



हरियाणा HARYANA

F 248866

RANJAN NARULA
ARBITRATOR

Appointed by the .In Registry - National Internet Exchange of India

In the matter of:

Pantaloon Retail (India) Limited

Knowledge House

Shyam Nagar

Off Jogeshwari Vikhroli Link Road

Jogeshwari East

Mumbai 400 060

India

Through

It's Chief Financial Officer

Chandra Prakash Toshniwal.

.Complainant

Domain Admin

Consulting First, Inc.

93A Mathis Dr. #141

Dickson

Tennessee 37055

US

Email: contactidrc503@consultingfirst.com.

.Respondent

AWARD

1. The Parties:

The Complainant is Pantaloon Retail (India) Limited, Knowledge House, Shyam Nagar, Off Jogeshwari Vikhroli Link Road, Jogeshwari East, Mumbai 400 060, India.

The Respondent is Domain Admin, Consulting First, Inc., 93A Mathis Dr. #141, Dickson, Tennessee 37055, US.

2. The Domain Name, Registrar & Registrant:

The disputed domain name is www.umm.in. The Registrar is Directi Internet Solutions Pvt. Ltd. (R5-AFIN). The registrant is Domain Admin (Respondent), Consulting First, Inc.

3. Procedural History:

The Complainant filed this complaint to the .In Registry and .In Registry appointed "Ranjan Narula" ("The Arbitrator") as Sole Arbitrator under clause 5 of its policy. The Arbitrator submitted his statement of acceptance and declaration of impartiality and independence on 17th February 2009 then the complaint was produced before the Arbitrator on 19th February 2009. The notice was issued to the Respondent on 23rd February 2009 on his email address with a deadline of 10 days to submit his reply to the arbitration but no response was filed by the Respondent. Again on 9th March 2009 second notice was sent to Respondent as a final opportunity to submit his reply within 7 days. However, no response was filed by the Respondent. On 17th March, the Arbitrator issued a notice to the Complainant seeking clarification as to his rights in the trade mark 'UMM Underground Music Movement' which stands registered in the name of Moda Musica SRL and for which the Complainant is a licensee. The Complainant was given 10 days to submit his response. A detailed reply was received on 26th March 2008. The Arbitrator therefore provided last and final opportunity to the Respondent on 26th March 2009 with a deadline of 30th March 2009 to submit his reply



to the Arbitrator. As there has been no response from the Respondent, the award is being given ex-parte.

4. Factual Background:

The Complainant, a company registered under the Indian Companies Act, is a licensee of Moda Musica SRL, the proprietor of mark "UMM Underground Music Movement" in India.

UMM Underground Music Movement is registered in India under no. 1232532 in Class 25 to cover man, woman, child clothing, footwear, and headgear goods, jackets and heavy jackets, overcoats, trousers, skirts, shirts, t-shirts, knitwears, sports clothes, gymnastics and leisure tracksuits, sweatshirts, gloves, belts, scarfs, hats, shoes, sports shoes, slippers, boots in class 25.

The Respondent registered the domain name <umm.in> on 6th July 2007. No detailed information is available about the Respondent, apart from what is mentioned in the complaint. No reply has been filed by the Respondent.

5. Parties Contention:

(1) Complainant

- (1) The Complainant claims to have been carrying on business of operating multiple retail formats in both value and lifestyle segment of the Indian Consumer market and is a renowned chain of retail outlet under the name and online portal www.futurebazaar.com. The Complainant claims to have been using the said trade mark 'UMM' in India for apparels category. Due to the best quality products and varieties according to latest fashion, the brand UMM has acquired formidable reputation and goodwill in relation to the said goods. The Complainant claims to have won several prestigious awards thus establishing a professional manner in which their business is being carried on by various companies belonging to the Future Group. The Complainant states that they are a flagship company of Future Group running over 1000 stores spread across 10



million sq. ft. They have won several prestigious awards. Some of them are: "Most Admired Retail Company of the year" - Future Group Award, "Retail Face of the Year" was awarded to Mr. Kishore Biyani, CEO and "Coca-Cola Golden Spoon Awards 2008", "The Reid & Taylor Awards for Retail Excellence 2008", "Images Retail Awards", "National Retail Federation Awards", "World Retail Congress Awards", "Hewitt Best Employers 2007 Award", "PC World Indian Website Awards", "Reader's Digest Trusted Brands Platinum Awards", Ernst & Young Entrepreneur of the Year Award, "CNBC Indian Business Leaders Awards" and "Lakshmipat Singhanian - IIM Lucknow National Leadership Awards".

- (2) The Complainant, are the licensed users of the trade mark UMM- Underground Music Movement (hereinafter 'trade mark'). The trade mark is owned by Moda Musica SRL, a Company organised and existing under the laws of the State of Italy. The mark is registered in their favour under the Trade Marks Act, 1999. A copy of certificate of registration under Trade Marks Act, 1999 bearing number 123252 in Class 25 has been filed alongwith the complaint. The trade mark has been registered since 5th September, 2003.
- (3) The Complainant has filed a licence agreement between Moda Musica SRL and Future Brands Ltd for long term development of 'UMM and Undergirl and all associated characters of Moda Musica SRL.' As per clause 5, the term of the agreement is stated to be ten years from July 1, 2007 to June 30, 2017. Clause 6 of the Agreement provides for Royalty payments, technology transfer fees and management fees. Clause 11 provides that, 'this Agreement includes all standard Terms and Conditions annexed hereto'.
- (4) The 'Standard Terms and Conditions' annexed to the Agreement in particular clause 8 of the Agreement with the heading 'Trademark, Patent and Copyright Protection' is reproduced below:
 - a) The License granted hereunder is conditioned upon Licensee's compliance with the applicable provisions of the trademark, patent and copyright laws of the United States and each foreign country in the territory. Licensee shall keep records of and advise Moda when each of the Products is first sold in each country in the Territory.



- b) Licensee shall cooperate with Moda in protecting and defending the Property and Trademarks including the execution of any documents as requested by Moda. If any claim or problem arises with respect to the protection of the Property or the Trademarks in the Territory, Licensee shall promptly advise Moda in writing of the nature and extent of same. Moda shall have the right but not the obligation to take any action whatsoever, with counsel of its own choice, if any claim or problem arises with respect to the protection of the Property or the Trademarks.
 - c) Licensee shall not at any time apply for copyright, trademark or patent protection nor file any document with any governmental authority nor take any other action which could affect Moda's rights in the Property or the Trademarks.
 - d) Licensee shall not be responsible for any loss, damage, claim or problem for which it has discharged its obligation under the terms of this agreement by intimating/advising Moda in writing. Licensee shall be entitled to claim reimbursements of expenses incurred for and in respect of any legal proceedings/actions taken on behalf of and as per instructions of Moda.
- (5) In order to seek clarification of the Complainant's locus standi in filing this complaint, in particular, clause 8 of the 'Standard Terms & Conditions' whereby the proprietor of the mark (Moda Musica SRL) had retained the right to initiate infringement/enforcement proceedings and by analogy INDRP complaint, the Arbitrator issued a notice on 17th March. By this notice, the Complainant was asked to explain his stand and to provide any documents authorising them to file the complaint.
- (6) On 26th March, the Complainant submitted a detailed response stating that:
- a) The Complainant is a leading retailer and a public listed company which belongs to the group of companies promoted by Kishore Biyani, popularly known as 'The Future Group' and is one of India's leading business houses with multiple businesses inter alia including telecom/IT,



apparels, general provisions, electronics, general merchandise, logistics, fashion, entertainment etc. spanning across the consumption space.

- b) The Complainant is the licensee of the registered mark containing "UMM" as an essential and prominent feature, which trade mark is registered under No. 1232532 dated 5th September 2003 in class 25 in the name of M/s. Moda Musica SRL, Italy. The said mark has been in open, continuous, extensive and exclusive use since the year 2004 by the Complainant in respect of apparels, footwear, headgear, etc. and has acquired a secondary meaning to connote and denote to the relevant section of public, the merchandise of the Complainant alone.
- c) The Complainant with a view to enhance consumer experience and to extend the benefits of e-commerce to their retailing business, the Complainant registered the domain name www.ummindia.com in the year 2004, inter alia to provide information, advertise, market and sell the merchandise bearing the mark/brand UMM of the Complainant.
- d) The Complainant has produced a copy of the letter dated 10th January 2009 vide which M/s. Moda Musica SRL have authorised the Complainant to file a complaint against the registration of the domain name www.umm.in at the .IN Registry.
- e) The Complainant claims that the said mark/brand has become well-known among the members of public and trade and any use thereof is instantly associated with the Complainant in the course of trade. The popularity and large-scale use of the mark UMM is apparent from the large and ever growing sales of the merchandise bearing the mark/brand UMM of the Complainant.
- f) The Complainant has made tremendous efforts and has spent considerable amounts of money for the publicity and promotion of the merchandise bearing the mark/brand 'UMM' and has filed copies of advertisement and promotional material.
- g) The Complainant states that by virtue of the valuable common law and statutory rights subsisting in the mark/brand 'UMM', the Complainant is



entitled and authorised by the owner of the mark M/s. Moda Musica SRL. Italy to prevent any other party/person from using and/or registering any identical, deceptively and/or confusingly similar mark and/or any domain name containing the registered trade mark 'UMM' and/or identical/deceptively similar to the registered domain name www.ummindia.com of the Complainant.

- h) The Complainant states that the Respondent has registered a domain name www.umm.in in the year 2007, subsequent to the registration of the mark 'UMM' and the domain name www.ummindia.com and the impugned domain name contains the prior well known and registered mark/brand 'UMM' and is identical and/or confusingly similar to the prior registered domain name www.ummindia.com of the Complainant.
- i) The Complainant contends that the Respondent has no rights and/or legitimate interests in the impugned domain name and the same has been registered in bad faith and with a malafide intention to trade upon the reputation and goodwill acquired by the Complainant in their prior well known mark/brand 'UMM' which is exclusively associated with them in the course of trade.

(2) Respondent

The Respondent did not reply to the Complainant's contentions even after several opportunities being granted.

Discussion and Findings:

In view of the above submissions and voluminous documents provided in support of use and reputation of the mark UMM, the Complainant has established its rights and authorization to file the complaint on behalf of the registered proprietor. The Complainant has also satisfied the three conditions as per paragraph 4 of the policy:

- (1) the Respondent's domain name is identical or confusingly similar to the trademark in which he has rights;



- (2) the Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered in bad faith.

It may be mentioned that since the Respondent did not file any response and rebut the contentions of the Complainant, it is safe to conclude that the prima facie case has been made out by the Complainant to establish that it has better and prior rights in the trademark UMM. Further, the Respondent not having used the mark or established its legitimate rights or interests in the mark, an adverse inference as to their adoption of an identical domain name has to be drawn.

7. Decision:

For all the reasons discussed above, the Arbitrator orders that the domain name <umm.in> be transferred to the Complainant.



RANJAN NARULA
SOLE ARBITRATOR
NIXI
INDIA
2 April, 2009