

BN 973594

P.S. SHANMUGA SUNDARAM
STAMP VENDOR
L.No. B4 / 109 / 88
HIGH COURT CAMPUS
CHENNAI - 600 104. (TAMIL NA)

**BEFORE THE SOLE ARBITRATOR MR.D.SARAVANAN
.IN REGISTRY
(C/o. NATIONAL INTERNET EXCHANGE OF INDIA)**

Disputed Domain Name: www.sunbrella.in

Glen Raven, Inc.
1831 North Park Avenue, Glen Raven, North Carolina
27217, United States of America
Phone: +91.11.2656.2545
Fax: +91.11.2656.2546
Email: ip.domains@algindia.com

.. Complainant

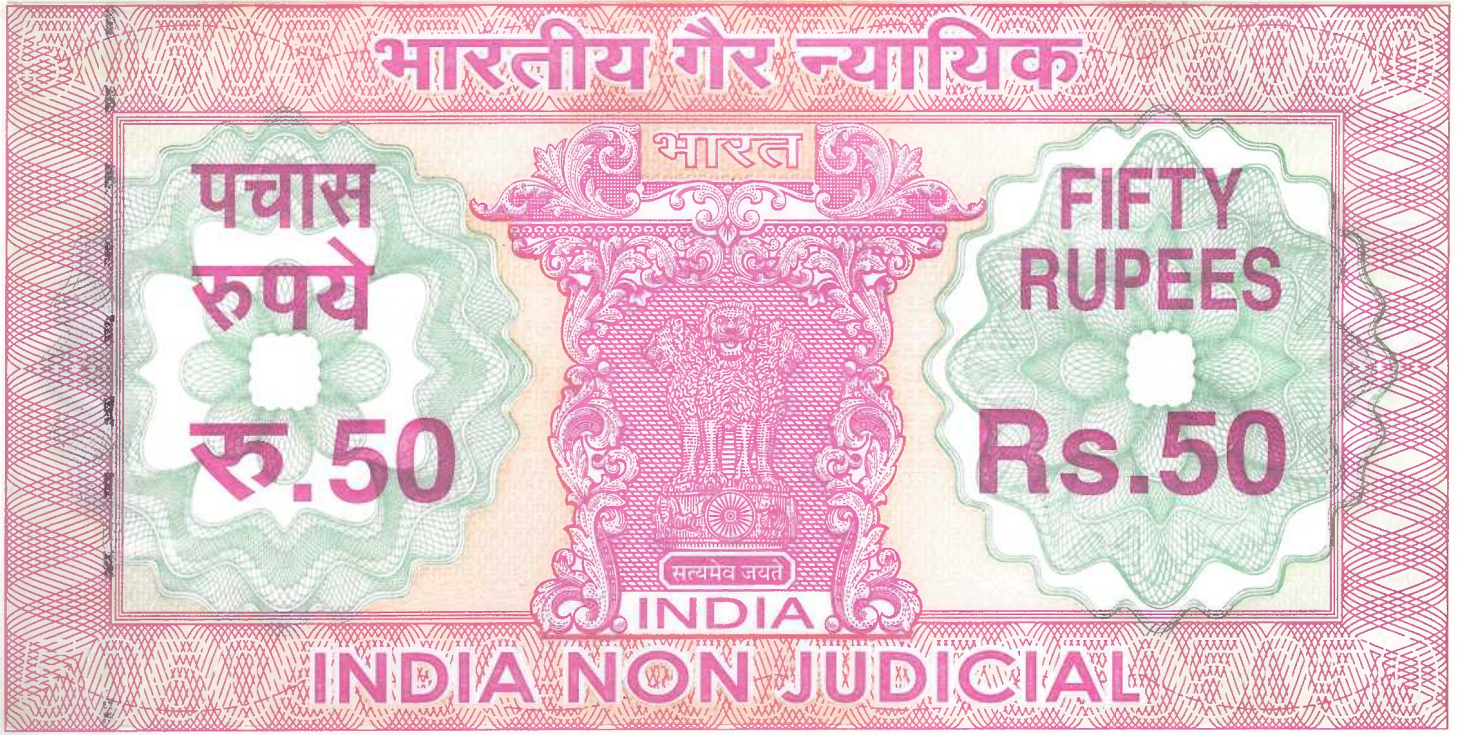
Vs.

DingDing
Dingcorp,
Tongluo, Huanghou
HongKong
Phone: +852.99675563
Email: domainbiz@hotmail.com

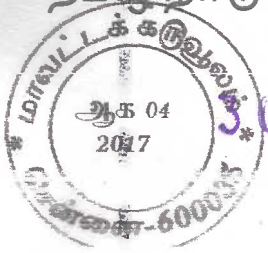
.. Respondent

..2





தமிழ்நாடு தமிழ்நாடு TAMILNADU



19008
APR 2018

AV 965309

P.S. SHANMUGASUNDARAM
STAMP VENDOR
L.No. B-1/109/88
HIGH COURT CAMPUS
CHENNAI - 600 104. (TAMIL NADU)

-2-

1. The Parties:

The Complainant is Glen Raven, Inc., a corporation organized under the laws of the state of North Carolina, whose address is 1831 North Park Avenue, Glen Raven, North Carolina 27217, United States of America (including its predecessor-in-interest, franchisees, licensees and affiliates). The Complainant is represented by ALG India Law Offices LLP. Copy of notarized Power of Attorney from the Complainant is provided as **Annexure-2**.

The Respondent is the current Registrant of the disputed domain name <sunbrella.in>. All the information known and available to the Complainant regarding the Respondent is as follows: DingDing, Dingcorp, Tongluo, Huanghou HongKong, Phone: +852.99675563, Email: domainbiz@hotmail.com. Neither the Respondent represented himself nor represented by any one.

..3.



2. The Domain Name and Registrar:

The disputed domain name is www.sunbrella.in. The domain name has been registered with .IN REGISTRY through its Registrar Netlynx Technologies Pvt. Ltd.

3. Procedural History:

| | | |
|----------------------------|---|--|
| 8 th May, 2018 | : | The .IN REGISTRY appointed D.SARAVANAN as Sole Arbitrator from its panel as per paragraph 5(b) of INDRP Rules of Procedure. |
| 8 th May, 2018 | : | Consent of the Arbitrator along with declaration was given to the .IN REGISTRY according to the INDRP Rules of Procedure. |
| 11 th May, 2018 | | .IN REGISTRY sent an email to all the concerned intimating the appointment of arbitrator. On the same day, the complete set of the soft copy of the Complaint with Annexure was sent to the Respondent by email while sending the hard copy of the same to the address of the Respondent by NIXI through post which was later reported to be undelivered due to wrong delivery address and wrong contact number of respondent. |
| 14 th May, 2018 | : | Notice was sent to the Respondent by e-mail directing him to file his response within 10 days, marking a copy of the same to the Complainant's representative and .IN Registry. |
| 24 th May, 2018 | : | Due date for filing response. |
| 29 th May, 2018 | : | Notice of default was sent to the Respondent notifying his failure in filing the response, a copy of which was marked to the Complainant's representative and .IN Registry. |



4. Factual Background:

4.1 The Complainant:

The Complainant is Glen Raven, Inc., a corporation organized under the laws of the State of North Carolina, whose address is 1831 North Park Avenue, Glen Raven, North Carolina 27217, United States of America (including its predecessor-in-interest, franchisees, licensees and affiliates). The Complainant is represented by ALG India Law Offices LLP. Copy of notarized Power of Attorney from the Complainant is provided as **Annexure-2**.

4.2 Complainant's Activities:

(i) The Complainant submits that it is a leading manufacturer of fabrics sold in the piece for use in a diverse array of applications, including, without limitation, shade applications, including beach, market and garden umbrellas, awnings, canopies, shade sails, screens, cabanas and tents. The Complainant adopted and commenced use of its flagship trademark SUNBRELLA at least as early as 1959 to identify a line of performance fabrics for many of its aforementioned products. The Complainant's SUNBRELLA branded fabrics as well as products made from SUNBRELLA branded fabrics are sold worldwide, including in India. The Complainant's textiles are made with close attention to design detail, and engineered with robust performance characteristics that provide resistance to fading and degradation from sunlight and chemical exposure. The fabric is tactile yet durable, has industry-leading environmental characteristics, is easy to care for and offers long life wherever it's used. Prints of web pages from the Complainant's website are annexed collectively as **Annexure-6**. Fabrics under the SUNBRELLA Mark have become widely adopted for shade structures, marine canvas and upholstery fabric for both outdoor and indoor applications. The Complainant's SUNBRELLA Mark and fabrics under the SUNBRELLA Mark are closely associated with such finished products as umbrellas in the minds of the public and consumers frequently base purchasing decisions on whether such goods are made using SUNBRELLA brand fabrics. The Complainant routinely supplies pass-through hang tags, labels and other materials



bearing the SUNBRELLA Mark to its manufacturing customers to affix to their articles of finished merchandise containing SUNBRELLA fabric. The Complainant maintains a prominent internet presence through its principal website www.sunbrella.com, which receives thousands of visitors annually looking for information about SUNBRELLA fabric. Prints of a publicly available report from a third-party commercial web traffic data and analytics provider is annexed as **Annexure-7**. The Complainant states that it not only owns several domain names incorporating the trademark SUNBRELLA, but also has a successful record of enforcing its SUNBRELLA Mark through numerous domain name complaints wherein the Complainant has obtained favourable decisions ordering the transfer of the infringing domain names in its favour. The dispute resolution panels have time and again acknowledged the Complainant's rights in the trademark SUNBRELLA and have consistently found disputed domain names incorporating the trademark SUNBRELLA to be identical/deceptively and confusingly similar to the Complainant's trademark SUNBRELLA. Further, the panels have opined that addition of generic terms and/or .ca, .com suffixes are to be ignored in judging similarity of marks. Some of the Complainant's successful domain name disputes include *Glen Raven, Inc. v. Joe Cruzio*, FA1609001696106 Nat Arb. Forum wherein the panel transferred the domain name <sunbrellafabricstore.com> in favour of the Complainant; *Glen Raven Inc. v. Tomislav Kotarac*, CIRA Dispute No. 00173, wherein the panel transferred the domain name <sunbrella.ca> in favour of the Complainant; *Glen Raven, Inc. v. Chuck / Media*, FA1404001552016 Nat Arb. Forum, wherein the panel transferred the domain name <sunbrellas.org> in favour of the Complainant, etc. Copies of the aforementioned decisions are annexed as **Annexure-8**. Some other select domain names registered by or transferred to the Complainant are as follows:

<sunbrella.com>

<sunbrella.mobi>

<sunbrella.xyz>

<sunbella.com>

<sunbrellaumbrellas.com>

<sunbrelladrapes.com>

<sunbrellacushions.com>

<sunbrellapillows.com>, <sumbrella.com>





(ii) WhoIs reports of the above-listed domain names are annexed by the Complainant as **Annexure-9**. The Complainant extensively advertises and promotes its SUNBRELLA brand fabrics in major newspapers, magazines, trade journals and via the Internet as well as distributes promotional brochures, pamphlets, promotional videos and podcasts and point of purchase materials. The search results generated by conducting a search for "SUNBRELLA" on prominent third-party online search engines (such as Google, Yahoo! and Bing) over the first few pages mostly pertain to the Complainant, evidencing that the trademark is prominently and exclusively associated with the Complainant. In fact, the Complainant's SUNBRELLA brand fabrics also receive considerable gratuitous publicity and awards. The Complainant's trademark SUNBRELLA is also actively promoted through social media networking platforms such as Facebook, YouTube, Twitter, Pinterest and Instagram. Prints of the first two pages of search results for SUNBRELLA generated on Google, Yahoo! and Bing and web pages from social networking platforms like Facebook, YouTube, Twitter, Pinterest and Instagram are collectively annexed as **Annexure-10**.



Copies of the registration certificates/status pages of the aforementioned registrations are collectively annexed as **Annexure-5**.

4.3 Complainant's Trading Name:



(i) The Complainant states that it is the owner of the trademark SUNBRELLA and various marks incorporating SUNBRELLA such as SUNBRELLAS, SUNBRELLA

"PLUS", SUNBRELLA FIRESIST,   etc. (hereinafter collectively referred to as "SUNBRELLA Mark") for which it owns trademark registrations and applications in a number of countries worldwide. A list of the Complainant's select trademark registrations for the SUNBRELLA Mark in select jurisdictions as submitted by the Complainant is as follows:




| S. No | Mark | Application/ Registration No. | Class (es) | Specifications | Date of filing |
|---------------------------------|---|-------------------------------|------------|---|--------------------|
| INDIA | | | | | |
| 1. |  | 1751519 | 24 | 24: Fabrics sold in the piece for use in producing awnings, sun and windscreens, tents, canopies, boat covers and tops, indoor and outdoor furniture, beach umbrellas, area rugs, draperies, sheers, window treatments. | November 6, 2008 |
| 2. |  | 953890 | 24 | 24: Fabrics sold in the piece for making awnings draperies, sun and wind screens, tents, canopies, boat covers and tops, indoor and outdoor furniture, and beach umbrellas, falling in class 24. | September 06, 2000 |
| UNITED STATES OF AMERICA | | | | | |
| 3. | SUNBRELLA | 0709110 | 24 | 24: Fabrics for awnings, furniture, handbags, and sports wear | May 3, 1960 |
| 4. | SUNBRELLA | 1815959 | 25 | 25: Outerwear; namely, dusters and jackets | April 30, 1992 |
| 5. | SUNBRELLAS | 2028355 | 03 | 03: Sunscreen lotions for the skin | July 21, 1995 |
| 6. | SUNBRELLA "PLUS" | 2966133 | 24 | 24: Fabrics sold in the piece for use in producing awnings, sun and windscreens, tents, canopies, boat covers and tops, indoor | June 9, 2004 |





| | | | | | |
|-----------------------|---|-----------|------------|--|-----------------|
| | | | | and outdoor furniture and beach umbrellas | |
| 7. |  sunbrella | 3652524 | 24 | 24: Fabrics sold in the piece for use in producing awnings, sun and windscreens, tents, canopies, boat covers and tops, indoor and outdoor furniture, beach umbrellas, area rugs, draperies, sheers, window treatments | August 26, 2008 |
| 8. |  sunbrella | 3731230 | 24 | 24: Fabrics sold in the piece for use in producing awnings, sun and windscreens, tents, canopies, boat covers and tops, indoor and outdoor furniture, beach umbrellas, area rugs, draperies, sheers, window treatments | June 2, 2009 |
| EUROPEAN UNION | | | | | |
| 9. | SUNBRELLA | 000131730 | 23, 24, 25 | 23: Yarns and treads, for textile use. 24: Textiles and textile goods, not included in other classes; bed and table covers. 25: Clothing, footwear, headgear. | April 1, 1996 |



| | | | | | |
|-----------------------|---|--------------------|------------------------|---|----------------------|
| 10. |  sunbrella | 008128936 | 23, 24, 25 | 23: Yarns and treads, for textile use. 24: Textiles and textile goods, not included in other classes; bed and table covers. 25: Clothing, footwear, headgear. | February 27, 2009 |
| CANADA | | | | | |
| 11. | SUNBRELLA | TMA184106 | 18,20, 22,24, 25 | Fabrics for upholstery, wearing apparel, tents and awnings. Fabrics for awnings, furniture, handbags and sportswear. | July 05, 1971 |
| 12. | SUNBRELLA FIRESIST | TMA377354 | 24 | Fabrics sold in a piece, for use in connection with awnings, canopies, boat tops, boat covers, indoor and outdoor furniture, clothing, draperies, curtains and upholstery. | November 14, 1989 |
| UNITED KINGDOM | | | | | |
| 13. | SUNBRELLA | UK0000143 2 541 | 24 | 24: Textile piece goods, all included in Class 24. | June 19, 1990 |
| 14. | SUNBRELLA FIRESIST | UK0000130 8 960 | 24 | 24: Fabrics in the piece having fire- resistant properties, all included in Class 24. | May 2, 1987 |
| MEXICO | | | | | |



| | | | | | |
|-----|---|---------|----|---|-------------------|
| 15. |  | 1094585 | 24 | 24: Fabrics sold in pieces for use in the production of awnings, screens for the sun and against the wind, shops, pavilions, covers for boats and covers for indoor and outdoor furniture, beach umbrellas, rugs for the area, of tapestries, curtains, and window coverings. | February 12, 2009 |
| 16. | SUNBRELLA FIRESIST | 401961 | 24 | 24: Fabrics for awnings for furniture, for handbags and for - clothes and in general textiles and textile products not included in other classes bed and table linen. | March 26, 1991 |
| 17. |  | 413532 | 24 | 24: Fabrics for awnings, for furniture, for handbags, and for clothing and in general textiles and textile products not included in other classes; bedding and table. | March 26, 1991 |
| 18. | SUNBRELLA | 387940 | 24 | 24: Fabrics for awnings, for furniture, for handbags and clothes. | August 10, 1990 |

Copies of the registration certificates/ status pages of the aforementioned registrations are collectively annexed as **Annexure-5**.



4.4 Respondent's Identity and activities:

The Respondent is the current Registrant of the disputed domain name <sunbrella.in>. All the information known and available to the Complainant regarding how to contact the Respondent is as follows: DingDing, Dingcorp, Tongluo, Huanghou HongKong, Phone: +852.99675563, Email: domainbiz@hotmail.com. A copy of the printout of the Whois report dated April 23, 2018, as available on <https://registry.in/whois/sunbrella.in> is annexed as **Annexure-3**. The disputed domain name was registered by the Respondent on August 22, 2014. According to the Whois Search Utility of .IN Registrar (<https://registry.in/whois/sunbrella.in>), the Registrar of the disputed domain name <sunbrella.in>, with whom the disputed domain name <sunbrella.in> is registered is: Netlynx Technologies Pvt. Ltd. The Registrar features in the list of Accredited Registrars on the .IN Registry database hosted at https://registry.in/Accredited_Registrars. The address of the Registrar as per its website hosted at <http://www.netlynx.com/contact.php> is as follows: Netlynx Technologies Pvt. Ltd., 103, Tirupati Udyog Premises, I. B. Patel Road, Off. Western Express Highway, Near HP Petrol Pump, Goregaon East, Mumbai – 400063, abuse@netlynx.com, support@netlynx.com. Copy of the webpage hosted at .IN Registry and the webpage of the Registrar are collectively annexed as **Annexure-4**.

5. Dispute

The dispute arose when the Complainant came to know about the disputed domain name in the name of the Respondent. The Complainant had also never authorized the Respondent to use the disputed domain name. In these circumstances, the Complainant requested this Tribunal to transfer the disputed domain name in favour of the Complainant.

6. Parties contentions:

A. Complainant:

(i) The domain name www.sunbrella.in is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights [Para 3(b)(vi)(1) INDRP Rules of Procedure to be read with para 3 of INDRP] :



The Complainant states that the Complainant's rights in the SUNBRELLA Mark have been established as stated above. In *Perfetti Van Melle Benelux BV v. Lopuhin Ivan, IPHOUSTER* (WIPO Case No. D2010-0858) and *Inter-Continental Hotels Cooperation v. Abdul Hameed* (NIXI Case No. INDRP/278, February 10, 2012) it was held that trademark registration constitutes *prima facie* evidence of the validity of trademark rights. Copies of the decisions are annexed as **Annexure-11**. The disputed domain name <sunbrella.in> is identical to the Complainant's trademark SUNBRELLA, which is incorporated fully, as is, with the ccTLD '.in'. In *Williams Sonoma, Inc. v. Liheng* (NIXI Case No. INDRP/910, September 26, 2017), while transferring the domain name <westelm.in> the panel held that '*This panel comes to a conclusion that when a domain name contains a trademark in its entirety, the domain name is identical or atleast confusingly similar to the trademark*'. Copy of the award passed in the above referenced case is annexed as **Annexure-12**. Further, in *The Forward Association, Inc. vs Enterprises Unlimited*, (FA0008000095491 Nat. Arb. Forum October 3, 2000) the panel held that '*[w]hen a trademark is composed in the whole or in part of a domain name, neither the beginning of the URL(http://www.), nor the TLD (.com) have any source indicating significance*'. A copy of the decision is annexed as **Annexure-13**. It is submitted that the ccTLD element of a domain name has no distinguishing capability and should be disregarded while considering whether a domain name is identical or confusingly similar to a trademark. Therefore, disregarding the ccTLD ".in", the disputed domain name <sunbrella.in> is identical to the Complainant's mark SUNBRELLA. In *Kingston Technology Co., vs Web Master Skype Network Limited* (NIXI Case No. INDRP/033, June 11, 2007), while transferring the domain name <kingston.co.in> the panel held that '*The Respondent's domain name, www.kingston.co.in, consists of entirely Complainant's trademark, except for .co and .in i.e., ccTLD. Thus, this Arbitral Tribunal comes to an irresistible conclusion that the disputed domain name... is confusingly similar or identical to the Complainant's marks*'. A copy of the decision is annexed as **Annexure-14**. Further in *Slickdeals LLC V Srujan Kumar* (NIXI Case No. INDRP/907, September 12, 2017), while transferring the domain name <slickdeals.in> the panel held that '*it is also well-established that the extensions in a disputed domain name does not affect a finding of similarity*'. A copy of the decision is annexed as



Annexure-15. It is therefore to be concluded that the Complainant has rights in the SUNBRELLA Mark and that the disputed domain name <sunbrella.in> is identical to the Complainant's mark.

(ii) The Respondent has no rights or legitimate interest in the domain name www.sunbrella.in [Para 3(b)(vi)(2) INDRP Rules of Procedure to be read with Para 7 of .INDRP] :

The Complainant states that the Respondent has no rights or legitimate interest in either the trademark SUNBRELLA or in the disputed domain name <sunbrella.in>. The Complainant has never authorized or licensed the Respondent to use the SUNBRELLA Mark in any way or for any purpose. The Respondent does not have any association or affiliation with the Complainant and neither the Complainant has any past dealing with the Respondent. The Respondent is not commonly known by the disputed domain name and, to the knowledge of the Complainant, has not acquired any trademark rights in the SUNBRELLA Mark. The Respondent therefore has no reason to adopt or register the domain name <sunbrella.in>. The mark SUNBRELLA is significantly unique and is used by the Complainant as a trade mark in relation to its fabrics and products thereof. The Respondent cannot contend that it is known by or trades under the uncommon and distinctive name - SUNBRELLA, which is in fact the trademark of the Complainant. Reference should be drawn to the case of *TTT Moneycorp Limited v. Privacy Gods / Privacy Gods Limited* (WIPO Case No. D2016-1973), wherein the panel while transferring the domain name <www.moneycorp.com> held that '*Respondent is not affiliated with Complainant and has not been authorized by Complainant to use and register its trade marks or to seek the registration of any domain name incorporating Complainant's Trade Mark. The registration and use of Complainant's Trade Mark preceded the registration of the Domain Name. The Domain Name makes an obvious and direct reference to Complainant's Trade Mark and services supplied in the financial services industry, particularly the online financial services sector, all of which are closely associated with Complainant.*' A copy of the decision is annexed as **Annexure-16**. The disputed domain name has been made available for sale by the Respondent at the website hosted at the disputed domain, with the message "*The domain sunbrella.in may be for sale. Click here to inquire about this domain.*" This further establishes that the



Respondent does not have any rights or legitimate interest in the domain name and it intends to make unjust commercial profits. Further, the webpage hosted at the domain name <sunbrella.in> carries sponsored listings/advertisements, which redirects internet users to various websites, including those competing with the Complainant's. Webpage hosted at the disputed domain name is annexed as **Annexure-17**. Use of the disputed domain name by the Respondent using the Complainants' well known trademark to redirect internet users to other website is not a *bonafide* use under the Policy and does not confer rights or legitimate interests upon the Respondent. Refer *HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager*, (WIPO Case No. D2007-0062), panel observed that using the domain name for the purposes of displaying links for commercial gain is evidence of bad faith use; *Factory Mutual Insurance Company v. Rihanna Leatherwood* (WIPO Case No. D2009-0144), panel held that Respondent has registered the disputed domain name, based on its trademark value, in order to generate Internet traffic to derive income; and such use is not recognized as *bona fide* use under the Policy.; *Mpire Corporation v. Michael Frey*, (WIPO 14 Case No. D2009-0258), the panel stated that, whilst the intention to earn click-through-revenue is not in itself illegitimate, "*the use of a domain name that is deceptively similar to a trademark to obtain click-through-revenue is found to be bad faith use.*"; *Accor v. Tans Wei*, (NIXI Case No. INDRP/127, February 24, 2010) the panel found that the Respondent's domain name resolved to a parked page which contained sponsored links to the third party hotels which provide services that are directly competing with the Complainant's and therefore such use cannot be termed as a *bonafide* offering of goods and services. Copy of the awards passed in the above referenced cases is annexed as **Annexure -18**. Accordingly, the Respondent's acts do not constitute a *bona fide* offering of goods or services. The Respondent therefore does not have any legitimate rights and interest in the disputed domain name and has evidently registered the same with the *malafide* intent of making illegitimate and illegal gains.

(iii) The domain name was registered and is being used by the Respondent in bad faith [Para 3(b)(vi)(3) INDRP Rules of Procedure to be read with para 6 of .INDRP:



The Complainant submits that bad faith is implicit in the registration of the disputed domain name. The Respondent registered the disputed domain name in issue on August 22, 2014, by which time the Complainant's SUNBRELLA Mark, through extensive and continuous use, had acquired immense goodwill and reputation amongst the public and trade. The SUNBRELLA Mark is associated exclusively with the Complainant. It is evident from the website hosted at www.sunbrella.in that the Respondent is making money by luring customers to the website and deceiving them by diverting them to third party sponsored listings. This establishes the Respondent's intention of selling, renting or transferring etc. of domain name and his intention to prevent the owner of trademark from reflecting the mark in corresponding domain name. There is also no instance where the Respondent has made (or has made preparations for) a *bona fide* offering of goods/services under the mark/name SUNBRELLA or through hosting at the disputed domain name <sunbrella.in>. In response to the Complainant's attempt to purchase the disputed domain name, the Respondent offered to sell the disputed domain name at USD 3890. A copy of the email wherein the Respondent made its offer is provided as **Annexure -19**. Thus it is clear that the domain name was acquired for the purpose of selling or transferring the domain name registration for valuable consideration in excess of the Respondent's out of pocket expenses. Refer *Phoenix IT Solutions Ltd. v. Mr. M. Ramesh* (NIXI Case No. INDRP/495, September 28, 2013) the panel while transferring the domain name held that *"...bad faith and illegitimate interest of the respondent/registrant in the disputed domain can be corroborated by the demand that the respondent/registrant made to sell the domain name ... Such an offer to sell the domain name clearly indicates that the Registrant had no legitimate interest in the domain name and that the registration was done in bad faith solely for the purpose of unlawful commercial gains."*; *Intesa Sanpaolo S.p.A. v. Feng Wang*, (WIPO Case No. DCO2012-0009), panel held that *"Such use of the disputed domain name to link to a page offering it for sale for an exorbitant amount does not result in the Respondent acquiring any rights or legitimate interests in the disputed domain name. Therefore the Panel holds that the Respondent has no rights or legitimate interests in the disputed domain name... The only inference open to the Panel is that the Respondent acquired the distinctive domain name for the purposes of selling it back to the Complainant for an inflated sum, without itself having any grounds to*



claim rights or legitimate interests in the disputed domain name. Therefore the Panel holds that the disputed domain name was registered and used in bad faith." In *Aktiebolaget Electrolux v. Li Bing Yu* (WIPO Case No. D2012-1106), panel held that "The Respondent attempted to sell the disputed domain name for USD 1,000, which, without evidence to the contrary given the normal registrations fees, will be more than its out of pocket expenses." Copy of the awards passed in the above is annexed as **Annexure –20**. The Complainant further states that it is evident that the Respondent is engaged in the business of cyber squatting by registering domain names containing well-known trademarks and making illegal benefits by sales or pay-per-click use thereof. It is also evident that the Respondent is trying to sell the domain name either to the Complainants or to a third party that would similarly be trying to benefit from the Complainants' famous trademark. It is submitted that the Respondent is known to register domain names containing well known/famous marks for commercial gains and has been involved as a Respondent in another INDRP domain name dispute. Refer *Le Creuset v. DingDing* (NIXI Case No. INDRP/961, February 27, 2018), wherein it was found that the Respondent has no rights of legitimate interest in the domain name <lecreuset.in> and that the Respondent's registration thereof was in bad faith. A copy of the decision is annexed as **Annexure –21**. It is a well settled that the Respondent's track record is relevant for ascertaining bad faith in registration of a domain name. In *Société des Technologies de l'Aluminium du Saguenay Inc. v. Success Inc.*, (WIPO Case No. D2008-0268), reference is made to the Respondent's track record and 12 previous decisions in which it has been found to have been implicated in the registration and use of domain names in bad faith. A copy of the decision is annexed as **Annexure-22**. In light of the above, it is apparent that the registration and use of the domain name <sunbrella.in> by the Respondent is not *bona fide* and the Respondent is *prima facie* using the domain name in bad faith.

B. Respondent:

The Respondent, in spite of notice dated 14th May, 2018 and default notice dated 29th May, 2018 did not submit any response.



7. Discussion and Findings:

It has to be asserted as to whether the Constitution of Arbitral Tribunal was proper and whether the Respondent has received the notice of this Arbitral Tribunal?

Having gone through the procedural history, this Tribunal comes to the irresistible conclusion that the Arbitral Tribunal was properly constituted and Respondent has been notified of the complaint of the Complainant. However, the Respondent did not choose to submit any response and that non-submission of the response by the Respondent had also been notified to the Respondent on 29th May, 2018.

Under paragraph 4 of the .IN Domain Name Dispute Resolution Policy (INDRP), the Complainant must prove each of the following three elements to establish their case, that:

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

(a) Identical or confusing similarity:

- i) The Arbitral Tribunal finds that the Complainant has provided evidences that it possesses registered trademark "Sunbrella" around the world, including in India. The same is evident from **Annexure 5** marked by the Complainant. As submitted by the Complainant, the decision in *Perfetti Van Melle Benelux BV*



v. Lopuhin Ivan, IPHOUSTER (WIPO Case No. D2010-0858) and *Inter-Continental Hotels Cooperation v. Abdul Hameed* (NIXI Case No. INDRP/278, February 10, 2012) in **Annexure-11**, it was held that the trademark registration constitutes *prima facie* evidence of the validity of trademark rights. This Tribunal also concurs with the decision stated supra.

- ii) Similarly this Tribunal relies on the decision submitted by the Complainant in, *The Forward Association, Inc. vs Enterprises Unlimited*, (FA0008000095491 Nat. Arb. Forum October 3, 2000) in **Annexure-13**, wherein the panel held that "[w]hen a trademark is composed in the whole or in part of a domain name, neither the beginning of the URL(<http://www.>), nor the TLD (.com) have any source indicating significance". Therefore, the mark 'Sunbrella' is significant in the disputed domain name, irrespective of the beginning of the URL and the TLD.
- iii) The disputed domain name, www.sunbrella.in, in toto, incorporates the complainant's mark, namely 'Sunbrella'. In *Kenneth Cole Productions V. Viswas Infomedia* INDRP/093, it has been held that there is confusing similarity where the disputed domain name wholly incorporates the Complainant's trademark. Similarly, the domain name www.sunbrella.in is confusingly similar to the Complainant's mark and also wholly incorporates the mark, "Sunbrella". Thus, this Arbitral Tribunal finds that the disputed domain name www.sunbrella.in is identical or confusingly similar to the Complainant's mark.
- iv) The Arbitral Tribunal concludes that the Complainant has established paragraph 4(i) of the .IN Domain Name Dispute Resolution Policy.

(b) Respondent's Rights or Legitimate Interests:

- i) The Complainant contends that the Respondent has no legitimate interest in the disputed domain name. Paragraph 7 of the IN Dispute Resolution Policy sets out three elements, any of which shall demonstrate the Respondent's rights or



legitimate interests in the disputed domain name for the purposes of Paragraph 4 (ii) of the Policy. The Respondent had been given the opportunity to respond and to present evidence in support of the elements in paragraph 7 of the INDRP. The Respondent has not chosen to do so and has not filed any response in these proceedings to establish any circumstances that could assist it in demonstrating, any rights or legitimate interests in the disputed domain name. Although, the Complainant is not entitled to relief simply by default of the Respondent to submit a Response, the Arbitral Tribunal can however and does draw evidentiary inferences from the failure of the Respondent to respond. It is also found that the respondent has no connection with the mark "Sunbrella". The Respondent has failed to rebut the presumption of absence of rights or legitimate interests.

- ii) It is further seen that the WHOIS lookup in **Annexure 3**, it relates the Respondent to the Disputed Domain name. However, it identifies the registrant as 'DingDing', with no organization name provided, which also not in the slightest way similar to the Disputed Domain name. The Respondent is found to have acted in a way that tarnishes the Complainant's well known mark "Sunbrella", by using the mark without any proper authorization.
- iii) Further from **Annexure 17**, the Respondent website hosted at the disputed domain name displays "*The domain sunbrella.in may be for sale. Click here to inquire about this domain,*" which implies the intention of the Respondent to make unjust commercial profits. As submitted by the Complainant, the webpage hosted at the domain name <sunbrella.in> carries sponsored listings/ advertisements, which redirects internet users to various websites, including those competing with the Complainant's. Such practise amounts to using the domain name in bad faith as laid down and relied by the Complainant in *HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager*, (WIPO Case No. D2007-0062). The decision is annexed in **Annexure-18**.
- iv) The disputed domain name has been made available for sale by the Respondent at the website hosted at the disputed domain, with the message



"The domain *sunbrella.in* may be for sale. Click here to inquire about this domain." This further establishes that the Respondent does not have any rights or legitimate interest in the domain name and it intends to make unjust commercial profits. Further, the webpage hosted at the domain name <sunbrella.in> carries sponsored listings/advertisements, which redirects internet users to various websites, including those competing with the Complainant's. Webpage hosted at the disputed domain name is annexed as **Annexure-17**.

v) Based on the record, the Respondent does not have rights or legitimate interests in the disputed domain name as the Respondent's current use is neither an example of a bona fide offering of goods or services as required under paragraph 7(i) of the Policy nor is there any legitimate non-commercial or fair use of the disputed domain name and as such there is no evidence that paragraphs 7(ii) or 7(iii) of the Policy apply. The Complainant asserts that they have not licensed or otherwise authorized the Respondent to use their trademark.

vi) The Arbitral Tribunal is satisfied that the Respondent has no rights or legitimate interests in respect of the disputed domain name and, accordingly paragraph 4(ii) of the Policy is satisfied.

(c) Registration and Use in Bad faith:

- i) It is seen from **Annexure-3**, the Respondent had registered the disputed domain name on August 22, 2014 which is very much after the date of registration of the Complainant's trademark. By that time, the Complainant's SUNBRELLA Mark, through extensive and continuous use, had acquired immense goodwill and reputation amongst the public and trade. The rights of the Complainant in the mark is also well established by various precedents submitted by the Complainant in **Annexure-8**.
- ii) It is seen from **Annexure-17**, which is the website hosted at the disputed domain name, the Respondent is luring customers to the said website and deceiving them to third party sponsored listings. It is further seen from



Annexure-19, the Complainant had attempted to purchase the disputed domain name and the Respondent had offered the Complainant to sell the disputed domain name for USD 3890. Therefore, it is perceived by this Tribunal that the Respondent do not have any bona fide intention to host the disputed domain name. The same is also discussed in *Phoenix IT Solutions Ltd. v. Mr. M. Ramesh* (NIXI Case No. INDRP/495, September 28, 2013) wherein the Panel while transferring the domain name held that *"...bad faith and illegitimate interest of the respondent/registrant in the disputed domain can be corroborated by the demand that the respondent/registrant made to sell the domain name ... Such an offer to sell the domain name clearly indicates that the Registrant had no legitimate interest in the domain name and that the registration was done in bad faith solely for the purpose of unlawful commercial gains."* Similarly in *Intesa Sanpaolo S.p.A. v. Feng Wang*, (WIPO Case No. DCO2012-0009), relied by the Complainant, the panel held that *"Such use of the disputed domain name to link to a page offering it for sale for an exorbitant amount does not result in the Respondent acquiring any rights or legitimate interests in the disputed domain name. Therefore the Panel holds that the Respondent has no rights or legitimate interests in the disputed domain name... The only inference open to the Panel is that the Respondent acquired the distinctive domain name for the purposes of selling it back to the Complainant for an inflated sum, without itself having any grounds to claim rights or legitimate interests in the disputed domain name. Therefore the Panel holds that the disputed domain name was registered and used in bad faith."* In *Aktiebolaget Electrolux v. Li Bing Yu* (WIPO Case No. D2012-1106), Panel held that *"The Respondent attempted to sell the disputed domain name for USD 1,000, which, without evidence to the contrary given the normal registrations fees, will be more than its out of pocket expenses."* A compilation of the above relied discussions by the Complainant are annexed as **Annexure-20**.

- iii) The Respondent had involved in cyber squatting by registering domain names containing well known trademarks and thereby making illegal benefits by sales or pay-per click use which would also amount to registration and use in bad faith.



- iv) The Respondent has no legitimate rights or interests in the disputed domain name and there was a *mala fide* intent for registering the disputed domain name other than for commercial gains, and that the intention of the Respondent was simply to generate revenue, either by using the domain name for its own commercial purpose or through the sale of the disputed domain name to a competitor or any other person that has the potential to cause damage to the ability of the Complainant to have peaceful usage of the Complainant's legitimate interest in using their own trade names.
- v) The Arbitral Tribunal is satisfied that the Respondent used the Complainant's domain name in bad faith and, accordingly paragraph 4(iii) of the Policy is also satisfied.
- vi) In the light of the above, this Arbitral Tribunal finds that the Complainant has established that the disputed domain name was registered and is being used in bad faith.

8. Decision:

For all the foregoing reasons, in accordance with paragraph 10 of the .INDRP, the Arbitral Tribunal orders that the Respondent shall cease to use the mark "Sunbrella" and also the disputed domain name www.sunbrella.in be transferred to the Complainant.



D.SARAVANAN
Sole Arbitrator
30th May, 2018
Chennai, INDIA.