

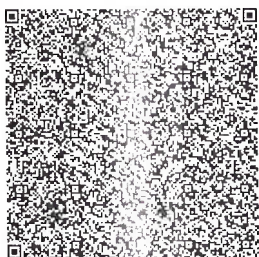
सत्यमेव जयते

INDIA NON JUDICIAL

Government of National Capital Territory of Delhi

e-Stamp

Certificate No.	: IN-DL98922852859547P
Certificate Issued Date	: 30-Jun-2017 09:46 AM
Account Reference	: IMPACC (IV)/ dl719103/ DELHI/ DL-DLH
Unique Doc. Reference	: SUBIN-DL71910398837449876491P
Purchased by	: SONAL KUMAR SINGH
Description of Document	: Article 12 Award
Property Description	: Not Applicable
Consideration Price (Rs.)	: 0 (Zero)
First Party	: SONAL KUMAR SINGH
Second Party	: Not Applicable
Stamp Duty Paid By	: SONAL KUMAR SINGH
Stamp Duty Amount(Rs.)	: 100 (One Hundred only)



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BEFORE THE SOLE ARBITRATOR UNDER THE .IN DISPUTE RESOLUTION POLICY

IN THE MATTER OF:

1. Santa Fe Moving Services Private Limited
619/9, Chattarpur, Opposite Tivoli Garden
New Delhi – 110 074 - India
2. Santa Fe Transport International Ltd.
18/F, C.C. Wu Building, 302-8 Hennessy Road,
Wanchai, Hong Kong

...Complainant(s)

V/s

Achyut Khare
Zawsoft

102/A, 1st Floor, Mustafa Towers
Lakdi Ka Pul, Hyderabad, Andhra Pradesh, 500004 India

...Respondent

Statutory Alert:

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(Signature)

The Parties

Complainant:

There are two Complainants in this Arbitration proceeding namely:

- a. Complainant No.1 is Santa Fe Moving Services Private Limited, a company incorporated under the laws of India and a subsidiary of Complainant No.2.
- b. Complainant No.2 is Santa Fe Transport International Limited a company incorporated under the laws of Hong Kong and also the owner of trade mark "Santa Fe" in India and other countries.

Respondent:

Respondent in this proceeding is Mr. Achyut Khare , of the address Zawsoft, 102/A, First floor, Mustafa Towers, Lakdi ka Pul, Hyderabad, Andhra Pradesh- 500004, India.

The Domain Name

The disputed domain name is www.santafemoversandpackers.in

Procedural History

I was appointed as an Arbitrator by .IN registry, to adjudicate upon the complaint of the Complainant, regarding the disputed domain name < www.santafemoversandpackers.in >.

.In Registry supplied the copy of the Complaint and annexures to the Arbitrator.

On 08.05.2017, the Arbitrator sent an email directing the complainant to supply the copy of the complaint with annexures to the Respondent and to provide the Arbitrator with the details of service record.

In accordance with INDRP Policy read with INDRP Rules of Procedure, notice of arbitration was sent to the Respondent on 08.05.2017 with the directions to file his reply within 15 days from the receipt of the above stated email or the receipt of the copy of the Complaint, whichever is later.

On 09.05.2017, Counsel/Representative of the Complainant sent the soft copy of the Complaint and the annexures to the respondent and also to the Arbitrator.

On 22.05.2017, the Counsel/Representative of the Complainant sent an email to the Arbitrator and the Respondent submitting that at the time of filing the complaint, the



Respondent had an active website on the impugned domain name for 'Santa Fe Logistics Packers and Movers'. It was also submitted that as soon as NIXI notified the parties of the commencement of the INDRP proceedings on April 28, 2017, the Respondent removed the entire website in an effort to cover its tracks and that at present, the impugned domain name directs to a blank page displaying a 'Not Found' and '404 Error'. It was also submitted that the Respondent's bad-faith and mala-fide intentions as well as the absence of any legitimate rights or interests in the domain name are apparent from the above-mentioned facts.

On 01.06.2017, the Arbitrator informed the parties that NIXI vide email dated 08.05.2017 confirmed that the complaint along with its annexures has been duly served upon the respondent. Arbitrator also informed the parties that the time granted to the respondent to file its reply has expired. However, the Arbitrator in the interest of justice granted 07 days to the respondent to file its reply and on the failure to file his reply within such period, the arbitrator will proceed with the matter on the basis of the pleadings and the documents already on record and will pass the award.

The Respondent failed to file his reply to the Complaint of the Complainant. The Arbitrator feels that enough opportunity has been given to the Respondent and genuine efforts have been made to make him a part of this proceeding. Since he has failed to join the proceedings, or to file any response, the present award is passed on the basis of the pleadings and the documents, placed on record by the complainant and .IN Registry.

On perusal of the entire pleadings and the documents placed on record, the Arbitrator's finding is as under:-

Factual Background

The following information is derived from the Complaint and supporting evidence submitted by the Complainant:

1. That the Complainant(s) are commonly known as the 'Santa Fe Group' or 'Santa Fe Relocation Services', and are a global mobility company with headquarters in London, United Kingdom. They have presence in over 57 countries through their 136 offices and various subsidiaries such as Santa Fe Moving Services Private Limited in India.
2. That Santa Fe Relocation Services was first established in Hong Kong in the year 1980 and has since then been providing high quality mobility services. The



Complainant(s) are the largest relocation solution providers in the world and provide a full range of mobility services for multinational companies and other organisations and are world leaders in designing and managing entire relocation programmes for large organisations with international operations. The Complainant(s) handle around sixty thousand relocations each year and have been accredited by FIDI, the global alliance of professional international moving and relocation companies; and FNAIM.

3. The Complainant(s) have acquired the Australian company Wridgways in December 2010 and the European-based company Interdean in August 2011. After the acquisition of these two companies, Santa Fe Relocation Services opened operations in Africa, the Middle East and the United States. The company also has several offices in Australia, Asia [including India], the Middle East, Africa, Eurasia, Europe and USA. That Santa Fe Relocation Services is also listed on NASDAQ in Copenhagen, Denmark and that the complainant had a turnover of 373 Million Euro in the year 2015.
4. That it has spent a huge amount of money on the promotion and advertisement of its services and products under the trade/service name/mark 'Santa Fe' since its adoption and use in all mediums including print and electronic.
5. That it considers its trade/service name/mark an important and an extremely valuable asset and thus in order to protect the same, have secured several trademark registrations for the mark 'Santa Fe' as well as their logo in India as well as several other jurisdictions around the world. That around sixty applications/registrations for the mark 'Santa Fe' have been filed/obtained across the world and the first trade mark registration dates back to the year 1985. That they are the exclusive owner and proprietor of the said registrations and that they are duly valid and subsisting as of the current date.
6. That their profile and popularity under the well known trade/ service mark 'Santa Fe' has been continuously increasing since the date of the adoption of the mark. That Google search of the term '**Santa Fe Relocation Service**' throws up a huge number of results of which each and every result displayed at the first page, pertains to the Complainant's only. That their present official website <www.santaferelo.com> is a comprehensive, unique and acclaimed introduction to 'Santa Fe'. That the Complainant/s and its subsidiaries own several other domain names comprising of the mark 'Santa Fe'.



7. That their mark is well known and at present, their trade name/mark is identified by the purchasing public exclusively with the complainant/s and has acquired an enormous goodwill not only in India but in several other countries across the globe. That they have a wide presence on social media. For example, Facebook (<https://www.facebook.com/SantaFeRelo/>); Twitter(<https://twitter.com/SantaFeReloAsia>); and YouTube (www.youtube.com/channel/UCof5SzqGFuzfh50pw3HF4cw). That they regularly provide services to well known brands across the world such as Coca Cola, Red Bull, Volvo, DHL, L'Oreal, Merck, Renault, etc and that the services are not only popular in India but worldwide.
8. That as internet has become an essential medium to conduct business, they in order to expand their presence decided to obtain a domain name for registration and therefore settled for santaferelo.com as a natural extension of their corporate name. That they spent considerable amount of money and skill to develop a website on the obtained domain name santaferelo.com and that in addition to this Complainant/s and its subsidiaries also own several other domain names comprising of the mark 'Santa Fe'. That their present official website www.santaferelo.com is a comprehensive, unique and acclaimed introduction to 'Santa Fe' and that it registered the said domain name in the year 2002. That its subsidiaries own several other domain names comprising of the mark 'Santa Fe'.
9. That they learned that somebody had obtained a domain name registration for santafemoversandpackers.in and, upon searching the WhoIs database for the disputed domain name, found that the impugned domain has been registered in the name of 'Achyut Khare', the Respondent. That the disputed domain name is a duplication of the Complainant/s' trade/service mark followed by the generic term 'Movers and Packers' and that being aggrieved by the registration of the disputed domain name i.e. santafemoversandpackers.in, the Complainant/s have filed this Complaint.

RESPONDENT:

1. Respondent in this proceeding is Achyut Khare of the address Zawsoft, 102/A, First floor, Mustafa Towers, Lakdi ka Pul, Hyderabad, Andhra Pradesh- 500004, India

Even after repeated opportunities, the Respondent has failed to file any reply to the Complaint within the given/stipulated time. The Arbitrator in the interest of justice,



suo moto extended the time for the Respondent to file his reply to the Complaint but the Respondent has neglected to file any reply even within the extended time.

PARTIES' CONTENTIONS:

I. Complainant:

The Complaint contends as follows:

- a. The Respondent's disputed domain name is confusingly similar to the Complainant's Trade Mark(s).
- b. The Respondent has no rights or legitimate interest in respect of the disputed domain name.
- c. The disputed domain name was registered and used in bad faith.

II. Respondent:

Even after enough opportunities, the Respondent has failed to file any reply to the Complaint within the given time by the Arbitrator as well as within the extended time given by the Arbitrator and thus none of the contentions of the Complainant have been rebutted by the Respondent.

Discussions and Findings:

The present proceedings have been conducted in accordance with Rule 8 (b) of the INDRP Rules of Procedure which states that "*In all cases the Arbitrator shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case*".

Rule 12 (a) of the INDRP Rules of Procedure provides that "*An Arbitrator shall decide a Complaint on the basis of the statements and documents submitted to it and in accordance with the Arbitration and Conciliation Act, 1996, Dispute Resolution Policy, the Rules of Procedure and any bye-laws, rules and guidelines framed thereunder and any law that the Arbitrator deems to be applicable*".

In the present proceedings, considering the fact that the Respondent has failed or neglected to file any reply to the complaint even after various opportunities given to him, the decision of the Arbitrator is based upon the statements and documents submitted by the Complainant.



Also, the conduct of the Respondent for not filing any reply even within the extended time infers that he has accepted the contentions of the Complainant and intentionally has chosen not to rebut the same by filing any reply.

Having perused the submissions and documentary evidence placed on record, the Complainants have proved that they have statutory and common law rights in the mark "Santa Fe".

Further, the Arbitrator is of the view that the complainant has satisfied all the three conditions outlined in the paragraph 4 of .IN Domain Name Dispute Resolution Policy, viz

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

- i. The Respondent's disputed domain name is identical and/or confusingly similar to the name, trade mark or service mark in which Complainants have rights.**

The Complainants have contended that the mark 'Santa Fe' has been in extensive, continuous and uninterrupted use since the year 1980 in relation to the Complainant/s' business and have thus acquired secondary meaning in the mark. More specifically, the mark 'Santa Fe' has been in use by the Complainant/s in relation to all its stationery articles including letterheads, visiting cards, order forms, bill books, envelopes, application forms and in relation to sales, promotional materials, such as, brochures, catalogues, etc. The Complainants have further submitted that the mark 'Santa Fe' has been used in relation to advertisements and business/commercial information has been disseminated in several print media such as newspapers, magazines etc. published around the world. In each of the instances of use, the mark 'Santa Fe' is prominently displayed and has become the focus of the Complainant/s' entire business. It is further submitted by the Complainants that the mark 'Santa Fe' is extremely popular and well-known across the world.

The Complainants contend that the disputed domain name is identical to the well-known trade mark 'Santa Fe' and the Respondent has picked up the registered trade mark of the Complainants verbatim without even changing a single letter and has



suffixed the term 'Movers and Packers' after it. This particular term describes the business of the Complainant/s which is carried out under the 'Santa Fe' mark. Therefore, a mere glance at the disputed domain name gives rise to enormous confusion to its origin, as the domain name by the respondent is identical to the trademark/service mark of the Complainants.

The Complainants have further contended that the addition of a generic term that is descriptive of the goods or services offered under the Complainants' mark increases the confusing similarity of the domain name with the Complainant/s' mark and that the use by any other concern of an identical/deceptively similar mark to that of the Complainant/s' well-known mark and corporate name 'Santa Fe' is bound to lead to confusion and deception and amounts to passing off as well as trademark infringement.

Since the above contentions of the complainant have not been specifically rebutted by the Respondent, as such they are deemed to be admitted by him.

Even otherwise upon perusing the submissions and substantial evidence placed on record by the Complainants, the Tribunal observes that:

- a. The Complainants have statutory and common law rights in the trade mark "Santa Fe".
- b. The Complainants hold registration of the trade mark "Santa Fe" per se and also its formative marks with logo all over the world including in India.
- c. The trade mark "Santa Fe" has been used by the Complainants as their trade name and also to identify their services.
- d. The Complainants are also the owner of various domain names incorporating the trade mark "Santa Fe".
- e. The trade mark "Santa Fe" has been extensively used and promoted in public by the Complainants and thus have gained considerable reputation and goodwill in the market.
- f. The disputed domain name incorporates the registered trade mark of the Complainants in its entirety and has merely suffixed the term 'Movers and Packers' after it.

In view of above, the Tribunal finds that disputed domain name of the Respondent is confusingly similar and identical to the mark of the Complainants since it is a settled

law enunciated in various decisions under UDRP and INDRP that the addition of a generic term that is descriptive of the goods or services increases the confusing similarity of the domain name. Also if the disputed domain name contains Complainants' mark in entirety then mere addition of any specific top level domain, such as "in" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar.

ii. The Respondent has no rights or legitimate interest in respect of the domain name.

The Complainants submit that the Respondent has no proprietary or contractual rights in any registered or common law trade mark corresponding in whole or in part to the disputed domain name and thus it is highly improbable that the respondent has any rights or legitimate interests in the impugned domain name.

The Complainants further submit that the Respondent has developed a website on the disputed domain name and claims to be 'Santa Fe Logistics Packers and Movers', whereas no such entity actually exists and the contact information provided on the website is incomplete and incorrect. It is contended that the Respondent has been trying to lure and defraud unassuming customers by misleading them into believing that the website and the services offered through the disputed domain name are being provided by the Complainants.

The Complainants submit that the Respondent has registered several other domain names, majority of which are identical or confusingly similar to well-known, famous and legitimate Indian brands associated with providing relocation and packaging and therefore the Respondent is a habitual cybersquatter seeking to mislead and/or defraud internet users and does not have any legitimate rights or interests in the impugned domain name. That the domain names registered by the Respondent have a fake website providing relocation and packaging services.

The Complainants also submit that the Respondent has no active legitimate or bona fide business in the name of 'Santa Fe' and that he is not a licensee of the Complainants, nor has the Respondent ever been authorized by the Complainants to use the Complainants' trade mark or register the disputed domain name.



According to paragraph 7 of the .IN Dispute Resolution Policy, the following circumstances show Registrants rights or legitimate interest in the domain name for the purpose of paragraph 4 (ii)

- i. *before any notice to the Registrant of the dispute, the Registrant's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services;*
- ii. *the Registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or*
- iii. *the Registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.*

In light of the above submissions of the Complainants and the documents produced on record by the Complainants, the Tribunal finds that the Respondent by adopting an identical domain name, is trying to associate himself with the Complainants with the mala fide intention to ride upon the goodwill of the Complainants. In line of various INDRP and UDRP cases, the Arbitrator concludes that the Complainants have made out a prima facie case that Respondent does not have legitimate rights or legitimate interest in the disputed domain name and thus the burden of proof shifts on the Respondent. The fact that the Respondent has not filed any response to rebut any of the contentions of the Complainants and there is no evidence to support any fact contrary to the submissions of the Complainants. Even otherwise, it is clear that the Respondent has never been commonly identified with the disputed domain name or any variation thereof prior to Respondent's registration of the disputed domain name.

Thus, the above facts and evidence establish that the Respondent has no right or legitimate interests in the disputed domain name under INDRP paragraph 4 (ii).

iii. The domain name has been registered or is being used in bad faith.

The Complainant has made following submissions to prove the contention that the disputed domain name has been registered or is being used in bad faith by the Respondent:



- a) The Complainants submit that the addition of the term 'Movers and Packers' after the Complainant/s trademark 'Santa Fe' in the disputed domain name makes it apparent that the Respondent knew about the Complainant/s and their business activities and that the Respondent registered the disputed domain name to mislead consumers into believing that the impugned domain name is associated with the Complainant/s.
- b) The Complainants submit that the registration of several other domain names similar to famous and well-known brands in the Complainant/s' field of makes it abundantly clear that the Respondent is meticulously targeting these brands to mislead and defraud general members of the public.
- c) The Complainants submit that the Respondent has also developed a website on the disputed domain name and that the said website is purportedly advertising relocation and packaging services for 'Santa Fe Logistics Packers and Movers'. It is also submitted by the Complainants that the Respondent is blatantly trying to mislead internet users into believing that this website is the actual website of the Complainant/s.
- d) The Complainants submit that the Respondent is conducting an elaborate scam in India by trying to mislead the general public who are in need of relocation or packaging service providers and that by using the disputed domain name for fraudulent and unlawful activities, the Respondent has violated Section 5 of the .IN Registry's 'Terms and Conditions for Registrants'. It is further submitted that as per Section 6 of the 'Terms and Conditions for Registrants', the .IN Registry considers illegal or fraudulent actions as abusive use of domain name.
- e) The Complainants submit that the Respondent is using their well-known mark 'Santa Fe' and a variation of its logo – the horse device to mislead and confuse the general public who would wrongly assume that the impugned domain name and the services provided through it are being offered by the Complainants.
- f) The Complainants submit that the general public would be induced to believe that the Respondent has some connection with the Complainants in terms of a direct nexus or affiliation with the Complainants and that the Respondent is carrying on activities that have been endorsed by the Complainants and the services or products that are sought to be offered by the Respondent are at the same level of quality and reliability as that offered by the Complainants and its group of companies.



- g) The Complainants submit that the Respondent registered the domain name on January 23, 2016 and it is inconceivable that the Respondent was not aware about the popularity of the mark 'Santa Fe' at the time of registration of the impugned domain name, especially so because the mark is regularly featured in advertisements and news articles across all mediums - including the internet.
- h) The Complainants submit that the Respondent can transfer or sell the domain name to some competing interest of the Complainants who may damage the goodwill and reputation of the Complainants by inserting prejudicial material in relation to the Complainants' companies and that this will lead to complete tarnishment of the Complainants' image if valuable property like this domain name falls into the hands of competing interests.
- i) The Complainants submit that at the time of filing a complaint, the respondent had an active website on the impugned domain name for 'Santa Fe Logistics Packers and Movers'. It is also submitted that as NIXI notified the parties of the commencement of INDRP proceedings on April 28, 2017, the respondent removed the entire website in an effort to cover its tracks and at present the impugned domain name directs to a blank page displaying a 'Not found. ' and '404 Error'. It is submitted that the respondent's bad faith is established from his acts.

As per paragraph 6 of the INDRP Policy, the following circumstances are deemed to be evidence that a registrant has registered and used a domain name in bad faith :

- (i) *circumstances indicating that the registrant has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or*
- (ii) *the registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the registrant has engaged in a pattern of such conduct; or*
- (iii) *by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to its Website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source,*



sponsorship, affiliation or endorsement of its Website or location or of a product or service on its Website or location.

In view of the submissions and evidence placed on record by the Complainant and the fact that the Respondent has chosen not to file any reply to the complaint and rebut the contentions of the Complainant, the Tribunal finds that the registration and use of the disputed domain name by the Respondent has been done in bad faith. Upon perusing the evidence filed by the Complainant, the Tribunal further finds that the Respondent has created a website on the disputed domain name with the intention to mislead and confuse the people at large. A bare perusal of the Annexure H of the complaint shows that the website of the Respondent is created to misguide the public and trade and make them feel that the said website is an offshoot of the Complainants. The fact that the said website contains the trade mark of the Complainants along with the variation of horse logo prominently displayed on the website clearly shows the mala fide intentions of the Respondent. Further it is pertinent to mention that the said website also has a tab of "SantaFe Group" which is used for the Complainants business worldwide. All these acts of the Respondent indicate that the said domain name is registered and used in bad faith and only to mislead public at large and the Respondent has intentionally attempted to attract the public for commercial gain.

The Tribunal also finds that since the trade mark of the Complainants is registered worldwide and in India also from a very long time, it is not possible that the Respondent who purports to be in the same business would not have been aware of the Complainants and their business.

The Tribunal on the basis of the evidence placed before it, also finds that the Respondent is a person who habitually registers domain names incorporating the trade marks of other people without having any bona fide use or adoption.

Such above mentioned facts constitute bad faith under paragraph 6 of INDRP Policy and thus the respondent has registered and used the domain name in bad faith.

DECISION

In view of the above facts and circumstances, it is clear that the complainants have succeeded in their Complaint.

NIXI is hereby directed to transfer the domain name of the Respondent i.e., www.santafemoversandpackers.in to the Complainants. In the facts and circumstances of the



case no cost or penalty is imposed upon the Respondent. The award is accordingly passed on this day of 30.06.2017.



Sonal Kumar Singh

Arbitrator

30.06.2017