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तळमजला, क्रम नं. ७, गिरगांव, मुंबई-४

क्र. 1677 दिनांक

राजेशी/श्री/श्रीमती..... Uttamprakash Agarwal,

बांका क्र. 1096 या मुद्रांक विवेका,

Abhil
मुद्रांक विवेका

Officer

ARBITRATION PANEL DECISION

Monster.com (India) Pvt. Ltd. v. Domain Leasing Company

Case No. AA 2006-0012, Domain Name : monsterJn

1. The Parties

The Complainant in this Arbitration proceeding is Monster.com (India) Private Limited, (A wholly owned subsidiary of Monster Worldwide Inc.) ("the Complainant") company incorporated and existing under the Indian Companies Act, 1956 having a place of business in FC-23, Sector 16A, Film City, Noida, Uttar Pradesh, India. Represented before the Arbitration Panel by Mr, Rodney D. Ryder of Khaitan & Co., New Delhi, India.

The Respondent in this Arbitration proceeding is Domain Leasing Company ("the Respondent"), with a postal mailing address listed as 68, Johnston Road, Unit B-11/F Trust Tower, Wan Chai, China.

2. The Domain Name and Registrar

The disputed domain name is <monster.in>. The Registrar of the domain name is OnlineNIC ("the Registrar").

3. Procedural History

This is a mandatory administrative proceeding submitted for decision in accordance with the INDRP (.IN Domain Name Dispute Resolution Policy) for Domain Name Dispute Resolution, adopted by the National Internet Exchange of India ("NIXI") on 28th June, 2005, (the "Policy"), INDRP Rules of Procedure, approved by NIXI on 28th June, 2005, (the "Rules") and The Indian Arbitration and Conciliation Act, 1996, any bye-laws, rules and guidelines framed there under and any law by Indian Government.

By registering the disputed domain name with the Registrar, the Respondent agreed to the resolution of certain disputes pursuant to the Policy and the Rules.

According to the information provided by the National Internet Exchange of India (the ".IN Registry"), the history of this proceeding is as follows:

The Complainant filed its Complaint with the .IN Registry by email and hardcopy along with annexure.

The .IN Registry requested and obtained from OnlineNIC, the registrar of the disputed domain name, verification that the domain name is registered with OnlineNIC and the Respondent is the registrant for the domain name.

The .IN Registry having verified that the Complaint satisfied the formal requirements of the Policy and the Rules, the .IN Registry formally commenced this proceeding and delivered to the Respondent notice of the Complaint and commencement of this proceeding.

The .IN Registry sent an electronic copy of the Complaint to the Respondent by email (using the email addresses info@bbmt-bbk).

The Arbitrator with .IN Registry, CA. Uttam Prakash Agarwal (the Arbitrator), agreed to act as Arbitrator in this proceeding and filed the necessary Statement Of Acceptance and Declaration Of Impartiality And Independence, and on 20th Feb, 2006, was duly appointed by the .IN Registry. Absent exceptional circumstances, The Arbitrator was required to forward its decision to the .IN Registry within 60 days.

Based upon the information provided by the .IN Registry, the Arbitrator finds that all technical requirements for the prosecution of this proceeding were not met and On 25th Feb., 2006 notified to the .IN Registry about the compliance requirement under the Rules 3 (x) which was rectified On 6th March, 2006.

On behalf of the .IN Registry, The Arbitrator sent hard copy of the Complaint to the Respondent's postal address set forth in the registration information for the disputed domain name. The hard copy of the Complaint along with all annexure was successfully delivered on 10th March 2006.

The Respondent failed to file a reply within the prescribed time limits or at all, and on 8th April 2006, the Arbitrator given last chance to the Respondent to file the reply by 12th April 2006.



On 14th April 2006, the Complainant filed the copies of Trade Mark certificate registered in China and India (in PDF format), This submission is accepted by the Arbitrator as these submission was forming the part of annexure and not considered as additional submission in the case.

On 10th April 2006, the complainant demanded personal hearing, personal hearing granted to the Complainant under the Rules Para 8 (b) and Para 10, date for personal hearing is fixed on 14th April 2006, But on given dates the Complainant failed to appear before the Arbitrator. On 15th April, 2006 the Complainant was informed about forfeiting his amount deposited for personal hearing with IN Registry and also informed that no further personal hearing is allowed in this case due to his non appearance, but given the Complainant the last chance to file any further submission to the Arbitrator till 17th April, 2006.

On 17th April 2006, the Arbitrator delivered a Notification of Respondent Default to the Respondent.

On 18 April 2006, the Arbitrator delivered a Notification of Projected Decision Date to the parties.

The Arbitrator finds that he was appointed in accordance with the Rules.

4. Factual Background

The following information is derived from the Complaint and supporting evidence submitted by the Complainant.

The Complainant is online career services provider since 1994 with official websites in 23 countries around the globe and headquarters of the parent company at New York. Parent company is NASDAQ listed company and providing its services under the brand "Monster" worldwide. It is also ranked 29th most visited website on the internet, serving around 20 million job seekers per month. The Complainant in this process is a registered Indian company (Wholly owned subsidiary of Monster Worldwide Inc.) incorporated in 2001 as per the provisions of Indian Companies Act, 1956. The Complainant promoting its Indian operations since 2001 and in last year (2005) they had spent around 8.64 crores Indian Rupees on Marketing the website and it brand "Monster" in India.

The Complainant holds a United States trademark for "Monster" in various classes since 1997. Also holds "Monster" as registered trademark in around 105 countries and pending status mark in 9 countries including India in various classes. The complainant applied for "Monster" trademark in India on January 17th, 2000 and it is still in pending status. The Complainant also holds other Indian registered trademark where the word "Monster" is in prominent position. The mark "Monster" with such a huge reorganisation falls within the preview of "well known mark" under the Article 6 bis of the Paris Convention.

On detailed investigation, the Arbitrator also finds that the Complainant in the case is also holding the "monster.co.in" domain since August 31, 2003. and also holds other extensions of the domain with word "monster". The Complainant's parent company holds the .com version of domain (monster.com) since July 18, 1994.

The only information about Respondent comes from the Complaint and the Registrar's verification response. His registration includes Wan Chai, China address.

Respondent registered the Disputed Domain Name on February 16, 2005. the Respondent is not using the website and error "403 forbidden" message displays on site, which means "The server understood the request, but is refusing to fulfill it".

Parties' Contentions

(a) Complainant

The Complainant contends as follows:

- (i) The Complainant is the owner of the well-known "monster" trademark in the India and other countries, and the disputed domain name is identical/deceptively similar to the Complainant's mark.
- (ii) The Respondent has no rights or legitimate interests in respect of the disputed domain name. As the Respondent is not commonly known by "monster" name and the Complainant never permitted the Respondent in any manner to use the said mark.
- (iii) The Respondent registered and is using the disputed domain name in bad faith and 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, and also engaged in a pattern of such conduct.

(b) Respondent

As previously indicated, the Respondent has not filed any response to the Complaint and has not answered the Complainant's contentions in any other manner.

Discussion and Findings

The application of the Policy is limited to situations in which a complainant asserts the following: (i) the registered domain name is identical or confusingly similar to a 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; and (iii) the domain name has been registered and is being used in bad faith.

Now according to the Policy **burden of proof goes to the Respondent**, as the Policy adopted for .IN Disputes resolutions does not put the burden of proof of any of the above upon the Complainant. Rather it is the Respondent that must prove that it does not violate any of the above and must present evidence and convincing arguments to support the same. **This distinction is very important since the entire arguments are based on this.**

According to the Policy, it is not the responsibility of the Complainant to prove the non-compliance of the Respondent, but rather the responsibility of the Respondent to prove that they are compliant.

the Policy, specifically Para 3. As a reference below

" The Policy 3. The Registrant's Representations

By applying to register a domain name, or by asking a Registrar to maintain or renew a domain name registration, the Registrant represents and warrants that:

(a) the statements that the Registrant made in the Registrant's Application Form for Registration of Domain Name are complete and accurate;

(b) to the Registrant's knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party;

(c) the Registrant is not registering the domain name for an unlawful purpose; and



(d) the Registrant will not knowingly use the domain name in violation of any applicable laws or regulations.

It is the Registrant's responsibility to determine whether the Registrant's domain name registration infringes or violates someone else's rights."

The above quoted Para 3 of the Policy specifically lays out the **Responsibility of a Registrant** when registering a .IN Domain Name. The lines in the above Para 3 of the Policy clearly states the following -

(i) Firstly - "It is the Registrant's responsibility to determine whether the domain name infringes or violates someone else's rights". In this case, the Respondent, at the time of registering the domain name, should have ensured that they are not infringing the rights of any 3rd party or give some kind of proof that the Respondent has reasonably tried to check that they are not violating any 3rd party right. Since the domain name was being registered in the .IN Registry, a simple search by the Respondent in the Indian Trademark Registry, can established that whether they were violating the trademark rights of any 3rd party or not ?. OR even the search of Trademark database of his own country where the Respondent has address can establish that the Respondent has done some efforts to determine that he is not violating any 3rd party right.

(ii) Secondly - "to the Registrant's knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party;". Once again it is important to note here that the onus is on the Registrant to ensure that they are not infringing on any 3rd party rights.

(iii) Thirdly - by quoting the Policy and the Rules, The entire document does not state anything with regards to the Complainant being responsible for any evidence. It explicitly states the responsibility of the Registrant, thus reinforcing that the Policy puts the burden of proof on the Registrant and not the Complainant.

(a) The Respondent's Default

The Rules paragraph 8(b) requires that the Arbitrator ensure that each party is given a fair opportunity to present its case. The Rules paragraph 11(a) reads as follows:

11. Default

(a) In the event that a Party, in the absence of exceptional circumstances as determined by the Arbitrator in its sole discretion, does not comply with any of the time periods established by these Rules of Procedure or the Arbitrator, the Arbitrator shall proceed to decide the Complaint in accordance with law.

The Respondent was given notice of this proceeding in accordance with the Rules. The .IN Registry discharged its responsibility under the Rules paragraph 2(a) to employ reasonably available means calculated to achieve actual notice to the Respondent of the Complaint.

As previously indicated, the Respondent failed to file any reply to the Complaint and has not sought to answer the Complainant's assertions, evidence or contentions in any other manner. The Arbitrator finds that the Respondent has been given a fair opportunity to present its case, and the Arbitrator will proceed to a decision on the Complaint.

The Respondent's default does not automatically result in a decision in favour of the Complainant. Although proof of burden lies on the Respondent and in absence of the Respondent's reply, the Complainant still have to provide details that all



three elements required by the Policy paragraph 4 (i), (ii) and (iii) is in favour of the complainant.

The Rules paragraph 12(a) provides that the Arbitrator shall decide the Complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules, The Arbitration and Conciliation Act, 1996, any bye-laws, rules and guidelines framed there under and any law that the Arbitrator deems to be applicable. In accordance with Rules paragraph 12, the Arbitrator may draw such inferences as are appropriate from the Respondent's failure to reply to the Complainant's assertions and evidence or to otherwise contest the Complaint. In the circumstances, the Arbitrator's decision is based upon the Complainant's assertions and evidence and inferences drawn from the Respondent's failure to reply.

(b) The Complainant's Trademark Rights

The Complainant is the owner of the "monster" trademark registered in several countries including the "applied for" status in India, the Complainant also provided copies of some of the marks registered in India where the word "monster" features prominently into that. The Complainant also given copies of the trademark certificates which shows that "monster" is registered trademark in China too, where the Respondent has registration address.

"Monster" is well know trademark in several countries including India and China, the Policy Para 3 clearly states that Respondent should determine that domain name registration should not infringe or violates someone else's right. Since the "monster" is famous and well known mark and has presence in the Chinese market, it is unlikely that the Respondent does not know about the Complainant's rights in the domain name is very less.

In the absence of any response from the Respondent and in the circumstances, the Arbitrator finds that the disputed domain name is identical/deceptively similar to the Complainant's "monster" trademark. Accordingly, the Arbitrator finds that the Complainant has satisfied the first element required by the Policy.

(c) The Respondent's Rights and Legitimate Interests

The second element required by the Policy paragraph 4(ii) - the registrant has no legitimate right or interest in the domain name.

The burden on a complainant regarding the second element is necessarily light, because the nature of the registrant's rights or interests, if any, in the domain name lies most directly within the registrant's knowledge. And once the complainant makes a prima facie showing that the registrant does not have rights or legitimate interest in the domain name, the evidentiary burden shifts to the registrant to rebut the showing by providing evidence of its rights or interests in the domain name.

Even though the Respondent has not filed any reply to the Complaint and has not contested the Complainant's assertions, it is incumbent upon the Arbitrator to consider whether the Respondent's use of the disputed domain name demonstrates rights or legitimate interests in the domain name. According to the Policy paragraph 7, the following circumstances, if proved, demonstrate a registrant's rights or legitimate interests in a domain name:

- (i) *the registrant used or demonstrably prepared to use the domain name or a corresponding name in connection with a bona fide offering of goods or services prior to notice of the dispute;*
- (ii) *the registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if it has not acquired trademark rights; or*



(Hi) the registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the complainant's mark.

To satisfy the requirements of the Policy paragraph 7(i), the Respondent's use of the disputed domain name must be in connection with a "bona fide" offering of goods or services. In the circumstances of this case, however, the Respondent has not at all hosted any web page and on reaching the url in question "Error 403 forbidden page" message came. So Respondent not shown any use of the domain name and also not shown that the Respondent demonstrably prepared to use the domain name in future or a corresponding name in connection with a bona fide offering of goods or services.

The Policy paragraph 7(ii) is not applicable. The Respondent does not contend, and there is no evidence that, the Respondent has been commonly known by the disputed domain name or that the disputed domain name is derived from one of Respondent's trademarks or trade names.

The Policy paragraph 7(iii) is not applicable. The Respondent is not using the domain name at all.

The Respondent in this case not at all filed any response which clearly shows that the Respondent is not in the interest of protecting his own right and interest in the domain name which means that the Respondent don't have any legitimate interest in the said domain name.

For these reasons, the Arbitrator finds that the Respondent has no rights or legitimate interests in the disputed domain name.

(d) Bad Faith Registration and Use

The Policy paragraph 4(iii) requires the Complainant to prove that the Respondent registered and has used the disputed domain name in bad faith. The language of the Policy paragraph 4(iii) is clear enough, and requires that either bad faith registration or bad faith use be proved.

The Policy paragraph 6 provides that the following circumstances are deemed to be evidence that a registrant has registered and used a domain name in bad faith:

- (i) circumstances indicating that the registrant has registered or 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 the complainant, for valuable consideration in excess of its 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 the registrant has engaged in a pattern of such conduct; or*
- (Hi) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to its Website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation or endorsement of its Website or location or of a product or service on its Website or location.*

The Arbitrator is in opinion that the following part of Para 3 of the Policy:

"It is the Registrant's responsibility to determine whether the Registrant's domain name registration infringes or violates someone else's rights" is indirectly related to the Policy Para 6 (ii) which states that *"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" provided the trademark element (the Policy Para 4 (i)) is established in the case and the Respondent has engaged in a pattern of such conduct.

Firstly, the Policy's Para 3 clearly put the burden on the Respondent to check the 3rd party right before the domain registration and the Respondent knowingly or unknowingly proceed to register the domain name and if the Complainant's right established as per the Policy Para 4 (i) regarding trademark above then it is clearly establish that the Respondent has registered the domain name to prevent the mark owner from reflecting the mark in a corresponding domain name provided the Respondent has engaged in a pattern of such conduct which amounts to bad faith registration of domain name.

Secondly, not using the domain name and no web page is displayed on the said domain name, again indirectly it fulfils the condition of the Policy 6 (ii) provided the Para 4 (i) is established in the same case, as once the trademark owner's right is established as per the Policy Para 4(i) which means the Respondent is failed in fulfilling the duties provided in Para 3 of the policy and in result it will fulfils the conditions of the bad faith use of domain name provided the Respondent has engaged in a pattern of such conduct.

The Policy expressly states that these circumstances are without limitation.

The Complainant does not rely on the Policy paragraphs 6(i) or 6(iii).

The Policy paragraph 6 (ii)

The Complainant relies upon the Policy paragraph 6 (ii), arguing that the Respondent's registration of the disputed domain name prevents the Complainant from business name and trademark in a corresponding domain name and the Respondent also engaged in similar conduct as he has also registered the domain name "sears.in" which again is a famous brand of Sears, Roebuck and Co. in USA and Canada. However, the burden of proving again goes to the Respondent that he is not engaged in a pattern of such conduct and In the absence of any response and evidence of the required pattern of similar conduct by the Respondent, this ground of the complaint succeeds in favour of the Complainant.

A domain name is more than a mere Internet address. It is a identifier, It often identifies the Internet site to those who reach it, and sends a message that the site is owned by, sponsored by, affiliated with, or endorsed by the person with the name, or owning the trademark, reflected in the domain name.

Accordingly, the Arbitrator finds that the Complainant has established that the Respondent registered and is using the disputed domain name in bad faith pursuant to the Policy paragraph 6(ii).

7. Other

The Respondent in this case clearly failed in:

- (i) submission to a mandatory Arbitration proceeding as per the Policy Para 4.
- (ii) fulfilling representation and warrants as per the Policy Para 3. and
- (iii) proving the Policy Para 4.

Above actions of the Respondent shows that he merely blocked the disputed domain name.


8. Decision

The Respondent failed in his responsibility to determine whether the Registrant's domain name registration infringes or violates someone else's rights and also failed in proving that each of the three requirements set forth in the Policy paragraph 4 (i), (ii) and (iii).

The Arbitrator therefore directs that the registration of the disputed domain name be **transferred** from the Respondent to the Complainant.

The Panel also awards the **costs of Indian Rupees 5,000.00** (Indian rupee five thousands only) to the complainant pursuant to the Policy Para 10, the Respondent in the case has to pay the said costs to the Complainant within 30 days of this decision.

As per the Policy paragraph 11 copy of this decision or any part thereof can be published unedited on the .IN Registry website and in media.



CA. Uttam Prakash Agarwal
Arbitrator.

Dated: 20 May, 2006.