



# INDIA NON JUDICIAL

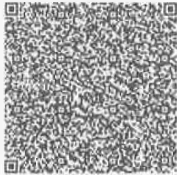
## Government of National Capital Territory of Delhi

### e-Stamp

<b>Certificate No.</b>	: IN-DL08632036849491U
<b>Certificate Issued Date</b>	: 24-Mar-2022 05:20 PM
<b>Account Reference</b>	: SELFPRINT (PU)/ dl-self/ NEHRU/ DL-DLH
<b>Unique Doc. Reference</b>	: SUBIN-DL DL-Self05583273182349U
<b>Purchased by</b>	: IRA LAW PREETIKA KASHYAP
<b>Description of Document</b>	: Article 12 Award
<b>Property Description</b>	: ARBITRATION AWARD
<b>Consideration Price (Rs.)</b>	: 0 (Zero)
<b>First Party</b>	: BINNY KALRA
<b>Second Party</b>	: BINNY KALRA
<b>Stamp Duty Paid By</b>	: BINNY KALRA
<b>Stamp Duty Amount(Rs.)</b>	: 100 (One Hundred only)

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IN-DL08632036849491U

### ARBITRATION AWARD

#### .IN REGISTRY

(C/O NATIONAL INTERNET EXCHANGE OF India)

Before the Sole Arbitrator, Binny Kalra

Disputed domain name <WWW.ASSAABLOY.CO.IN>

In the matter of:

INDRP Case No: 1501

ASSA ABLOY AB

vs

Yitao, C/o Apex Consulting

**Complainant**

**Respondent**

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*Binny Kalra*

## **ARBITRATION AWARD**

### **.IN REGISTRY**

(C/o National Internet Exchange of India)

Before the Sole Arbitrator, Binny Kalra

Disputed domain name: **<WWW.ASSAABLOY.CO.IN>**

#### **In the matter of:**

ASSA ABLOY AB  
Box 70340, SE-107 23 Stockholm,  
Sweden

Complainant

v.

Yitao, C/o Apex Consulting  
No. 33, Tongji East Road,  
Chancheng District, Foshan City - 528000,  
China

Respondent

#### **INDRP Case No: 1501**

#### **1. The Parties:**

The Complainant in the proceedings is Assa Abloy AB, a public limited liability company incorporated under the laws of Sweden, who is represented in these proceedings by Mr. Shantanu Sahay and Mr. Apoorv Bansal of M/s Anand and Anand, First Channel Building, Plot No.17A, Sector 16A, Film City, Noida 201301, UP. The Respondent is Yitao, Apex Consulting who is the registrant of the disputed domain name.

#### **2. The domain name, Registrar, and Policy:**

The domain name complained of is www.assaabloy.co.in (hereinafter referred to as the "**Disputed Domain Name**"). The sponsoring Registrar with whom the disputed domain name is registered is indicated as Dynadot LLC having its address at 210 S, Ellsworth Ave #345, San Mateo, California 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:**

- 8 February 2022: The .IN Registry transmitted information of appointment of the arbitrator and circulated the complaint and its annexures to the parties
- 8 February 2022: The Complainant submitted the amended complaint as well as an amended schedule list of annexures along with the relevant annexures
- 9 February 2022: The Panel submitted the statement of acceptance and declaration of impartiality and independence to .IN Registry.
- 11 February 2022: The Complainant confirmed that it had no objection to the Panel's disclosure the statement of acceptance and declaration of impartiality and independence
- 12 February 2022: Notice of commencement of arbitration proceedings was sent by the Panel to the parties and a period of 21 days, until 5 March, 2022, was given to the Respondent to submit a statement of defense
- 7 March 2022: No statement of defense or other communication / response was forthcoming from the Respondent. The award was reserved.

### **Complainant's case:**

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

- i. The Complainant was created in 1994 by the merger of two separate companies, Sweden-based Assa and Finland-based Abloy. The trade name and trademark 'ASSA ABLOY' of the Complainant is derived from the names of these companies.
- ii. The Complainant, its group companies, subsidiaries, and the companies promoted by it are one of the world's most trusted business conglomerates. It has become a global leader in providing access solutions such as mechanical and digital locks,



cylinders, keys, tags, security doors, and automated entrances. It represents its own and the interests of all Assa Abloy companies.

- iii. It collectively employs approximately 48000 people around the world and is responsible for developing, manufacturing, and selling over a billion locks and doors.
- iv. The Assa Abloy Companies have achieved global leadership in their businesses under around 190 brands which include various well-renowned and reputed brands such as ASSA ABLOY, YALE, HID, etc. Its brand name and trademark ASSA ABLOY contributes to approximately 70 per cent of the total sales of its group of companies, which is about USD 6.7 Billion (INR 670 Crores).
- v. The Complainant is the registered proprietor in India of the trademark ASSA ABLOY in classes 6, 9, and 42, in relation to a diverse range of goods and services. A copy of the tabulated list of its trademark registrations in India is at Annexure C.
- vi. The Complainant also owns registrations for the trademark ASSA ABLOY and various ASSA ABLOY formative marks in around 27 countries besides India. A list of trademark registrations currently existing in its favour on the WIPO Global Brand Database is at Annexure D.
- vii. It is the registrant of various domain names containing its trade/service mark ASSA ABLOY, such as [<www.assaabloy.com>](http://www.assaabloy.com), [<www.assaabloyopeningsolutions.co.in>](http://www.assaabloyopeningsolutions.co.in), [<www.assaabloyopeningsolutions.com>](http://www.assaabloyopeningsolutions.com), [<www.assaabloydss.com>](http://www.assaabloydss.com), [<www.assaabloyentrance.com>](http://www.assaabloyentrance.com), [<www.assaabloyentrance.us>](http://www.assaabloyentrance.us), [<www.assa-abloy.com>](http://www.assa-abloy.com), [<www.assaabloy.in>](http://www.assaabloy.in), [<www.assabloy.org>](http://www.assabloy.org), [<www.assa-abloy.org>](http://www.assa-abloy.org), and [<www.assabloy.net>](http://www.assabloy.net).
- viii. The Complainant has successfully defended its trademark rights in various cases before the WIPO Arbitration and Mediation Centre and the Czech Arbitration Court.
- ix. The WIPO Arbitration and Mediation Centre decisions favouring the Complainant are listed as follows:
  - ASSA ABLOY AB v. P D S AB (WIPO Case No. D2000-0442, WIPO, July 4, 2000), wherein it was held that domain name <assaabloy.com> is identical with the trademark ASSA ABLOY and the company name ASSA ABLOY except for the addition .com. Therefore, the Respondent in the matter could



not be said to have had a legitimate interest in the domain name. The order passed in favour of the Complainant is at Annexure E.

- ASSA ABLOY AB v. Goharbarane Sharif / Mohammed Rezza Rahmani Zanjani (WIPO Case No. DIR2016-0005, WIPO, April 13, 2016), wherein it was held that disputed domain names <assaabloy.ir> and <assa-abloy.ir> were confusingly similar to the Complainant's trademark ASSA ABLOY, as they include said trademark in its entirety. The order passed in favour of the Complainant is at Annexure F.

- x. The orders passed by the Czech Arbitration Court protecting the trademark ASSA ABLOY of the Complainant in the case of ASSA ABLOY Branding S.a.r.l. v. Jeremy Howard (Case No. 103635, CAC, May 10, 2021) are at Annexure G.
- xi. Respondent is the registrant of the Disputed Domain Name which was registered on 5 July 2018. The disputed domain name is inactive and does not host a website. In fact, the disputed domain name is available for sale at [www.sedo.com](http://www.sedo.com), a website which is involved in buying, parking, and selling of domain names. An extract from [www.sedo.com](http://www.sedo.com) evidencing this is at Annexure H.
- xii. A Reverse Whois Lookup for the Respondent's email address i.e., [sunong@live.com](mailto:sunong@live.com), using [www.reversewhois.io](http://www.reversewhois.io), shows that there are around 220 domains names that have been registered using the said email address. These include domain names incorporating well-known trademarks, such as <applestore.in>, <ballantines.co.in> and <chrysler.co.in>. Printouts of webpages from [www.reversewhois.io](http://www.reversewhois.io) pertaining to domain names owned by the Respondent are at Annexure M. This evidences the fact that the Respondent did not have legitimate intentions in registering the domain name and misappropriated the Complainant's trademark with the intention of profiting off its sale to the Complainant at an exorbitant price.
- xiii. Further, various arbitral panels have ruled against the Respondent in cases involving domain names identical or confusingly similar to the respective trademarks of the Complainants therein. This shows that the Respondent is a habitual offender with respect to cases of domain name squatting. Instances of such cases are listed below:



- Mead Johnson & Company, LLC v. Yitao, Apex Laboratories Limited (INDRP/458) at Annexure N;
- Le Creuset v. Yitao, Apex Consulting (INDRP/962) at Annexure O;
- M/s. Merck KGaA v. Yitao, Apex Laboratories Limited (INDRP/401) at Annexure P;
- Deloitte Touche Tohmatsu v. Yitao, Apex Consulting (INDRP/1031) at Annexure Q; and
- Tetra Laval Holdings & Finance S.A. v. Yitao, Apex Laboratories Limited (INDRP/676) at Annexure R.

#### **4. Respondent's case:**

Despite being served with a notice of commencement of Arbitration Proceedings in respect of the Disputed Domain Name by the Panel and thereafter being granted adequate time to respond, the Respondent has failed to submit any response, communication or evidence to the Panel in this matter.

#### **5. 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.

#### **6. 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 <www.assaabloys.co.in>. The Complainant has shown that it has rights in the ASSA ABLOY Marks by virtue of:

- i. prior adoption and continuous use of the highly distinctive trademark ASSA ABLOY;
- ii. registrations in India for the ASSA ABLOY Marks under Nos. 1130090 (Annexure C2), 1130091 (Annexure C3), 1242763 (Annexure C4), 3356765 (Annexure C5) and 1794813 (Annexure C7);
- iii. a successful track record of enforcing the ASSA ABLOY Marks before the WIPO Arbitration and Mediation Centre (Annexure E and Annexure F) and the Czech Arbitration Court (Annexure G).

The Panel accepts the Complainant's statement that ASSA ABLOY is an invented word with no known meaning in English or Indian languages. It is created by combining the names of the two Scandinavian companies that merged to form the Complainant, providing a distinct connection and reason for the Complainant to claim the mark. 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 ASSA ABLOY together with the statutory protection granted to the mark in India and the Complainant's common law rights in the said trademark, and findings in preceding awards and decisions in the





Complainant's favour, confirm that the Complainant has strong and enforceable rights in the trademark. The Disputed Domain Name is identical to the ASSA ABLOY Trademark for all intents and purposes.

For the above reasons, the Panel finds that the Disputed Domain Name is identical to the ASSA ABLOY 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 nor responded to any communication from the Panel. The Respondent evidently has no justification for adoption of the Disputed Domain Name since the very nature of the trademark is such that no plausible explanation could exist to explain how the Respondent chanced upon the exact words ASSA ABLOY for the Disputed Domain Name. The Respondent is therefore deemed to have no defensible rights or any claim 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 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 not only did not exercise any diligence when it applied to register the Disputed Domain Name, it has made brazen misrepresentations to the Registrar in contravention of Section 3.

The Disputed Domain Name was created by the Respondent on 5 July 2018. As far back as 4 July 2000, the Complainant had received an award in its favour in ASSA ABLOY AB v. P D S AB (WIPO Case No. D2000-0442) and recovered the domain name <assaabloy.com>. On 13 April 2016, the WIPO Arbitration and Mediation Centre had passed an award in ASSA ABLOY AB v. Goharbarane Sharif / Mohammed Rezza Rahmani Zanjani (WIPO Case No. DIR2016-0005) ordering the transfer of domain names identical to the Complainant's trademark ASSA ABLOY, albeit with a .ir extension in that case (namely <assaabloy.ir> and <assa-abloy.ir>). The Respondent was deemed to be aware of the WIPO decisions which are a matter of public record, and ought to have known that any domain name comprising the words ASSA ABLOY even with a different ccTLD extension would violate the Complainant's legal rights in the said trademark. Further, the Complainant's registrations for the mark ASSA ABLOY in India constitute constructive notice to the Respondent of its breach of the Complainant's statutory rights when registering the disputed domain name with a '.co.in' SLD.

Moreover, Annexure M relied on by the Complainant shows that there are around 220 domains names that have been registered by using the Respondent's email address, including some that incorporate widely known trademarks. Further, the Respondent has already been involved in several domain name disputes with the disputed domain names being identical or confusingly similar to the trademarks of the respective complainants, with arbitrators ruling against it in each of these disputes. These factors strongly suggest that the Respondent is a habitual offender who registers domain names in bad faith for mercenary reasons. In an ideal world, a registrant with a bad track record of this nature ought to be blacklisted by domain registrars, for at least a finite duration, to create deterrence against such conduct. At the same time, the Panel is conscious that there are many ways in which a bad actor can circumvent a potential blacklisting in this space.



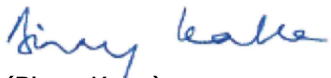
In view of the factors discussed above, the Panel finds that the Disputed Domain Name has been registered and is being passively held in bad faith.

**Decision:**

In conclusion, the Panel finds that the Complainant has succeeded in making a case for transfer of the disputed domain name by meeting the criteria under paragraph 4 of the Policy.

The Panel directs that the disputed domain name <**assaabloy.co.in**> be transferred to the Complainant.

Signed:



(Binny Kalra)

Arbitrator

Date: 25 March 2022