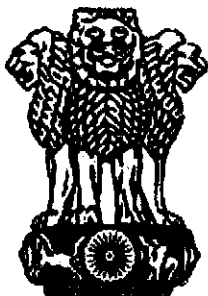


# INDIA NON JUDICIAL

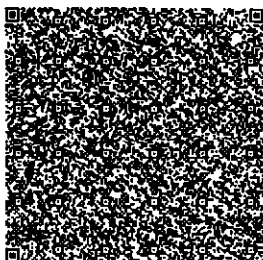


सत्यमेव जयते

## Government of National Capital Territory of Delhi

### e-Stamp

Certificate No. : IN-DL93523377191757L  
Certificate Issued Date : 21-Mar-2013 12:54 PM  
Account Reference : SHCIL (FI)/ dl-shcil/ HIGH COURT/ DL-DLH  
Unique Doc. Reference : SUBIN-DL DL-SHCIL86621536105315L  
Purchased by : A K SINGH ADVOCATE  
Description of Document : Article 12 Award  
Property Description : NA  
Consideration Price (Rs.) : 0  
(Zero)  
First Party : A K SINGH ADVOCATE  
Second Party : NA  
Stamp Duty Paid By : A K SINGH ADVOCATE  
Stamp Duty Amount(Rs.) : 100  
(One Hundred only)



Please write or type below this line.

### BEFORE THE SOLE ARBITRATOR UNDER THE .IN DISPUTE RESOLUTION POLICY

#### IN THE MATTER OF:

Shiseido Co., Ltd.  
5-5, Ginza 7-chome  
Chuo-ku, Tokyo 104-0061  
JAPAN

... Complainant

VERSUS

Ye Genrong  
Weihai Rd, 55, 1001 DK  
Shanghai 200050  
CN (CHINA)

... Respondent

### **The Parties**

The Complainant in this proceeding is Shiseido Co., Ltd., having its address at 5-5, Ginza 7-chome, Chuo-ku, Tokyo 104-0061, Japan. The Respondent in this proceeding is Ye Genrong, Weihai Rd, 55, 1001 DK, Shanghai 200050, CN (CHINA).

### **The Domain Name & Registrant**

The disputed domain name is www.shiseido.co.in registered by Ye Genrong having his address at Weihai Rd, 55, 1001 DK, Shanghai 200050, CN (CHINA).

### **Procedural History**

I was appointed as the Arbitrator by .IN Registry, to adjudicate upon the complaint of the Complainant, regarding the dispute over the domain name www.shiseido.co.in.

.In Registry has supplied the copy of the Complaint and Annexures to me.

On 09.02.2013, I sent an email to the parties informing them about my appointment as an Arbitrator.

In the abovementioned mail itself the Complainant was directed to supply the copy of the complaint with annexure to the Respondent and in case if they have already served it, then to provide me with the details of service record.

In accordance with INDRP read with INDRP Rules of Procedure, notice of arbitration was sent to the Respondent on 09.02.2013 with the instructions to file his say latest by 24.02.2013.

On 12.02.2013, I received an email from the Counsels/Representative of the Complainant, informing about the details of the service of the copy of Complaint to the Complainant. According to this mail copy of the complaint was duly sent to the email address as well as the postal address of the Respondent, proof of which was provided to the Tribunal.

On 15.02.2013, I received another email from the Counsels/Representative of the Complainant, where it was informed that the copy of the complaint could not be served upon the Respondent as the postal address mentioned as per the Whois record was incomplete and incorrect.

A handwritten signature in black ink, consisting of a large, stylized letter 'A' followed by the letters 'K S'.

The Respondent failed / neglected to file his say / reply to the Complaint of the Complainant within the stipulated time. Similarly he has not communicated anything on the Complaint till the date of this award and as such the proceedings were conducted.

I feel that enough opportunity has been given to the Respondent and genuine efforts have been made to make him a part of the proceedings. Since he has failed to join the proceedings, or to file any response the present exparte award is passed.

That I have perused the record and annexures / document.

### **Factual Background**

The following information is derived from the complaint and the supporting documents filed by the complainant before the Arbitrator:-

The Complainant has stated that the Complainant i.e. Shiseido Co., Ltd., is a company organized and existing under the laws of Japan, was incorporated on June 24, 1927 with the Tokyo Legal Affairs Bureau, Ministry of Justice, Government of Japan. The Complainant is the world's fourth largest cosmetic company which can be traced back to the year 1872, when Mr. Arinobu Fukuhara, a former chief pharmacist at a navy hospital, opened Japan's first western-style pharmacy with the name SHISEIDO in Tokyo's Ginza district. It was in the year 1915 when Mr. Shinzo Fukuhara, the third son of Mr. Fukuhara, who became the first president of Shiseido, changed direction and diversified into cosmetic industry and established the first testing laboratory in Tokyo in the following year. In the year 1927, the Complainant was formally incorporated as Company by changing from a limited partnership to a stock company.

It is also contended that the Complainant has established its footprint in cosmetic, healthcare, frontier science, food, education, welfare etc. and has led the Japanese cosmetic and culture for over 140 years. The Complainant has been expanding its business globally for more than 50 years and now sells its products in 87 countries and regions including Japan. At present, the Complainant has over 46,000 employees spread worldover. In India, the products of the Complainant were launched in the year 2001 and presently the Complainant has more than 31 shops/outlets throughout the country including Mumbai, Delhi and Chennai. Products of the Complainant have been, from time to time, exhibited/displayed/advertised in well-known





magazines enjoying circulation in India such as ELLE, VOGUE and promoted in shopping malls, supermarkets etc.

The Complainant has over the years, received numerous awards and recognition for its customer service, products, innovation and has gained significant market share owing to its strong sale success. The Complainant has been ranked 5<sup>th</sup> amongst world's top 100 beauty manufacturer by Women's Wear Daily (WWD) - a leading magazine for source of fashion news and analysis for industry leaders and the global fashion community for the year 2011.


It should be noted that SHISEIDO forms part of the corporate name of the Complainant/its subsidiaries and serves as its principal trade mark/name and domain name. With a view to protect the trade mark/name/domain name SHISEIDO, the Complainant has obtained registrations/filed applications for the same in numerous countries of the world including India.

Further, the Complainant/its affiliates have registered top level domain name (TLD) comprising the trade mark/name SHISEIDO such as shiseido.com, shiseido.info, shiseido.mobi etc. The Complainant has also obtained numerous country code top-level domain names (ccTLD) such as shiseido.ca, shiseido.sg, shiseido.hk, shiseido.jp, shiseido.us, shiseido.ph, shiseido.in etc.

The trade marks/name/domain name SHISEIDO/  represent important statutory and/or proprietary rights of the Complainant. The said marks/name are representative of Complainant/its products, brand identity, business reputation and public identification throughout the globe including India. Infact, as per the 2004 Report generated by the AIPPI Japan on 'Famous Trade Marks in Japan', Complainant's trade mark  has been identified as a famous/well-known trade marks. Needless to say, Complainant's said trade marks/name are extremely well-known throughout the world and Complainant considers the same as its valuable intellectual property and vigorously enforces against any act of infringement and passing off.

The websites of Complainant are very popular amongst the users and disseminate valuable information and are a source of knowledge of its business/products. The website [www.shiseido.com](http://www.shiseido.com) which allows discerning members of trade and public worldwide to contact and conduct business records significant number of hits every month. Therefore, it is



apparent that the goodwill and reputation of Complainant as regards the trade marks/name SHISEIDO/  pervades both the real world as well as cyber space.

India being an important market and with a view to increase its presence in the cyberspace, the Complainant attempted to register the domain name 'shiseido.co.in'. However, when the Complainant sought to register the domain name 'shiseido.co.in', it was shocked to learn that the said domain was already registered in the name of the former Registrant i.e. Jack Sun of SuperNames, Inc. As per the then WHOIS records, the domain 'shiseido.co.in' was registered by Jack Sun of SuperNames, Inc. i.e. former Registrant on August 25, 2010 and due to expire on August 25, 2012.

On July 26, 2012 the Complainant (through its Counsel) addressed a legal notice to Jack Sun calling upon him to, *inter alia*, transfer the domain name 'shiseido.co.in' in its favour. Absent receipt of any response from 'Jack Sun' a reminder thereto was addressed on August 13, 2012. Upon receipt of legal notice, former Registrant made few changes in the particulars so much so that the name of the organization was reflected as 'Domainjet, Inc.'. Thereafter, the said domain was renewed and transferred in the name of the current Registrant i.e. Ye Genrong.

#### **Parties Contentions**

a) Complainant

The complainant contends as follows:

1. The respondent's domain name is deceptively similar to the trademark of the complainant.
2. The respondent has no rights and legitimate interest in respect of the registered domain name.
3. The respondent has registered and is using his domain name in bad faith.

a) Respondent

The Respondent has failed to file any reply or make any submissions to defend his case despite having adequate knowledge of the institution of the proceedings.

#### **Discussions and Findings:**

As mentioned above, the respondent has failed to file any reply to the complaint and has not rebutted any of the submissions or the evidence filed by the complainant.



Rule 8 (b) of the INDRP Rules of Procedure provides 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"*.

As highlighted above ample opportunities have been given to the respondent to file a reply but no response has been received till date. Therefore, the proceedings have been initiated ex-parte and conducted in the absence of the complainant.

Rule 12 (a) of the INDRP Rules of Procedure provided 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 there under or any law that the arbitrator deems to be applicable"*.

In these circumstances, the decision of the arbitrator is based upon the complainant's assertions, and evidence and inference is drawn from the respondent's failure to file a reply.

Having perused the submissions and documentary evidence placed on record, the complainant has proved that it has statutory and common law rights in the trademark "SHISEIDO".



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

- i) the registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the complainant has rights;
  - ii) the registrant has no rights or legitimate interests in respect of the domain name; and
  - iii) the registrant's domain name has been registered or is being used in bad faith.
- i) The domain name [www.shiseido.co.in](http://www.shiseido.co.in) is identical to, or is deceptively similar to the name, trademark or service mark in which the complainant has rights.**


The complainant has stated in its complaint that the domain name [www.shiseido.co.in](http://www.shiseido.co.in) registered in the name of the respondent is confusingly similar and identical to their name/trademark SHISEIDO. Therefore, registration of the impugned domain name is




violative of the statutory rights vested in Complainant's registered trademarks and is tantamount to infringement.

The Complainant has also stated in its complaint that the Registrant's impugned domain name 'shiseido.co.in' comprises the Complainant's trademarks/name SHISEIDO/ which is proprietary to it. It is submitted that the Registrant has registered the impugned domain name 'shiseido.co.in' with an intention to trade upon the immense goodwill and reputation enjoyed by the Complainant in its famous trade marks/name/domain name SHISEIDO/ and thereby gain undue mileage out of it. This is a clear case of passing off which is violative of the rights enjoyed by the Complainant in its famous trademarks/name/domain name.

It is further stated that the complainant is the registered proprietor of the "SHISEIDO" trademark in numerous countries of the world including India and has gained significant reputation thus its mark can be termed as a well known trademark/brand.

The complainant is also the registered proprietor of similar domain name registrations around the world. A list of worldwide registrations obtained in respect of the trade marks/label SHISEIDO/ has been provided by the Complainant. The Complainant has also attached copies of few certificates of registrations/online printouts in respect of the said trade marks from a few jurisdictions such as Canada, Japan, WIPO, USA, UK etc.

The Complainant has further submitted that the Complainant's adoption of the trade marks/name/domain names in respect of SHISEIDO is much prior to the Registrant's registration of the impugned domain name 'shiseido.co.in' as the Registrant registered the impugned domain name on October 15, 2012 whereas the Complainant's domain 'shiseido.com' was created on August 6, 1995. Further, in India, the earliest registration for the trade mark  was obtained on March 14, 1972 with first use claimed since the year 1925 by Complainant.

The above submission of the Complainant has not been rebutted by Respondent, as such it is deemed to have been admitted by them.



Even otherwise the above facts and attached annexure(s) establish that the disputed domain name registered in the name of the respondent is identical and confusingly similar to the trademark of the complainant.


**ii) The respondent(s) have no right or legitimate interest in the domain name [www.shiseido.co.in](http://www.shiseido.co.in).**

According to the paragraph seven (7) of the .IN Dispute Resolution Policy, the following circumstances show the registrants rights or legitimate interest in the domain name for the purpose of paragraph four (4) sub clause (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.*

The Complainant has submitted in its complaint the following:-

That the Registrant does not offer any goods/services under the domain name 'shiseido.co.in' as it is not operating any active website under the impugned domain 'shiseido.co.in' and the weblinks listed on the website pertain to third party websites as well as entities.

It is also contended by the Complainant that the Registrant is not commonly known by the disputed domain name. The Complainant, a leading cosmetic company in the world, has been in operation for over 140 years and its products can be found in 89 countries worldover. Due to the extensive and continuous use of the trade marks/name SHISEIDO/  for almost a century and half in relation to its products, the same has become well-known and is associated with the Complainant/its businesses and none else. Hence, the Registrant cannot claim to have been commonly known by the domain name for any reason/s whatsoever.

The complainant further submits that the Registrant is not making any legitimate, non-commercial or fair use of the domain name. The mere listing of weblinks pertaining to third





party websites and parking of the impugned domain name on 'Sedo' cannot come under the definition of '*bona fide use*'.

Therefore, by no stretch of imagination, the Registrant can demonstrate any use relating to *bona fide* offering of goods or services before any notice of this dispute or at any point in time whatsoever.

The above submission of the complainant has not been rebutted by the respondent, and as such they are deemed to have been admitted by him. The above facts and annexure(s) further establish that the respondent has no legal right or legitimate interest in the disputed domain name under INDRP paragraph four (4) sub clause (ii).

**iii) The registered domain name is being used in bad faith by the respondent(s).**

The Complainant has contended that the Registrant has registered the impugned domain name 'shiseido.co.in' with the sole purpose of selling the same for excessive consideration. The said objective is evident from the fact that the impugned domain name was parked at 'Sedo, a well-known website for selling domain names and advertisement of sale of said domain on the website 'www.shiseido.co.in'.

To add to it, till date the Registrant has not developed any active website in respect of the said domain and has only listed weblinks pertaining to third party websites/entities including Complainant's competitors.

The complainant alleges that the respondent has full knowledge of the SHISEIDO brand and has registered the domain name www.shiseido.co.in with the sole intention to create confusion among the buyers and malign the complainant's reputation by directing various bona fide users to its portal and making them believe that there is a relation between the complainant's and the respondents in India.

The Tribunal is of the view that the respondent has neither responded nor has put forth or provided any evidence to show that the respondent is engaged in or demonstrably prepared to engage in offering any bona fide service or supply such goods in the name "SHISEIDO" which is the subject matter of the dispute.



The above submission of the Complainant has not been rebutted by respondent, as such they are deemed to be admitted by him. Even otherwise, the above facts and annexure(s) establish that the respondent has registered the disputed domain name in bad faith.

#### **DECISION**

In view of the above facts and circumstances, it is clear that the Complainant has succeeded in its complaint.

.IN Registry of the NIXI is hereby directed to transfer the domain name of the Respondent i.e. "www.shiseido.co.in" to the Complainant. In the facts and circumstances of the case no cost or penalty is imposed upon the Respondent. The Award is accordingly passed on this 21<sup>st</sup> day of March, 2013.



**A.K. Singh**

**Sole Arbitrator**

**Date: 21<sup>st</sup> March, 2013**