

तमिलनाडु TAMILNADU

30 AUG 2019

Dr. Sudhir Raja Ravindran

BW 147584

V.BEDHARAJAN  
Stamp Vendor  
L.No: 12144/B1/96  
Ekkattuthangal, Ch-32  
Mobile No: 971001947

BEFORE THE SOLE ARBITRATOR, DR. SUDHIR RAJA RAVINDRAN

.IN REGISTRY

(NATIONAL INTERNET EXCHANGE OF INDIA)

.IN DOMAIN NAME DISPUTE RESOLUTION POLICY (INDRP)

ARBITRATION AWARD

DATED: August 30<sup>th</sup>, 2019

Piaggio & C.S.p.A.

Viale Rinaldo Piaggio 25 - 56025

Pontedera, Pisa, Italy.

COMPLAINANT

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**VERSUS**

**Xu Xiantao**

Xheda Road 38,

Hangzhou,

Zhejiang – 310027

CHINA

**RESPONDENT/REGISTRANT**

**DISPUTED DOMAIN NAME: "WWW.VESPA.CO.IN"**

**1. Parties**

1.1. The Complainant in this arbitration proceeding is represented by Mr. Luca Barbero, c/o Studio Barbero S.r.l, Corso Massimo d'Azeglio 57, 10126 Torino, Italy.

1.2. The Respondent in this arbitration proceeding, according to the WHOIS database accessed via the .IN Registry's website, is Xu Xiantao.

**2. The Dispute:** The domain name in dispute is **VESPA.CO.IN**. According to the WHOIS search utility of the .IN Registry, the Registrar of the disputed domain name is Endurance Domains Technology LLP.

**3. Calendar of Major Events:**

<b>S. No</b>	<b>PARTICULARS</b>	<b>DATE</b>
1.	Date on which NIXI'S letter was received for appointment as Arbitrator	<b>31.07.2019</b>
2.	Date on which consent was given to act as an Arbitrator	<b>31.07.2019</b>
3.	Date of appointment of Arbitrator	<b>05.08.2019</b>
4.	Date on which the Hard copy of the complaint was received	<b>07.08.2019</b>

5.	Date on which notice was issued to the Respondent	<b>07.08.2019</b>
6.	Due date for filing of Counter Statement by the Respondent	<b>14.08.2019</b>

#### 4. Procedural History

4.1. This arbitration proceeding is in accordance with the .IN Domain Name Dispute Resolution Policy (INDRP), adopted by the National Internet Exchange of India ("NIXI"). The INDRP Rules of Procedure ("Rules") were approved by NIXI on June 28, 2005 in accordance with the Indian Arbitration and Conciliation Act, 1996. By registering the disputed domain name with the NIXI accredited Registrar, the Respondent agreed to the resolution of the disputes pursuant to the .IN Dispute Resolution Policy and Rules framed thereunder.

4.2. In accordance with the Rules 2(a) and 4(a), NIXI formally notified the Respondent of the complaint and appointed Dr. Sudhir Raja Ravindran as the sole arbitrator for adjudicating upon the dispute in accordance with the .IN Domain Name Dispute Resolution Policy and the Rules framed thereunder and the Indian Arbitration and Conciliation Act, 1996 and the Rules framed thereunder. The Arbitrator submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the NIXI.

4.3. The Complaint was filed in accordance with the requirements of the .IN Domain Name Dispute Resolution Policy (INDRP).

4.4. On August 7, 2019, the Arbitrator issued a notice to the Respondent intimating the Respondent of the appointment of the Arbitrator and calling upon the Respondent to submit his response within seven (7) days, i.e. on or before August 14, 2019.

#### 5. Factual Background:

5.1. The Complainant is a company founded in the year 1884, initially producing locomotives and railway carriages, in Sestri Ponente, Italy. The Complainant is an Italian motor vehicle manufacturer, which produces a range of two-wheeled motor vehicles

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and compact commercial vehicles under seven brands: PIAGGIO, VESPA, GILBRA, APRILIA, MOTO GUZZI, DERBI AND SCARABEO. It has six research and development enters and operates in over 50 countries worldwide. The Complainant has reinforced its international presence with locations/additional offices/dealers in many countries worldwide, including all the European countries, Russia, Ukraine, Turkey, Georgia, Armenia, Azerbaijan, Bahrain, Cambodia, China, Hong Kong, India, Indonesia, Israel, Japan, Jordan, Lebanon, Malaysia, Oman, Philippines, Qatar, Saudi Arabia, Singapore, South Korea, Taiwan, Thailand, United Arab Emirates, Vietnam, Algeria, Angola, Gabon, Mauritius, Mayotte, Morocco, Reunion, Senegal, South Africa, Tunisia, Bermuda, Guadeloupe, Guatemala, Martinique, Canada, Mexico, USA, Australia, French Polynesia, New Caledonia, New Zealand, Tahiti, Argentina, Chile, Costa Rica, Ecuador, French Guiana and Uruguay.

5.2. The Respondent registered the disputed name **VESPA.CO.IN** on 1<sup>st</sup> May, 2014.

## 6. Parties Contentions

### 6.1. Complainant's Submission:

6.1.1. The Complainant claims that the company founded in the year 1884, initially producing locomotives and railway carriages, in Sestri Ponente, Italy. The Complainant is a Italian motor vehicle manufacturer, which produces a range of two-wheeled motor vehicles and compact commercial vehicles under various brand names including but not limited to VESPA.

6.1.2. The complainant claims that the Complainant has registered for its trademark "VESPA" in various countries including India and China, under class 12, 9, 18 and 28, the Indian trademark Application numbers are 156638, 2057160, 2089790, 596259, 2527567, 656992 and 75471.

6.1.3. The complainant claims that the Complainant has registered the domain name [www.vespa.com](http://www.vespa.com) on 23<sup>rd</sup> June 1997 and [www.vespa.in](http://www.vespa.in) on 20<sup>th</sup> October 2011 as set out in Annexure 5.1 and 5.2 of the Complaint.

6.1.4. The Complainant claims that the disputed Domain Name was registered on May 1, 2014, in the name of the Respondent, Xu Xiantao, well after Complainant's

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registration of the trademarks cited including in India and China. The Complainant states that at the time of drafting of the Complaint, the disputed Domain Name is redirected to a web page featuring several sponsored links to third parties' commercial websites, some of them also related to the Complainant's Trademarks and Products as set out in Annexure 6.2 of the Complaint. In addition, through the link "Buy this domain" published on the right side of the home page of the current version of the website to which the domain name is pointed <http://vespa.co.in/>, users are redirected to another webpage where they are invited to submit an offer for the domain name as set out in Annexure 6.3 of the complaint.

6.1.5. The Complainant claims that the Complainant instructed a web agency to contact Respondent in order to ascertain the Respondent's real intention as to the Domain Name and acquire information on any possible legitimate interest related to it. The Complainant claims that the web agency initially sent an email on October 4, 2016, requesting to Respondent which were his projects related to the Domain Name and the possible availability and conditions to assign it as set out in Annexure 7.1 and 7.2 of the Complaint. Respondent replied to that communication on October 5, 2016 as set out in Annexure 7.1 of the Complaint. The web agency answered to Respondent's email on October 10, 2016, indicating that the requested consideration was too high and requesting a discount and the Respondent on the same day replied, as set out in Annexure 7.2 of the Complaint.

6.1.6. The Complainant claims that since the bad faith of Respondent as to the Domain Name had clearly emerged from such exchange of communications, the web agency reported the communications received to Complainant. Further the Complainant claims that the Complainant then instructed its legal representatives to draft and send to the holder of the Domain Name a Cease and Desist letter, which was first addressed to Respondent on October 24, 2016 via registered mail and email to the addresses indicated in the Whois database, requesting that Respondent cease any use of the disputed Domain Name and transfer it to Complainant free of charge as set out in Annexure 7.3 and 7.4 of the Complaint.

- 6.1.7. The Complainant claims that after the receipt of such communication, the Respondent the same day replied requesting also the Representative of the Complainant a consideration well over the out-of-pocket costs directly related to the domain name as set out in Annexure 7.5 of the Complaint. Further the Complainant claims that, through its representatives, the Complainant reiterated the requests set forth in the Cease and Desist letter on October 6, 2016 as set out in Annexure 7.6 of the Complaint and after an additional reminder sent on November 9, 2016 as set out in Annexure 7.7 of the Complaint, the counterparty replied on November 9, 2016 stating they will support in both [www.Escrow.com](http://www.Escrow.com) and Sedo to transfer the domain safely and smoothly for 6000US\$ as set out in Annexure 7.8 of the Complaint.
- 6.1.8. The Complainant claims that due to the domain owner's failure to comply with Complainant's requests and in view of the fact that Respondent, notwithstanding receipt of the representative's Cease and Desist letter and subsequent follow up correspondence, continues to date to use the disputed domain name containing the Complainant's registered trade mark by redirecting it to a pay-per-click landing page and offering it for sale, Complainant instructed its representatives to file the present Complaint which falls within the scope of the INDRP.
- 6.1.9. The Complainant submits that the disputed Domain Name [vespa.co.in](http://vespa.co.in) contains the Complainant's trademark VESPA registered in India and other countries. Complainant further states that the disputed Domain Name is visually and phonetically identical to the trademark of the Complainant. Such registration by the Respondent amounts to a violation of Para 3 of the INDRP which states that a Registrant is solely responsible to ensure before the registration of the disputed domain name that such domain name registration does not violate the rights of any proprietor/brand owner.
- 6.1.10. The Complainant submits that the Complainant also reiterates that it is as well the owner of several websites which are accessible world over and are available for use by users globally including those in India and China, as also showed above. The

complainant states that the said websites contain extensive information about the Complainant and its products marketed and sold under the trademark "VESPA". Further Complainant states that in order to protect its trademark VESPA on the Internet and promote its brand online, Complainant registered numerous domain names for or incorporating VESPA or slight variations thereof under several different TLDs, including, inter alia vespa.com, registered on June 23, 1997 and vespa.in registered on October 20, 2011 as set out in Annexure 5.3. Complainant's site [www.vespa.com](http://www.vespa.com) has become the brand's global flagship, with its clean and elegant layouts which offer vivid and full-screen views of their motorcycles and related accessories as set out in Annexure 5.1 of the complaint.

6.1.11. The Complainant claims that it has painstakingly built up a good reputation worldwide and has invested substantial amounts of resources in advertising its products under the trademark "VESPA" in various international magazines, brochures, catalogues, Internet, other print and visual media and also through fairs, exhibitions and events. Complainant's activity under the trademark VESPA was and presently is strongly supported by intensive advertising campaigns worldwide, including in India. In light of Complainant's substantial investments in advertising, its marketing and sales worldwide, its consistent use of the trademark VESPA for decades, VESPA has become a well-known trademark worldwide.

6.1.12. Further the Complainant states the Complainant submits that upon perusal of the Respondent's website [www.vespa.co.in](http://www.vespa.co.in), it seems that the Respondent, besides redirecting the Domain Name to a web page featuring several sponsored links to other commercial web sites, is also attempting to sell it through a link published on the site where the disputed Domain Name resolves. Furthermore the Complainant states that Respondent, even after having received a Cease and Desist letter from Complainant's representatives, requested an amount well beyond the out of pocket costs for the transfer of the disputed Domain Name to Complainant.

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- 6.1.13. The Complainant states that the mere addition of the Top Level "co.in" to the disputed Domain Name does nothing to exclude confusing similarity of the disputed Domain Name with the Complainant's VESPA trademark.
- 6.1.14. The Complainant states that the Complainant submits that it has registered the domain name [www.vespa.com](http://www.vespa.com) on 23/06/1997 and [www.vespa.in](http://www.vespa.in) on 20/10/2011 whereas the disputed Domain Name [www.vespa.co.in](http://www.vespa.co.in) was registered by the Respondent on 01/05/2014. Complainant further states that such subsequent adoption and registration of the disputed Domain Name shows that the Respondent has no right or legitimate interest in the domain name [www.vespa.co.in](http://www.vespa.co.in).
- 6.1.15. The Complainant states that the Respondent is not a licensee or an authorized agent of Complainant or in any other way authorized to use Complainant's trademark VESPA. Further, the Complainant states that the Respondent is neither commonly/popularly known in the public nor has applied for any registration of the mark "VESPA" or any similar mark or has registered his business under the said name with the Ministry of Corporate Affairs, India, to the contrary, Respondent's name, according to the official Whois database, is "Xu Xiantao".
- 6.1.16. The Complainant states that the Respondent has not provided Complainant with any evidence of its use of, or demonstrable preparations to use, the Domain Name in connection with a bona fide offering of goods or services before any notice of the dispute. The Complainant submits that the disputed Domain Name has in fact intentionally created by the Respondent for commercial gain to misleadingly divert the consumers or traders of the Complainant to the disputed Domain Name, which has been and currently is redirected to a web page featuring several sponsored links to other commercial websites and where there is a link redirecting to a website where the Domain Name itself is offered for sale.
- 6.1.17. The Complainant states that the as a final remark on the issue of rights or legitimate interest, it is a consolidated principle that the burden of proof lies on Complainant. However, satisfying the burden of proving a lack of Respondent's



rights or legitimate interests in respect of the domain name according to Rule 4 (a) of the Policy is quite onerous, since proving a negative circumstance is always more difficult than establishing a positive one. Further states that it is sufficient that Complainant shows a prima facie evidence in order to shift the burden of production on Respondent.

6.1.18. The Complainant submits that the Respondent was aware of the Complainant's exclusive trademark rights at the time of registration and that it has been using the Domain Name in bad faith, as it was put on notice of the infringement of the Complainant's rights via Complainant's cease and desist letter sent on October 24, 2016 and subsequent correspondence but failed to comply with the Complainant's demands and continued its use of the Domain Name in an infringing manner.

6.1.19. Furthermore, the Complainant submits that the Respondent has deliberately registered the disputed domain name with the intention of preventing the Complainant who is the owner of the trademark VESPA from reflecting the said trademark in its domain name in India.

6.1.20. In support of its contentions, the Complainant/s relied on the decisions in the cases of Perfetti Van Melle Benelux BV v. Jing Zi Xin INDRP/665; La Roche-Posay Laboratoire Pharmaceutique v. Eac International Co., Limited INDRP/457; Shenzhen Yi SiLang E-Commerce Co Ltd v. Salim M INDRP/1046; Clarins v. Liheng INDRP/739; Calvin Klein Inc. v. M/s Hangzhou Gougou Internet Co. Ltd INDRP/704; Perfetti Van Melle Benelux BV v. Jing Zi Xin; ITC Limited V Travel India INDRP/065; Boehringer Ingelheim Pharma GmbH & Co. KG v Philana Dhimkana WIPO D2006-1594; Allied DOMECCQ Spirits and Wine Limited v Roberto Ferrari, INDRP/071); Philip Morris USA Inc. v Doug Nedwin/SRSPlus Private Registration WIPO D2014-0339. Further, it has been held in the matter of Disney Enterprises, Inc. v. John Zuccarini, Cupcake City and Cupcake Patrol WIPO D2001-0489; Clarins v. Liheng INDRP/739; Shenzhen Yi Si Lang E-Commerce Co Ltd v. Salim M INDRP/1046, , Pharmacia & Upjohn Company v. Moreonline. WIPO D2000-0134; Perfetti Van Melle Benelux BV v. Jing Zi Xin; Elektronik Sanayi ve Ticaret AS v. Mehmet Kahveci, WIPO D2000-1244; Paris Hilton

v. Deepak Kumar, WIPO D2010-1364; Fiskars Corporation v. Lina/Doublefist Limited INDRP/1067; Luigi Lavazza S.p.A. v. Flying Stingrays Ltd, WIPO D2012-1391; Lancome Parfums et Beaute & Compagnie v. D Nigam, Privacy Protection Services/Pluto Domains Services Private Limited, WIPO D2009-0728; Croatia Airlines d.d. v. Modern Empire Internet Ltd. WIPO D2003-0455; Belupo d.d. v. WACHEM d.o.o. WIPO D2004-0110, Sampo plc v. Tom Staver WIPO D2006-1135, Audi AG v. Dr. Alireza Fahimipour WIPO DIR2006-0003; Accor v. Jiangdeyun, WIPO D2011-227; Sparkol Limited v. Mr. Shripal INDRP/1069; The Ritz Carlton Hotel Company LLC v. Nelton! Brands Inc, INDRP/250; Future Brands LLC v. Mario Dolzer, WIPO Case No. D2004--,0718; ACCOR v. Mr. Young Gyoon Nah, WIPO Case No. D2004--,0681 and Deloitte Touche Tohmatsu v. Henry Chan, WIPO Case No. D2003--,0584; Telstra Corporation Limited v. Ozurls WIPO D2001-0046; Inter-IKEA Systems B.V v. Technology Education Center, WIPO D2000-0522; Volvo Trademark Holding AB v. Cup International Limited, WIPO D2000-0338.

6.1.21. The Complainant/s requests for the following relief: "that the disputed domain name www.vespa.co.in be transferred to the Complainant along with the costs of the proceedings be awarded to the Complainant and pass any such further and other orders as this Hon'ble Tribunal may deem fit in the circumstances of the case may require".

## 6.2. Respondent:

6.2.1. The Respondent did not file any reply to the Complaint.

## 7. Discussion and Findings

7.1. 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.

7.2. The .IN Policy, Paragraph 4 requires the Complainant, to establish the following three elements:

7.2.1. The disputed domain name is identical or confusingly similar to the trademark or service mark in which the Complainant has rights, and

7.2.2. The Respondent has no rights or legitimate interests in respect of the domain name;  
and

7.2.3. The Respondent's domain name has been registered or is being used in bad faith.

### **7.3. Identical or Confusingly Similar**

7.3.1. 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.

7.3.2. It is well established that trademark registration is recognized as prima facie evidence of rights in a mark. The Complainant by filing documents of its registered trademarks and has established that it has rights in the trademark "VESPA" in various Jurisdiction including India and also the owner of several websites which are accessible world over and are available for use by users globally including those in India and China

7.3.3. It is further evident that the Complainant has its rights on the trademark "VESPA" and this has been established in the following case laws listed in the Complaint *Perfetti Van Melle Benelux BV v. Jing Zi Xin INDRP/665* wherein it has been held that the domain name wholly incorporating a Complainant's registered trademark may be sufficient to establish identity or confusing similarity, despite the addition of other words to such marks. It was held that when a disputed domain name contains the trade mark in its entirety, the domain name is identical and confusingly similar, as confirmed in *La Roche-Posay Laboratoire Pharmaceutique v. Eac International CO., Limited INDRP/457* and *Shenzhen Yi SiLang E-Commerce Co Ltd v. Salim M INDRP/1046*.

7.3.4. The Arbitrator finds that the Complainant has satisfied the first element under paragraph 4 of the Policy.

### **7.4. Rights and Legitimate Interests**

7.4.1. The second element requires the Complainant to show that the Respondent has no rights and legitimate interests in the disputed domain name.

7.4.2. Under Paragraph 7 of the Policy, a Respondent or a registrant can establish rights in the domain name, if

7.4.2.1. before notice of the dispute, the registrant had used or made demonstrable preparations to use the domain name in connection with a bona fide offering of goods or services or

7.4.2.2. the registrant (as an individual, business organization) has been commonly known by the domain name, or

7.4.2.3. the registrant is making legitimate, non-commercial 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.

7.4.3. It is evident to the Arbitrator that the Respondent does not satisfy any of criteria mentioned in Paragraph 7 of the Policy, it is clear that the Respondent has attempted to unfairly capitalize on or otherwise take advantage of the Complainants' trademarks and resulting goodwill. This was also confirmed in *Fiskars Corporation v. Lina/Doublefist Limited INDRPI1067* where it was held that "The respondent's use of the disputed domain name is merely intended to divert costumers to respondent's website, which provides multiple pay-per-click links."

7.4.4. The Complainant has asserted that the Respondent has no rights or legitimate interests in the disputed domain name since the Respondent is using the domain name to divert/ redirect internet users who may be seeking the Complainant's service for commercial gains and that the Respondent has registered the domain name "www.vespa.co.in" mala fide with the sole motive to encash upon the goodwill and reputation of the Complainant. This view has been upheld *Sparkol Limited v. Mr. Shripal INDRP/1069*.

7.4.5. The Respondent has not responded in these proceedings and has not provided any material to show any rights in the disputed domain name. The Arbitrator finds no material on record to show that the Respondent is commonly known by the disputed domain name. If the Respondent does not put forward any evidence that it is known by the disputed domain name, it is a strong basis to infer that the

Respondent lacks rights. Further, there is no indication from the material on record that the Respondent is using the disputed domain name for any legitimate purposes such as non-commercial fair use purposes.

7.4.6. The Arbitrator finds the Complainant have made a prima facie case that the Respondent has no rights and legitimate interests in the disputed domain name and has satisfied the second element under paragraph 4 of the Policy.

#### **7.5. Bad Faith**

7.5.1. Under the INDRP Policy the Complainant is required to establish that the domain name was registered or is being used in bad faith. Proof of bad faith is a separate requirement. Information that is relevant to a consideration of the other ingredients of a claim can be relevant to bad faith inquiry, but it usually will not be sufficient to meet the Complainant's burden of proof.

7.5.2. The Complainant has asserted that the Respondent has registered and uses the disputed domain name in bad faith for the reasons that the Complainant has well-established rights in the trademark "VESPA".

7.5.3. The Respondent's intention to sell the domain name is evident from the email conversation produced by the Complainant is abundantly clear that the Respondent has purposely demanded an amount far more than its out-of-pocket costs for registration. Registering a domain name for the purpose of selling or transferring the domain name for excessive consideration is evidence of bad faith registration and use as held in *The Ritz Carlton Hotel Company LLC v. Nelton! Brands Inc, INDRP/250* and *Vodafone Group PIC v. Rohit Bansal, Case No. INDRP/052*.

7.5.4. Under Paragraph 6 (i) of the Policy, if the registrant of the domain name in dispute, has registered or circumstances indicate that he has 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. The Arbitrator finds the circumstances here suggest

that there is no other reasonable explanation for the registration of the disputed domain name by the Respondent.

7.5.5. For the reasons discussed, the Arbitrator finds the disputed domain name has been registered and used in bad faith under the Policy.

7.6. The above-mentioned contentions and submissions of the Complainant/s have not been rebutted by the Respondent, as such, they are deemed to be admitted by them.


## 8. Decision

8.1. The Complainant has successfully established the three grounds required under the Policy to succeed in these proceedings.

8.2. For reasons discussed, the .IN Registry of the NIXI is hereby directed to transfer the domain name [www.vespa.co.in](http://www.vespa.co.in) to the Complainant without any cost.

8.3. The Award is accordingly passed on this the 30<sup>th</sup> day of August, 2019.

Place: Chennai

  
Dr. Sudhir Raja Ravindran  
Sole Arbitrator