

Bond



**Indian-Non Judicial Stamp
Haryana Government**



Date :23/10/2019

Certificate No. G0W2019J1066



Stamp Duty Paid : ₹ 101
(Rs. Only)

GRN No. 59196524



Penalty : ₹ 0
(Rs. Zero Only)

Deponent

Name: Rachna Bakhru

H.No/Floor : Na

Sector/Ward : Na

Landmark : Na

City/Village : Gurugram

District : Gurugram

State : Haryana

Phone : 0



Purpose : ALL PURPOSE to be submitted at All place

Ru

RACHNA BAKHRU

ARBITRATOR

Appointed by the .IN Registry – National Internet Exchange of India

In the matter of:

Trent Limited
Trent Limited Legal Department
Trent House, 10th Floor
Plot No. C-60, G- Block
Bandra Kurla Complex
Bandra (East)
Mumbai 400 051

....Complainant

Mansi Diwakar
201, Rushabh Towers, St. Braz Road
Vile Parle West
Mumbai-400056

....Respondent

Disputed Domain Name: **WWW.UTSA.CO.IN**

Rachna

AWARD

1) The Parties:

The Complainant in this arbitration proceeding is Trent Limited, a company registered and existing under the laws of India with its registered address at Trent House, 10th Floor, Plot No. C-60, G- Block, Bandra Kurla Complex, Bandra (East), Mumbai 400 051. The Complainant is represented by its authorized representative, Smriti Yadav of Khaitan & Co.

The Respondent in this arbitration proceeding is Ms. Mansi Diwakar of 201, Rushabh Towers, St. Braz Road, Vile Parle West, Mumbai 400 056 as per the details available in the Whois database maintained by National Internet Exchange of India (NIXI).

2) The Domain Name, Registrar & Registrant:

The disputed domain name is <www.utsa.co.in>.

The Registrar is GoDaddy.com, LLC (IANA ID: 146).

The Registrant is Ms. Mansi Diwakar of 201, Rushabh Towers, St. Braz Road, Vile Parle West, Mumbai 400 056.

3) Procedural History:

This arbitration proceeding is in accordance with the .IN Domain Name Dispute Resolution Policy (INDRP), adopted by the National Internet Exchange of India (NIXI). The INDRP Rules of Procedure (the Rules) were approved by NIXI on 28th June, 2005 in accordance with the Indian Arbitration and Conciliation Act, 1996. By registering the disputed domain name with the NIXI accredited Registrar, the Respondent agreed to the resolution of the disputes pursuant to the .IN Dispute Resolution Policy and Rules (the Policy) framed thereunder.

As per the information received from NIXI, the history of the proceedings is as follows:

In accordance with the Rules 2(a) and 4(a), NIXI formally notified the Respondent of the Complaint and appointed Ms. Rachna Bakhru as the Sole Arbitrator for adjudicating upon the dispute in accordance with the Arbitration and Conciliation Act, 1996, and the Rules framed thereunder, .IN Domain Dispute Resolution Policy and the Rules framed thereunder. The Arbitrator submitted the Statement of Acceptance and Declaration of impartiality and independence, as required by NIXI.

- The Complaint was produced before the Arbitrator on September 23, 2019 and the notice was issued to the Respondent on September 24, 2019 at her email address with a deadline of 10 days (i.e. October 04, 2019) to submit his reply to the Arbitrator.
- The Respondent acknowledged receipt of the Complaint on September 24, 2019 and provided her response via email on September 30, 2019 to the Arbitrator.



- The Arbitrator forwarded the reply of the Respondent to the Complainant on October 01, 2019 granting them a period of 7 days (i.e. till October 08, 2019) to file their rejoinder, if any.
- The Complainant sent their rejoinder via email on October 07, 2019 to the Arbitrator.

In view of the above, the Complaint is being decided based on materials and evidence submitted by both parties and contentions put forth by them.

4) Grounds for administrative proceedings:

Paragraph 4 of .IN Domain Name Dispute Resolution Policy provides grounds on which INDRP complaint can be filed:

- 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

5) Summary of the Complainant and Respondent's contentions:

The Complainant in support of its case has made the following submissions:

- a) The Complainant submits that the trademark "UTSA" was coined conceived and adopted by the Complainant in the year 2015 and is used at-least since 3rd November, 2016 in relation to garments for men, women and children, cosmetics, perfumes, footwear etc. The Complainant sells their products bearing the UTSA trademark through Westside stores and online marketplace www.tatacliq.com. The Complainant also has an exclusive UTSA store in the city of Pune.
- b) The Complainant states that they have secured registration for UTSA word and logo mark in class 25 vide registration nos. 3094803 for UTSA (label), 3094806 for UTSA (word mark) and 3470609 for UTSA Kids (label) and in class 35 vide registration nos. 4032025 for UTSA (word mark) and 4104527 for UTSA (label). The said registrations are valid and subsisting in the records of the Indian Trade Marks Registry.
- c) The Complainant claims to be openly, continuously, extensively using the trademark since 3rd November 2016 have generated substantial revenues in relation to the said goods and services provided under the trademark UTSA and have been spending substantial time, effort, skill and money in promoting the trademark UTSA through various media such as newspapers, magazines and also through social and digital media.
- d) As per the Complainant, the Respondent has registered the domain www.utsa.co.in which incorporates the well-reputed and registered trademark UTSA of the Complainant.



- e) The Complainant alleges that the domain name www.utsa.co.in is identical with/ similar to the prior adopted, registered and used trademark UTSA of the Complainant. The Complainant further alleges that the Respondent has incorporated the entire mark UTSA of the Complainant in the disputed domain name. The Complainant claims that such resemblance between the disputed domain name and the Complainant's registered and well known mark cannot be by any stretch of imagination considered as a mere co-incidence and that the Respondent is clearly attempting to give an impression that it has relation with the Complainant.
- f) It is also the allegation of the Complainant that the addition of the country code ".co.in" (INDIA) to the Complainant's trademark makes the resulting domain name utsa.co.in identical/ confusingly similar to the Complainant's registered trademark UTSA. The Complainant further states that it is the responsibility of the Respondent to determine whether the Respondent's domain name registration infringers or violates someone else's rights.
- g) The Complainant further states that the mark UTSA is distinctive to the goods and services of the Complainant and the Respondent does not have any reason for adopting and registering the disputed domain name which is identical to the prior adopted, registered and used trademark of the Complainant.
- h) The Complainant states that there is no possibility of the Respondent not being aware of the Complainant's trademark and its popularity at the time of registration of the disputed domain name as the Respondent is also from Mumbai where the Complainant has its principal office and has been extensively marketing its goods under the said trademark through its 15 stores located in different parts of Mumbai city.
- i) The Complainant claims that the Respondent has intentionally attempted to attract the internet users by creating a likelihood of confusion with the well-known trademark of the Complainant as to the source, affiliation or endorsement of the Respondent's website.

Respondent:

The Respondent in support of its case has made the following submissions:

- a) The Respondent through UTSA provides eco-friendly vegetable storage bags that are an alternative to plastic bags to store vegetables in the refrigerator. The concept is based on and inspired from the Vedic way of life that embodied living in tune with nature.
- b) The Respondent claims that the UTSA storage bags are available through Amazon and Flipkart since June 2018. As per the Respondent's claim the word UTSA was chosen as it has a deep connection with the Vedic philosophy which is the basis of the UTSA project. The word 'Utsa' is connected to nature in terms of its association with the water element and spring season. The word 'Utsa' is also



ruled by the Taurus sign which relates to Earth and resonates with 'Krittika' nakshatra which is ruled by the Sun.

- c) The Respondent claims that UTSA word was conceived for the project as it relates to the elements of nature and the founder has knowledge and awareness of Vedic sciences and is a follower of the same. The Respondent further claims that the logo of the project was designed based on a combination of the Devanagari alphabet 'OO', English alphabet 'U' and the number 5 which is the number of nature. The logo represents a flower which is just about to bloom, it essentially represents a feature of the spring season. As per the Respondent, the entire concept was conceived based on the Respondent's awareness of Vedic sciences and the product offering of a 'Natural vegetable storage bag'.
- d) The Respondent holds trademark rights for UTSA under class 22 in respect of "bags and sacks" through registration no. 3724475 which was filed on January 11, 2018 and granted protection on August 8, 2018.
- e) The Respondent further claims that the website clearly refers to the product 'Vegetable storage bag' and displays information on the Vedic way of life and the inspiration background. The look and feel, logo and content is very distinctive. The website title that appears on the top left of the browser when opening the website clearly states 'Natural vegetable storage bags'.
- f) The Respondent states that the Municipal Corporation of Greater Mumbai had included the Respondent's name in their list of alternative providers of plastic when the plastic ban had come into effect in Maharashtra in June 2018. Further, the Panvel Municipal Corporation (PMC) also invited the Respondent for participating in an exhibition on plastic alternatives. The Respondent has also been invited by Radio City to feature on their show showcasing 'Emerging start-ups that are making a difference to the city through an innovative concept or idea'.
- g) It is the Respondent's contention that it has not attempted to capitalize on any fame and reputation of the Complainant's trademark and also has not attempted to misappropriate any reputation of the Complainant's trademark or monetize on the same. The Respondent claims to have registered the domain name in good faith and with a righteous intention and is making fair, legitimate and honest use of the domain.
- h) It is also the contention of the Respondent that its offering is in an entirely different category of 'eco-friendly vegetable storage bag' and holds no resemblance in any way to the Complainant's product/ service.

6) Discussion and Findings:

The submissions and documents provided by the Complainant show that the trademark "UTSA" has been used by them in relation to garments for men, women and children since November 3, 2016. The Complainant sells their products bearing the UTSA trademark through Westside stores and online marketplace www.tatacliq.com. The


5

Complainant also has an exclusive UTSA store in the city of Pune which was launched in 2019. The Complainant to support their adoption and use has submitted evidences, the earliest of which being the trademark application 3094803 in class 25 applied on 5 November, 2015, thereafter the Complainant has provided an invoice dated 3 November, 2016. The Complainant, by way of **Annexure – C** has enclosed social media extracts & advertisement videos on YouTube and by way of **Annexure – G** has enclosed extracts from their website reflecting the store addresses in Mumbai. Pertinently noted by the Arbitrator and as contended by the Respondent, all materials enclosed by the Complainant as on date of application of the disputed Domain Name, show use of the mark UTSA along with the parent brand WESTSIDE specifically in respect of clothing, footwear and headgear. It is noted that the Complainant has not filed any documents to support independent awareness and reputation of the mark UTSA at the time of registration of the Domain Name by the Respondent in 2017. The Complainant has claimed that there exists a webpage for UTSA under the Complainant's website www.mywestside.com. This webpage is not the exclusive webpage under www.mywestside.com instead contains many other brands of the Complainant including UTSA.

From the documents and materials provided by the Complainant, the Arbitrator has taken into account that there was no independent use of the trademark UTSA by the Complainant until the year 2019, when the Complainant set up a store in Pune; whereas the Respondent has been selling vegetable storage bags at-least since 2018. Till then, the Complainant was using the UTSA mark only with WESTSIDE.

At this juncture, since the Complainant has not shown any evidence of use of the marks specifically in respect of bags, the Panel has laid emphasizes on the Complainant's claim that it has secured registration for the UTSA trademark in respect of services relating to "retailing of goods and merchandise including bags". However, as pointed out by the Respondent, the Complainant's application in class 35, which is pertinent for retailing of goods and merchandise including bags was applied in 2018 for application no. 4032025 and 2019 for 4104527. The Arbitrator has also perused the online records of the Trade Marks Registry and notes that the registrations have been secured on proposed to be used basis which is also a determinant, that the Complainant had not commenced use of the mark in respect of bags as on date of application of the said registrations.

I now deal with the three requisite conditions laid in paragraph 4 of the .IN Domain Name Dispute Resolution Policy which is listed below.

According to paragraph 4 of the Policy, for this Complaint to succeed in relation to the Domain Name, the Complainant must prove each of the following, namely that:

- (i) The domain name is identical or confusingly similar to a name, 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; and
- (iii) The Domain Name has been registered and is being used in bad faith



A. Identical or Confusingly Similar:

To determine the first element under the Policy, the Panel makes a typical and relatively straightforward side-by-side comparison and for this purpose determines that the disputed domain name is identical to the trademark of the Complainant.

Panel does not get into the considerations as to whether the marks are liable to cause confusion with one another since it is not relevant to the assessment under this element of the Policy.

Accordingly, the Arbitrator concludes that disputed domain name is identical to that of the Complainant and that the requirements of paragraph 4 (i) of the Policy have been satisfied.

B. Rights or Legitimate interests:

In order to satisfy requirement of INDRP Policy paragraph 4(ii), the Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. On making such *prima facie* case, the burden of proof shifts to the Respondent to provide appropriate allegations or evidence to demonstrate rights or legitimate interests in the domain name.

Paragraph 7 of INDRP Policy deals with 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 purposes of Paragraph 4 (ii) :

(i) before any notice to the Registrant of the dispute, the Registrant'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 goods or services;

(ii) the Registrant (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.

In this regard, the Respondent in support of its case has submitted sufficient evidence of use of the domain name before receiving any notice from the Registrant, including first commercial invoice dating back to 30 June 2018 and GST Registration Certificate dated 6 April 2018 which contains the trade name UTSA. The Respondent has also produced trademark registration certificate in their favour for the UTSA mark in class 22 and promotional materials related to UTSA which indicates bona fide use of the domain name prior to notice by the Complainant. In their rejoinder, the Complainant has merely


7

denied these documents without according any reasons for such denials and therefore the Panel has no reasons to doubt the authenticity of these documents.

While the Arbitrator agrees that the goods may be considered allied or overlapping in nature; however in order to answer this element, it is imperative to consider the bona fide offering of the goods by the Respondent prior to the notice by the Complainant.

The Complainant also contends that the Respondent is not known commonly by the Domain Name which clearly indicates that the Respondent does not have any legitimate rights in the disputed domain name. The Arbitrator is unable to accept this contention, since the documentary evidence provided by the Respondent has not shown use of any other name by the Respondent except for UTSA.

In view of the above submissions, in order to consider if there has been bona fide use of the Domain Name prior to the Notice, the Respondent has sufficiently proved that before the institution of the present proceedings, the Respondent has intended to use and in fact used the Domain Name in respect of vegetable storage bags.

It is well established that the Policy is not designed to address complex business disputes or broader cases of trademark infringement rather intends to address if it is a typical case of cybersquatting which does not seem in the present case. The Panel further considers the observation in the case of *Regency Furniture of Laurel, Inc. v. David Lively*, WIPO Case No. D2018-0919 which pertinently notes that to determine whether a Respondent's real world business infringes the Complainant's rights, it is not appropriate to resolve the dispute through an administrative proceeding.

Thus, the Complainant has failed to satisfy paragraph 4 (ii) of the Policy.

C. Registered and Used in Bad Faith

In order to answer this element, the Panel relies on the non-exhaustive list provided in paragraph 6 of the Policy to evidence if a domain name has been registered in bad faith:

" by using the domain name, the Respondent has intentionally attempted to attract Internet users to the Respondent's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location".

Ignoring the legal significance of the extent of the trademark rights of the Parties (a matter in which the Panel expresses no views), the Arbitrator is going to consider this allegation only with respect to diversion of internet traffic and if in practice the relevant Internet users (i.e. those likely to need to have direct dealings with the Complainant) would believe a domain name in the form of the Domain Name to be a domain name of or authorized by the Complainant.

In order to quantify diversion of internet traffic, it is imperative to consider the reputation of the Domain Name. To substantiate this, the Respondent has provided sufficient evidence to show an independent reputation of the domain name.

After much thought, and giving due consideration to the evidences put forth by both Parties, the Arbitrator concludes that more likely than not, the Respondent is an honest trader and that if its choice of name does constitute an infringement of the



8

Complainant's trademark rights, it was the result of a honest unawareness rather than a deliberate bad faith attempt to deceive. Therefore the Complainant has failed to satisfy paragraph 4 (iii) of the Policy and in these circumstances the Complaint fails.

The Arbitrator also opines that there are a number of factual matters which need to be resolved and which cannot be readily dealt by way of an administrative proceeding under the Policy.

7) Procedural defect:

As pointed out by the Complainant in their rejoinder, the Respondent has forwarded an unsigned copy of their response. In this regard, the Panel has considered the timely responses received from the Respondent though email and the surrounding circumstances to regard the lack of signatures as an oversight and exercised its discretion to take the Respondent's submissions on record and proceed accordingly.

8) Decision:

To conclude, the Panel is satisfied that the Complainant has failed to satisfy requirements of paragraph 4 (ii) and (iii) of the policy and hence the Complaint is denied.



RACHNA BAKHRU
SOLE ARBITRATOR
NIXI
INDIA

November 22, 2019