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BEFORE SMT. DEEPA GUPTA, SOLE ARBITRATOR
OF
NATIONAL INTERNET EXCHANGE OF INDIA (NIXI)

In the Matter of:-

Mr. Chandra Prakash Toshniwal
Chief Financial Officer
Knowledge House, Shyam Nagar
Off Jogeshwari - Vikhroli Link Road,
Jogeshwari (East), Mumbai-400060

Complainant

VS

Mr. Michael Martin
Street 1: 2602 Snowy Egret Way
City : Elk Grove State: California
Postal Code: 95757 Country : US
Tel: + 916.7528056

Defendants

1. The parties:

Complainant is Mr. Chandra Prakash Toshniwal, Pantaloon Retail (India) Limited, Knowledge House, Shyam Nagar, Off Jogeshwari - Vikhroli Link Road, Jogeshwari (East), Mumbai-400060

Respondent is Mr. Michael Martin, Street 1: 2602 Snowy Egret Way, City : Elk Grove State: California, Postal Code: 95757 Country : US

2i The domain name at issue is <pantaloon.in> (the domain name)
The registrar NIXI is at Incube Business Centre, 38 Nehru Place, New Delhi

Deepa

3. Brief Background

This Arbitral proceeding commenced in accordance with the .IN Dispute Resolution Policy (INRDP) and rules frame there under.

Complainant submitted his complaint in the registry of NIXI on 06.02.2009 and the respondent submitted his reply on 6th March 2009.

Ms. Deepa Gupta has been appointed as Sole Arbitrator in this matter

It is alleged in the complaint that the complainant is using this trademark since October 1987. It is also revealed from the filed documents that the complainant is in the business of producing, distributing, and marketing of value & life style segment of consumer market including telecom/ IT, apparels, provisions, entertainments, logistics, Merchandise etc under pantaloon brand presently.

Respondent has submitted that he has registered the domain name <pantaloons.in> as a website for enhancement of academic knowledge and literary growth and without a commercial view intends to promote the knowledge of the word pantaloon by citing references wherefrom and how the word Pantaloon has come into being etc etc

4. Parties contentions:

Complainant alleges that the respondent has registered pantaloons.in, which is visually conceptually and confusingly similar to his trademark and also phonetically similar and that the respondent is a well known speculator and has registered the domain name pantaloons.in with the intention to sell it to others for profits & misleading the public.

The Complainant has also submitted the following:

That it is a leading company initially incorporated as M/s. Manz Wear Private Limited by Mr. Kishore Biyani on 12th October 1987. In or about 1988 PANTALOON was adopted to market their clothing as their trade name/mark, and in 1991 it was converted into a Public Limited Company renamed as Pantaloon Fashions. A year thereafter in the year 1999 into Pantaloon Retail (India) Limited. It is submitted that it is India's leading retailer operating multiple retail formats in both value and lifestyle segment of consumer market including telecom/ IT, apparels, general provisions, electronics, general merchandise, logistics, fashion, entertainment and is extremely popular in the Indian subcontinent as well as all across globe, being the flagship company of Future Group, India's leading business group that caters to the entire Indian consumption space.

Complainant also submits that it is the registered proprietor of more than twenty five trademarks for the word 'PANTALOON' per se, and other trade marks containing PANTALOON as an essential feature which is in use in relation to several goods, merchandise and services provided by the complainant's Company. PANTALOON is registered for goods/ services falling in various classes such as 14,18,24,25,26,35 and 42 of the Trademarks Act, 1999. The said marks have been used openly continuously and extensively since then and have gained wide acceptance and enjoy enormous popularity amongst one and all.



Complainant also submits that the name has become distinctive with Complainant's Company and thereby acquired formidable reputation and invaluable goodwill and that Registration details of the said trademarks are submitted along with the complaint documents evidencing the use of name/mark/brand attached and marked as Exhibit-A.

Complainant further submits that in order to process the consumer e-commerce business by providing customers e-shopping experience and to sell, promote and advertise through internet it got itself registered in the following domain names; www.pantaloon.co.in, www.pantaloon.com, pantaloonmails.com, www.pantaloonportal.com, www.pantaloonportal.biz, www.pantaloonbazaar.com, www.pantaloonfreshfashion.net, www.pantaloonfreshfashion.org, www.pantaloonfreshfashion.com, www.pantaloonfreshfashion.co.in, www.pantaloonfreshfashion.in in the year 2005 and the Registration details of the same are submitted as Exhibit-B.

Complainant submits that it has made Long, exclusive, continuous and extensive use of the corporate name/mark/brand PANTALOOON and International standards merchandise have been sold there under, and the far-reaching publicity name/ mark/ brand PANTALOOON has acquired tremendous distinctiveness and exclusivity associated and identified with the Complainant's Company. The said mark/ brand also features extensively on the internet and is associated with the complainant alone in the course of trade and that Exhibit -C are some of the internet search result for the said name/brand/mark "PANTALOOON" whereas Financial turnover for the last ten year is attached and marked as Exhibit-D.

The Complainant submit that it has made tremendous efforts and has spent considerable amount of money for the publicity promotion of the name/mark/ brand PANTALOOON and that it has been awarded the 'International Retailer of the year 2007' by the US based National Retail Federation (NRF) and the Emerging Market retailer of the year 2007 at the World Retail Congress in Barcelona. He further submits that he has Annexed as Exhibit -E copies of newspaper and web articles etc featuring the well known status of complaint's name/ mark/ brand 'PANTALOOON'.

Complainant submits that it has acquired valuable common law and statutory rights in the name mark/ brand 'PANTALOOON' and entitled to prevent any other party from using and/ or registering identical, deceptively trade mark/ name PANTALOOON.

Complainant states that the Respondent has registered a domain name www.pantaloons.in which contains the corporate name, registered mark/ brand 'PANTALOOON' of the Complainant and is identical and/or confusingly similar to the prior registered domain names of the complainant.

The use and/ or registration of the impugned domain name is bound to divert internet traffic and cause confusion and/or deception in the minds of unwary consumers and submits that courts have taken cognizance of the fact that a domain name business identifier accessible from any geographical location and requires world wide exclusivity.



The Complainant again submits that the impugned domain name is identical and/or deceptively similar to the well known and registered mark 'PANTALOON' and bound to cause confusion and/or deception and pass off the products/ services of the Respondent as that of the Complainant.

It is also submitted that Complainant approached Respondent in the month of March 2008, to surrender or transfer or sale the impugned domain name www.pantaloons.in. The valley of emails marked as Exhibit -F are also admitted for record herewith.

Complainant alleged that Respondent is conducting cyber squatting activities, by registering domain names blocking them and /or then offering it for sale, thereby making illegal gains which as per complainant is evidenced by the Respondent response on email for request of transfer or sale of name www.pantaloons.in and that the registration details of the domain name in dispute is attached as Exhibit-G

Complainant denies all statements, averments, claims and contention of Respondent and claims to deal with them Para-wise.

The Complainant submits that he denies that the Respondent had no knowledge of the Complainant's trade name/ trademarks/ brand and got registered the impugned domain in good faith. He claims that Respondent is having the knowledge of the reputation and good will of complainant's business registered trademarks and domain names, has got registered the impugned and/or similar domain name with intention to make illegal benefits or to creates an association or likely hood of association with the complainant, intending to cash upon the reputation and goodwill acquired by Complainant and indulged himself in cyber squatting. That Respondent is intentionally attempting to attract internet users from the Complainants website.

He further denies that the Respondent's registration and or use is legitimate, or is in non commercial manner and no way competes or interferes with complainants interest. He submits that there is bad faith and ill intention on the part of the Respondent evident from the act of the Respondent's registration of the impugned identical or similar domain name before the .in registry and that he is having no business presence or registered trademarks for PANTALOON in India or elsewhere and it is only to make an illegal benefit which is not permitted in law.

Complainant further states that the Respondent has miserably failed to make his case or to establish legitimate right or bonafide interest in registering or using the impugned identical and or similar domain name to an earlier registered and well known trademarks or domain name of the Complainant and therefore requests that the respondent be directed to transfer the impugned domain name to the Complainant.

Complainant further goes on to state that he disagrees that PANTALOON is a common English word, and submits that by virtue of its long, extensive use and publicity undertaken by the Complainant 'PANTALOON' has become distinctive to the Complainant's business. He further challenges that the Respondent has not disputed the exclusive right of the Complainant trademark/name/brand PANTALOON and that any other use will disparage the complainant legitimate and lawful rights in the said domain name.

Deepa

Complainant submits that hardship or injury will be caused to the Complainant if the impugned domain name is transferred to the Respondent and requests that justice may be granted.

Respondent

Respondent submits that he Michael Martin wrote a letter in response to the official complaint brought against him, for registering the domain name pantaloons.in. He submits that he received notice of this complaint by email on February 17, 2009 and received a hard copy of the complaint on February 23, 2009 at his mailing address.

He further submits that he registered the domain name pantaloons.in on November 22, 2007 as a part of a series of projects to create informational sites around topics based on single generic dictionary words and meaningful two word combinations. He stated that he would use these projects to enhance his writing skills and provide useful definitions and histories of generic dictionary words to internet users and that he did not register this domain for any other reason.

He further went on to submit that until the Pantaloon group contacted him to offer to purchase this domain, he was completely unaware of their existence or the existence of their "Pantaloon's" stores. He humbly submitted that he normally created these informational sites based on the .com extension (example: SolarGeysers.com was owned by him), but in late 2007, names in the .in and .co.in extensions were selling at a highly discounted rate, with many dictionary terms available therefore he took that as an opportunity to expand his collection of websites beyond the .com extension.

He submits that he came across the availability of pantaloons.in by plugging large lists of dictionary terms into the search feature at whiz.in. while scanning the available domain names for topics he was interested to write about and registered those names for current and future writing projects. Pantaloons.in happened to be one of the available names and felt that it would be interesting to research and write about the history of "pantaloons" (a man's close-fitting garment for the hips and legs, worn esp. in the 19th century, but varying in form from period to period; trousers). He then began researching and writing about this topic and posted the results of his writing to a website at pantaloons.in. Upon receiving notice of this complaint, he noticed that the registrar locked this domain and somehow brought his site down. The content that was featured at pantaloons.in could now be seen at pantaloons.co.in. For further proof that this content existed at pantaloons.in prior to this complaint being filed, he submitted it in Exhibit A attached to the response letter. This exhibit contained a screenshot of the home page of pantaloons.in archived at Google.com as of February 5, 2009.

Respondent does not dispute that Pantaloon Retail Ltd. has the exclusive right (based on registered trademarks) to use the trade name "pantaloons" in the Indian marketplace. However, he submits that their registered trademarks do not give them 100% full and unrestricted ownership and control of all use of the word "pantaloons" in every context and situation. The word "pantaloons" has been in use all over the world for many centuries. "Pantaloons" is an English language word derived from the French word "pantalone" which translates to "trousers." The very common English word "pants" originated as a shortened version of the word "pantaloons." Due to the very large English speaking population in India, the .in extension provides a logical platform for a legitimate site showcasing the definition and history of not only the word "pantaloons," but the article of clothing it represents.

He further submitted that in paragraph 9 of the complaint, the complainant states the name was apparently registered in bad faith and falsely claims that pantaloons.in "shows a website imitating to sell garments." This could not be farther from the truth. Prior to receiving this complaint, his domain, pantaloons.in, was resolving to the correct web servers which displayed the content that could now be seen at pantaloons.co.in verified by Exhibit A which showed a screen shot from a Google.com archive of the page dated February 5, 2009. Respondents contention was that content, in no way, imitated any commercial activities. It did not even display any advertisements or external links to any commercial sites. The site was strictly informational and tightly focused on the topic of pantaloons (pants, trousers). Also, it did not mention any companies owned by or related to Pantaloon Retail Ltd. or any other companies or commercial activities period.

He has contended that content seen at pantaloons.co.in was displayed at pantaloons.in for approximately 10 months prior to this complaint being filed. Upon receiving notice of the complaint, pantaloons.in mysteriously stopped resolving to his web server. Because the domain had been locked, he was unable to resolve the issue. He stressed that it was a legitimate website, being used for legitimate purposes, in a non-commercial manner that, in now way, competes or interferes with any of Pantaloon Retail's operations.

He further argued that the word "Pantaloons" was not created by Pantaloon Retail Ltd., so their trademarks restrict their control of the term to the marketplace or to unique titles they originated by combining this word with other words. For instance, if they decided to create a business called "Socks" and received a trademark to have exclusive rights to operate in the Indian marketplace using the trade name "Socks," it would not give them the right to deny a site to use the domain name "socks.in" to create a legitimate, non-commercial, non-competing informational site about the article of clothing referred to in the English language as "socks." If "pantaloons" was a word they originated, rather than a common English language word, they would likely have more control in restricting its non-commercial use with or without it being combined with other words. While Pantaloon Retail Ltd. did prove they have exclusive **commercial** rights to use the word "pantaloons" based on TRADE and MERCHANDISE marks, evidence contained in this response proves that my site is excluded from these restrictions, as it is not involved in any trade or other commercial activity and the term "pantaloons" is a common word in the English language, used for many centuries. Also, their accusation of my website "imitating to sell garments" is 100% false. He further went on to say that I have shown that I have, beyond a doubt, registered this domain name in good faith and with good intentions. I have also disproved all claims and accusations made by the complainant that would prove their right to have my control of pantaloons.in revoked.

Respondent requested the inclusion of an additional exhibit: Exhibit C. This exhibit is a copy of the email correspondence initiated by the complainant attempting to purchase the domain pantaloons.in from him. In both of his responses, he submitted that he informed the complainant that the domain was ordinarily not for sale, but would consider the offers if they were worth more than his writing project. He further explained that once he completed the first stage of his writing project, he took on some other projects that took away much of the time he had kept for update and improvement of pantaloons.in. At this time, he contacted Pantaloon Retail, Ltd. to let them know that he would be more willing to sell the domain with the website since he would no longer have as much time to dedicate to his site. His original intentions were not to sell the domain, but thought they may be interested in buying his site as a whole, as it would probably be more valuable to them. This was submitted as a proof that the site was registered in good faith.

Deepa

Respondent states that he registered the domain, promptly created a website, and never offered the domain for sale. Upon receiving interest in the domain/ website from Pantaloon Retail, Ltd., he made them aware that he was not looking to sell the domain, but welcomed an offer, as the offer may have been worth more to him than the website/writing project and hence should not constitute bad faith.

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 the domain name in question is identical or confusingly similar to a trademark or service mark in 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 been using the name Pantaloon since 1991 in one form or the other and has made sincere efforts to promote the brand name pantaloon by consuming various resources available at his end and word pantaloon has certainly acquired a popular Brand name in the process.

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

It is confirmed that Complainant is user of name pantaloons & operates worldwide employing thousands of people all over.

The complainant has spent considerable amount of money in promoting its brand is established.

On the basis of the record submitted and statements made by the respondent as per Para 4 by the respondent and that respondent has responded and the reason given for registering the domain name sounds logical on the face value but there is more to it than what meets the eye. The allegation made by the Complainant that the traffic of Complainant is being diverted to the Respondents site is not correct though similar web names lead to confusion among web surfers cannot be denied.



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 preexistence of same or similar domain names on the world wide web so as to avoid any intentional or unintentional imbroglia and illegality of its operation and to ensure that no illegalities are committed.

The respondent does not have honorable intentions and has flouted the legal requirements and rules of registration of getting a Domain name and its registration and has not bothered to do the verification of preexistence of the domain name wishing to be registered. Pantaloon and similar domain names were legally registered at the various registries of internet by the Future Group of Companies also having Pantaloons Retail Ltd as its Company much before the Respondent started the process of registration, and were legitimately using the name for business purposes profusely empowers them with the First right to the domain name www.pantaloons.in and therefore any rights of the Respondent in this regard stand defeated in favor of Pantaloons Retail Ltd.

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

Complainant has amply demonstrated that he is in the business of value and lifestyle segment of Consumer Market with the trademark for the word Pantaloon and has contributed amply to the popularity of the brand name Pantaloon.

The tribunal is of confirmed opinion that the domain name trade name and trade are facially and correctly conjoint to each other and is proof of the same of widespread recognition of the products and services provided by the Complainant make this complaint a plausible case of action.

II. Domain name hijacking

This is establish 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 ask for finding of bad faith, under this principle. In support of this prayer the Complainant cites the Respondent's failure to fully disclose the facts related to allegation against the respondent. Further, in support of this the Complainant submitted documents marked as annexure A,B,C,D,E which amply 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.

But it is pertinent to mention that if Complainant is convinced within himself that an illegal act of domain name hijacking & cyber squatting has been committed by the Respondent it is abhorring & deplorable that the Complainant has instead of resorting to legal means first resorted to illegal

means of buying the domain name by offering payment of money under undue coercion thus rendering the very basis of enactment of law of justice redundant & by becoming an accomplice in an act of illegality has done an illegal act. It is only when the illegal negotiation has not turned out successfully that the Complainant has resorted to legal means of settling the matter by admitting an application for arbitration at NIXI. The law clearly states that the accomplice in an act of crime is also guilty along with the main accused and offerer of bribe is equally guilty of the person receiving the bribe.

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 all the necessary conditions. Further, this tribunal bound to conclude with the 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.

This tribunal further directs the Complainant to deposit a token sum of Rs.25,000 INR in the registry of NIXI as penalty for being an accomplice in an act of illegality so as to act as a deterrent for all others to being an accomplice/ a party to Criminal offence of offering money to a Cyber Squatter for buying a Domain name. This tribunal also directs the Respondent to pay an amount of 1000 Us Dollars to NIXI as punishment and penalty for resorting to illegal means/ cyber squatting and as cost of this proceedings for burdening the administration to fulfill his dirty ulterior motives. In the facts and circumstances of this case this tribunal further directs the registry of NIXI to take adequate precaution in entertaining such complaints and send a copy of this decision to the Hon'ble High Court of Delhi at New Delhi to take further actions against the miscreants as this tribunal cannot go beyond its jurisdiction.

Given under my hand and seal on this day of 23rd May 2009.


Deepa Gupta
Arbitrator