



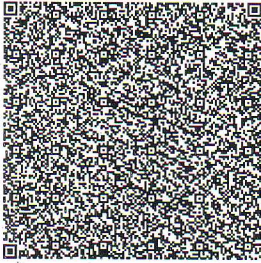
सत्यमेव जयते

INDIA NON JUDICIAL

Government of National Capital Territory of Delhi

e-Stamp

Certificate No.	: IN-DL940245916912590
Certificate Issued Date	: 09-Sep-2016 01:18 PM
Account Reference	: IMPACC (IV)/ dl967303/ DELHI/ DL-DLH
Unique Doc. Reference	: SUBIN-DL967303877830019671160
Purchased by	: JAYANT KUMAR
Description of Document	: Article Others
Property Description	: Not Applicable
Consideration Price (Rs.)	: 0 (Zero)
First Party	: JAYANT KUMAR
Second Party	: Not Applicable
Stamp Duty Paid By	: JAYANT KUMAR
Stamp Duty Amount(Rs.)	: 100 (One Hundred only)



Please write or type below this line

BEFORE THE NATIONAL INTERNET EXCHANGE OF INDIA
IN THE MATTER BETWEEN

Metropolitan Trading Company

v.

Chandan Chandan

Complainant

Respondent

Statutory Alert:

1. The authenticity of this Stamp Certificate should be verified at "www.shcilestamp.com". Any discrepancy in the details on this Certificate and as available on the website renders it invalid.
2. The onus of checking the legitimacy is on the users of the certificate.
3. In case of any discrepancy please inform the Competent Authority.

ARBITRATION AWARD

1. The Complainant is M/s Metropolitan Trading Company, a registered partnership firm in Mumbai, India. The Respondent is Chandan Chandan with its address in Karnataka, India.
2. The Arbitration pertains to the disputed domain name <zodiac.in> registered on April 18, 2010 by the Respondent.
3. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence to NIXI on July 15, 2016.
4. NIXI served a copy of the complaint along with annexures on the Respondent through courier as well as email on July 19, 2016. The Respondent was then granted 14 days time to file its Reply to the complaint. The Respondent then vide its email dated July 27, 2016 informed the Arbitrator that it has not received the complaint attached with the email and hence, requested for a copy of the same. The Arbitrator vide its email dated July 28, 2016 directed the Complainant to serve a copy of the complaint by email on the Respondent and the Complainant complied with the same on July 28, 2016. The Respondent then sought leave to file its Reply by August 7, 2016, which was granted by the Arbitrator. The Respondent filed its Reply by email vide its email dated August 7, 2016. The Arbitrator vide its email dated August 27, 2016 informed the Complainant's counsel that the complaint does not contain a Power of Attorney in their favour authorizing them to file the instant complaint on behalf of the Complainant and directed them to cure this irregularity within a week's time. The Arbitrator then gave a last opportunity to the Complainant's counsel to do the needful by September 8, 2016 and the complainant's counsel filed its vakaltanama vide email dated September 6, 2016.

Complainant's Submissions

5. The Complainant states that the mark ZODIAC was adopted by them in the year 1961 and over the years the mark is being recognized as a leading and premier brand in the men's fine clothing and accessories industry. The trademark ZODIAC, has on account of extensive use and wide publicity across India, has lost its primary significance and has acquired a secondary meaning associated and identified with the Complainant and its merchandise.



6. The Complainant also stated that it is the registered proprietor of the mark ZODIAC as of 1961 in India and filed various registration certificates in support thereof. It also stated that it has also registered/applied for registration in several countries of the world including UAE, UK, China, Singapore, EU, Germany etc.
7. The Complainant also stated that it is also the owner/proprietor and registrant of the domain name and website www.zodiaconline.com which it registered on June 28, 1999.
8. The Complainant further stated that it came to know about the domain name <zodiac.in> sometime in November, 2015 and the webpage hosted thereat at that time was offering links to third party online shopping websites dealing into clothing including men's clothing. Being aggrieved by the use of an identical word/name ZODIAC as the name of its website, the Complainant on 19.11.2015 issue a Legal Notice to the Respondent calling upon it to cease and desist from using the domain name <zodiac.in>. The Respondent replied to the said Legal Notice vide its email dated December 28, 2015 and stated that it is not sure what kind of violation is the domain name <zodiac.in> for complainant since it purchased the domain name for astrological project and that the word 'zodiac' is a generic word and that there 100+ companies using the said word. The Complainant then sent another Legal Notice on January 9, 2016 calling upon the Respondent to assign and transfer the domain name <zodiac.in> to the Complainant. The Respondent did not responded to the aforementioned Legal Notice.
9. The Complainant submitted that the domain name <zodiac.in> is confusingly similar to its mark ZODIAC.
10. The Complainant submitted that the Respondent has no rights or legitimate interests in respect of the disputed domain name. It further submitted that the fact that the Respondent was originally providing links to third party website who in turn were offering clothing and garments online, establishes beyond doubt that the aim and object of the Respondent was to encash upon the goodwill and reputation acquired by the Complainant in its trademark ZODIAC and derive illegal profits by deceiving the gullible public and the unwary purchasers.
11. The Complainant submitted that the disputed domain was registered and is being used in bad faith. It submitted that the nefarious acts undertaken by the Respondent both prior to issuing the first Legal Notice on November 11, 2015 and even now (viz. providing links to third party websites who are in the business of garments) proves the Respondent's malafide motive and the dishonesty in registration and use of the domain name <zodiac.in>.



Respondent's Submissions

12. The Respondent submitted that the word ZODIAC is a generic word and cannot be treated as a trademark owned by the Complainant. It was further submitted that the domain name <zodiac.in> was registered by it for astrological project and not as bad faith.
13. The Respondent then submitted that the trademark registration details filed by the Complainant shows that all these trademarks were filed on 'proposed to be use' basis.
14. It was also submitted that there are a number of entities featuring the mark ZODIAC in their name and hence, its registration of a domain name featuring the mark ZODIAC cannot be termed as a trademark violation.
15. It was also submitted that the domain name <zodiac.in> is not similar to the Complainant's domain name <zodiaonline.com>.
16. It was further submitted that the weblinks appearing on the webpage hosted at the domain name <zodiac.in> is a human error and because of change of nameserver and it has taken appropriate measures in the past so as not to have the weblinks appear on the domain name <zodiac.in>. It was submitted that the use and registration of this domain name by the Respondent is not in bad faith.

Discussion and Finding

17. 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. The .IN Policy, Paragraph 4 requires the Complainant, to establish the following three elements:
 - a. The domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights; and
 - b. The Respondent has no rights or legitimate interests in respect of the domain name; and
 - c. The Respondent's domain name has been registered and is being used in bad faith.
18. The Arbitrator finds that the Complainant has submitted sufficient documentary evidence to establish its rights in the mark ZODIAC, particularly trademark registration certificate for trademark registration no. 543011 dated January 7, 1991 in class 14 for the mark ZODIAC and trademark registration no. 203483 dated July 7, 1961 in class 25 for the mark ZODIAC (label). The Arbitrator is convinced with the distinctive nature of and the Complainant's ownership in the mark ZODIAC. Accordingly, the Respondent's submission that the mark ZODIAC is not capable of being registered as a trademark is rejected on account

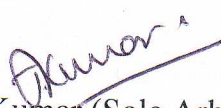


of the trademark registration certificated filed by the Complainant. The disputed domain name incorporates the mark ZODIAC in entirety and hence, the disputed domain name is held to be confusingly similar with the Complainant's mark ZODIAC.

19. Paragraph 7 of the Policy states a Respondent's or a registrant's rights can be found from the material on record, 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. The Respondent has stated that it registered the domain name <zodiac.in> for astrological project but did not find any evidence in support thereof. Moreover, it is also noticeable that the Respondent registered the domain name <zodiac.in> in 2010 but has not used or showed any intention to use the domain name in connection with a *bonafide* offering of goods or services. The Respondent's defence therefore appears afterthought. The Respondent has also not lead any evident to establish that it is commonly known by the disputed domain name or makes legitimate non-commercial fair use of the website linked to the disputed domain name. Based on the above, the Arbitrator finds that the Respondent has no rights or legitimate interests in the disputed domain name.
20. The Respondent has made no use of the domain name or website that connects with the domain name other than providing links to third party websites dealing in garments viz. the same goods in which the Complainant is dealing. The Respondent has submitted that the ads of third parties on the webpage hosted at <zodiac.in> was on account of human error and it has purchased the domain name <zodiac.in> for use in connection with an astrological purpose, however, the same does not appears convincing. This is particularly when the Respondent has not made any use (except hosting third party ads) of the domain name since 2010. Based on the above, the Arbitrator finds that the domain name was registered and used in bad faith by the Respondent.

Decision

21. In light of the aforesaid discussion and findings, the Arbitrator directs that the disputed domain name <zodiac.in> be transferred to the Complainant.


Jayant Kumar (Sole Arbitrator)
Dated: September 22, 2016
