

# INDIA NON JUDICIAL

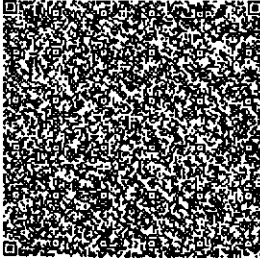
Government of National Capital Territory of Delhi



सत्यमेव जयते

## e-Stamp

Certificate No. : IN-DL018078833853620  
Certificate Issued Date : 28-Sep-2016 02:51 PM  
Account Reference : IMPACC (IV)/dl921.303/ DELHI/ DL-DLH  
Unique Doc. Reference : SUBIN-DL921303035029229939990  
Purchased by : SONAL KUMAR SINGH  
Description of Document : Article 12 Award  
Property Description : Not Applicable  
Consideration Price (Rs.) : 0  
(Zero)  
First Party : SONAL KUMAR SINGH  
Second Party : Not Applicable  
Stamp Duty Paid By : SONAL KUMAR SINGH  
Stamp Duty Amount(Rs.) : 100  
(One Hundred only)



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### BEFORE THE SOLE ARBITRATOR UNDER THE IN DOMAIN NAME DISPUTE RESOLUTION POLICY

#### IN THE MATTER OF:

BMW AG  
Petuelring 130,  
80788, Munich  
Germany

...(Complainant)

v.

Jiayi  
C/o Oversee Domain Management  
Dongchuan Rd. 50 Ruo,  
Shanghai- 200205  
China

...(Respondent)

## **The Parties**

The Complainant in this proceeding is: Bayerische Motoren Werke GmbH, is a company incorporated under the laws of Germany, with its registered office at Peteuiring 130, 80788, Munich, Germany.

Respondent in this proceeding is Jiayi, Oversee Domain Management, Dongchuan Rd. 50 Ruo., Shanghai – 200205, China

## **The Domain Name**

The disputed domain name is **WWW.BMW-MOTORRAD.IN**

## **Procedural History**

I was appointed as the Arbitrator by .IN Registry, to adjudicate upon the complaint of the Complainant, regarding the dispute over the domain name www. BMW-MOTORRAD.IN.

On 29.07.2016, NIXI sent the soft copy of the Complaint for BMW-MOTORRAD.IN to the respondent and informed that the courier containing the hard copy of the complaint and annexures has been sent to the respondent.

On 02.08.2016, NIXI informed the Tribunal and the parties that by an inadvertent error the courier relating to another domain name dispute "BMW-MOTORRAD.CO.IN" has been dispatched to the Arbitrator and the respondent.

.IN registry had supplied the hard copy of the Complaint and Annexures to me for www. BMW-MOTORRAD.IN.

On 05.08.2016, I sent an email to the parties informing them about my appointment as an Arbitrator.

In the abovementioned mail itself, I requested the Complainant to supply the copy of the complaint with annexures to the Respondent and to provide me with the details of the service record.

In accordance with INDRP read with INDRP Rules of Procedure, notice of arbitration was sent to the Respondent on 05.08.2016 with the instructions to file his reply within 15 days from the receipt of the stated email or the receipt of the copy of Complaint, whichever is later.



On 08.08.2016, Counsels/Representative of the Complainant sent the soft copy of the Complaint to the Tribunal.

On 08.08.2016, NIXI informed the Tribunal that the courier containing the Complaint and the annexures could not be delivered to the respondent due to incomplete address.

On 11.08.2016, the Tribunal stated that vide email dated 08.08.2016 of the complainant and email dated 29.07.2016 of NIXI, the soft copy of the complaint with the annexures have been duly served on the respondent. The Tribunal in the interest of justice directed the respondent to file its reply within 15 days from the receipt of this email and on its failure to file his reply within such period; the tribunal shall proceed with the matter on the basis of the pleadings and documents already on record and would pass its award.

Till the date of this award, the respondent has not filed its response to the complaint.

Apropos of the material on record before the Tribunal, this award is passed.

I have perused the entire record and all the annexures / documents.

### **Factual Background**

The following information is derived from the Complaint and supporting evidence submitted by the Complainant.

### **COMPLAINANT:**

The submissions of the complainant are briefly summarized as under:

1. The Complainant submits that it was founded in the year 1916 in Germany, and has been commonly and popularly referred to as BMW AG (BMW, being the abbreviation of Bayerische Motoren Werke).
2. The Complainant submits that it enjoys the distinction of being Germany's largest industrial companies. Since its founding 100 years ago, it has become one of the most reputed car and motorcycle manufacturers in the world along with others such as MERCEDES BENZ, TOYOTA, HONDA and GM. The complainant also submits that the automobiles manufactured by it set the highest standards in terms of aesthetics, dynamics, technology



and quality, borne out by its leading position in engineering and innovation.

3. The Complainant submits that it has been consistently ranked as among the world's largest companies. For example, as early as the year 2002, the Complainant was listed at No. 81 in the Forbes Global 2000, a comprehensive annual ranking of the world's largest companies. It continued to be featured in this prestigious list in the year 2008, coming in at No. 112. In the years 2014 and 2016, it was ranked at No. 45.
4. The Complainant submits that it operates on a global scale, and does business in more than 150 countries worldwide, including in India. The Complainant further submits that its worldwide distribution network currently consists of more than 3250 dealerships which sell automobiles and other goods. It is also submitted that as of December 31, 2015, the Complainant's production network comprised a total of 30 locations in 14 countries, including India and as of December 31, 2015, the Complainant had a work force of 122,244 employees worldwide. The Complainant has set up sales subsidiaries in more than 35 countries around the world, including India.
5. The Complainant submits that it has used the trade mark BMW and trademarks that incorporate the BMW mark consistently and extensively since the year 1916. During the 100 year period during which the Complainant has used the BMW Marks, these marks have been used on cars, motorcycles and other goods, including, parts and fittings of cars and motorcycles, miniature cars, clothing and luggage; in connection with services offered by the Complainant, including, retail store services and financial services; in the Complainant's advertising; on its Internet web sites such as [www.bmw.com](http://www.bmw.com) and [www.bmw.in](http://www.bmw.in); on social media and in other ways. It is also submitted that owing to their prominent and ubiquitous use, the BMW Marks are synonymous with the Complainant and no one else.
6. The Complainant submits that over the years, the Complainant's revenues have shown significant increases. As early as 2003, the Complainant's annual revenue exceeded EURO 40,000 million. It is also submitted that the Complainant's advertising has, and continues to, consistently display the BMW Marks. The Complainant further submits that it invests large



amount of resources in advertising and publicizing its goods and services and that in the year 2003, the Complainant spent more than EURO 1,000 million in advertising its goods and services under the BMW Marks. It is further submitted that the complainant advertises the BMW Marks through various media including, but not limited to, print and television and that the marks have received extensive media coverage over the years in renowned publications that have a worldwide circulation and on the Internet.

7. The Complainant submits that it owns registrations for the BMW Marks in many countries and jurisdictions, including in India, the United States, the European Union, Singapore, Hong Kong, Australia and others and that the BMW Marks are registered in more than 140 countries around the world, including India.
8. The Complainant submits that in the year 1996, the Complainant registered the domain name BMW.COM and for many years, this domain name has resolved to an active website. This web site is well-known to customers, the trade and other segments of the public. The BMW Marks are prominently displayed on this web site.
9. The Complainant submits that it manufactures not only cars, but also motorcycles and that it has manufactured and sold motorcycles under the BMW Marks since the early 1900s. It further submits that it uses the mark BMW MOTORRAD in relation to its motorcycles. It is submitted that MOTORRAD is the German word for "motorcycles" and that for a consumer living in India, the word "motorrad" does not have any generic or descriptive connotation. In fact, consumers in India will construe the word "motorrad" as a coined, and, consequently, highly distinctive term.
10. The complainant submits that the has registered the mark BMW MOTORRAD in numerous countries and jurisdictions around the world, including India, Germany, the European Union, the United States of America and others. The earliest German registration for the mark BMW MOTORRAD dates back to December 10, 1917 and the earliest United States registration dates back to May 30, 2005. It also submits that the Complainant has sought registration of the mark MOTORRAD in the United States. It further submits that has registered the top-level and country-code top-level domain names such as BMW-MOTORRRAD.COM, BMW-



MOTORRAD.COM.AU, BMW-MOTORRAD.CA, BMW-MOTORRAD.DE, BMW-MOTORRAD.JP, BMW-MOTORRAD.CO.NZ and BMW-MOTORRAD.CO.UK.

11. The complainant submits that the Complainant set up a wholly-owned subsidiary in India named M/S BMW India Private Limited in the year 1997. This wholly-owned subsidiary manages the Complainant's business operations in India. It further submits that in the year 2007, it set up an assembly plant in Chennai, India. The primary function of this assembly plant is to assemble automobiles that bear the BMW Marks and supply them to regional markets. It is also submitted that presently the Complainant has sales offices in numerous Indian cities, including, Delhi, Gurgaon, Bangalore, Hyderabad, Chennai, Mumbai, Kolkata, Chandigarh, Kochi, Indore, Nagpur, Raipur and Ahmedabad.
12. The complainant submits that it has sold approximately 50,000 cars bearing the BMW Marks during the period 2007-2014. It further submits that it has enjoyed significant commercial success and witnessed numerous milestones in India such as CNBC- Auto Car Award for 'Best Premium Car in the year 2008, NDTV Profit Car and Bike award for 'Design of the year' in the year 2009, AutoBild Golden Steering award for the 'Import Luxury Car of the year' in the year 2010, Business Standard Motoring Car and Bike Award for 'Premium car of the year' in the year 2011, TopGear award for 'Car of the year' in the year 2012 etc.
13. The Complainant submits it has sponsored many important and widely advertised events to promote the BMW brand experience in India. An example of this is the BMW India Bridal Fashion Week 2014, in which many celebrity designers participated and many Bollywood celebrities walked the ramp. It also submits that in 2012, the renowned cricketer, Sachin Tendulkar, was appointed as the Complainant's brand ambassador in India and that Mr. Tendulkar has an immense fan following in India and his appointment as brand ambassador has contributed to the fame of the BMW Marks in India. It further submits that in February, 2015, Mr. Tendulkar launched the Complainant's new range of automobiles under the BMWi8 mark.
14. The Complainant submits that it owns numerous registrations for the BMW Marks covering a broad spectrum of goods and services, including Classes 7, 9, 12, 25, 28, 36, 37 and 39 in India and that its earliest



Indian registration for the BMW Mark, namely, Registration No. 173509, dates back to the year 1956.

15. The Complainant submits that on November 13, 2002, the Complainant registered the domain name BMW.CO.IN and on February 14, 2005, the Complainant registered the domain name BMW.IN.
16. The Complainant submits that the BMW Marks have developed a stellar reputation owing to the Complainant's extensive and continuous use all over the world and this reputation has spilled over into India. It also submits that the BMW Marks qualify as 'well-known trademarks under Article 6bis of the Paris Convention. Consequently, the BMW Marks are entitled to a broad scope of protection extending to those goods and services that are not similar to those for which the marks are registered. The Complainant submits that it has continuously and extensively used the BMW Marks in India. Owing to such use, Indian consumers associate the BMW Marks solely and exclusively with the Complainant and its high quality goods and that BMW Marks have become well-known owing to extensive and continuous use within India and qualify as 'well-known trade marks', as envisaged by Section 2 (l)(zg) and Section 11(6) of the Trade Marks Act, 1999.
17. The Complainant submits that it has used the BMW MOTORRAD mark in India for many years. In fact, the Complainant's motorcycles are sold in India through Navnit Motors, the Complainant's authorized importer in India and that the complainant has obtained a registration for the BMW MOTORRAD mark in India. This registration, namely, Registration No. 1497996, is dated October 19, 2006 and is valid and subsisting.
18. The complainant submits that the disputed domain name, BMW-MOTORRAD.IN, resolves to a web site that has links to third party websites and that on clicking on these links, a user is taken to third-party web sites, including the web sites of entities that sell motorcycles. It is also submitted that the web page also states that the domain name is available for sale and that the home page has a link entitled "bmw-motorrad.in is for sale." On clicking on this link, a user is taken to a page on which users can submit bids to purchase the disputed domain name through Domain Sponsor. There is no limit set for the bids.

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19. The complainant also submits that upon learning of the registration of the domain name BMW-MOTORRAD.IN, instructed its Indian representative to send a letter to the Registrant to demand that the disputed domain name be transferred to the Complainant without any monetary consideration. The complainant further submits that the registrant is a habitual cyber-squatter who has registered domain names that incorporate third-party marks, some of which are known all over the world. Some of these domain names are G-STAR.IN and KOREANAIR.IN. As per the WHOIS records, the Registrant has listed these domain names for sale.

### **RESPONDENT**

1. Respondent in this proceeding is Jiayi, Oversee Domain Management, Dongchuan Rd. 50 Ruo., Shanghai – 200205, China
2. The respondent has failed to file his say /reply to the Complaint of the Complainant within the stipulated time nor has he communicated anything on the complaint till the date of this award.

### **Parties Contentions**

#### **i) Complainant**

The Complainant contends as follows:

- a. The Respondent's domain name is identical and / or confusingly similar to the Complainant's Trade Mark(s).
- b. The Respondent has no rights or legitimate interest in respect of the domain name.
- c. The Domain Name was registered and used in bad faith.

#### **ii) Respondent**

The Respondent has failed to file any reply to the Complaint and thus has not rebutted the contentions made by the complainant.





**Discussions and Findings:**

Rule 8 (b) of the INDRP Rules of Procedure provides that *"In all cases, the Arbitrator shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case"*.

Therefore, the proceedings have been proceeded with in accordance with the aforementioned provision of the act.

Rule 12 (a) of the INDRP Rules of Procedure provided that *"An Arbitrator shall decide a Complaint on the basis of the statements and documents submitted to it and in accordance with the Arbitration and Conciliation Act, 1996, Dispute Resolution Policy, the Rules of Procedure and any bye-laws, rules and guidelines framed thereunder and any law that the Arbitrator deems to be applicable"*

In these circumstances, the decision of the Arbitrator is based upon the statements and documents submitted before the Tribunal.

Having perused the submissions and documentary evidence placed on record, the Complainant has proved that it has statutory and common law rights in the mark "www. BMW-MOTORRAD.IN".

Further, the Arbitrator is of the view that the Complainant has satisfied all the three conditions outlined in the paragraph 4 of .IN Domain Name Dispute Resolution Policy, viz.

- (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.

**i. The Domain name is identical or confusingly similar to a name, trade mark or service mark in which Complainant has rights.**

- a) The Complainant submits that Complainant owns registrations for the BMW Marks, including the BMW MOTORRAD mark and the MOTORRAD mark, in various countries and jurisdictions around the world, including in India and it has used the BMW Marks, including the BMW MOTORRAD



mark, for a number of years around the world, including in India. The Complainant also submits that the Registrant has registered the disputed domain name in the year 2012 and that the Complainant's rights in the BMW Marks predate registration of the disputed domain name by the Registrant.

- b) The Complainant submits that the disputed domain name BMW-MOTORRAD.IN is identical to the BMW MOTORRAD mark and confusingly similar to the BMW Marks. The domain name, BMW-MOTORRAD.IN, incorporates the BMW MOTORRAD/BMW marks in its entirety.
- c) The complainant submits that the .IN is a country code and non-distinctive. It is an essential part of every domain name. Thus, the .IN part of the domain name does nothing to distinguish the disputed domain name from the BMW Marks. The complainant also places reliance on Wells Fargo & Co. and others v. Sree Das Kumar, INDRP/666 (June 5, 2015).

The above submission of the Complainant has not been specifically rebutted by the Respondent, as such they are deemed to be admitted by him.

Thus, the above facts and annexures establish that the domain name of the Respondent is confusingly similar and identical to the mark of the Complainant. Even otherwise the above facts and the perusal of the domain name of the respondent clearly establish that the domain name of the respondent is similar and identical to the mark of the complainant.

**ii. The Registrant has no rights or legitimate interests in respect of the domain name.**

According to the paragraph 7 of the .IN Dispute Resolution Policy, the following circumstances show Registrants rights or legitimate interest 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 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.*
- a) The Complainant submits that the Registrant is not commonly known by the domain name, nor does the Registrant actually engage in any business or commerce under the names BMW or BMW MOTORRAD. It further submits that the Registrant is not known to the public under the names BMW or BMW MOTORRAD and this is evidence of the Registrant's lack of rights or legitimate interests in the disputed domain name. The complainant relies on *FMTM Distribution Limited v. Bel Arbor, INDRP/681* (17 June 2015).
  - b) The Complainant submits that the Registrant does not have any statutory or common law rights or any legitimate interest in the disputed domain name because the domain name incorporates the Complainant's mark BMW/BMW MOTORRAD. The Complainant submits that it has sole and exclusive prior rights in the BMW/BMW MOTORRAD marks that have become well-known owing to the Complainant's efforts, and are associated solely and exclusively with the Complainant and that the Registrant, on the other hand, does not own any trade mark registration for BMW/BMW MOTORRAD marks. Furthermore, there is no evidence of use of the BMW/BMW MOTORRAD marks by the Registrant. The Complainant relies upon *Jaguar Land Rover Ltd. v. F.C. Huang INDRP/655* (March 24, 2015).
  - c) The Complainant submits that the BMW/BMW MOTORRAD is not part of the Registrant's personal name. A copy of the WHOIS record associated with the disputed domain name shows that the Registrant's name is Jiayi and that the Registrant cannot be known as BMW/BMW MOTORRAD or his/her name cannot incorporate the BMW Marks. This is also evidence of the Registrant's lack of rights or legitimate interest in the disputed domain name.



- d) The Complainant submits that the Registrant is not a licensee of the Complainant, nor has the Complainant authorized the Registrant to use the BMW Marks or to register the disputed domain name. In fact, the Registrant has no relationship with the Complainant.
- e) That the Complainant submits that the Registrant also does not have any rights or legitimate interest in the disputed domain name because the domain name resolves to a web site that displays links to third-party web sites and this is not legitimate non-commercial or fair use because the Registrant is attempting to generate revenue from consumers who mistakenly visit the web site believing that it is the Complainant's web site. The Complainant relies upon *Aerogroup International LLC v. Yin Yanxiao*, INDRP/690 (29 July 2015).
- f) The Complainant submits that the registrant's lack of rights and legitimate interest is also evident because the Registrant has offered to sell the disputed domain name through Domain Sponsor. It also submits that there is no monetary limit set for the bids and thus, the Registrant is attempting to attract the highest possible bid. This is evidence of no rights or legitimate interests in the domain name. The Complainant relies upon *Microsoft Corporation v. Juergen Thirds* Claim No. FA 1307001509789 (August 25, 2013).
- g) The Complainant submits that the illegality of the Registrant's registration of the disputed domain name arises from the fact that, today, domain names are part and parcel of a company's corporate identity. The Complainant also submits that the Complainant has a history of registering country-code top-level domain names that include its BMW/BMW MOTORRAD marks, and is using some of these domain names to resolve to active web sites that feature its goods and services offered under these marks. Thus, by registering the disputed domain name, the Registrant is preventing the Complainant from using the disputed domain name for the intended purpose.

The above submission of the Complainant has not been specifically rebutted by the Respondent, as such they are deemed to be admitted by him. Even otherwise the above facts and annexures attached with the Complaint establish that the Respondent has no right or legitimate interest in the disputed domain name under INDRP paragraph 4(ii).



**iii. The Registrant domain name has been registered or is being used in bad faith**

- a) The Complainant submits that the Registrant has offered to sell the disputed domain name through Domain Sponsor and that there is no monetary limit set for the bids. Clearly, the Registrant is attempting to attract the highest possible bid. This is evidence of the Registrant's bad faith.
- b) The Complainant submits that the registrant is a cyber-squatter. Cyber-squatting is evidence of bad faith. The Complainant relies upon *Accor v. Xu Xiantao*, INDRP/692 (August 24, 2015).
- c) The Complainant submits that it is clearly more than a coincidence that the Registrant chose and registered a domain name that is identical/confusingly similar to the BMW Marks. It also submits that the Complainant has a long and well established reputation in the BMW Marks through its exclusive use throughout the world, including in India. The Complainant further submits that there can be no doubt that the Registrant was aware of the BMW Marks when he chose and registered the disputed domain name, and in fact chose the domain name because it was confusingly similar to the BMW Marks, and intended to capitalize on that confusion. This constitutes evidence of bad faith. It relies upon *Disney Enterprises Inc. v. Registrant ID: DI\_7305075*, INDRP/596 (17 June 2014) wherein has been held that registration of a domain name that incorporates a well-known mark by an entity that has no relationship to the owner of the mark is in itself evidence of bad faith.
- d) The Complainant submits that the disputed domain name was registered in 2012 and that since registration the Registrant has not used the domain name in connection with any legitimate business. It further submits that the Registrant registered the domain name with the intention of depriving the Complainant from using the domain name in connection with its business in India and this demonstrates the Registrant's bad faith.
- e) The Complainant further submits that the Registrant registered the disputed domain name in 2012 and, since then, it has been holding the domain name without a proper website related to Registrant's products or services.



- f) The Complainant submits that the Registrant's use of the disputed domain name is bound to lead to confusion and deception in the minds of the public. It is further submitted that the BMW Marks have been used extensively by the Complainant and understood by consumers, including those in India, as marks that identify the Complainant's goods and services. On account of the high reputation attributable to the BMW Marks, use of the disputed domain name would lead to confusion and deception in the trade.
- g) The Complainant submits that its goods and services under the BMW Marks are offered in various countries, including in India. To facilitate consumer access to these services, the Complainant has registered domain names such as BMW-MOTORRAD.COM. It is also submitted that by registering the disputed domain name, the Registrant is preventing the Complainant from using the BMW-MOTORRAD.IN domain name in connection with its goods and services for consumers in India. This is not evidence of good faith use of the disputed domain name.
- h) It is submitted by the Complainant that the Registrant uses the disputed domain name in connection with a web site on which it provides links to web sites, including, through which goods similar to the goods on which the BMW Marks are sold. Thus, the Registrant is generating revenue or attempting to generate revenue through consumers who visit this web site. This is evidence of the Registrant's bad faith registration and use.

All above submissions made by the Complainant have not been rebutted by Respondent, as such they are deemed to be admitted by him. The fact that the Registrant has offered to sell the disputed domain name is a clear indication of his registration and use in bad faith. Even otherwise the unrebutted facts and annexures give no reason to doubt that the respondent has registered and used the domain name in bad faith. This issue is decided accordingly.

## **DECISION**

In view of the above facts and circumstances, it is clear that the Complainant has succeeded in its complaint.



NIXI is hereby directed to transfer the domain name of the Respondent i.e. - www.BMW-MOTORRAD.IN to the Complainant. In the facts and circumstances of the case no cost or penalty is imposed upon the Respondent. The Award is accordingly passed on this day of 06<sup>th</sup> October, 2016.



**Sonal Kumar Singh**

**Sole Arbitrator**

**Date: 06<sup>th</sup> October, 2016**