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K 833589

No. 10124 Dt. 18/12/2007 Rs. 100/-
Sold To..... Harini Narayan Swamy
Sto./W/o./D/o..... B. Narayan Swamy No. 111
Whom..... Self

K. Rama Chandravathi
K. RAMA CHANDRAVATHI
STAMP VENDOR (LNO: 27/99 R.L.No. 20/2005)
6-3-387, Beside Banjara Durbar Hotel, Panjagutta,
HYDERABAD - 500 082 Phone. No: 23351799

IN THE MATTER BETWEEN

ITC Limited

V

Vishal

Case No. L-2/5-R3 OF 2007 -<iteportal.in>

ARBITRATION AWARD

THE PARTIES

The Complainant in these proceedings is ITC Limited, an Indian company with its principal place of business in Virginia House, 37, J.L.Nehru Road, Kolkata-700 071, India.

The Respondent in these proceedings is Mr. Vishal, #6-3-853/1 15, Ground Floor. Meridian Plaza, Ameerpet, Hyderabad 500016, India.

THE DOMAIN NAME

The disputed Domain Name is <itcportal.in>. The registrar of the domain name is NET 4 INDIA LIMITED. It was registered on February 25, 2005.

LAW, POLICY AND RULES APPLICABLE

This Arbitration Proceeding is conducted in accordance with the Arbitration and Conciliation Act of 1996, the .IN Domain Name Dispute Resolution Policy (the "INDRP Policy"), and the INDRP Rules of Procedure (the "Rules").

PROCEEDURAL HISTORY

The Complaint was filed with the .IN Registry in September 2007. The sole arbitrator appointed in the case is Mrs. Harini Narayanswamy. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, in compliance with the Rules.

A notification of commencement of Arbitration proceedings was sent to the Respondent under Paragraph 5 (c) of the INDRP Rules of Procedure on November 7, 2007. The Arbitration Proceedings accordingly commenced from this date. The Respondent was given fifteen days time to file a Response. The Respondent did not file a response.

The Arbitrator proceeds under paragraph 11 of the Rules, to determine the merits of the case, based on the submissions made by the Complainant and the documents on record.

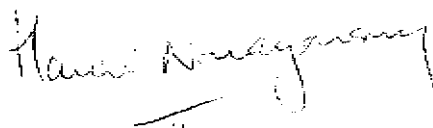
FACTUAL BACKGROUND

PARTIES CONTENTIONS

Complainant

Complainants Background and History

The Complainant is a leading multi-business company and carries on business under its well known trademark ITC. It states that it is one of India's foremost private sector companies



with a market capitalization of nearly US \$ 15 billion and a turnover of LS \$ 4.75 billion. It has provided a plethora of data regarding its popularity ratings. It is rated as one of the "Worlds Best Big Companies", Asia's "Fab 50", and one of the World's most reputable companies by Forbes magazine, among India's most respected companies by Business World and among India's top "Most Valuable Companies" as per Business Today. It also ranks as India's top ten most valuable (company) brands', in a study conducted by Brand Finance and published by the Economic Times, a leading daily newspaper. It has won the "World Business Award", a recognition awarded jointly by the UNDP, International Chamber of Commerce (ICC) and the HRH Prince of Wales International Business Leaders Forum (IBLF) to companies that have made significant efforts to create sustainable livelihood opportunities and enduring wealth in developing countries.

The Complainant has provided the history of its name since the year 1910, when it was incorporated under the name of Imperial Tobacco Company of India Limited. It states its ownership was progressively Indianised, and the Complainant changed its name to Indian Tobacco Company Limited by a certificate of Incorporation dated May 20, 1970. Thereafter the Complainant renamed itself "I.T.C Limited" by a fresh certificate of incorporation dated March 14, 1974, On September 18, 2001. its name was changed again to ""ITC Limited", and the Complainant has filed a copy of the certificate of incorporation as evidence.

Complainants" Business

In the initial years sixty years since its inception in 1910, the Complainant states, it was in the business of leaf tobacco and cigarettes. It started diversifying, into the hotel business for the purpose of earning foreign exchange, to create tourism infrastructure and to generate employment. It acquired the first hotel "ITC Welcome Group Hotel Chola" in the year 1975. The Complainant is presently owning and managing seventy properties across India. In the year 1979 the Complainant entered the Paperboards business. Its paperboard technology, productivity, quality, and manufacturing processes are, according to the Complainant, comparable to the best in the world. In 1990 it set up its International Business Division for export of Agri. commodities and is presently a leading exporter in India.

In the year 2000 the Complainant states its packing and printing business launched high quality greeting cards under the brand name "Expressions". In 2002, the product range was enlarged with the addition of gift wrappers, autograph books, and slam-books, and in the same year it launched "Expressions Matrubhasha" a vernacular range of greeting cards in eight languages and "Expressions Paperkraft", a range of premium stationary products.

In 2003 the Complainant launched school note books called "classmate". The Complainant's Food business was launched in 2001 with the "Kitchens of India" ready to eat gourmet dishes. In 2002, it entered the confectionery area with its brands "niint-o" and "Candyman" and in the staples segment with "Aashirvaad Atta"(wheat flour). "Sunfeasi" biscuits were launched in the year 2003, and Bingo snacks was launched in 2007. In a span of six years its food business grew significantly covering 150 products using diverse brands. All these businesses and brands are promoted under Complainant's house mark IK which is the umbrella brand of ITC Limited.

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The Complainant also entered Lifestyle retailing business in 2000 with its "Wills Lifestyle" stores selling Wills Sport Range of casual apparel. Its chain of stores has expanded its range to include formal wear and a popular segment called the John Players brand in 2002. It has also introduced "Wills Club Life" evening wear in 2003 and in 2005 it introduced "Essanza di Wills" an exclusive line of prestige fragrance products. In 2006 it partnered a premier fashion event, the Wills Lifestyle Indian Fashion Week, which it states is recognized by buyers and retailers as the single largest B-2-B platform for the fashion design industry. In a special celebration series it extended the event to consumers. In 2007, it introduced the "Miss Players" brand for young women.

The Complainant states it employs over 21,000 people in over sixty locations in India and its vast business includes cigarettes, Hotels, Paperboards & Specialty Papers, Packaging, Agri-business, Packaged Foods and confectionery, Information Technology, Branded Apparel, Greeting Cards, Safety matches and other FMCG products. The Complainant has filed copies of its Annual Reports for the years 2005, 2006, 2007 as evidence.

Complainants' Intellectual Property Rights

Through extensive use and publicity of the ITC mark, the Complainant states, its mark has increased in popularity over the years. It has acquired the status of a WELL, KNOWN TRADE MARK under Section 2 (1) (zg) of the Trademark Act 1999. The mark qualifies all tests for the "Well known status" under section 11 (6) of the Act which includes aspects like knowledge and recognition among relevant sections of the public, duration, extent and geographical area of use, promotion and publicity of the mark. It contends that the ITC mark can also be considered a famous mark under Article 6 *bis* of the Paris Convention.

The Complainant considers its mark a very valuable asset and has obtained several trade mark registrations for its mark and its variations in different jurisdictions. It has filed copies of its registration certificates as evidence. The Complainant has also provided the figures of the vast amounts it expends on promotional expenses for the period 2000 to-2007. For instance in the year 2006-2007 the Complainant's promotional expenses are to the tune of Rupees. 288.15 Crores.

The Complainant states that it assiduously protects its mark and has successfully obtained the domain name <itcthreadandneedle.com> in a dispute filed before the WIPO Arbitration and Mediation Center. Its ITC mark is an invented mark which is unique and distinctive. A mere mention of the ITC name establishes an identity in connection with the Complainant, and all rights to the name and the trademark belong to the Complainant. The use of the mark or name in any form by anyone not authorized would be an infringement of the Complainant's rights.

The Complainant states it has registered several domain names to conduct its important business over the Internet. It states that it has spent considerable resources in developing these websites. Some of the websites are:

Wavsv.itcportal.com, WWW.itccorpoarte.com, www.itcibd.com, www.itcsta.org,
www.itcbpl.com, www.itc.ppd.com, www.itcinfotech.com.

The websites, according to the Complainant, are a comprehensive guide to its business activities. **The Complainant states it adopted the www.itcportal.com domain name as a**

natural extension of its corporate name. A print out of the Home page of the Complainant's website is tiled as evidence.

Complainants' Legal Submissions

The Complainant states it has recently come to know that the domain name <www.itcportal.in> is registered by one Mr. Vishal. The Complainant alleges that the domain name is a verbatim copy (except for the suffix ".in") of the Complainant's domain name in the dot com gTLD. According to the Complainant this is evidence of the Respondent's *mala fide* intentions.

The legal grounds on which the present Complaint is filed are:

A. THE DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH I III COMPLAINANT HAS RIGHTS.

A mere glance at the disputed domain name, according to the Complainant, gives rise to confusion as to origin of the domain name and shows the *mala fide* intention of the Respondent. The Complainant cites the WIPO cases *Reuters Ltd Vs. Global Net 2000 Inc.* WIPO Case No. D2000-0441, *Altavista Company v. Grandtotal Finances Ltd.* WIPO Case No. D2000-0848, *Playboy Enterprises v. Movie Name Company* WIPO Case No. D2001 - 1201. It was held in those cases that the mere omission of one letter in a trademark has no effect on determining confusing similarity. The present case, according to the Complainant is on a higher footing as it is a verbatim copy without changing even one letter and it therefore constitutes infringement of Complainant's marks and cyber-squatting.

The Complainant further contends that the ITC mark and name is distinctive, unique and is an invented mark. Its mere mention establishes an identity and connection with the Complainant. The Complainant states it owns all rights including statutory and common law rights in the name and the Complainant is therefore entitled to protection under the Indian Trademarks Act 1999. Use of the name either as a mark, name or domain name or in any other form constitutes violation of its rights.

It is well established in domain name cases, that the suffix to indicate the top level of the domain name can be disregarded for the purpose of determining confusing similarity to the trademark in which the Complainant has rights. The Complainant cites the WIPO cases *Magnum Piering Inc. v. The Mudjacks and Grawood S. Wilson* WIPO Case No 2000-1525 , and *Rollerblade Inc. v. Chris McCrady*, WIPO Case No. D2000-0429, in this regard.

B. THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant alleges that Respondent is apparently in the business of holding domain names and selling them; whereas the Complainant is an established business doing business under the brand ITC since 1910. This according to the Complainant shows the Respondent lacks legitimate interests in the domain name and that it is merely being hoarded by the Respondent.

The Complainant argues that the Respondent has no proprietary or contractual rights in any registered or common law trademark, corresponding in whole or part, to the disputed domain

name. The Complainant further states that the Respondent is not authorized or licensed by the Complainant to use its trademark or to use the domain name. The Respondent is not running any website linked to the domain name and it is the contention of the Complainant that the Respondent is not doing any business using the domain name. The Complainant concludes that it can be inferred that the Respondent has no *bona fide* interest nor uses the disputed domain name for any legitimate non commercial or fair use. Complainant relies on the following decisions that have held that merely hoarding domain names with the intention of selling it for financial gain is illegitimate: *Gerber Products Company v. LaPorte Holdings* WIPO Case No. D2005-1277, *Aria Foods Amba v. Jucco Holdings* WIPO Case No. D2006-0409 and *Bits & Pieces Inc. v. LaPorte Holdings*, WIPO Case No. D2006-0244.

The illegality of the registration of the disputed domain name, according to of the Complainant, arises from the fact that domain names today are a part and parcel of corporate identity. A domain name acts as the address of the company on the Internet and can be termed the web address or a web mark just like a trademark or service mark: it is also the internet address of the company. The act of registration of the domain name by the Respondent therefore constitutes passing off as it contains its entire corporate name.

C. THE DOMAIN NAME WAS REGISTERED IN BAD FAITH AND IS BEING USED IN BAD FAITH.

The domain name has been registered in bad faith, according to the Complainant as it has been registered six years after the Complainant's domain name <itcportal.com>. The Complainant ascribes the following bad faith motives which the Respondent may have in registering the domain name:

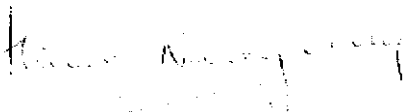
- (i) The domain name could be used by the Respondent to extract huge sums of money from the Complainant who has a legitimate business interest in the said domain name. This is evident as the Respondent is not running any website on the disputed domain name.
- (ii) The Respondent may be able to hold itself out as the Complainant and cause damage to some third party by entering into transactions or contracts with them under the garb of being associated with the Complainant. This can be extremely dangerous and prejudicial to public interest.
- (iii) The Respondent can transfer or sell the domain name to some competitor of the Complainant who can damage to the goodwill or reputation of the Complainant by inserting material prejudicial to the Complainant. This will lead to tarnishment of the Complainant's image if valuable property like the domain names falls into the hands of the competitors of the Complainant.

The Complainant requests in accordance with Rule 10 of the Policy for the transfer of the domain name and for costs.

Respondent

The Respondent did not file any response.

DISCUSSION AND FINDINGS

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Under the .IN Policy the Registrant of the domain name is required to submit to a mandatory Arbitration proceeding in the event that a Complaint is filed in the .IN Registry, in compliance with the .IN Policy and the INDRP Rules.

Under Paragraph 4 of the .IN Policy the Complainant has to establish the following three criteria:

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

The Arbitrator now proceeds to find whether the Complainant has discharged the burden of proof in respect of each of the three criteria referred to in Paragraph 4 of the Policy. In the absence of evidentiary hearings the Complainant has the burden of proving a prima facie case. The following are the findings, based on all the material on record.

Identical or Confusing similarity

The first criterion requires the Complainant to prove it has rights in the trademark, and that the domain name is identical or confusingly similar to this mark. Ample evidence has been provided by the Complainant of its longstanding and extensive use of its trademark ITC. It is established beyond reasonable doubt that the Complainant is the owner of the well known ITC trademark.

Clearly, the ITC mark has been used extensively in commerce for a sufficient length of time and the Complainant has also established in these proceedings that it has made enormous investments in terms of advertising and promoting its trademark in India. The Complainant has demonstrated that the ITC trademark is a highly distinctive one, and that it is used in several areas of business. The fame of the mark has been recognized in many previous domain name cases such as *ITC Limited v. Buy This Domain*, WIPO Case No. D 2002-0007 (March 12, 2002).

The Respondent has not filed a response. Given the strong distinctiveness of the Complainant's mark and its extensive use in commerce it is not conceivable that any *bona fide* intention can be shown by the Respondent in choosing the disputed domain of name. When a domain name wholly incorporates a well known trademark, it is held to be sufficient similarly. See *Parfums Christian Dior v. Javier Garcia Quintas and Christian Diornet*, WIPO Case No. D2002-0226. In the present case not only is the trademark entirely incorporated in the domain name, the second level domain name is identical to the Complainant's domain name in the dot com domain. Where the Respondent registers a domain name that is identical to the Complainant's domain name used for its official website in another domain it is held to be confusingly similar, See *Societe Air France v. Richard,!*, WIPO Case No. D2005- 0812.

In *Boehringer Ingelheim Pharma GmbH & Co.KG v. Philana Dhimkana*, WIPO Case No.2006 - 1594, it was held that, if a well known trademark was incorporated in its entirety, it is sufficient to establish that a domain name is identical or confusingly similar to the

Complainant's registered mark. Accordingly, the disputed domain name <itcportai.in>, is found to be confusingly similar to the Complainant's trade mark and is identical to the second level domain name in Complainant's domain name <itcporta!.com>. It is likely that the public and Internet users, in particular, may be confused to thinking that the disputed domain name is in some way associated with the Complainant. Clearly, by registering the domain name in this manner, the Respondent's domain name would create a likelihood of confusion with the Complainant's mark.

The Complainant has successfully established that the disputed domain name is identical to the trademark in which Complainant has rights and the Complainant has proved the first criterion under paragraph 4(i) of the .IN Policy.

Rights or Legitimate Interests

The Complainant has asserted that Respondent has no rights or legitimate interests to the disputed domain name for the reason that the mark ITC is well known and widely used by the Complainant. Use of another's trademark in the domain name does not confer rights or legitimate interests in favor of the owner of the domain name. See e.g. *America Online Inc., v. Xianfeng Fit* WIPO Case No.D2000-1374.

The Complainant's rights in the ITC mark predate the Respondent's registration of the domain name by a considerable length of time. There is not a scintilla of evidence of Respondent's rights in the absence of a response from the Respondent. This coupled with the fact that the Complainant's mark is very well known and is widely recognized, renders it doubtful that the Respondent could put forth any arguments that may establish any rights or legitimate interest in the Respondent's favor, See *General Electric Company v. LaPorte Holdings Inc.*, WIPO Case No. D2005-0076.

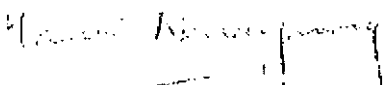
Based on all of the evidence on the record, and as discussed above, it is found that the second criterion under paragraph 4(i) of the .IN Policy, namely, that the Respondent has no rights or legitimate interest in the domain name has been established by the Complainant.

Bad Faith.

The Complainant has to establish that the domain name was registered and used in bad faith. The .IN Policy lists the following non exhaustive circumstances that would indicate bad faith registration and use:

"For the purposes of Paragraph 5(iii), 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:

- (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*

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(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

(Hi) 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."

The Complainant is undoubtedly a leading private sector company in India and it is reasonable to infer that the Respondent has registered the domain name knowing that it represents a well know trademark. Clearly, the trademark rights of the Complainant precede the Respondent's registration, in such circumstances the Respondent is presumed to have knowledge of the Complainant's mark. See *Sterling v. Sterling Jewelry and Domain Traffic*, WIPO Case No. D 2002-0772. It is fair to presume that the Respondent has registered the famous mark to capitalize on the Complainant's long history, its reputation, and its goodwill.

The evidence furnished by the Complainant also shows that there is no active use of the domain name. Non use and passive holding is also evidence of bad faith use. See *Bayer Aktiengesellschaft v. Henrik Monssen*, Wipo Case No.D2003-0275. Also see *Telstra Corporation Limited v. Nuclear Marshmallows* WIPO Case No. D 2000-0003.

The Complainant is apprehensive that there are several ways in which such domain names could be misused. In the present times, misleading customers online for the purposes of "phishing" or the practice of obtaining personal or financial information is rampant. The Complainant's customers may be misled to believe the domain name is endorsed by the Complainant and may divulge personal or other information. These and many other bad faith disruptive effects could be presumed by the use of such a domain name. The arbitrator recognizes that there are several ways in which the domain name could potentially be misused and the detrimental effects it could have on the Complainant's business.

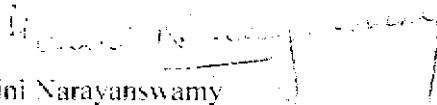
The Respondent is obviously aware of the commercial value of the name, and has registered the domain name for possibly deriving revenue from it. Further by registering the domain name, the Respondent has prevented the owner of the trademark from using the mark in a corresponding domain name. These aspects indicate both bad faith registration and bad faith use of the domain name.

The Complainant has successfully established the third criterion under paragraph 4(i) of the .IN Policy, that the domain name was registered and used in bad faith.

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DECISION

In the light of all that has been discussed above, it is ordered that the domain name <itcportal.in> be transferred to the Complainant. No costs are awarded as the Complainant has not demonstrated any actual loss due to the registration or use of the disputed domain name.


Harini Narayanswamy
Arbitrator

November 30, 2007