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INDIA NON JUDICIAL

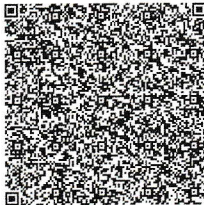
Government of National Capital Territory of Delhi

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e-Stamp

Certificate No.	: IN-DL95235794943590V
Certificate Issued Date	: 11-Nov-2023 12:37 PM
Account Reference	: SELFPRINT (PU)/ dl-self/ NEHRU/ DL-DLH
Unique Doc. Reference	: SUBIN-DLDL-SELF55353304575645V
Purchased by	: SANJEEV CHASWAL
Description of Document	: Article 12 Award - Movable
Property Description	: INDRP ARBITRATION NO 1764 OF PETSMART INTERNATIONAL IP HOLDINGS INC
Consideration Price (Rs.)	: 100 (One Hundred only)
First Party	: SANJEEV CHASWAL
Second Party	: NA
Stamp Duty Paid By	: SANJEEV CHASWAL
Stamp Duty Amount(Rs.)	: 100 (One Hundred only)

₹100



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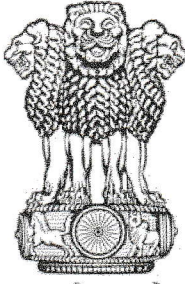
Please write or type below this line

IN THE MATTER OF INDRP CASE
NO 1764 OF M/s PETSMART
INTERNATIONAL IP HOLDINGS INC
VS MR PRASHANT BHEKRE

[Signature]
Sanjeev K
Chaswal
Sole Arbitrator

Statutory Alert:

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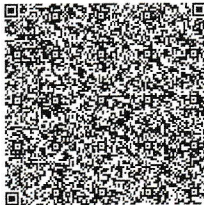
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**INDRP ARBITRATION
UNDER THE NATIONAL INTERNET EXCHANGE OF INDIA [NIXI]
ADMINISTRATIVE PANEL PROCEEDING
SOLE ARBITRATOR: SANJEEV KUMAR CHASWAL**

In the matter of Arbitration Proceeding for the Domain name

<petsmart.in>

and in the matter of INDRP Case no: 1764

**PETSMART INTERNATIONAL IP HOLDINGS, INC.
19601, N. 27TH Avenue,
Phoenix, Arizona 85027,
United States of America**

Complainant

Vs.

**Mr Prashant Bhekar
Bhagwati Internet Realty
Veena Appt, SV Patel Road,
Borivali West, Opp. Bhagwati Hospital,
Maharashtra INDIA**

..... Respondent

ORDER

History:

WHEREAS I, have been appointed by NIXI as sole arbitrator pursuant to the complaint filed by the complainant The Complainant in this administrative proceedings is M/s. Petsmart International Ip Holdings, Inc. 19601, N. 27th Avenue, Phoenix, Arizona 85027, United States of America is a American corporation with its principal place of business at United States of America represented through its authorized representative seeking invoking of arbitration proceedings, against the Registrant / Respondent M/s. Prashant Bhekar Bhagwati Internet Realty, in respect of domain name <petsmart.in>



The Complainant has filed the above arbitral complaint for Registrant / Respondent registering domain name <***petsmart.in***> and seeking a claim of relief of transferring the said domain name to the Complainant herein, thereby seeking a claim of relief for transferring the domain name to the Complainant herein.

As per the WHOIS record containing the address and the domain details of the Registrant / Respondent, the Complainant has filed the complaint before the office of the undersigned by incorporating the office address Registrant / Respondent in this administrative proceeding in respect of domain name <***petsmart.in***> >.

As such in the above said arbitral reference the sole arbitrator had issued the directions to the complainant and the Registrant / Respondent to comply notice of **10th October 2023** to file reply, detail statement, if any, **within 15 (fifteen) days from issue the date of this Notice**, the reply detail statement, if any should reach by **25th October 2023**. The complainant had served the notice to the respondent / registrant to their email address as listed in WHOIS records. As such the issued notice is duly served to the respondent / registrant.

The respondent / registrant namely M/s. Prashant Bhekare Bhagwati of Internet Realty, Veena Appt, SV Patel Road, Borivali West, Opp. Bhagwati Hospital, Maharashtra in respect of domain name <***petsmart.in***>, Registrant / Respondent has submitted its detailed reply, statement in the above arbitral reference, before **25th October 2023** under INDRP Rules and procedure.

1. The Parties:

The Complainant in this arbitration proceeding is M/s. Petsmart International IP Holdings, inc.19601, N. 27th Avenue, Phoenix, Arizona 85027, United States of America,, company incorporated under the laws of the USA, has invoked domain arbitration proceedings in respect of domain name <***petsmart.in***>against the Registrant / respondent M/s. Prashant Bhekare Bhagwati Internet Realty, Veena Appt, SV Patel Road, Borivali West, Opp. Bhagwati Hospital, Maharashtra seeking a claim of relief of transferring the said domain name to the Complainant herein.



2. The Domain Name and Registrar:

2.1 The disputed domain name <*petsmart.in*> is registered by the IN. registry registrar M/s. Endurance Digital Domain Technology LLP,.

3. Arbitration Proceedings Procedural History:

3.1 This is a mandatory arbitration proceeding in accordance with the IN Domain Name Dispute Resolution Policy [INDRP], adopted by the National Internet Exchange of India ["NIXI"]. The INDRP Rules of Procedure [the Rules] as approved by NIXI in accordance with the Indian Arbitration and Conciliation Act, 1996. By registering the disputed domain name with the NIXI accredited Registrar, the Respondent agreed to their solution of the disputes pursuant to the IN Dispute Resolution Policy and Rules framed there under.

According to the information provided by the National Internet Exchange of India ["NIXI"], the history of this proceeding is as follows:

3.2 In accordance with the Rules, 2(a) and 4(a), the NIXI formally notified the appointment to the Respondent as well as the Complaint, and appointed the undersigned as the Sole Arbitrator for adjudicating upon the dispute in accordance with the Arbitration and Conciliation Act, 1996, and the Rules framed there under. IN Domain Name Dispute Resolution Policy and the Rules framed there under.

The Arbitrator as submitted the Statement of Acceptance and Declaration of Impartiality and Independence as required by the NIXI.

As per the information received from NIXI, the history of the proceedings is as follows:

3.3 The present Arbitral Proceedings have commenced on 10th of October 2023 by issuing of 1st notice under rule 5(c) of INDRP rules of procedure and the same was forwarded through email directly to the Respondent / Registrant



as well as directing the complainant to serve the copies of the domain complaint along with documents in soft copies as well as physically or via courier or post to the Respondent / Registrant at the address provided in the record and the same was served by the complainant to the Respondent / Registrant

3.4 Further as per the issued Notice, the Respondent / Registrant was directed to file its reply, detail statement, if any, to the above said complaint within 15 (fifteen) days from the date of this Notice or by 25th of October 2023, failing which the Complaint shall be decided on the basis of the merits.

3.5 The respondent / registrant have submitted its detailed reply, or detail statement in the above arbitral reference. The Complainant has also submitted rejoinder reply / statement to the reply of the respondent herein in time bound manner

4. Factual Background:

4.1 The Complainant in this administrative proceedings is M/s. Petsmart International IP Holdings, Inc. 19601, N. 27th Avenue, Phoenix, Arizona 85027, United States of America by invoking this administrative domain arbitration proceeding through its authorized signatory, in respect of domain name <***petsmart.in***> against the Registrant / Respondent M/s. Prashant Bhakare Bhagwati Internet Realty Veena Appt, SV Patel Road, Borivali West, Opp. Bhagwati Hospital,.

5 Parties Contentions:

5.1 The complainant has submitted many legal submissions under INDRP Rules of Procedure for seeking relief transfer of the domain name against the Registrant / respondent for registering domain name <***petsmart.in***> illegally.

5.2 The Registrant / Respondent had submitted its reply or detailed statement to the sole arbitrator panel within 15 days of the issued notice but and the subsequently the complainant had also complied directions of the said notice as well in respect of filing rejoinder to reply of the respondent.



5.3 The complainant has raised three pertinent grounds under INDRP Rules of Procedure for seeking relief against the Registrant / respondent disputed domain name <*petsmart.in*>is stated as under:

I. To decide the matter there are Grounds for proceedings to be adjudged

A. The Complainant counsel states that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has statutory / common law rights.

B. The Complainant counsel states that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. That the disputed domain name has been registered or is/are being used in bad faith.

The Complainant has submitted its detailed contentions in their complaint that are described in details as under:

A. The Complainant counsel states that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has statutory/common law rights.

The Complainant's Claim of Statutory Rights:

5.4 The complainant submits that the complainant company was founded 1986 by Jim and Janice Dougherty, the Complainant opened its first two stores in 1987 in Phoenix, Arizona under the name Pet Food Warehouse. The company changed its name to PETsMART in 1989 and, along with expanding around the country, began a long term shift away from visually unappealing discount warehouse stores to attractive stores that sold pet food and supplies and offered services such as grooming, adoption events, and vet visits.



The company went public via an IPO in 1993, and thereafter increased its nationwide expansion and the types of goods and services it offered. Via its non-profit PETsMART Charities (now PetSmart Charities), it offered in-store dog and cat adoptions in lieu of selling dogs or cats, in order to combat the number of dogs and cats that are euthanized each year.

- 5.5 The complainant further submits that the complainant established in the USA in 1987, PetSmart provides a broad range of competitively priced pet foods and products, as well as services such as dog training, pet grooming, pet boarding, PetSmart Doggie Day Camp and pet adoption facilities. PetSmart, PetSmart Charities and PetSmart Charities of Canada work with nearly 4,000 animal welfare organizations and has helped more than 10 million pets find their forever homes; donated over \$500 million in grants to change-making organizations.

They also bring adoptable pets into stores so they have the best chance possible of finding a forever home. Through this in-store adoption program and other signature events, PetSmart has facilitated more than 9 million adoptions, more than any other brick-and-mortar organization.

- 5.6 The Complainant further submits that after opening nearly 300 stores in the U.S., in 1996 the company expanded to Canada. By 2002 the company had fully integrated its in-store, online, and catalogue sales. There was also the opening of an average of 100 new stores per year from 2002 through to 2009 in different parts of the world. In May 2017, PetSmart acquired Chewy, Inc., which through its ownership and operation of Chewy.com, is a leading online retailer of pet food and products in the U.S. PetSmart currently retains a controlling interest in Chewy.

- 5.7 In connection with their worldwide business and in order to distinguish and market its goods and services, the Complainant uses, inter alia, its renowned mark PETSMART in respect of numerous goods and services, particularly, food, treats, medicine, accessories etc. for domesticated animals.

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5.8 The Complainant further submits that the Complainant is a lawful proprietor of the mark PETSMART by virtue of honest adoption, long and continuous usage, worldwide registrations and voluminous sales of goods/services under the aforesaid mark and extensive promotional activities towards popularizing the said mark worldwide. Such is the worldwide popularity, international fame and repute of the mark that it is invariably and exclusively identified and associated with the Complainant and its business, and none else, by the consumers and members of the public.

5.9 The Complainant submits that owing to the rise in tourism worldwide, as well as the large number of Indians settled in foreign countries, many of whom care for pets of their own, citizens of this country are regularly exposed to various international brands, such as PETSMART of the Complainant. Additionally, the Complainant has been regularly and continuously manufacturing and trading in pet related goods from India since April 2015.

Thus the reputation and fame of the mark PETSMART can be said to have reached the Indian Territory and be prevalent among the relevant consuming public and members of the trade in India, who, accordingly, on coming across the mark PETSMART, invariably associate the same exclusively with the Complainant.

5.10 The Complainant further submits that in order to expand its business and safeguard its rights in the mark PETSMART in India, the Complainant has obtained registration of its mark PETSMART in India bearing no. 3379884 dated 03/10/2016 in class 35.

5.11 The Complainant further submits that by virtue of prior adoption, worldwide registration and use, the Complainant's mark PETSMART has gained immense popularity and attained the status of well-known mark within the provisions of Article 6bis of the Paris Convention and Sections 2 (1) (zg) and Section 11 (2),(6-7) and (10) of the Trade Marks Act, 1999.

A handwritten signature in black ink, appearing to be 'Sg' or similar, located at the bottom left of the page.

The mark PETSMART has become synonymous with the Complainant and their quality goods and services alone, and therefore the Complainant is exclusively entitled to use the mark PETSMART to the exclusion of all others and the Complainant is also entitled to prevent others from in any way using any identical and/or deceptively and/or confusingly similar mark for identical and/or similar and/or allied and/or cognate goods or services under the provisions of the Trade Marks Act, 1999..

- 5.12 The Complainant further submits that the essence of a mark is the association that it bears in the minds of the potential buyers of the goods/services in relation to which it is applied. In case of a mark, which is in extensive use and which has consequently acquired a goodwill and reputation of its own which is associated with its proprietor, its use by someone else is bound to give rise to confusion and deception as regards its source or origin. It is well settled principle of trademark law and practice that public interest is of paramount importance and that under no circumstances can any confusion or deception be permitted to occur as regards the source or origin of the goods/services in the minds of the members of the trade and / or general public

The Respondent and its use of the domain name:

- 5.13 The Complainant further submits that the Complainant recently came to the knowledge of the present Respondent's (Registrant) domain <petsmart.in> (hereinafter referred to as the "impugned domain") inter alia featuring an under-construction webpage, as on date. Accordingly, the Complainant retains legitimate apprehension regarding unauthorized misuse of the said impugned domain name which comprises of their trade name/trademark PETSMART in entirety.
- 5.14 It is further submitted that the Respondent's impugned name, "PETSMART" along with the corresponding impugned domain name <petsmart.in> can be seen to be incorporating the Complainant's trade name / trademark PETSMART in its entirety. It is a well-established principle of law, as upheld by Indian courts including in, but not limited to, the cases of:



Exide Industries Limited v. Exide Corporation; Subhash Chand Bansal v. Khadim's; Dr. Reddy's Laboratories Ltd. V. Reddy Pharmaceuticals Ltd., that where a name/mark incorporates the entirety of a pre-existing mark, then deceptive similarity must be presumed in regard to the lay consumer having average intelligence and imperfect recollection.

- 5.15 That the Respondent have been registering regularly many domain names, who has admitted to having more domain names besides the Complainant's trademark PETSMART in a standalone manner or as a part of other trademarks owned by the Complainant, the Registrant / Respondent has further admitted that he is not using the said domain name at present.

The disputed domain is identical or confusingly similar to a trademark of the Complainant

- 5.16 The disputed domain name <petsmart.in>incorporates the Complainant's "PETSMART" mark in its entirety. The alterations of the mark, made in forming the domain name, do not save it from the realm of confusing similarity. Precedents have shown that a domain name is identical to a trademark when the domain name contains or is confusingly similar to the trademark, regardless of the presence of other words in the domain name (*see INDRP Case No.861, Amazon Technologies, Inc. v. Surya Pratap; INDRP Case No.868, Amazon Technologies, Inc. v. Jack Worli*).

The Disputed domain <petsmart.in >entirely subsumes the Complainant's trademark "nearly identical to the Complainant's trademark "PETSMART". as the dominant part of the disputed domain remains the trademark "PETSMART".

- 5.17 The complainants submits that Numerous UDRP panels have agreed that supplementing or modifying a trademark with descriptive words does not make a domain name any less "identical or confusingly similar" for purposes of the Policy - *Inter Ikea Systems B.V. v. Polanski, WIPO Case No. D2000-1614 (transferring <ikeausa.com>);*



General Electric Company v. Recruiters, WIPO Case No.D2007-0584 (transferring <ge-recruiting.com>); Microsoft Corporation v. Step-Web, WIPO Case No. D2000-1500 (transferring <microsofthome.com>); CBS Broadcasting, Inc. v. Y2K Concepts Corp., WIPO Case No. D2000-1065 (transferring <cbsone.com>).

5.18 *In several UDRP decisions as well, various panels have found that the fact that a domain name wholly incorporates a Complainant's registered trademark is sufficient to establish identity or confusing similarity for the purpose of the Policy- PepsiCo. Inc. v. PEPSI SRL, D2003-0696 (WIPO Oct. 28, 2003), Oki Data Americas, Inc. v. the ASD, Inc. (WIPO Case No. D2001- 0903), Go Daddy.com, Inc. v. Shoneye's Enterprise (WIPO Case No. D2007-1090), Qalo, LLC v. Chen Jinjun and Magnum (WIPO Case No. D2018-2215) Piering Inc v. The Mudjackers (WIPO Case No. D2000-1525).*

5.19 *The Sole Arbitrator appointed in the matter of Google Inc. v. Mr. Gulshan Khatri (Case No. INDRP-189 May 06, 2011), in relation to the domain googlee.in, held that the act of registering a domain name similar to or identical with a well-known trade mark is an act of unfair competition whereby the domain name registrant takes unfair advantage of the fame of the trademark to either increase traffic to the domain, or to seize a potential asset of the trademark owner in the hope that the trademark owner will pay the requirement to relinquish the domain name. As such, the same principle is applicable here as well, since the Disputed domain completely subsumes the well-known trademark "PETSMART". of the Complainant.*

B. The respondent has no right or legitimate interest in respect of the domain name:

5.20 The complainant has submitted that the Respondent Given the Complainant's established rights, statutory as well as under common law, in respect of their prior adopted, used and registered well-known trademark and trade name, PETSMART, both in India as well as abroad, it may be further submitted that there is no affiliation or relationship between the Complainant and Respondent herein,



that may lead to presumption of allowance of their use of the Complainant's trade name/trademark PETSMART in respect of their much subsequent business. Furthermore, the Complainant has never, either expressly or by any implication whatsoever, permitted or authorized the Respondent's use of Complainant's prior adopted, used and registered well-known trade name/trademark PETSMART in respect of their business.

- 5.21 That the Complainant has not authorized or licensed the Respondent to use any of its trademarks in any way. Such unlicensed, unauthorized use of the disputed domain incorporating the Complainant's trademark is strong evidence that Respondent has no rights or legitimate interest in the disputed domain.
- 5.22 It is submitted that, given the Respondent-Registrant's name and other details being completely dissimilar, there does not appear to be any bona fide or legitimate reason for the Respondent to have chosen to adopt the Complainant's trade name/trademark PETSMART in respect of their business or domain name.
- 5.23 Further, in the words of the Sole Arbitrator in *Kraft Foods Global Brands, LLC v. Jet Stream Enterprises Limited, Jet Stream (Case No. D2009-0547)*“ while the overall burden of proof rests with Complainant, panels have recognized that this could result in the often-impossible task of proving a negative, requiring information that is often primarily within the knowledge of the respondent. Therefore, a Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests.
- 5.24 It is submitted that, having regard to the far subsequent date of registration of the impugned domain name, as compared to the Complainant's commencement of business under their trade name/trademark PETSMART, over 34 years ago now, the Respondent can claim no legitimate right or interest in the same in the absence of any express authorization, permission or license in this regard from the Complainant, being the prior adopter, user and registered proprietor of the well-known trade name/trademark PETSMART, and the only conceivable intention must be to ride upon the hard-earned reputation and goodwill of the Complainant's trademark and trade identity, with the dishonest and mala fide intent of making unlawful gains there from.



- 5.25 Once such a prima facie case is made, respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, a Complainant is deemed to have satisfied paragraph 4(a) (ii) of the UDRP. See Croatia *Airlines d.d. v. Modern Empire Internet Ltd., WIPO Case No. D2003-0455*; Belupo *d.d. v. WACHEM d.o.o., WIPO Case No. D2004-0110*.” It is submitted that the said threshold has been satisfied in the present instance.
- 5.26 In view of the above, the lack of rights or legitimacy of the Respondent in the impugned domain name <petsmart.in>, when compared with the Complainant’s prior adopted, used and registered well-known trade name/trademark, PETSMART, both in India as well as abroad, is conclusively established. The provisions of Paragraph 4(b) of the INDRP read with Rule 4(b)(vi) of the INDRP Rules of Procedure accordingly stand satisfied.
- 5.27 As per the Reply submitted by the respondent herein that the Respondent is not using the Disputed domain for bona fide offering of services and not making legitimate, non-commercial, and fair use of the Complainant’s trademarks as per the policy:

C. The Disputed domain name has been registered in bad faith:

- 5.28 The complainant has submitted that the Respondent is a habitual registrant who has admitted to having many domain names besides the Complainant’s trademark PETSMART, along with other trademarks owned by Complainant.
- 5.29 The complainant has submitted that the Respondent’s has subsequently adopted impugned name, “PETSMART” along with the corresponding impugned domain name <petsmart.in> can be seen to be incorporating the Complainant’s trade name/trademark PETSMART in its entirety, in respect of an identical and therefore conflicting line of business, in the absence of any manner of express authorization or license from the Complainant, being the prior adopter, user and registered proprietor of the well-known trade name/trademark PETSMART, is nothing but a blatant and mala fide act to impinge and illegitimately ride upon the hard-earned reputation and goodwill of.



- 5.30 The complainant has submitted that the Respondent's bad faith is further established by the fact that Respondent has made no bona fide use of the Disputed domain. As detailed above, the Disputed domain appears as a click bait for the Complainant's web analytics service under the trademark PETSMART.
- 5.31 It is further submitted that the Respondent's mala fide intentions and bad faith in their act of registering the subsequent and unauthorized impugned domain name <petsmart.in>, in which they can claim no legitimate rights or interest, is apparent from the fact that the same was being actively, blatantly and prominently used by the Respondent in respect of soliciting business for gain.
- 5.32 That having regard to Respondent's far subsequent registration of the impugned domain name <petsmart.in> which incorporates the Complainant's prior adopted, used and registered well-known trade name/trademark, PETSMART, in the absence of any statutorily granted rights in respect of the same in favour of the Respondent, there cannot be any conceivable legitimate or justifiable reason for the Respondent's adoption or use of the same, save in bad faith to acquire illegitimate enrichment from illicit use of the Complainant's trademark/trade identity to confuse, mislead and dupe unwary consumers and Internet users into believing that they are an extension of the Complainant's business, or in any way associated therewith.

Contention of the Complainant:

- 5.33 Firstly the Complainant submits that the Respondent has used the Complainant's well-known trademark 'PETSMART' as part of the impugned domain name <***petsmart.in***> in which the Complainant has legitimate right under common law as well as under statutory rights. The said acts of the Respondent, therefore, amounting to a infringement of the complainant's rights as are vested in the trade/service: mark 'PETSMART'
- 5.34 Secondly, the Respondent is well aware of the insurmountable reputation and goodwill associated with the Complainant's trade and service mark "PETSMART" which insures and continue to insure its legitimate right to Complainant only.



- 5.35 The Complainant has a long and well-established reputation in the Complainant's mark. By registering the disputed domain name with actual knowledge of the Complainant's trademark, the Respondent has acted in bad faith by breaching its service agreement with the Registrar because the Respondent registered a domain name that infringes upon the Intellectual Property rights of another entity, which in the present scenario is the Complainant. [***Relevant Decisions: Ray Marks Co. LLC v. Rachel Ray Techniques Pvt. Ltd., INDRP/215 (July 9th 2011); Kenneth Cole Production Inc. v. ViswasInfomedia, INDRP/93 (April 10, 2009)***].
- 5.36 The registration of the disputed domain name bearing the registered as a trade/service mark of the complainant is nothing but an opportunistic bad faith registration on the part of the Respondent.
- 5.37 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. With regard to famous brands, successive UDRP panels have found Bad faith registration where:
- a) ***Complainant's name was famous at the time of registration: Cho Yong Pil v. Sinwoo Yoon, WIPO-D2000-0310.***
 - b) ***Registration of a well-known trademark by a party with no connection to the owner of the trademark and no authorization and no legitimate purpose to utilize the mark reveals bad faith: America Online Inc. v. Chinese ICQ Network, WIPO-D2000-0808.***
 - c) ***The very use of domain name by Respondent who had no connection whatsoever with Complainant's mark and product suggests opportunistic bad faith: America Online Inc. v. Chinese ICQ Network, WIPO-D2000-0808.***
 - d) ***Thus, the Respondent is guilty of registering and using the disputed domain name <petsmart.in> in bad faith in terms of Para 7 of the INDRP.***



A. Contention of the Respondent:

- 5.38 The Respondent had filed detailed response to the Complaint to the sole arbitrator office, and the Respondent clearly stated that the respondent / registrant has not exploited or used the impugned domain name **<petsmart.in>** so far. Thus the Complaint of the complainant is considered on submissions on record and analyzing whether the Complainant has satisfied the conditions laid down in paragraph 4 of the policy.
- 5.39 The Respondent has submitted that the Respondent registered their first domain Bhagwati.net on 2001-10-05 the Respondent further submitted that the respondent booked petsmart.in. But also booked so many others domain names regularly. The Respondent has further submitted Similarly, the Respondent has bought many domain names like playstore.in, Upline.org and acquired the DavaBazaar.com domain too. The respondent has stated that most of the domain names are not in use.

6. Discussion and Findings:

- 6.1 It is evident that the Respondent knowingly chose to register and use the disputed domain name **<petsmart.in>** as the Respondent must have got report from domain registrar showing the report that the complainant is already owner of domain name and mark 'PETSMART" **while registering the domain name <petsmart.in>**, despite of knowing fully the respondent registration of the impugned domain name has adversely affecting the Complainant's goodwill and reputation and its right to use said India specific domain name. Doing so, it also violated Rule 3 clause (b) of INDRP, whereby a domain registrant declared that he would not infringe the intellectual property rights of others.
- 6.3 Once a complainant makes a prima facie case showing that a respondent lacks rights to the domain name at issue, the respondent must come forward with the proof that it has some legitimate interest in the domain name to rebut this presumption.



[b] The issues involved in the dispute:

As per the complaint herein, the Complainant in its complaint has invoked paragraph 4 of the INDRP which read as under:

"Brief of Disputes:

Any Person who considers that a registered domain name conflicts with his legitimate rights or interests may file a Complaint to the .IN Registry on the following premises:

(i) the Respondent's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;

(ii) the Respondent has no rights or legitimate interests in respect of the domain name; and

(iii) the Respondent's domain name has been registered or is being used in bad faith.

6.9 The Respondent / registrant is required to submit to a mandatory Arbitration proceeding in the event of a Complainant filed by a complaint to the .IN Registry, in compliance with this Policy and Rules there under."

6.10 According to paragraph 4 of the INDRP, there are 3 essential elements of a domain name dispute which are being discussed hereunder in the light of the facts and circumstances of this case.

I. The Respondent's domain name is identical and confusingly similar to a name, trademark or service in which the Complainant has rights.

6.11 The mark "PETSMART" has been highly known in both the electronic and print media; both in India and globally. According to the INDRP paragraph 3, it is the responsibility of the Respondent to find out before registration that the domain name he is going to register does not violate the rights of any proprietor/brand owner.



Paragraph 3 of the INDRP is reproduced below:

"The Respondent's Representations:

By applying to register a domain name, or by asking a Registrar to maintain or renew a domain name registration, the Respondent represents and warrants that :the statements that the Respondent made in the Respondent's Application Form for Registration of Domain Name are complete and accurate; to the Respondent's knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party;

the Respondent is not registering the domain name for an unlawful purpose; and the Respondent will not knowingly use the domain name in violation of any applicable laws or regulations. It is the Respondent's responsibility to determine whether the Respondent's domain name registration infringes or violates someone else's rights."

- 6.12 The Respondent / Registrant has failed in his responsibility discussed above and in the light of the pleadings and documents filed by the Complainant, the undersigned has come to the conclusion that the domain name <***petsmart.in***>, is identity theft, identical with or deceptively similar to the Complainants' "PETSMART" mark. Accordingly, the undersigned conclude that the Complainant has satisfied the first element required by Paragraph 4 of the INDRP.

II. The Respondent has no rights or legitimate interests in respect of the disputed domain name

- 6.13 The second element that the Complainant needs to prove and as is required by paragraph 4(ii) of the INDRP is that the Respondent has no legitimate right or interests in the disputed domain name.
- 6.14 Moreover, the burden of proof is on a Complainant regarding this element in the domain name lies most directly within the Respondent's knowledge and once the Complainant makes a prima facie case showing



that the Respondent does not have any rights or legitimate interest in the domain name, the evidentiary burden shifts to the Respondent to rebut the contention by providing evidence of its rights in the domain name.

- 6.15 The Respondent has submitted its detailed reply and admitted the respondent has registered many domains and has not produced any documents or submissions to establish his interest in protecting his own right and interest in the domain name.

Further, the Respondent is not commonly known by the disputed domain name and has not made any legitimate non-commercial or fair use of the disputed domain name.

Thus, it is very much clear that the Respondent has no legitimate right or interest in respect of the disputed domain name *<petsmart.in>*. For these reasons, the Arbitrator opines that the Respondent / Registrant have no rights or legitimate interests in the disputed domain name.

The disputed domain name has been registered or is being used in bad faith.

- 6.16 It has been contended by the Complainant that the Respondent / Registrant has registered and has used the disputed domain name in bad faith and rather done a identity theft on their back. The language of the INDRP paragraph 4(iii) is clear enough, and requires that either bad faith registration or bad faith use be proved.

- 6.17 The paragraph 6 of the INDRP Rules provides that the following circumstances are deemed to be evidence that a Respondent / Registrant has registered and used a domain name in bad faith: *"Circumstances indicating that the Respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name;*



or the Respondent 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 Respondent has engaged in a pattern of such conduct; or by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its Website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation or endorsement of its Website or location or of a product or service on its Website or location."

- 6.18 From the circumstances of the case and the evidences placed before me by the Complainant herein, I am of the opinion that the Respondent / Registrant had no previous connection with the disputed domain name and It has clearly registered the disputed domain name in order to prevent the Complainant, who is the owner of the said trademark from reflecting the said trademark in a corresponding domain name, It is clear case identity theft.
- 6.19 Moreover, the respondent has admitted in its reply that the respondent is not using presently impugned domain name, as impugned domain name **<petsmart.in>** is associated exclusively with the complainant, by the trade and public in India as well as all over the world. As such there will be no business loss, if the domain name **<petsmart.in>** is transferred back to the complainant.
- 6.20 Further the Respondent / Registrant has prevented the Complainant, who is the owner of the service mark "PETSMART" from reflecting in the domain name and also that the domain name is deceptively similar to the trademark of the Complainant and will lead to confusion with the Complainant's mark "PETSMART".

Thus, all the three conditions given in paragraph 6 of the Rules are proved in the circumstances of this case and thus the registration of the impugned domain name of the Respondent is a registered in bad faith.



7. DECISION

7.1 The Respondent / Registrant has failed to comply with Para 3 of the INDRP which requires that it is the responsibility of the Respondent / Registrant to ensure before the registration of the impugned domain name by the Respondent that the domain name registration does not infringe or violate someone else's rights other than the complainant herein

7.2 The Complainant has given sufficient evidence to prove its trademark rights on the disputed domain name thereby having prior registration of trademark. Further; the Respondent's registration of the domain name is dishonest and malafide knowing ly that complainant is a prior registrant.

The Respondent / Registrant have clearly registered the disputed domain name **<petsmart.in>** in order to prevent the Complainant, who is the prior owner and user of the said trademark from reflecting the said trademark in a corresponding domain name.

7.3 The Respondent / Registrant have not given any reasons other then claiming it PETSMART as a common word to register the domain name **<petsmart.in>** that is rightfully owned by the Complainant much prior to the respondent and therefore it can be presumed that the Respondent / Registrant had registered the domain name only to make monetary benefit by selling the domain name to the rightful owner or his competitor.

[Relevant WIPO decisions:

Uniroyal Engineered Products, Inc. v. Nauga Network Services D2000-0503; Thaigem Global Marketing Limited v. SanchaiAreeD2002-0358; Consorzio del FormaggioParmigianoReggiano v. La casa del Latte di Bibulic Adriano D2003-06611

7.4 It is a settled proposition that the registration of a domain name incorporating trademark has been upheld to be in bad faith and this contention upheld by numerous INDRP as well as UDRP decision.



Some notable cases reaffirming this proposition are INDRP decision in *Trivago N.V. is. Shiv Singh (INDRP/1 171)* and *WIPO decisions in Marie Claire Album v. Mari Claire Apparel, Inc., Case No D 2003 0767* another case *Verve ClicquotPonsardin, MaisonFortdée en 1772 v. The Polygenix group Co case Adidas D 2000 0163* and *Adidas-Solomon AG v. Domain Locations Case No D 2003 04*

- 7.5 While the overall burden of proof rests with the Complainant, The panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is often primarily within the knowledge of the Respondent. Therefore a 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, Respondent carries the burden of demonstrating rights or legitimate interests in the domain name.

Thus it is very much clear that the Respondent / Registrant has registered the disputed domain name in bad faith and 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.

[Relevant WIPO decisions: Croatia Airlines d.d. v. Modern Empire Internet Ltd. D2003-0455; Belupod.d. v. WACHEM d.o.o. D2004-01101

- 7.6 The Respondent's registration and use of the Domain Name is abusive and in bad faith. The Respondent / Registrant has no rights or legitimate interests in respect of the domain name. In my view, the Complainant has satisfied all the three requisite conditions laid down in paragraph 4 of the INDRP policy.
- 7.7 It has also well-settled and has been held by various Panels deciding under UDRP and INDRP that where the disputed domain name wholly incorporates the Complainant's registered trademark, the same is sufficient to establish the first element.



FAIRMONT Sons Ltd v. mmt admin / OkFAIRMONTbyebye.com (WIPO Decision Case No. D2009-0646), F. Hoffmann-La Roche AG v. Jason Barnes, ecnopt, WIPO Case No. D2015-1305, Swarovski Aktiengesellschaft v. meixudong, WIPO Case No. D2013-0150, Wal-Mart Stores, Inc. v. Domains by Proxy, LLC / UFCW International Union, WIPO Case No. D2013-1304

- 7.8 The prior decision of a Panel in ***M/s Retail Royalty Company v. Mr. Folk Brook INDRP/705*** wherein on the basis of the Complainant's registered trademark and domain names for "AMERICAN EAGLE", having been created by the Complainant much prior to the date of creation of the disputed domain name <americaneagle.co.in> by the Respondent, it was held that

"The disputed domain name is very much similar to the name and trademark of the Complainant. The Hon'ble Supreme Court of India has recently held that the domain name has become the business identifier. A domain name helps identify the subject of trade or service that entity seeks to provide to its potential customers. Further that there is strong likelihood of confusion that a web browser looking for AMERICAN EAGLE products in India or elsewhere would mistake the disputed domain name as of the Complainant."

- 7.9 It was observed that ***"it is the Registrant's responsibility to determine whether the Registrant's domain name registration infringes or violates someone else's rights"*** and since the Respondent failed to discharge such responsibility, it was held that the Complainant has satisfied the first element required by Paragraph 4 of the INDRP.

In the present dispute as well, the Respondent, in registering the disputed domain name, has done so in clear violation of the exclusive rights of the Complainant in the FAIRMONT name and mark. ***In Lockheed Martin Corporation v. Aslam Nadia (INDRP/947)***

The WIPO Administrative Panel in ***Veuve Clicquot Ponsardin, Maison Fondée en 1772 vs. The Polygenix Group Co., WIPO Case No. D2000-0163*** has been held that registration of a domain name,



so obviously connected with a well-known product that its very use by someone with no connection with the product suggests opportunistic bad faith. The Respondent is also guilty of the same.

- 7.10 As per pleadings submitted by the Registrant / Respondent's in this case, it is very much clear that the registration and use of the Domain Name **<petsmart.in>** is abusive and is not in good faith. The Registrant / Respondent has no legitimate right or interest in respect of the domain name in any manner.

In my considered view, the Complainant has satisfied all the three requisite conditions laid down in paragraph 4 of the INDRP policy thus able to prove his complaint .

In accordance to the INDRP defined Policy and Rules, the sole arbitrator directs that the disputed domain name **<petsmart.in>** be transferred from the Registrant / Respondent to the Complainant herein with a request to NIXI to monitor the transfer of domain name in time bound manner.



**SANJEEV KUMAR CHASWAL
SOLE ARBITRATOR
INDRP ARBITRATION NIXI**

NEW DELHI DATE 8th of November 2023