

**BEFORE ALOK KUMAR JAIN, SOLE ARBITRATOR
.IN REGISTRY
NATIONAL INTERNET EXCHANGE OF INDIA(NIXI)
INDRP ARBITRATION
INDRP Case No. 1810**

Disputed Domain Name: < CLUBMED.IN>

ARBITRATION AWARD

Dated 17.2.2024

IN THE MATTER OF:

CLUB MED SAS
11,RUE DE CANBRAI

PARIS

75019

Complainant

Versus

RAY WINSTON
1500 SW8 STREET
MIAMI
FL
33199
UNITED STATES

Respondent

1. The Parties

- 1 The Complainant in this administrative proceeding is CLUB MED SAS, a company incorporated under the Companies Act, 1956, having its registered office at 11, rue de Cambraj, Paris, 75019, France, represented by Joe Viviani, CSC Digital Brand Services

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Group AB. Telephone: c/o +1 302-636-5401x 60555 E-mail:
c/o udrp@cscglobal.com The authorised representative of the
Complainant is Joe Viviani, CSC Digital Brand Services Group AB
,Sveavägen 9, 10th floor, 111 57 Stockholm, Sweden ,Telephone: +1
302-636-5401x 60555 ,E-mail: udrp@cscglobal.com

1.1 Respondent in these proceedings is Ray Winston ,1500 SW8
Street, Miami, FL, 33199, United States ,Telephone: +1
305398188,Email: raywinstonus@hotmail.com

2. Domain Name and Registrar:-

The disputed domain name is <clubmed.in>, is registered with
Dynadot, LLC, address P.O. Box 345, San Mateo CA 94401,
United States iii. Telephone Number: +1 6502620100 iv. Fax
Number (if any): N/A E-mail Address: info@dynadot.com

3. Procedure History

3.1. This arbitration proceeding is in accordance with the .IN
Domain Name Dispute Resolution Policy (the "Policy")
adopted by the National Internet Exchange of India ("NIXI")
and the INDRP Rules of Procedure (the "Rules") which were
approved in accordance with the Indian Arbitration and
Conciliation Act, 1996. By registering the Disputed Domain
Name with a NIXI accredited Registrar, the Respondent
agreed to the resolution of disputes pursuant to the said Policy
and the Rules.

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

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3.2. The Complaint was filed by the Complainant with NIXI against the Respondent . On 11.1.2024 I was appointed as Sole Arbitrator to decide the disputes between the parties. I submitted statement of Acceptance and Declaration of Impartiality and Independence as required by rules to ensure compliance with Paragraph 6 of the Rules. NIXI notified the Parties of my appointment as Arbitrator *via* email dated 11.1.2024 and served by email an electronic Copy of the Complainant with Annexures on the Respondent at the email addresses of the Respondent.

3.3. I issued notice to the parties vide email dated 12.1.2024 directing the Complainant to serve complete set of Complaint on the Respondent in soft copies as well as in physical via courier /Post. The Respondent was directed to file its response within 10 days from the date of notice. No response was received from the Respondent within 10 days or thereafter till 22.1.2024. On 23.1.24 granted another opportunity to the Respondent to file its reply on or before 31.1.2024. However no response was received from the Respondent till 5.2.24. On 6.2.2024 I intimated the parties that now the matter will be decided on its own merit. Accordingly now the complaint is being decided on merit. No personal hearing was requested by any parties.

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3.4 A Complete set of Complaint was served by NIXI in electronic form by email to the Respondent on 11.1.2024 at the email provided by the Respondent with WHOIS, while informing the parties about my appointment as Arbitrator. Thereafter notice was sent vide same trailing email. All communications were sent to Complainant, Respondent and NIXI by the Tribunal vide emails. None of the emails so sent have been returned so far. Therefore I hold that there is sufficient service on the Respondent through email as per INDRP rules. The Respondent has not filed any response to the Complaint.

3.5. Clause 8(b) of the INDRP Rules requires that the Arbitrator shall at all times treat the Parties with equality and provide each one of them with a fair opportunity to present their case.

3.6. Clause 12 of INDRP Rules provides that in event any party breaches the provisions of INDRP rules and/or directions of the Arbitrator, the matter can be decided ex-parte by the Arbitrator and such arbitral award shall be binding in accordance to law.

3.7 As stated above, the Respondent failed to file any Response to the Complaint despite opportunities and chose not to answer the Complainant's assertions or controvert the Complaint and the contentions raised. As a result, I find that the Respondent

has been given a fair opportunity to present his case but has chosen not to come forward and defend itself.

- 3.8 Further Clause 13(a) of the Rules provides that an Arbitrator shall decide a Complaint on the basis of the pleadings submitted and in accordance with the Arbitration & Conciliation Act, 1996 amended as per the Arbitration and Conciliation (Amendment) Act, 2015 read with the Arbitration & Conciliation Rules, Dispute Resolution Policy, the Rules of Procedure and any by-laws, and guidelines and any law that the Arbitrator deems to be applicable, as amended from time to time.

In these circumstances the Tribunal proceeds to decide the complaint on merit in accordance with said Act, Policy and Rules on Respondent's failure to submit a response despite having been given sufficient opportunity and time to do so.

Discussions and findings:

The Complainant has invoked Clause 4 of the Policy to initiate the Arbitration Proceeding.

Clause 4 of the INDRP Policy provides as under:

4. Class of disputes:

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

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

Therefore in order to succeed in the Complaint, the Complainant has to satisfy inter alia all the three conditions provided in clauses 4(a),4(b) and 4(c) quoted above.

4.1 Condition 4(a):) the Registrant's domain name is identical and/or confusingly similar to a name, trademark or service mark in which the Complainant has rights;

I have gone through the complaint and perused all the documents annexed with the Complaint.

A perusal of the averments made in the complaint and the documents annexed shows that the Complainant is the owner of CLUBMED trade marks by virtue of its trade mark and service mark registrations as shown in **Annexure E** to the Complaint. Thus the Complainant has established its right in the CLUBMED trade marks.

A mere perusal of the disputed domain name **CLUBMED.IN** of the Registrant/Respondent shows that the Respondent has used the Complainant's trading mark 'CLUBMED' in its

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entirety. The disputed domain name second level “**CLUBMED**” is identical to the “**CLUBMED**” trade marks of the Complainant. It is well established that the addition of a TLD such as ‘.in’ is not significant in determining whether the disputed domain name is identical or confusingly similar to the mark.

It has been held by prior panels deciding under the INDRP that there is confusing similarity where the disputed domain name wholly incorporates the Complainant’s trade mark such as *Kenneth Cole Productions v. Viswas Infomedia INDRP/093*. Further, a TLD/ccTLD such as ‘.in’ is an essential part of domain name. Therefore, it cannot be said to distinguish the Respondent’s domain name <**CLUBMED.IN**> from the Complainant’s trademark ‘**CLUBMED**. This has been held by prior panels in numerous cases, for instance in *Dell Inc. v. Mani, Soniya INDRP/753*. In *M/s Retail Royalty Company v. Mr. Folk Brook INDRP/705*

The Complainant has acquired rights in the trade mark ‘**CLUBMED**’ by way of trademark registrations, and by virtue of use as part of their company since much prior to the date on which the Respondent created the impugned domain <**CLUBMED.IN**> incorporating the Complainant’s identical company name, trade mark and trade name **CLUBMED** in toto.

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The Respondent has not filed any response to the complaint as such all the averments of the complainant has remained un rebutted.

In view of the above facts and submissions of the complainant, and on perusal of the documents annexed with the Complaint, I hold that the Disputed Domain Name < **CLUBMED.IN**> of the Registrant is identical and or confusingly similar to the trademark **CLUBMED** of the Complainant.

6.2 **Condition no.4 (b) the Registrant has no rights or legitimate Interest**

The Complainant submits that the granting of registrations by IP India, USPTO, WIPO and EUIPO to Complainant for the **CLUB MED** trade mark is prima facie evidence of the validity of the term **CLUB MED** as a trade mark, of Complainant's ownership of this trade mark, and of Complainant's exclusive right to use the **CLUB MED** trade mark in commerce on or in connection with the goods and/or services specified in the registration certificates. Reference is made to **Annexure B** to complaint. It is further stated that the Respondent is not sponsored by or affiliated with Complainant in any way and Complainant has not given Respondent permission to use Complainant's trade marks in any manner, including in domain names. In the absence of any license or permission from the Complainant to use its

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trademark ,no actual or contemplated bona fide or legitimate use of the Disputed Domain Name could reasonably be claimed. Respondent is not commonly known by the Disputed Domain Name, which evinces a lack of rights or legitimate interests. The Respondent is using the Disputed Domain Name to redirect internet users to a SEDO website where the Disputed Domain Name is being offered for sale in an amount that far exceeds the Respondent's out-of-pocket expenses in registering the domain name, which serves as further evidence of Respondent's lack of rights and legitimate interests. Past Panels have consistently upheld this view. See *Siemens AG v. Tech Narayana Software Pvt. Ltd.*, INDRP/1260 (Sep. 1, 2020) (finding that registering a domain name "for impending the use of the domain name by the Complainant and awaiting its future resale" does not constitute a legitimate use nor confer any rights to the respondent). Further when it is a purposeful act to gain profits on the basis of business standing, reputation and credentials of others, this business cannot be considered as legitimate and lawful.

The Respondent registered the Disputed Domain Name on January 20, 2019, which is significantly after Complainant filed for registration of its CLUB MED trade mark with IP India, USPTO, WIPO and EUIPO, and also significantly after Complainant's first use in commerce of its trade mark in 1971. In addition, the Disputed Domain Name's registration date

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also falls significantly after the Complainant's registration of its domain names <clubmed.com>, <clubmed.us>, <clubmed.co.in> and <clubmed.asia>. See **Annexures B, C and E**

Thus the Respondent cannot claim to have been legitimately known under the name **CLUBMED**.

The Complainant has established its rights in the trade mark **S CLUBMED**. The mere fact that the Disputed Domain Name is registered does not imply that the Respondent has any rights or legitimate interests in them. In *Deutsche Telekom AG v. Phonotic Ltd.* (WIPO Case No. D2005-1000), it has been held that "*Registration of a domain name in itself does not establish rights or legitimate interests for purposes of paragraph 4(a)(ii) of the Policy*". Therefore, any use of the Disputed Domain Name by the Respondent is not a legitimate non commercial or fair use of, and it has no rights or legitimate interests in, the Disputed Domain Name.

The inclusion of the well-known mark '**CLUBMED**' in the Disputed Domain Name reflects the malafide intention of the Respondent to use the Dispute Domain Name for earning profits. Such a conduct demonstrates anything but a legitimate interest in the domain name. **The Sports Authority Michigan, Inc. v. Internet Hosting, NAF Case No. 124516** wherein it was held "*It is neither a bona fide offerings of goods or services, nor an example of a legitimate non-*

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commercial or fair use under Policy 4(c)(i) and (iii) when the holder of a domain name that is confusingly similar to an established mark uses the domain name to earn a profit without approval of the holder of the mark”.

The Respondent has not filed any response as such the facts stated in the complaint had remained unrebutted. Further the Respondent has failed to satisfy the conditions contained in clause 6(a),(b) and 6(c) of INDRP Policy.

On the contrary it is evident that the Registrant has no rights or legitimate interest in respect of the Disputed Domain Name and has never been identified with the Disputed Domain Name or any variation thereof. The Registrant's use of the Disputed Domain Name will inevitably create a false association and affiliation with Complainant and its well-known trade mark **CLUBMED**.

Therefore, in view of the submissions made in the complaint and on perusal of the accompanying documents, I am of the opinion that the Respondent has no rights or legitimate interests in respect of the domain name;

Accordingly I hold that the Registrant has no rights or legitimate interests in respect of the Disputed Domain Name.

6.3

Condition 4(C): the Registrant's domain name has been registered or is being used in bad faith

Clause 7 of INDRP Policy provides as under:

Clause 7. Evidence of Registration and use of Domain Name in Bad Faith For the purposes of Clause 4(c), the following circumstances, in particular but without limitation, if found by the Arbitrator to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (a) 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
- (b) 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
- (c) by using the domain name, the Registrant has intentionally attempted to attract 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.

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The Complainant stated that the Complainant and its CLUB MED trade mark are known internationally, with trade mark registrations across numerous countries and in India. The Complainant has marketed and sold its goods and services using this trade mark since 1971, which is well before Respondent's registration of the Disputed Domain Name on January 20, 2019. By registering a domain name that solely consists of Complainant's CLUB MED trade mark, Respondent has created a domain name that is identical to Complainant's trade mark, as well as its <clubmed.com> and <clubmed.co.in> domain names. As such, Respondent has demonstrated a knowledge of and familiarity with Complainant's brand and business. The composition, along with the fact that Respondent is offering the Disputed Domain Name for sale for such an extortionate amount, suggests that their registration was made with full knowledge of Complainant's CLUB MED trade mark, and the risk that the sale of such a domain name could pose for Complainant. In light of the facts set forth within this Complaint, it is not possible to conceive of a plausible situation in which the Respondent would have been unaware of the Complainant's brands at the time the Disputed Domain Name was registered. The numerous trade marks filed in connection with Complainant's business prior to Respondent's registration of the Disputed Domain Name, Complainant has been a leading provider of luxury all-inclusive resorts, as reflected by its 766,000 customers and operating income of €159 million in the

first half of 2023 alone, all of which demonstrates Complainant's fame and success. See **Annexure H**. Further, performing internet searches for **CLUB MED** on Google India and Yahoo! India returns multiple links referencing Complainant and its business. Complainant relies upon the case of *Caesar World, Inc. v. Forum LLC*, D2005-0517 (WIPO Aug. 1, 2005) wherein it was held that 'given the Complainant's worldwide reputation and presence on the Internet, indicates that Respondent was or should have been aware of the marks prior to registering the disputed Domain Name. **Annexure K** is referred in this regard.

The Respondent is merely using the Disputed Domain Name to redirect users to another website, where it offers the Disputed Domain Name for sale. Such actions constitute bad faith because Respondent has demonstrated an intent to sell, rent, or otherwise transfer the Disputed Domain Name for valuable consideration in excess of his out-of-pocket expenses. It is well established that seeking to profit from the sale of a confusingly similar domain name that incorporates a third party's trade mark demonstrates bad faith. Reference may be made to case of *Singapore Airlines Limited v. Wang Liqun*, INDRP/1227 (Jun. 29, 2020) (finding bad faith where "[Respondent's] only interest in the disputed domain name is to derive illegal money from its sale"). This is corroborated by the Indian Supreme Court decision in *American Home*

Products Corporation vs. Mac Laboratories Pvt. Ltd., wherein, at AIR 1986 SC 136, such practices were considered a “cardinal sin” of Trade Mark law.

The Respondent has ignored Complainant’s attempts to resolve this dispute outside of this administrative proceeding. Past Panels have held that failure to respond to a cease-and-desist letter may properly be considered a factor in finding bad faith registration and use of a domain name. The Complainant relies upon case of *Encyclopedia Britannica v. Zuccarini*, D2000-0330 (WIPO June 7, 2000) (failure to positively respond to a demand letter provides “strong support for a determination of ‘bad faith’ registration and use”). See **Annexure L**. Lastly , on balance of the facts set forth above, it is more likely than not that the Respondent knew of and targeted Complainant’s trade mark, and Respondent should be found to have registered and used the Disputed Domain Name in bad faith.

Thus from perusal of documents annexed with the complaint and the averments made in the complaint and the decisions relied upon by the Complainant, it is clear that the Respondent got the Disputed Domain Name registered in bad faith and in contravention of Paragraph 4(iii) of the Policy.

In this regard the decision of prior Panel in *M/s Merck KGaA v Zeng Wei INDRP/323* can be referred wherein it was stated that:

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“The choice of the domain name does not appear to be a mere coincidence, hut a deliberate use of a well-recognized mark... such registration of a domain name, based on awareness of a trademark is indicative of bad faith registration. ”

The Respondent had no reason to adopt an identical name/ mark with respect to the impugned domain name except to create a deliberate and false impression in the minds of consumers that the Respondent is somehow associated with or endorsed by the Complainant, with the sole intention to ride on the massive goodwill and reputation associated with the Complainant and to unjustly gain enrichment from the same.

In view of above facts, submissions of the Complainant and on perusal of the documents annexed with the Complaint , I find that the Complaint has proved the circumstances referred in Clause 7(a)(b) and (c) of INDRP policy and has established that the registration of disputed domain name is in bad faith.

Accordingly I hold that the Registrant's Domain Name has been registered in bad faith.

Decision

In view of the foregoing, I hold that the Disputed Domain Name is identical and or confusingly similar to the Complainant's well-known ‘CLUBMED’ Trademarks and that the Respondent has no rights or legitimate interests in

respect of the Disputed Domain Name and that the Disputed Domain Name was registered in bad faith.

In accordance with the INDRP Policy and Rules, I direct that the Disputed Domain Name registration be transferred to the Complainant.

Delhi
Dated 17.2.2024

Alok Kumar Jain
Alok Kumar Jain
Sole Arbitrator