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ARBITRATION CASE NO. 1/2009

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IN THE ARBITRATION MATTER OF:-

PANTALOON RETAIL (INDIA) LIMITED. . . . . .COMPLAINANT

VERSUS

JOHN GLENNON. . . . .RESPONDENT

AWARD

The present dispute has arisen over the registration of the domain name ***rip.in***, which is registered in favour of the Respondent. The Complainant through the instant complaint claims its rights over its registered mark/brand 'RIG' and questions the bonafide of the Respondent's domain name www.rig.in which is deceptively similar to the complainant's prior registered domain name www.rig.co.in. The complainant seeks a transfer of the impugned domain name **www.rig.in** in favour of the complainant.

The Complainant has filed the present complaint under the .IN Domain Name Resolution Policy of .IN Registry.

The Complainant contended that it acquired registration of the marks 'RIG' in or around 2003 and from then onwards it has been in continuous, extensive and exclusive use in respect of the merchandise of the Complainant. Further, its extensive and continuous usage of the marks 'RIG' has led to its acquiring a secondary meaning to connote and denote to the relevant section of the public, the merchandise of the Complaint and also tremendous distinctiveness of the same. Accordingly, in the year 2005, in furtherance of their business activities, the Complainant got the domain name www.rig.co.in registered. The Complainant has also depicted through a chart (2006-2008) an insight into its increasing sale, owing to the popularity and large-scale use of the mark RIG.

The Complainant has stated that they have made sufficient investment toward the publicity and the promotion pertaining to the mark' RIG'. By virtue of its continuous and consistent usage, the Complainant claims to have acquired common law and statutory rights to the exclusive use of the brand name 'RIG' and coherently its domain name www.rig.co.in and hence challenges the validation of the registration of the domain name www.rig.in in favour of the Respondent, which is deceptively similar to the Complainant's prior registered domain name. The Complainant has contended that the use of such confusingly similar domain name by the Respondent would create deception in the minds of unwary consumers/ internet users and is bound to divert internet traffic haywire.

In reply to the said complaint, the Respondent has stated that the Complainant has not complied with the conditions of INDRP and has accused the Complainant of "domain hoarding". The Respondent has stated that the Complainant has submitted evidence of ownership of three registered trade marks but the Complainant has not sought protection under the Trade Marks Act of the alleged textual mark "RIG", for which the Complainant claims to have rights. In the context the Respondent has relied upon a decision in **(maha.com) Maschinenbau Haldenwang GmbH & Co. KG v. Deepak Rajani WIPO Case No.** D **2000-1816.** The Respondent stated that the Complainant did not make any mention of the nature of its registered trademarks in the Complaint. The Respondent contended that the evidence submitted by the Complainant are the actual marks for which the Complainant has sought and obtained protection, and all of which are considerably more complex and convey a compound impression beyond the mere three letters 'RIG'. Furthermore, the Respondent has stated that a Google India search of the term "rig" shows a finding of 28,400,000 search results. The Respondent has stated that it does not contest the Complainant's rights in the marks for which it has obtained registration, and in connection with the goods of clothing upon which the Complainant claims such marks are used. But it is not the Complainant's rights in its actual marks which is being challenged. The Respondent has submitted that the Complainant has not on the preponderance of evidence, discharged its burden to show that the domain name is identical or confusingly similar to a trade or service mark in which the complainant has rights. With respect to the second factor of the INDRP policy, the Respondent has stated that it is for the Complainant to show that the Respondent has no legitimate rights or interests in the

domain name, which the Complainant could not establish. The third factor of the INDRP policy which the Complainant fails to prove, as per the Respondent is that the registration and use of a domain name by the respondent is in bad faith.

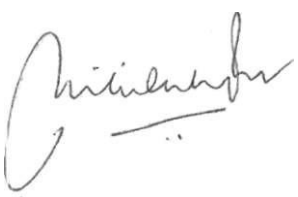
The complainant in its rejoinder to the reply filed by the respondent stated that the continuation of registration and any subsequent use of the impugned identical domain name by the respondent would cause great prejudice and injury to the commercial interests of the Complainant in the mark "RIG". The Complainant has stated that the registered marks "RIG" referred to and relied upon in the Complaint contain "RIG" as the only prominent feature, the other features being descriptive and non-significant. The complainant has further submitted that it is apparent that the impugned domain name www.riq.in is identical to the prior registered domain name www.rig.co.in and contains the registered marks "RIG" of the Complainant and the said contention does not necessitate any further proof. The Complainant has relied upon the decision in **Satyam Infoway Ltd v. Sifynet Solutions Pvt. Ltd** where it was observed by the Hon'ble Supreme Court of India that a domain name is accessible by all internet users and the need to maintain an exclusive symbol for such access is crucial. Therefore a deceptively similar domain name may not only lead to confusion of the source but also the receipt of unsought for services. Furthermore, it is submitted that the Respondent has failed to justify the bonafide adoption of the impugned identical domain name more particularly in view of the already existing domain name www.arogi.com owned by the respondent which also offers identical/ similar services as those alleged in respect of the impugned domain name. Furthermore, it is

submitted that the domain names being business identifiers have to be unique and should be considered independently of the products/ services provided there under.

On the analysis of the document and record submitted by both parties it is seen that the Complainant had registered the trademark prior to the Respondent and it has been in use with respect to the business activities of the Complainant since 2003. The Complainant has produced its trademark registration over its mark "RIG". The connection between trademarks and domain names has been well observed in various national and international cases. Recently, authorities in India (Yahoo! Inc Vs. Akash Arora), the U.K. (Marks & Apences & Ors Vs. One in a Millions & Ors.), Taiwan(fair Trade Committee 89 Gong Zhu Zi No.036), Italy, Germany, and the USA, among other jurisdiction, have ruled that the act of registering a domain name similar to or identical with or famous trade mark is an act of unfair competition whereby the domain name registrant takes unfair advantage of the fame of the trademark to either increase traffic to the domain, or to seize a potential asset of the trademark owner in the hope that the trademark owner will pay the requirement to relinquish the domain name.

In this context, I rely on the findings in the landmark judgment of **Yahoo! Inc. Vs. Akash Arora & Anr.; 78(1999) Delhi Law Times 285.** In this matter, relying on a decision in **Cardservice International Inc Vs. McGee 42 USPQ 2d 1850,** the Hon'ble High Court of Delhi held that the domain name serves the same function as the trademark and is not a mere address and therefore entitled to equal protection as trade mark. In

the said case, it was held that, Cardservice international's customers who wish to take advantage of its internet service but do not know its domain name are likely to assume that "cardservice.com" belongs to Cardservice International. However, these customers would reach McGee and see a home page for "Cardservice" and thereby assume that they have reached Cardservice International. The Court observed that the services of the plaintiff under the trademark/domain name 'Yahoo!' have been widely publicised and written about globally. In an internet service, a particular internet site could be reached by anyone anywhere in the world who proposes to visit the said internet site.... as a matter of fact in matter where services are rendered through the domain name in the internet, a very alert vigil is necessary and a strict view is to be taken for its easy access and reach by anyone from any corner of the globe.....there can be no two opinions that the two marks/domain names 'Yahoo!' of the plaintiff and "Yahooindia" of the defendant are almost similar.... and there is every possibility and likelihood of confusion and deception being caused. The plaintiffs herein were thus granted and interim injunction restraining the defendants from using the domain name 'Yahooindia.com'. Another similarly decided case is that of **Marks & Spencers & Ors. Vs. One in a Million & Ors,** wherein a British Court ruled that where the value of the domain name consists solely of its resemblance to the trademark of another, the Court could assume likelihood of confusion, and thus find unfair competition. The Court found that the registrant of many domain names similar to famous marks had committed a "deliberate practice....with clear intent to deceive people" as the registrant had no legitimate use for the domain names.



Furthermore, under the Policy, the Registrant has to demonstrate its legitimate right or interest over the domain name in connection with offering of goods or services. The Respondent has not shown evidence that he has a right or interest over the domain name use particularly for any goods or services.

Even if the complainant was not able to prove that the said domain name was not used in bad faith, although by using such domain name there is every likelihood that it could create confusion with the Complainant's mark, but the Respondent has been unable to show that he has any legitimate right or interest over domain name for the goods or services offered by him.

The Respondent in his reply does not dispute the Complainant's right over the mark "RIG". What he raises is that the complainant has not been able to prove or show that the domain name is identical or confusingly similar. This issue would not hold good for the reason the internet user are only aware by the domain name and not by any mark. What comes in the mind of a user is the name and not the mark. Furthermore, the rig is not distinct or a combination of words. The word is common word and therefore it is prone to create confusion in the minds of the internet user.

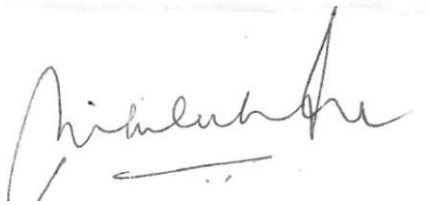
From the evidences submitted, I find that the complainant is the proprietor of several well known marks which are in long and extensive use thereby acquiring distinctiveness in the merchandise of the complainant. The complainant is the registered proprietor of the marks 'RIG' from the year 2003. I find that the impugned domain name www.rig.in is identical and

confusingly similar to the prior registered domain name of the complainant which is www.rig.co.in. Further the respondent could not submit evidence in support of its claim for bonafide adoption of the impugned identical domain name. The stand of the respondent does not seem bonafide especially in view of the respondent's already existing domain name www.arogi.com, which also offers similar services as those alleged in respect of the impugned domain name.

Considering the facts and circumstances of the present matter and taking view of the precedents laid in the context thereof, it is found that the complainant has proprietary right over the mark 'RIG' and coherently its domain name www.rig.co.in. The registration of a domain name bearing the same mark 'RIG' will create nothing but confusion and thereby deception in the minds of the consumers/internet users. The law and Policy is very clear on the issue of proprietary rights over names of a registered user.

Under the facts and circumstances and on perusal of the records, I deem it fit and proper to allow the prayer of the Complainant to the transfer of the said domain name www.rig.in in its favour.

Parties to bear their costs.



NIKILESH RAMACHANDRAN
ARBITRATOR

DATED: 27th March 2009