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BEFORE THE NATIONAL INTERNET EXCHANGE OF INDIA

ARBITRATION AWARD

Case No. L-2/5/R 7 of 2009

In The Matter Between

Permira IP Limited

Complainants

Versus.

Paperboy & Co.

Respondent

1. The Parties

The Complainant, Permira IP Limited, is a private equity firm based in Europe. The Complainant's authorized representatives in these proceedings are Anand & Anand, of Noida, India.

The Respondent is Paperboy & Co., of Japan.

2. The Domain name, Registrar and Policy

This Arbitration pertains to a dispute regarding the domain name <permira.in>. The registrar for the disputed domain name is eNom Inc., United States of America.

The Arbitration Proceeding is conducted in accordance with the Arbitration and Conciliation Act of 1996, the .IN Domain Name Dispute Resolution Policy (the "INDRP Policy"), and the INDRP Rules of Procedure (the "Rules").

3. Procedural History

The Arbitrator received the hard copy of the Complaint from the .IN Registry on March 19, 2009. On March 21, 2009 the Arbitrator send by "Registered Post" a notification of commencement of the arbitration proceedings to the Respondent under paragraph 5 (c) of the INDRP Rules, and by email to other interested parties to the dispute.

The Respondent was given twenty-five days time from the date of the notification to file a Response. The Respondent did not file a formal response in these proceedings. The Respondent however sent an email on March 25, 2009, details of which are discussed below.

Factual Back ground

The Complainant is a provider of financial services and uses the trade name and service mark PERMIRA for its business and on its website. The Complainant is the registered proprietor of the PERMIRA marks in several countries and has furnished documentary evidence of the registration of the PERMIRA marks, including copies of its Indian trademark application number 1585008, dated July 27,2007, in classes 35 and 36.

The Complainant is the owner of the domain name www.permira.com and numerous variations thereof in the .com and in other gTLDs. The Complainant also owns other country code domain name registrations including <permira.co.in> and has provided proof of these registrations.

The Respondent is identified as Paperboy &Co. a/k/a MuuMuu Domains, a Japanese entity.

The disputed domain name <permira.in> was registered on April 5, 2007.

4. Parties contentions

A. Complainant

The Complainant states that it is a leading international private equity firm, which was established in the year 1985. it uses the name PERMIRA as a business identifier and as its trademark in connection with its financial services and private equity business. The Complainant alleges that it has used the PERMIRA marks since the year 2001 and it continues to use it throughout the world, including India, the United States, the United Kingdom, Europe and Japan. The Complainant states that its mark is prominently advertised and promoted in print and electronic media.

The Complainant alleges that it makes long-term investments in companies, for providing consistent returns to its investors. The Complainant has provided a copy of a press release

relating to its investment in Arysta Life Science Corporation Japan and states that since then it has raised thirteen buy-out funds. The most recent Permira IV, was raised in 2006.

The Complainant states that its teams are based in Frankfurt, Guernsey, Hong Kong, London, Luxembourg, Madrid, Milan New York, Paris, Stockholm and Tokyo, advising funds with a total committed capital of approximately EUR 20 billion. Since 1985 the Complainant alleges it has completed over 180 private equity transactions.

The Complainant states that the disputed domain name is identical to its mark PERMIRA in which it has statutory and common law' rights. It states the Respondent has misappropriated its mark, which is a rare Latin word. The use of country code .IN, is non distinctive, states the Complainant and cites the case *SAS Institute Inc. v. Farzad Bahreini*, FA0207000115038 (Nat Arb. Forum , August 26, 2001), in this regard. The Complainant argues that incorporating the trademark in its entirety is sufficient to establish confusing similarity and refers to the INDRP decision: *Taco Bell Co. v. West Masters Casino*. The use of its trademark by the Respondent in the disputed domain name is likely to confuse Internet users and would lead to dilution of its trademark, alleges the Complainant.

The Complainant states that the Respondent lacks legitimate rights in the domain name, as it comprises of its well-known mark, in which the Respondent can have no rights. The sole purpose of the Respondent's use of its mark, argues the Complainant is to cause confusion as to the source, sponsorship, affiliation or endorsement. The Complainant believes the Respondent is not commonly known by the name PERMIRA or does any business or commerce under that name. The Respondent is not making legitimate non-commercial or fair use of the domain name, but is exploiting fame of the Complainant's well-known trademark to create initial interest confusion to bait Internet users. The Respondent is a known cyber squatter, states the Complainant, who has been involved in a previous UDRP dispute: WIPO Case No. D2006-0851. The Respondent has also registered the domain name <permira.biz>.

Finally, the Complainant contends that the domain name was registered and is being used in bad faith. The Complainant argues that its mark is well known, the Respondent ought to have prior knowledge of its mark and therefore its use by the Respondent amounts to misappropriation of its mark. The Complainant further states that it has a well-established presence in Japan for financial services. The registration of the disputed domain name and its use by the Respondent is a deliberate attempt by the Respondent to disrupt its business. Attempts to resolve the dispute, prior to filing this case did not succeed, states the Complainant, as the Respondent/ registrant demanded USD 14000 for the transfer of the two domain names <permira.in> and <permira.biz>. Finally, the Complainant argues that the Respondent's website is likely to mislead the public to believe that there is some affiliation between the parties or that it is authorized by the Complainant.

The Complainant requests for the transfer the domain name<PERMIRA.IN> for the above stated reasons.

B. Respondent

The Respondent sent an email dated March 25, 2009, in reply to the Complaint and has made the following contentions:

The Respondent, " Paperboy& Co.", is a web hosting company, which provides domain name registration services for individuals and small businesses under the name MuuMuu Domain. According to the Respondent, all domain names registered through the Respondent are the property of the registrants.

The Respondent states that for its clients who request for privacy, the Respondent does not publish their personal information on the Internet, but MuuMuu Domains provides Whois Information protection services by showing the contact information of Paperboy & Co. . This is done, according to the Respondent, under the understanding that the

Respondent retains the contact information of each individual, so that the registrant of the domain name can be contacted through the Respondent.

The Respondent goes on to state that:

"In general, upon the receipt of the infringement of domain name use, MuuMuu Domain notifies the registrant to change the Whois information so the issue can be resolved between the registrant and the Complainant. In the case the registrant fails to change the Whois information to the registrant's own information within five days from the notice by MuuMuu Domain, the registrant information is disclosed as Whois information.

It is regrettable that the complainant did not notify Paperboy & Co, regarding the infringement of domain use prior to filing domain dispute, such as Paperboy and Co, was unaware that the communication that the registrant demanded \$14000 for the domain name(s) until the point that paperboy & co. had received the set of complaint documents. Otherwise, we could have taken an appropriate action to assist the Complainant by changing the Whois information to the actual registrant's so the Complainant can deal with the actual Respondent.

Therefore, paperboy&co. proposes that Complainant withdraw the case so Paperboy& co. will disclose the actual registrant as Whois information, so the Complainant may contact the actual registrant and file a domain name dispute, and not the domain name registration provider. "

This email sent by the Respondent, was from its Customer Support person named Ryo Hirosawa, but does not purport to be a formal verified response. Further, no supporting documents were filed by the Respondent to substantiate its claims.

5. Discussion and Findings

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.

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

- (i) The domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights, and
- (ii) The Respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) The Respondent's domain name has been registered and is being used in bad faith.

Identical or Confusingly Similar

The Complainant is required to prove that the domain name registered by the Respondent is identical or confusingly similar to a mark in which it has rights.

The Complainant has demonstrated its ownership in the PERMIRA marks by providing evidence of its trademark registrations in India and internationally. The Complainant has demonstrated its prior adoption of the PERMIRA mark and its sustained use over a period of time. These factors establish the Complainant's ownership in the mark as a distinct identifier of its services and its rights in the PERMIRA mark.

It has been recognized in numerous prior decisions that incorporating of a trademark in its entirety, is sufficient to establish that a domain name is identical or confusingly similar to the Complainant's registered mark. See for instance *Investments. Inc v. Dennis Hoffman*, WIPO Case No.D2000-0253. In the present case the disputed domain name is

identical to the Complainant's mark except for the ".in" domain identifier, which is inconsequential for finding confusing similarity.

The Arbitrator is satisfied that the disputed domain name <permira.in> is identical to the Complainant's mark, PERMIRA, in which it has rights.

Rights and Legitimate Interests

The Complainant has to show that the Respondent has no rights and legitimate interests in the domain name.

The Respondent has stated that it is in the business of registration of domain names. This fact is re-confirmed from the case *Rhodia v. Paperboy & Co.*, WIPO Case No.D2006-0851, where it was found that the Respondent is in the business of registration and reselling domain names. In the present case, the Respondent has registered the disputed domain name, which consists entirely of the Complainant's trademark. Given the prior reputation of the Complainant's mark, the conceivable objective behind the Respondent's registration here appear to be, for impeding the use of the domain name by the Complainant and awaiting its future resale. It has been found in previous cases that exploiting the Complainant's mark in this manner does not confer any legitimate rights on the Respondent. See for instance *Sociedad Rectora de la Bolsa de Valores de Bilbao, S.A. v. domains for sale \$500*, WIPO Case No.D2001-0091, where the Complainant in that case was the owner of a financial service mark "BOLSA DE BILBAO", and the Respondent was in the business of registration and reselling domain names, it was found that registration of the domain name <bolsadebilbao.org> for reselling or preventing Complainant's use was not legitimate use and did not give any rights to the Respondent.

The Arbitrator finds the other possible use of a domain name which is identical or confusingly similar to the Complainant's trademark is to attempt deriving advantage from user confusion and diverting Internet users to the Respondent website, but this again does

not confer legitimate rights on the Respondent. See for instance, *Bridge stone Corporation v. Horoshiy, Inc.* WIPO Case No. D2004-0795.

The Arbitrator finds there is nothing on record to show the Respondent has been commonly known by the disputed domain name. Further, although the Respondent may be in the business of registering and reselling domain names and to that extent it is engaged in a legitimate business, there is nothing on record to show that the Respondent has made a *bona fide* offering of goods and services under PERMIRA name to give the Respondent any legitimate rights in the disputed domain name.

The Arbitrator is therefore convinced that the Respondent has no rights or legitimate interests in the disputed domain name.

Bad Faith

Under the INDRP Policy the Complainant is required to prove that the domain name is being used in bad faith. The Policy provides a non-exhaustive list, of circumstances, which indicates bad faith registration and use of a domain name under Paragraph 5 (iii) of the Policy.

The Arbitrator notes that the Complainant has a well-established international presence for its financial services including Japan, where the Respondent is located. The Complainant has demonstrated that it has used and developed the PERMIRA mark for about seven years prior to the registration of the disputed domain name. The use of the Complainant's mark by the Respondent, an entity not connected with the Complainant, leads to the presumption of possible misuse of the mark. In numerous cases where a third party with no connection to the mark and who is not authorized to use the mark, registers a domain name incorporating the mark, it has been considered a strong indication of bad faith. See for instance *AXA SA, AXA BANQUE SA v. Glenn Snapp*, WIPO Case D20G9-0207.

The Complainant has put forward the contention that it had attempted to resolve the dispute prior to filing the present case. According to the Complainant, the settlement negotiations failed as the Respondent / Registrant had demanded an amount of USD 14000 for the transfer of two domain names. The Complainant argues that the alleged demand for excessive amount to settle the matter show bad faith. The Arbitrator however, is unable to determine the veracity of these statements; firstly, as the Complainant has not filed any documents or evidence of these alleged communications with the other party, and secondly it is inconsistent with the Respondent's stand, who appears to have been unaware of these negotiations, allegedly till it received the Complaint. The Arbitrator declines a finding of bad faith on this specific ground raised by the Complainant, due to the lack of proper supporting documents.

The Respondent has stated that it has provided its own name in order to protect the identity of the actual owner, as a privacy service to the registrant. However there is no evidence produced by the Respondent to substantiate its claims. Neither has the Respondent come forward to reveal the identity or contact details of the so-called "real owner". The Arbitrator views the assertions of Respondent that it is not the owner of the domain name or alternatively the suppression of registrant details, even after being served with the complaint, with some skepticism. The previous WIPO case in which the Respondent was similarly involved was in *Rhodia v. Paperboy and Co.* WIPO Case No. D2006-0851, the Panel there had found that "*Respondent has deliberately allowed itself to be used as a front for an undisclosed registrant who has elected to remain in the shadows*". The parties here appear to be suppressing the so-called "shadow figure", or the "true owner" of the domain name, if at all one exists. The Arbitrator, therefore rejects the Respondents assertions that it is not responsible for the disputed domain name, as it is the registrant on record and also for the reasons discussed here, which are similar to the Panel's reasoning in *Rhodia v. Paperboy & Co.* WIPO Case No.D2006-0851.

The Arbitrator accepts the Complainant's argument that the Respondent has misappropriated its mark and there is a likelihood of its misuse by the Respondent which includes its potential to mislead the public to create a false affiliation with the

Complainant. The totality of circumstances of the case therefore shows the Respondent's bad faith intent to exploit and profit from the Complainant's mark.

in conclusion, for the reasons discussed, the Arbitrator finds the domain name has been registered and used in bad faith under paragraphs 4 and 5 (iii) of the Policy.

6, Decision

For all the reasons discussed above the Arbitrator orders that the Domain Name <permira.in> be transferred to the Complainant.



Harini Narayanswamy

Arbitrator

Date: 24 April, 2009