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NATIONAL INTERNET EXCHANGE OF INDIA
Incube Business Centre, 5th Floor,
18, Nehru Place,
NEW DELHI – 110 019

Consorzio del Prosciutto di Parma v. Mr. Liqun Wang

AWARD

1. The Parties

The Complainant is Consorzio del Prosciutto di Parma, Via Marco dell'Arpa, 8/b – 43100, Italy.

The Respondent is Mr. Liqun Wang, Domain Legal Services, Tianmushan Road, Hangzhou, Zhejiang 310028, China.

2. The Domain Name and Registrar

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The disputed domain name is <www.parmaham.in>. The said domain name is registered with Directi Internet Solutions Pvt. Ltd. Dba Public Domain Registry.com.

3. **Procedural History**

- (a) A Complaint dated January 10, 2011 has been filed with the National Internet Exchange of India. The Complainant has made the registrar verification in connection with the domain name at issue. The print outs so received are attached with the Complaint. It is confirmed that the Respondent is listed as the registrant and provided the contact details for the administrative, billing, and technical contact. The Exchange verified that the Complaint satisfied the formal requirements of the Indian Domain Name Dispute Resolution Policy (INDRP) (the "Policy") and the Rules framed thereunder.
- (b) The Exchange appointed Dr. Vinod K. Agarwal, Advocate and former Law Secretary to the Government of India as the sole arbitrator in this matter on February 3, 2011. The arbitrator finds that he was properly appointed. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Exchange.
- (c) In accordance with the Rules, on 7th February 2011 the Sole Arbitrator formally notified the Respondent of the Complaint. The Respondent was required to submit his defence within 15 days from the date of receipt of the letter, that is, by 7th March 2011 (taking 7 days each in the transit of the communication both ways). The Respondent was informed that if his response was not received by that date, he would be considered in default and the matter will proceed ex-parte.

4. **Factual Background**

From the Complaint and the various annexure to it, the Arbitrator has found the following facts:

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Complainant's activities

The Complainant is a voluntary Consortium (Consorzio) of Parma Ham. It was established in 1963 by 23 producers of ham of the Parma region in Italy. There is a well defined Parma production area. It is around 5 km south of the via Emilia and encircled by the river Enza in the east and the river Stirone in the west. The Consortium now has 189 members. In the aforesaid Parma region highest quality of hams are produced. It is stated that the tradition and practice of the region of Parma of preparing specially cured ham dates back to 100 BC. The word "Prosciutto" is derived from the Latin word "perexsuctum" meaning thereby "dried ham" an indication of the purity of Parma Ham productions and their ancient roots in Italy. Only Hams produced and cured in the hills around Parma region may become Parma Ham.

Respondent's Identity and Activities

Respondent did not file any reply. Hence, the Respondent's activities are not known.

5. Parties Contentions

A. Complainant

The Complainant contends that each of the elements specified in the Policy are applicable to this dispute.

In relation to element (i), the Complainant contends that it is one of the leading Consortiums of Parma Ham. In many countries the words "Parma", "Prosciutto di Parma" etc., are registered as trademarks and/or certification marks.

The Consortium is the owner of a number of domain names. Some such domain names are <parmaham.net>; <parmaham.us>; <parmaham.com.cn>; <parmaham.biz>; <parmaham.eu>; <parmaham.com>; <parmaham.co.uk>; <parmaham.org>; <parmaham Jnfo>; <parma-ham.de>; <parma-ham.com>; <parma-ham.com.au>; etc. Therefore, the

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Complainant is well known to its customers as well as in business circles as Parmaham all around the world.

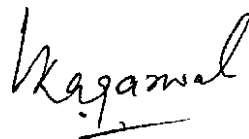
In relation to element (ii), the Complainant contends that the Respondent (as an individual, business, or other organization) has not been commonly known by the mark "parmaham". Parma is a region of Italy. China has no region by the name Parma. Further, the Respondent is not making a legitimate or fair use of the said domain name for offering goods and services. The Respondent registered the domain name for the sole purpose of creating confusion and misleading the general public.

In support of its contentions, the Complainant has relied on the decisions in the cases of American Home Products Corporation vs. Ben Malgioglio, WIPO Case No. D20000-1602 and Vestel Elektronik Sanayi Ve Ticaret As vs. Mehmet Kahvect, WIPO Case No. D2000-1244 where in it has been held that a passive holding of a domain name is an evidence of a lack of legitimate rights and interests in that name.

Regarding the element at (iii), the Complainant contends that the main object of registering the domain name <www.parmaham.in> by the Respondent is to earn profit by selling the domain name and to mislead the general public and the customers of the Complainant. The Complainant has stated that the use of a domain name that appropriates a well known trademark or servicemark to promote competing or infringing products cannot be considered a "*bona fide offering of goods and services*".

B. Respondent

The Respondent did not submit any evidence or argument indicating his relation with the disputed domain name <parmaham> or any trademark right, domain name right or contractual right. Therefore, the Respondent has no legal right or interest in the disputed domain name.

A handwritten signature in black ink, appearing to read 'K. G. Kamal', with a horizontal line underneath the name.

6. Discussion and Findings

The Rules instructs this arbitrator as to the principles to be used in rendering its decision. It says that, "a panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, the Arbitration and Conciliation Act, 1996, the Rules and any rules and principles of law that it deems applicable".

According to the Policy, the Complainant must prove that:

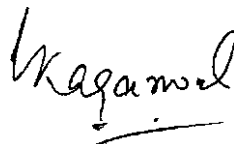
- (i) The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) The Respondent has no rights or legitimate interests in respect of the domain name that is the subject of Complaint; and
- (iii) The domain name in question has been registered and is being used in bad faith and for the purposes of trafficking;

A. Identical or Confusingly Similar

As per the whois information, the Respondent has created the disputed domain name <www.parmaham.in> on April 22, 2010. The expiration date is April 22, 2011.

According to the information submitted by the Complainant, the Complainant is the owner of several registrations of Geographical indications, trademarks and certification marks "PROSCIUTTO DI PHARMA", "PARMA" and "PARMA HAM".

The trademark and/or certification mark "PROSCIUTTO DI PHARMA" and "PARMA" are registered in many countries of the world such as, Argentina, Australia, Benelux, Chili, Croatia, Hong Kong, Iceland, Italy, Mexico, Monaco, Peru, Poland, Portugal,



Russia, Singapore, South Africa, United Kingdom, United States of America, etc. In most of these countries the registration is in class 29 - "Ham protected by the designation of origin Prosciutto di Parma; meat and charcuterie, except ham; fish; poultry; eggs; meat extracts, etc.

In India the Applications No. 164 submitted to the Registrar of Trademarks on March 26, 2009 by the Complainant for the registration of the Geographical Indication Prosciutto di Parma "Parma Ham" in Class 29 has already been advertised and is pending registration.

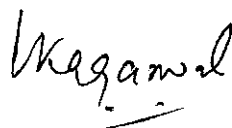
The present dispute pertains to the domain name <www.parmaham.in>. The Complainant possesses a large number of other domain names with the word "parmaham" and "prosciutto di pharma" as indicated above. The Complainant is also the owner of trademark/certification mark "prosciutto di Parma" and "Parma", etc. Most of these domain names and the trademarks/certification marks have been created by the Complainant much before the date of creation of the disputed domain name by the Respondent.

The disputed domain name is very much similar or identical to these domain names and the trademark/certification mark of the Complainant. Therefore, I hold that the domain name <www.parmaham.in> is confusingly similar to the Complainant's marks.

B. Rights or Legitimate Interests

The Respondent may demonstrate its rights to or legitimate interest in the domain name by proving any of the following circumstances:

- (i) before any notice to the Respondent of the dispute, the Respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of



a *bona fide* offering of goods or services; or

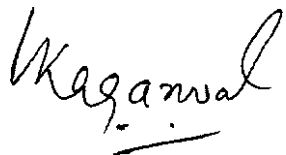
- (ii) the Respondent (as an individual, business or other organization) has been commonly known by the domain name, even if the Respondent has acquired no trademark or service mark rights; or
- (iii) The Respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent's response is not available in this case. There is no evidence to suggest that the Respondent has become known by the disputed domain name anywhere in the world. Based on the evidence adduced by the Complainant, it is concluded that the above circumstances do not exist in this case and that the Respondent has no rights or legitimate interests in the disputed domain name. Consorzio del Prosciutto di Parma is the name and mark of the Complainant. The Respondent is known by the name of Mr. Liqun Wang. It is evident that the Respondent can have no legitimate interest in the domain name. Further, the Complainant has not licensed or otherwise permitted the Respondent to use its name or trademark or to apply for or use the domain name incorporating said name. I, therefore, find that the Respondent has no rights or legitimate interests in the domain names.

C. Registered and Used in Bad Faith

Any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration or use of the domain name in bad faith:

- (i) Circumstances indicating that the Respondent 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 is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable



consideration in excess of documented out of pocket costs directly related to the domain name; or

- (ii) The Respondent 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 it has engaged in a pattern of such conduct; or
- (iii) The Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) By using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, internet users to its website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on its website or location.

The contention of the Complainant is that the present case is covered by the above circumstances. There are circumstances indicating that the Respondent has intentionally attempted to attract, for commercial gain, internet users to its web site, by creating a likelihood of confusion with the Complainant's mark. The Respondent's registration of the domain name <www.parmaham.in> is likely to cause immense confusion and deception and lead the general public into believing that the said domain name enjoys endorsement and/or originates from the Complainant.

On coming to know of registration of the disputed domain name, the Complainant sent a letter on June 16, 2010 to the Respondent demanding that the disputed domain name may be transferred to the Complainant. The letter was returned undelivered by the postal authorities. This raises question as to the veracity of the organization and contact details provided by the Respondent for the purposes of registering the disputed

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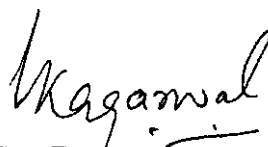
domain name

A visit to the domain <www.parmaham.in> says that "the domain parmaham.in may be for sale by its owner. More details **sedo**". A click at the said statement opens a domain <www.sedo.co.uk> which contains a description that, "domain parmaham.in is for sale. Seller's Listing Price : 10,000. EUR" It is thus clear that the Registrant is using the domain name only for sale.

The foregoing circumstances lead to the presumption that the domain name in dispute was registered and used by the Respondent in bad faith. Therefore, I conclude that the domain name was registered and used by the Respondent in bad faith.

7. Decision

In light of the foregoing findings, namely, that the domain name is confusingly similar to a mark in which the Complainant has rights, that the Respondent has no rights or legitimate interests in respect of the domain name, and that the domain name was registered in bad faith and is being used in bad faith and for the purposes of sale, in accordance with the Policy and the Rules, the Arbitrator orders that the domain name <www.parmaha.in> be transferred to the Complainant.



Vinod K. Agarwal
Sole Arbitrator

Date: 7th March 2011