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ARBITRATION AWARD

.IN REGISTRY - NATIONAL INTERNET EXCHANGE OF INDIA
.IN domain Name Dispute Resolution Policy
INDRP Rules of Procedure

IN THE MATTER OF:

Kenneth Cole Productions, Inc.
603 West 50th Street,
New York, NY 10019,
U.S.A.

.....COMPLAINANT

VERSUS

Naveen Tewari,
1917, #2B Raheja Classique,
New Link Road,
Andheri (W),
Mumbai 400053,
India.

.....RESPONDENT

1 **The Parties:**

The Complainant is Kenneth Cole Productions, Inc.,
603 West 50th Street, New York, NY 10019, U.S.A.

The Respondent is Naveen Tewari, 1917, #2B
Raheja Classique, New Link Road, Andheri (W),
Mumbai 400053, India.

2. **The Domain Name and Registrar**

The disputed domain name **KENNETHCOLE.CO.IN**
is registered with Directi Internet Solutions Pvt.
Ltd. dba PublicDomainRegistry.com (R5-AFIN).

3. **Procedural History**

The Complaint was filed with the .In Registry,
National Exchange of India (NIXI), against
Mr. Naveen Tewari, 1917, #2B Raheja Classique,
New Link Road, Andheri (W), Mumbai 400053,
India. The NIXI verified that the Complaint together
with the annexures to the Complaint and satisfied
the formal requirements of the .in Domain Name
Dispute Resolution Policy ("The Policy") and the
Rules of Procedure ("The Rules").

- 3.1 In accordance with the Rules, Paragraph-2(a) and
4(a), NIXI formally notified the Respondent of the
Complaint and appointed me as a Sole Arbitrator
for adjudicating upon the dispute in accordance
with The Arbitration and Conciliation Act, 1996,
Rules framed there under, .In Dispute Resolution
Policy and Rules framed there under on March 2,
2009. The parties were notified about the
appointment of Arbitrator on March 4, 2009.



3.2 The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by NIXI to ensure compliance with the Rules (paragraph-6). The arbitration proceedings commenced on March 4, 2009. In accordance with the rules, paragraph 5(c). The Respondent was notified by me about the commencement of arbitration proceedings and the due date for filing his response.

3.3 The Respondent failed and/or neglected and/or omitted to file any response to the Complaint within 10 days as was granted to him by the notice dated March 04, 2009. The Respondent was again granted another opportunity to file its response within 5 days time by the notice dated March 16, 2009. The Respondent was again granted final opportunity to file its response within 2 days by the notice dated March 25, 2009 however, the Respondent did not file any reply to the Complaint filed on behalf of the Complainant.

3.4 The Panel considers that according to Paragraph-9 of the Rules, the language of the proceedings should be in English. In the facts and circumstances, in-person hearing was not considered necessary for deciding the Complaint and consequently, on the basis of the statements and documents submitted on record, the present award is passed.

3.5 The present award is passed within the period of 60 days from the date of commencement of Arbitration proceedings as per Paragraph-5 of the rules.

4. **FACTUALBACKGROUND**

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4.1 The Complainant: in these administrative proceedings is Kenneth Cole Productions, Inc. 603 West 50th Street, New York, NY 10019, U.S.A.

The Complainant requests arbitration proceedings in accordance with the Arbitration and Conciliation Act, 1996, .In Dispute Resolution Policy and rules framed there under and any bye-laws, rules and guidelines framed there under and any law that the Arbitrator deems to be fit and applicable to the proceedings.

4.2 The Complainant, Kenneth Cole Productions, Inc., is a corporation organized and existing under the laws of the state of New York, USA and having its registered office at 603 West 50th Street, City of New York, USA. The Complainant is a well known fashion house founded by Mr. Kenneth Cole, the eminent fashion designer in December 1982, specializing in manufacture and distribution of inter alia, clothing, men's and women's footwear, handbags and accessories such as watches, sunglasses.

4.3 The Complainant is the proprietor of many well known marks in the context of fashion goods. The products of the complainant are stylized and trendy and cater to a more sophisticated clientele. The products that are sold under a trademark KENNETH COLE are sold in part through a specialized channel i.e. through a Kenneth Cole stores. The nature of the products sold are centric on designing, trendy, styling etc. Thus the products of the complainant are under the Trademark KENNETH COLE having acquired reputation, goodwill and are highly distinctive. A list of countries where the Trademark Kenneth Cole is



registered and the list of Trademarks registered in India has been provided in Annexure-A and Annexure-B to the Complaint by the Complainant.

- 4.4 The Complainant successfully sells branded product through more than 6000 departments and specialty stores that carry their products under the trade mark KENNETH COLE. The complainant and its licensees operate more than 90 retail and outlet stores and sell through catalogs and web sites. The complainant is currently offering 30 product categories.
- 4.5 The complainant's goods under the mark KENNETH COLE have been sold extensively through branded stores in numerous countries such as Aruba, Bahrain, Bermuda, Chile, Colombia, Costa Rica, the Dominican Republic, Ecuador, EL Salvador, Guatemala, Holland, Korea, Kuwait, London, Mexico, Panama, Peru, Philippines, Taiwan, Thailand, United Arab Emirates, Venezuela, Hong Kong, Singapore, and the United States besides sales world over through multiple wholesale channels.
- 4.6 The Complainant has been on the Forbes annual list of the World's 200 Best Small Companies' since 1994. The Complainant has also ever since been named on Business week's list of Top Hot Growth Companies'.
- 4.7 It is submitted by the Complainant that Indian consumers, who have traveled abroad for tourism or study, are invariably exposed to and are fully aware of the reputation and goodwill enjoyed by the Complainant under its trademark KENNETH COLE. Furthermore, the Complainant's trademarks are

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advertised in a variety of magazine and media which is also freely available in the Indian markets.

4.8 The Complainant has a huge Internet presence including their own website www.kennethcole.com that provides information on their business activities, products. The homepage of the website has been attached as Annexure-G to the Complaint by the Complainant. The website also provides information about the range of products offered by them to their customers such as shoes, accessories, clothing, etc. The Complainant also allows for people to place orders for its goods through their web site www.kennethcole.com. Colour printouts of some of the web pages from the Complainant's website KENNETHCOLE.COM are annexed as Annexure-H to the Complaint by the Complainant.

4.9 The respondent in the present dispute is Naveen Tewari, 1917, #2B Raheja Classique, New Link Road, Andheri (W), Mumbai 400053, India.

4.10 The respondent has registered the disputed domain name KENNETHCOLE.CO.IN. The respondent has not submitted any response to the Complaint as has been filed by the Complainant in the above proceedings.

5. Parties Contentions

A Complainant

5A(1) The Complainant submits that, the disputed domain name KENNETHCOLE.CO.IN included the word KENNETH COLE, which is identical and confusingly similar as a whole to the well-known and registered trademark KENNETH COLE in which the Complainant has statutory rights as well as rights in common law,



by virtue of a long and continuous user and being its registered proprietor thereof.

5A(2) The Complainant further submits that the respondent is not commonly known by the domain name nor has he made any demonstrable preparation to use the disputed domain name KENNETHCOLE.CO.IN name in connection with a commercial purpose.

5A(3) It is submitted on by the Complainant that the respondent is not a license of the Complainant and neither has the Complainant granted any permission or consent to the respondent to use the trademark KENNETH COLE in any manner or to incorporate the same in a domain name.

The Complainant further submits that the respondent's website is not bonafide as the respondent in order to cause initial interest confusion and bait internet users to accessing its website, has registered the impugned domain name. No website has been uploaded on the said domain name and it resolves to the Complainant's website KENNETHCOLE.CO.IN.

5A(4) The Complainant puts on record that he has requested the respondent to cease and desist from using the domain name KENNETHCOLE.CO.IN through the letter dated September 8, 2008. The notice was returned as not claimed. No reply was received from the respondents in this regard and continued on the use of the said domain name in dispute. The Complainant thereafter sent a reminder letter dated October 31, 2008 and the same was returned. The lack of response indicates that the Respondent has no reason and/or justification for the adoption of the Complainant's trade mark KENNETH COLE. Copies of the letters along with AD card have been attached as



Annexure-N and Annexure-0 to the Complaint by the Complainant.

B Respondent

5B(1) The Respondent has been given three opportunities to file its response to the Complainant by the panel by its notice(s) dated March 04, 2009, March 16, 2009 & March 25, 2009.

5B(2) The Respondent has failed and/or neglected and/or omitted to file any response to the Complaint filed by the Complainant.

6 Discussions and Findings

6.1 The Complainant, while filing the Complaint, submitted to arbitration proceedings in accordance with the .In Dispute Resolution Policy and the Rules framed thereunder in terms of paragraph (3b) of the Rules and Procedure. The Respondent also submitted to the mandatory arbitration proceedings in terms of paragraph 4 of the policy.

6.2 Paragraph 12 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted and that there shall be no in-person hearing (including hearing by teleconference video conference, and web conference) unless, the Arbitrator, in his sole discretion and as an exceptional circumstances, otherwise determines that such a hearing is necessary for deciding the Complaint. I do not think that the present case is of exceptional nature where the determination cannot be made on the basis of material on record and without in-person hearing. Sub-Section 3 of Section 19 also empowers the Arbitral Tribunal to conduct the proceedings in the



manner it considers appropriate including the power to determine the admissibility, relevance, materiality and weight of any evidence.

- 6.3 It is therefore appropriate to examine the issues in the light of statements and documents submitted as evidence as per Policy, Rules and the provisions of the Act.
- 6.4 Under order 8 Rule 10 of the Code of Civil Procedure, the arbitrator is empowered to pronounce judgment against the Respondent or to make such order in relation to the Complaint as it think fit in the event, the Respondent fails to file its reply to the Complaint in the prescribed period of time as fixed by the panel.

The award can be pronounced on account of default of Respondent without considering statements or averments made by the Complainant on merit. However, in view of the fact that preliminary onus is on the Complainant to satisfy the existence of all conditions under the policy to obtain the reliefs claimed, the panel feels it appropriate to deal with the averments made by the Complainant in its Complaint in detail and to satisfy itself if the conditions under the policy stand satisfied.

The Complainant has filed evidence by way of Annexure A to O with the Complaint.

The Respondent has not filed its reply or any documentary evidence.

- 6.5 The onus of proof is on the Complainant. As the proceeding is of a civil nature, the standard of proof is on the balance of probabilities. The material facts pleaded in the Complaint concerning the



Complainant's legitimate right, interest and title in the trade mark, trade name and domain name KENNETHCOLE.CO.IN and the reputation accrued thereto have neither been dealt with nor disputed or specifically denied by the Respondent. The Respondent has not also denied the correctness and genuineness of any of the annexures filed by the Complainant along with the Complaint

- 6.6 Under the provisions of Order 8 Rule 5 of the Code of Civil Procedure, 1908 the material facts as are not specifically denied are deemed to be admitted.
- 6.7 The decision of Hon'ble Supreme Court of India in the matter of Jahuri Sah Vs. Dwarika Prasad -AIR 1967 SC 109, be referred to. The facts as are admitted expressly or by legal fiction require no formal proof, (see Section 58 of the Indian Evidence Act, 1872).
- 6.8 The Panel therefore accepts case set up and the evidence filed by the Complainant and concludes that the same stand deemed admitted and proved in accordance with law.
- 6.9 The Complainant has provided the WHOIS record that of domain name KENNETHCOLE.IN instead of KENNETHCOLE.CO.IN which is subject matter of this dispute as Annexure J to the Complaint.

The WHOIS record of the domain name KENNETHCOLE.CO.IN is as follows:-

Administrative Contact	Naveen Tewari,
Admin ID	N4IR-6579370241
Admin name	Naveen Tewari
Admin Organization	Mkhoj



Admin Street 1	1917, #2B Raheja Classique, New Link Road, Andheri (W) Mumbai
Admin City	Mumbai
Admin Postal Code	400053
Admin Country	IN
Admin Phone	+91.22.26717772
Admin email	Naveen.tewari@gmail.com

6.10 Paragraph 10 of the Policy provides that the remedies available to the Complainant pursuant to any proceedings before an arbitration panel shall be limited to the cancellation or transfer of domain name registration to the Complainant

6.11 Paragraph 4 of the Policy lists three elements that the Complainant must prove to merit a finding that the domain name of the Respondent to be transferred to the Complainant or cancelled:

- (i) the domain names are identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the domain names; and
- (iii) the domain names have been registered and are being used in bad faith.

That being so, the Panel will now proceed to examine if the Complainant has otherwise discharged its onus to prove each of the three elements specified in paragraph 4 of the Policy.

A. **Identical or Confusingly Similar**



6A.1 The Complainant submits that the disputed domain name KENNETHCOLE.CO.IN includes the word KENNETH COLE, which is identical and confusingly similar as a whole to the well-known and registered trademark KENNETH COLE in which the Complainant has statutory rights as well as rights in common law, by virtue of a long and continuous user and being its registered proprietor thereof.

6A.2 The Complainant further submits that due to the above mentioned factors, the trademark KENNETH COLE has acquired distinctiveness and is exclusively identified with the Complainant's goods. As such the use of the word KENNETH COLE in the domain name would be understood as a reference to the Complainant thus perpetuating confusion among consumers who wish to access the Complainant's web

The Complainant has filed the list of countries where the trade mark KENNETH COLE is registered as Annexure A to the Complaint.

The Complainant has also provided the registration details of the trade mark KENNETH COLE in India. This is annexed with the Complaint as Annexure-B.

The trade mark KENNETH COLE is registered in India in Class 25 vide trademark registration no. 1035056 and in Class 18 in trademark registration no 753897.

6A.3 The Respondent has not disputed any contentions raised by the Complainant in the Complaint. Therefore, the Complainant has been successful in proving that the domain name KENNETHCOLE.CO.IN is identical and/or confusingly similar to the



trademark KENNETH COLE of the Complainant. The Complainant has also successful in proving the first element by providing registration details of the trademark KENNETH COLE in India and other parts of the world.

B. Rights or Legitimate Interests

6B.1 The Respondent has no rights or legitimate interests in respect of the domain name.

6B.2 Paragraph 7 of the Policy lists the following three non-existence methods for determining whether the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to the Registrant of the dispute, the Registrant use of, or demonstrate 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;
- (ii) the Registrant (as an individual, business, or other organization) have 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 noncommercial 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.

6B.3 The Complainant submits that the domain name KENNETHCOLE.CO.IN resolves to the Complainant's web site www.kennethcole.com therefore, it is obvious that not only does the Respondent have knowledge of

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the Complainant's world famous trade mark KENNETH COLE but the only purpose behind registering the impugned domain name can only be to encash on the goodwill attached to the Complainant's trademark/name by selling the domain name for profit or in the alternative, preventing the Complainant from registering a domain name in which it has full legal rights.

6B.4 The Complainant further submits that the Respondent is not commonly known by the domain name nor has he made any demonstrable preparation to use the disputed domain name **KENNETHCOLE.CO.IN** name in connection with a commercial purpose.

6B.5 It is thus the Complainants contention that the Respondent has no rights or legitimate interest in the domain name as:

The Respondent is not a licensee of the Complainant and neither has the Complainant granted any permission or consent to the Respondent to use the trademark KENNETH COLE in any manner or to incorporate the same in a domain name.

The Respondent's website is not bonafide as the respondent in order to cause initial interest confusion and bait internet users to accessing its website, has registered the impugned domain name. No website has been uploaded on the said domain name and it resolves to the Complainant's website KENNETHCOLE.CO.IN.

6B.6 The Respondent did not dispute any of the contentions raised by the Complainant in its Complaint. The case set up by the Complainant is deemed to be admitted as not disputed by the Respondent.

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6B.7 The Panel, therefore holds that the circumstances listed above demonstrates rights or legitimate interests of the Complainant in the domain name KENNETHCOLE.CO.IN and holds that Respondent has infringed the rights of the Complainant by registering the Domain Name.

C Registered and used in Bad Faith

6C.1 For a Complainant to succeed, the Panel must be satisfied that a domain name has been registered and is being used in bad faith.

6C.2 Paragraph 6 of the Policy states circumstances which, if found, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the Registrant has registered or the Registrant 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 that complainant, for valuable consideration in excess of our 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 you have engaged in a pattern of such conduct; or
- (iii) by using the domain name, the Registrant has intentionally attempted to attract, Internet users to the Registrant website or other online



location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Registrant website or location or of a product or service on the Registrant website or location".

6C.3 The Complainant submits that the Complainant's KENNETH COLE mark is a well known mark and the Respondent is presumed to have had knowledge of Complainant's mark at the time it registered the confusingly similar domain name. Secondly, the domain name of the Respondent revolves around the Complainant's global web page. This indicates that the Respondent was well aware of the reputation and goodwill attached to the Complainant's trademark/name. Thus this is prima facie evidence of the Respondent's bad faith use and registration. The complainant had placed reliance on Rediff.com India Limited v. Mr. Abhishek Verma & Others. (L-1/1/R1), wherein the disputed Domain Name rediff.in was ordered to be transferred to the complainants. The panel held, "the disputed domain name was registered for the sole purposes selling, renting or transferring the same for monetary gains over and above the documented registration expenses". Therefore, it is submitted that the domain name has only been registered in bad faith for monetary gains. A copy of the award has been attached as Annexure-M.

6C.4 The Complainant further reiterate that the disputed domain name KENNETHCOLE.CO.IN registered by the Respondent incorporates as a whole the Complainants well known and famous trademark KENNETH COLE.

6C.5 The Complainant further submits that the Complainant has put the Respondent on notice of its illegal activities and has requested the Respondent to



cease and desist from using the domain name KENNETHCOLE.CO.IN through the letter dated September 8, 2008. The notice was returned as not claimed. No reply was received from the respondents in this regard and continued on the use of the said domain name in dispute. The complainant thereafter sent a reminder letter dated October 31, 2008 and the same was returned. The lack of response indicates that the Respondent has no reason and/or justification for the adoption of the Complainant's trademark KENNETH COLE.

The Copies of the letters along with AD card have been attached as Annexure-N and Annexure-O to net Complaint by the Complainant. Therefore, the Complainant submits that the fact that the Respondent has made no such efforts to desist from the use of the impugned Domain Name is prima facie proof of the Respondent's mala fide intentions.

Further, there is a great likelihood that an actual or potential visitor to the Respondent's present web page or any future web page that the subject domain name resolves to, will be induced to:

- Believe that the Complainant has licensed their trademark KENNETH COLE to the Respondent or has authorized the Respondent to register the . disputed domain name.
- Believe that the Respondent has some connection with the Complainant in terms of a direct nexus or affiliation with the Complainant or has been authorized by the Complainant.

6C.6 The Respondent does not dispute any of the contentions raised by the Complainant.



6C.7 The panel accepts the contentions of the Complainant as have been raised by them and holds that the registration of the domain name on part of the Respondent is in bad faith.

7. **Decision**

In view of the fact that all the elements of Paragraphs 6 and 7 of the policy have been satisfied and in the facts and circumstances of the case, the panel directs the Respondents to:-

- a) Transfer the domain name KENNETHCOLE.CO.IN to the Complainant.
- b) The panel finds that the respondent in the above matter is habitual cyber squatter and has been registering well known trade marks as the domain names. Reliance is made on case no. INDRP/82 concerning domain name armani.co.in.

For the foregoing reasons I direct respondent to pay to the Complainant a sum of Rs. 25,000/- towards the cost of proceedings.

27-4-2009



AMARJIT SINGH
Sole Arbitrator