



INDIA NON JUDICIAL

Government of National Capital Territory of Delhi

e-Stamp

सत्यमेव जयते

Certificate No.

Issued in Lieu of

Certificate Issued Date

Account Reference

Unique Doc. Reference

Purchased by

Description of Document

Property Description

Consideration Price (Rs.)

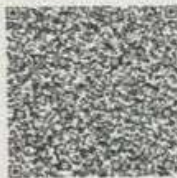
First Party

Second Party

Stamp Duty Paid By

Stamp Duty Amount(Rs.)

: IN-DL12407342073124T
 : IN-DL12394909536855T
 : 19-Aug-2021 11:15 AM
 : SELFPRINT (PU)/ dt-self/ NEHRU/ DL-DLH
 : SUBIN-DLDL-SELF21944748352932T
 : IRA LAW PREETIKA KASHYAP
 : Article 12 Award
 : ARBITRATION AWARD
 : 0
 : (Zero)
 : BINNY KALRA
 : BINNY KALRA
 : BINNY KALRA
 : 100
 : (One Hundred only)



SELF PRINTED CERTIFICATE
TO BE VERIFIED BY THE RECIPIENT

Please write or type below this line

ARBITRATION AWARD

.IN REGISTRY

(C/O National Internet Exchange of India)

Before the Sole Arbitrator, Binny Kalra

Disputed domain name <CANALI.CO.IN>

INDRP Case No. 1395

In the matter of:

Canali Ireland Limited

vs

Feifei

Doublelist Limited

Complainant

Respondent

Binny Kalra

Statutory Alert:

1. The authenticity of this Stamp certificate should be verified at www.stockstamp.com or using a Stamp Mobile App of Stock Holding.
2. Any discrepancy in the details on this Certificate and as available on the website / Mobile App renders it invalid.
3. The onus of checking the legitimacy is on the users of the certificate.
3. In case of any discrepancy please inform the Competent Authority.

ARBITRATION AWARD

.IN REGISTRY

(C/O NATIONAL INTERNET EXCHANGE OF India)

Before the Sole Arbitrator, Binny Kalra

Disputed domain name <**CANALI.CO.IN**>

In the matter of:

Canali Ireland Limited

7 D'Olier Street, D02HF60 Dublin 2

Dublin

Ireland (IE)

Complainant

Versus

Feifei

Doublefist Limited

A3, JiaZhaoYe, JiangBei.

Huicheng District, HuiZhou City,

GuangDong Province, China

Respondent

INDRP Case No: 1395

1. The Parties:

The Complainant, Canali Ireland Limited, is a company headquartered in Dublin, Ireland who is represented in these proceedings by its authorised representative, Michele Provera, c/o Via Sagra di San Michele, 27 10139 Torino, Italy. The Respondent is Feifei dba Doublefist Limited. The Respondent is not represented in these proceedings.

2. The domain name, Registrar, and Policy:

The disputed domain name is www.canali.co.in (hereinafter referred to as the "**Disputed Domain Name**"). The Registrar for the Disputed Domain Name is



Dynadot LLC, having its address at 210 S Ellsworth Ave #345 San Mateo, CA 94401, USA. 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:

- 30 June 2021: Statement of acceptance along with a declaration of impartiality and independence was sent by the arbitrator to the .IN Registry
- 2 July 2021: The .IN Registry transmitted information of appointment of the arbitrator and circulated the complaint and its annexures to the parties
- 2 July 2021: Notice of commencement of arbitration proceedings was sent by the Panel to the parties and a period of 21 days, until 23 July 2021, was given to the Respondent to submit a statement of defence
- 23 July 2021: The Panel wrote to the Parties and NIXI to record that no statement of defence or other communication was forthcoming from the Respondent by the due date therefore its right to file the statement of defence stood forfeited. The award was accordingly reserved.

4. Complainant's case:

The Complainant's submissions in the complaint are recapitulated here in brief:

- i. The Complainant is a prominent, high-end men's fashion and luxury industry headquartered in Dublin, Ireland.
- ii. The Complainant, led by the third generation of its founder's Canali family, designs a wide range of luxury products with 'Made in Italy' standards of



excellence such as suits, shoes, bags and men's accessories which are sold in more than 100 countries around the globe.

- iii. The Complainant is the registered proprietor of the trademark CANALI both in India and abroad. The Complainant has given details of its trademark registrations in Annexure 1.
- iv. The Complainant's trademark CANALI is distinctive and well-known around the world and was first registered in 1968 when the Complainant began to expand its commercial footprint to new countries such as England, France, Canada and the Middle East.
- v. The Complainant's products are worn by men of distinction, including award winning actors, sportsmen at the top of their game, statesmen and politicians (Annexure 2.1).
- vi. The Complainant is the owner of the domain names www.canali.com, www.canali.in, www.canali.us and others. It has extensively used the trademark CANALI for its social media accounts on Facebook, Instagram and Twitter (Annexure 2.2).
- vii. The Disputed Domain Name www.canali.co.in wholly incorporates the Complainant's registered trademark CANALI (Annexure 3).
- viii. The Disputed Domain Name leads to a parked website displaying sponsored links including those dedicated to Complainant's competitors and offering the Disputed Domain Name for sale (Annexure 4).
- ix. The Complainant issued a cease and desist notice to the Respondent on October 2, 2020 (Annex 5.1) via email to the address indicated in the WhoIs database (i.e. ymgroup@msn.com), and a reminder notice on March 8, 2021 (Annex 5.2). The Respondent answered requesting EUR 2890 for the transfer (Annex 5.3).
- x. "CANALI" is neither a generic English term, nor descriptive, and it is not an English or Hindi dictionary word, rather it is an Italian word meaning "channels" and an inherently distinctive trademark which solely refers to and belongs to the Complainant.



- xi. Since no relationship or connection has ever been established between the parties and no lawful connection of the Respondent to the denomination (mark) "CANALI" is apparent from the records either, the Complainant could not find any evidence on which to base the assumption that the Respondent is making a bona fide offering of goods or services related to the Disputed Domain Name. Rather, the Respondent has registered the Disputed Domain Name which is identical to the Complainant's trademark to prevent the owner of the trademark from reflecting the mark in a corresponding domain name and to exploit the value of the Complainant's brand, since the Disputed Domain Name at present is connected to a parking page where the Domain Name is offered for sale and where there are links to Complainant's competitors, such as Zegna and Brioni (Annex 4).
- xii. The trademark CANALI which comes from the surname of the Complainant's founders has been deemed well-known in the men high-end fashion and luxury industry in the WIPO decision Canali Ireland Ltd. v. Kanchai Tanurat Case No. D2011-1469 wherein the arbitrator noted "Canali [...] is recognized as a well-known trademark in the fashion field".
- xiii. The Respondent has used prima facie false data to register the domain name: i.e. Feifei, based in HuiZhou City, GuangDong Province, China or Wisconsin U.S.A. The use of false registration data in connection with the disputed domain name supports a finding of bad faith registration and use.
- xiv. The Respondent, knowing the value of the Complainant's trademark, offers for sale the Disputed Domain Name, directly on the website corresponding to the Domain Name, via Sedo and Bodis.com platforms and, following the Complainant's cease and desist letter, the Respondent asked for EUR 2890. Therefore, the Respondent acquired the Disputed Domain Name primarily for the purpose of selling it to the Complainant for a sum significantly more than the Respondent's out-of-pocket costs for registering the disputed domain name which, according to paragraph 7(a) of the Policy, is evidence of registration and use of the disputed domain name in bad faith.

The Complainant also relies on domain name decisions such as *Home Director, Inc. v. HomeDirector, WIPO Case No. D2000-0111* for the proposition that Respondent's use of false or misleading information for the registration of the domain name is evidence of bad faith; *INDRP/1262 (award pertaining to delonghi.in)* in support of the proposition that the registration of a domain name that incorporates a well-known mark by an entity that has no relationship to the mark is evidence of bad faith; *Gene Kelly Image Trust v. BWI Domain Manager, WIPO Case No. D2008-0342* for the proposition that the existence of sponsored links on the website are evidence that the respondent's use of the disputed domain name is not legitimate non-commercial use but for commercial gain; *SAP SE v. Domains by Proxy, LLC / Kamal Karmakar WIPO Case No. D2016-2497* for the proposition that the Respondent is responsible for the links displayed in the parking page and could earn money from the clicks of the users, and profit could be obtained either by the Respondent or the provider; *INDRP/730 (award pertaining to sothebysrealty.in)* to support its contention that the requirements under Paragraph 4 (iii) and paragraph 6 of the INDRP are satisfied and the Respondent is indeed a cyber squatter.

5. Respondent's case:

The Respondent, though duly served on its email address ymgroup@msn.com as provided in the WhoIs database, has not filed a statement of defense or participated in any manner in these domain name dispute proceedings.

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. Since the Respondent has not submitted a statement of defence in these proceedings, the Panel must proceed on the basis of the Complainant's uncontroverted submissions in the complaint and an unbiased appreciation of the documents placed on record by the Complainant. The below discussion analyzes whether the Complainant has established the presence of the aforesaid three elements in this case to succeed in the Domain Name Dispute.

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 <CANALI.CO.IN>. The Complainant has shown that it has rights in the trademark CANALI by virtue of:

- i. registrations in India for the mark CANALI under trademark No. 1276441 in class 3 and trademark No. 661906 in class 25 (Annexure 1.3 and 1.4 respectively). The statutory protection granted to the Complainant's trademark CANALI in India confirms that it has strong and enforceable rights in the said mark.
- ii. the Complainant's earliest trademark registration dates to 1968.
- iii. the operation of the website at www.canali.com which is accessible in India and confirms the online presence of the Complainant's products.
- iv. the Complainant's social media accounts which are accessible in India and evidence the Complainant's goodwill and reputation.

The trademark CANALI is replicated in entirety in the Disputed Domain Name.



For the above reasons, the Panel finds that the Disputed Domain Name is identical to the trademark CANALI in which the Complainant clearly has an exclusive right.

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

The Panel assesses the claims made by the Complainant to be tenable and based on an independent analysis of its documents, the Panel finds that the Disputed Domain Name is identical to the mark CANALI, for the following reasons:

- i. The Disputed Domain Name <CANALI.CO.IN> wholly contains the word CANALI which forms the entirety of the mark CANALI in which the Complainant has rights.
- ii. The Complainant's claim that the mark CANALI is exclusively associated with its business has been accepted by the Panel to be correct.
- iii. It is highly likely that consumers who access the website corresponding to the Disputed Domain Name will associate it with the Complainant believing it to be that of or related to the Complainant, there being no difference between the key and prominent word designating the addresses of the Complainant's website i.e. **canali.com** and the website at the Disputed Domain Name i.e. **canali.co.in**. There is no question that, given the very distinctive nature of the Complainant's mark CANALI, the Respondent's ccTLD extension ".co.in" is immaterial and of no significance as it does not distinguish the Disputed Domain Name from the Complainant's trademark or domain name comprising the word CANALI.
- iv. The communications between the Complainant and the Respondent show that the Respondent was on strict notice of the Complainant's rights in the trademark CANALI and that the Respondent did not attempt to explain or justify its choice of the Disputed Domain Name or shy from the fact that this domain name was up for sale and, indeed, the Respondent asked for an unreasonable sum of money to transfer the Disputed Domain Name to the Complainant.



- v. There is no apparent basis to presume in the Respondent's favour that it has any independent claim to or rights in the Disputed Domain Name. A legitimate owner will typically not use sponsored links to its competitors' websites as this runs counter to the integrity of its own brand, and in any case, offering the Disputed Domain Name for sale together with links to competitors' brands is completely inconsistent with rights and legitimate interests in the Disputed Domain Name.

The conduct of the Respondent is self-speaking as to the absence of any legitimate interest in respect of 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 Panel discusses below whether the Respondent has complied with Section 3 of the INDRP:

- i. Based on the averments in the complaint and the documents filed by the Complainant, the Panel is of the view that the Respondent did not comply



with Section 3 (a) since it failed to furnish complete and accurate credentials for registration of the Disputed Domain Name.

- ii. The Respondent also had actual knowledge from the Complainant's cease and desist letter of October 2, 2020 that the latter has statutory rights in the mark CANALI in several countries. The Panel notes that the Complainant did not specifically reference its statutory rights in the trademark CANALI in India in the said cease and desist letter, however this does not take away from the fact that such rights existed, and the Respondent could have questioned the Complainant in this regard if it wanted to. Thus the Respondent did not comply with Section 3 (b) by knowingly registering a domain name that infringes upon or otherwise violates the rights of a third party.
- iii. The Respondent replied to the Complainant's notice on March 11, 2021 (Annexure 5.3) stating:

*"Hello,
Thanks for your email.
Only 2890 EUR.
We could transfer the domain name via Sedo.com (Germany), and the transfer will be finished in one week
I'm sincere.
Thank you.
Best regards, Zhao"*

It is evident from the above communication that the Respondent asked for a disproportionate sum of money from the Complainant to transfer the Disputed Domain Name to the legitimate owner which shows an undisguised motive of profiteering. Thus the Respondent did not comply with Section 3 (b) and registered the domain name for an unlawful and mala fide purpose.

- iv. The Panel finds strength in the Complainant's averment that an additional circumstance demonstrating bad faith is that the Respondent has used the email domainhk@hotmail.com in a communication dated January 12, 2021 (Annex 6), for a reminder to the Complainant's Legal Representative, which email is connected to the Respondents in the following .in cases:



- INDRP/549 for the domain name coldwellbanker.co.in,
- INDRP/552 for the domain name aseabrownboveri.co.in,
- INDRP/1128 for the domain name lowes.in.

The Respondent's email ymgroup@msn.com, indicated in the WhoIs data of the Disputed Domain Name, is connected to the Respondents in the following .in cases:

- INDRP/840 zippo.co.in and
- INDRP/1032 deloitte.in

In these cases, the Respondent had different names and physical address but both the emails domainhk@hotmail.com and ymgroup@msn.com were used to promote the sales of the domain names at issue as in this case. The Respondent has thus engaged in a pattern of conduct and has registered the Disputed Domain Name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, which attracts paragraph 7 (b) of the Policy.

This Panel also takes express note of the fact it has previously given two awards in complaints by other complainants pertaining to different disputed domain names wherein the same Respondent. i.e. Doublefist Limited, with the same email address i.e. ymgroup@msn.com, was the registrant of the disputed domain names that were ordered to be transferred to the rightful claimants (see INDRP/1368 re brioni.in; INDRP/1385 re steelcase.in). The Respondent did not participate in those proceedings either and the same pattern is repeated in this proceeding too. Thus, the Respondent clearly appears to be an archetypal cyber squatter.

In this background, the Panel cannot find any factor that comes to the assistance of the Respondent and the Panel finds that the Disputed Domain Name has been registered and is being used in bad faith.

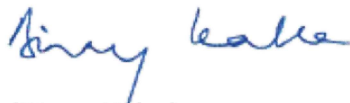


Decision:

In the facts and circumstances, and 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. Accordingly, the Panel directs that the Disputed Domain Name <CANALI.CO.IN > be transferred to the Complainant.

Given the Panel's finding that the Respondent is a cyber squatter, this is a fit case to impose costs on the Respondent. Accordingly, the Respondent is directed to pay the Complainant its official filing costs of Rs. 30,000.

Signed:



(Binny Kalra)

Arbitrator

Date: 19 August 2021