

दिल्ली DELHI

N 397151

**VISHESHWAR SHRIVASTAV
SOLE ARBITRATOR**

IN

**ARBITRATION PROCEEDINGS OF DOMAIN NAME
"prosciuttodiparma.co.in"
Between**

CONSORZIO DEL PROSCIUTTO DI PARMA

.COMPLAINANT

AND

CORPORATE DOMAINS

.RESPONDENTS

AWARD

1. This Arbitral Tribunal was constituted by nomination of undersigned as the Arbitrator in the aforesaid proceeding vide communication by NIXI. This Tribunal while checking the records of the proceedings, found that there was nothing on

record to show that a copy of the complaint has been supplied to the Respondents. Accordingly vide its communication dated 29/01/2011 this Tribunal directed the Complainants to send a copy of their complaint to the Respondents by Courier. The Respondents were given time of seven days after receipt of the complaint to send their Statement of Defense.

2. That the Tribunal in response to its communication received email(s) dated 01/02/2011, 04/02/2011 & 11/02/2011 from the Complainants stating that they have resent the hard copy of the complaint via DHL Courier and sent DHL receipt along with Tracking records. The DHL Courier Waybill No. 7598027253 was put on hold from 02/02/11 to 08/02/11 due to holidays of Chinese New Year, then from 09/02/11 it stated "Address information needed" and then "Shipment on hold". Accordingly this Tribunal in terms of the orders passed by this Tribunal on 14/02/2011 had already waited for the Respondent's Statement of Defense to the Complaint but to no avail and hence was constrained to pass its order dated 14th February, 2011 reserving it's Award. \



3. This Tribunal finds that the Complainants had duly complied with the directions of this Tribunal and had tried level best to serve the Respondents on the address provided but to no avail. Besides, copy(s) of the order (s) passed by this Tribunal have also been emailed to the Respondent hence it cannot be said that the Respondents are unaware of the proceedings.

4. This Tribunal notes that the Respondent have been elusive *qua* this domain name and have given incorrect address even in the WHOIS and despite being aware of these proceedings through email chose not to send any communication or file any Statement of Defense to the Complaint and maintained silence on the same, hence in view of such peculiar facts and circumstances and in view of INDRP which makes it incumbent upon this Tribunal to decide the controversy within 60 days, this Tribunal accordingly proceeds in the matter as per the material available before it.



5. This dispute concerns the domain name '**prosciuttodiparma.co.in**' that is registered with the IN Registry through the sponsoring Registrar M/s Directi Internet Solutions Pvt. Ltd.dba PublicDomainRegistry.com.

CLAIM

The complainants claim a right in the said name based on the following assertions as given in their complaint which are as under:

A. **The domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;**

B. **The Registrant has no rights or legitimate interests in respect of the domain name;**

C. **The domain name has been registered and is being used in bad faith**

The Complainant claim that it is a voluntary Consortium of Parma Ham, set up in 1963 on the initiative of 23 producers of the



Parma region in Italy, with the objectives of safeguarding the genuine product of Parma and the image represented by the name 'Parma'. The Consortium claims that it has now has 189 members that caters to the over-growing domestic and international demands.

It is claimed that since Roman times, the unique dry conditions of the clearly defined region of Parma have made it possible to produce the highest quality hams that have been appreciated by gourmets for centuries. It is further claimed that the tradition and practice of the region of Parma of preparing specially cured ham dates back to 100 BC and that the word "Prosciutto" is derived from the Latin *perexsuctum* meaning "dried" - an indication of the purity of Parma Ham production and its ancient roots in Italy.

It is claimed that only hams produced and cured in the hills around Parma may become **Parma Hams**. It is also claimed that the Consortium's quest for perfection was acknowledged by the European Union in 1996 when Parma Ham became one of the first meat products to be awarded the **Designation of Protected Origin** status. The complaint states that designated status of the product entails that all Parma Ham producers must be located within the geographical boundaries of the Parma production area, 5 km south of the via Emilia, limited to the east by the river Enza and on the west by the river Stirone, and up to an altitude of 900 mtrs. The complainants rely on various documents and other

material depicting its corporate history, businesses and activities given as **Exhibit A**.

The Complainant further claims that it is the owner of a number of domain names which support the Complainant's several dedicated and official websites for its consumers from different countries and jurisdictions the list of the Complainant's domain names is as under:

1. prosciuttodiparma.it
2. prosciuttodiparma.eu
3. prosciuttodiparma.es
4. prosciuttodiparma.cz
5. prosciuttodiparma.dk
6. prosciuttodiparma.se
7. prosciuttodiparma.co.uk
8. prosciuttodiparma.cn
9. prosciuttodiparma.lu
10. prosciuttodiparma.ro
11. prosciuttodiparma.be
12. prosciuttodiparma.gr
13. prosciuttodiparma.com.pt
14. prosciuttodiparma.au
15. prosciuttodiparma.com.mt
16. prosciuttodiparma.com
17. prosciuttodiparma.org
18. prosciuttodiparma.net
19. prosciuttodiparma.biz
20. prosciuttodiparma.info
21. prosciuttodiparma.us
22. prosciuttodiparma.com.cn
23. prosciuttodiparma.asia
24. prosciuttodiparma.lt
25. prosciuttodiparma.ru



26. prosciuttodiparma.pl
27. prosciuttodiparma.lv
28. prosciuttodiparma.hu
29. prosciuttodiparma.mobi
30. prosciuttodiparma.hk
31. prosciuttodiparma.com.hk
32. prosciuttodiparma.sg
33. prosciuttodiparma.jp
34. prosciuttodiparma.co.nz
35. prosciuttodiparma.tw
36. prosciuttodiparma.com.tw
37. prosciuttodiparma.ca
38. prosciuttodiparma.com.mx
39. prosciuttodiparma.co.ve
40. prosciuttodiparma.co.za

The Complainant's claim also to be the owners of several registrations of Geographical Indications (Protected Origin), trademarks, and certification marks containing and pertaining to **PROSCIUTTO DI PARMA, PARMA** and their variants and rely upon a list of registered **PROSCIUTTO DI PARMA** and **PARMA** formative marks in different countries, together with some representative registration certificates, annexed and collectively marked as **Exhibit B**. It is also pointed out that the registration of the trademark and Geographical Indication **PROSCIUTTO DI PARMA** was obtained by the Complainant on **16 September, 2005** and further in India, the Complainant has filed Geographical Indication Application no. 164 for registration of **PROSCIUTTO DI PARMA** under The Geographical Indication of Goods (Registration and Protection) Act, 1999 and the said application has been advertised and pending registration, and the status of



the application, as obtained from the online database of the Geographical Indications Registry, Government of India, is annexed and marked **Exhibit C** Later on on 15/02/2011 the Complainant has furnished copy of their Geographical Indication Registration Certificate bearing no. 164 certificate no. 149 dated 27/01/2011. Besides the above some copies of articles and news items about the Complainant and its activities and Protected origin status of **Prosciutto di Parma** and **Parma ham** is also published in India and international media are annexed as **Exhibit D.**

That the complainants were aggrieved by registration of the aforesaid domain name on **22 April, 2010** in the name of Genrong Ye, of Corporate Domain Name Portfolios having the same address as the present Respondent. It is alleged that on coming to know about the registration the complainant's sent a letter dated 16 June, 2010, through its counsel, to Genrong Ye, cautioning him of the Complainant's rights to the trademark and Geographical Indication "**Prosciutto di Parma**" and demanding that the disputed domain name be transferred to the Complainant and on receiving no response from Genrong Ye coupled with a subsequent search of Whois record after some time they Complainant found that the name of the registrant of the disputed domain has changed from Genrong Ye to Corporate Domains, the present Respondent herein. Complainants point out that the prior and present registrants of the disputed domain name share



the same physical and e-mail addresses. The complainants rely upon a copy of letter dated 16 June, 2010, .IN Registry Whois database record of the domain name <prosciuttodiparma.co.in> and domain registration history given as **Exhibit E**

The complainants state that the ownership issue concerning the trademark **PROSCIUTTO DI PARMA** has been considered by a number of international arbitration panels, including the WIPO Arbitration & Mediation Panels, and decided in favor of the Complainant and to buttress their claim they have filed a list of WIPO decisions concerning disputed domain names containing "Prosciutto di Parma" that have been decided in favor of the Complainant as **Exhibit F**.

Based on the above they assert that they are the sole owner and right holder of the expression, trademark, and domain name "prosciuttodiparma" and also that by virtue of **PROSCIUTTO DI PARMA** being a recognized **Geographical Indication/Protected Origin** being associated the Complainant Consortium's producer members from the region of Parma, Italy, the said expression/mark is the exclusive property of the Complainant and cannot be used or claimed by any body else.

The Complainant's further state that they have neither licensed nor otherwise authorized or given consent to the Respondent to



use/utilize or commercially exploit the Complainant's internationally registered and very well known trademark, Geographical Indication/Protected Origin, and service mark in any manner.

It is alleged that the disputed domain name resolves to a dummy website parked with Sedo's Domain Parking. The website carries the legend, "*The domain prosciuttodiparma.co.in may be for sale by its owner!*". And fortify their allegation a print of the web page has been annexed as **Exhibit G**. They allege that it is likely to cause confusion in the mind of the internet users looking for the Complainant's website and diverting traffic to unrelated websites. It is further alleged that the Respondent has acquired the subject domain purely to make illegal profit therefrom. The complainants point out that the Respondent has made no use of the domain name in connection with a bona-fide offering of goods or services, and is holding on to the domain name for dishonest purposes. They further state that respondent's registration and passive holding of the domain name fails to demonstrate any use in connection with a bona fide offering of goods or services, and have relied upon: **{Am. Home Prod. Corp. v. Malgioglio, D2000-1602 (WIPO Feb. 19, 2001)}**; **{Vestel Elektronik Sanayi ve Ticaret AS v. Kahveci, D2000-1244 (WIPO Nov. 11, 2000)}** - and have annexed the copies of the same with their complaint as **Exhibit H** and **Exhibit I**

V



The complainants claim that their marks and Geographical Indications/Protected Origin designation are particularly strong and have gained absolute exclusivity in respect with the Complainant and its unique product and due to the wide recognition and goodwill accrued in the Complainant's marks and Geographical Indications/Protected Origin designation as being synonymous with a premium and unique product, the Respondent is relying on such recognition and goodwill of the Complainant to sell the disputed domain name at a profit. The Complainant avers that the Respondent has no legitimate interest and no basis to claim non-commercial fair use or, under the circumstances, any kind of use of the Complainant's mark **PROSCIUTTO DI PARMA**, except to make unlawful profit therefrom. Further the Respondent does not use the mark/name **PROSCIUTTO DI PARMA** as his business name/corporate name and neither does he use the said mark/name for any legitimate commercial purposes and that the Respondent clearly could not have independently arrived at the domain name "prosciuttodiparma".It is alleged that the Respondent does not and never had any intention of providing a legitimate, non-commercial fair use of the disputed domain name.

It is alleged that the Respondent has registered the domain name <prosciuttodiparma.co.in> in bad faith as it by registering the disputed domain name for no apparent legitimate purposes and holding on to the same with absolutely no justification is aimed to



make wrongful profit reliance is placed on *{HSBC Holdings pic v. Hooman Esmail Zadeh, **Exhibit J***

The complainants point out that past and present registrants of the disputed domain name share the same physical and e-mail addresses and are one and same entity/person. The Complainant alleges that that the Registrant-Respondent, on receiving the Complainant's demand letter, changed domain registration details to deflect further action. The fact that the Registrant-Respondent ignored the Complainant's legitimate demand of domain transfer, but instead proceeded to offer the domain to third parties, adequately proves the Respondent's bad faith. They allege that the Respondent's website carries nothing but irrelevant and unrelated links showing that it is just a cyber-squatter, waiting for an illegal profit out of his wrongful act. Furthermore, the temporary page currently available on www.prosciuttodiparma.co.in indicates that the domain has already been put up for sale.

The Complainant's trademark and Geographical Indication/Protected Origin designation is distinctive and is in evidence that it is well known around the world and thus there is absolutely no justification for the Respondent, residing and operating in China, to select a name, which by definition is region and product specific and cannot be used by anybody else except



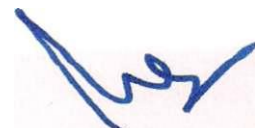
the members of the Complainant and entities authorized by it, for its domain.

It is further alleged that the disputed domain name is not used for any *bone fide* offerings and this shows that the Respondent never had any honest intention to use the domain name and acquired it only for wrongful commercial gain - either to sell outright or to attract Internet users for commercial gain, that is, facilitating "pay-per-click" on various unrelated links, by trading on the goodwill associated with the Complainant's trademark.

ORDER

This Tribunal has given an anxious consideration to the allegations of the complainants and has seen that the Respondent despite being aware of the present proceedings and despite being called upon by this Tribunal to give its Statement of Defense chose not to give any and hence the allegations of the complainants remain un rebutted.

In view of the undisputed weighty evidence of the Complainants this Tribunal holds that the respondents did not have any claim on



the domain name '**prosciuttodiparma.co.in**' hence this Tribunal directs the Registry to transfer the domain name '**prosciuttodiparma.co.in**' to the complainants. The Complainants too are free to approach the Registry and get the same transferred in their name.

The original copy of the Award is being sent along with the records of this proceedings to National Internet Exchange of India (NIXI) for their record and a copy of the Award is being sent to both the parties for their records

Signed this 22nd day of February, 2011



V. SHRIVASTAV
ARBITRATOR

NEW DELHI
22/02/2011