

चंडीगढ़ (संघ राज्यक्षेत्र) CHANDIGARH (U.T.)

664025

ARBITRATION AWARD

(On Stamp Paper)

INDRP ARBITRATION

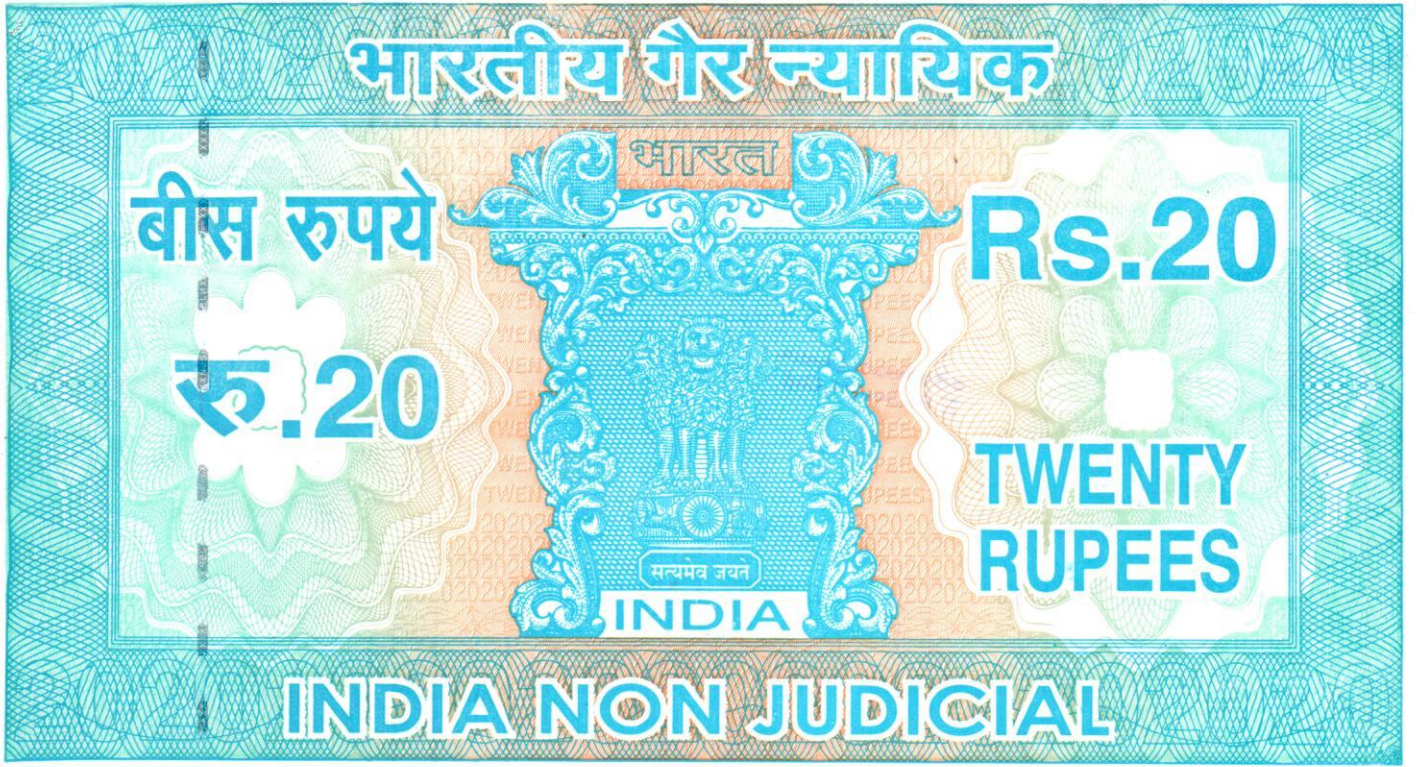
THE NATIONAL INTERNET EXCHANGE OF INDIA [NIXI]

ARBITRAL TRIBUNAL CONSISTING OF

SOLE ARBITRATOR:

DR. ASHWINIE KUMAR BANSAL, L.L.B; Ph.D.

Ashwinie Bansal



चंडीगढ़ (संघ राज्यक्षेत्र) CHANDIGARH (U.T.)

01AA 464016

In the matter of:

ZINGAMETALL BVBA

...Complainant

VERSUS

MISTER ALEXEY NAVALNY

...Respondent

REGARDING: DISPUTE DOMAIN NAME: WWW.ZINGA.IN

1. The Parties:

Complainant:

A Blume Bann

The Complainant in this arbitration proceedings is: Zingametall BVBA (company under Belgian Law), Rozenstraat 4, BE-9810 EKE (NAZARETH), Telephone N. : +32(0)9/385.68.81, Fax N. :+32(0)9/385.58.69, Email: zingametall@zinga.be

Respondent: The Respondent in this arbitration proceedings is Alexey Navalny (Rospil), Lenina Street 22 , 141070 Voronezh, Russia Tel, N.: +7.9055870025, Email:5188487@mail.ru

2. The Domain Name and the Registrar:

The disputed domain name <www.zinga.in> is registered with Name.com LLC (the "Registrar").

3. Procedural History [Arbitration Proceedings]

A Complaint has been filed with the National Internet Exchange of India (NIXI). The Complainant has made the registrar verification in connection with the disputed domain name <zinga.in>. It is confirmed that at present the Respondent is listed as the Registrant and provided the administrative details for administrative, billing and technical contact. NIXI appointed Dr. Ashwinie Kumar Bansal, Advocate, as the sole arbitrator in this matter. The Arbitrator has submitted his Statement of Acceptance and Declaration of Impartiality and Independence, as required by NIXI.

NIXI had sent complaint with Annexures through Blue Dart Courier to the Respondent on 26.11.2014. Blue Dart Courier has informed that courier vide consignment no. 4584650814 sent on 26.11.2014 has been returned due to consignee address incomplete/incorrect.

Ashwinie Bansal

In accordance with the INDRP Rules of Procedure (the Rules), Arbitrator tried to notify the Respondent officially through the given email address-5188487@mail.ru. The arbitrator had sent notice on 7.12.2014 to the Respondent, with copy to Complainant and NIXI, through the email address to give his response in 15 days. There after 3 more opportunities were given to the Respondent to give his response by email dated 25.12.2014, 7.1.2015 and 13.1.2015. The Respondent has not filed any response to the said Complaint hence the case is being decided on merits.

4. Factual Background

The Complainant, Zingametall BVBA, is the registered proprietor of trademark and domain name Zinga in various countries and has been using it in connection with its on-going business. The Complaint Company was founded in the year 1981 in Belgium having its head office at Belgium, 9810 EKE (NAZARETH), Rozenstraat. The Complainant became aware of the Respondent's disputed domain name <zinga.in> in and around March, 2014. Hence, present Complaint has been filed.

5. Parties Contentions

A. Complainant

The Complainant submits that disputed domain name <zinga.in> is identical and/or confusingly similar to the trademark 'ZINGA' in which the Complainant has rights. The disputed domain name <zinga.in> contains the Complainant's complete trademark registered in India and other countries. The disputed domain name <zinga.in> is visually and phonetically identical and/or confusingly similar to the trademark of the complainant. Such registration by the Respondent amounts to violation of Paragraph 3 of .IN Domain Name Dispute Resolution Policy (the Policy) which states that a Registrant is solely responsible to ensure before the registration of the disputed domain name <zinga.in> that such

Ashume Bansal

domain name registration does not violate the rights of any third party. The Complainant contended that it is the world leading manufacturer of Zinga-products engaged in the business of manufacturing, designing and supplying of wide range of paints, lacquers, varnishes, etc. across the globe including India for several years.

The Complainant has stated that on April 24, 1981 it coined, conceived and adopted the trademark ZINGA and has been openly, continuously and extensively using the trademark ZINGA as its trade name, corporate name, business name, trading style, trademark worldwide since then. The Complainant's products bearing the mark "ZINGA" are well known and are sold in more than 90 countries. Specifically in India, the Complainant's products have been sold under the trademark ZINGA since April 13, 1994.

The Complainant is the owner of the trademark Zinga in various jurisdictions in about 70 countries and has mostly used the trademark Zinga in respect to goods and services covered under classes 1 and 2.

The Complainant submits that the disputed domain name <zinga.in> is identical or deceptively similar to its trademark and that the Respondent has no rights and legitimate interests in the disputed domain name <zinga.in>. The Respondent's registration of the disputed domain name <zinga.in> violates the Complainant's rights in its marks. As the Respondent is not connected to the mark, the Respondent's registration of disputed domain name <zinga.in> constitutes infringement and dilution of the trademark.

The Complainant submits that the disputed domain name <zinga.in> was registered in bad faith. The disputed domain name <zinga.in> was intentionally created by the Respondent for commercial gain to misleadingly divert the consumers or traders of the Complainant to the disputed domain name

Ashwini Bansal

<zinga.in> thereby causing irreparable loss, harm and damage to the goodwill and business of the Complainant.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

As per Paragraph 11 of the Rules where a Respondent does not submit a response, in the absence of exceptional circumstances, the arbitrator may decide the Complaint in accordance with law. The Arbitrator does not find any exceptional circumstances in this case preventing it from determining the dispute based upon the Complaint, notwithstanding the failure of the Respondent to file a response.

It remains incumbent on the Complainant to make out its case in all respects under Paragraph 4 of the Policy, which sets out the three elements that must be present for the proceeding to be brought against the Respondent, which the Complainant must prove to obtain a requested remedy. It provides as follows:

"4. Types of Disputes

Any Person who considers that a registered domain name conflicts with his legitimate rights or interests may file a Complaint to the .IN Registry on the following premises:

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

The Registrant is required to submit to a mandatory Arbitration proceeding in the event that a Complainant files a Complaint to the .IN Registry, in compliance with this Policy and Rules thereunder."

The Arbitrator will address the three aspects of the Policy listed above.

Ashume Baml 6

A. Identical or Confusingly Similar

The Complainant has established that it has registered trademarks rights in ZINGA in India as per certificate dated 31.5.2004 granted by the Registrar of Trade Marks. The Complainant has also produced few other trademark certificates granted in other countries.

The trademark ZINGA has become associated by the general public exclusively with the Complainant. The Complainant also has several domain name registrations incorporating the trademark ZINGA.

The Respondent has registered the disputed domain name <zinga.in> wholly incorporating the trademark ZINGA of the Complainant, which the Arbitrator finds is sufficient to establish confusing similarity for the purpose of the Policy.

The generic Top-Level Domain (gTLD) is typically not an element of distinctiveness that is taken into consideration when evaluating the identity or confusing similarity between a complainant's trademark and a disputed domain name¹.

The Arbitrator finds that the registration of the trademark ZINGA is *prima facie* evidence of the Complainant's trademark rights for the purposes of the Policy².

Internet users who enter the domain name <zinga.in> being aware of the reputation of the Complainant may be confused about its association or affiliation with the Complainant.

The Arbitrator finds that the disputed domain name <zinga.in> is confusingly similar to the trademark ZINGA of the Complainant.

¹ See *Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr.*, WIPO Case No. D2000-1525; *Rollerblade, Inc. v. Chris McCrady*, WIPO Case No. D2000-0429; *Phoenomedia AG V. Meta Verzeichnis Com*, WIPO Case No. D2001-0374.

² See *State Farm Mutual Automobile Insurance Company v. Periasami Malain*, NAF Claim No. 0705262 ("Complainant's registrations with the United States Patent and Trademark Office of the trademark STATE FARM establishes its rights in the STATE FARM mark pursuant to Policy, paragraph 4(a)(i)."); see also *Mothers Against Drunk Driving v. phix*, NAF Claim No. 0174052 (finding that the Complainant's registration of the MADD mark with the United States Patent and Trademark Office establishes the Complainant's rights in the mark for purposes of Policy, paragraph 4(a)(i)).

Ashume Dandl 7

B. Rights or Legitimate Interests

The Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in the Domain Name. Nevertheless, it is well settled that the Complainant needs only to make out a *prima facie* case, after which the burden of proof shifts to the Respondent to rebut such *prima facie* case by demonstrating rights or legitimate interests in the Domain Name³. The Complainant has registered the disputed domain name consisting of the trademark ZINGA. The Complainant has been using the trademark for a long time. The Complainant has not authorized or permitted the Respondent to use the trademark ZINGA. The Arbitrator finds that the Complainant has made out a *prima facie* case.

The Respondent has not filed a Response to rebut the Complainant's *prima facie* case and the Respondent has thus failed to demonstrate any rights or legitimate interests in the disputed domain name <zinga.in> as per Paragraph 7 of the Policy.

Based on the facts as stated above, the Arbitrator finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name <zinga.in>.

C. Registered and Used in Bad Faith

Paragraph 6 of the Policy identifies, in particular but without limitation, three circumstances which, if found by the Arbitrator to be present, shall be evidence of the registration and use of the Domain Name in bad faith. Paragraph 6 of the Policy is reproduced below:

"6. Evidence of Registration and use of Domain Name in Bad Faith

For the purposes of Paragraph 4(iii), the following circumstances, in particular but without limitation, if found by the Arbitrator to be present, shall be

³ See *Hanna-Barbera Productions, Inc. v. Entertainment Commentaries*, NAF Claim No. 0741828; *AOL LLC v. Jordan Gerberg*, NAF Claim No. 0780200.

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 name 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

(ii) 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

(iii) by using the domain name, the Registrant has intentionally 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."

Each of the three circumstances in Paragraph 6 of the Policy, if found, is evidence of "registration and use of a domain name in bad faith". Circumstances (i) and (ii) are concerned with the intention or purpose of the registration of the domain name, and circumstance (iii) is concerned with an act of use of the domain name.

The Complainant is required to prove that both that the disputed domain name <zinga.in> was registered in bad faith and that it is being used in bad faith because in Paragraph 4 of the Policy, the provision contains the conjunction "and" rather than "or" and it refers to both the past tense ("has been registered") and the present tense ("is being used"). Hence circumstances at the time of registration and

Ashume Bant

thereafter have to be considered by the Arbitrator. The Complainant is required to prove that the registration was undertaken in bad faith and that the circumstances of the case are such that the Respondent is continuing to act in bad faith.

The Respondent has registered the disputed domain name <zinga.in> and he is using the impugned website by using copy of logo of the Complainant and contents of its one of official websites as per print screen of the website reproduced in the Complaint. Thus he is bypassing the services of the Complainant by causing confusion in the general public. The question that then arises is what circumstances of inaction (passive holding) other than those identified in Paragraph 6 of the Policy can constitute a domain name being used in bad faith? This question cannot be answered in the abstract; the question can only be answered in respect of the particular facts of a specific case. The Complainant has not granted the Respondent permission, or, a license of any kind to use its trademark ZINGA and register the disputed domain name <zinga.in>. Such unauthorized registration and use of the trademark ZINGA by the Respondent suggests opportunistic bad faith. The Respondent's true purpose in registering the disputed domain name <zinga.in> which incorporates the well-known trademark ZINGA of the Complainant is, in this Arbitrator's view, to capitalize on the reputation of the trademark ZINGA.

The Arbitrator therefore finds that the Domain Name <zinga.in> has been registered and is being used by the Respondent in bad faith.

The trademark ZINGA has been a well-known name in India. The domain disputed name <zinga.in> is confusingly similar to the Complainant's trademark ZINGA, and the Respondent has no rights or legitimate interests in respect of the domain name, and he has registered and used the domain name <zinga.in> in bad faith. These facts entitle the Complainant to an award transferring the domain name <zinga.in> **from** the Respondent. The Arbitrator allows the Complaint and directs that the Respondent's domain name <zinga.in> **be** transferred in favour of the Complainant.

Ashume Bannal

7. **Decision**

Keeping in view all the facts and circumstances of the matter this Complaint is allowed here in. The disputed domain name <zinga.in> is similar to the trademark ZINGA in which the Complainant has rights.

The Arbitrator orders in accordance with the Policy and the Rules, that the domain name <www.zinga.in> be transferred to the Complainant.

The award has been made and signed at Chandigarh on Jan 21, 2015.

Place: Chandigarh

Dated: Jan 21, 2015



Ashwinie Kumar Bansal

Sole Arbitrator

#187, Advocates Society, Sector 49-A

Chandigarh, India