



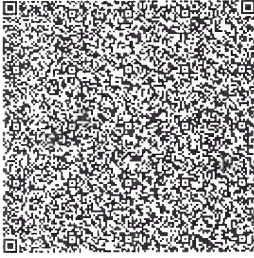
सत्यमेव जयते

INDIA NON JUDICIAL

Government of National Capital Territory of Delhi

e-Stamp

Certificate No.	: IN-DL93949781648120Q
Certificate Issued Date	: 27-Feb-2018 01:46 PM
Account Reference	: IMPACC (IV)/ dl839103/ DELHI/ DL-DLH
Unique Doc. Reference	: SUBIN-DL83910391286315577610Q
Purchased by	: DIVYA BALASUNDARAM
Description of Document	: Article 12 Award
Property Description	: Not Applicable
Consideration Price (Rs.)	: 0 (Zero)
First Party	: DIVYA BALASUNDARAM
Second Party	: Not Applicable
Stamp Duty Paid By	: DIVYA BALASUNDARAM
Stamp Duty Amount(Rs.)	: 100 (One Hundred only)



.....Please write or type below this line.....

BEFORE THE SOLE ARBITRATOR: DIVYA BALASUNDARAM
C/O National Internet Exchange of India

In the matter of :

PUMA SE Versus CHRISTIAN SCHMIDT

Statutory Alert:

1. The authenticity of this Stamp Certificate should be verified at "www.shcilestamp.com". Any discrepancy in the details on this Certificate and as available on the website renders it invalid.
2. The onus of checking the legitimacy is on the users of the certificate.
3. In case of any discrepancy please inform the Competent Authority.

ARBITRAL AWARD

.IN REGISTRY

C/O NATIONAL INTERNET EXCHANGE OF INDIA

Disputed Domain Name : <puma.in>
Before the Sole Arbitrator: Divya Balasundaram

PUMA SE
PUMA Way 1,
Herzogenaurach 91074, Germany

... Complainant

Versus

Christian Schmidt
Terra Preta GmbH
Gustav-Mueller-Strasse 1
Berlin 10829, Germany

... Respondent

1. The Parties

- 1.1 The Complainant in this matter is PUMA SE, a company organized under the existing laws of Germany with its office at PUMA Way 1, Herzogenaurach 91074, Germany. The Complainant is represented by its authorized representative Rahul Sethi of RNA, Technology and IP Attorneys, 401-402, 4th Floor, Suncity Success Tower, Sector-65, Golf Course Extension Road, Gurgaon - 122005, Haryana.
- 1.2 The Respondent in the present proceeding is Christian Schmidt of Terra Preta GmbH, Gustav-Mueller-Strasse 1, Berlin 10829, Germany.

2. The Domain Name and Registrar

- 2.1 The disputed domain name is <puma.in> registered with Key-Systems GmbH (R 48-AFIN), In the Upper Plant 1, 66386, St. Ingbert, Germany.


3. Procedural History

- 3.1 Arbitrator received an email on January 17, 2018 inquiring if NIXI can avail its services as an arbitrator for the dispute pertaining to the domain name <puma.in>. Arbitrator confirmed availability by email of January 18, 2018 and also sent the signed Statement of Acceptance and Declaration of Impartiality and Independence as required by the Rules.
- 3.2 The .IN Registry appointed Divya Balasundaram as the Sole Arbitrator in this dispute on January 24, 2018 and the Arbitrator received soft copy

of the complaint with annexures. Hard copy was also received by courier.

- 3.3 Arbitral proceedings were commenced by the Arbitrator on January 24, 2018 by issuance of notice to the Respondent by email directing him to file reply to the Complaint within 15 days.
 - 3.4 The Respondent sent an email dated February 1, 2018 to NIXI with six annexures. The Complainant then filed Rejoinder on February 13, 2018. The Respondent sent another response with eight annexures on February 18, 2018. This was followed by further emails by both Complainant and Respondent on February 19, 2018.
 - 3.5 Arbitrator sent an email on February 19, 2018 reserving the order in this matter.
 - 3.6 The language of these proceeding is English.
4. Background of the Complainant and its rights in the trademark PUMA as stated in the Complaint
- 4.1 The Complainant is a company organized and existing under the laws of Germany headquartered at Puma Way 1, Herzogenaurach, 91074 Germany.
 - 4.2 The Complainant on its own and through its subsidiaries/affiliates world-wide is engaged in the business of manufacturing and marketing a wide range of products, inter alia, sports shoes, apparel and accessories including but not limited to track suits, T-shirts, shorts, polo shirts, Sports shoes, formal shoes chappals, Flipflops, Slippers, Sandals, Socks, ladies purse, bags, wallets, fashion products and other accessories and equipment of the highest quality. The Complainant and their subsidiaries and affiliates the world over are one of the world's leaders in the sporting goods industry with sports brands built on a passion for sports and a sporting lifestyle and providing highest value to consumers.
 - 4.3 For over 65 years, the Complainant has established a history of making fast product designs for the fastest athletes on the planet. Complainant offers performance and sport-inspired lifestyle products in categories such as Football, Running, Training and Fitness, Golf, and Motorsports. The Complainant's soccer shoes are known for their durability and ground breaking designs. The Complainant is the sponsor of more than 30 national soccer teams in five different FIFA confederations. Furthermore, the Complainant has also enjoyed endorsement of some famous soccer celebrities like Pelé, Diego

Maradona and others. It collaborates with renowned design brands to bring innovative and fast designs to the sports world. The

ComplainantGroup owns the brands PUMA, , Cobra Golf, Dobotex and Brandon.

- 4.4 The trade mark PUMA was coined in 1948 by Rudolf Dassler and has been extensively used since then. The Complainant PUMA products are available in more than 120 countries worldwide including India and the Complainant employees more than 10,000 people worldwide.
- 4.5 The Complainant has spent millions of dollars on advertisement and promotion of its brands and products worldwide including in India. The Complainant advertises its brand and products through various media including through celebrity endorsement, newspapers, magazines etc.
- 4.6 Sales of Complainant's products have crossed millions of dollars. For example, the consolidated sales for the financial year 2016 were € 3626.7 million. The Complainant sales its products through physical stores as well as online. In India, products have been available since the year 1982.
- 4.7 Details of the Complainant's business can be found on the website www.puma.com which is accessible throughout the world. In India, the Complainant is caring on its business activities under the name "Puma Sports India Pvt. Ltd." with its registered office at Bangalore, incorporated in 2005. Details of Complainant's extensive business activities in India can be viewed on its website <https://in.puma.com>.
- 4.8 The domain name <puma.com> is owned by the Complainant and was registered by it on September 19, 1997. The Complainant has widespread presence over the internet. Thus, the public at large identifies the Complainant through its trade mark/ trade name 'PUMA' even on the internet.
- 4.9 The earliest Trade Mark registration for the mark PUMA goes back to the year 1948. The Complainant's mark PUMA (word and logo form) is registered in a number of countries around the world including India for various goods and services. In India, the earliest registration for PUMA dates back to the year 1977. Details of trade mark registration of the Complainant have been provided by it.
- 4.10 The popularity and the fame of the Complainant's PUMA trademark have also transcended the physical boundaries and have acquired

trans-border reputation in India. The Complainant's rights in the trade mark PUMA have been recognized as well known in various jurisdictions across the world.

4.11 By virtue of long, continuous and extensive use and promotion of the PUMA mark, the Complainant has earned substantial goodwill and reputation in the same worldwide. The mark PUMA is exclusively identified with the Complainant to the exclusion of all others. The use of the said mark by any person other than the Complainant will give rise to confusion and deception amongst the purchasing public that such products and our services are connected or otherwise related to the Complainant.

4.12 The Complainant's trademark PUMA is well-known mark as envisaged under the provisions of Section 2(1) (zg) and Section 11 of the Trade Marks Act, 1999. In view of the above, the trademark PUMA is entitled to protection against any misappropriation by third parties. The PUMA trademark / trade name has acquired as secondary meaning and is a valuable asset to the Complainant's business.

5. Respondent, its activities and registration of the Domain Name

5.1 The Respondent has registered the domain name www.puma.in with .IN Registry on February 16, 2005. The disputed domain name incorporates the Complainant's well-known and prior used mark PUMA and prior registered domain www.puma.com in entirety. It is a settled proposition of law that where there is copying, dishonesty ought to be presumed. In the present case, copying by the Respondent is evident from its adoption of an identical domain name. In the circumstances, the present case is clearly that of cyber-squatting. The registration of disputed domain name www.puma.in amounts to infringement of the Complainant's IP rights vested in the PUMA mark.

6. Legal Grounds of the Complainant

6.1 The domain name www.puma.in is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights.

6.2 The Complainant is the prior adopter and user of the trade mark PUMA globally and in India. Thus, the Complainant has rights in the PUMA mark that predates registration date of the domain name.

6.3 The disputed domain name www.puma.in is identical to the Complainant's PUMA mark, save for the .IN generic top level domain which is required for technical reasons and does not serve to

distinguish the disputed domain name from the Complainant's trademark.

- 6.4 The Complainant owns several country specific domain names (ccTLDs) constituting PUMA mark namely; www.puma.jp, www.puma.de, www.puma.fr, etc. All these domain names resolve to the official websites of the Complainant in the respective countries namely Japan, Germany and France. In such situation, it is obvious that the Respondent's website at the disputed domain name will confuse Internet users, visitors or potential customers to believe that the said website is Complainant's India specific website which is not true. The Complainant further submits that it has not licensed or otherwise permitted the Respondent to use the trademark/domain consisting of or incorporating the PUMA trademark.
- 6.5 The Respondent has no rights or legitimate interests in respect of the Domain Name.
- 6.6 By the time Respondent registered the disputed domain name, the PUMA mark had already attained the status of well known / famous mark. Accordingly, the Respondent was well aware of Complainant's prior rights in the PUMA mark and domain name www.puma.com at the time of registering the disputed domain name in the year 2005.
- 6.7 There is no credible legitimate reason for the Respondent to have chosen to adopt the identical domain name consisting of PUMA mark. The only purpose to do so was to use the fame of the Complainant's mark to generate web traffic and to confuse internet users visiting the Respondent's website/domain name www.puma.in when looking for the Complainant and their famous products. In plenty of cases, UDRP panels have found that domain names identical to a Complainant's trademark carry a high risk of implied affiliation.
- 6.8 The disputed domain name redirects to the Respondent's website. It is submitted that over the years, UDRP Panels have consistently found that "redirecting the domain name to a different respondent-owned website, even where such website contains a disclaimer" supports the finding that the Respondent has registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark.
- 6.9 On information and belief, the Respondent is not commonly known by the name or nickname of the disputed domain name or any name containing Complainant's PUMA mark. The Respondent is trading off its goods and services through the resolved website <https://terra-preta.de/> and such use by the Respondent is neither a bona fide

offering of goods or services nor a legitimate non-commercial or fair use of the domain name. The Respondent does not have any active business interests under the PUMA mark and is simply a cyber squatter.

- 6.10 The aforementioned facts establish a prima face case that the Respondent has no right or legitimate interest in the disputed domain name and that pursuant to the Policy, the burden shifts to the Respondent to show it does have a right or legitimate interests.
- 6.11 The Domain Name was registered or is being used in bad faith.
- 6.12 The fame and prior use of the Complainant's PUMA mark make it extremely unlikely that the Respondent created the identical disputed domain name independently or that it just mere co-incidence. The Respondent could have adopted any other domain name however, it willingly adopted of the domain name containing Complainant's PUMA mark despite knowledge of Complainant's PUMA mark.
- 6.13 The Respondent is not using the disputed domain name, and is redirecting the same to its own website with entirely different domain name (www.terra-preta.de). It is clear that the Respondent has registered the disputed domain name in order to prevent the Complainant from reflecting the PUMA trademark in a corresponding domain name.
- 6.14 The Complainant approached the Respondent in the month of December 2017 seeking voluntary transfer of the disputed domain name to its custody. However, the Complainant was told by the Respondent's counsel that the Complainant has no right in the disputed domain name as the Complainant is aware of the disputed domain name since 2006 and that there was no likelihood of confusion between the Complainant's and Respondent's goods and business.

7. Reply of Respondent

- 7.1 The Respondent is a company founded in 2005 as a Sole Proprietorship and incorporated in the year 2012 in Germany. The main purpose of the Respondent company is to develop and sell various soil and fertilizer products to the public in the European Union only. Its website is <http://terra-preta.de>. The Respondent company has been in good standing and was a partner in a European Union Research Programme.
- 7.2 The Respondent is the owner of various domain names to cover its past, current and future products. The domain name <puma.in> was registered by the Managing Director of the Respondent. The name

PUMAIN originates from the strong smell of the product coming from the German saying within "someone smells like a puma".

- 7.3 The Respondent has been selling product name PUMAIN since 2007 and the Respondent was the owner of the German trademark PUMAIN from 2006 to 2016. The trademark was not renewed in 2016 since PUMAIN had become a longstanding trade name which generates its own protection. The Respondent recognizes the legitimate rights of the Complainant regarding its trade mark rights in the word PUMA. The PUMAIN trade mark is for soil products falling in Class 1 which does not interfere with the Complainant's trade mark.
- 7.4 The trade mark PUMAIN has not been disputed by the Complainant although he knew the same from 2006 onwards. The Complainant has twice failed with cease and desist orders to transfer the disputed domain name in 2006 and 2017.
- 7.5 The use of "dot" within a trade mark is fair use. The domain name <puma.in> is identical / confusingly similar to the brand PUMAIN which the Respondent has been using for over 10 years in commerce. Various UDRP cases underline that a "dot" between the letters needs to be taken into account when deciding on a trade mark. For example, tru.green is identical to TRUGREEN, tes.co is confusingly similar if not identical to TESCO, b.mw is confusingly similar if not identical to BMW. Further, the domain name <puma.in> is the shortest domain for trade mark PUMAIN. This is a good faith use of a domain name.
- 7.6 The word PUMA is primarily a generic word with multiple references, it refers to multiple uses such as an animal name, company name, technology name, vehicle name, people name, sports name and many more.
- 7.7 The Respondent denies all the allegations of the Complainant. The Respondent states that it has legitimate rights and interests in the disputed domain name. The Respondent also states that the disputed domain name was registered in a bonafide manner.
- 7.8 The Complainant missed its chance to apply for its top level domain name and also the .IN top level domain name. The Complainant has lost its rights to claim the disputed domain name since it did not taken any action against the Respondent from 2005 to 2017. The Complainant is trying to over stretched its trade mark reach towards all words including the word PUMA. This is a case of reverse domain name hijacking.

8. Rejoinder by the Complainant

- 8.1 In its rejoinder, amongst other contentions, the Complainant has pointed out that Respondents business is restricted to European Union only as admitted by the Respondent. Further, the Respondent's official website is terra-preta.de wherein .de is the country code top level domain for the Federal Republic of Germany, therefore, it is evident to the Respondent has known business interests in India.
- 8.2 Prior to the filing of the present complaint, the disputed domain name <puma.in> redirected to the Respondent's website which did not contain any use of the PUMA mark in the resolved domain name or the resolved website. The Respondent has made changes to the disputed domain name to redirect to a new domain name containing PUMAIN only after the receipt of present complaint. This is accepted by the Respondent on the basis that it is constantly developing website with changing texts, pictures, keywords and links.
- 8.3 Assuming without admitting that the Respondent sells a product under the name PUMAIN, it should have registered the domain name PUMAIN.IN instead of the disputed domain name. Since, the .IN generic top level domain name for India is required for technical reasons, the Respondent domain name is PUMA which is identical to the Complainant's trade mark and bears no reference to the Respondent's alleged mark PUMAIN. Hence this is bad faith to come as close as possible to the Complainant's well known mark PUMA.

9. Discussions

- 9.1 I have reviewed all the pleadings as filed by the Complainant and the Respondent and annexures. Submissions by additional email correspondence has also been reviewed. Upon review and detailed reading of all the pleadings, I find that the complaint has been properly filed.
- 9.2 The Complainant has established its rights in the mark PUMA internationally and in India much prior to Respondent's registration of the disputed domain name. The Complainant has been using the mark since 1948, it is used world over including in India and the name PUMA and PUMA with logo have become synonymous with the Complainant and its products. Significantly, the Respondent has admitted knowledge of Complainant's PUMA mark.
- 9.3 Whilst the word puma may have multiple meanings, it cannot be denied that the same has acquired a secondary meaning in name of the Complainant by virtue of long standing adoption and extensive use by

Complainant. The Complainant's trademark PUMA can be regarded as well-known under the provisions of Section 2(1) (zg) and Section 11 of the Trade Marks Act, 1999 and is hence entitled to protection against use for unrelated products as well.

- 9.4 With respect to the first legal ground, the disputed domain name incorporates the mark PUMA in entirety. Save for the .IN generic country code top level domain, it is identical to the Complainant's PUMA mark. The ccTLD is not to be considered for purposes of determining similarity between domain name and trademark.
- 9.5 Even presuming Respondent's contention that the disputed domain name is based on its product PUMAIN originating from the strong smell of the product from the German saying "someone smells like a puma", they should have adopted pumain.in instead of puma.in. Further, given that the Respondent has admitted its business is in the European Union only, their choice of placing a dot between <puma> and <in> is unjustified and seems a clear attempt to take advantage of Complainant's reputation and goodwill in its PUMA mark.
- 9.6 It is natural for any user of the Internet to assume that puma.in is the India specific site of the Complainant, since PUMA is the trademark and .in refers to the cc TLD. In this background, the reason offered by the Respondent that puma.in is the shortest domain for trade mark PUMAIN and this is a good faith use of a domain name doesn't stand. The examples offered by the Respondent such as tru.green, tes.co and b.mw are irrelevant as <.in> in this instance is the cc TLD for India and hence the disputed domain name is actually identical with PUMA.
- 9.7 The Respondent has not been authorized to use PUMA nor has it been known by this name. At best, Respondent can claim rights in PUMAIN as a whole, interestingly they have given up their statutory rights by not renewing their trademark in Germany. No evidence has been shown of any rights in PUMAIN outside Germany, and definitely not in India.
- 9.8 The domain resolved to Respondent's website www.terra-preta.de which did not feature the product PUMAIN initially but did so only after receipt of this complaint which is accepted by the Respondent. Hence its claims that the disputed domain name was used to redirect to product page featuring PUMAIN is invalid.
- 9.9 Keeping in mind the above facts and circumstances, the contentions of the Respondent that the disputed domain name is not confusingly similar to Complainant's mark, or that it has a legitimate right in the same or that its adoption and use are in good faith are untenable. The

argument that PUMAIN has not been disputed by the Complainant despite knowledge from 2006 is immaterial as is the contention that the Complainant failed with cease and desist orders to transfer the disputed domain name. The other contentions of the Respondent that Complainant has lost its rights cannot now come to its aid.

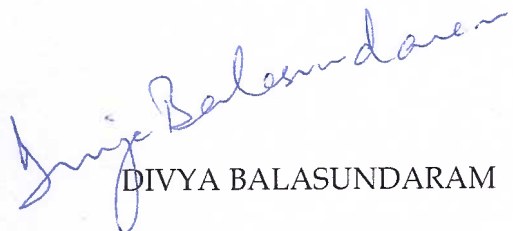
9.10 Hence, I find that the Complainant has been able to establish its rights in the name and mark PUMA as well as the three elements required by the INDRP Policy and Rules to arrive at a conclusion in its favour.

10. Decision

10.1 For all the foregoing reasons, the Complaint is allowed.

10.2 It is hereby ordered in accordance with paragraph 10 of the INDRP that the disputed domain name <puma.in> be transferred to the Complainant.

10.3 The Parties shall bear their own costs.


DIVYA BALASUNDARAM

ARBITRATOR

Date: March 20, 2018

Place: New Delhi, India