



हरियाणा HARYANA

H 177660

RANJAN NARULA

ARBITRATOR

Appointed by the .In Registry - National Internet Exchange of India

**In the matter of:**

National Indemnity Company  
3024 Harney Street  
Omaha, Nebraska, 68131-3580  
United States  
Phone: (402) 916-3383  
Email: [bsneville@nationalindemnity.com](mailto:bsneville@nationalindemnity.com)

and

**National Liability & Fire Insurance Company**  
100 First Stamford Place  
Stamford, Connecticut 06902-6745  
United States  
Phone: (402) 916-3383  
Email: [bsneville@nationalindemnity.com](mailto:bsneville@nationalindemnity.com)

**Complainant(s)**

**Domain Admin**

**Privacy Protection**

14525 SW Millikan #48732

Beaverton, Oregon 97005-2343

United States

Phone: +1-201-377-3952

Email: [info@domainwhoisprivacyprotection.com](mailto:info@domainwhoisprivacyprotection.com)

... ..Respondent

**AWARD**

**1) The Parties:**

The Complainants are **National Indemnity Company**, a Nebraska corporation with its principal place of business at 3024 Harney Street, Omaha, Nebraska, 68131-3580, United States, and **National Liability & Fire Insurance Company**, a Connecticut corporation with its principal place of business at 100 First Stamford Place, Stamford, Connecticut 06902-6745, United States (hereinafter collectively referred to as "**Complainants**"). Complainants' parent company is Berkshire Hathaway Inc. The Complainants are represented by its authorized representative NEAL & MCDEVITT, LLC, 1776 Ash Street, Northfield, Illinois 60093, United States, who has submitted complaint against the domain. The Respondent is Domain **Admin, Privacy Protection**, 14525 SW Millikan #48732, Beaverton, Oregon 97005-2343, United States.

**2) The Domain Name, Registrar & Registrant:**

The disputed domain name is [www.berkshire.in](http://www.berkshire.in) The Registrar is Directi Web Services Pvt. Ltd., DirectiPlex, Mogra Village Nagardas Road, Andheri (East), Mumbai, Maharashtra 400069, India. The Registrant is Domain Admin, Privacy Protection (Respondent), 14525 SW Millikan #48732, Beaverton, Oregon 97005-2343, United States,

**3) Procedural History:**

The Complainants filed this complaint with the .IN Registry and the .IN Registry appointed "Ranjan Narula" ("The Arbitrator") as the Sole Arbitrator under clause 5 of its policy. On 9<sup>th</sup> May, 2011 the arbitrator confirmed his acceptance of complaint via e-mail and followed with formal statement of acceptance and declaration of impartiality and independence on June 10, 2011. The Arbitrator issued notice to the Respondent on May 23, 2011 at their email address with a deadline of 10 days to submit their reply to the arbitration, however, the notice sent on [info@domainwhoisprivacyprotection.com](mailto:info@domainwhoisprivacyprotection.com) bounced back. The message received is reproduced below



"This is a delivery failure notification message indicating that an email you addressed to email address :  
-- info@domainwhoisprivacyprotection.com  
could not be delivered. The problem appears to be :  
-- Recipient email address is possibly incorrect  
Additional information follows :  
-- Domain has no MX records or is invalid  
This condition occurred after 39 attempt(s) to deliver over a period of 92 hour(s)."

The arbitrator in his notice dated 23<sup>rd</sup> May had directed the Complainant to send a soft copy of the complaint to the Respondent. The complainant's representative Laurin L. Grabowski of Neal & McDevitt, LLC sent out the e-mail on 23<sup>rd</sup> May with a copy to the Arbitrator. However the mail was returned and the complainant's representative informed that they have received the following message

"Delivery has failed to these recipients or groups:

info@domainwhoisprivacyprotection.com  
(info@domainwhoisprivacyprotection.com)

A problem occurred during the delivery of this message to this e-mail address. Try sending this message again. If the problem continues, please contact your helpdesk.

The following organization rejected your message: Postini.

Diagnostic information for administrators:

Generating server: NMSBS2011.NMLAW.local

info@domainwhoisprivacyprotection.com

Postini #550 Host not found for domain:domainwhoisprivacyprotection.com  
- psmtpt #"

Thereafter the Arbitrator wrote to the NIXI to confirm if they were able to serve the complaint via courier. The NIXI responded on 30<sup>th</sup> June, 2011 informing that the complaint was sent by FedEx on 19<sup>th</sup> May, 2011 and delivered on 23<sup>rd</sup> May, 2011. On 4<sup>th</sup> July, 2011 the Arbitrator once again wrote to the parties closing the Respondent's right to file the response As no response has been filed by the Respondent and sufficient opportunity being granted, therefore, the complaint is being decided based on materials submitted by the Complainants and contentions put forth by them.

#### 4) **Summary of the Complainants' contentions in the Complaint:**

**The complainants in support of their case have made the following Submissions:**



- a) Complainants are the sole and exclusive owners of the famous United States registered trademark BERKSHIRE HATHAWAY GROUP, U.S. Reg, No. 1839594 dated June 14, 1994 which has been in use since at least as early as 1988 in connection with insurance underwriting, casualty insurance and reinsurance services. The complainant has filed a copy of the registration as **Annexure C**.
- b) Complainants' parent company viz., Berkshire Hathaway Inc. owns and has registered various domain names comprising the Berkshire Hathaway marks and formatives thereof, including [www.berkshireIndia.com](http://www.berkshireIndia.com) and [www.berkshireindia.in](http://www.berkshireindia.in), *inter alia*. **Annexure D** has been furnished as a list of domain names owned by the Complainants and/or Berkshire Hathaway Inc.
- c) On account of extensive promotion/advertisement of services under Berkshire Hathaway Marks, the Complainants and Berkshire Hathaway Inc. are well-known globally, particularly in the insurance and reinsurance industries. In India, the Complainants conduct business under the trade name 'Berkshire India Private Limited'.
- d) The Respondent's domain name is identical to the Berkshire Hathaway Registration and Marks, as well as Complainants' domain names [www.berkshireindia.com](http://www.berkshireindia.com) and [www.berkshireindia.in](http://www.berkshireindia.in), among others, in which the Complainants enjoy substantial goodwill. The addition of ".in" to Complainants' marks does not change the likelihood of confusion, as ".in" is an irrelevant distinction. The complainants have filed offending website pages as **Annexure E**.
- e) The Respondent is not listed as an owner of any pending/ registered trademark containing a formative of the term "**Berkshire**". Moreover, there is no evidence that the Respondent, as an individual, business, or other organization has been commonly known by the offending domain name.
- f) The Respondent has made no use and/or any demonstrable preparations to use the domain name or any other trademark similar to the domain name in connection with a *bona fide* offering of goods or services. Further, the Respondent is not making a legitimate non-commercial or fair use of the disputed domain name.
- g) The Respondent is using the offending website to derive revenues from "click-throughs" featuring products and services from competitors of Complainants and to mislead the consumers. On its website, the Respondent references "**Berkshire**" repeatedly.
- h) On visiting the [www.berkshire.in](http://www.berkshire.in) website, there is an indicator that the website is "parked" for free, courtesy of Sedo. This further evidences that Respondent has no rights or legitimate interests in the domain name as this message illustrates passive holding of the domain name by the Respondent.
- i) The Respondent has adopted the domain name with a view to attract the web users to the Respondent's website, who would actually be searching for the Complainants or their parent company. Such use of a domain name does not provide a legitimate interest under the Policy.



- j) By using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, internet users to Respondent's website by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or of a product or service on the Respondent's website.
- k) Registration of a well-known trademark in a domain name, of which the Respondent must reasonably have been aware of, constitutes opportunistic bad faith. Further, the offending website does not contain any statement that makes it explicitly clear that the website is not associated with the Complainants.
- l) The use of the Complainants' marks simply for the purpose of driving traffic to Respondent's website and to competitors of Complainants, is not a *bona fide* attempt to offer goods and services to the public.
- m) According to the website, the Respondent is currently accepting offers to potentially sell the domain name [www.berkshire.in](http://www.berkshire.in). Under the UDRP Policy, such an offer to sell a domain name for valuable consideration establishes that the domain name has been registered and is being used in bad faith.
- n) It is not possible to obtain every variation of how Complainant's marks may be registered or used as a domain name and the Respondent has devised a variation that has not been contemplated by the Complainants.
- o) "Domain Admin Privacy Protection" allows an entity to get around a "public" registration to a "private" one by using the private registration process, thus allowing the true registrant to hide behind the name Domain Admin Privacy Protection.

#### 5) **Deisiort/s Upholding The Complainant's Rights**

LEGO Juris A/S v. Martin, INDRP/125 (2008): the Complainants have relied on the following legal principles that have been laid down in the above case:

- (i) It is well recognized that incorporating a trademark in its entirety, particularly if the mark is an internationally well-known mark, is sufficient to establish that the domain name is identical or confusingly similar to the Complainant's registered mark.
- (ii) The use of the disputed domain name by the Respondent using the Complainant's well-known trademark to redirect internet users to other websites is not a *bona-fide* use and does not confer rights or legitimate interests.
- (iii) Where a domain name is found to have been registered with an intention to attract internet users by exploiting the fame of a well-known trademark, it constitutes bad faith registration.

#### 6) Respondent

The Respondent has not filed any response to the Complaint though they were given opportunity to do so. Though e-mails sent to their address have been returned with delivery failure notification. The Respondent appears to have given a wrong address at the time of domain registration which is violation of the terms of Registration. In any case it has been confirmed by the .IN Registry that the Respondent was successfully served with the copy of the complaint by courier, thus indicating that the

Respondent has received the complaint and elected not to file its response. Therefore, the complaint had to be decided based on submissions on record and analyzing whether the Complainant has satisfied the conditions laid down in paragraph 4 of the policy.

#### 7) **Discussion and Findings:**

The submission and documents filed by the Complainants in support of their prior adoption, use and registration of the mark/domain name "BERKSHIRE" leads to the conclusion that the Complainants have better and prior rights in the domain name. Further, they have registered a number of domain names containing the mark "BERKSHIRE".

Based on the submissions and documents on record, I'm satisfied that the Complainants have established the three conditions as per paragraph 4 of the policy:

- 1) *The Respondent's domain name is identical and confusingly similar to a name, trademark or service in which the Complainant has rights.*

It has been established by the Complainants that they have trademark rights, and rights on account of prior and longstanding use in the "**Berkshire** Hathaway Marks". The Complainants have in support submitted substantial documents. The disputed domain name contains Complainants' "**BERKSHIRE**" trademark in its entirety. The mark is being used by the Complainants worldwide including in India in relation to its business. The mark has been highly publicized and advertised by the Complainants in both the electronic and print media.

- 2) *The Respondent has no rights or legitimate interests in respect of the disputed domain name.*

The Complainants have not authorised the Respondent to register or use the "**BERKSHIRE**" trademark. Further, the Respondent has never used the disputed domain name or any trademark similar to the disputed domain name prior to the registration of the disputed domain name in favour of the Complainants.

The Respondent has not rebutted the contentions of the Complainants and has not produced any documents or submissions to show their interest in protecting their right and interest in the domain name. Further, the Respondent has not used the domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offer of goods or services. Further, the Respondent is not commonly known by the disputed domain name and has not made any legitimate non-commercial or fair use of the disputed domain name. The Respondent has in fact parked the domain name on what appears to be "pay per click" website purposely putting links of insurance companies products/services on their website. The instruction is obviously to attract internet traffic by using a well known mark as domain name.

The above leads to the conclusion that Respondent has no right or legitimate interest in respect of the disputed domain name [www.berkshire.in](http://www.berkshire.in). Its primary intention is to trade upon the reputation of the Respondent.



3) *The disputed domain name has been registered or is being used in bad faith.*

It has been contended by the Complainants that the Respondent has registered the disputed domain name in bad faith as they have a reputation all around the world in the field of insurance underwriting, casualty insurance, and reinsurance services. The Respondent has failed to respond to the complaint even after opportunity being granted, Thus the Respondent is deemed to have admitted the contentions in the Complaint leading to an adverse inference being drawn as to their adoption of an identical domain name.

**8) Decision:**

For the reasons discussed above the Arbitrator directs that the disputed domain name www.berkshjre.in be transferred to the Complainants.



**RANJAN NARULA**  
**SOLE ARBITRATOR**  
**NIXI**  
**INDIA**

July 13, 2011