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Purchased by	: POOJA DODD
Description of Document	: Article 12 Award
Property Description	: Not Applicable
Consideration Price (Rs.)	: 0 (Zero)
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ARBITRATION AWARD

.IN REGISTRY - NATIONAL INTERNET EXCHANGE OF INDIA (NIXI)

.IN domain Name Dispute Resolution Policy

INDRP Rules of Procedure

Statutory Alert:

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Disputed Domain Name: www.heromotor.in

Decision of Ms. Pooja Dodd, Sole Arbitrator

INDRP Case No. 1068

IN THE MATTER OF:

Hero MotoCorp Limited,

34, Basant Lok, Vasant Vihar,

New Delhi – 110057.

...Complainant

Versus

Mickel Pointing

Das Gupta Road, Arizona,

Andaman and Nicobar Islands 2345

India

...Respondent

1. The Parties:

1.1. The Complainant in this arbitration proceeding is Hero MotoCorp Limited, a company incorporated under the laws of India with registered office at 34, Basant Lok, Vasant Vihar, New Delhi- 110057. The Complainant is represented by its General Manager Legal, Mr. Vinay Kumar.

1.2. The Respondent is Mickel Pointing, a Resident of Das Gupta Road, Arizona, Andaman and Nicobar Islands - 2345, India. The email address connected

PA

with the Respondent is subhamkr204@gmail.com and the phone number connected with the Respondent is +17546962040.

2. Domain Name and Registrar:

2.1. The Disputed Domain Name is heromotor.in which was registered on January 2, 2019.

2.2. The accredited Registrar with whom the Disputed Domain Name is registered is GoDaddy.com, LLC situated at 14455 N. Hayden Rd., Ste. 226, Scottsdale, Arizona 85260, United States of America.

3. Procedural History:

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

As per the information received from NIXI, the history of the proceedings is as follows:



- 3.1. The Complaint was filed by the Complainant with NIXI, against Mickel Pointing. NIXI verified the Complaint and its annexures for conformity with the requirements of the Policy and the Rules.
- 3.2. On February 5, 2019, I submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by NIXI to ensure compliance with Paragraph 6 of the Rules.
- 3.3. NIXI notified the Parties of my appointment as the Arbitrator via email on February 8, 2019 and served an electronic as well as a physical copy of the Complaint on the Respondent. I informed the Parties about the commencement of arbitration proceedings on February 11, 2019 and the Respondent was directed to submit a Response within 10 days.
- 3.4. The courier was returned undelivered with the message "Wrong address, Incomplete address". On February 11, 2019, I informed the parties that even though the courier was returned undelivered, the electronic service of the Complaint was adequate and that the Complaint was successfully served on the Respondent, especially since NIXI "Terms and Conditions for Registrants" clearly state that the Respondent has a duty to ensure that the contact details available in WHOIS of .IN Registry are accurate.
- 3.5. On February 22, 2019, I informed the Parties that though no Response was received from the Respondent within the time period granted, in the interest of justice, I was granting additional time of 5 days, and that if no reply was

filed by February 26, 2019, the award would be passed on merits. The additional time period granted lapsed but no Response was received.

3.6. On March 27, 2019 I requested the Complainant to furnish proof of the allegation that the Respondent is a habitual offender.

3.7. The Complainant replied on March 28, 2019 and provided documents and a summary to support its claim that the Respondent is a habitual offender.

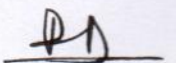
Grounds for Arbitration Proceedings

- A. The disputed domain name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights;
- B. The Respondent has no rights or legitimate interest in respect of the domain name; and
- C. The disputed domain name was registered and is being used in bad faith.

Summary of the Complainant's Contentions:

In support of its case, the Complainant has made the following submissions:

- 4.1. The Complainant is a company organized and existing under the Companies Act, 1956 in India with the office at 34, Community Centre Basant Lok, Vasant Vihar, New Delhi- 110057. The Complainant is a part of the HERO group of companies, including *inter-alia* Hero Invest Corp Private Limited, and other affiliates, predecessors-in-interest, title and rights.



- 4.2. The earliest of the Hero group companies was established in the 1950s for the manufacturing and sale of bicycles and their parts. As on date the HERO group companies are engaged in diverse business activities including but not limited to manufacture and sale of automobiles (two wheelers) and their parts and fittings, financial solutions, insurance, investments, planning, advisory, execution and monitoring of investments.
- 4.3. The word "Hero" forms the forepart and most distinguishing feature of the Complainant's corporate name and trading style and the name of some of the Complainant's other group companies, all of which are using the name HERO with the permission/authority/license from Hero Investcorp Private Limited, the owner of the trade mark HERO and other composite marks with the brand HERO used in conjunctions with other words/devices/logos including the trade marks Hero MotoCorp and H device. The Complainant is authorized/permitted user of these trade marks.
- 4.4. The Complainant was incorporated on January 19, 1984 and is the largest manufacturer of motorcycles and scooters having cumulative sales of 84+ million two wheelers since its inception. It is the No. 1 two-wheeler manufacturer company in the world for the last 17 consecutive years with a market share of 36.9% in the domestic two-wheeler market and a market share of 51.1 % in the domestic motorcycles market with global presence in about 35 countries. The Complainant has an extensive sales and service network which spans over to 6000 customer touch points. The Complainant

markets, sells and advertise its products under the distinctive marks HERO and Hero MotoCorp, which is also a part of its trade name.

4.5. HERO was adopted as a trade mark in the year 1950 by the Hero group. The Complainant has been using the brand name "HERO" since 1984. The mark registered globally in around 122 countries.

4.6. The Complainant owns trade mark registrations and applications for HERO,



HERO MOTOCORP, **Hero** and HERO formative marks namely:

1. HERO
2. HERO MOTOCORP

3. **Hero**



4. **Hero**
5. HERO MOTOCORP
6. HERO GROUP



and related variations of the above (collectively the "HERO Marks") in India.

4.7. The Complainant submits that the HERO Marks are the most distinguishing feature of Complainant located in different jurisdictions of the world and the relevant members of the industry and trade as well as general public

exclusively associate these with the Complainant and the Hero group companies. The Complainant further submits that the HERO Marks are well-known across the globe and that the Complainant has, since its incorporation, spent huge amount of money on the worldwide publicity, advertisements and promotions of their goods and services sold under the HERO Marks. As a result of such expenditure in terms of time, money and effort, the HERO Marks today have become synonymous with the products and services of the Complainant and its group companies, which are all market leaders in their respective fields. By virtue of several registrations, continuous and extensive usage, vast publicity, and the excellent and unmatched quality of the goods and services, the HERO Marks have acquired enormous reputation and goodwill, which have become a household word associated with the HERO group companies.

- 4.8. The Complainant states it has received various awards/ recognitions/ accolades for the goods sold by it under the HERO Marks and is the exclusive owner of domain heromotocorp.com, used for the purposes of giving greater public access, showcasing information about the products and services, advertising, promotion of Complainant. The website associated with this domain is accessible all over the world (including India). This domain name/website is very famous and frequently visited website in India for two-wheeler and its parts. This domain/website is partly interactive in nature and *inter alia* provides for an online platform to the prospective dealers for applying for dealership of the Complainant.

4.9. The Complainant states that it is selling, marketing and advertising its products, services and dealerships by adopting the aforementioned domain name and HERO Marks for decades. Due to enormous goodwill of the brand and the popularity of the website the trade channels and public associate and identify this domain or any other domain with the words "Hero MotoCorp" or "Hero" with the Complainant or its group companies. The Complainant has created a niche for itself in the domestic and international markets and any domain created containing the HERO Marks shall create confusion and shall lead to deception amongst public at large that the same originate from the Complainant or are in some way associated with the Complainant.

4.10. The Complainant claims that the Respondent has dishonestly, malafidely and unauthorizedly registered the Disputed Domain Name by adding the letter "R" at the end of the corporate name of the Complainant and this forms the most distinguishing and major feature of the Disputed Domain Name. This adoption is without authorization from the Complainant.

4.11. The Complainant states that in addition to modifying the domain name by adding the letter "R", the Respondent has also created a confusingly similar website and has copied the Complainant's copyrighted content and acquired a toll-free number which bears no association with the Complainant, amounting to trade mark and copyright infringement. The Complainant claims that the website that resolves at the Disputed Domain Name is misrepresenting itself to be originating from the Complainant, by giving address details of the Complainant in the "About Us" and "Contact Details"

section. By creating an identical form as that which is used by the Complainant, the Respondent is trying to dupe prospective dealers of Complainant and public at large. Owing to this, the Complainant states that it is obvious that a substantial section of the prospective customers/ dealers can be misled into believing that the Disputed Domain Name and the associated website are related to the Complainant.

4.12. The Complainant further argues that Disputed Domain Name was registered with the intention of raging a cyber-attack on the Complainant Group in a bid to extort monetary benefit from its illegal and unethical activities.

4.13. The Complainant believes that the Respondent is making an illegitimate, commercial, unfair use of the Disputed Domain Name, with intent to reap commercial benefits and to cheat, defraud mislead and divert consumers, trade channels and public at large.

4.14. In support of the contentions, the Complainant has furnished copies of the following documents:

Annexure I	A copy of Board Resolution dated 10 November, 2018 authorizing the authorized Representative
Annexure II	A copy of the certificate of incorporation of the said company Hero MotoCorp Ltd
Annexure III	A copy of the Whois record of the Complainant's website
Annexure IV	Copies of few of the representative International Registration Certificates for the HERO Mark

Annexure V	Copies of registration certificates/ online statuses obtained from the website of the Registrar of Trade Marks and other HERO Marks
Annexure VI	A copy of the Whois record of the Respondent's website
Annexure VII	A copy of decision in Complaint D2018-1480 and D2018-1744 passed by WIPO
Annexure VIII	Extracts of the websites of both the Complainant and the Respondent

Discussions and findings:

- 5.1. The submissions and documents provided by Complainant lead to the conclusion that the HERO Marks form an integral part of the Complainant's business. The Respondent does not have any relationship with the business, or authorization from of the Complainant; the Respondent does not have any legitimate interest in the Disputed Domain Name and the Respondent has registered the Disputed Domain Name to enrich itself unjustly from such adoption and registration.
- 5.2. It's a well-established principle that that once a Complainant makes a prima facie case showing that a Respondent lacks rights to the domain name at issue, the Respondent must come forward with the proof that he has some legitimate interest in the domain name, to rebut this presumption.



5.3. The Respondent has not filed any Response to the Complaint. Paragraph 8(b) of the Rules requires that the Arbitrator must ensure that each party is given a fair opportunity to present its case. Even though sufficient time (including additional time) was granted, the Respondent chose to refrain from submitting any Response to the Complaint.

5.4. Paragraph 11(a) of the Rules empowers the Arbitrator to proceed with an *ex parte* decision in case any party does not comply with the timelines set or fails to submit a Response to the Complaint filed against it. As stated above, I initially gave the Respondent 10 days and in the absence of a Response, I granted an additional 5 days to the Respondent to file a Response, but the Respondent failed to file any Response to the Complaint and has sought not to answer the Complainant's assertions or controvert the Complaint and the contentions raised.

5.5. As a result, I find that the Respondent has been given a fair opportunity to present his case but has chosen not to come forward and defend himself.

5.6. Paragraph 12(a) of the Rules provides that the Arbitrator shall decide the Complaint on the basis of the statements and documents submitted in accordance with the Arbitration and Conciliation Act, 1996 and any law that the Arbitrator deems fit to be applicable. In accordance with Paragraph 12 of the Rules, 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.

- 5.7. In the circumstances, my decision is based upon the Complainant's assertions and evidence and inferences drawn from the Respondent's failure to submit a Response, despite having been given sufficient opportunity.

The issues involved in the Dispute:

- 6.1. The Complainant invokes Paragraph 3 of the Rules to initiate an arbitration proceeding by submitting a Complaint to NIXI. The Respondent in registering a .in domain name submitted to the mandatory arbitration proceeding in terms of Paragraph 4 of the Policy, which determines the elements for a domain name dispute, which are;

- 1) whether the domain name in question is identical or confusingly similar to a trade mark;
- 2) why the Respondent cannot claim any legitimate interest in the trade mark; and
- 3) why the domain name in question should be considered as having been registered and being used in bad faith.

These elements are discussed below in tandem with the facts and circumstances of this case.



Element 1- The Respondent's domain name is identical/confusingly similar to a name, trade mark or service mark in which the Complainant has rights:

6.2. I am of the view that the Complainant has submitted enough documentary evidence to prove its rights in and to the ownership of the HERO Marks arising out of prolonged use and registration. The HERO Marks have been used extensively by the Complainant and have acquired secondary meaning. The submissions and documents provided by Complainant lead to the conclusion that the Complainant has proprietary rights, more particularly trade mark rights and other common law rights in the HERO Marks. The Disputed Domain Name is confusingly similar to the Complainant's HERO Marks and its trading name. Moreover, even the website that resolves at the Disputed Domain Name contains content that would invariably lead a visitor to believe that it is maintained by the Complainant. Therefore, in light of the Complaint and accompanying documents, I am of the view that the Disputed Domain Name is confusingly similar with the Complainant's HERO Marks and Complainant's trading name and the use of the Disputed Domain Name will inevitably lead consumers to believe that the Disputed Domain Name is affiliated in some way to the Complainant. Hence, the first element is satisfied.

Element 2 - The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name:



- 6.3. Through its submissions, the Complainant has established that it has never authorized or licensed the Respondent to use its HERO Marks. The Respondent does not have any relationship with the business of the Complainant or any legitimate interest in the Disputed Domain Name. The Respondent registered the impugned domain name on January 02, 2019 which is many decades after the Complainant started using the HERO Marks.
- 6.4. The burden of proof to establish any legitimate interests over the Disputed Domain Name falls on the Respondent, and by not responding to the Complaint, within the timeline set, the Respondent failed to establish legitimacy in registering the Disputed Domain Name.
- 6.5. The fact that Respondent maintains a website on the Disputed Domain Name that attempts to illegally attract traffic by misrepresenting the Disputed Domain Name as that of the Complainant to unjustly enrich itself, is sufficient to prove that the Respondent does not have any legitimate business offerings on the website that resolves at the Disputed Domain Name.
- 6.6. For these reasons, I find that the Respondent has no rights or legitimate interests in the Disputed Domain Name.

Element 3 - why the domain name in question should be considered as having been registered and being used in bad faith.

- 6.7. From the evidence submitted it is proved without a doubt that the Disputed Domain Name as well as the associated website was adopted and used to:



- defraud and cheat customers, dealers, and other relevant stakeholders of the Complainant.
- mislead and divert the consumers, distributors and the public at large into believing the Disputed Domain Name and associated website were created and maintained by the Complainant.
- Enrich the Respondent unjustly, through illegal and unauthorized means.

6.8. The Complainant alleged that the Respondent is a repeat offender and that the Complainant has previously filed domain name disputes with the WIPO and NIXI in respect of:

- a. www.heromotocorps.com
- b. www.herodealership.com
- c. www.hmclddealership.com
- d. www.heromotocorps.in

All the complaints filed by the Complainant were upheld and the domain names namely www.heromotocorps.com, www.herodealership.com, www.heromotocorps.in, www.hmclddealership.com were ordered to be transferred to the Complainant. After reviewing the evidence produced, I am convinced that indeed the Respondent is a habitual offender who had some connection with the domain names listed above. The Respondent seems to follow a pattern of obtaining abusive registrations for domain names that infringe on the HERO Marks for monetary gain.

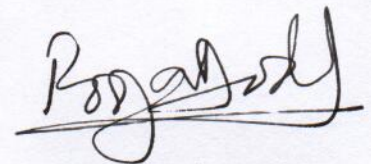
6.9. In view of the above, it is evident beyond reasonable doubt that the Respondent is a habitual offender and adopted the Disputed Domain Name in bad faith.



Decision:

7.1. In view of the foregoing, I am convinced that the Disputed Domain Name is confusingly similar to the Complainant's well-known HERO Marks, that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and that the Disputed Domain Name was registered in bad faith. In accordance with the Policy and Rules, I direct that the Disputed Domain Name be transferred to the Complainant, with a request to NIXI to monitor the transfer. In the facts and circumstances as discussed above, given that the Respondent willfully attempted to make illegitimate, commercial and unfair use of the Disputed Domain Name and attempted to divert traffic from the Complainant's legitimate domains, the Respondent is also ordered to pay to the Complainant, costs of ₹100,000 (Indian Rupees One Lakh Only).

This award is being passed within the statutory deadline of 60 days from the date of commencement of arbitration proceeding.



Pooja Dodd

Sole Arbitrator

Dated: March 28, 2019