



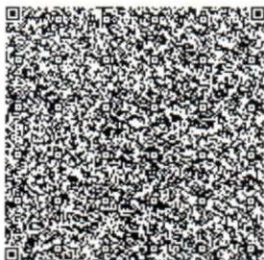
सत्यमेव जयते

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P.T.O

**BEFORE SMT. DEEPA GUPTA, SOLE ARBITRATOR OF
NATIONAL INTERNET EXCHANGE OF INDIA
.IN REGISTRY – NATIONAL INTERNET EXCHANGE OF INDIA
.IN domain Name Dispute Resolution Policy and INDRP Rules of Procedure**

ARBITRATION AWARD

DATED: June 30, 2014

In the matter of:

**M/s. Pangaea Laboratories Limited
240, Centennial Avenue Centennial Park
Elstree WD63SJ, UK**

Complainant

VS

**Mr. Mukul Agarwal
SCF 26, 2nd Floor,
Gurgaon-122001, Haryana
India**

Respondent

1. THE PARTIES:

The parties to domain name dispute are:

- (a) Complainant firm is **Pangaea Laboratories Limited, 240, Centennial Avenue Centennial Park, Elstree WD63SJ, UK.**
- (b) Respondent firm is: **Mr. Mukul Agarwal SCF 26, 2nd Floor, Gurgaon-122001, Haryana, India.** It has presence on internet with domain name of www.nanogen.co.in which is subject of dispute.

2. THE DOMAIN NAME IN DISPUTE, REGISTRAR AND POLICY

- i. The disputed domain name is www.nanogen.co.in registered with the DOT IN Registry through the Direct Internet Solutions Pvt. Ltd.
- ii. The registrar NIXI is Flat no. 6B, Uppal, M 6 Plaza 6, Jasola District, New Delhi-110025
- iii. The Arbitration Proceeding is conducted in accordance with the Arbitration and Conciliation Act of 1996 (India), the current .IN Domain Name Dispute Resolution Policy (the "INDRP Policy"), and the INDRP Rules of Procedure (the "Rules").
- iv. Paragraph 4 of the Policy and paragraph 3(b)(vi) of the Rules states:
 - (a) The Infringing Domain name is identical or confusing similar to a trademark or service mark in which complaint has rights,
 - (b) The respondent has no rights or legitimate interest in respect of Infringing Domain Name, and
 - (c) The Infringing Domain Name should be considered as having been registered and is being used in bad faith.



3. BRIEF BACKGROUND

FACTUAL AND LEGAL GROUNDS

Company Pangaea Laboratories Ltd. Was established in 1999 as a biotech start-up. Its recognized the world over for world class skin care and hair care products sold under brand 'NANOGEN' and others. Companies products bearing the mark 'NANOGEN' are used by the plastic surgeons and found in the windows of the world's most posh department stores. Companies professional skin care (known in the market as Medik8), hair care (known in the market as Nanogen) make up products (known in the market as Magnifibers /Lashfibres) are very popular. The company started its operation in India way back in the year 2004.

Company is the proprietor of the trade mark 'NANOGEN' and have several patents for skin and hair cosmeceutical ingredient, product and packaging inventions.

Company has long and consistent use of the trade mark 'NANOGEN' & has acquired certain distinctiveness and has become well known worldwide.

Company owns worldwide trademarks and registrations pertaining to the trade mark 'NANOGEN'. Company is also the owner of several domain names consisting of the mark 'NANOGEN' through which it provides information about their business, products and services through various websites.

The Companies goods have acquired a huge consumer base in the market. (Bills and invoices annexed '**Annexure-C**').

Complainant Company advertised trade mark 'NANOGEN' through various print and electronic media and participation in the fairs and exhibitions etc. It spent substantial amount of money on the publicity of said trade mark and in consequence thereof the said trade mark enjoys solid, enduring and first class reputations in the market. Use of the keyboard 'NANOGEN' in any leading search engines throws up the web pages of the company among the leading hits. A printout of the search result from the famous search engine google.com is annexed hereto and collectively marked as 'Annexure-E' . The disputed domain name is also appearing in the said search report.

On account of extensive usage of the trade mark 'NANOGEN', the said mark is identified solely and exclusively only with the complainant and none other.



4. PARTIES CONTENTIONS:

A. COMPLAINANTS CONTENTIONS:

- a. The disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights:

Complainant claims that

- (i) Complainant is the lawful owner of the trade mark 'NANOGEN'. This trade mark endures as a symbol of quality, dependability and reliability of the products in relation to which it is used and enjoys vast reputation and enviable goodwill associated with the complainant in several countries. The complainant has registered trade mark 'NANOGEN' in several countries including India. (Particulars of registrations attached as Annexure F)
- (ii) Complainant is also the registrant and proprietor of various domain name registrations at International and domestic level.
- (iii) The respondent's domain name is nothing but a blatant imitation of the complainant's trade mark and trade name. Respondent purposefully created conflict and confusion so as to result in dilution of the reputation of complainant's business.
- (iv) The respondent's domain name is identical to that of complainants. Its very existence would cause the public to believe that respondent and their domain name is sponsored by or affiliated to the complainant.
- v) Respondent created and registered the disputed domain name subsequent to the Complainant's conception and usage of the trade mark and domain name.
- vi) That Trade mark and domain name of the Complainant are highly distinctive and their extensive use qualified 'NANOGEN' into a well known mark under Trademarks law. If the respondent is allowed to operate the disputed domain name, the potential customers would be induced to:
 - a) Subscribe to the products/services of the impugned website believing it to be licensed or authorized by the complainant;
 - b) Believing that the Respondent is carrying on activities endorsed by the Complainant;
 - c) Believing that the Respondent is another business entity of the complainants.



b. The Respondent has no rights claims, or legitimate interests in respect of the disputed domain name:

Complainant submits that

- i) the disputed domain name was registered by Respondent on 27th December 2012. At this time, the complainant was actively using the website 'www.nanogen.co.uk'
- ii) Due to long and consistent use of the trade mark 'NANOGEN' it has attained certain distinctiveness and has become famous. It is worldwide associated solely and exclusively with the Complainant including India. Trade mark 'NANOGEN' has been continuously used since 2004.
- iii) Information available in the Respondent's disputed domain name i.e. 'www.nanogen.co.in' is identical to the goods and services offered by the Complainant. This clearly shows cyber squatting activity with malafide intention to give an impression to the potential viewers that the Respondent is associated with the complainants. Such use of the domain name is evidence of bad faith.
- iv) The disputed domain name incorporates the well known trade mark 'NANOGEN' in its entirety.

c. The Disputed domain name was registered and is being used in bad faith:

Complainant submits that

- i) At the time of creation and registration of the disputed domain name by the Respondent, The Complainant already had a well established business presence globally.
- ii) The Respondents have not been authorized, licensed or otherwise consented by the Complainant to use the trade mark 'NANOGEN' or to seek any sort of registration incorporating the said marks and domain name of the Complainant.
- iii) on or about July 2013 Complainant came to know about the existence of the disputed domain name and contracted Respondent to retrieve the disputed the domain name but Respondent refused to transfer the disputed domain name to the Complainant is apparent form the conduct of the respondent
- iv) The Respondent has registered the disputed domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration, to the Complainant who owns trade mark, for valuable



consideration in excess of the registrant's documented out-of-pocket costs for registration of the domain.

- v) the Respondent has with mala-fide intention adopted the disputed domain name incorporating the said trade mark of the Complainant.
- vi) The registration of the disputed domain name and its subsequent use by the Respondent is a deliberate attempt by the Respondent to attract, for commercial gain, internet users to another online location by creating a likelihood of confusion with the Complainant's 'NANOGEN' trade mark, trade name and domain name such that the public would in all likelihood falsely believe that the disputed domain name is sponsored, endorsed or authorized by or in association with the Complainant.
- vii) use of the domain name itself is evidence of bad faith registration and be transferred back to the Complainant.

B. Respondents Contentions

Not responded at all.

5. OPINION:

I. Issue:

- A) to obtain relief under the dispute resolution policy and the rules framed by the .IN registry the complainant is bound to prove each of the following :
 - 1. Manner in which the domain name in question is identical or confusingly similar to a trademark or service mark in which the complainant has rights.
 - 2. Why the respondent should be considered as having no rights or legitimate interests in respect of the domain name that is the subject of the complaint.
 - 3. Why the domain name in question should be considered as having been registered and being used in bad faith.

Complainant's principal contention as enumerated in Para 4 and on the basis of perusal of the records submitted by Complainant with the complaint –

This tribunal is of confirmed opinion that the Complainant has origination since Year 1999 and is using the brandmark 'NANOGEN' since then, has a huge customer base and has made massive efforts to promote the brand name 'NANOGEN' by consuming various resources available at his end and got National, International visibility with media coverage too.

Word 'NANOGEN' has certainly acquired a popular Brand name across the length and breadth of Other Countries including Britain, USA, EUROPE, India and a prominent place in internet electronic media.

On the basis of the records submitted by the complainant it's proved that the domain name 'nanogen.co.in' is related to the business of Complainant and is being used for purpose related to his work.



It is confirmed that Complainant is user of name 'NANOGEN'. The allegation made by the Complainant that the traffic of Complainant is being diverted to the Respondents site is correct and similar web names lead to confusion among web surfers cannot be denied.

That trade mark 'NANOGEN' has been registered effectively in different places in the world as attached in the Annexures submitted. Respondent's registration of the infringing Domain with knowledge of the fame and public recognition of the 'NANOGEN' marks throughout global internet establishes that Respondent has registered the Infringing Domain Name to prevent the complainant from using its 'NANOGEN' mark and design as a domain name.

Furthermore, if a trademark is incorporated in its entirety in a domain name, it is sufficient to establish that said name is identical or confusingly similar to Complainant's registered mark.

It cannot be overlooked that whenever a domain name registration is sought ample professional efforts need to be made to make sure that there is no pre existence of same or similar domain names on the world wide web so as to avoid any intentional or unintentional imbroglio or illegality of its operation and to ensure that no illegalities are committed.

Registrant failed to fulfill its responsibility to find out before registration whether the domain it is about to register violates the rights of a brand owner.

The respondent does not have clear intentions and has flouted the legal requirements and rules of registration of getting a Domain name and its registration. Knowing completely well of the pre existence at the various registries of internet, of the domain name wishing to be registered and without understanding whether he has rights to register such a name or not, still the respondent proceeded with registration of the domain name in question to intentionally trade on NANOGEN, incorporated in its reputation, goodwill and trademarks & was purportedly using the name for business purposes though indirectly and illegitimately putting it for sale.

Respondent has not shown any fair or legitimate non-commercial use, but instead has just remained silent and non responsive. Respondent has registered and used the Infringing Domain Name to direct Internet users familiar with 'NANOGEN' reputation and services to third party links on a portal site constitute bad faith use under the policy. It is very clear that the Respondent registered the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the owner of the trademark for valuable consideration. Respondent has attempted to take unfair advantage of Complainant's rights in his mark by using it to attract Internet users. Parking of such domain names to obtain revenue through web traffic and sponsored results constitutes bad faith.

It is also important to note that the Respondent has not been commonly known by the domain name, that Respondent has no relationship with or without permission from the



complainant for use of its marks and that Respondent cannot have ignored the fact that 'NANOGEN' is a registered and protected trademark of the Complainant.

Respondent intentionally attempted to attract, for commercial gain, Internet users to his website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the web site (Para 6 (iii) INDRP).

Complainant is well-known with its trademark. Due to the strong reputation of the trademark 'NANOGEN', Internet users will apparently and reasonably expect it as an offer of the Complainant or authorized or affiliated enterprises under 'nanogen.co.in'.

The complainant has the right to exercise control on how its trademark is used by the third parties on the Internet. Complainant has prior rights in that trade/service mark, which precede the respondent's registration of the domain name.

The logo 'NANOGEN' and similar domain names ,i.e., 'nanogen.com.pt', 'nanogen.org', 'nanogen.es', 'nanogen.hu', 'nanogen.pk', 'nanogen.asia', 'nanogen.ca', 'nanogen.tw' etc were legally registered at the various registries of internet by the Complainant before the respondent started the process of registration, and were legitimately using the name for business purposes. It profusely empowers them with the First right to the domain name 'nanogen.co.in' and therefore any rights of the Respondent in this regard stand defeated in favor of Complainant. The tribunal is of confirmed opinion that the domain name trade name and trade are factually and correctly conjoint to each other and is proof of the same of widespread recognition of the services provided by the Complainant make this complaint a plausible case of action.

This tribunal also holds that such misuse of the names should be checked in most efficient manner. That the complainant efforts to prove his good faith and right on the domain name in question should be considered good and that the domain name as having been registered and being used in bad faith by the respondent.

II. Domain name hijacking

This is an established rule that if the tribunal finds that the complaint was brought in good faith, for example in an attempt at forfeiting domain name hijacking or was brought primarily to rightly support the true domain name holder, the tribunal shall declare that the complaint was brought in good faith and constitute true use of administrative proceedings.

As enumerated in para 4 the Complainant asked for finding of bad faith, under this principle. In support of this prayer the Complainant cites the Respondent's misuse of name. Further, in support of this the Complainant submitted documents marked as Annexures which demonstrate and prove beyond any doubt that the complainant filed this complaint with no ulterior motive. Complainant's complaint is uncolorable and confirms beyond doubt the mind of tribunal that the present complaint is filed with no ulterior motive. Therefore, I am bound to conclude with the certainty that the present complaint by the complainant is an effort to save the disputed domain name from misuse and intention to harass or abuse the process of Law.



III. Conclusion

On the basis of the available records produced by the parties their conduct in the proceedings and the establish law, this tribunal is of considered opinion that the complainant succeeded to prove the necessary conditions. Further, this tribunal is bound to conclude with certainty that the present complaint by the complainant is an attempt by the complainant to save the domain name of complainant from hijacking by the respondent and in good faith with no intention to harass the respondent or abuse process of law and the name 'nanogen.co.in' be and is hereby transferred to Complainant with immediate effect.

Further the arbitration court takes an adverse view on the bad faith registration by the respondent and to act as a deterrent to future misuse it further imposes a fine of Rs. 5,000/- on the respondent to be given to NIXI for putting the administration to unnecessary work and wrongful registration by respondent.

Given under my hand and seal on this day of 30th day of June 2014.



Deepa Gupta
Arbitrator