



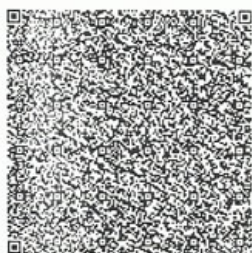
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INDRP ARBITRATION
THE NATIONAL INTERNET EXCHANGE OF INDIA [NIXI]

ADMINISTRATIVE PANEL DECISION
Ducati Motor Holding S.p.A V Abhishek Chordia <www.Ducati.co.in>
SOLE ARBITRATOR: ANKUR RAHEJA, FCS LLB MCA

A. Raheja

Statutory Alert:

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In the matter of:

Ducati Motor Holding S.p.A.

Via Cavalieri Ducati 3,
40132 Bologna, Italy,
India

Complainant No 1

And

Ducati India Pvt Ltd

BB-71A, East Shalimar Bagh,
New Delhi - 110088
India

Complainant No 2

Versus

Abhishek Chordia

12-B, Takht-e-Shahi Road,
Jaipur, Rajasthan - 90069
India

Respondent

ARBITRATION AWARD

Disputed Domain Name: Ducati.co.in

1. The Parties:

- 1.1.** The Complainant in this arbitration proceedings is: **Ducati Motor Holding S.p.A**, a Company having its registered office at Via Cavalieri Ducati 3, 40132 Bologna, Italy and also Ducati India Pvt Ltd, having registered office at BB-71A, East Shalimar Bagh, New Delhi - 110088,

India, represented by Adv. Rahul Beruar of M/s Clasis Law, Barakhamba Road, New Delhi - 110001.

- 1.2.** The Respondent in this arbitration proceeding is **Mr Abhishek Chordia** of 12-B, Takht-e-Shahi Road, Jaipur, Rajasthan - 90069, India represented by Adv. S.A. Gundecha, Chatushringi Road, Pune - 411016.

2. The Domain Name and the Registrar:

- 2.1. The Disputed Domain Name is **<ducati.co.in>**, created on 11th December 2007.

- 2.2. Domain Registrar is Net4India, New Delhi.

3. Procedural History:

- 3.1. Arbitrator received an email, inquiring if Nixi can avail of its services as an arbitrator for the dispute pertaining to the domain name **<ducati.co.in>**. Arbitrator confirmed availability and sent the signed Statement of Acceptance and Declaration of Impartiality and independence as required by rules.

- 3.2. The .IN Registry appointed Ankur Raheja as the sole Arbitrator on 21 November 2016 and Arbitrator received the hard copy of the Complaint along with Annexures on 22 November, 2016.
- 3.3. Arbitral Proceedings commenced on 24 November 2016 by issue of a notice by the Arbitrator by email to the Respondent email IDs - chordia@msn.com and postmaster@ducati.co.in, directing Respondent to file his response to the Complaint by 05 December 2016, which was successfully delivered on the WHOIS Email ID. But in terms of INDRP rules, the email was also additionally marked to postmaster@ducati.co.in.
- 3.4. In the meantime, Nixi served soft copy of the Complaint with Annexure, while the hard copy of the same was dispatched through courier on 21st November 2016, to the WHOIS address of the Respondent.
- 3.5. On 26 November 2016, the Respondent's Advocate tried to enter the proceedings without production of any authority letter and also complained as to non-receipt of the copy of the complaint and asked for re-fixing of 05 December timeline to a later date. The concerned lawyer for the Respondent was asked to first produce his authority to represent

in the matter and he was also updated as to the status of the service of complaint, as the soft copy was already served on the Respondent.

- 3.6. That the Respondent submitted brief response on 03 December 2016 without giving up the right to file further detailed response, if required. Further, submitted that he has appointed Adv S.A. Gundecha as his advocate for the proceedings. Additionally, the Vakalatnama in original was received by post.
- 3.7. That Respondent was asked to provide a proper detailed response as he was bound by the INDRP Policy and the rules thereunder, in terms of Section 11 of the Domain Registrant Agreement. Therefore, on 05 December 2016, the Respondent emailed seeking 4 weeks time for filing of response. But only 10 days till 15 December 2016 was granted, which was almost 3 weeks since the commencement of the proceedings on 24 November 2016.
- 3.8. That on 06 December 2016, an email was received from the Registrar for the Disputed Domain Name by Nixi, seeking clarifications as to status of the Domain Name. Arbitrator also emailed explaining about the INDRP proceedings. The said enquiry by Registrar was issued as a result of

matter raised with the Registrar by the Respondent questioning as to why the Domain has been put on hold, the registrar's email read.

3.9. That on 08 December 2016, Nixi informed that the courier sent by NIXI to the respondent address (containing the hard copy of the complaint and the annexures) has been returned yesterday to NIXI office by DTDC. That Arbitrator wrote to the Respondent asking for alternative address, so that courier could be delivered and also demanded an ID proof in support. In response Respondent asked for the courier to be resent at the same address and asked for the consignment number so that he can coordinate with the courier company and the same was complied with by Nixi and the consignment number was shared. As a result, the hard copy of the Complaint was successfully delivered to the Respondent.

3.10. That on 15 December, Respondent emailed asking for further time to file response till 27 December 2016 for filing of response. Arbitrator asked him to first list out proper justifiable grounds or explain the circumstances for delay in the same. To which the Respondent replied as follows:

"Dear Mr. Raheja

Thank you for your mail.

We are in the process of retrieving records from archive and also missing information from the registrar.

Kindly grant us until 23rd December and we will positively have the needful done.

Sincere regards

Abhishek"

- 3.11. That Arbitrator granted him till 23rd December 2016, as per their request, considering their submissions as to time taken in searching for further evidence in support of their response.
- 3.12. That on 23 December 2016, that is on the 30th day of the proceedings, the Respondent instead of filing a proper response, filed objections under section 12 and 13 of the Arbitration and Conciliation Act, 1996 and again requested for further time to file detailed reply. Also Respondent sent a reminder on 26 December 2016 by including new statements, while Arbitrator was already in the process of sending the response.

3.13. The Arbitrator responded on 26 December 2016 stating that the objections have no substance and are not tenable, interalia, citing a Hon'ble Delhi High Court judgment in the matter of Stephen Koeing vs Arbitrator Nixi And Anr. decided on 2 November, 2015 [FAO (OS) 42/2012], laid down as follows:

"This Court notes that the INDRP mechanism of dispute resolution through arbitration would fall within the description of an arbitration agreement under Section 7 of the Arbitration and Conciliation Act, 1996."

3.14. Arbitrator in his response also stated that this was the third opportunity provided to the Respondent to file the Response, as follows:

3.14.1. *Initial timeline set for response was 05 December 2016.*

3.14.2. *Extended till 15 December 2016.*

3.14.3. *Finally to 23 December 2016, on an assurance from your side.*

And it was only possible further to provide for detailed response as requested again, subject to payment of costs of Rs 5,000 with a strict timeline.

3.15. That Respondent further replied on the 5th day i.e. 31 December 2016, without having any regard to the summary procedure being followed

under the INDRP policy. He agreed to pay the costs and asked for further two weeks time for filing of reply, in case arbitration proceedings are to continue.

3.16. That Arbitrator on 01 January 2017, asked Complainant to respond to the Respondent's request seeking more time and submit in response to the INDRP proceedings till date, by 05th January 2017. The Complainant filed his response within the timeline of 05th January 2017. The Complainant was not provided any previous opportunity as INDRP rules provide for the INDRP proceeding to be handled in an expedite manner and to be decided in maximum of 60 days normally.

3.17. The Complainant's Response to the proceedings till 31 December 2016, was as follows (*extract*):

- That even after a lapse of approximately 45 days from the date of service of complaint, the Respondent has till date failed to file any response on merits or even adduce a single piece of documentary evidence to counter the averments and claims made by the Complainants in the present proceedings. The Respondent has merely indulged in questioning the jurisdiction of the Hon'ble Arbitral Tribunal and the learned Arbitrator to entertain and decide the present dispute.

- Additionally, despite seeking further time repeatedly on four instances within a span of month and half, and being well aware that the present proceedings are summary proceedings, the Respondent has failed to file a proper response addressing the contentions and averments made in the complaint thus not adhering to the extended timelines as well. Furthermore, the Respondent has been changing its stance with every email communication as it challenges the jurisdiction of the Hon'ble Arbitral Tribunal and simultaneously keeps seeking further time to file a proper response to the complaint.
- It is further submitted that the Respondent's conduct has been negligent from the time of initiation of proceedings including non-filing of the correct address, non-filing of ID proof in support of the WHOIS details despite repeated requisitions, inter alia. Furthermore, the grounds for seeking extensions are also vague, frivolous and baseless such as non-receipt of the hard copy of the complaint, retrieving documents from archives and other information, unfounded allegations of impartiality, repeated and unsubstantiated challenges to the jurisdiction, despite categorical dismissal of these objections.

3.18. The submissions of the Complainant were considered but it seemed appropriate, in the interest of justice, to provide a final opportunity to the Respondent to respond to the Complaint and the same were granted subject to payment of costs of Rs 5,000/-. Therefore, timeline till 16 January 2017 was provided, as 60 days time period was to complete on 22 January 2017. That is, if the Respondent was not interested in responding at least the proceedings could be completed well in time by rendering the INDRP decision. Therefore, more time could not be provided to the Respondent, and in any case, they themselves were responsible for the delay in the proceedings, so far.

3.19. That the Respondent again did not respond immediately as to whether they are filing a response or not but on the last day, i.e. 16 January 2017 morning Respondent emailed from WHOIS ID, that they have paid the costs of Rs 5,000 to the Complainant and showed unavailability of their Advocate, while communicated that Response will be filed till 21st January 2017. But Arbitrator strictly communicated to the Respondent immediately upon the WHOIS Email ID that before paying costs Respondent could have asked for permission, as they have no right to extend the timeline all by themselves as per their convenience. Moreover, when it was clearly provided that this is the last opportunity for responding to the matter, when the Respondent have already failed

to file the response on three previous occasions. And the timeline is 16th January 2017 midnight only, as proceedings cannot accommodate more time and asked them to provide for the Bank Details for reversal of costs, in case they fail to file reply on the said date. But Respondent did file the response on 16th January 2017 itself before midnight.

- 3.20. At this stage, in the last few emails and also during payment of costs, the Complainant tried to mislead the proceedings by using name as Mr Ashish Chordia, i.e. previous owner of the domain name, though emailing from the WHOIS Email ID and was appropriately warned.
- 3.21. The Response was taken on record, pending filing of affidavit in support due to the summary nature of the proceedings. And an opportunity was granted to the Complainant, very next day, to file the rejoinder by 27th January 2017. While in the meantime, the hard copy of the Response along with Affidavit was received by post on 25th January 2017 only.
- 3.22. Complainant's representative filed the Rejoinder within the provided timeline, and was further directed to file the hard copy of the same, along with affidavits supporting the rejoinder and the Complaint. But due to unavailability of the Complainants, the affidavit was delayed and they were allowed to file the same later. Therefore, the matter was

proceeded with, an opportunity was provided to both the parties to file written arguments in maximum of two pages, by 13th February 2017, pending the affidavit to expedite the proceedings. The Complainant filed the Arguments in time as always, while the Respondent again sought further 7 days time to file written arguments with unnecessary explanations in order to mislead the proceedings, but only time till 15 February 2017 was provided to the Respondent, as the 90 days timeline for completion of the proceedings was approaching.

3.23. The Complainant No 2 filed the Affidavits on 14th February 2017 but as regards Complainant No 1, the Complainant submitted *"Complainant No. 1 being an Italian entity, is in the process of getting their affidavits notarised and legalised as it takes about a month's time for an affidavit to be stamped as per their local laws."* But with the approaching 90 days timeline, it was not possible to provide any further time but to waive the requirement for the same. While the Affidavit for the Complainant no 2 was taken on record in support of both the Complaint and the Rejoinder and the said matter was represented jointly by the Complainants.

3.24. Due to Respondent's late filing of proper response in these INDRP proceedings, finally on 16 January 2017, while the notice was issued on 24 November 2016. The 60 days timeline for INDRP decision (from the

date of commencement of Proceedings) had to be extended by another 30 days in terms of Para 5(c) of INDRP Rules of procedure. And the procedural formalities continued till 15 February 2017, when the written arguments were submitted by the parties. The extended 30 days period were to end on 21 February 2017 in terms of Para 4(c) of INDRP Rules of Procedure.

- 3.25. Personal hearing was requested by the Respondent at an early stage during the INDRP Proceedings but no request was ever made by the Complainant. In any case, the INDRP Rules of procedure provide for maximum of two hearing that can be granted in exceptional circumstances. Therefore, it was more appropriate to consider the request for hearing at the later stage, only if time could permit given the 60 (+30 maximum) days timeline to complete the INDRP proceedings. But the said proceedings continued till 15 February 2017, while the award was to be pronounced by 21 February 2017. Moreover, the Respondent themselves had delayed the proceedings by seeking more and more time for filing on various instances. Lastly, it doesn't seem to be an exceptional case, where an opportunity could have been re-considered as Respondent has already not filed a response as expected in a Domain Dispute proceedings that could have included a specific reply to the three INDRP conditions.

3.26. The language of these proceedings is in English.

4. **Factual Background:**

The Complainant submits as follows:

4.1. Complainants are the leading manufacturers of the world's most attractive sports-inspired motorcycles. Complainant No 1 is a sole shareholding company - an AUDI Group Company based out of Italy and its inception and history can be traced back to as early as 1926. The trading style of '**DUCATI**' was adopted in the year 1926 when three Cavalieri Ducati brothers along with their father Antonio Cavalieri Ducati founded the '**Società Radio Brevetti Ducati**' in Bologna, Italy.

4.2. The word **DUCATI** is the surname of the founders of Complainant No 1 and has always formed a very essential part of the trading style of the Complainant as well as its sister concerns across the world. Further the trademark '**DUCATI**' is the house mark of Complainant No 1 and any product bearing the said mark invariably denotes that the said product has been sourced from Complainant No 1 and none else.

- 4.3. Complainant No 1 further submits that originally established with the aim of producing industrial components for the growing field of radio transmissions, based on Adriano Ducati's patents, the company Società Radio Brevetti Ducati manufactured its first product, the Manens condenser for radio equipment, rapidly followed by others, and was extremely successful throughout the world. This allowed Società Radio Brevetti Ducati to expand by leaps and bounds, and won itself the respect of the international industrial community. Subsequently, post World War II, DUCATI brothers ventured into the automotive sector and in March 1946, the predecessor of complainant No 1 launched Cucciolo, the first motorcycle produced under the DUCATI brand - the small auxiliary motor for bicycles destined to become the most famous in the world.
- 4.4. In a very short time, the Cucciolo became the real miniature motorcycle and as is well known it was the success of the Cucciolo, and that of its descendants, that led Complainant's **"DUCATI"** to become affirmed trademark in the mechanical sector. Since then, Complainant No 1 has established an envious reputation for itself in the automotive sector under the **"DUCATI"** trademark and trading style. By manufacturing sinuous, seductive bikes with a permanent, timeless quality that sets an unsurpassable standard, Complainant No 1 has expanded exponentially and established its presence in over 60 countries across the globe so far.

Complainant No 1 has till date successfully launched a hugely successful range of motorcycles under the “**DUCATI**” trade mark which is divided into different model families and covers several market segments, catering to a huge customer base. Further, in addition to the motorcycles, Complainant No 1 also manufactures and markets under its proprietary trademark “**DUCATI**” an extensive range of associated accessories, technical and Lifestyle apparel such as jackets, t-shirts, belts, caps, gadgets, glasses and more.

- 4.5. Well-known trademark “**DUCATI**” Internationally have enjoyed since the very Inception and continue to enjoy an unparalleled and envious reputation in respect of bikes in India as well. While Complainant No 1 has established direct physical presence in India by incorporating Complainant No 2 - Ducati India Private Limited in the year 2014, the bikes and accessories under its brand “**DUCATI**” have already acquired distinctiveness and popularity amongst consumers in India as the products have been made available by Complainant No 1 in India through its exclusive network of dealerships. Complainant No 1 had entered into an exclusive distributor agreement with Precision Motor India Private Limited - an Indian company in the year 2007. Precision Motor made available Complainant No 1’s bikes and accessories under the “**DUCATI**” brand in India from 2007 to 2013, whereafter

Complainant No 2 has been directly involved in the business of distributing brand "**DUCATI**" and the products in India. Further, the numerous victories registered by Complainant's bikes, both in the World Superbike and MotoGP World Championships have further contributed to the popularity of the "**DUCATI**" brand *per se*. Participations and victories at multiple instances have led to extensive media coverage of the Complainants and their motorcycles under the "**DUCATI**" brand and have, therefore, contributed in creating a truly global reputation.

- 4.6. Complainant's zealously protect their brand "**DUCATI**" and the goodwill associated with it against inappropriate use or misappropriation by third parties and dilution. Complainant No 1 being the global proprietor of the trademark "**DUCATI**" and formative marks thereof has secured registration for the same across several jurisdictions in the world. A list of the trade mark registrations secured and applications filed and pending for "**DUCATI**" word mark and formative marks primarily in class 7 and / or 12 have been produced in the complaint and supported by proper annexures. It also evidences that Complainant No 1 has secured registration for the "DUCATI" trademark and the formative marks thereof in India as well. The same is also supported by relevant Annexures with the Complaint.

- 4.7. Furthermore, the Complainants, with a view to zealously guard against the unauthorised encroachment and misappropriation of the "**DUCATI**" trade mark by third parties, have initiated and successfully maintained several legal proceedings to protect its intellectual property and the rights therein. For instance, in India the Complainant successfully filed an opposition against the registration of the label mark "D DUKAATI EVERY PAIR GUARANTEED" under application no 2051643 as the impugned domain name was deceptively and confusingly similar to the Complainant's DUCATI trade mark. Complainant No 1 has also taken similar actions in other countries to protect and enforce its statutory as well as common law rights in other trade mark DUCATI. Order passed by Trade Mark Registry has been annexed.
- 4.8. The success, popularity and well-knownness of the brand "DUCATI" is also evident from the colossal revenue generated and the huge demand of the products manufactured under the said brand. The Complainants also have a YouTube channel in the name "**DUCATI**" to carry with more than 93000 subscribers and 22 million views.
- 4.9. The Complainants are also actively present on Facebook and Twitter with more than 3 million likes and 200 thousand followers on the respective platforms. Further, the Complainants are also active on

Instagram under the name 'DUCATIMOTOR' and have more than 295 thousand followers. Given such widespread presence over the Internet and number of followers running into hundreds of thousands, it is evident that the Complainants have carved out a niche for themselves and earned exceptional goodwill under the brand "DUCATI" in India as well as internationally.

4.10. In the light of worldwide sales, extensive advertising and promotion, numerous victories in the world bike championships and highly active social media presence it is safe to state that the complainant reputation and Goodwill transcends geographical boundaries and the **Ducati** trademark has become a well-known mark and has acquired distinctiveness to the extent that no entity other than the complainant are associated or identified with the same.

4.11. Complainant No 1 has painstakingly created the reputation and generated the Goodwill for itself and its brand "**Ducati**" in the motorcycle industry and makes colossal investments into protecting and further strengthening its brand "**DUCATI**". One of the primary modes of promotion of one's brand is the creation of an informative and attractive website since in this age it can be safely stated that internet is the most

effective way of reaching out to consumers beyond territorial limits of the places where an entity might have actual physical presence.

4.12. Complainant further submits that it is pertinent that complaint no 1, has secured the registration for the domain name www.Ducati.com and has invested a great deal in terms of time, dedicated efforts and money to maintain a very informative website at the said location on the Internet. As is the common practice, the domain name comprises of the word **"DUCATI"** - the house mark and the trading name and, therefore, the same lends an obvious association in the minds of consumers between the products and the Complainants. The international website also features and links country specific web pages with apprise customers of country specific information and updates particularly for countries such as India, Argentina, Australia, Belgium, Brazil, Canada and so on. It is pertinent to note that international website receives over 12 million clicks each year. Extracts from Complainant No 1's international website www.ducati.com bearing the trademark **"DUCATI"** and other formative trademarks are annexed with the Complaint.

4.13. Furthermore, in addition to the international website, Complainant No. 1 has also obtained registration for several country and region specific domain names or ccTLDs bearing the word **DUCATI** and/or its

derivatives such as www.Ducati.com.au, www.ducatistore.co.uk, www.ducati.fr, www.ducati.co.jp, www.ducatinortheurope.be. Printouts of the extracts of the WHOIS lookup database pertaining to the above country and region specific domain name registration comprising the world **"DUCATI"** secured by Complainant No 1 is annexed with the Complaint.

- 4.14. The Complainants by manufacturing and producing world's most attractive and high performance sport-inspired motorcycles and related accessories for over six decades and by ensuring the same standard of quality and reliability in their products and services, have painstakingly built for themselves and for the **"DUCATI"** trade mark, an enviable reputation for quality and trust. Besides, the Complainant incur considerable expenditure on advertising and promoting their motorcycles and other products under the trademark **"DUCATI"**. As a result, the **"DUCATI"** trade mark has become a popular name that enjoys exceptional goodwill, highest customer loyalty and high brand recognition, retention and recall.

- 4.15. **Complainant's Contentions under Para 4 of the INDRP Policy:**

The Disputed Domain Name is identical or confusingly similar to the trademark of the Complainant in which the Complainant has statutory and/or common law rights

- 4.15.1. The disputed domain name registered by the Respondent is identical to the well-known trademark "**DUCATI**" which has been owned and used by Complainant No 1 continuously and openly since 1926. The web page currently accessible at the disputed domain name registered by the Respondent merely displays an error message and the same has being reproduce in the complaint as a screenshot.
- 4.15.2. As is well known and established herein above, Complainant No 1 has been continuously and uninterruptedly using the trademark "**DUCATI**", both as a wordmark as well as other formative device marks since 1926. Which such extensive, continuous, open and uninterrupted use of the "**DUCATI**" trademark and trade name by the Complainants, throughout the world the "**DUCATI**" trademark has become distinctive and indicative of the goods of the Complainants alone and none else. The disputed domain name **<ducati.co.in>** is, but for the necessary suffix identical to Complainant's well known trademark "**DUCATI**". The disputed domain name incorporates the Complainant's trademark in its

entirely and does not add any distinguishing element to it. The suffix **".co.in"** is necessary for India-specific top level domains on the Internet and should not be taken into consideration. While comparing the disputed nme with the Complainant's well-known trademark.

- 4.15.3. That given the immense popularity and goodwill enjoyed by the Complainant's trade mark and their impeccable market reputation,, it is clear that the Complainant's trademark is well-known trademark within the meaning of Section 2(1)(zg) of Trademark Act 1999. The Trademark Ducati has become distinctive of the Complainants' good and instantly reminds the general public of the Complainants. It is also pertinent to note that Complainant No 1 owns and uses various domain names, all incorporating its trademark DUCATI along with country specific gTLDs. Hence, any individual coming across the disputed domain name will assume it to be the Complainant's website for the Indian nation and instantly associate the same with the Complainants.

The Respondent has no legitimate interests in respect of the disputed domain name

4.15.4. The Respondent is neither known by the name **DUCATI** nor carries any trade or business under the said trademark. The Respondent essentially has no rights or legitimate claims in respect of the domain name **www.ducati.co.in** which is identical to and based on the Complainant's' well known trademark DUCATI. Furthermore, the Complainants - the rightful proprietor of the DUCATI brand globally - have not authorized the respondent to secure and continue to hold such domain name registration. Additionally, the Respondent does not have any Trademark registration in the "Ducati" mark. Moreover, no particulars or details of the Respondent are displayed on the website. The Respondent has simply registered the disputed domain name in order to benefit from the Complainant's' goodwill and deceive the visitors by registering a domain name that entirely incorporates the Complainant's trademark without including any distinguishing features.

4.15.5. That the Respondent continues to hold the said website with no content displayed on the same purely with the malafide intention from preventing the complainant from securing the registration and using the same to their benefits as conferred under the law. The Respondent, being well aware of the Complainant's business

and practice of securing country code domain names, has specifically held on to the registration of the said domain name with a view to put the complainants through unnecessary losses and harassment.

- 4.15.6. Further, in the absence of any legitimate interest or right of the Respondent in the disputed domain name and in light of the goodwill enjoy by the Complainants, it is submitted that any unauthorised use of the "DUCATI" trademark with inevitably create confusion among customers and general public. Further, the use of the disputed domain name **<ducati.co.in>** by the Respondent will most likely deceive the general public into believing that the disputed domain name, registered by the Respondent, is associated with or endorsed by the Complainants in some way. That such unauthorized use will invariably lead to an impression building in the consumers minds that the Respondent being the Registrant of the disputed domain name is associated with the Complainants through contractual relations such as licensee, distributor, inter alia. Alternatively, if such unauthorized use by the respondent is allowed to continue, it may also lead to dilution of Complainant's trademarks, loss of goodwill and degradation of brand equity.

4.15.7. Furthermore, the Respondent cannot possibly have any cogent and justifiable reason to hold on the disputed domain name and give the well-known status of the DUCATI brand in favour of the Complainants herein, such registration and ownership of the disputed domain name by the Respondent restricts the Complainant's rights to use the said domain to its benefit and advantage.

The disputed Domain Name has been registered or is being used in Bad Faith

4.15.8. The disputed domain name **www.ducati.co.in** was registered and is being used by the Respondent in the bad faith to cause confusion and mislead the Complainant's customers as well as the general public.

4.15.9. The complainant's use of the trademark goes back to 1926. The **DUCATI** trademark has acquired immense goodwill and popularity in the last nine decades by virtue of its open, continuous and extensive use by the Complainants. Even a preliminary search over the Internet or survey among the public in general reveals that the "**DUCATI**" brand is associated with the

Complainants and is being used by them in their trade and business since the 1920s. It is submitted that the Respondent deliberately chose to register the disputed domain **<ducati.co.in>** with malafide intent of deriving undue profits from the goodwill and impeccable reputation enjoyed by the Complainants under the trademark "**DUCATI**". The Respondent registered the disputed domain name with actual knowledge of the Complainant's right in the 'DUCATI' trademark intentionally attract internet users who mistakenly believe that the domain name is related to Complainants or its products.

- 4.15.10. The Respondents' malafide is clear from the fact that the whois lookup records of the .IN Registry show that the website title for the Respondent owned **www.ducati.co.in** reads as, "Ducati India - Bikes Equipment, Accessories, Racing, Company, Dealer - Official Site Ducati India", whereas neither the Complainants nor any of its affiliates have entered into an agreement with the Respondent designating it an official dealer of the Complainants and the latter's products. The fact that the Respondent has knowingly projected itself as an official dealer of the Complainants shows its intent of taking undue advantage of and riding on the complainant's hard earned reputation.

4.15.11. The Complainant's websites are extremely popular and attract a colossal traffic from visitors across the globe. They provide information about their bikes, various racing events, various Ducati events, Desmo Owners Clubs, its dealers and services, etc. It is pertinent to point out that the Complainants and their sister concerns have registered and use various domain names to cater to its existing and/or potential customers and the general public in different geographical regions. These websites also provide area specific contact information as well as details of Ducati dealers, stores and product pricing. For instance, the domain name ducatiuk.com is used to attract online traffic in the United Kingdom, ducati.com.au for Australia, ducati.fr for France, ducati.de for Germany, ducati.co.jp for Japan. Moreover, the customers can also buy some of the Complainant's products from their website www.shop.ducati.com which provides online shopping options for 39 countries. In light of the Complainant's existing practice of offering its products via various country specific top-level domain will necessarily create similar expectations of association in the minds of the consumers to the disadvantage of the Complainants as the customers.

4.15.12. Furthermore, the disputed domain name, when accessed, currently displays an error message, suggesting that the website is not in use. If the disputed domain name is visited by any potential customer of the complainants, they will be tricked into believing that either the complainants' website is not working or the Complainant has interrupted provision of its goods in India. Such impression will consequently disappoint the loyal customers the Complainant has secured by extending the services of the highest standards for almost a century and eventually lead to loss of Complainant goodwill and cause irreparable losses.

4.15.13. Additionally, it is a settled law that registration of an identical or confusingly similar domain name that is patently connected with a particular trademark owned by an entity with no connection with the trademark owner is indicative of bad faith as understood in the Policy.

4.15.14. It is therefore submitted that the Respondent knowingly chose to register and use the disputed domain name **<ducati.co.in>** to divert customers from the Complainants' official websites, deceive them into visiting the disputed domain name and drawing damaging conclusions as to the Complainant's

operations in India, thus adversely affecting the Complainant's goodwill and reputation and its right to use said India specific high level domain name. Thus, the Respondent is guilty of registering and using the disputed domain name <**ducati.co.in**> as per INDRP Policy and Rules.

5. RESPONSE & THE REJOINDER:

5.1. Response filed by the Respondent

5.1.1. A bare perusal of the complaint filed by Complainants would go to show that nowhere in the complaint it has been alleged that there is an arbitration agreement between the complainants and Respondent. That as per section 7 of the Arbitration and Conciliation Act, 1996, an arbitration agreement is an agreement between the parties if the same is in writing which may be a document signed by parties in the manner provided.

5.1.2. Further that as per the procedure laid down under the INDRP rules of procedure the arbitration proceedings are required to be completed and the award is to be passed within a period of 60 days from the date of commencement of arbitration proceedings. The aforesaid procedure provided under INDRP is contrary to the

section 29-A and 29-B of the Act of 1996 as the time limit prescribed for completing the arbitration proceeding and passing of the award is 6 months.

5.1.3. That as per the procedure laid down under INDRP rules of procedure, the challenge of an appointment of arbitrator is to be decided by the .IN registry. Before the filing of the present Response, the Respondent challenged the appointment of the Hon'ble Arbitrator by way of filing of the Objections, however instead of referring the aforesaid Objections to the .IN registry, the Hon'ble Arbitrator proceeded with the matter which is contrary to the rule 6 (iii) of the INDRP rules of procedure.

5.1.4. That the procedure further provides that there shall be no in person hearing unless the arbitrator determines in his sole discretion and as an exceptional matter that such a hearing is necessary for deciding the complaint. The aforesaid procedure is also contrary to the principle of Natural Justice as well as against the concept of section 24 of the Act of 1996.

5.1.5. That the complaint of complainants is barred by the vice of delay, laches and acquiescence.

5.1.6. That the Learned Arbitrator has no jurisdiction to entertain the present Complaint made by the Complainants, nor the Complaint is a pure complaint of "Domain Name" related matter as envisaged by the Regulations, but is a matter related to rights of the Respondent and other persons, as per the applicable Civil Laws of India. Thus, without prejudice to the rights of the Respondent to initiate appropriate proceedings as and when required against the Complainants in India, in view of the submission of the Complainant No.1 to Indian Jurisdiction, the Respondent is submitting this present Response.

5.1.7. It is pertinent to note that the Complainant No.1, Ducati Motor Holding S.p.A. appointed Precision Motor India Pvt. Ltd., as an exclusive importer and distributor to distribute its products in the territory of India and Sri Lanka by executing an Exclusive Distribution Agreement dated 17-12-2007. Copy of the said agreement is being enclosed and marked as Annexure.

5.1.8. That the registration of the said domain name was made by Mr. Ashish Chordia on 11th December 2007 and this fact is evidenced by the Domain Name Created on Date mentioned on WHOIS

data. Copy of the WHOIS Data is being enclosed and marked as Annexure.

5.1.9. The Respondent submits that that before expiry of the said domain name in 2008, an email was received by Mr. Ashish Chordia regarding the expiry from Good Luck Domains, the registrar of the said domain name at that time. Copy of the email from Good Luck Domains is being enclosed and marked as Annexure.

5.1.10. The Respondent further states that thereafter in 2008 the domain name registrar was changed from Good Luck Domains to Net 4 India Pvt. Ltd. Subsequently the domain name was registered for 5 years from 2009 to 2014 followed by yearly renewals till date.

5.1.11. That even though payments towards renewal of the said domain name were made the registrar, Net 4 India Ltd., did not renew the domain name even after accepting the payment towards renewal of the said domain name on three occasions namely 22nd November 2016, 2nd December 2016 and 3rd December 2016. According to the complainant, the said domain name was placed under locks thereby prohibiting deletion, transfer, renewal and

update by the Respondent. It should be noted that the domain name was to be renewed by 11th December 2016 and the needful payment for the same was done on time. However, Net 4 India Pvt. Ltd., who had earlier informed Respondent that the said domain name will be renewed upon expiry and payment towards same has been received, had now changed its stance and informed Respondent that the same has been put on hold by the National Internet Exchange of India due to dispute. Copy of Orders and Renewals is being enclosed and marked as Annexure.

- 5.1.12. That Mr. Ashish Chordia has numerous business interests and due to his constant travels, he executed a Power of Attorney in favour of the Respondent in January 2014. M/s. Precision Motor India Private Limited also passed a Board Resolution in 2014 authorizing the Respondent to attend to legal matters of the company. Since the Power of Attorney and Board Resolution was executed in favour of the Respondent, Mr. Ashish Chordia thereby changed the name of registrant/administrator of the said domain name from himself to the Respondent sometime in January 2016 to be able to attend to any legal matters pertaining to himself and M/s Precision Motor India Pvt. Ltd.

5.1.13. That after the execution of the exclusive distribution agreement dated 17th December 2007, representatives of Complainant No.1 have been communicating with Mr. Ashish Chordia, Director of M/s. Precision Motor India Private Limited, and his staff members on the emails which are registered under the Domain name **<ducati.co.in>**. Copy of the correspondences exchanged between the representatives of Complainant No.1 and Mr. Ashish Chordia are being enclosed and marked as Annexure.

5.1.14. That from the aforesaid facts it is clearly evident that the Complainant No.1 has been aware of the Domain name **<ducati.co.in>** being registered in the name of the Mr. Ashish Chordia and /or in favour of the Respondent. Having been aware of the registration of the Domain name **<ducati.co.in>**, no objection was ever raised by the Complainant No.1 at any point of time and even the registration of the Domain name was acknowledged by them while communicating with Mr. Ashish Chordia or his staff on email addresses associated with said domain name.

5.1.15. It is worthwhile to note that on 4th September, 2015, Mr. Gerasis Gerasimos, gainfully employed with Ducati Motor Holding S.P.A.

wrote an Email to Mr. Ashish Chordia to permit Complainant No.1 to access the Domain name **<ducati.co.in>**. Similar Emails were also sent to other Domain name owners which were registered as Ducati.nl & Ducati.es (which are registered for Netherland & Spain respectively). From the aforesaid it is clear that the Domain name with prefix Ducati has been registered in the name of different owners around the world and the Complainant No.1 & 2, having been aware of the different Domain names such as "Ducati.nl", "Ducati.es" and "Ducati.co.in" existing in the international arena, sought permission to use them for the purpose of promoting their business. Copy of the Email dated 4-9-2015 written by Gerasis Gerasimos from his Email ID gerasimos.gerasis@ducati.com is being enclosed and marked as Annexure.

- 5.1.16. That when the Ducati Motor Holding S.p.A. was requesting permission from Mr. Ashish Chordia to access the disputed domain name **<ducati.co.in>** for their business purpose, Ducati Motor Holding S.p.A. contacted Geo Trust to provide Security Certificate commonly called as SSL Certificate (which permits secure connections from a web server to a browser). In response to the communication from Ducati Motor Holding S.p.A., the Geo

Trust wrote an email to Mr. Ashish Chordia recognizing him as Domain Owner /Administrator of **<ducati.co.in>** and informed him that Geo Trust has received a SSL Certificate request from Ducati Motor Holding S.p.A. to secure the Domain **<ducati.co.in>** and as Ducati Motor Holding S.p.A. is not the registrant of the Domain **<ducati.co.in>**, therefore a confirmation from Mr. Ashish Chordia is required. Copy of the email written by Geo Trust to Ashish Chordia on 8-4-2015 is being enclosed and marked as Annexure.

5.1.17. The Complainant No.1 has been accessing and using the said Domain Name to manage its Indian website. A news item regarding the use of Domain name **<ducati.co.in>** by Complainant No.1, Ducati Motor Holding S.p.A., was also published sometime in 2011 on Rushlane.com, an online newspaper reporting on Auto News. Copy of the news item published on Rushlane.com is being enclosed and marked as Annexure.

5.1.18. On the contrary, the Complainant No.2 was incorporated as a corporate entity in India on 26th June, 2014 as admitted in the Complaint.

5.1.19. That the Complainant No.1 and M/s Precision Motor India Pvt. Ltd. entered into a Deed of Termination-cum-Settlement agreement dated 22nd October 2013. Upon signing of this agreement the Distributor Agreement signed on 17th December 2007 had become ineffective. Further, the said Deed of Termination-cum-Settlement contained an Arbitration Clause wherein any dispute regarding the said Deed of Termination-cum-Settlement shall be dealt with as per the procedure laid out in the Termination-cum-Settlement Deed. Copy of the said Deed of Termination-cum-Settlement is being enclosed and marked as Annexure.

5.1.20. However, the Complainants have ignored Arbitration clause mentioned in the Termination-cum-Settlement Deed and instead have wrongfully approached the National Internet Exchange of India while claiming that the Respondent has no civil rights and obligations in the said domain name and has registered the said domain name in bad faith and with malafide intentions.

5.1.21. The Complainants have also ignored and hidden the fact from the Learned Arbitrator that as per the Deed of

Termination-cum-Settlement the Complainants were to allow M/s. Precision Motor India Pvt. Ltd. operate dealerships in Mumbai, Delhi and Jaipur. However, the complainants intentionally avoided providing such vital information, such as investment, pricing strategy, margin strategy, etc., on the dealerships to be operated to M/s. Precision Motor India Pvt. Ltd. to enable them to operate the dealerships as per the Terminationcum-Settlement Deed.

5.1.22. The Complainant No.1 intentionally and with mala fide objectives has not indicated several commercial understandings based on or before which the Respondent was named as the registrant of the said Domain Name by the Domain Name owner Mr. Ashish Chordia and being currently administered by the Respondent, nor has the Complainant No.1 referred to the various commercial transactions, agreements and arrangements to which the Complainant No.1 was a party.

5.1.23. The use of the said Domain Name and the alleged dispute, raised by the Complainants in respect of the said Domain Name, do not relate to use of a particular Domain Name only, but use of the said Domain Name is a part of a series of transactions and

arrangements and thus cannot be adjudicated, by an arbitration, and that too as per the Regulations, nor the Arbitrator can enter the present Reference considering the provisions of the Act, the Regulations and laws relating to civil rights of the Respondent and of the owner of the said Domain Name.

5.1.24. Therefore, in view of the above, it is pertinent to note that the complaint filed by the Complainants lacks merit since Mr. Ashish Chordia and M/s. Precision Motor India Pvt. Ltd. through the Respondent are involved in commercial dealings with the complainant and also in regards to the rightful use of the said domain name **<ducati.co.in>**. Further, as evidenced, it is also pertinent to note that the said domain name was registered in 2007 and has been in use and has never been objected for the same by the Complainants, thereby proving that the said domain name was never registered in bad faith or has been misused in any manner whatsoever.

5.1.25. Therefore, the Learned Arbitrator should not proceed ahead with the arbitration proceedings as suggested by his Notice dated 24th November, 2016 as the complaint itself lacks merit and is devoid of true facts in regards to the dispute between the various parties

involved. Further, the Learned Arbitrator lacks jurisdiction due to the commercial nature of the dispute and nor the reference made to him is a valid reference, nor all related parties are Complainants to the present Complaint.

5.2. Rejoinder filed by the Complainant

5.2.1. At the outset, it is submitted that the Respondent's averments in the reply filed on 16th January 2017 (hereinafter referred to as the 'Reply') are utterly false, incorrect and misleading. It is further submitted that primarily, the Respondent's reply to the submissions in the complaint are evasive and lack any point of substance and relevance. The Respondent has gravely failed to establish any legitimate rights or interests over the disputed domain name or that the registration of the disputed domain name existing in the Respondent's name is valid and is not being used in bad faith. The Respondent's reply does not bear any cogent rebuttal to the Complainant's case and also failed to place any relevant evidentiary document in support of its case presented in the Reply.

5.2.2. That email addressed to the learned Arbitrator on 16th January 2017 (11:41 pm) filing a soft copy of the Reply was signed as

'Ashish' who is not a party to the proceedings and hence not competent to sign the email and / or take any other steps to prosecute the present proceedings on behalf of the Respondent. Furthermore, no statement has been made neither any evidence has been furnished which establish any authority conferred on Mr. Ashish by the Respondent to address such emails in the present proceedings. In view of the above, it is humbly submitted that the Reply has not been correctly and appropriately filed and hence the Reply filed vide such email may not be considered and may be rejected in limine by the learned Arbitrator in the present proceedings.

- 5.2.3. The present complaint has been appropriately filed by the Complainants under the law as provided for in Para 4 of the INDRP. Furthermore, the Complainants have also made cogent submission supported by documentary evidence to establish that the Complainants are the rightful proprietor of the globally well-known trademark 'DUCATI', that the impugned domain name registered by the Respondent is identical to Complainant's registered trademark 'DUCATI', that the Respondent has no legitimate rights or interest in the impugned domain name and lastly that the impugned domain name has been used by the

Respondent in bad faith. The Complainants crave leave of the Hon'ble Tribunal to rely upon the averments made in the Complaint which are not reiterated herein for the sake of brevity.

5.2.4. The Complaint has been filed by the Complainants seeking a limited relief of cancellation of the disputed domain name registration secured in malafide and existing incorrectly in the name of the Respondent as on date and transfer of the disputed domain name in favour of the Complainants who are the rightful proprietor of the trademark and trade name 'DUCATI' and several other domain names the essential feature whereof is the word 'DUCATI'. It is further submitted that the Complainants clearly and unambiguously averred in the Complaint as to how the Complainants are the rightful proprietor of the 'DUCATI' trade mark worldwide including in India. In view of the above, it is humbly submitted that the Complaint is well within the scope of the INDRP and the issues raised in the Complaint ought to be decided in the present proceedings and in accordance with the INDRP.

5.2.5. That it is a settled position of law that the INDRP mechanism of dispute resolution through arbitration would fall within the

description of an arbitration agreement under Section 7 of the Arbitration and Conciliation Act 1996 (hereinafter referred to as the '1996 Act'). Therefore, the Respondent's objections to the present proceedings on the ground of absence of an arbitration agreement are untenable and baseless. It is further submitted that the objections raised by the Respondent with respect to the maintainability of the present proceedings under INDRP and the appointment of the learned Arbitrator and impartiality thereof has been addressed and clearly settled by the learned Arbitrator.

- 5.2.6. Further, as already pointed out by the learned Arbitrator vide email dated 6th December 2016 (11:30 am) in the present proceedings, the Respondent herein is bound by the .IN Dispute Resolution Policy and Procedure (INDRP) and the requirement to submit to mandatory arbitration proceedings in the event a complainant files a complaint with .IN Registry against the registrant on the basis of unlawful registration of a domain name which is categorically and explicitly dealt in Clause 11 of the Terms and Conditions for Registrants accepted by the Respondent at the stage of registration of the impugned domain name. It is further submitted that the Respondent, under the said Clause is also bound by the arbitration proceedings being

conducted by one of .IN Registry empanelled Arbitrators, in accordance with the Dispute Resolution Policy and Procedure or the INDRP and the 1996 Act. Therefore, the Respondent may not be allowed to approbate and reprobate at this stage objecting to the applicability of the INDRP and the procedure prescribed therein governing the timeline for filing pleadings, personal hearings, inter alia on the ground that such procedures are contrary to the 1996 Act.

5.2.7. Complainants have filed the Complaint and initiated the present proceedings against the Respondent – Mr. Abhishek Chordia basis the fact that Mr. Abhishek Chordia was (and continues to be as on date) the Registrant of the impugned domain name as is evident from the WHOIS records obtained on 1st November 2016 i.e. a day prior to the date of filing of the Complaint and institution of the present proceedings. The WHOIS records pertaining to the impugned domain name filed at Annexure A to the Complaint also identifies the Respondent Mr Abhishek Chordia as the "Registrant Name", "Admin Name" as well as the "Tech Name". It is also pertinent to note that the column for "Registrant Organization" does not identify any organization and is reflected as NA. The WHOIS records do not at any place indicate any

reference to any third party or organization having any link to the impugned domain name and thus any averment by the Respondent in this regard is not only misconstrued but also against the understanding of law.

5.2.8. The Complainants have accordingly, and aptly so, initiated the present proceedings against Mr. Abhishek Chordia. It is also submitted that any reference to Mr. Ashish Chordia, Precision, prior history as well as prior authorizations and agreements executed by the Complainants including the exclusive distributorship agreement dated 17th December 2007 in the reply filed by the Respondent are inconsequential and irrelevant to the present proceedings primarily on the following grounds:

- i. the Respondent is an entity completely separate and distinct from Mr. Ashish Chordia and Precision in the eyes of law;
- ii. Respondent was never a party to any agreement entered into between Complainant No. 1 and Mr. Ashish Chordia or Precision;
- iii. the Complainants have never at any point of time in the past authorized the Respondent to secure registration and operate the impugned domain name.

5.2.9. The Respondent's reliance upon the Exclusive Distribution Agreement and Deed of Termination Cum Settlement are irrelevant to the proceedings and have been deliberately filed by the Respondent merely in the pretext of prolonging the present proceedings by seeking extensions to rely upon such documents only to place colossal yet inconsequential documents before the learned Arbitrator attempting to prejudice the learned Arbitrator against the Complainants.

5.2.10. In any event, in case the learned Arbitrator deems it fit to rely upon such documents, it is further humbly submitted that a bare perusal of the Exclusive Distribution Agreement dated 17th December 2007, as relied upon by the Respondent, evidences that as discussed above the said agreement had been entered into between Complainant No. 1 and Precision through its legal representative Mr. Ashish Chordia and the Respondent herein is not privy to the said distribution agreement. It is therefore submitted that the Respondent does not derive any authorization to register, use and operate the impugned domain from the Complainants, much less under the Exclusive Distribution Agreement between Complainant No. 1 and Precision and Mr. Ashish Chordia. In fact the Exclusive Distribution Agreement does

not even grant Mr. Ashish Chordia or Precision to use any trade mark of the Complainants except as was explicitly allowed by the Complainants under the Agreement for marketing and promotion of the Complainants' products.

5.2.11. The rights enjoyed by Precision and / or Mr. Ashish Chordia under the Exclusive Distribution Agreement have been terminated with the expiration of the Exclusive Distribution Agreement in 31st December 2013 and execution of the Deed of Termination Cum Settlement executed on 22nd October 2013 which clearly captures that in the event that termination of the exclusive distribution agreement at closing shall fail, even then the expiration date of the exclusive distribution agreement i.e. 31st December 2013 shall remain unchanged and unaffected.

5.2.12. At this stage, it is pertinent to consider the following clauses of the Exclusive Distribution Agreement:

"22. TRADE MARKS

22.1 DUCATI will supply the Products branded with DUCATI denominative and emblematic trademarks (herein 'Trademarks');

22.2 the DISTRIBUTOR will not modify such Trademarks in any way and acknowledges that the Trademarks are the exclusive property of DUCATI. The DISTRIBUTOR also acknowledges that this Contract does not transfer to the DISTRIBUTOR any rights to make use of such Trademarks except for the marketing of the Products during the term of this Contract and in order to promote their image by respecting the criteria established by DUCATI;

22.3

26. EFFECTS OF TERMINATION

26.1 In any case of expiration of the Contract term, after notice of non-renewal, or termination of the Contract the DISTRIBUTOR undertakes to:

a) immediately stop to act as DISTRIBUTOR, to distribute the Products, to use DUCATI distinctive marks and to exhibit the premises as DISTRIBUTOR of DUCATI;...."

It is also pertinent to appreciate Clause 2.1(ii) which provides as follows:

"2. Establishment of the presence of Ducati in India

5.1.1

5.1.2 Precision Block hereby irrevocably and unconditionally agrees and acknowledges that immediately upon payment of the

Settlement Amount at Closing, Ducati shall have the full right, without limitation and at its complete discretion, to set up a presence in India and / or enter into a new Distributorship in India and / or to incorporate a legal entity in India (such presence, new distributor or subsidiary hereinafter referred to as "NewCo" or "Ducati Presence"), requesting the NewCo to be allotted of the name Ducati India Private Limited or any other similar name to be chosen in Ducati sole discretion, whether by itself or through a joint venture, for the purposes of the carrying out retail, wholesale, services and manufacture of Products and other ancillary services in relation to the Products in the Territory and Precision has and shall have no objection to the same. This right of Ducati shall become full, effective and enforceable on the same day of the Closing. Ducati intends to establish or incorporate the NewCo immediately thereafter and to deal straight ahead with all of its start up activities (including, not exhaustively, any applications to be released of any governative or state authorisations, permits, issuance of import export code, selection of any commercial partners, suppliers, labour and employment force). Precision Block hereby expressly agrees, acknowledges and declares that:

(i)

(ii) It has not registered nor will register in the future any trademark, trade name or business name, including without limitation any domain names, that may be considered in Ducati's sole discretion, to be similar or in any case confusing with Ducati's registered or unregistered intellectual property and undertakes to assign upon Effective Date any rights on such signs that may have due to the authorized registration of the same or anyway use of the same in the Territory;"

5.2.13. That a bare perusal of the above clauses of the Exclusive Distribution Agreement and the Deed of Termination Cum Settlement reveals that Mr. Ashish Chordia and Precision both have in fact acknowledged the sole and exclusive right of the Complainants in the 'DUCATI' trademarks. Further, the reliance placed upon the Exclusive Distributorship Agreement and the Deed of Termination Cum Settlement by the Respondent in the present proceedings is fallacious and goes only to evidence the indisputable rights of the Complainants in the valuable and well-known trademark 'DUCATI' and in which the Respondent has no right or interest whatsoever.

5.2.14. Further, under the Exclusive Distributorship Agreement as well, Precision and Mr. Ashish Chordia themselves did not have any right to the Complainant's No. 1 trade marks or any mark confusingly similar thereto or use any domain name including the impugned domain name subsequent to the termination of the Exclusive Distribution Agreement as specified in the Agreement and the Deed of Termination Cum Settlement Agreement executed on 22nd October 2013, and therefore the Respondent herein could not have derived any right from Precision and / or Mr. Ashish Chordia to indulge in any of the above activities by virtue of the Exclusive Distribution Agreement, particularly post the termination of the Exclusive Distribution Agreement. In any event, at the cost of sounding repetitive, it is humbly submitted that the Respondent was not privy to the Exclusive Distribution Agreement and hence cannot claim any right to use the Complainant's trademarks or domain names comprising the Complainant's trademark 'DUCATI' including the impugned domain name.

5.2.15. Additionally, the Respondent has failed to file any single document whatsoever in support of the submissions with regard to amendment of the name of registrant / administrator of the

impugned domain name in favour of the Respondent in January 2016 and the alleged authorization and power conferred on the Respondent by Mr. Ashish Chordia to represent him in the legal matters.

PARA WISE REPLY BY THE COMPLAINANT UNDER REJOINDER

- 5.2.16. The contents of paragraphs 1 & 2 of the Reply are matters of record and do not need any specific reply herein.
- 5.2.17. The contents of paragraph 3 of the Reply to the extent that a preliminary response had been filed by Respondent on 23rd December 2016 is a matter of record and does not need any specific reply. The remaining contents of the said paragraphs under reply herein are vehemently denied as untenable and baseless and the contents of paragraphs B and C of Preliminary Objections herein relied upon and not reiterated herein for the sake of brevity. With regard to the submission that the Complaint does not bear any averment with regard to existence of any arbitration agreement between the Complainants and the Respondent, it is humbly submitted that the Complainants have filed the present complaint with NIXI as prescribed under the law,

specifically under Para 4 of the INDRP in force under INDRP whereafter NIXI had appointed the learned Arbitrator which marked the initiation of the arbitration proceedings. In any event, the Respondent had agreed to submit to such mandatory arbitration between a complainant on any dispute with regard to the malafide registration of the impugned domain at the stage of securing the domain name registration. At the cost of sounding repetitive, it is further submitted that it has been well settled through judicial pronouncements that the INDRP mechanism of dispute resolution through arbitration would fall within the description of an arbitration agreement under Section 7 of the Arbitration and Conciliation Act 1996. Additionally, with regard to the challenge of appointment of arbitrator, it is humbly submitted that the Respondent ought to have appropriately raised such objections with NIXI directly which it failed to do.

- 5.2.18. The contents of paragraph 9 are denied and incorrect and it is humbly submitted that the complaint is not barred by delay, laches and acquiescence as the Complainants became aware of the Respondent's registration of the impugned domain only recently and have initiated the present proceedings at the earliest possible opportunity. It is further submitted the Respondent's

averments are vague and frivolous and the Respondent has not filed any document to establish knowledge on the part of the Complainants with regard to registration of the impugned domain name in the name of the Respondent to qualify as acquiescence on the part of the Complainants.

5.2.19. The contents of paragraph 10 are denied as vague and unfounded and do not merit any specific reply. The Respondent, if aggrieved by the partiality and lack of independence of the learned Arbitrator ought to have approached NIXI within the time prescribed by NIXI which it failed to do.

5.2.20. The contents of paragraph 11 are matters of record and hence do not merit any specific response.

5.2.21. The contents of paragraph 12 are denied as vague and repetitive. The learned Arbitrator has already adjudicated on the issue of jurisdiction vide the email dated 6th December 2016 (11:30 am) and therefore the contents of the paragraph under reply are irrelevant. The Respondent is merely attempting to prolong the proceedings by making baseless and frivolous allegations and

objections to make up for the lack of any evidence or averment to prove its case on merits.

5.2.22. The contents of paragraph 13 are denied as untenable in law as they comprise of vague denials without any cogent reasoning or evidence supporting such blanket denials.

5.2.23. The contents of paragraph 14 are denied as irrelevant and inconsequential to the present proceedings as Precision is not the registrant organization or admin or tech of the impugned domain and not a party to the present proceedings. Therefore, any arrangement between Precision and the Complainants has no bearing on the present proceedings and has been relied upon by the Respondent merely to attempt at prejudicing and confusing the learned Arbitrator by burdening the present proceedings with unnecessary information.

5.2.24. The contents of paragraph 15 are denied as false and misleading and the Respondent be put to strict proof of such averments. The WHOIS records filed by the Respondent at Annexure B indicate the Respondent as the Registrant, Admin and Tech and there is no reference to Mr. Ashish Chordia in the said document.

5.2.25. The contents of paragraph 16 are irrelevant and inconsequential to the present proceedings as Mr. Ashish Chordia is not a party to the present proceedings. Therefore, any document or correspondence received by Mr. Ashish Chordia with regard to the impugned domain name bear no relevance to the present proceedings and ought to be ignored.

5.2.26. The contents of paragraph 17 are denied as vague, irrelevant and misleading. The history of the registration and order of renewal of the impugned domain name are not relevant to the proceedings since on the date of initiation of the present proceedings, the impugned domain stood registered in the name of the Respondent and hence the Complainant filed the complaint against the Respondent and not against any other third party such as Mr. Ashish Chordia or Precision, inter alia. Furthermore, it is incorrect on the part of the Respondent to state that the according to the Complainants, the impugned domain name was placed under locks thereby prohibiting deletion, transfer, renewal and update by the Respondent since as per email dated 6th December 2016, it was NIXI who apprised the Respondent as well as the Complainants that the impugned domain had been placed

under locks. The contents with regard to the stance of Net 4 India Pvt. Ltd. are a matter of record and do not require any specific response from the Complainants.

5.2.27. The contents of paragraph 18 are denied as false, vague and misleading as the Respondent has failed to produce any document including the alleged Board Resolution and the Power of Attorney executed in favour of the Respondent in the present proceedings. The Respondent has also not produced any document evidencing the change of name of Registrant / Administrator to reflect his own name in January 2016 as alleged in the paragraph under reply herein. Furthermore, such a change in name is an afterthought on the part of the Respondent and thus further evinces the malafide on the part of the Respondent and the attempts to mislead this Hon'ble Tribunal. Furthermore, the malafide is evident from the ever changing stance adopted by the Respondent in the email responses filed and correspondences exchanged wherein the Respondent first submitted that he is the administrator for the impugned domain and subsequently amended his position to state that he is the power of attorney holder and hence the registrant of the impugned domain name. Additionally, assuming but not conceding the fact that the

Respondent has been authorized by Mr. Ashish Chordia or Precision to act on their behalf, as per the Deed of Termination Cum Settlement, all the rights enjoyed by Precision and / or Mr. Ashish Chordia in registration / use of the impugned domain cease to exist and operate in 2013. Since Mr. Ashish Chordia and Precision did not enjoy any rights in the domain name, the Respondent cannot draw any power or exercise any right on the impugned domain on behalf of Mr. Ashish Chordia and Precision. The contents of paragraphs H – I of the Preliminary Objections hereinabove are relied upon and not reiterated herein for the sake of brevity.

- 5.2.28. The contents of paragraph 19 are denied as false, vague and misleading. The authenticity of the email correspondences annexed is questionable as the headers and subject lines are missing. Furthermore, the said email correspondences have been exchanged with third parties who are not party to the present proceedings and no legal relationship between the said third parties and the Respondent has been established. Therefore, the said email correspondences are irrelevant and may be ignored as inconsequential to the present proceedings and the Respondent

must be reprimanded for unnecessarily citing such documents to mislead the Hon'ble Tribunal.

5.2.29. The contents of paragraph 20 are denied are baseless, immaterial and unconnected to the present proceedings as Mr. Ashish Chordia is not a party to the present proceedings. The present proceedings have been initiated against the Respondent in the capacity of the Registrant on record as on date as per the INDRP and it is pertinent to note that the Respondent holds the impugned domain name in his own name and to his own benefit and there has been no evidence to establish to the contrary. Therefore, the email correspondences between Complainant No. 1 and Mr. Ashish Chordia – an unrelated third party are not relevant to the present proceedings.

5.2.30. The contents of paragraphs 21-22 are denied as vague, irrelevant and immaterial to the present proceedings and the contents of paragraph 20 hereinabove are reiterated for the sake of brevity and to avoid repetition. The contents of paragraphs H – L of the Preliminary Objections hereinabove are relied upon and not reiterated herein for the sake of brevity.

5.2.31. The contents of paragraph 23 are admitted by the Complainants so far as evidence of use of the impugned domain name for Complainants' business is concerned. Infact the averments in the said paragraph itself evidence that the Respondent was aware of the exclusive rights of the Complainants in the DUCATI trademarks and further evinces the malafide on the part of the Respondent who deliberately registered and is holding the impugned domain name thereby violating Complainants' exclusive rights and causing irreparable losses and injury to the Complainants.

5.2.32. The contents of paragraph 24 are a matter of record and does not need any specific response and also does not bear any relevance to the present proceedings.

5.2.33. The contents of paragraphs 25 and 26 are denied as irrelevant and immaterial to the present proceedings as the Respondent was not privy to the Deed of Termination Cum Settlement and Exclusive Distribution Agreement and hence cannot draw any right or authority thereunder. Therefore, the arbitration clause in such agreement and deed could not be invoked by the Complainants against the Respondent – a non-signatory to such

distribution agreement. The Complainants have appropriately filed the Complaint against the Respondent – the Registrant of the impugned domain name as per the WHOIS records as on date of institution of the complaint and the submission in paragraph E of Preliminary Objections are relied upon and not reiterated herein for the sake of brevity.

- 5.2.34. The contents of paragraphs 27 and 28 are denied as vague, incorrect, misleading and immaterial to the present proceedings. It is humbly submitted that the Complainants have not concealed any facts material to the present proceedings and any information pertaining to the prior history of present understandings between the Complainants and third parties such as Mr. Ashish Chordia and Precision are inconsequential and have no bearing on the present proceedings. The Complainants have never entered into any commercial understanding or arrangement with the Respondent and any commercial understanding with third parties such as Mr. Ashish Chordia and Precision have no bearing on the present proceedings as such third parties are not the registrant or admin or technician of the impugned domain name and hence not made a party to the present proceedings.

5.2.35. The contents of paragraph 29 are denied as irrelevant and immaterial to the present proceedings. At the cost of sounding repetitive, it is reiterated that the transactions and arrangements between the Complainants and independent / unrelated third parties such as Mr. Ashish Chordia and Precision, inter alia bear no relevance and significance to the present proceedings. Furthermore, the impugned domain name as on date is registered in the name of the Respondent. The Complainants have initiated the present proceedings against the bad faith registration and use of the impugned domain name by the Respondent as on the date of filing of the complaint. The fact remains that the Complainants have never authorized the Respondent to use, register or hold the impugned domain name and hence the use of the impugned domain being a part of any transaction with any third party does not validate the bad faith use and / or registration of the impugned domain name in the name of the Respondent. Furthermore, the Respondent had agreed to submit to mandatory arbitration under the INDRP and cannot approbate and reprobate to escape liability in the present proceedings. The submission in paragraphs B – D in Preliminary Objections hereinabove are relied upon and not reiterated herein for the sake of brevity.

5.2.36. The contents of paragraph 30 are vehemently denied as misleading, vague, untenable and immaterial to the present proceedings. The Respondent has failed to establish any legal authorization wherein Mr. Ashish Chordia or Precision whereby the latter had required him to hold the domain name on their behalf. In any event, any rights enjoyed by Mr. Ashish Chordia and Precision under the Exclusive Distribution Agreement also ceased to exist with the termination of the agreement and the execution of the Deed of Termination Cum Settlement. Therefore, the Respondent does not enjoy any rights, let alone legitimate interests in the impugned domain, on his own account or through any authorization flowing from Mr. Ashish Chordia or Precision. Furthermore, the Complainants have filed the Complaint against the Respondent who as on date is the Registrant of the impugned domain and continues to be so without any authorization from the Complainants and thus infringing upon Complainants' exclusive rights in the trade mark 'DUCATI' and leading to likelihood of confusion and deception amongst the customers and traders.

5.2.37. The contents of paragraph 31 are denied as untenable, baseless and unfounded in the absence of any cogent evidence.

5.2.38. Furthermore, at the cost of sounding repetitive, it is humbly submitted that the Complainants have, through the submissions in the complaint filed and supported by the necessary evidence, discharged the responsibility to establish that the Respondent's present registration and operation of the impugned domain is actuated out of pure malafide and further that the Respondent has no legitimate interests or rights whatsoever in holding the domain name registration as on date.

Discussion and Findings:

6. Preliminary

- 6.1. The Arbitrator has reviewed the all the documents placed before it by the Complainant and the Respondent respectively.
- 6.2. The Complainant in its complaint has invoked Para 4 of the INDRP, wherein the Complainant is supposed to satisfy all the three conditions provided under Para 4 of the INDRP Policy, which reads:

"Any Person who considers that a registered domain name conflicts with his legitimate rights or interests may file a Complaint to the .IN Registry on the following premises:

- (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.

The Registrant is required to submit to a mandatory Arbitration proceeding in the event that a Complainant files a complaint to the .IN Registry, in compliance with this Policy and Rules thereunder."

- 6.3. The Respondent has raised some issues during the proceedings. Firstly, the question of lack of an Arbitration Agreement between the parties as raised by the Respondent citing section 7 of the Arbitration and Conciliation Act, 1996, has already been dealt by Honorable Delhi High Court in the matter of Stephen Koeing vs Arbitrator Nixi And Anr. decided on 2 November, 2015 [FAO (OS) 42/2012], laid down - "This

Court notes that the INDRP mechanism of dispute resolution through arbitration would fall within the description of an arbitration agreement under Section 7 of the Arbitration and Conciliation Act, 1996."

6.4. Accordingly, this Arbitration Tribunal and these Arbitration proceedings have proper Jurisdiction to proceed over any INDRP complaint filed in terms of clause 11 of the Domain Registrant agreement over any .IN Domain Name, which is agreed by the Domain Registrant at the time of Registration of .IN Domain. And the INDRP Policy and Rules of Procedure thereunder lays down the procedure / framework within which these Arbitration Proceeding are to be conducted.

6.5. Further, the Complainants have rightly made the Complaint against the Respondent Mr Abhishek Chordia only, who is the owner of the disputed domain as per the publicly available record of the domain name, i.e. WHOIS Information and Complainants never had any business relations or commercial dealings with him in particular, as held herein-below under the para "*B. Registrant's rights to or legitimate interests in the domain name*".

6.6. Furthermore, the Respondent made reference to Rule 6(iii) of the INDRP rules of procedure, wherein the Respondent themselves were supposed

to act within 7 days of the notification of the Complaint and the Complaint was to be made directly to the .IN Registry i.e. Nixi. But no such issue was raised by the Respondent within the said timeline.

6.7. That is, the Respondent never acted within the timeline either provided under Rule 6(iii) of the INDRP Rules of procedure or under section 13 of the Arbitration & Conciliation Act, 1996. Further, in any case, Respondent has participated in the said INDRP proceedings till the very last stage of filing of written arguments. The Complainant has rightly analyzed the various objections made by the Respondent as follows:

- The Complainants object to the repeated attempts of the Respondent to undermine the impartiality of this Hon'ble Tribunal, the unfounded allegations of bias and prejudice made against the learned Arbitrator and the undue delay caused in adjudication of the present domain name dispute on account of the negligent approach of the Respondent towards the present proceedings.
- Complainants would like to draw the learned Arbitrator's attention to the fact that the Respondent strategically questions the impartiality of the learned Arbitrator or maintainability of the

present proceedings at the time when the Respondent has failed to comply with the directions of the Hon'ble Tribunal and requires an extension of time. The Respondent has never pursued his objections with regard to the independence and impartiality of the learned Arbitrator or the maintainability of the present proceedings seriously and as required under law.

- If the Respondent had been questioning impartiality in bonafide and sincerity, then the Respondent would have raised the objection with regard to the Complainants' pleadings being taken on record without the affidavit at the stage of filing such pleadings or in any of the several responses filed by the Respondent. However, not even one of the responses filed by the Respondent contains a single averment as regards lack of affidavit in support of the Complainants' pleadings and thus the Respondent said objections is not maintainable. Further, the Respondent failed to raise any objection on the date on which the learned Arbitrator granted time to Complainant to file the affidavits i.e. on 28th January 2017. However, the Respondent conveniently chose to remain silent even then and now only when the Respondent has failed to file the written note of arguments by 13th February 2017 as per the learned Arbitrator's directions, the

Respondent has once again questioned the impartiality of the learned Arbitrator, and fallaciously so on frivolous grounds. This is evident from the statement of the Respondent from the trailing email which reads as *"Without prejudice it is further submitted that In case you still insist on pursuing the matter then you are requested to grant us an opportunity of seven days to prepare and submit our written arguments as sought by you."*

- Therefore, the intention of the Respondent in making such baseless allegations and objections with regard to impartiality and maintainability of the instant proceedings without any cogent justification or proof is only fuelled by using the said allegations as an opportunity to seek further time and the same is evident from several instances in the past vide Email dated 3rd December 2016 (1:31 pm), Response dated 23rd December 2016 (9:25 am) and Email dated 31st December 2016 (6:10 pm).
- Further, the question of impartiality stand defeated as the Respondent has been granted 4 extensions in the present proceedings over one and half months, even though the same was strongly objected to by the Complainants.

- 6.8. The decision in Stephen Koenig v. Arbitrator, National Internet Exchange of India (2015) which was subsequently upheld by the Division Bench of this Court by its decision dated 2nd November, 2015 because of the fact that a mere delay in lodging the complaint would not disentitle the aggrieved party from proceeding against the 'squatter'. [Hon'ble Delhi High Court in Thoughtworks Inc vs Super Software Pvt Ltd. & Anr on 12 January, 2017]
- 6.9. Hon'ble Supreme Court in Rashtriya Ispat Nigam Ltd. Vs. Dewan Chand Ram Saran (2012) 5 SCC 306 reiterated that the Arbitral Tribunal is legitimately entitled to take the view which it holds to be correct one after considering the material before it and after interpreting the provisions of the Agreement and if the Arbitral Tribunal does so, its decision has to be accepted as final and binding.
- 6.10. Lastly, the Law governing the trademark is well established. The Apex Court in Thukral Mechanical Works v. P. M. Diesels Private Limited & anr., (2009) 2 SCC 768 in paragraph 22 observed: "There cannot be any doubt or dispute that the registration of a trademark confers a very valuable right. The person in whose name the trademark has been registered may take action against any person for passing off the goods as that of the registered owner. It confers an exclusive right of use of the

trade mark in relation to the goods in which the trade mark is registered."

7. Requirements of INDRP Policy:

A. Identical or Confusingly Similar

7.1. Complainant No 1 has been using the mark **DUCATI** since 1926 and ventured into automotive sector in March 1946. The **DUCATI** marks used in association with sports motorcycles and associated accessories, technical and lifestyle apparel such as jackets, t-shirts, gadgets, glasses, etc. Undoubtedly, **DUCATI** is internationally known trademark since the very inception and continue to enjoy an unparalleled and envious reputation in respect of bikes in India as well.

7.2. Complainant No 1 has secured registration for the Trademark **DUCATI** for the same across several jurisdictions in the world including India. The details of registration of trade marks secured and applications filed and pending for **DUCATI** marks in various classes have been produced along with the complaint. The Indian Trademark Registry website also evidences that Complainant No 1 had applied for some of its first Trademark applications under class 7 & 12, way back in 1985.

- 7.3. The Complainant No 1 owns Domain Name **www.ducati.com**, whose registration date appears as 25 June 1997 and has also obtained registration for several country and region specific domain names or ccTLDs bearing the word **DUCATI** and/or its derivatives such as *Ducati.com.au*, *Ducatistore.co.uk*, *Ducati.fr*, *Ducatinortheurope.be* and *Ducati.co.jp*.
- 7.4. Complainant has a huge online Social media presence and also incurs considerable expenditure on advertising and promoting their motorcycles and other products under the trademark **DUCATI**. The Trademark **DUCATI** has become distinctive of the Complainant's good and instantly reminds the general public of the Complainants. That is, the **DUCATI** trade mark has become a popular name that enjoys exceptional goodwill, highest customer loyalty and high brand recognition. And Complainants have established a strong presence in India as well since 2007.
- 7.5. The disputed domain name registered by the Respondent is identical/confusingly similar to the well-known trademark **DUCATI** which has been owned and used by Complainant No 1 continuously and openly since 1926. With such extensive, continuous, open and uninterrupted use of the **DUCATI** trademark and trade name by the

Complainants, throughout the world the **DUCATI** trademark has become distinctive and indicative of the goods of the Complainants alone and none else. Hence, any individual coming across the disputed domain name **<ducati.co.in>** will assume it to be the Complainant's website for the India and instantly associate the same with the Complainants. That is, the domain name **<ducati.co.in>** of the Respondent, is identical / confusingly similar to the registered trademark of the Complainant - **DUCATI**, which incorporates the same in its entirety. In a number of past domain dispute decisions, it has been confirmed that incorporating a trademark in its entirety can be sufficient to establish that a domain name is identical or confusingly similar to a registered trademark (Toyota France and Toyota Motor Corporation v. Computer-Brain, WIPO Case No. D2002-0002 and Toyota Jidosha Kabushiki Kaisha d/b/a Toyota Motor Corporation v. S&S Enterprises Ltd., WIPO Case No. D2000-0802). In addition, the disputed domain name almost entirely copies the Complainant's registered domain name www.ducati.com.

- 7.6. The Hon'ble Supreme Court in the matter of Cadila Health Care Ltd. vs. Cadila Pharmaceuticals Ltd. (2001) 5 SCC 573, inter alia, observed that its decisions in the last four decades had clearly laid down that what had to be seen in the case of a passing off action was the similarity between

the competing marks and to determine whether there was likelihood of deception or causing confusion.

7.7. Honorable Delhi High Court in the matter of Yahoo!, Inc. vs Akash Arora & Anr. [78 (1999) DLT 285] referred to Card service International Inc. Vs. McGee; reported in 42 USPQ 2d 1850, where it was held that the domain name serve same function as the trademark and is not a mere address or like finding number on the Internet and, therefore, it is entitled to equal protection as trademark. Further, Honorable Supreme Court in the matter of Satyam Infoway Ltd vs Siffynet Solutions Pvt. Ltd on 6 May, 2004, also held that Trademark law is applicable to Domain Names as well and laid down the following principles, which all weigh in favor of the Complainant:

7.7.1. The passing off action is normally available to the owner of a distinctive trademark and the person who, if the word or name is an invented one, invents and uses it. If two trade rivals claim to have individually invented the same mark, then the trader who is able to establish prior user will succeed.

7.7.2. What has to be established is the likelihood of confusion in the minds of the public, that the goods or services offered by the

defendant are the goods or the services of the plaintiff. In assessing the likelihood of such confusion the courts must allow for the "imperfect recollection of a person of ordinary memory".

7.7.3. 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 would thereby lose their customers. It is apparent therefore that a domain name may have all the characteristics of a trademark and could found an action for passing off.

7.8. The Complainants have brought conclusive evidence that it owns trademark rights in the name **DUCATI** on a worldwide scale, including India. The registration and the use of the identical/confusingly similar disputed domain is a direct infringement of the legitimate rights held by the Complainant of the mark **DUCATI**. In the matter of F. Hoffmann-La Roche AG v. Relish Enterprises, [WIPO Case No D2007-1629], where it was held - "if the Complainant owns a registered Trademark then it satisfies the threshold requirement of having the Trademark rights and

the Domain name is confusingly similar to Complainant's Trademark because disputed Domain Name looks and reads like Complainant's Trademark". The disputed domain name, **<ducati.co.in>**, which entirely contains the Complainant's trademark, is identical to the Complainant's trademark.

7.9. In the matter of Nikon, Inc. v. Technilab, Inc, [WIPO Case No D2000-1774] and Magnum Piering, Inc. v. Mudjackers & Wilson, [WIPO Case No D2000-1525], it was held that holding that confusing similarity under the Policy is decided upon the inclusion of a trademark in the domain name. That is, The registration and the use of the confusingly similar impugned domain is a direct infringement of the legitimate rights held by the Complainant of the mark **DUCATI**.

7.10. No doubt, that the disputed domain name is confusingly similar to Complainant's Trademark as it consist of Complainant's mark in its entirety. It is well established that "if a well known trademark is incorporated in its entirety, it may be sufficient to establish that a domain name is identical or confusingly similar to Complainant's registered mark." [ITC Limited V Travel India (INDRP Case No. 065) - bristol.in; Allied DOMEQ Spirits and Wine Limited v Roberto Ferrari, (INDRP Case No. 071) - ballantines.in; Calvin Klein Trademark Trust and Calvin Klein,

Inc. v. Perfect Privacy, LLC / Matthew Singleton, IAAPublications (WIPO Case No. D2016-2516)].

- 7.11. The addition of the ccTld ".co.in" is irrelevant, as it results from a technical constraint, and in any event does not neither conceal the reproduction of the trademark **DUCATI** nor mitigate the risk of confusion and association between the Complainant's trademark and the disputed domain name in the public's mind. The extensions such as '.co.in' in a disputed domain name does not affect a finding of similarity. In numerous INDRP matters, it has been held that the addition of the country top level domain ".co.in" in the disputed domain does not avoid a determination that the domain name is identical or confusingly similar to the Complainant's mark [The Hershey Company V. Rimi Sen (INDRP/289) - Hersheys.co.in and Morgan Stanley vs Bharat Jain, (INDRP/156) - MorganStanleyBank.co.in]. Also, it is technically required for the operation of a domain name, and thus it is without legal significance in an inquiry of similarity.
- 7.12. In the circumstances, the Arbitrator concludes that the Complainant has established the requirement of paragraph 4 (i) of the Policy i.e. the disputed domain name is confusingly similar to the mark in which Complainant has rights.

B. Registrant's rights to or legitimate interests in the domain name

7.13. For the second condition as to legitimate interests, the Para 7 of the INDRP policy, states 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) :

7.13.1. (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;

7.13.2. (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

7.13.3. (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.

- 7.14. Complaint submits that the Respondent is neither known by the name **DUCATI** nor carries any trade or business under the said trademark. Further, the Complainants have not authorized the Respondent to secure and continue to hold such domain name registration. Moreover, no particulars or details of the Respondent are displayed on the website. The Respondent has simply registered the disputed domain name in order to benefit from the Complainant's' goodwill and deceive the visitors by registering a domain name that entirely incorporates the Complainant's trademark without including any distinguishing features.
- 7.15. Given the submissions considered, that currently, domain name does not resolve to any website and the current owner as per WHOIS info, i.e. Respondent with whom the Complainants never had any business dealings. The case made out by the Complainant, given the strong trademark, prima-facie proves that Respondent have no legitimate rights or interest in the Domain Name.
- 7.16. Under this clause, a complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of proof shifts to the Respondent to

come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name.

7.17. The Respondent's response is mainly based upon the evidence that could have been relied upon by the previous owner. It has produced evidence as to the Exclusive Distribution Agreement that the previous domain owner Mr Ashish Chordia has entered into with Complainant No 1 in 2007 and later on termination of original agreement, - a Termination cum Settlement Agreement entered between the two in 2013. The Email correspondence previous owner Mr Ashish Chordia had with Complainant No 1 during 2013 - 2015 and so on.

7.18. That the Respondent further contends that a Power of Attorney was executed by the previous owner in favor of the Respondent and also a Board Resolution was passed in this respect, though it failed to produce the same during these arbitration proceedings. Also, the ID proof of the Respondent in support of his WHOIS information demanded on various occasion was never produced.

7.19. Now, it is important to analyze the factor as to Change in WHOIS and resultant Change in Ownership of the Domain Name. The **paragraph**

3.7 of the UDRP Overview 2.0, that is based upon majority of the Domain Decisions under UDRP, lays down as follows:

"Panels have tended to the view that formal changes in registration data are not necessarily deemed to constitute a new registration where evidence clearly establishes an unbroken chain of underlying ownership by a single entity or within a genuine conglomerate, and it is clear that any change in Whols registrant data is not being made to conceal an underlying owner's identity for the purpose of frustrating assessment of liability in relation to registration or use of the domain name."

- 7.20. That the Respondent has clearly failed to produce and establish any evidence in support of his holding of the Domain Name on behalf of the previous owner. Though, his submissions include reference to a Power of Attorney that was executed in 2014, while the domain was transferred in January 2016 and does not seem to be any direct relation between the two. Moreover when the Complainant No 1 has already terminated the initial agreement with the previous Domain owner Mr Ashish Chordia in 2013 end and Mr Ashish Chordia was no more an Exclusive Distributor for the Complainant No 1 for India & Sri Lanka. And in 2014, Complainant No 1 has incorporated Complainant No 2 for almost the same purpose as indicated in Termination Agreement as well.

7.21. Whereas, the Complainant has rightly filed for action against Respondent only, as WHOIS Information for the disputed domain indicates the Respondent as the owner of the disputed domain name **<ducati.co.in>** only. Further, there is no evidence to show that Complainant ever had any business dealing with the Respondent in any form. Also the evidence produced as to correspondence between the previous owner Mr Ashish Chordia with Complainants in 2015 happened while the WHOIS was in fact in the name of previous owner only.

7.22. The Respondent submits that WHOIS Information for the disputed domain name was changed in January 2016, pursuant to the execution of Power of Attorney in January 2014 by the previous owner in favor of the Respondent. The date as to change in WHOIS Info has been verified online by the Arbitrator, which included complete change in Name, Address and even the Email ID. Old and new WHOIS Info was as follows:

Old WHOIS Info (As on 11 December 2015)	Domain ID:D2714371-AFIN Domain Name:DUCATI.CO.IN Created On:11-Dec-2007 21:15:43 UTC Last Updated On:11-Dec-2015 22:30:47 UTC Expiration Date:11-Dec-2016 21:15:43 UTC Sponsoring Registrar:Net4India (R7-AFIN) Status:OK Status:AUTORENEWPERIOD Registrant ID:NER2R-PERAC4394
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	<p>Registrant Name:Ashish CHordia Registrant Organization: Registrant Street1:401C Poonam Chambers, Worli Registrant Street2: Registrant Street3: Registrant City:Mumbai Registrant State/Province:Maharashtra Registrant Postal Code:400018 Registrant Country:IN Registrant Phone:+1.912266160000 Registrant Phone Ext.: Registrant FAX:+1.912266160050 Registrant FAX Ext.: Registrant Email:ashish.chordia@shreyans.in</p>
<p>New WHOIS Info (Updated on 31 January 2016)</p>	<p>Domain ID:D2714371-AFIN Domain Name:DUCATI.CO.IN Created On:11-Dec-2007 21:15:43 UTC Last Updated On:31-Jan-2016 16:11:55 UTC Expiration Date:11-Dec-2016 21:15:43 UTC Sponsoring Registrar:Net4India (R7-AFIN) Status:OK Registrant ID:N8R465539 Registrant Name:Abhishek Chordia Registrant Organization:NA Registrant Street1:12-B Takht-e-Shahi Road Registrant Street2: Registrant Street3: Registrant City:Jaipur Registrant State/Province:RJ Registrant Postal Code:90069 Registrant Country:IN Registrant Phone:+91.2267450000 Registrant Phone Ext.: Registrant FAX: Registrant FAX Ext.: Registrant Email:chordia@msn.com</p>

- 7.23. That the Respondent's claim as to date of change in WHOIS information is correct but it has failed to produce the Power of Attorney or any board resolution in support of his contentions, which could have only proved the beneficial rights of the previous owner in the disputed domain name.
- 7.24. That the Respondent has also produced a news article from rushlane.com, which evidences the launch of the website on the disputed domain **<ducati.co.in>** in 2011. The same is also evident from the Archives, which Respondent referred during the proceedings in their email dated 16 December 2016 that "We are in the process of retrieving records from archive". But did not produce in any information from Archives in support with the Response. Therefore, it had to be verified at the Arbitrator's end.
- 7.25. Indeed the archives from 2011 till Jan 2016 show that website truly represented the Complainants, when the WHOIS information was in the name of the previous owner Mr Ashish Chordia and it seems, it could have been tested as per the criterion laid down in the **OKI Data** matter. As the parties entered into an exclusive distribution agreement in 2007, whereby the Respondent was authorized reseller of the Complainant No 1 for whole of India and Sri Lanka. In such a scenario, proper test has been laid down as to what constitutes a bona fide offering of goods set

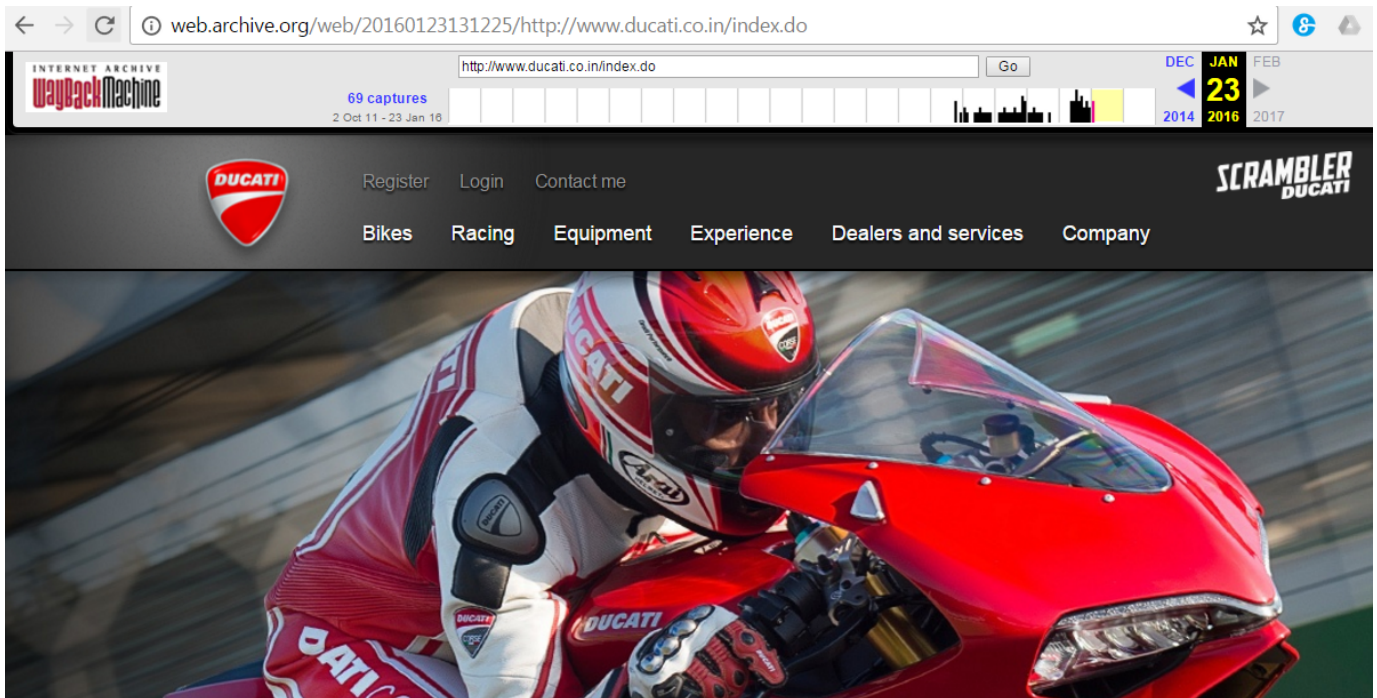
out in Oki Data Americas, Inc v. ASD, Inc, WIPO Case No. D2001 0903.

That is:

- 7.25.1. The Respondent must actually be offering the goods or services at issue;
 - 7.25.2. The Respondent must use the site itself to sell only the trademarked goods;
 - 7.25.3. The site must accurately disclose the registrant's relationship with the trademark owner; and
 - 7.25.4. The Respondent must not try to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in a domain name.
- 7.26. But the archives evidence that the website was not available after January 2016, as the last archive was captured on 23 January 2016, that is, almost the same time when the domain was transferred in the name of the Respondent and the WHOIS was changed to indicate Respondent's information. And in any case, the disputed domain **<ducati.co.in>** did not resolve to a website on the date of filing of the complaint or anytime thereafter. In the UDRP matter before National Arbitration Forum (NAF) of MB Financial Bank, N.A. v. MBBANK - Claim Number: FA0602000644517 - "the proper record for review of this

dispute should be based on the website at the Domain Name as it existed on the date the Complaint was filed...."

7.27. Further, the following screenshot from the Archive.org as to the disputed domain name, shows the archives captured 69 times starting from 02 October 2011 till 23 January 2016, thereafter, the next arrow is disabled for any further dates. This very clearly evidences that the website was closed down and became unavailable along with the change in ownership of the Domain Name took place or maybe little before that. But there is no evidence on record as to use of the disputed domain name, from 31 January 2016 onwards.



7.28. Evidence from Internet Archive - Archive.org is considered a reliable source of evidence and often referred in Domain Dispute matters. Under INDRP, it was referred in the matter of Eterno Infotech Pvt. Ltd. V Zheng Wei <www.HuntNews.in> [INDRP Case No 782] and also in the matter of Facebook, Inc. v. Domain Admin, Privacy Protection Service Inc. d/b/a PrivacyProtect.org / Ông Trần Huỳnh Lâm, "the screen captures from www.archive.org were considered to see where the disputed domain was previously resolving to "<http://360facebook.blogspot.com>>", as presently the disputed domain name was not resolving anywhere" [Case D2016-0771]. Even the WIPO Overview 2.0, recognizes the Archive.org and any attempt to block access to Archive.org by use of 'robots.txt' file is considered as bad faith.

7.29. In 2015, before the website on the disputed domain was shut down in January 2016, there has been some correspondence between the previous owner and the Complainant No 1 as to installation of GeoTrust SSL certification upon the disputed domain name in Aug-Sept 2015 as per the annexure provided by the Respondent. It seems, the previous domain owner being admin contact for the disputed domain name was required to send a confirmation before it could have been installed by GeoTrust. There seems to be delay caused by the previous owner Mr

Ashish Chordia, though whether it was finally confirmed by the Mr Ashish Chordia or not, it is not on record. Though lack of cooperation seems visible as Complainant No 1, had to issue reminder. In the next few months, it has been followed by change in Ownership/WHOIS information and shutting down of website in January 2016 itself.

- 7.30. That even if we assume for a moment, that the previous owner has intentionally changed the WHOIS information and closed down the website, but still the theory of new owner of the Disputed Domain Name holds good, as the **WIPO Overview 2.0** lays down in a negatively framed sentence - "that when it is clear that any change in Whois registrant data is not being made to conceal an underlying owner's identity for the purpose of frustrating assessment of liability in relation to registration or use of the domain name, only in that particular case, the new WHOIS information may not be deemed to be regarded as a new registration". That is, any deliberate changes to the WHOIS in an attempt to frustrate the Complainants bonafide rights in the domain name, even in such an alternative scenario the matter still will be upheld as the case for new registration only, from the date of change in WHOIS information and is to be proceeded accordingly. That is, the Respondent is Mr Abhishek Chordia only !

- 7.31. In many past UDRP decisions, this majority view as provided under paragraph 3.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, on change in WHOIS Info has been rightly upheld. Acquisition of a domain name licence by way of transfer or assignment is treated under the Policy as a new registration. [Dreamgirls, Inc. v. Dreamgirls Entertainment, WIPO Case No. D2006-0609 and Alpine Entertainment Group, Inc. v. Walter Alvarez WIPO Case No. D2007-1082].
- 7.32. In any case, the WHOIS details for any domain name truly represents who is the owner/registrant for the domain name, which is Mr Abhishek Chordia (*the Respondent*) in the present case. And a duty has been cast upon the Domain Registrant to maintain the WHOIS information correct and up to date at all times, else it leads to suspension of the Domain Name. The importance of maintaining correct WHOIS has been time and again emphasised by ICANN and also by various Registrars and Registries all over the world including Nixi. The same is also contained under clause 1 and 2 of the Terms and Conditions for .IN Registrants. Further, in the court proceedings the WHOIS search is considered to be a good and reliable source of information in ascertaining the details of the owner of an infringing domain name. [Hon'ble Delhi High Court in the matters of Superbrands Ltd. & Ors. vs Superbrand Home Care Products

on 25 September, 2009; John Wiley & Sons Inc. & Ors vs International Book Store & Anr. on 20 May, 2010; Tata Sons Ltd. & Anr. vs Arno Palmen & Anr. on 22 March, 2013; Microsoft Corporation & Anr. vs Kurapati Venkata Jagdeesh Babu & on 3 February, 2014 have relied on WHOIS search].

7.33. It is amply clear that there has been no active website on the date of filing of the Complaint and no legitimate use of the domain name being made. That is, there is no showing that 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. In the UDRP matter of Vestel Elektronik Sanayi ve Ticaret AS v. Mehmet Kahveci, it has been held that merely registering the domain name is not sufficient to establish right or legitimate interests. [WIPO Case No. D2000-1244].

7.34. Complainant contends Respondent's use of the said domain name is not in connection with a bona fide offering of goods or services. This is evident by the fact that the said domain name is completely unused by the Respondent up until the filing of the present complaint. Further, the Complainants doesn't seemed to have authorized the Respondent to

register or continue to hold such domain name registration. That is, no bona-fide offering of goods or services being made. Further in the UDRP matter of PepsiCo, Inc v. Paul J. Swider, it has been held that registration of a domain name which is identical to a complainant's famous mark and trade name is, in and of itself, evidence of bad faith [WIPO Case No. D2002-0561]

- 7.35. In the WIPO matter of American Home Products Corporation vs. Ben Malgiogli - "it was held that the Respondent's website is not operational and the Panel infers that it never has been. The Panel simply does not see such passive use to constitute a legitimate non-commercial or fair use without any intent to misleadingly divert consumers or tarnish the trademark or service mark at issue" [WIPO Case No. D2000-1602]. Further in the WIPO matter of Paris Hilton v. Deepak Kumar, if the owner of the domain name is using it in order "...to unfairly capitalise upon or otherwise take advantage of a similarity with another's mark then such use would not provide the registrant with a right or legitimate interest in the domain name. The Respondent's choice of the Domain Name here seems to be a clear attempt to unfairly capitalise on or otherwise take advantage of the Complainants' trademarks and resulting goodwill" [WIPO Case No. D2010-1364].

- 7.36. Further, there is no indication that Respondent is commonly known by that name or carrying on business under the name, corresponding to the disputed domain name or has any intellectual property rights over the term **DUCATI**. Further, obviously neither Complainant has assigned, granted, licensed, sold, transferred or in any way authorized the Respondent to use the distinctive mark **DUCATI** or to register the disputed domain name.
- 7.37. In the matter of Tercent Inc. v. Lee Yi, FA 139720 (Nat. Arb. Forum February 10, 2003) it was held: "nothing in Respondent's WHOIS information implies that Respondent is 'commonly known by' the disputed domain name as one factor in determining that Policy paragraph 4(c)(ii) does not apply". Also in the matter of Gallup Inc. v. Amish Country Store, FA 96209 (Nat. Arb. Forum Jan. 23, 2001) "finding that the respondent does not have rights in a domain name when the respondent is not known by the mark". Therefore, the Arbitrator finds that Respondent is not commonly known by the disputed domain name under Policy paragraph.
- 7.38. Respondent's domain name contains the Complainant's mark in its entirety, and the domain is not resolving to any website. Therefore, cannot be said to be making a bonafide or fair use of the domain name.

Rather by holding such a Domain Name, Respondent is trying to capitalize on the goodwill and reputation of the Complainant's mark **DUCATI**. The use of the disputed domain name <**ducati.co.in**> by the Respondent will most likely deceive the general public into believing that the disputed domain name, registered by the Respondent, is associated with or endorsed by the Complainants in some way. But the Complainants have not authorized the Respondent to register or continue to hold such domain name registration. Such registration and ownership of the disputed domain name by the Respondent restricts the Complainant's rights to use the said domain to its benefit and advantage. Also recently in January 2017, Hon'ble Delhi High Court: "With the domain name taking up the entire name of the Petitioner, there could be no doubt that the use of such domain name by the Respondent would be deceptively confusing and erroneously indicate a connection of Respondent No. 1 with the Petitioner when there is none". [Thoughtworks Inc vs Super Software Pvt Ltd. & Anr on 12 January, 2017 - O.M.P. 530/2015]

- 7.39. In the matter of Barlow Lyde & Gilbert v. The Business Law Group, it was laid down - that non-use of a domain name does not on its own constitute bad faith, other factors must be involved. An important element is that the complainant's mark is sufficiently well known such

that a registrant might reasonably be inferred to have registered an identical or confusingly similar domain name in the expectation of taking advantage of the trademark holder [WIPO Case No. D2005-0493].

7.40. In the INDRP matter of BASF V GaoGou, it was held that the registration of a domain name that is confusingly similar or identical to a famous trademark by an entity that has not relationship to the mark is sufficient evidence of bad faith registration and use. Internet users may believe that the Respondent's domain name is being operated or endorsed by the Complainants [INDRP/752 - basf.co.in].

7.41. Lastly, it is quite evident from the parked webpage at the disputed domain name that neither any legitimate, noncommercial or fair use of the disputed domain name being made, but the Respondent seems to have intentionally registered the disputed domain name, which reproduces Complainant's well-known trademark **DUCATI**, in order to capitalize / profit from the goodwill associated with the famous mark.

7.42. Given the long and widespread reputation of the Complainant's mark, the compelling conclusion is that the Respondent, by choosing to register and use a domain name which is not only confusingly similar to the Complainant's widely known and distinctive mark but identical,

intended to ride on the goodwill of the Complainant's trademark in an attempt to exploit, for commercial gain, Internet traffic destined for the Complainant. Potential partners and end users are led to believe that the website is either the Complainant's site, especially made up for the bearings, or the site of official authorized partners of the Complainant, while in fact it is neither of these [Viacom International Inc., and MTV Networks Europe v. Web Master, WIPO Case No. D2005-0321 – mtvbase.com].

- 7.43. In the circumstances, the Arbitrator concludes that the Complainant has established the requirement of paragraph 4 (ii) of the INDRP Policy, i.e. Respondent has no rights to or legitimate interests in the disputed domain name.

C. Registration and Use of a Domain Name in the Bad Faith

- 7.44. For the purposes of Paragraph 4(iii), the following circumstances, in particular but without limitation, if found by the Arbitrator to be present, shall be evidence of the registration and use of a domain name in bad faith:

- 7.44.1. (i) circumstances indicating that the Registrant 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 bears the name or is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented out-of-pocket costs directly related to the domain name; or

7.44.2. (ii) the Registrant 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 the Registrant has engaged in a pattern of such conduct; or

7.44.3. (iii) by using the domain name, the Registrant has intentionally attempted to attract Internet users to the Registrant'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 Registrant's website or location or of a product or service on the Registrant's website or location.

7.45. As already discussed herein-above, the change in WHOIS in this domain dispute matter constitutes the new ownership from the date of change in WHOIS, i.e. transfer of the disputed domain <**ducati.co.in**>. Therefore, the update date of 31 January 2016, in which ownership was transferred is the date of new registration for the purposes of INDRP Policy. The

change in WHOIS shows the name of the new Registrant, Admin, Technical contact as Mr Abhishek Chordia with Jaipur Address, i.e. the Respondent only.

7.46. INDRP casts a duty upon the Domain Registrant/Respondent in terms of clause 3(b) of the INDRP Policy as well, to do a research before registering a domain name so that it does not violate a third party's rights. The complainant contends that the Complainants use of mark goes back to 1926 and has acquired immense goodwill and popularity over the last nine decades and has a huge social media presence as well. As simple google search can reveal that the **DUCATI** brand is associated with the Complainants and is being used by them in their trade and business.

7.47. The Registrant represents that the registration of the Domain Name will not infringe upon or otherwise violate the rights of any third party, as follows:

Clause 3 of INDRP Policy reads as follows:

By applying **to register a domain name**, or by asking a Registrar to maintain **or renew** a domain name registration, the Registrant represents and warrants that:

- (a) the statements that the Registrant made in the Registrant's Application Form for Registration of Domain Name are complete and accurate;
- (b) to the Registrant's knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party;
- (c) the Registrant is not registering the domain name for an unlawful purpose; and
- (d) the Registrant will not knowingly use the domain name in violation of any applicable laws or regulations.

7.48. It has been laid down in the INDRP matter of ITC Limited v Travel India that registration of Domain Name which is identical to a trademark, with actual knowledge of the trademark holder's rights, is strong evidence that the domain name was registered in bad faith [INDRP Case No 065]. Also in the matter of The Caravan Club v. Mrgsale, FA 95314 it was held that registration of a well-known trademark by a party with no connection to the owner of the trademark and no authorization or legitimate purpose to utilize the mark reveals bad faith.

7.49. That the Respondent's ownership of the disputed domain name **<ducati.co.in>** shows the malafide intent on its part to earn undue

advantage by capitalizing on the goodwill and reputation of the Complainant's well-known mark **DUCATI**. Clearly, the disputed domain name **<ducati.co.in>** incorporates the said Complainant's mark in its entirety. Recently in January 2017, Delhi High Court held: "With the domain name taking up the entire name of the Petitioner, there could be no doubt that the use of such domain name by the Respondent would be deceptively confusing and erroneously indicate a connection of Respondent No. 1 with the Petitioner, when there is none". [Thoughtworks Inc vs Super Software Pvt Ltd. & Anr on 12 January, 2017 - O.M.P. 530/2015]

- 7.50. The Complainant have registered and used many country specific ccTLDs like *Ducati.com.au* for Australia, *Ducati.fr* for France, *ducati.de* for Germany, *Ducati.co.jp* for Japan to provide information as to about their bikes, various events, owner's clubs, dealers and so on. Moreover, the disputed domain **<ducati.co.in>** also had website or over 4 years, almost till the time, when the disputed domain seems to have been acquired by the Respondent. Under the Policy, it is evidence of bad faith registration and use that by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 or your web site or location of a product or service on your web-site or location.

7.51. Further, given the Complainant's mark / brand popularity, as the Complainant's websites are extremely popular and attract a colossal traffic from visitors across the globe due to ecommerce / online shopping facility at <http://shop.ducati.com> for 39 countries. Therefore, the use of substantially similar or identical mark, the Respondent has intentionally attempted to attract Internet users to the said website, by creating a likelihood of confusion with the Complainant's Trademark as to the source, sponsorship, affiliation, or endorsement of the said domain name. In the INDRP matter of Lego Juris V Robert Martin, it has been held that "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" [INDRP/125 - lego.co.in].

7.52. Therefore, given the immense goodwill and popularity acquired by the Complainants even in India, the act of acquisition of the Domain Name indicates Bad Faith on behalf of the Respondent and it is safe to assume that Respondent already possessed the knowledge of **DUCATI** Trademark. This action of the Respondent clearly constitutes an attempt

to free-ride on the Complainant's goodwill and reputation. The Respondent has sought to squat/hoard the said domain with mala fide intent and to the Complainant's detriment and prejudice.

7.53. In the INDRP matter of QRG Enterprises Limited and Havells India Limited V Zhang Mi - "The Complainant's prior adoption of the mark predates the Respondent's domain name registration of a name that is so obviously connected with the Complainants is suggestive of the Respondent's Bad Faith" [INDRP/852 - QRG.co.in]. Respondent seems to have intentionally registered the disputed domain name, which reproduces Complainant's well-known trademark "Ducati", in order to capitalize / profit from the goodwill associated with the famous mark. In the UDRP matter of Barney's Inc. v B N Y Bulletin Board - Only a person who is familiar with Complainant's mark could have registered a domain name that is confusingly similar [WIPO Case No D2000-0059].

7.54. In the matter of LACER, S.A. v Constanti Gomez Marzo [Case No. D2001-0177] - the lack of use of the domain name must also be re-examined under the perspective of good or bad faith. The lack of use by itself does not indicate anything. Nevertheless, the lack of use of a domain name that is not backed up by any trademark and that coincides with a known, well-known or renowned trademark owned by someone

else, does not indicate other than bad faith in the sense of paragraph 4(b) of the Policy. (Ingersoll-Rand Co. v. Frank Gully, d/b/a Advcomren, WIPO Case no. D2000-0021; Compaq Computer Corporation v. Boris Beric, WIPO Case no. D2000-0042; InfoSpace.com, Inc. v. Tenenbaum Ofer, WIPO Case no. D2000-0075; Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case no. D2000-0003; Association of British Travel Agents Ltd .v. Sterling Hotel Group Ltd, WIPO Case No. D2000-0086; Marconi Data Systems, Inc. v. IRG Coins and Ink Source, Inc., WIPO Case no. D2000-0090; Sanrio Company, Ltd. and Sanrio, Inc. v. Neric Lau, WIPO Case no. D2000-0172.

7.55. In the matter of Telstra Corporation Limited v. Nuclear Marshmallows [WIPO Case No D2000-0003] the question was considered as to what circumstances of inaction (passive holding) other than those identified in paragraphs 4(b)(i), (ii) and (iii) can constitute a domain name being used in bad faith ?

7.56. In the said Telstra matter, the Administrative Panel has considered whether, in the circumstances of this particular Complaint, the passive holding of the domain name by the Respondent amounts to the Respondent acting in bad faith. It concludes that it does. The particular circumstances of this case which lead to this conclusion are:

- 7.56.1. (i) the Complainant's trademark has a strong reputation and is widely known, as evidenced by its substantial use in Australia and in other countries,
- 7.56.2. (ii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the domain name,
- 7.56.3. (iii) the Respondent has taken active steps to conceal its true identity, by operating under a name that is not a registered business name,
- 7.56.4. (iv) the Respondent has actively provided, and failed to correct, false contact details, in breach of its registration agreement, and

Taking into account all of the above, it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law.

- 7.57. Clearly, the above factors are proved in the current matter of **<ducati.co.in>** as well, as the Complainant has a strong reputation due to well known mark globally on the one hand, on the other hand Respondent has failed to provide any evidence whatsoever of any actual or contemplated good faith use by it of the domain name and/or any

further documents including ID proof in support of his WHOIS Information.

- 7.58. Given the distinctiveness of the Complainant's mark it is reasonable to infer that the Respondent has registered the domain name with full knowledge of the Complainant's marks and uses it for the purpose of misleading and diverting Internet traffic.
- 7.59. In the UDRP matter of PepsiCo, Inc. v. "null", aka Alexander Zhavoronkov, it has been held that registration of a well-known trademark as a domain name may be an indication of bad faith in itself, even without considering other elements of the Policy [WIPO Case No. D2002-0562]. And given the popularity of the Complainant's www.Ducati.com website, the Complainant's mark **DUCATI** is acknowledged as a "well-known" mark, and is as such exclusively associated with Complainant's products/services.
- 7.60. In the matter of HSBC Holdings plc v Hooman Esmail Zadeh [INDRP Case No 032], it was held that non-use and passive holding are evidence of bad-faith registration. The evidence furnished by the Respondent does not give a plausible explanation as to why there was no use or the

domain name for more than two years. [Bayer Aktiengesellschaft v. Henrik Monssen, Wipo Case No D2003-0275]

7.61. In the WIPO matter of Ga Modefine, Giorgio Armani S.p.A. v. Kim Hontage - the Panel accepts the Complainant's arguments that the worldwide fame of the trademarks leaves no question of the Respondent's awareness of those at the time of the registration of the disputed domain names which wholly incorporate the Complainant's trademarks, as even recognized by numerous previous UDRP panels, [WIPO Case No. D2007-0851].

7.62. Even where the domain name has not been used to identify a web site, Panels have held that the ICANN Policy 'use in bad faith' requirement is met by registering a domain name that will ultimately result in consumer confusion. In the matter of CBS Broadcasting, Inc. v. LA-Twilight-Zone, [WIPO Case no D2000-0397] - finding bad faith where Respondent failed to provide any evidence to controvert Complainant's allegation that it registered the domain name in bad faith and where any future use of the domain name would do nothing but cause confusion with the Complainant's mark, except in a few limited noncommercial or fair use situations, which were not present.

7.63. In the circumstances, the Arbitrator concludes that the Complainant has established the requirement of paragraph 4 (iii) of the Policy i.e. both registration and use of the Domain Name in bad faith.

8. Decision:

8.1. Therefore, the Arbitrator concludes that the Complainant has established all the three essential elements to maintain its complaint being that the disputed domain name is identical or confusingly similar to its Trademark **DUCATI**; the Respondent has no rights or legitimate interests in respect of the disputed domain name; the Disputed Domain Name was registered or is being used in bad faith.

8.2. Consequently the Arbitrator orders that in accordance with INDRP policy that the disputed domain name **<ducati.co.in>** be transferred to the Complainant.



Ankur Raheja, MCA FCS LLB
Sole Arbitrator, NIXI, India
Date: 20th February 2017
Place: New Delhi