



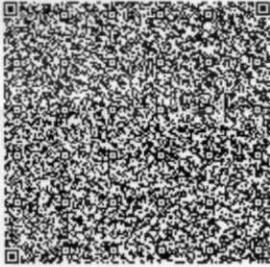
सत्यमेव जयते

INDIA NON JUDICIAL

Government of National Capital Territory of Delhi

e-Stamp

Certificate No.	: IN-DL01011703010252L
Certificate Issued Date	: 09-Apr-2013 03:54 PM
Account Reference	: SHCIL (FI)/ dl-shcil/ HIGH COURT/ DL-DLH
Unique Doc. Reference	: SUBIN-DLDL-SHCIL01501978464428L
Purchased by	: NIKILESH RAMA CHANDARAN SO U K RAMA CHANDARAN
Description of Document	: Article 12 Award
Property Description	: NA
Consideration Price (Rs.)	: 0 (Zero)
First Party	: NIKILESH RAMA CHANDARAN SO U K RAMA CHANDARAN
Second Party	: NA
Stamp Duty Paid By	: NIKILESH RAMA CHANDARAN SO U K RAMA CHANDARAN
Stamp Duty Amount(Rs.)	: 100 (One Hundred only)



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ARBITRATION CASE NO. 2 OF 2013

IN THE ARBITRATION MATTER OF:-

GENERAL MEDIA COMMUNICATIONS INC

COMPLAINANT

VERSUS

DEEPAK DAFTARI

RESPONDENT

(Signature)


AWARD

The present dispute relates to the registration of the dispute domain name <www.penthouse.in> in favour of the Respondent.

The Complainant has filed the instant complaint challenging the registration of the disputed domain name <penthouse.in> in favour of the Respondent. In pursuance to the In Domain Name Dispute Resolution Policy (INDRP) and the rules framed there-under, the Complainant had preferred this arbitration for raising this dispute for redressal of its grievances.

In its complaint, the complainant has stated that the trademark was coined and adopted in the year 1965 by Mr. Bob Guccione who was the founder and publisher of the magazine PENTHOUSE in the year 1965 and was openly and continuously used in the United Kingdom. The said trademark was applied in the United States in the year 1968 and was subsequently registered in the year 1969. The complainant states that it is registered proprietor of the trademark PENTHOUSE with registration nos. 286302 and 1308619 in India since at least as early as 1973. The complainant has filed the particulars of the Indian trademark registrations and the complainant's other trademark registrations around the world.

The complainant has further stated that its total monthly readership is approximately 1,600,000. The complainant has stated that it has over 100 trademark registrations for the PENTHOUSE trademark in the United States. It has been also stated by the complainant it considers its trade/service name/mark as an extremely valuable asset and thus in order to protect the said assets the complainant has secured trademark registration for the mark "PENTHOUSE" globally. The complainant is an international multimedia entertainment enterprise characterizing its businesses such as providing adult

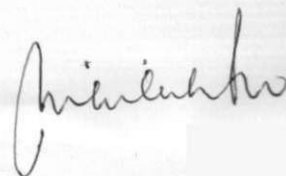


entertainment and related goods and services, the production and distribution of the videos/DVD's, Licensing (including for goods, night clubs, restaurants lounges and hotels), online services (including social networking website) and publishing (magazine including Penthouse, penthouse forum etc.) The complainant also the trademark PENTHOUSE for goods such as calendars, adult toys, apparel, shows jewelry, gifts, watches etc.

The complainant has contended in its complaint that by virtue of the prior adoption, extensive and continuous use in respect of penthouse trademarks coupled with registrations of the said trademarks, the complainant is entitled to the exclusive property rights therein, and the public at large associate the said trademarks with goods/ services offered by the complainant alone and none else. The complainant has further contended that it is also the registered proprietor of the several domain names www.penthousemagazine.com, www.penthousesex.com, www.penthouseshoes.com, www.penthouse.store.com and www.penthouseforum.com In support of its claim the complainant avers that the website www.penthouse.com is used extensively by complainants to promote and advertise its products and services. The complainant has filed the registration certificate of the domain name www.penthouse.com along –with the complaint.

The complainant avers that the websites relating to 'PENTHOUSE' trademark have been accessible to people in India and are popular amongst the relevant section of public in India. Thus the complainant is using the Penthouse trademarks in India through online shopping websites including Amazon and e-bay.

The complainant has averred in its complaint that in and around September 2012, it became aware of the registration of the disputed domain name <www.penthouse.in> in the name of the Respondent.



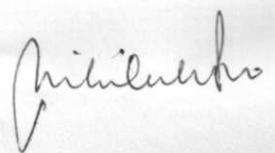
The Complainant has stated in its complaint that it served a Cease and Desist Notice dated 20.09.2012 on the respondent via Registered AD and called upon the respondent to cease and desist from offering, advertising or dealing in any similar services bearing with mark 'PENTHOUSE' and for unauthorized registration and holding of a domain name www.penthouse.in identical to that of the Complainant's domain name www.penthouse.com within 15 days of the date of receipt of the notice.

That the complainant has contended that the disputed domain name registered by the Respondent is identical or at least confusingly similar with the Complainant's domain name www.penthouse.com and is exclusively owned and used by complainant, it is reasonable to infer that respondent registered the disputed domain name with the full knowledge of the complainant's trademark. The complainant has stated that it has its presence on a worldwide basis and its trade mark 'PENTHOUSE' is well-known throughout the world. It has been stated by the complainant that the disputed domain name have been unauthorized and illegally registered with mala fide intentions to take advantage of enormous goodwill and reputation of complainant's well known PENTHOUSE trademarks.

The complainant has stated that the respondent have committed trademark infringement as per section 29(4) of the Trade Marks Act, 1999 for unauthorized use of the registered trademark and cyber squatting by registration of domain name <www.penthouse.in>.

The complainant has averred that the respondent has no legitimate interests in respect of the domain name <www.pentahouse.in>. It has been stated by the Complainant that the Respondent does not have any prior rights or legitimate interests in the 'PENTHOUSE' trademark.

On the basis of the aforesaid averments on behalf of the Complainant, the complainant has sought remedy that the domain



name<www.penthouse.in> may be transferred to the Complainant and to permanently refrain the respondent from using the domain name www.penthouse.in and any other mark which is either identical or confusingly similar to the registered trademark PENTHOUSE.

The Respondent on the other hand replied to Cease and Desist Notice on 28.09.2012 wherein the respondent have stated that the domain name www.penthouse.in was established to run its Real Estate website for dealing in Luxurious Penthouses all over India and further submitted that the word PENTHOUSE is generic word for which no one individual or corporation can claim exclusive rights of use.

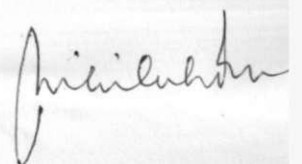
The Respondent averred that there was no infringement of Complainant's trademark as NO WEBSITE operates on the domain name Penthouse.in. The domain name Penthouse.in does not resolve to any website and hence there is no question of infringing trademark Penthouse.com.

Pursuant to such circumstances ensuing between the parties herein, the complainant referred a complaint to NIXI (National Internet Exchange of India) on January 29, 2013 for appointment of arbitrator.

The complainant in its complaint has averred that unauthorized and illegal registration of a domain name is done by the respondent on the grounds that the said act was done in for cyber squatting by the registering confusingly similar Domain name www.penthouse.in by the respondent, thereby seeking transfer of the said domain name to the complainant.

I was appointed as a arbitrator to adjudicate the dispute relating to the disputed domain name <www.penthouse.in>. I received pleading in response to the complaint from the respondent on 18.03.2013 via e-mail.

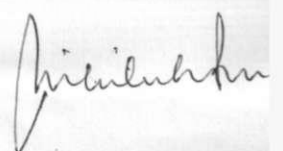
I have perused the records and have gone through the contents of both the complaint.

A handwritten signature in black ink, appearing to read 'Chinilubha', is located in the bottom right corner of the page.

Firstly I shall deal with the rights of the complainant vis-à-vis that of respondent's over the domain name <www.penthouse.in>. The mark <PENTHOUSE> is a unique and distinct word and has acquired distinctiveness and is known to be a trademark owned by the complainant. The complainant has shown its various trademark registration details from world over. Also it is not in dispute that the complainant is owner of the trademark world over and the said trademark is used by the complainant since last 50 years approximately. The said trademark is registered in India with registration nos. 286302 and 1308619 at least as early as 1973. On the other hand the respondent instead of dealing with the contentions made by the complainant has chosen to aver that he does not have any business relationship with the complainant, he has also stated that he has never tried to sell any goods and services or any kind of content on Penthouse.in. Therefore, from the records, it is seen that the complainant is the owner of the trademark penthouse and the respondent has no legitimate right over the mark "PENTHOUSE". Merely by the adding of the name '.in' in the word cannot mean to be a mark different from the registered mark. Hence, the registration of the disputed domain name <www.penthouse.in> is not legitimate.

Secondly the contention of the Respondent that the PENTHOUSE is as generic as are the words Food, Air, Water , House , Home, etc, for which no one Individual or Corporation can claim exclusive rights of use. I do not find any weight in the contention made by the Respondent since the present dispute relates to the usage of the trademark by the Respondent which has been in use by the complainant for the last 50 years.

Thirdly, I will deal with the rights of the parties to have the access and registration of the disputed domain name. The complainant has stated that it has been using the said trademark since last 50 years throughout the world and has filed the particulars said trademark in its complaint. I doubt that the



respondent was not aware that the trademark PENTHOUSE is being used by the complainant world over and India. I am of the view that the domain name was registered with mala fide intentions and in bad faith to take advantage of enormous goodwill and reputation of our Client's well known PENTHOUSE trademarks and the said domain name <www.penthouse.in> should be transferred to Complainant. It was held in **Kabushiki Kaisa Hitachi Seisakusho (d/b/a Hitachi Ltd) v. Click Consulting , Ltd., (WIPO Case no. D2007- 0809)** where the panel was of the opinion that "incorporating a widely- known trademark as domain name is a clear indication of bad faith in itself, even without considering other elements. As decided before, 'knowledge of corresponding mark' at time of registration of the domain name suggests bad faith." Therefore I am of the view that the domain was registered in bad faith.

Fourthly, after the going through the history of the complainant and the fact that the trademark PENTHOUSE is owned by the Complainant I am of the view that the disputed trademark is identical to and confusingly similar to the trademark used by the complainant. It was held in **Satyam Infoway Ltd. V. Sifynet Solutions Pvt. Ltd. [AIR 2004 SC 3540]** that "the use of same or similar domain name may lead to diversion of users which would result from such users mistakenly accessing one domain name instead of another. This may occur in e-commerce with its rapid progress and instant (and theoretically limitless) accessibility to users and potential customers and particularly so in areas of specific overlap. Ordinary consumers/users seeking to locate the functions available under one domain name may be confused if they accidentally arrived at a different but similar web site which offers no such services. Such users could well conclude that the first domain name owner had misrepresented its goods or services through its promotional activities and the first domain owner thereby lose their customers." Therefore I am of the view that the respondent is using the trademark of Complainant, in order to achieve more hits on his website which is liable to confuse the consumers and will also



lead to losses of the complainant. Hence the use of the disputed domain by the respondent cannot be treated as a non-commercial or fair one.

In view of my aforesaid inference and decision, I also restrain the respondent from transferring rights of the disputed domain name to any third party in order to avoid any further disputes in regard to penthouse.in

Considering the facts and circumstances of the present case and in view of the precedents in this context, I am of the view that the complainant has proprietary right over the trademark "PENTHOUSE". Under the facts and circumstances and on perusal of the records, I deem fit and proper to allow the prayer of the Complainant in its favour and direct the Registry to transfer the said domain name i.e. <penthouse.in> in favour of the complainant.

Parties to bear their own costs.



(NIKILESH RAMACHANDRAN)

ARBITRATOR

DATED:- 09.05.2013