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**BEFORE SHRI SANJAY KUMAR SINGH ARBITRATOR
IN DOMAIN NAME DISPUTE RESOLUTION POLICY (INDRP)**

IN RE:

AB Electrolux
St. Göransgatan 143
105 45 Stockholm
Sweden

COMPLAINANT

VERSUS

YERECT INTERNATIONAL LIMITED
No.23 Floor 5th, Nanhai Rd,
Hong Kong 999077
Hong Kong ROOM 403,
E-mail: shahuang@msn.com

RESPONDENT

1. Disputed Domain Name: aeg-electrolux.co.in

This is an arbitration proceeding in accordance with the Indian Arbitration and Conciliation Act, 1996, and the bye-laws, rules and guidelines framed there under. The Complainant has submitted the present Complaint to arbitration in accordance with the Dispute Resolution Policy and the Rules framed there under.

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2. The Complainant: (Rules, Para. 3(b) (ii) and (iii))

The Complainant in this administrative proceeding is Aktiebolaget Electrolux (hereinafter referred to as AB Electrolux), St Goransgatan 143, 105 45 Stockholm, Sweden.

The Complainant's contact details are:

Address: St Goransgatan 143, 105 45 Stockholm

Telephone: +46.855382630

Fax: +46.855384117

E-mail: cecilia.borgenstam@melbourneitdbs.com

The Complainant's authorized representative in this administrative proceeding is:

Cecilia Borgenstam

Melbourne IT Digital Brand Services

Saltmätargatan 7, SE-113 59 Stockholm, Sweden

Telephone: +46.855382630

Fax: +46.855384117

E-mail: Cecilia.borgenstam@melbourneitdbs.com

The Complainant's preferred method of communications directed to the Complainant in this administrative proceeding is:

Electronic-only material

Method: e-mail

Address: cecilia.borgenstam@melbourneitdbs.com

Contact: Cecilia Borgenstam

Material including hardcopy

Method: courier

Address: Melbourne IT Digital Brand Services

Saltmätargatan 7, SE-113 59 Stockholm, Sweden

Fax: + 46 8 553 402 01

Contact: Cecilia Borgenstam

3. The Respondent:

According to the concerned registrar's, A to Z Domains Solutions Pvt. Ltd., whois database the Respondent in this administrative proceeding is; YERECT INTERNATIONAL LIMITED, No.23 Floor 5th,Nanhai Rd, Hong Kong, 999077 Hong Kong ROOM 403, shahuang@msn.com.

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A copy of the whois record from the search conducted on March 28, 2012 has been annexed by the complainant as **Annexure-3**.

All information known to the Complainant regarding how to contact the Respondent has been provided by the complainant as follows:

Registrant, administrative and technical contact:

YERECT INTERNATIONAL LIMITED

No.23 Floor 5th, Nanhai Rd,

Hong Kong, 999077, Hong Kong ROOM 403,

E-mail: shahuang@msn.com

4. The Domain Name and Registrar:

This dispute concerns the domain name identified below:

AEG-ELECTROLUX.CO.IN (Hereinafter referred to as the "Domain Name".)

The registrar with which the Domain Name is registered is:

A to Z Domains Solutions Pvt. Ltd

A to Z Domains Solutions Private Limited

102, Osia Friendship, 51 Gaothan Lane Off. J.P. Road, Opp. Ram Mandir, Andheri (west) Mumbai, Maharashtra, India

91-2230797500

E-mail : contact@atozdomainssolutions.com

5. Factual and Legal Grounds :

This Complaint is based on the following grounds:

The complainant has provided a list of the registered trademarks which includes the AEG and ELECTROLUX trademarks in India and China in accordance with the Rules paragraph 3 (b) (viii) of INDRP. The copy of the same has also been annexed by the complainant as **Annexure -4**. The owner of the trademarks ELECTROLUX and AEG is AB Electrolux.

The Complainant, AB Electrolux, is a Swedish joint stock company founded in 1901 and registered as a Swedish company in 1919. AB Electrolux is a world leading producer of appliances and equipment for kitchen and cleaning. Electrolux is also one of the largest producers in the world of similar equipment for professional users. In addition, they are the market leader in many of the individual product categories in which they compete.

Electrolux is a global leader in home appliances and appliances for professional use, selling more than 40 million products to customers in 150 countries every year

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Agreement on Trade-Related Aspects of Intellectual Property Rights ("TRIPS Agreement"), the statute of a well-known trademark provides the owner of such a trademark with the right to prevent any use of the well-known trademark or a confusingly similar denomination in connection with any products or services (i.e. regardless of the list of the products and services for which the trademark is registered). The complainant has contended that the protection for ELECTROLUX and AEG goes far beyond appliances and equipment for kitchen, cleaning and outdoor use and goods similar to equipment for kitchen, cleaning and outdoor use. According to paragraph 4 of the INDRP, there are 3 essential elements of a domain name dispute which is discussed hereunder in the light of the facts and circumstances of this case. The complainant has placed reliance on **Annexure-7**.

6. Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights ((paragraph 4(i) of the INDRP):

The complainant has submitted that the Domain Name is identical to the Complainant's registered trademarks ELECTROLUX and AEG. The trademarks are famous in India as well as in other major jurisdictions such as Europe and Southern Pacific. The Domain Name incorporates the Complainant's trademarks AEG and ELECTROLUX in their entirety. The Domain Name is identical to the Complainant's trademarks except for the country code top level domain (cc TLD) ".co.in" identifier and the hyphen. The ccTLD can be disregarded for purposes of assessing similarity of the domain name to the trade mark. The complainant has placed reliance on *Morgan Stanley v. Bharat Jain, INDRP Case No.156 dated October 27, 2010 (morganstandleybank.co.in)*. As such, consumers looking for AEG and ELECTROLUX may instead reach the Respondent's website. Therefore the Domain Name identical to the Complainant's trade mark.

Rights and Legitimate Interests (paragraph 4(ii) of the INDRP):

The complainant has submitted that the Respondent has no rights or legitimate interests in the Domain Name, as the Respondent has not been given any authorization to use the Complainant's mark. The complainant has stated that this was stated by the panel as a factor in the finding of non legitimate interest with the Respondent in the WIPO Case No. D2004-0312 *Dr. Ing. h.c. F. Porsche AG v. Ron Anderson*.

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including in India. The company focuses on innovations that are thoughtfully designed, based on extensive consumer insight, to meet the real needs of consumers and professionals. Electrolux products include refrigerators, dishwashers, washing machines, vacuum cleaners and cookers sold under esteemed brands such as ELECTROLUX, AEG, AEG-ELECTROLUX, Zanussi, Eureka and Frigidaire. In 2010 Electrolux had sales of SEK 106 billion and 52,000 employees. The complainant has placed reliance on **Annexure-5**.

It has been contended that the trademarks ELECTROLUX and AEG have due to extensive and long-term use on products and services of the Complainant and, in connection therewith, by tremendous costs incurred by the Complainant in connection with the production, distribution and advertising with respect to the products and services that are marked by the trademarks acquired the status as well-known trademark within the areas for appliances and equipment for kitchen, cleaning and outdoor products. As a result, the trademarks and the products and services designated by this trademark are connected with good reputation and international recognition.

The Complainant has registered the trademarks ELECTROLUX and AEG as word and figure marks in several classes in more than 150 countries all over the world including in India and China. The trademarks ELECTROLUX and AEG were registered long before the registration of the disputed domain name. The Complainant has also registered the trademarks ELECTROLUX and AEG. The complainant has placed reliance among others 146292, 146293, 146294 for AEG and 81907, 292630, 81908, 770064 for ELECTROLUX. The complainant has annexed documents in its support as **Annexure-4**. As per the Complainant, it has also registered AEG and ELECTROLUX as domain names under almost 700 gTLDs and ccTLDs worldwide, among these; Electrolux.com, Electrolux.in, Electrolux.com.cn, Electrolux.com.hk, Electrolux.co.in and AEG.com and AEG.in. The complainant has annexed documents in its support as **Annexure-6**. The awareness of said trademarks is considered in Asia to be significant.

The complainant has submitted that the marks ELECTROLUX and AEG are in possession of substantial inherent and acquired distinctiveness. The awareness of the trademarks are considered in the whole Community to be significant. According to the provisions of Article 6bis of the Paris Convention for protection of Industrial Property ("PC") confirmed and extended by Article 16.2 and Article 16.3 of the

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The complainant has further submitted that the Respondent is not known by the Domain Name and has no trade mark rights in the name as far as the Complainant is aware. The Respondent has not used or made demonstrable preparations to use the Domain Name in connection with a bona fide offering of goods or services and is not making legitimate, non commercial or fair use of the Domain Name. The Respondent has not rebutted the Complainant's rights in the Domain Name and has not produced any documents or submissions to show his interest in protecting his own right and interest in the Domain Name. By doing this, the Respondent is misleading Internet users to a commercial web site and consequently, the Respondent is tarnishing the trademarks ELECTROLUX and AEG. In the earlier decided cases D2010-1156 and D2010-0707, the Panel stated that there is a consensus view that such use as sponsored links cannot be considered a bona fide offering of goods or services. Thus, it is clear that the Respondent has no right or legitimate interest in respect of the Domain Name. In addition the INDRP paragraph 3 clearly states that it is the responsibility of the Respondent to find out before registration that the domain name does not violate the rights of a third party.

Since the Complainant's mark AEG and ELECTROLUX are a famous and well-known mark and is registered in many countries including the country of the Respondent, it is unlikely that the Respondent did not know about the Complainant's rights in the mark or the Domain Name. The Respondent registered the Domain Name on May 21, 2011 which is subsequent to when the trademarks for AEG and ELECTROLUX were registered. The Registrant has had time to demonstrate its rights and/or legitimate interest in the Domain Name but has failed to do so. Instead the Respondent is using the Domain Name which promotes the Complainant's competitor's brand BOSCH. This sort of behaviour is not considered to be legitimate and thus, the Respondent is consequently damaging the goodwill of the brands ELECTROLUX and AEG. Moreover, the Respondent offered to sell the Domain Name to the Complainant for a substantial amount (USD 990) following a cease and Desist letter which further support that the only interest the Respondent has in the Domain Name is to profit from it.

The complainant has contended that there is no evidence that the Respondent has become known by the Domain Name anywhere in the world. It is evident that the Respondent has no legitimate interest in the Domain Name. Further, the

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Complainant has not licensed nor otherwise permitted the Respondent to use its name or trade mark or to apply for or use the Domain Name incorporating AEG or ELECTROLUX. Based on the evidence adduced by the Complainant, it must be concluded that the Respondent has no rights or legitimate interests in the Domain Name.

Registered or used in bad faith (paragraph 4(iii) of the INDRP):

The complainant has contended that On November 23, 2011, a cease and desist letter was sent to the Registrant of the Domain Name via email. In the cease and desist letter, the Respondent was advised that the unauthorized use of the trademark ELECTROLUX and AEG within the Domain Name violated the rights in the Complainant's trademarks. Cease of use and immediate transfer of the Domain Name was requested. The Respondent replied directly and advised the Complainant they would transfer the Domain Name for "only" 2590 USD. The Complainant replied and explained that they do not acquire domain names and offered to reimburse the registration fee. They did not accept this and the Respondent reduced the price to USD 990. Since the efforts of trying to solve the matter amicably were unsuccessful, the Complainant chose to file a complaint according to the INDRP process. The complainant has annexed documents in its support as **Annexure-8**.

The complainant has contended that the Domain Name is currently connected to a website which is displaying a competitor's brand and the Respondent is using the Domain Name to intentionally create a likelihood of confusion with the Complainant's mark as to the source. The complainant has annexed documents in its support as **Annexure-9**. It is without relevance whether or not the Respondent himself is actually getting revenue from the page. The complainant has placed reliance on *D2007-1912, Villeroy & Boch AG v. Mario Pingerna*, where the Respondent claimed that the web site was created by the registrar, that he had no knowledge of the content and that he had actually not received any money from the web site. The panel then stated that "these facts do not exclude bad faith because the Respondent has at all times been in contractual control of the content of the website of the disputed domain name, and had the power to instruct the Registrar to remove the parking page." These circumstances apply in this case as well. The Respondent can at all times remove the content if he likes, but the site is still showing a competitors site after notice of the cease and desist letters.

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The complainant has submitted that ELECTROLUX and AEG are famous trademarks. There is no doubt that the Respondent was aware of the rights the Complainant has in the trademarks and the value of said trademarks, at the point of the Domain Name registration. The trademarks in respect of kitchen appliances belonging to the Complainant have the status of a well-known and reputed trademark with a substantial and widespread reputation throughout the whole Community and throughout the world. The awareness of the trademarks ELECTROLUX and AEG is considered, in the whole Community in general, to be significant and substantial.

The complainant has submitted that there is no connection between the Respondent and the Complainant and the Respondent has registered and is using the domain name in bad faith. By using the Domain Name, the Respondent is not making a legitimate non-commercial or fair use without intent for commercial gain but is misleadingly diverting consumers for his own commercial gain. Further, the Respondent is preventing the Complainant from reflecting the mark in a corresponding Domain Name. The Respondent has not shown any evidence of use of the Domain Name in a legitimate manner and retaining the Domain Name under these circumstances constitutes bad faith use.

The Complainant has submitted in the above paragraphs:

- 1) That the Domain Name is confusingly similar to the Complainant's trade mark,
- 2) That the Respondent has no rights or legitimate interests in respect of the Domain Name, and
- 3) That the Domain Name was registered in bad faith.

The complainant has further submitted that these points make out a prima facie case for recovery of the Domain Name and for the reasons stated above the Complainant has requested that the Domain Name be transferred from the Respondent to the Complainant.

The Complainant has prayed that the Domain Name be transferred to the Complainant.

7. A copy of complaint has already been sent to the respondent by the .In Registry through e-mail. Upon receipt of the complaint, the Arbitrator sent a notice dated 13-05-2012 to respondent whereby the respondent was directed to submit counter affidavit/reply to the complaint of the complainant with supportive documents/evidence to the undersigned within **seven** days positively from the receipt of notice.

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Despite the above notice the respondent neither filed counter affidavit/reply to the complaint of the complainant nor any supportive documents/evidence in his support.

8. On 15-06-2012, the Arbitrator further directed the respondent to send his defence / counter to the complaint along with supportive documents / evidence at the e-mail address within further **THREE** days positively from the receipt of the notice. But the respondent has not filed/submitted his defence / counter to the complaint till date despite notice that complaint would be decided ex parte on the merits of the complaint. This was also last and final opportunity granted to the respondent. It was further made clear that this was last and final opportunity granted to the respondent with direction that further time shall not be granted to the respondent.

The respondent despite of earlier notices and reminders failed to send his defence / counter to the complaint though the notices were duly served on E-mail ID of the respondent.

Therefore, this matter is being decided ex-parte and on the merits of the complaint and as per law of the land.

9. OPINION/FINDING:

The Para no.4 of the IN Domain Dispute Resolution Policy (INDRP) is as follows:-

TYPES OF DISPUTES

Any person who considers that a domain name conflicts with his legitimate rights or interest may file complaint to .IN Registry on 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 Para no.6 of the IN Domain Dispute Resolution Policy (INDRP) is as follows:

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10. EVIDENCE OF REGISTRATION AND USE OF DOMAIN NAME IN BAD FAITH :

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 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
- ii) by using the domain name, the Registrant has intentionally attempted to attract Internet users to the Registrant's website or other online 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."

The Para no.7 of the IN Domain Dispute Resolution Policy (INDRP) is as follows:-

11. REGISTRANT'S RIGHTS TO AND LEGITIMATE INTERESTS IN THE DOMAIN NAME:

Any of the following circumstances, in particular but without limitation, if found by the Arbitrator to be proved based on its evaluation of all evidence presented, shall demonstrate the Registrant's rights to or legitimate interests in the domain name for the purpose of paragraph 4 (ii):

- "i) before any notice to the Registrant of the dispute, the Registrant's use of, or demonstratable preparations to use, the domain name

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or a name corresponding to the domain name in connection with a bonafide offering of goods or services;

- ii) the Registrants (as an individual, business, or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or
- iii) the Registrant is making a 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."

12. OPINION AND FINDINGS ON MERITS:

A) Whether the domain name is identical or confusingly similar to a trademark in which complainant has right.

It has been held in Indian decision *M/s Satyam Infoway Ltd. Vs. M/s Sifynet Solution (P) Ltd. JT. 2004 (5) SC 541*, that Domain name has all characteristics of trademark. As such principles applicable to trademark are applicable to domain names also. In the said case the words, 'Sify' & 'Siffy' were held to be phonetically similar and addition of work 'net' in one of them would not make them dissimilar.

It is held in Indian case **JT.2004 (5) SC 541**, that in modern times domain name is accessible by all internet users and thus there is need to maintain it as an exclusive symbol. It is also held that it can lead to confusion of source or it may lead a user to a service, which he is not searching.

Thus conclusion is that domain name and trademark, which may be used in different manner and different business or field, or sphere, can still be confusingly similar or identical. As such the conclusion is that the domain name of respondent is identical and confusingly similar to the trademark of complainant.

The other fact, which is to be dealt with, is, as to whether, the cases decided by WIPO- Administrative Panel could be considered, while deciding the present controversy. Moreover these cases throw light upon various important aspects of controversy. As such they would be considered, while deciding the present controversy, in so far as they do not conflict with INDRP.

Now the other important aspect that needs consideration is, as to whether the complainant has right in the trademark. It is important to mention here that as per

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the claim of the complainant the respondent has no trademark right on the said domain name.

This principle is settled in many Indian cases referred herein above. The complainant has made submission that he has legitimate trademark.

Thus the conclusion is that the domain name 'aeg-electrolux.co.in' is identical and confusingly similar to the trademarks of complainant 'ELECTROLUX and AEG' and the complainant has established that the complainant has right in the trademark.

B) Whether the respondent has no right or legitimate interest in the domain name got registered by him

It is pertinent to mention here that paragraph 4 (ii) of INDRP is to be read with paragraph no.7.

As already stated that paragraph 4 (ii) and 7 of INDRP are to be read together. Their combined effect is that, onus to prove the ingredients of these paras are prima facie on complainant. The onus is not very weak and prima facie, but it heavily shifts on respondent. Respondent can discharge the onus by direct cogent and positive evidence which are in his special knowledge and power. The complainant has made positive assertions that respondent has no legitimate right in domain name and the respondent has no trademark on the domain name. The complainant has made positive assertions regarding the fact that respondent has got registered the disputed domain name in the .IN Registry for which the respondent has no right or trademark. As such in above circumstance it is clear that the complainant has prima facie discharged the initial onus cast upon him by virtue of paragraph 4(ii) and 7 of INDRP.

The respondent on other hand has neither filed any reply / counter nor has provided any positive, cogent and specific evidence in spite of repeated notices. The respondent has failed to show that it is known or recognized by the impugned domain name in the present complaint. Thus the conclusion is that respondent has no right or legitimate interest in the domain name.

C. Whether the respondent's domain name has been registered or is being used in bad faith:

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It is to be seen as to whether the domain name has been got registered in bad faith. The paragraph no.4 (iii) and 6 are relevant and as already stated; the onus is primarily upon complainant.

Keeping in view the above facts and circumstances and Indian cases referred herein above it is thus clear that the respondent has registered the disputed domain name and in spite of repeated notices, he has not provided any substantial evidence in his support.

Thus, the conclusion is that the respondent has got registered his domain name "aeg-electrolux.co.in" in bad faith.

RELIEF

The respondent has no right and legitimate interest in the domain name 'aeg-electrolux.co.in' and that the respondent has illegally and wrongfully adopted the words "ELECTROLUX and AEG" of the complainant with the sole intention to create an impression of an association with the complainant. The domain name of the respondent is identical and confusingly similar to trademark of complainant. The respondent also does not have right or legitimate interest in the domain name. He has got it registered in bad faith; as such he is not entitled to retain the domain name. The complainant is entitled for transfer of domain name "aeg-electrolux.co.in" to him, as he has established his bonafide rights in trademark in view of facts of the case and as per law discussed above. Hence I direct that the Domain name be transferred to the complainant by registry on payment of requisite fee to the registry.

No order as to costs.

Date: 12-07-2012.

Sanjay Kumar Singh
(Sanjay Kumar Singh)
Arbitrator