



दिल्ली DELHI

BEFORE SHRI A.K. SINGH
SOLE ARBITRATOR NEW DELHI

D 541976

IN THE MATTER OF:

THE HARTZ MOUNTAIN CORPORTION
400 PLAZA DRIVE
SECAUCUS NJ 07094-3688 .COMPLAINANT

Versus

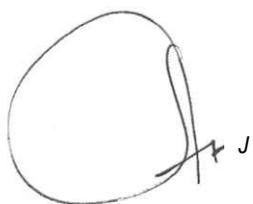
CHANDULAL RANCHHODDAS KUNDALIYA
TRADE-EASTERLY
AUM, 27 AG SOCIETY
KALAWAD ROAD, RAJKOT
GUJARAT 360005, INDIA .RESPONDENT

AWARD

A Complaint under .in domain name dispute resolution policy (INDRD) is filed by the Complainant wherein I have been appointed as an Arbitrator by the National Internet Exchange of India to adjudicate upon the dispute between the complainant and the respondent.

The brief history of the dispute as raised by the Complainant is as under :-

- a) The Complainant is a corporation established under laws of the states of New Jersey (USA) with a principal place of business in Secaucus, New Jersey.
- b) The Complaint is filed by the Complainant for transferring the domain name "wardley.in" which according to the Complainant, the Respondent got registered through Director Information Pvt. Ltd., a Registrar appointed by NIXI.
- c) The complaint is filed by the Complainant through its authorized representative Amy B. Goldsmith.
- d) According to the Complainant, it is a corporation, which does business under the trademarks HARTZ® and WARDLEY®, and is the owner of all right, title and interest in and to the trade mark HARTZ® & WARDLEY®.
- e) The Complainant claims that it is involved in design, manufacturing and sale of high quality products relating to aquarium, pond fish and reptiles under the WARDLEY® brand.



- f) The Complainant claims that in the early 1980's, HARTZ® products were sold in more than 40,000 US and Canadian retail outlets. In the 1990's, Complainant added WARDLEY ® brand. Complainant further claims that under the authority of the HARTZ Mountain, sale of products and services bearing or under the WARDLEY trade mark have been substantial and in the year 2006 alone aggregate worldwide sales figures for merchandize under the WARDLEY® trademark have been exceeded tens of million dollars.
- g) The complainant claims that WARDLEY products are sold in many countries and the mark WARDLEY is advertised in print magazines. On account of Complainant extensive advertising the WARDLEY trademark has come to be recognized and relied upon by the trade and the public as identifying and distinguishing Hartz Mountain the complainant and its pet products. The Complainant further claims that WARDLEY mark is registered in 46 countries and the Complainant applied to register the mark in India in 1994 i.e. the decade prior to the Respondent registration of its domain name.



The Complainant also claims that it also owns domain names incorporating the WARDLEY ® mark.

The Complainant claims that on March 11, 2007 the Respondent contacted to Complainant and offered to sell domain name "wardley.in" to the Complainant. On March 15, 2007 the Complainant sent the notice to the Respondent not to use domain name WARDLEY and requested him to transfer the same to the Complainant. The Complainant further claims that the Respondent vide e-mail dated March 18, 2007 demanded an amount of \$2000 for transfer of the domain name.

The Complainant thus claims that the Respondent has got registered the domain name wardley.in primarily for the purpose of selling the domain name to the Complainant for valuable consideration in excess to the Respondents documented out of pocket cost directly related to domain name and the Respondent has never been known by the domain name Wardely.in. The Complainant claims that the domain name is identical or confusingly similar to the Complainant mark

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and the Respondent has no right or
• legitimate interest in the domain name, the
domain name was registered in bad faith and
as such the Complainant requests that the
domain name "wardley.in" may be transferred
to it.

In support of the Complainant's case, the
Complainant has filed a declaration, Exhibit-1,
the copies of the advertisement and publicity
materials in support of trademark WARDLEY,
Exhibit-2 list of trademark registration and
applications for the WARDLEY and other
trademark to the Complainant, Exhibit-3 copies
of trademark registration certificate in India
in respect of other trademark of the
Complainant and copy of WARDLEY trademark
application in India, Exhibit-4 list of domain
names incorporating word WARDLEY and other
trademark of the Complainant, Exhibit-5 the
correspondence between the Complainant and the
Respondent in regard to the disputed domain
name. Exhibit-6 document showing fees payable
for domain name registration.

Complainant has also filed the decision of the
administrative panel of WIPO Arbitration and



Mediation Centre in Case No. D2306-1319 filed as Exhibit-D.

The Respondent has filed his response to the Complaint which was received vide mail dated 30.7.07. The Respondent has submitted that Trade Easterly is a tiny service oriented unit, engaged in providing various kind of tailor made services and is an entity serving to the community with high integrity and ethics. Respondent claims to be working in the field of Information Technology and is developing various sites and is also creating the intellectual property assets by registering the domains. He claims to do research and analysis of the various brand potentials to theft and registration of domain names **and** also to handover the domain name registered to the legitimate claimants.

The Respondent admits to have got registered the domain name WARDLEY@ and submits that WARDLEY is not a prohibited word in any of the language at present and as such the Respondent has right to do the business in the name and style of WARDLEY.

1. The Respondent claims that he has put in lot of experience, expertise and knowledge for



developing the business/profession in the name of WARDLEY.

The Respondent claims that the Complainant has never been interested in the domain with extension .in because

- i) The Complainant did not get domain registered during sunrise period
- ii) The Complainant showed his interest in domain name only after its registration by the Respondent.
- iii) By not registering the domain name it has caused loss to NIXI
- iv) The Complainant knew about the procedure of registration of domain name but did not register domain name with .in extension.
- v) Complainant was not interested in registration of the domain name in India though it has got its domain name's registered in other countries.

The Respondent has claimed that the Complainant did not act in the business terms and applied charges of extortion and has involved the Respondent in litigation causing expenses and inconvenience to the Respondent.

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10. The Respondent has claimed that the Complainant has not come with clean hands and its presumption is not tenable in the eyes of law.
11. The Respondent has stated that any person who has legitimate interest in "WARDLEY" and "HARTZ" and who come forward for such enterprise can be sold intellectual property.
12. The Respondent has submitted that no valuable consideration has been asked and meager out of pocket expense was requested if party agree to it. The Respondent has also admitted that simple letter of indemnity and reasons for not making the payment was requested which is fair in all circumstances on behalf of the Respondent .
13. The Respondent has submitted that registration was not done in bad faith and has given the circumstances for saying so in para 12 of the reply.
14. The Respondent has claimed that to waive the right in domain and to charge reasonable for giving priority is a fundamental basis in any social or commercial transaction, no business or service industry can run on charity.
15. The Respondent has claimed that the Complainant has no locus standi in claiming such right as is claimed by the Complainant.



16. The Respondent has not filed any document alongwith his response.

17. No rejoinder to the response of Respondent is filed by the Complainant.

18. From the above pleadings, the question arises whether the Complainant is entitled for the transfer of domain name "WARDLEY" in its favour.

19. .IN Domain Name Dispute Resolution Policy (INDRP) in paragraph 4 provides that any person, who considers that a registered domain name conflicts his legitimate rights or interests may file a complaint to the .IN registry on the premises which include "The registrant's domain name has been registered or is being used in bad faith".

20. Paragraph 6 of INDRP deals with the evidence of registration and use of domain name in bad faith. The said paragraph is reproduced here below: -

For the purpose of Paragraph 5 (iii), the following circumstances, in particular but without limitation, if found by the Arbitrator to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain registration to the Complainant, who bears the name or is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented out-of-pocket costs directly related to the domain name; or

11 The registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the registrant has engaged in a pattern of such conduct; or

111 By using the domain name, the registrant has internationally attempted to attract Internet users to the registrant's website or other on-line location by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation or endorsement of the registrant's website



or location or of a product or service on
the registrant's website or location.

21. In the complaint the Complainant has specifically alleged that the registrant's has got registered the domain name WARDLEY in bad faith and has stated that the Respondent after registration of the domain name contacted to the Complainant to sell the said domain name for \$2000

22. The Complainant has further submitted that the registration fee of one year of the said domain name is \$45. In support of its contentions the Complainant has attached the copies of the mail as Exhibit-5. The Respondent has specifically mentioned in his mail that he intends to sell the domain name to the legitimate brand owner and has shown his willingness to transfer it to the Complainant at the legitimate cost and price.

23. In the mail dated 11th March 2007 of the Respondent the amount of \$2000 does not figure specifically. The Complainant has filed a mail dated 14th March 2007 whereby the Respondent was called upon to transfer the domain name to the Complainant. The Complainant has also filed a mail dated 12th April 2007 issued by Amy.B. Goldsmith informing the respondent that in case



the domain name is not transferred to her client legal proceedings would be taken. The Complainant has also filed mail dated 18th April 2007 which is sent by the Respondent in reply to the correspondence issued by Amy.B. Goldsmith. The Respondent has tried to justify in this mail that he did not try to extort the money from the Complainant.

However the wordings of the mail dated 18th April 2007 would show that the Respondent has been trying to justify his act of offering to sell the disputed domain name to the Complainant.

It is also worthwhile to mention that against the specific averments made by the Complainant about Respondent approaching to the Complainant to sell the domain name, the Respondent in his reply in para no. 13 and 18 has mentioned as under:-

"To waive the right in any domain and to charge reasonable for giving priority is a fundamental basis in any social or commercial transaction. For no business or service industry can run on charity".

"The Hartz Mountain Corporation, failed to appreciate the spirit of the Trade-Easterly and



failed to appreciate that it is Trade-Easterly, who has brought to their notice about WARDLEY and HARTZ in Indian registry may be useful for them. Therefore, fraction of value was requested towards inputs applied to meet part of actual expenses".

25. From the documents placed on record by the Complainant, a demand of \$ 2000 was not reflecting in the mails filed by the Complainant with the claim petition. Arbitrator vide mail dated 1.9.07 asked to the complainant to send the copy of the mails which were relevant but not filed by the Complainant. A copy of this mail was also sent to NIXI as well as to the Respondent.

26. The Complainant vide mail dated 5.7.07 has sent the copies of the letter/mails which have exchanged between the Complainant and the Respondent. Mail of the Respondent dated 19.3.2007 made it clear that the specific demand of \$ 2000 per domain name was demanded by the Respondent for transferring the domain names.

27. In Para no. 4 of the said mail the respondent has informed to the Complainant that it is not a non-profit identity.

28. The Respondent vide mail dated 9.9.07 made certain further submissions and has tried to project the transfer of domain name detrimental to creativity and



it would be loss to intellectual assets of this country.

29. I have examined all aspects of the case before me for adjudication.

30. The above discussion would show that the Respondent has got booked the domain name primarily for the purpose of selling or transferring the domain name registration to the Complainant or others for valuable consideration in excess of registrant's documented out of pocket costs directly related to the domain name.

31. Exhibit filed by the Complainant shows that the word "WARDLEY" is the trademark of the Complainant which it has got registered at various countries and for its registration in India it has also moved an application in Trademark Registry, Government of India. Exhibit-4 would show various domain name which the Complainant owns and start with the word WARDLEY.

32. I thus hold that the Respondent has got booked the domain name in bad faith and directs the registry to cease the said domain name from the Respondent and transfer it to the Complainant as per its rules and procedure. I also direct



Announced and published on 21.9.07



(A.K. Singh)
ARBITRATOR

SANDEEP/WADLEY.IN