Marks and the Complainant. Samples of such media coverage are at Annexure-11.

- ix. The Complainant has received numerous awards for its VELCRO®-branded goods and evidence relating to some of these awards is filed as Annexure-12.
- x. The Complainant has commercial presence in India as consumers in India have purchased goods bearing the Complainant's VELCRO® Marks. The sales figures for goods bearing the VELCRO® mark in India in the year 2019 exceeded INR 3,50,00,000. Evidence in the shape of invoice copies for sales in India are at Annexure-13.
- xi. The Complainant has over 200 registrations for the Complainant's VELCRO® Marks in over 150 countries, including India. Photocopies of the registration certificates or e-registers from various Trademark Offices are at Annexure-14.
- xii. In India, the Complainant owns registrations for the Complainant's VELCRO® Marks, including Registration Nos. 184852, 203742, 1114518, 1114519, 4124811, and 2009357. The Complainant's earliest registration for the VELCRO mark in India dates back to 1958. Copies of registration certificates issued by the Indian Trade Marks Registry along with some renewal certificates are at Annexure-15.
- xiii. The Complainant's VELCRO® Marks have a stellar reputation that has spilled over into India due to extensive and continuous use. In fact, the Complainant's VELCRO® Marks have acquired the status of well-known marks under Article 6bis of the Paris Convention.
- xiv. It has kept up enforcement efforts against unauthorized third-party usage of the Complainant's VELCRO® Marks and/or marks similar to the Complainant's VELCRO® Marks inter alia as domain names and has successfully obtained awards ordering the transfer of such domain names. Some awards granted in favour of the Complainant with the key findings are listed here:



- Velcro BVBA v. Velcro Engineering India Pvt. Ltd. (WIPO Case No. D2018-2937, WIPO, February 15, 2019), which was an award issued in a UDRP proceeding filed by the Complainant against the Respondent in 2019;
- Velcro Industries BVBA v. Monali Mohanty, Velcroelectricals (WIPO Case No. D2018-0635, WIPO, June 22, 2018) which held that since the respondent's company name was modeled on the Complainant's trademark without permission, the corresponding domain name could not be considered to be legitimate fair use;
- Velcro BVBA v. Vellcro Technologies Private Limited, an order dated 5 August 2019, in which the Hon'ble Delhi High Court held that the VELCRO mark is to be afforded protection against use of identical/ deceptively similar marks irrespective of the goods/services on or in relation to which such marks are used;
- Velcro Industries B.V. v. Velcro Technologies INDRP/858 (March 10, 2017) in which the award noted that the Complainant's VELCRO® Marks are well-known globally;
- Velcro BVBA v. Steven Jiang, D 2016-0714 (WIPO, June 13, 2016) in which it has been held that addition of a generic or descriptive term to a trademark in a domain name is insufficient, in itself, to avoid the finding of confusing similarity.

xv. The Respondent, Velcro Engineering India Private Limited, is the registrant of the Disputed Domain Name which was registered on April 25, 2019. The Disputed Domain Name resolves to an active web site on which the Respondent provides information about its goods and services. A screenshot of the same is at Annexure-18.

xvi. When the Complainant first learned of the Respondent around October 2018, the Respondent was using the VELCRO® Marks as part of its corporate name Velcro Engineering India Private Limited and as part of the domain name VELCROENGINEERING.COM. The Respondent was incorporated on July 17, 2018



under CIN U29308UP2018PTC106325 as per the relevant online records of the Ministry of Corporate Affairs at Annexure-17. There is a pending complaint before the Regional Director, Northern Region, filed by the Complainant for cancellation of the registration of the Respondent's corporate name.

xvii. In December 2018, the Complainant sent a cease and desist letter to the Respondent asking it to cease use of the VELCRO® Marks as part of its corporate name and transfer of the domain name. There was no response from the Respondent and on December 24, 2018, the Complainant filed a UDRP complaint against the domain name VELCROENGINEERING.COM before the WIPO Arbitration and Mediation Center.

xviii. On February 15, 2019, the WIPO Arbitration and Mediation Center passed an award ordering the transfer of the domain name VELCROENGINEERING.COM to the Complainant. Thus the Respondent is clearly aware of the Complainant's rights in the Complainant's VELCRO® Marks. Despite this, the Respondent has registered the disputed domain name VELCROENGINEERING.IN.

The Complainant has noted from the Respondent's email dated March 31, 2021 that the latter does not want to contest the matter and that the latter has purchased a new domain name and is in the process of transferring data to the new domain and that it has requested NIXI to not suspend the domain name VELCROENGINEERING.IN for a period of two (2) weeks in order to complete the transfer process. The Complainant has agreed to the two (2) weeks' period sought in the Respondent's email dated March 31, 2021 but requests that an award be issued after completion of the afore-mentioned two (2) weeks' period, so that the disputed domain name, VELCROENGINEERING.IN, and all rights thereto, are transferred to the Complainant's subsidiary, Velcro USA Inc.

5. Respondent's case:

The Respondent sent an email communication on 31 March 2021 stating "We don't want any conflict in this matter". The Respondent further stated that it had purchased a new domain and was in the process of retrieving its mail data from



this domain. For this reason the Respondent requested the Panel to give it 2 more weeks for domain suspension. Accordingly, there is no statement of defense submitted by the Respondent in this domain name dispute and the award is being passed on the basis of the settlement reached between the Parties after the Complainant confirmed its acceptance of the Respondent's willingness to surrender the Disputed Domain Name.

6. Legal grounds:

Under Paragraph 4 of the Policy, the Complainant must establish the following three elements to succeed:

- (a) the Disputed Domain Name is identical and/or confusingly similar to a name, trademark or service mark in which the Complainant has rights; and
- (b) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (c) the Disputed Domain Name has been registered or is being used in bad faith.

7. Discussion and findings:

The Panel has gone through the complaint and annexures submitted by the Complainant. The three elements that the Complainant must satisfy to succeed in the Domain Name Dispute are discussed below.

A. Whether the Disputed Domain Name is identical and/or confusingly similar to a name, trademark or service mark in which the Complainant has rights

The Disputed Domain Name is < VELCROENGINEERING.IN >. The Complainant has shown that it has rights in the VELCRO Marks by virtue of:



- i. registrations in India for the VELCRO® Marks under Nos. 184852 (Annexure 15, page 109), 1114518 (Annexure 15, page 110), and 2009357 (Annexure 15, page 111-112);
- ii. use by way of sales of products under the VELCRO Trademark in India (Annexure 13, pages 89-98);
- iii. operation of a website at www.velcro.com

The Panel accepts the Complainant's statement that VELCRO is an invented word with no known meaning in English or Indian languages. Trademark jurisprudence laid down over the years is clear that invented words are inherently distinctive and deserve a higher degree of protection. In *The Timken Company vs Timken Services Private Ltd.* [(2013) 15 PTC 568] the Hon'ble High Court of Delhi held :

"8.12. The defendant has not offered any plausible explanation for adopting the mark "Timken". The name "Timken" is neither parental name of defendant nor in any way connected with them. The word "Timken" does not appear in the dictionary. It cannot be a mere co-incidence that the defendant had adopted the same mark for their products which was registered in the name of the plaintiff and which have a worldwide market. As noticed earlier, the mark "Timken" is attributable to the surname of plaintiff's founder, Henry Timken. The trade mark and trade name "Timken" has become distinctive of the plaintiff's goods as a result of substantially exclusive and continuous use in commerce since 1899. It appears that defendant's desire to market their goods under the name of mark "Timken" is to trade upon and encash on the name, fame, reputation, image and goodwill acquired by the plaintiff."

The distinctive nature of the Complainant's trademark VELCRO together with the statutory protection granted to the mark in India and the Complainant's common law rights in the said trademark of which note has been taken in preceding awards and decisions in its favour, confirm that the Complainant has strong and enforceable rights in the trademark.

It is evident that the Complainant's trademark VELCRO is wholly contained in the Disputed Domain Name whereas the word 'engineering' suffixed to VELCRO in the



Disputed Domain Name is merely descriptive with no memorable attribute and this descriptor is liable to be ignored in determining the similarity between the Complainant's VELCRO Marks and the Disputed Domain Name. The Disputed Domain Name is thus identical to the VELCRO Trademark for all intents and purposes.

For the above reasons, the Panel finds that the Disputed Domain Name is identical to the VELCRO® Marks in which the Complainant has rights.

B. Whether the Respondent has any rights or legitimate interests in respect of the Disputed Domain Name

As noted earlier, the Respondent has not submitted a statement of defence and has voluntarily surrendered the Disputed Domain Name. The Respondent is therefore deemed to have admitted that it does not have defensible rights or any claim in respect of the Disputed Domain Name.

Even though the Respondent's corporate name includes the word "Velcro" it has not sought to defend or justify its adoption and registration of the Disputed Domain Name. The incorporation of the Respondent's company and the registration of the Disputed Domain Name are subsequent to the registration and use of the trademark VELCRO in India by the Complainant. The Panel accepts the Complainant's submission that in the absence of an explanation for adoption of the Disputed Domain Name and given the prior encounters between the Complainant and the Respondent, the fact that the VELCRO® mark is part of the Respondent's corporate name is insufficient to confer any rights or legitimate interest in the disputed domain name.

Therefore, the Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name.

C. Whether the Disputed Domain Name has been registered or is being used in bad faith



Section 3 of the INDRP clearly stipulates that by applying to register a domain name, or by asking a Registrar to maintain or renew a domain name registration, the Registrant thereby represents and warrants that:

- (a) the credentials furnished by the Registrant for registration of Domain Name are complete and accurate;
- (b) to the knowledge of registrant, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party;
- (c) the Registrant is not registering the domain name for an unlawful and malafide purpose; and
- (d) the Registrant will not knowingly use the domain name in violation or abuse of any applicable laws or regulations.”

The Respondent thus has an express duty of care which it did not exercise when it applied to register the Disputed Domain Name, and, specifically, it made misrepresentations in respect of Section 3(b), (c) and (d).

The Respondent also appears to have been put on strict notice by the Complainant in December 2018 about its statutory rights in the VELCRO Marks in India to which it did not pay heed.

Moreover, the fact that the Respondent was fully aware at the time of registering the Disputed Domain Name that there was already an award dated 15 February 2019 given by the WIPO Arbitration and Mediation Center ordering the transfer of an identical domain name registered by the Respondent, albeit with a .com extension, namely **velcroengineering.com** was sufficient reason and warning for the Respondent not to venture down the same path with a ccTLD extension.

In view of the factors discussed above, the Panel finds that the Disputed Domain Name has been registered and is being used in bad faith.

Decision:



For the reasons discussed above, the Panel finds that the Complainant has satisfied all three elements required under Paragraph 4 of the Policy to obtain the remedy of transfer of the Disputed Domain Name. Therefore, the Arbitrator directs that the Disputed Domain Name <VELCROENGINEERING.IN> be transferred to the Complainant.

Since the complaint is filed by Velcro BVBA as the Complainant and the remedy sought in point 8 of the complaint is that "the disputed domain name, VELCROENGINEERING.IN, and all rights thereto, be transferred to the Complainant", the Complainant's request in its communication dated 7 April 2021 that "the disputed domain name and all rights thereto, be transferred to the Complainant's subsidiary, Velcro USA Inc." cannot be allowed in this complaint as it will amount to an infirmity in the award.

Further, since the Respondent had voluntarily requested 2 weeks' time starting 31 March 2021 for suspension of the Disputed Domain Name which was accepted by the Complainant, this award is made in pursuance of Section 13(a) of the INDRP and the domain name transfer may be effected accordingly.

No order is made as to costs.

Signed:



(Binny Kalra)

Arbitrator

Date: 20 April, 2021