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Kohler Co., USA vs. Rajeev Jain, Mahalaxmi Valves Pvt Ltd, Delhi-52
INDRP Case no. 1576
Arbitrator: Mr. P.K.Agrawal

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AWARD

1. The Parties

The Complainant is M/s Kohler Co., 444 Highland Drive, Kohler, Wisconsin 53044, USA.

The Respondent is Rajeev Jain, Mahalaxmi Valves Pvt Ltd, 3224 & 3227, Hakim Baka Street, Near Chaumukha Mandir, Delhi-110052, India.


2. The Domain Name and Registrar

The disputed domain name is <*kohler.org.in*>. The said domain name is registered with the Registrar – GoDaddy.Com LLC (IANA ID: 146). The details of registration of the disputed domain name (as per WHOIS details relevant to the Complaint) are as follows:

- a. Domain ROID: D1EA1A7C8E6EB412892B33CF1A3D0EAA9-IN
- b. Date of creation: August 13, 2020
- c. Expiry date: August 13, 2022

3. Procedural History

- (a) A Complaint dated 4th June, 2022 has been filed with the National Internet Exchange of India (NIXI). The Complainant has made the registrar verification in connection with the domain name at issue. The print outs confirmed that the Respondent is listed as the registrant and provided the contact details for the administrative, billing, and technical contact. The Exchange verified that the Complaint satisfied the formal requirements of the Indian Domain Name Dispute Resolution Policy (INDRP) (the “Policy”) and the Rules framed thereunder.
- (b) The Exchange appointed the undersigned Mr. P.K.Agrawal, Advocate and former Addl. Director General in the Government of India, as the sole Arbitrator in this matter. The Arbitrator finds that he has been properly appointed. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Exchange.

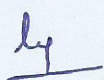

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- (c) In accordance with the Policy and the Rules, the copies of complaint with annexures were sent by the National Internet Exchange of India on 22.06.2022 by email. The Arbitrator served the Notice under Rule 5(C) of INDRP Rules of procedure along-with copies of complaint and annexures to the parties through email on 22.6.2022. The Complainant was advised to submit amended copy of complaint with the Respondent's address as reflected in WHOIS details. The Complainant submitted & served the amended complaint through email. The Respondent was given 14 days for reply to the complaint. The Notice email was served upon the Respondent email id given in WHOIS details which was delivered; however, it could not be served upon the postmaster@kohler.org.in as it was returned undelivered by Gmail due to non- acceptance by the recipient's server. The Complainant, through his email dated 28.6.2022 has submitted the proof of dispatch of his Complaint to the Respondent through Speed Post. In view of this, the Complaint and its annexures may be deemed to have been served to the Respondents as per Arbitration and Conciliation Act, 1996 and INDRP rules. The Respondent has not responded to the Complaint served to him. Since the Respondent has not responded and presented any grounds in his defence, the present proceedings have to be conducted *ex parte* as per the Arbitration and Conciliation Act, 1996 and the .IN Domain Name Dispute Resolution Policy and the Rules of Procedures framed there under.

4. Factual Background

The Complainant in this arbitration proceedings is M/s Kohler Co., 444 Highland Drive, Kohler, Wisconsin 53044, USA. According to the details given in the complaint, the Complainant is a global leader in designing and manufacturing kitchen and bath products, engines and power generation systems, cabinetry, and home interiors, *inter alia* under the brand "KOHLER". Founded in 1873 by John Michael Kohler, Complainant was initially named Kohler & Silberzahn and made plows and other farm equipment. Complainant adopted its present trading name in 1912 after undergoing several structural changes and expanding its portfolio of products/services under the aegis and control of generations of the Kohler family.

The trademark "KOHLER" was thus adopted and used by Complainant, and its predecessors, as early as in 1873 with a view to encash upon tremendous goodwill associated with Mr. Kohler and the Kohler family's surname / family in the relevant industry. The brand/trademark "KOHLER" therefore holds immense significance for the Complainant.


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The Complainant claims that, as on date, it is one of the largest privately held companies in the United States, employs more than 36,000 associates in six continents, operates plants/factories in 49 locations worldwide and dozens of sales offices globally. Complainant enjoys worldwide presence in several countries including USA, Canada, Mexico, Brazil, Algeria, Belgium, Egypt, France, Germany, Italy, Morocco, Netherlands, Russia, Slovakia, South Africa, Spain, Togo, China, India, Indonesia, Japan, Malaysia, Philippines, Singapore, South Korea, Thailand, UAE, UK, and Vietnam, among others.

The Complainant operates in India through its wholly owned subsidiary, Kohler India Corporation Private Limited (KICPL) incorporated on 20th September 1999 and having its registered address at 26 A, Ring Road, Lajpat Nagar IV, New Delhi – 110024. Complainant first used its well-known trademark “**KOHLER**” in India in 1994 preparing for launch of its goods/services in India. Complainant, through KICPL, has pan-India sales and business development teams across 4 regional offices and a nationwide after-sales service network. The Complainant works on a B2B system and has created a network of over 350 dealers, distributing partners and outlets spread across almost every city in India.

The Complainant is the exclusive owner of the word mark “**KOHLER**” in India registered vide **Trade Mark No. 643704** since **21st October 1994** in **Class 11** vide **Certificate No. 260735** dated 15th May 2003, among other registrations for formative marks. The said registration is subsisting as on date and renewed up to 21st October 2031. According to the Complainant, given the immense popularity and goodwill accrued, Complainant’s trademark “**KOHLER**” qualifies as a well-known trademark under Section 2(1) (zg) of the Trade Marks Act, 1999 and has also been declared as such by the Indian Trade Marks Registry. The Registrar of Trade Marks, India has also declared and included Complainant’s trade mark “**KOHLER**” in the list of well-known trademarks under Rule 124 of the Trade Marks Rules, 2017 as advertised in Trade Marks Journal No. 1942 dated 24th February 2020.

Complainant secured the first registration for its trademark “**KOHLER**” in the United States vide **Serial No. 71072289** and **Registration No. 0094999** on as early as **20th January 1914** with use claim asserted since **1873**. Complainant also enjoys registrations for the mark ‘**KOHLER**’ and various other formative marks in several jurisdictions including Australia, Bhutan, Botswana, Brunei, Cambodia, Canada, Chile, Costa Rica, Cuba, Estonia, European Union, France, Gambia, Germany, Indonesia, Israel, Italy, Jordan, Kenya, Madagascar, Malaysia, Mexico, Morocco, Mozambique, Namibia, New Zealand, North Macedonia, Philippine, Singapore, Switzerland, Tongo, United States, Uruguay, Vietnam, and Zimbabwe.

The Complainant is registrant of the top-level domains (TLD) kohler.com and kohlercompany.com since 8th November 1994 and 6th December 2006 respectively and host interactive websites at www.kohler.com and www.kohlercompany.com accessible globally including in India. Complainant is also the registrant of India's Country Code Top Level domain (ccTLD) kohler.co.in since 23rd March 2005 and host an interactive website at www.kohler.co.in dedicated specifically to customers in India.

Respondent's Identity and Activities

The Respondent's activities are not known as per WHOIS details. According to the Complainant, the Respondent is his rival / competitor. The Respondent has not responded to the Notice and complaint served upon him through emails and couriers.

5. Parties Contentions

A. Complainant

The Complainant contends that each of the elements specified in the Policy are applicable to this dispute.

In relation to **element (i)**, the Complainant submits that the disputed domain name kohler.org.in registered by Respondent is identical to and comprises in entirety Complainant's trade name and trademark "**KOHLER**". Furthermore, the disputed domain name kohler.org.in is also is identical and confusingly similar to Complainant's Domain Names kohler.com, kohlercompany.com, and kohler.co.in.

The disputed domain name incorporates Complainant's trademark "**KOHLER**" and essential element of Complainant's domain names in entirety, but for the necessary suffix "**.org.in**" and does not add any distinguishing element to it. The suffix "**.org.in**" is merely indicative of the domain name being a India-specific top-level domain on internet and ought to be disregarded while comparing disputed domain name with Complainant's well-known trademark "**KOHLER**", formative marks thereof and Complainant's Domain Names.

The Complainant contends that the Respondent is also registrant of the domain name rnvalves.com and hosts a website accessible at www.rnvalves.com. A perusal of said website reveals that RN valves, established by Mr. Rajeev Jain (also a director/signatory with Respondent) is engaged in offering bathroom solutions to customers in India and manufactures/trades in bath accessories, diverter and spouts, faucets,

hoses, showers, etc. which are same/similar and overlapping with award winning goods/services offered by Complainant under its iconic brand "**KOHLER**". Therefore, the Respondent also carries on business in the same industry as the Complainant. Accordingly, any of Complainant's customers/intended customers who come across the disputed domain name, are likely to assume some connection between the Respondent and the Complainant when in actuality no such association or connection exists. The disputed domain name held by the Respondent is bound to deceive and cause confusion in the minds of the general public.

The Complainant submits that the Respondent's registration of the disputed domain name adversely affects the exclusive, prior, and superior rights, statutory as well as under the common law, enjoyed by the Complainant in the well-known trade name, trademark "**KOHLER**", formative marks thereof and Complainant's Domain Names

Accordingly, the Complainant contends that the first condition that Respondent's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights, as per Paragraph 4 (a) of the Policy has been satisfied.

In relation to **element (ii)**, the Complainant contends that the Respondent does not have any legitimate interest in using the disputed domain name. Based on the Complainant's reputation, there is no believable or realistic reason for registration or use of the Disputed Domain Name other than to take advantage of the Complainant's rights. The Respondent can demonstrate no legitimate interest in the Disputed Domain Name. The Respondent registered the Disputed Domain Name after the Complainant had established rights in its well-known trademarks through extensive use and registration in various countries.

The Complainant submits that The Respondent is neither known by the name "**KOHLER**" nor carries on any legitimate trade under the trademark "**KOHLER**" in any industry, much less in the kitchen and bath fixtures industry, and any claim to the contrary by the Respondent is untenable given that the Complainant is the exclusive prior and superior owner and user of the brand "**KOHLER**", associated trading names and domain names which has been adopted drawing inspiration from the founding family's surname "**KOHLER**". In fact, as is evident from the website www.rnvalves.com, Respondent offers its products/services under the brand "**RN Valves & Faucets**".

The Complainant has never granted Respondent any license, permission, consent, or authorization to secure and continue to hold the registration of the disputed domain name. Furthermore, given the much prior statutory and common law rights enjoyed by the Complainant in the well-known brand "**KOHLER**" globally since 1873 and in India since

1994, the Respondent cannot possibly have any cogent reason or justification for adopting the trademark/domain name identical to Complainant's trademark "**KOHLER**" in respect of any business, much less for bath accessories and cognate goods.

The Complainant contends that the Respondent secured registration for the disputed domain name kohler.org.in as recently as on 13th August 2020 i.e. i.e. decades after complainant adopted and secured registrations for its trademark "**KOHLER**", formative marks thereof and Complainant's Domain Names and that too at a time when the Complainant, its brand "**KOHLER**" and the products/services thereunder had already acquired distinctiveness, tremendous goodwill and well-known reputation globally and in India.

According to the Complainant, the Respondent has not created and does not host any website at the disputed domain name kohler.org.in or conduct any *bona fide* trade through the said website. Upon accessing the disputed domain name, a viewer only comes a blank webpage without any content whatsoever. The Respondent does not have *bona fide* trademark rights associated with the term "Kohler" on its own. The Respondent has no rights or legitimate interests in the disputed domain name as it has never used the disputed domain name or any corresponding name/mark in connection with any *bona fide* offering of goods/services.

Based on the above-mentioned arguments, the Complainant argues that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name, as per Paragraph 4 (b) of the Policy.

Regarding the **element (iii)**, the Complainant contends that the bad faith is implicit in the registration of the Disputed Domain Name. The disputed domain name kohler.org.in was registered and is being used by the Respondent in *bad faith* to unfairly gain from the well-known reputation enjoyed by the Complainant's products/services under the iconic brand "**KOHLER**" and/or cause confusion and mislead the general public including the Complainant's genuine customers, existing as well as future or intended, to dilute the well-known reputation enjoyed by the Complainant under the brand "**KOHLER**" as well as cause colossal loss and damage to Complainant's business under the brand "**KOHLER**".

The Complainant contends that it is a settled law that registration of identical or confusingly similar domain name that is patently connected with a particular trademark owned by an entity with no connection with the trademark owner is indicative of bad faith as understood in the Policy. Furthermore, use of same or similar domain name is likely to lead to diversion of users which could result from such users mistakenly access one domain name instead of another and is likely to have a greater impact in case of e-commerce which is characterized by rapid progress and instant

and theoretically limitless accessibility to users and potential customers. Ordinary customers / users seeking to locate, access and avail the products/services available on one domain name may be confused if they accidentally arrive at a different but similar website which also offers similar products/services or even in case it does not offer any similar products/services.

According to the Complainant, the Respondent has deliberately registered the disputed domain name only in 2020 despite being well-aware of Complainant's rights in the iconic trade name and trademark "**KOHLER**" and solely with the *mala fide* to attract internet users who mistakenly believe that the Respondent / its website is related to Complainant or its products/services. Furthermore, the conduct of the Respondent in deliberately registering the disputed domain name without posting any genuine content of its own, clearly evinces the bad faith registration and hoarding of the disputed domain name by the Respondent.

The Complainant contends that it is also well-known that customers usually do not remember the exact website and often look up for a specific website by typing in the name of the brand that they recall to the best of their memory. Accordingly, an existing or even an intended customer looking up the Complainant by the word "**KOHLER**" on a search engine may accidentally come across or be directed to Respondent's disputed domain name kohler.org.in instead of being routed to Complainant's global website www.kohler.com, www.kohlercompany.com or its India specific website www.kohler.co.in *inter alia*.

As per the Complainant, the Respondent is not carrying out any genuine trade or business through the disputed domain name and is hoarding the same to make unjustified commercial gains possibly by selling it to the highest bidder at an exorbitant price without making any considerable investments on its own or with a view to adversely affect Complainant's business under the brand "**KOHLER**" and mislead and divert Complainant's customers from accessing Complainant's genuine websites, particularly given that the Respondent appears to be in direct competition with the Complainant as the Respondent operates in the same industry and offers similar / cognate goods.

The Complainant further submits that it is also pertinent to note that the Respondent has also secured registration of several other domain names comprising of the Complainant's iconic trademark "**KOHLER**" in entirety namely <kohler.center>, <kohler.company>, <kohler.email>, <kohler.marketing>, <kohler.network>, <kohlerreal.com>, <kohler.support>, <kohler.work>, and <kohler.zone> which were also registered with GoDaddy.com, LLC. The Complainant had filed a complaint with WIPO Arbitration and Mediation Center ("WIPO Center") on 25th September 2020. The Administrative Panel Decision dated

24th November 2020 passed by a Sole Panelist of WIPO Center in the said complaint titled "Kohler Co. v. Rajeev Jain, Mahalaxmi Valves Pvt Ltd" concluded all three elements under the paragraph 4 of the Uniform Domain Name Dispute Resolution Policy were satisfied. The said decision clearly captures that the domains names in question are confusingly similar to the KOHLER trademark in which the Complainant has rights, that the Respondent does not have any legitimate rights or interests in the said domain names, and further that the said domain names were registered and being used in bad faith by the Respondent. Accordingly, the WIPO Panel directed that the above-mentioned domain names be transferred to the Complainant herein. Pursuant to the said WIPO Panel decision, the Complainant's Counsel addressed an email to the Respondent on 31st March 2021 calling upon the Respondent to transfer the disputed domain name kohler.org.in, *inter alia*, in favour of the Complainant. The Complainant's counsel issued another follow up email on 14th April 2021 extending the Respondent one final opportunity to resolve the matter amicably and transfer the disputed domain name in favour of the Complainant. However, the Respondent has not responded to any of the above emails and proposals from the Complainant's side to settle and conclude the disputes amicably. Accordingly, the Complainant is constrained to initiate the instant proceeding against the Respondent.

According to the Complainant, it is therefore evident that the Respondent has engaged in systematic and blatant illegal activities given that the Respondent has registered and been hoarding another ccTLD and domain names apart from the disputed domain name i.e. kohler.org.in and consequently, prevented the Complainant from legitimately reflecting the mark "KOHLER" in a corresponding domain name. Thus, the Respondent is guilty of registering and using the disputed domain name kohler.org.in in *bad faith* as per INDRP Policy and Rules. Respondent's use of a privacy service to conceal its identity and provision of false or incomplete WHOIS information, further evidences the Respondent's bad faith registration and use of the Disputed Domain.

B. Respondent

The Respondent did not submit any response (evidence or argument) indicating his relation with the disputed domain name <kohler.org.in> or any trademark right, domain name right or contractual right.

6. Discussion and Findings

The Rules instruct this arbitrator as to the principles to be used

in rendering its decision. It says that, “a panel shall decide a complaint on the basis of the statements and documents submitted by the parties in accordance with the Policy, the Arbitration and Conciliation Act, 1996, the Rules and any rules and principles of law that it deems applicable”.

According to the Policy, the Complainant must prove that:

- (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’s has no rights or legitimate interests in respect of the domain name that is the subject of Complaint; and
- (iii) The Registrant’s domain name has been registered or is being used in bad faith.

Although Respondent has not offered any arguments to defend himself on this complaint, the default does not automatically result in a decision in favour of the Complainant. The burden remains with Complainant to establish the three elements of the Policy by a preponderance of the evidence.

A. Identical or Confusingly Similar

The disputed domain name *<kohler.org.in>* was registered by the Respondent on August 13, 2020.

The Complainant is an owner of the registered trademark “**KOHLER**” for the last many years. The Complainant is also the owner of the similar domains as referred to in the Complaint. These domain names and the trademarks have been created by the Complainant much before the date of creation of the disputed domain name by the Respondent. In the present case the disputed domain name is *<kohler.org.in>*. Thus, the disputed domain name is very much similar to the name, activities and the trademark of the Complainant.

The Hon’ble Supreme Court of India has held that the domain name has become a business identifier. A domain name helps identify the subject of trade or service that an entity seeks to provide to its potential customers. Further that, there is a strong likelihood that a web browser looking for “TOPSHOP” products would mistake the disputed domain name as of the Complainant.

In the case of *Wal Mart Stores, Inc. v. Richard MacLeod*, (WIPO Case No. D2000-0662) it has been held that “When the domain name includes the trademark, or a confusingly similar approximation, regardless of the other

terms in the domain name" it is identical or confusingly similar for purposes of the Policy.

Therefore, I hold that the domain name <*kohler.org.in*> is phonetically, visually and conceptually identical or confusingly similar to the trademark of the Complainant.

B. Rights or Legitimate Interests

The Respondent may demonstrate its rights to or legitimate interest in the domain name by proving any of the following circumstances:

- (i) 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; or
- (ii) the Registrant (as an individual, business or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or
- (iii) The Registrant 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.

In Case No. INDRP/776, *Amundi v. GaoGou*, the arbitration panel found that the Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests. Once such *prima facie* case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4 (II) of the INDRP Policy.

The Respondent has not responded in this case despite sufficient notice. There is also no evidence to suggest that the Respondent has become known by the disputed domain name anywhere in the world. The name of the Registrant / Respondent is not KOHLER as per WHOIS details. Based on the evidence adduced by the Complainant, it is concluded that the above circumstances do not exist in this case and that the Respondent has no rights or legitimate interests in the disputed domain name.

Further, the Complainant has not consented, licensed or otherwise

permitted the Respondent to use its name or trademark “KOHLER” or to apply for or use the domain name incorporating said trademark. The domain name bears no relationship with the Registrant. Further that, the Registrant has nothing to do remotely with the business of the Complainant.

As has been contended by the Complainant, the Respondent is not making a legitimate, fair or bona fide use of the said domain name for offering goods and services. The Respondent registered the domain name for the sole purpose of creating confusion and misleading the general public.

I, therefore, find that the Respondent has no rights or legitimate interests in the domain name <*kohler.org.in*> under INDRP Policy, Para- 4(ii).

C. Registered and Used in Bad Faith

Any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration or use of the domain name in bad faith:

- (i) circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who bears the name or is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented out of pocket costs directly related to the domain name; or
- (ii) the Registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Registrant has engaged in a pattern of such conduct; or
- (iv) by using the domain name, the Registrant has intentionally attempted to attract the internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's

website or location.

The contention of the Complainant is that the present case is covered by the circumstances mentioned herein above. There are circumstances indicating that the Respondent has intentionally attempted to attract, for commercial gain, internet users to its web site, by creating a likelihood of confusion with the Complainant's mark. It may also lead to deceiving and confusing the trade and the public.

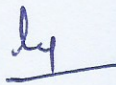
In WIPO Case No. D2007-1695, Mayflower Transit LLC v. Domains by Proxy Inc./Yariv Moshe - "Respondent's use of a domain name confusingly similar to Complainant's trademark for the purpose of offering sponsored links does not of itself qualify as a bona fide use."

The circumstances as evident from the foregoing paragraphs lead to the conclusion that the domain name in dispute was registered and used by the Respondent in bad faith.

7. Decision

In light of the foregoing findings, namely, that the domain name is confusingly similar to the trademark in which the Complainant has rights, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the domain name was registered in bad faith and is being used in bad faith, it is clear beyond doubt that the Respondent has violated the provisions of Rule-3 of the Policy. Therefore, in accordance with the Policy and the Rules, the Arbitrator orders that the domain name <kohler.org.in> be transferred to the Complainant.

No order to the costs.



Prabodha K. Agrawal

Sole Arbitrator

Dated: 7th July, 2022