



हरियाणा HARYANA

M 682655

**BEFORE THE NATIONAL INTERNET EXCHANGE OF
INDIA**

ARBITRATION AWARD

In The Matter Between

**Starcir Clips Engineering Ltd.
B-24 Hingna Road
Nagpur
Maharashtra - 440016
India**

Complainant

Versus.

Hanvi Narayana

1. Shika S Shukla
IIS (Registrant Organization)
B-23 Office No. 2 Opp Shubham Party Hall
Mira Road
Mumbai – 401107

Respondents

2. Rainbow Mechanical Engineering Pvt. Ltd.
Plot No. 120/2, Near Vidhya Vikasini High School
Gokhiware Village, Father Wadi
Vasai E), Dist. Thane 401 208
Mumbai, India

1. The Parties

The Complainant is Star Circlips & Engineering Limited, Nagpur, India represented in these proceedings by Khaitan & Co. The Respondents are Shika S Shukla, IIS, (Registrant Organization) Mumbai and Rainbow Mechanical Engineering of Mumbai.

2. The Domain name, Registrar and Policy

The present Arbitration proceeding pertains to a dispute regarding the domain name <starcirclips.in> (hereinafter referred to as disputed domain name). The registrar for the disputed domain name is IN Registrar d.b.a inregistrar.com (R123-AFIN). The Arbitration proceeding is conducted in accordance with the Arbitration and Conciliation Act of 1996 (India), the .IN Domain Name Dispute Resolution Policy (the “INDRP Policy” or “Policy”), and the INDRP Rules of Procedure (the “Rules”).

Haini Narayana

3. Procedural History

The sole arbitrator appointed in the case is Mrs. Harini Narayanswamy. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, in compliance with the Rules. The Arbitrator received the Complaint from the .IN registry on January 7, 2014 and on January 10, 2014 transmitted by email a notification of commencement of the arbitration proceedings to the Respondent. Under the INDRP Rules, copies of the said notification were sent to other interested parties to the dispute. The Respondent was given twenty-one days time from the date of the notification to file a response.

Factual Background

The Complainant is a manufacturer of automotive parts such as circlips, retaining rings, shims, washers and formed components and several other products supplied to automobile industry.

The Complainant's registered and pending trademarks are:

S.No	Trademark	Trademark No and Date	Class & Goods / Services	Status
1.	STAR CIRCLIPS (Device)	1483371 1 September 2006	6 Goods of common	Registered

Harini Narayanswamy

			metals	
2.	STAR CIRCLIPS	2634650 28,November 2013	6 Goods of common metals	Pending
3.	STAR CIRCLIPS	2634651 28,November 2013	1 Coupling and transmission components	Pending

The Parties Contentions

A. Complainant's Submissions

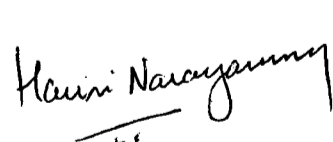
The Complainant states its trademark has international reputation as it exports its products to several countries. The Complainant contends it owns the domain names such as <starcirclips.com> and <starcirclips.net>. Its products are sold internationally and it has worldwide reputation and goodwill in the mark that is exclusively associated with Complainant. The Complainant states it adopted the mark in 1989 and has sold its products under the mark in India and several countries of the world since the last several years. As evidence the Complainant has filed a statement of its sales turnover certified by a chartered accountant showing its sales turnover since 1995. The Complainant further states that the promotional expenditure for the STAR CIRCLIPS trademark is Rupees four hundred thousand for the period 2011 – 2013.

Havir Narayannan

The disputed domain name is based on Complainant's well-known trademark STAR CIRCLIPS and the Complainant argues it is Confusingly similar to its mark in which it has statutory and common law rights and it is a prior adopter and user of the mark. The disputed domain name incorporates the Complainant's well-known mark STAR CIRCLIPS in its entirety and renders it identical / confusingly similar to the STAR CIRCLIPS mark, particularly as the Respondent is in same business as that of the Complainant. The ccTLD ".in" can be disregarded in assessing similarity of the domain name to the trademark argues the Complainant.

The Complainant further argues that the Respondent has no rights or legitimate interest in the disputed domain name as the Respondent is not commonly known by the disputed domain name. The name of the Respondent in the records is shown as Shika. S Shukla further the domain name resolves to the Website of the organization named as Rainbow Mechanical Engineering Private Limited, which is in no way related to the disputed domain name. The Complainant states that it has not authorized or licensed the use of its trademark by the Respondent. As the disputed domain name consists of the trademark in its entirety, the Complainant argues that the Respondent cannot conceivably have any legitimate right or interests in the disputed domain name.

The Complainant states that the disputed domain name has been registered and used in bad faith as the Complainant has rights and Respondent has ulterior motives in using the mark with its goodwill for creating a likelihood of confusion with its mark. The products bearing the STAR CIR CLIPS

 5

mark have come to be associated with the Complainant and its products. Further more the website linked to the disputed domain name clearly shows the disputed domain name is used in connection with a competing business to that of the Complainant's business. The registration and the use of the disputed domain name in this manner amounts to infringement of its registered trademark, passing off, misrepresentation to the public and breach of service agreement with the Registrar. The Complainant therefore requests for the transfer of the disputed domain name.

Discussion and Findings

Under the INDRP Policy, the registrant of the domain name is required to submit to a mandatory arbitration proceeding in the event that a complaint is filed in the .IN Registry alleging that there has been a violation of Complainant's rights. Paragraph 4 of the INDRP Policy mandates that the Complainant has to establish the following three elements to succeed in the proceedings:

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

Haini Narayann

Identical or Confusingly Similar

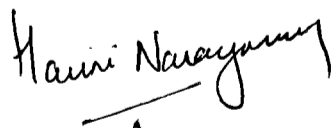
The first element requires the Complainant to prove that the domain name registered by the Respondent is identical or confusingly similar to a mark in which the Complainant has rights.

The Complainant has submitted sufficient evidence to show that it has rights in the STAR CIRCLIPS trademark. The Arbitrator finds, based on the evidence on record, the Complainant has established its rights in the trademark STAR CIRCLIPS.

The Arbitrator concurs with the Complainant's submission that the disputed domain name consists of the STAR CIRCLIPS trademark in its entirety with country code Top Level domain (ccTLD) ".IN". Accordingly, for the reasons discussed, the Arbitrator finds that the disputed domain name is almost identical and confusingly similar to a mark in which the Complainant has rights. The Complainant has satisfied the first element under paragraph 4 of the Policy.

Rights and Legitimate Interests

The second element requires the Complainant to show that the Respondent lacks rights and legitimate interests in the disputed domain name. It is sufficient for the Complainant to put forward a *prima facie* case regarding the Respondent's lack of rights and legitimate interests.



The burden of proving rights or legitimate interests in the disputed domain name rests with the Respondent. Paragraph 7 of the Policy, provides a non-exhaustive set of circumstances that a respondent could rely on to establish rights in the domain name. These briefly are: (i) if before notice of the dispute, the respondent had used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services or (ii) the respondent (as an individual, business organization) has been commonly known by the domain name, or (iii) The respondent is making legitimate, non commercial or fair use of the domain name without intent for commercial gain.

The Complainant has submitted that the Respondent has no rights or legitimate interests in the disputed domain name as the Complainant has not licensed or otherwise permitted the Respondent to use its mark. Further, given the Complainant's rights the STAR CIRCLIPS mark and the fact that the Respondent has offered the disputed domain name for sale, the Complainant states that the Respondent has registered the domain name for purpose of exploiting the mark and therefore has no legitimate rights to the disputed domain name.

The Arbitrator finds that there is no evidence on record to show that the Respondent has made preparations to use the disputed domain name for a *bona fide* offering of goods or services or that the Respondent has been commonly known by the disputed domain name or makes any legitimate non-commercial fair use of the disputed domain name. The Arbitrator has provided the Respondent the opportunity to file evidence of his rights in the disputed domain name. The Respondent has however failed to file any

Haini Narayan

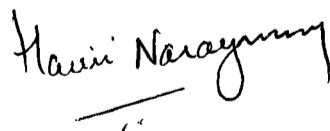
material in these proceedings that demonstrates rights in the disputed domain name. In the absence of any material from the Respondent, and other material on record to indicate the Respondent has rights, it is found that the Respondent has not established any rights or legitimate interests in the disputed domain name.

Accordingly, for the reasons discussed, the Arbitrator finds the Complainant has made a *prima facie* case that the Respondent lacks rights and legitimate interests in the disputed domain name and has satisfied the second element under paragraph 4 of the Policy.

Bad Faith

Under the INDRP Policy the Complainant is required to establish that the domain name was registered or is being used in bad faith. The Complainant has urged that the Respondent has intentionally registered the disputed domain name to exploit its trademark STAR CIRCLIPS.

As discussed earlier it is found that the Complainant has adopted and used the mark STAR CIRCLIPS extensively and has registered marks that bear testimony to this fact. Under Paragraph 6 (iii) of the Policy, if the registrant of the domain name in dispute, has used the domain name to intentionally attract Internet users to the Registrant's website or other online location by creating a likelihood of confusion with the trademark of another, it is considered evidence of bad faith. The Arbitrator finds the circumstances here suggest that the Respondent seeks to use the Complainant's mark in the manner mentioned under Paragraph 6 of the Policy, namely to attract

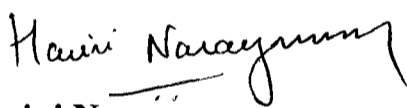

Havin Narayana

Internet traffic to the Respondent's website, or mislead Internet users to the disputed domain name which is considered bad faith registration and use of the disputed domain name under the INDRP Policy.

Based on all the facts and circumstances of the case the Arbitrator finds that the disputed domain name was registered in bad faith and has been used in bad faith. The Arbitrator finds the Complainant has satisfied the third element under paragraph 4 of the Policy.

Decision

For the reasons discussed, it is ordered that the disputed domain name <starcirclips.in> be transferred to the Complainant.



Harini Narayanswamy

(Arbitrator)

Date: March 16, 2014