



हरियाणा HARYANA

M 682657

**BEFORE THE NATIONAL INTERNET EXCHANGE OF
INDIA**

ARBITRATION AWARD

In The Matter Between

LIU. Jo S.p.A

Viale John Ambrose Fleming 17

00189 Capri

ITALY

Complainant

Versus.

He GUOQIANG

Genyu Road, GuiSi Industry Zone

Ningbo

Zhejiang 315206

CHINA

Respondent

Hanni Narayana

1. The Parties

The Complainant is LIU. Jo S.p.A of Capri Italy and is represented in these proceedings by Sujata Chaudhri and VC Mathews of IP Gurus of India.

The Respondent is He Guoqiang of Zhejiang of China.

2. The Domain name, Registrar and Policy

The present Arbitration proceeding pertains to a dispute regarding the domain name <liujo.in> (hereinafter referred to as disputed domain name). The registrar for the disputed domain name is Webiq Domains Solutions Pvt. Ltd. (R131-AFIN). The Arbitration proceeding is conducted in accordance with the Arbitration and Conciliation Act of 1996 (India), the .IN Domain Name Dispute Resolution Policy (the "INDRP Policy" or "Policy"), and the INDRP Rules of Procedure (the "Rules").

3. Procedural History

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. The Arbitrator received the Complaint from the .IN registry on October 24, 2013 and on October 26, 2013 transmitted by email a notification of commencement of the arbitration proceedings to the Respondent. Under the INDRP Rules, copies of the said notification were sent to other interested parties to the dispute. The Respondent was given twenty-one days time from the date of the notification to file a response.

Factual Background

The Complainant is an Italian fashion house founded in 1995 in Capri Italy. It sells high-end clothing and fashion accessories under the trademark LIU.JO since its inception. The Complainant has registered the trademark LIU.JO in several jurisdictions including India.

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The Complainant's Indian trademark registration details are: Indian trademark registration number 1509163 in classes 18 and 25 dated November 30, 2006.

The Respondent registered the disputed domain name <lujio.in> on July 25, 2011.

The Parties Contentions

A. Complainant's Submissions

The Complainant states it has evolved into a multinational Company since its inception in 1995 and does business across many continents, including Asia. The Complainant states its products bear its highly distinctive LIU.JO mark and its products are sold through its stores and through its website located at www.luijo.com. It states that it currently has more than 130 flagship stores and 4500 retail stores at which its trademarked products are sold in numerous countries including India. In the year 2010 the Complainant states its revenue crossed 5 billion US dollars and has been increasing steadily. The Complainant spends millions of dollars annually on advertisement and its advertisement campaign has featured the famous Kate Moss. In India the Complainant states it has manufactured its products bearing the mark for four years. Its products are sold in India through a retail store located in Ambience Mall Gurgaon. A print out from Complainant's website showing its store location has been filed as evidence.

Its products are of high quality and due to enormous commercial success the Complainant alleges that its LIU.JO mark has become extremely well known within the fashion industry. It is also well known among the public at large as a symbol of quality clothing and fashion accessories marketed exclusively by the Complainant.

The Complainant states it has statutory rights in the mark in more than 80 countries world over, including the United States, European Union, United Kingdom, Singapore and India. Certificates of its registered trademarks in various jurisdictions including India are filed as evidence.

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The Complainant states it has owned the domain name Luijo.com since 2009, and has filed a copy of the “Whois” record relating to the disputed domain name Luijo.it as evidence. The Complainant states that the registrant He Guoqiang has registered the disputed domain name on July 25, 2011 and has put it up for sale on the SEDO site. The Complainant contends that the Respondent has been a habitual offender and was named as a respondent in the case *Fendi Adele S.r.l v. He Guoquoqiqng* WIPO Case No.D2011-1309 (September 16, 2011) pertaining to the domain name FENDIKIDS.COM and is also named as the registrant of the domain names BLEDILAIT.COM and MIUMIU.CM.TW. The Complainant has filed as evidence the print out of the case *Fendi Adele S.r.l v. He Guoquoqiqng* WIPO Case No.D2011-1309 (September 16, 2011) and print outs of the “Whois” records of the domain names BLEDILAIT.COM and MIUMIU.CM.TW.

The Complainant states the disputed domain name is identical or confusingly similar to its mark in which it has rights and the Respondent has no rights or legitimate interests in the disputed domain name. The disputed domain name has been registered and used in bad faith as a domain name that incorporates a well-known mark registered by a person who has no relationship to the mark is itself evidence of bad faith. The Complainant states it has a well-established reputation through out the world, including China where the Respondent resides and therefore it is no co-incidence that the Registrant chose to register a domain name identical to the LIU.JO mark. The Respondent therefore ought to have known of the mark when he registered the disputed domain name because of its confusing similarity to the Complainant’s well-known mark.

The past conduct of the Respondent registering numerous domain names that incorporate well-known trademarks and being involved in a prior domain name dispute is evidence of his being a cyber squatter argues the Complainant. As the Respondent has offered the disputed domain name for sale, it is evidence that the disputed domain name has been registered primarily to sell it and not for use in connection with any legitimate business. The Complainant states that the disputed domain name has been registered to deprive the

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Complainant of its use, which shows the Respondent's bad faith motives and therefore requests for the transfer of the disputed domain name.

Respondent's Email Response and Complainant's replies:

The Respondent sent an email replies but did not file any formal response to the Complainant. In the Respondent's email he states "Liujo" is not a registered trademark, let alone a well known trademark in India before the registration of the disputed domain name. The Respondent further alleges that the said mark has not been used in India by advertisement or marketing activities and that no store or organization has been established by the Complainant using the brand LIUJO and therefore the Complainant is not entitled to civil rights (sic) or intellectual property rights concerning LIUJO and therefore is not entitled to claim the disputed domain name <liujo.in>.

The Complainant in its reply to the Respondent's email states that the Respondent's reply ought not be taken on record as it was sent after the stipulated time, it lacks merits and is unsupported by evidence. The Complainant asserts that there is no merit in the Respondent's statement that the Complainant has no trademark registration in India when the Complainant has obtained its trademark registration in India from the year 2006 and the disputed domain name was registered only in the year 2011. The Complainant further reemphasizes that it sells its products through a retail store in Gurgaon and also from its website that is accessible to Indian customers. As it advertises its products bearing the LIUJO mark in India, the Complainant states that it has demonstrated that it has statutory and common law rights in the LIUJO mark in India. The Complainant states it has also established that it has rights in the mark in other countries that predate the registration of the disputed domain name and requests for transfer of the disputed domain name and for award of costs.

The Respondent in reply to the Complainant's email states the email was originally sent on October 26, 2013, and argues that even if the Complainant has a trademark and store in Gurgaon, India before the domain name registration, it is doubted that it is supported

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by a competent government agency. The Respondent further argues that the Complainant did not conduct widespread advertisement to make LIUJO popular to Indian audiences and has not establishes its rights in the mark in India. As per the Respondent only when the trademark is made well known in a specific country, is the trademark owner entitled to claim related domain name in the country. The Respondent states that the Complainant is not the owner of the "liujo.cn" domain name in China, and this according to the Respondent is due to the reason that the Complainant's mark is not well known in China.

The Complainant in its reply disputes the Respondent's statement of any earlier response being sent. The Complainant strongly refutes the Respondents' allegation that it doubts products bearing the LIUJO mark being sold through a retail store in Gurgaon and that the Respondent has made an absurd argument that the store is not supported by a competent governmental agency. The Complainant emphasis that it has been selling its products in India and has filed as evidence print out from the website "The Collective" that shows the Complainant has been selling its trademarked products in India. The Complainant has also attached a printout of an article that shows its products are sold at "The Collective". The Complainant states that it has manufactured its products under the LIUJO mark in India for four years and as such this constitutes use in India.

The Complainant refutes the Respondent's contentions that the LIUJO mark is not well known in India and argues that it has provided proof of its statutory and common law rights in the mark. The Complainant further argues that its rights in the mark are not limited to India but exists around the world and these rights are sufficient to entitle the Complainant to the disputed domain name. The Complainant also argues that none of the three requirements under paragraph 4 of the INDRP Policy require a complainant to demonstrate that its mark is well known in India. The Complainant states it has met all three requirements under the Policy by demonstrating that the it has rights in the LIUJO mark, and that the Respondent does not have rights or legitimate interests in the disputed domain name and the disputed domain name was registered and used in bad faith by the Respondent.

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The Complainant refutes the Respondent's argument that a party is entitled to a domain name only if its trademark is well known in a country and argues that many companies register domain names under top-level country codes without ever having used their trademark in those countries. The Complainant further argues that that as per the Respondent's own argument, he is not entitled to claim rights in the disputed domain name without demonstrating that LIU.JO is well known, and states that the arguments by the Respondent are misleadingly. The Respondent's contention of the Complainant not obtaining a domain name under the ".cn" China country code is irrelevant argues the Complainant and states that companies are not required to register each and every domain name which would not only be burdensome and also defeat the purpose of proceedings under the Policy.

The Respondent replied to the Complainant's email stating that it disputes the statement that an earlier reply has not been filed and that the original; response was directly "replied" and not "replied all". The Respondent states that the Complainant has not proven the existence of a retail store in Gurgaon and its marketing activity using the mark that predates the domain name registration. Printout from the web site of the "The Collective", according to the Respondent does not prove the establishment date of the retail store or its marketing activity, and dismisses the document as meaningless. The marketing activity of "liujo" in India is too little to according to Respondent's research through a search engine. The Respondent states mark owners, like the Chinese name "liujo.cn/com.cn/" are not entitled to specific country code domain names unless the mark is successfully linked to mark owner by persuasive/substantial marketing activity, which according to the Respondent the Complainant has still failed to prove.

The Respondent then goes on to state that: ".. the Complainant said "it is not required to register each and every domain name", yet it tries to "grab" domain name from others. While the complainant fail to grab "cn" domain name under CN Domain Name Dispute Resolution Policy (CNDRP), which follows basically same rule of IN Domain Name Dispute Resolution Policy (INDRP) ..", and this fact is not "irrelevant" as argued by Complainant. The Respondent concludes by stating: "We believe Indian arbitrators are

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by no means less wise than Chinese arbitrator. ”

The Arbitrator sent an email to the Respondent on December 27, 2013, calling upon the Respondent to provide documents to prove the his rights in the disputed domain name and any evidence that may show whether he has been using the disputed domain name for a legitimate offering of goods or services, within seven days by email to the Arbitrator and hard copies by post to the INDRP Registry at Delhi. There was no reply or response from the Respondent.

Discussion and Findings

Under the INDRP 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 alleging that there has been a violation of Complainant’s rights. Paragraph 4 of the INDRP Policy mandates that the Complainant has to establish the following three elements to succeed in the proceedings:

- (i) The domain name is 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 name; and
- (iii) The Respondent’s domain name has been registered or is being used in bad faith.

Identical or Confusingly Similar

The first element requires the Complainant to prove that the domain name registered by the Respondent is identical or confusingly similar to a mark in which the Complainant has rights.

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The Complainant has submitted extensive evidence to show that it has rights in the LIU.JO trademark. Such evidence *inter alia* includes copies of its international trademark registrations and its Indian trademark registration in two classes. Trademark registration is considered *prima facie* evidence of rights in a mark, based on evidence on record, the Complainant is found to have established its rights in the trademark LIU.JO.

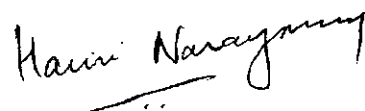
The disputed domain name consists of the LIU.JO trademark in its entirety with the omission of the dot between LIU and JO and the country code Top Level domain (ccTLD) “.IN”. The Arbitrator finds that the omission of the dot in the mark is insignificant and the mark has been reflected in the disputed domain name.

Accordingly, for the reasons discussed, the Arbitrator finds that the disputed domain name is identical and confusingly similar to a mark in which the Complainant has rights. The Complainant has satisfied the first element under paragraph 4 of the Policy.

Rights and Legitimate Interests

The second element requires the Complainant to show that the Respondent lacks rights and legitimate interests in the disputed domain name. It is sufficient for the Complainant to put forward a *prima facie* case regarding the Respondent’s lack of rights and legitimate interests.

The burden of proving rights or legitimate interests in the disputed domain name rests with the Respondent. Paragraph 7 of the Policy, provides a non-exhaustive set of circumstances that a respondent could rely on to establish rights in the domain name. These briefly are: (i) if before notice of the dispute, the respondent had used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services or (ii) the respondent (as an individual, business organization) has been commonly known by the domain name, or (iii) The respondent is making legitimate, non commercial or fair use of the domain name without intent for commercial gain.



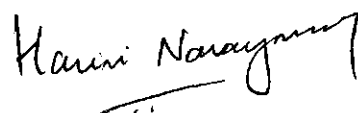
The Complainant has submitted that the Respondent has no rights or legitimate interests in the disputed domain name as the Complainant has not licensed or otherwise permitted the Respondent to use its mark. Further, given the international popularity of the LIU.JO mark and the fact that the Respondent has offered the disputed domain name for sale, the Complainant states that the Respondent has registered the domain name for purpose of exploiting the mark and therefore has no legitimate rights to the disputed domain name.

The Arbitrator finds that there is no evidence on record to show that the Respondent has made preparations to use the disputed domain name for a *bona fide* offering of goods or services or that the Respondent has been commonly known by the disputed domain name or makes any legitimate non-commercial fair use of the disputed domain name. The Arbitrator has provided the Respondent the opportunity to file evidence of his rights in the disputed domain name. The Respondent has not filed any material that demonstrates his rights in the domain name. In the absence of any material from the Respondent, and other material on record to indicate the Respondent has rights, it is found that the Respondent has not established any rights or legitimate interests in the disputed domain name.

Accordingly, for the reasons discussed, the Arbitrator finds the Complainant has made a *prima facie* case that the Respondent lacks rights and legitimate interests in the disputed domain name and has satisfied the second element under paragraph 4 of the Policy.

Bad Faith

Under the INDRP Policy the Complainant is required to establish that the domain name was registered or is being used in bad faith. The Complainant has urged that the Respondent has intentionally registered the disputed domain name to exploit its well-known trademark LIU.JO and the Respondent is a proven cyber-squatter. The Complainant has provided evidence of the Respondent having being named as a Respondent in a previous UDRP case, where he was found to have registered a domain

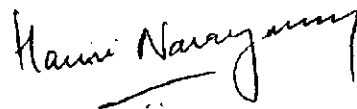


name in bad faith further he has advertised the sale of the disputed domain name, and there is evidence of his being the registrant of other domain names using others trademarks. The Arbitrator finds there is sufficient evidence that shows the Respondent has engaged in a pattern of behavior that is recognized as bad faith registration and use under the Policy.

The Arbitrator also finds there is absolutely no merit in the Respondent's arguments that the disputed domain name was registered prior to the Complainant having established its rights in the mark in India. The Complainant has clearly established its prior rights in the mark through its trademark registrations. The Arbitrator finds the record clearly shows the Complainant has obtained its trademark registration in India from November 30, 2006 whereas the disputed domain name was registered only in the year 2011. Therefore the Respondent's submissions are found untenable and without any basis.

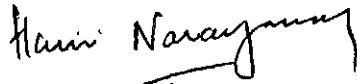
As discussed earlier it is found that the Complainant has adopted and used the mark LIU.JO extensively in several jurisdictions and its registered marks bear testimony to this fact. Under Paragraph 6 (iii) of the Policy, if the registrant of the domain name in dispute, has used the domain name to intentionally attract Internet users to the Registrant's website or other online location by creating a likelihood of confusion with the trademark of another, it is considered evidence of bad faith. The Arbitrator finds the circumstances here suggest that the Respondent seeks to use the Complainant's mark in the manner mentioned under Paragraph 6 of the Policy, namely to attract Internet traffic to the Respondent's website, or to sell the disputed domain name which is considered bad faith registration and use of the disputed domain name under the INDRP Policy.

Based on all the facts and circumstances of the case the Arbitrator has no hesitation in finding that the disputed domain name was registered in bad faith and has been used in bad faith. The Arbitrator finds the Complainant has satisfied the third element under paragraph 4 of the Policy.



Decision

For the reasons discussed, it is ordered that the disputed domain name <liujo.in> be transferred to the Complainant.



Harini Narayanswamy

(Arbitrator)

Date: February 10, 2014