

தமிழ்நாடு தமில்நாடு TAMILNADU

25025
16/08/2018

Dr. SUDHIR RAJA RAVINDRAN

BH 091270

V. BEDHARAJAI
Stamp Vendor
L.No:12144/B1/90
Ekkattuthangal, Ch-3.
Mobile No: 9710019475

BEFORE THE SOLE ARBITRATOR, DR. SUDHIR RAJA RAVINDRAN

.IN REGISTRY

(NATIONAL INTERNET EXCHANGE OF INDIA)

.IN DOMAIN NAME DISPUTE RESOLUTION POLICY (INDRP)

ARBITRATION AWARD

DATED: August 27, 2018

Advance Magazine Publisher Inc.

One World Trade Center

New York NY 10007

USA

COMPLAINANT

[Handwritten signature]

VERSUS

Basheer Poolachalil

Vogue,

Attur Layout,

Yelahanka Newtown,

Bangalore 560064

RESPONDENT/REGISTRANT

DISPUTED DOMAIN NAME: "VOGUEINDIA.CO.IN"

1. Parties

1.1. The Complainant in this arbitration proceeding is represented by Mr. Rahul Chaudhry, RCY House, C- 235, Defence Colony, New Delhi – 110024.

2. The Respondent in this arbitration proceeding, according to the WHOIS database accessed via the .IN Registry's website, is GoDaddy.com,LLC.

3. **The Dispute:** The domain name in dispute is "VOGUEINDIA.CO.IN". According to the WHOIS search utility of the .IN Registry, the Registrar of the disputed domain name is GoDaddy.com,LLC.

4. Calendar of Major Events:

| S. No | PARTICULARS | DATE |
|--------------|--|-------------|
| 1. | Date on which NIXI'S letter was received for appointment as Arbitrator | 24/07/2018 |
| 2. | Date on which consent was given to act as an Arbitrator | 24/07/2018 |
| 3. | Date of appointment of Arbitrator | 30/07/2018 |
| 4. | Date on which the Hard copy of the complaint was received | 02/08/2018 |

| | | |
|----|---|------------|
| 5. | Date on which notice was issued to the Respondent | 02/08/2018 |
| 6. | Due date for filing of Counter Statement by the Respondent | 09/08/2018 |
| 7. | Date on which Complainant sent the 1 st follow up email requesting to pass the award | 10/08/2018 |
| 8. | Date on which Complainant sent the 2 nd follow up email requesting to pass the award | 21/08/2018 |
| 9. | Date on which the Arbitrator replied to the Complainant stating that the award shall be passed as per the timelines prescribed in Rule 5 c of the INDRP Rules of Procedure. | 23/08/2018 |

5. Procedural History

5.1. This arbitration proceeding is in accordance with the .IN Domain Name Dispute Resolution Policy (INDRP), adopted by the National Internet Exchange of India ("NIXI"). The INDRP Rules of Procedure ("Rules") were approved by NIXI on June 28, 2005 in accordance with the Indian Arbitration and Conciliation Act, 1996. By registering the disputed domain name with the NIXI accredited Registrar, the Respondent agreed to the resolution of the disputes pursuant to the .IN Dispute Resolution Policy and Rules framed thereunder.

5.2. In accordance with the Rules 2(a) and 4(a), NIXI formally notified the Respondent of the complaint and appointed Dr. Sudhir Raja Ravindran as the sole arbitrator for adjudicating upon the dispute in accordance with the .IN Domain Name Dispute Resolution Policy and the Rules framed thereunder and the Indian Arbitration and Conciliation Act, 1996 and the Rules framed thereunder. The Arbitrator submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the NIXI.

5.3. The Complaint was filed in accordance with the requirements of the .IN Domain Name Dispute Resolution Policy (INDRP).

5.4. On August 2nd, 2018, the Arbitrator issued a notice to the Respondent intimating the Respondent of the appointment of the Arbitrator and calling upon the Respondent to submit his response within seven (7) days, i.e. on or before August 9th, 2018.

6. Factual Background:

6.1. The Complainant is a company incorporated under the laws of the State of New York and is one of the world's most successful magazine publishers. Through its unincorporated division, Conde Nast, the Complainant publishes such well-known magazines as VOGUE, Glamour, The New Yorker, Self, Vanity Fair and QQ. Conde Nast's magazines have an internet presence and the company operates, with its affiliates, several popular web sites that incorporate content from many of its magazines.

6.2. The Respondent registered the disputed name "**VOGUEINDIA.CO.IN**" on October 2nd, 2015.

7. Parties Contentions

7.1. Complainant's Submission:

7.1.1. The Complainant claims that it is the proprietor of the world famous/well-known trademark "VOGUE" in respect of fashion magazine. The trademark "VOGUE" has been used by the Complainant in relation to fashion magazine ever since the year 1892 when it was founded as a bi-monthly publication. In 1992, the Complainant claims to have celebrated 100 years of the magazine "VOGUE" in a big way in New York. A 100th anniversary special issue of the magazine in the form of a hard cover book was released during a party at the New York Public Library. Today "VOGUE" magazine has become a fashion icon.



7.1.2.The complainant claims that his magazine VOGUE was described by book critic Caroline Weber in The New York Times in December 2006 as 'the world's most influential fashion magazine'. The Complainant's customers/purchasers of the VOGUE magazine include fashion conscious people particularly of the age group ranging from 19 to 45 years.

7.1.3.The Complainant claims to have wholly owned subsidiaries in various countries including the United Kingdom, Germany, Italy, India, Japan, Spain, Russia and France, among other countries, all of which publish a magazine under the trade mark "VOGUE", and/or with variation to the said trade mark. Further the Complainant claims that their magazine is published under the trademark "VOGUE" is sold/circulated in around 145 countries around the world, including India and the same has been available/sold in India since 1990 and has established enormous and enviable reputation and goodwill in India, among other countries. Additionally the Complainant Claims that the circulation figures show that the magazine has touched the lives of people covering all the continents of the world except Antarctica. Additionally the Complainant states that the its presence in India is since the 1930s when Princess Karam of Kapurthala was photographed and featured in the American edition of VOGUE magazine and later, Maharani Gayatri Devi was featured in the VOGUE magazine and was listed as one of the most beautiful women in the world. Therefore the Complainant states that the imprint of the VOGUE magazine in the cultural fabric of India has now been in existence for 75 long years. Also the Complainant claims that they have won/ received various awards/recognitions

7.1.4.The Complainant claims that they have been doing business in India through its Indian subsidiary, Conde Nast Private Limited, which is publishing a magazine under the Trademark "VOGUE INDIA". The first issue of the magazine "VOGUE INDIA" (October 2007) was launched in the Indian market on September 21, 2007.



7.1.5. The Complainant has obtained registration with the Indian Trademark Registry for its trademark "VOGUE" under trademark numbers 315672, 1302833, 1580019, 1580021, 2025572 and "VOGUE INDIA" under trademark numbers 1601198, 1601195, 1601196 in various classes. The trademark "VOGUE" and "VOGUE INDIA" has been used since January 1st 1939 and December 1st 2006, respectively.

7.1.6. The Complainant has to its credit various websites such as www.vogue.com, www.vogue.in, www.teenvogue.com, www.vogue.us, www.vogue.com.cn, www.vogue.fr, www.voguehellas.com, www.vogue.ru, www.vogue.it, www.vogue.co.m, www.vogue.com.tw, www.voguemag.com.tr and www.vogue.co.uk.

7.1.7. Further the Complainant claims that in September, 2017, Complainant noticed that the Respondent has been using the marks VOGUE for its business and has also registered the domain name www.vogueindia.co.in, wherein the Complainant's registered and well-known mark has completely been copied and is identical to its registered mark "VOGUE" and "VOGUE INDIA".

7.1.8. Further, the Complainant claims that they had sent a cease and desist letter to the Respondent on September 26, 2017 to stop the use of the word VOGUE in relation to which Respondent had no connection and to transfer the domain name www.vogueindia.co.in to the Complainant, which was duly received by the Respondent on October 03, 2017 by Speed Post. Further, the Complainant states that since there was no response from the Respondent a reminder letters were sent to the Respondent on October 18th 2017 and December 28th 2017 which was received by the Respondent via courier and speed post. The Complainant states that no response was received by Complainant for any of the notice received by the Respondent from the Complainant.



7.1.9. In support of its contentions, the Complainant relied on the decisions in the cases of 3M Company v. Machang [INDRP/856], Charmin Charlie LLC v. Normand Clavet [INDRP/859], Inter Continental Hotels Corporation v. Abdul Hameed [INDRP/278], Indian Hotels Company Limited v. Mr. Sanjya Jha [INDRP/148], Farouk Systems Inc. v. Yishi, WIPO Case No. D2010-006, Ingersol-Rand Co. Frankly Gully d/b/a Advcomren, WIPO Case No. D2000-0021, Boehringer Ingelheim Pharma GmbH & Co. KG v. Philana Dhimkana WIPO Case No. D2006-1594, Ducati Motor Holding S.p.A. v. Abhishek Chordia [INDRP/834], Toyota France and Toyota Motor Corporation v. Computer-Brain, WIPO Case No. D2002-0002, Toyota Jidosha Kabushiki Kaisha d/b/a Toyota Motor Corporation v. S&S Enterprises Ltd., WIPO Case No. D2000-0802, Yahoo!, Inc. vs Akash Arora & Anr. [78 (1999) DLT 285] referred to in Card service International Inc. v. McGee; reported in 42 USPQ 2d 1850, Bharti Airtel limited v. Sunita Bhardwaj [INDRP/837], Zippo Manufacturing Company v. Zhaxia [INDRP/840], Paris Hilton v. Deepak Kumar, WIPO Case No. D2010-1364, QRG Enterprises Limited and Havells India Limited v. Zhang Mi [INDRP/852], Dell Inc. v. Mani, Soniya [INDRP/ 765], Factory Mutual Insurance Company v. Rhianna Leatherwood WIPO Case No. D 2009, Velcro Industries B.V. v. Velcro Technologies [INDRP/858], Lego Juris v. Robert Martin [INDRP/125], Pentair Inc. v. Bai Xiqing [INDRP/827], Exxon Mobil Corp. v. Prop. Mgmt. Prof'l, FA 1059655 and Exxon Mobil Corp. v. Exxon Mobil c/o Internet Coordinator, FA 1220454.

7.1.10. The Complainant requests for the following relief: "that the disputed domain name <VOGUEINDIA.CO.IN> be transferred to the Complainant, costs be awarded to the Complainant for initiating this arbitration proceedings and any other relief that the Arbitration Panel deems fit."

7.2. Respondent:



7.2.1.The Respondent did not file any reply to the Complaint.

8. Discussion and Findings

8.1. Under the .IN 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, in compliance with the .IN Policy and the INDRP Rules.

8.2. The .IN Policy, Paragraph 4 requires the Complainant, to establish the following three elements:

8.2.1.The disputed domain name is identical or confusingly similar to the trademark or service mark in which the Complainant has rights, and

8.2.2.The Respondent has no rights or legitimate interests in respect of the domain name; and

8.2.3.The Respondent's domain name has been registered or is being used in bad faith.

8.3. Identical or Confusingly Similar

8.3.1.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.

8.3.2.It is well established that trademark registration is recognized as prima facie evidence of rights in a mark. The Complainant by filing documents of its registered trademarks has established that it has rights in the trademark "VOGUE" and "VOGUE INDIA" in India. The documents filed by the Complainant also show that it has used the mark extensively for a considerable period. Evidence of use of the mark for several years by the Complainant undoubtedly shows its rights in the mark.

8.3.3.The Complainant has established that it has rights in the trademark "VOGUE" and "VOGUE INDIA".

8.3.4.The disputed domain name incorporates the trademark "VOGUE" and "VOGUE INDIA" in its entirety and this is adequate to prove that the disputed domain name is either identical or



confusingly similar to the mark. A domain name that entirely incorporates a Complainant's mark is sufficient to establish the confusing similarity of the disputed domain name with the mark. This position was upheld in *Ducati Motor Holding S.p.A. v. Abhishek Chordia* [INDRP/834] and *Akshaya Pvt. Ltd. v. Mr. Prabhakar Jeyapathy*[INDRP/277].

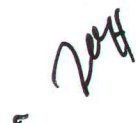
8.3.5.The Arbitrator finds that the Complainant has satisfied the first element under paragraph 4 of the Policy.

8.4. Rights and Legitimate Interests

8.4.1.The second element requires the Complainant to show that the Respondent has no rights and legitimate interests in the disputed domain name.

8.4.2.The Complainant has asserted that the Respondent has no rights or legitimate interests in the disputed domain name and that the Respondent has registered the domain name "VOGUEINDIA.CO.IN" with a mala fide intention to show that the domain name is somehow associated with the Complainant and its Indian subsidiary The Complainant states that the Complainant's adoption and extensive use of the mark "VOGUE" predates the Respondent's registration of the infringing domain name and further states that the burden is on the Respondent to establish its rights or legitimate interests in the infringing domain name.

8.4.3.Under Paragraph 7 of the Policy, a Respondent or a registrant can establish rights in the domain name, if (i) before notice of the dispute, the registrant 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 registrant (as an individual, business organization) has been commonly known by the domain name, or (iii) the registrant is making 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.



8.4.4. The Respondent has not responded in these proceedings and has not provided any material to show any rights in the disputed domain name. The Arbitrator finds no material on record to show that the Respondent is commonly known by the disputed domain name. If the Respondent does not put forward any evidence that it is known by the disputed domain name, it is a strong basis to infer that the Respondent lacks rights. Further, there is no indication from the material on record that the Respondent is using the disputed domain name for any legitimate purposes such as non-commercial fair use purposes.

8.4.5. The use of the Complainant's mark in the disputed domain name in the Arbitrator's view is likely to mislead the public and Internet users that the disputed domain name may refer to the Complainant. Misleading users by incorporating a third party's trademarks in a domain name gives a false impression to users and does not constitute a *bona fide* use under the Policy. This view has been upheld in *Dell Inc. v. Mani, Soniya INDRP/ 765*.

8.4.6. The Arbitrator finds the Complainant have made a prima facie case that the Respondent has no rights and legitimate interests in the disputed domain name and has satisfied the second element under paragraph 4 of the Policy.

8.5. Bad Faith

8.5.1. Under the INDRP Policy the Complainant is required to establish that the domain name was registered or is being used in bad faith. Proof of bad faith is a separate requirement. Information that is relevant to a consideration of the other ingredients of a claim can be relevant to bad faith inquiry, but it usually will not be sufficient to meet the Complainant's burden of proof.

8.5.2. The Complainant have asserted that the Respondent has registered and uses the disputed domain name in bad faith for the reasons that the Complainant has well-established rights



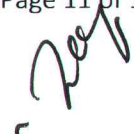
in the trademark "VOGUE" and "VOGUE INDIA", and that the Respondent seeks to exploit its famous mark to attract Internet users for commercial purpose.

8.5.3. The Complainant's prior adoption of the mark predates the Respondent's domain name registration and the registration of a name that is so obviously connected with the Complainant is suggestive of the Respondent's bad faith.

8.5.4. The Arbitrator finds the Complainant have established its prior adoption and rights in the trademark "VOGUE" and "VOGUE INDIA". Further, the Complainant's trademark applications were clearly made before the disputed domain name was registered. The evidence on record shows that the Complainant's trademark is well known. Thus the choice of the domain name does not appear to be a mere coincidence, but is a deliberate use of a well-recognized mark to attract unsuspecting users to the Respondent's website, such registration of a domain name, based on awareness of a trademark is indicative of bad faith registration under the Policy.

8.5.5. The registration of a domain name that is confusingly similar or identical to a famous trademark by an entity that has no relationship to the mark is sufficient evidence of bad faith registration and use. Internet users may falsely believe that the Respondent's domain name is being operated or endorsed by the Complainant. This view was upheld in the decision in *Pentair Inc. v. Bai Xiqing INDRP 827*.

8.5.6. 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 there is no other reasonable explanation for the registration of the disputed domain name by the Respondent.



8.5.7. For the reasons discussed, the Arbitrator finds the disputed domain name has been registered and used in bad faith under the Policy.

8.6. The above-mentioned contentions and submissions of the Complainant have not been rebutted by the Respondent, as such, they are deemed to be admitted by them.

9. Decision

9.1. The Complainant has successfully established the three grounds required under the Policy to succeed in these proceedings.

9.2. For reasons discussed, the .IN Registry of the NIXI is hereby directed to transfer the domain name "VOGUEINDIA.CO.IN" to the Complainant without any costs.

9.3. The Award is accordingly passed on this the 27th day of August, 2018.

Place: Chennai



Dr. Sudhir Raja Ravindran
Sole Arbitrator