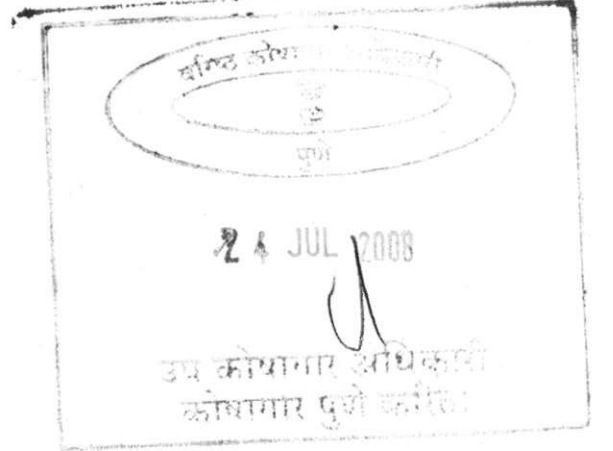




महाराष्ट्र MAHARASHTRA

BE 094560

नंबर ..... 239C ..... रुपये 2009-09  
दिनांक ..... 4/10/08 .....  
नाम ..... श्री. जयश्री बेल्सारे .....  
धत्ता ..... 268, शनिवार पेठ, पुणे-30 .....  
हरते ..... श्री. जयश्री बेल्सारे .....  
सौ. जयश्री बेल्सारे, स्टॅम्प केंद्र, ला.नं. - हवेली 1/36/9994  
424 ब, शनिवार पेठ, पुणे-30



**AWARD.**

IN ARBITRATION  
DISPUTE BETWEEN

- (1) Franke Holding AG  
Franke-Strape 2, 4663 Aarburg, Switzerland
- (2) Franke India Private Limited  
Dr.E.Moses Road, Mumbai. 400011.  
India

THE COMPLAINANT

**REPRESENTED BY ATTORNEY: -**

**Bartsch und Partner, Attorneys-at-Law**

BahnhofstraPe 10, 76137 Karlsruhe, Germany

**AND**

**Andreas Franke**

Hermann-von-der-Becke-Strape 11

58675 Hemer

Germany

**THE RESPONDENT**

**REPRESENTED BY ATTORNEY: -**

**Remfry & Sagar**

Attorneys at Law

Remfry House at the Millennium Plaza

Sector - 27

Gurgaon. 122002.

**IN THE MATTER OF DISPUTED DOMAIN NAME: - franke.in'**

**CASE NO. - NOT ALLOTTED BY NATIONAL INTERNET EXCHANGE OF  
INDIA (NIXI)**

**BEFORE MR.S.C.INAMDAR, B.COM. LL.B., F.C.S**

**SOLE ARBITRATOR**

**DELIVERED ON THIS 5th DAY OF AUGUST TWO THOUSAND EIGHT.**

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**I] SUMMARISED INFORMATION ABOUT THE DISPUTE: -**

**01. Names and addresses**

**Of the Complainants: -**

(a) Franke Holding AG

Franke-StraPe 2

4663 Aarburg

Switzerland

(b) Franke India Private Limited

Dr.E.Moses Road

Mumbai. 400011.

**02. Name of the Authorised**

**Representative of complainant: -** Bartsch und Partner, Attorneys-at-Law

BahnhofstraPe 10

76137 Karlstruhe

Germany

Phone: +49(0)721/93175-52

Facsimile: +49(0)721/93175-88

Email: [js@bartsch-partner.de](mailto:js@bartsch-partner.de)

**03. Name and address of**

**The Respondent: -**

Andreas Franke

Hermann-von-der-Becke-StraPe 11

58675 Hemer

Germany

Phone: +49(0)2372/902210

Fascimile: —

Email: [andreas.franke@freenet.de](mailto:andreas.franke@freenet.de)



04. Name and address of the  
Authorised representative

Of the Respondent:

Remfry & Sagar  
Attorneys at Law  
Remfry House at the Millennium Plaza  
Sector - 27  
Gurgaon. 122002  
Phone: 0124-2806100  
Fax: 0124-2806101  
Email: [remfry-sagar@remfry.com](mailto:remfry-sagar@remfry.com)

05. Calendar of Major events:

Sr. No.	Particulars	Date (Communications in electronic mode)
01	Arbitration case was referred to me	04/07/2008
02	Acceptance was given by me	04/07/2008
03	Complaint physically received by me	09/07/2008
04	Notice of arbitration was issued	10/07/2008
05	Submission of reply by the Respondent	17/07/2008
06	Issue of notice to the Complainant to submit his say on the reply of the Respondent	17/07/2008
07	Submission of say by the Complainant	21/07/2008
08	Issue of notice to the Respondent to submit his rejoinder on the Complainant's say	22/07/2008
09	Respondent's complaint about non-receipt of certain annexures to the Complainant's say	22/07/2008
10	Issue to the Complainant to submit his say on the Respondent's complaint	23/07/2008



11	Submission of the said annexures by the Complainant	23/07/2008
12	Issue of notice to the Respondent to submit his rejoinder	24/07/2008
13	Submission of rejoinder by the Respondent	28/07/2008
14	Issue of Notice to the Complainant to submit his final say on the rejoinder of the Respondent	28/07/2008
15	Submission of the say by the Complainant	30/07/2008
16	Issue of notice to the Respondent to submit his final say	31/07/2008
17	Submission of the final say by the Respondent	1/08/2008

**PRELIMINARY: -**

- 1) Franke Holding AG is a parent company of the Franke Group of companies having its registered office in Switzerland. It has 80 group companies all over the world. One of them is Franke India Private Limited, a company incorporated under the provisions of the Companies Act, 1956 having its registered office at Mumbai. (Jointly referred to as **The Complainant**)
- 2) Since the Complainant is holder of various trademarks / service marks with the word Franke and it is also a part of its corporate name, it has disputed registration of domain name **franke.in'** (**the disputed / domain name**) in the name of Mr. Andreas Franke, Germany. (**The Respondent**).
- 3) The complaint was first referred to Mr. Manoj Bhatt, panel arbitrator of National Internet Exchange of India (NIXI), who did not give award in the matter.



- 4) Thereafter the compliant was withdrawn by NIXI from Mr.Bhat and referred to me under .IN Domain Disputes Resolution Policy (INDRP).
- 5) Major events took place as enumerated in the above table.

### **II] PROCEDURE FOLLOWED IN ARBITRAION PROCEEDINGS: -**

01. In accordance with INDRP read with INDRP Rules of Procedure, copies of all communications between me and parties and vice-versa were marked to each other including copy to NIXI.
02. Sufficient opportunities were given to both the Complainant and the Respondent to submit their say and rejoinders.
03. After final opportunity given to both the parties to the dispute evidence was closed.
04. Both the parties cooperated in arbitration proceedings by expeditiously submitting their say / rejoinders from time to time.

### **III] SUMMARY OF THE COMPLAINT: -**

(A) The Complainant has raised, *inter-alia*, following important objections to registration of disputed domain name in the name of the Respondent and contended as follows in its Complaint: -

- a) The Complainant is a parent company having its registered office in Switzerland. It has about 80 companies world over. The use of trade name Franke by the group can be traced back to 1911. The Complainant No. 2 is its subsidiary company in India. The main business activity of this group is to manufacture and market kitchen sinks, kitchen appliances, washroom and sanitary systems, food service systems, beverage systems etc. The group has excellent reputation within its industry.

- b) The Respondent, as a private individual, has acquired the disputed domain name from the previous holder of this domain - Mr. Markus Herbig. The Respondent does not use the domain for his own purposes. Instead, the same is used to offer a so-called "Email and Sub-domain service" which is operated by previous holder of the domain Mr. Markus Herbig. The Registrant Mr. Markus Herbig promoted a shopping portal **Bestpreis.Info = bestprice.info' (shopping portal)** on the disputed domain name, in which among other things, the products of the Complainant were also offered.
- c) The Complainant itself or through its group companies is holder of various trade marks all over the world. The registration of trade mark in India could not be completed before the closure of Sunrise Period as envisaged under INDRP and hence benefit of registering the disputed domain name in the name of the Complainant could not be availed.
- d) Mr. Markus Herbig did not have any rights on and to the designation FRANKE and abused the disputed domain name by promoting shopping **portal'Bestpreis.Info = bestprice.info'**, in which among other things, kitchen and household appliances were offered, which was a clear cut infringement of legitimate interests and rights of the Complainant. **Similarly he offered through this site about 80 .in domain names registered in his name.** The Complainant, therefore, had filed a law suit against Mr. Markus Herbig before the Trade Mark Litigation Division of the Regional Court for Farnkfurt am Main. After filing of the law suit before the said court but during the court proceeding, Mr. Markus Herbig transferred the disputed domain to the present Respondent with the exclusive intention of avoiding a court order directing him to relinquish the domain. Thus there is a violation of INDRP Paragraph 12 by Mr. Markus Herbig and the Respondent.



- e) The said Court passed a judgement against Mr.Markus Herbig and among other things, directed to refrain from using the disputed domain name. Mr.Markus Herbig made an appeal against the said order to the Higher Regional Court Frankfurt / Main. The said Higher Court rejected the appeal and also ordered that no further appeals were permitted as the legal matter did not find any fundamental impact.
- f) Despite orders of the Hon. Courts, Mr.Markus Herbig continues to be registered as 'Admin' of the disputed domain. The use of the impugned domain name franke.in by the Respondent is solely with *mala fide* intentions in order to deceive the potential consumers of the Complainant's product.

**(B) DOCUMENTS PRODUCED BY THE COMPLAINANT** - In support of its contentions the Complainant has furnished, *inter-alia*. copies of the following important documents: -

- (i) List of Franke Group companies and detailed addresses
- (ii) Copies of commercial brochures
- (iii) Turnover details
- (iv) Certificate of Incorporation of Franke India Private Limited
- (v) Screenshot of [www.franke.in](http://www.franke.in) as on 16<sup>th</sup> April 2007
- (vi) Extract from the Commercial Register of the canton Aargau (Main Register) regarding registration of trade marks
- (vii) Extract from the corporate web site [www.franke.co.in](http://www.franke.co.in) as of 16<sup>th</sup> April 2007
- (viii) Extract from WHOIS database of IN registry as on 7<sup>th</sup> November 2005
- (ix) Screenshot of [www.franke.in](http://www.franke.in) as on 12<sup>th</sup> December 2005
- (x) Certificate of Registration of Trade Mark issued by Trade Marks Registry, Government of India





- (xi) Power of Attorney favoring Bartsch und Partner issued by Franke Holding AG and Franke India Private Limited.
- (xii) Copy of judgement given by Regional Court Frankfurt / Main with its certified English translation
- (xiii) Copy of judgement given by Higher Regional Court Frankfurt / Main in the appeal made by Mr.Markus Herbig with its certified English translation
- (xiv) Undertaking to cease and desist given by Mr.Markus Herbig
- (xv) Authorisation in favor of Franke Holding AG and Franke India Private Limited given by Nero-Plan AG
- (xvi) Copies of correspondence with NIXI and previous arbitrator, says, rejoinders etc. filed with previous arbitrator

**IV] REPLY TO THE COMPLAINT / STATEMENT OF DEFENSE: -**

In response to the Complainant and rejoinders of the Complainant, the Respondent has submitted his reply and rejoinders. The main contentions of the Respondent are as follows: -

- a. The Complaint has been filed by Bartsch & Partner, Attorneys at Law based in Germany. According to Section 33 of the Advocates Act, 1961 they are not entitled to represent the Complainant in the Arbitration proceedings.
- b. The Respondent had entered into agreement in the year 2004 with Mr.Markus Herbig to register domain name, design the website and to administer and maintain the same. In pursuance this agreement Mr.Markus Herbig transferred the disputed domain name to the Respondent.
- c. The District Court Frankfurt had decided the issue of trade mark infringement against the Complainant No.1.



- d. There is a considerable population with the common surname Franke in Switzerland and Germany and therefore use of the disputed domain name is bona-fide on the part of the Respondent.
- e. In accordance with Paragraph 18(a) of Uniform Domain Name Disputes Resolution Policy (UDRP) (according to the Respondent from which INDRP has been derived) these arbitration proceedings are liable to be terminated or suspended.
- f. According to Section 35 of the Trade Marks Act, 1999, the holder of a registered trade mark can not interfere with any bona fide use by a person of his own name, his place of business, or of the name. In the present case the Respondent Mr.Franke can not be prevented from using disputed domain name due to his surname being involved in it.
- g. The trade mark in India has been registered in the name of Niro-Plan AG, Germany and not in the name of the Complainant(s) and as such they are not entitled to protection as holders of registered trade mark.
- h. The Complainant can not claim monopoly rights over the disputed domain name in the light of over 27000 bearers of the surname Franke including the Respondent.
- i. The goods / services sold / provided by the Complainant NO.1 are distinct and different from the services of the Respondent.
- j. The Respondent's objective behind registering the domain name franke.in is to set up email addresses and homepages for the benefit of approximately 27000 persons bearing the surname Franke.
- k. A search in whois.net for domain names comprising the word FRANKE reflects 94546719 registered domain names and 37650475 on hold domains. Therefore the Complainant can not claim monopoly over the name FRANKE.

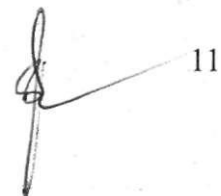


1. If the Complainant's pleas of monopoly is accepted then thousands of persons having Franke as their surnames who are carrying out business using the said name would lose their rights to use the same which can not stand the test of law.
- m. The Complainants have registered domain names 'franke.co.in' and 'franke.om' to which the Respondent has not prevented them for doing so.
- n. The objective of the Respondent in registering the disputed domain name is to provide homepages / email services / sub-domains to bearers of the surname FRNKE whereas the Complainants are engaged in the business of kitchen sinks etc. Thus the objectives are totally different and hence there is no likelihood of any confusion in the minds of internet users.
- o. The Complainants are trying to exploit the Alternate Dispute Resolution Procedure for "Reserve Domain Name Hijacking".
- p. The Respondent denies that disputed domain name infringes the legitimate rights / interests of the Complainants.
- q. The Complainants did not register the disputed domain name during the sunrise period. They realized about the registration requirement in February 2005 but took legal action before NIXI after almost two years to protect their rights.

**VJ DOCUMENTS FURNISHED BY THE RESPONDENT: -**

In support of its contentions the Respondent has furnished, inter-alia, copies of the following documents: -

1. Relevant extract from The Advocates Act, 1961 and a copy of the resolution dated February 8, 1997 passed by the Bar Council of India.
2. A search in whois.net for domain names containing the word Franke

 11

3. A host of extracts from various websites such [www.houseofnames.com](http://www.houseofnames.com), London Postal Directory etc. in evidence of wide use of the word franke, frank, franks, frankes, frenk, etc.

**VI] ISSUES & FINDINGS: -**

On the basis of policies and rules framed by NIXI in respect of dispute resolution as also on the basis of submissions of both the parties I have framed following issues. My finding on each issue is also mentioned against it respectively.

<b>SR. NO.</b>	<b>ISSUE</b>	<b>FINDING</b>
01	Whether the Attorneys-at-Law M/s Bartsch und Partner, Germany, are entitled to represent the Complainant in this arbitration proceeding?	Yes
02	Whether the Complainant could establish their nexus with the registered trade marks and as such whether they are entitled to protect their rights / interests in the same?	Yes
03	Whether the Registrant registered domain name primarily for selling, renting or otherwise transferring it?	Yes
04	Whether the Registrant's domain name is identical or confusingly similar to a name or trademark in the Complainant has rights?	Yes
05	Whether the disputed domain name was being used in bad faith and with the intention to deceive the internet users?	Yes
06	Whether the Respondent is holder of any registered trademark or service mark and accordingly has any right or legitimate interest in respect of disputed domain name?	No
07	Whether the disputed domain name was transferred pending court proceedings?	Yes



08	Whether the Registrant / Respondent has registered domain name in bad faith?	Yes
09	Whether the Registrant is using the domain name before notice to him / has demonstrated considerable preparation to use in good faith?	No
10	Whether the Registrant has commonly been known by the domain name?	No
11	Whether the Registrant has registered the disputed domain name to intentionally attempt to attract internet users to the website by creating confusion with the Complainant's name?	Yes

**VII] BASIS OF FINDINGS: -**

**ISSUE NO.1:**

**The Respondent has raised preliminary objection that M/s Bartsch und Partner can not file this complaint and can not represent the Complainant in view of the provisions of the Advocates Act, 1961 and also in view of the resolution passed by the Bar Council of India.**

**FINDING: -**

The cited provisions are in respect of representing other party before Hon. Courts in India. The Respondent has failed to bring out any provision under the Arbitration Act, 1961 or INDRP / Rules of procedures which would prohibit M/s Bartsch und Partner, to represent the Complainant.



ISSUE NO.2

**The Respondent's second objection is that the Complainants do not have trademark registered in their names. Therefore they can not have status of holder of registered trade mark for this arbitration proceeding.**

FINDING

The Complainant No.1 has produced several documents which establish that it is a group of companies of more than 80 companies. Complainant No.2 is one of them. The holder of registered trade mark Niro-Plan AG, Germany, is also among the group companies of Franke Holding AG, which is a parent company and Complainant No. 1 herein. Under the present commercial world there is a method of creating holding - subsidiary relationship or group company relationship to spread business in different businesses or over more than one country. This relationship always has vested cross interests among those companies. The Complainant No.1 has produced a list of companies under its group and Niro-Plan AG is one of them. Hon. The Regional Court Frankfurt / Main in its Judgement dated 02.08.2006 (where the Complainant No. 1 was Plaintiff and present Respondent Mr.Markus Herbig was the Defendant) has observed on page no.No.7/11 as follows: -

*"However the Plaintiff also has the power of active representation in this regard. After all, just as in a dispute over a domain name where the parent company within a group of companies must be treated as if it were itself entitled to carry the name in question if it has permitted the registration of the company name of a subsidiary with the latter's consent as a domain name. The parent company within a group of companies also has the right to object to the registration of a domain name by an unauthorized third party in the event of the infringement of the company name that has been derived from its own name."*



Moreover the Complainant No.1 produced Authorisation Letter from Niro-Plan AG to represent them in protecting their trade marks rights / interests in the present arbitration matter. The Complainant No.2 has also executed similar letter and therefore the Complainant No.1 is sufficiently authorized to file this complaint on behalf of them.

### **ISSUE NO.3**

**Whether the Registrant registered domain name primarily for selling, renting or otherwise transferring it?**

### **FINDING**

The Respondent has admitted the fact that the disputed domain name was registered by one Mr.Markus Herbig, in his own name. The Respondent's contention is that there was an agreement between him and Mr.Herbig in the year 2004 to register the domain name in Mr. Markus's name, to develop the same and then to transfer it to the Respondent. It was a sort of professional assignment to Mr.Markus Herbig and therefore there is nothing illegal or immoral in this sale of domain name to the Respondent. The Respondent has not produced any copy of the said agreement during arbitration proceedings.

The Complainant has produced a screenshot of the website of the disputed domain name when it was registered but was not transferred to the Respondent. Mr.Markus Herbig did not have any rights on and to the designation FRANKE and abused the disputed domain name by promoting shopping portal, in which among other things, kitchen and household appliances were offered, which was a clear cut infringement of legitimate interests and rights of the Complainant. Had it been a case of genuine website development professional assignment, Mr.Markus would not have ventured in this type of portal in his own name. He would have developed the website to suit the objectives as stated by the Respondent in his statement of defense, like email services to Frankes, sub-domain services to franks etc. Obviously intentions of Mr.Markus Herbig, as evident from the said screenshot of the then website, do not match with the Respondent's representations

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in this regard. I am therefore of the opinion that Mr.Markus Herbig registered the domain name primarily for selling / transferring / letting out the same and not for his personal use.

#### **ISSUE NO.4**

**Whether the Registrant's domain name is identical or confusingly similar to a name or trademark in which the Complainant has rights?**

#### **FINDING**

The name of the Complainant No.1, Complainant No.2 include the word 'Franke' very prominently. The Registrant's name is Mr.Markus Herbig which does not have any similarity or closeness to the names of the Complainant or their trademarks. Mr.Markus Herbig did not own any trade mark or service mark anywhere in the world, having the word 'Franke' in it. Obviously the Registrant's domain name is identical or confusingly similar to the names of the Complainant and trademarks owned by them, directly or through their group companies.

#### **ISSUE NO.5**

**Whether the disputed domain name was being used in bad faith and with the intention to deceive the internet users?**

#### **FINDING**

Admittedly Mr.Markus Herbig was using the website and disputed domain name for promoting shopping portal. Interestingly a link to the website / products of the Complainants was also provided in the portal. The contention of the Respondent is that professional assignment was given to Mr.Markus Herbig to register and develop website for itself. If this is accepted, I am constrained to draw a conclusion that the Respondent





was fully aware about this portal promoted by Mr.Markus Herbig and that it was with the consent of the Respondent to the same. The Respondent should have taken objection to this and should have taken all steps to prevent Mr.Markus Herbig from doing so. Unfortunately the Respondent has failed to produce any copy of the said agreement between him and Mr.Markus Herbig for such professional assignment.

Similarly the information regarding agreed consideration, terms of payment and other details about the said agreement are not available. Therefore, assuming that there did exist such agreement, the reasonability of the Respondent's contention about this professional assignment can not be verified. This all leads to a conclusion that the disputed domain name was being used in bad faith and with the intention to deceive the internet users.

#### **ISSUE NO.6**

**Whether the Respondent is holder of any registered trademark or service mark and accordingly has any right or legitimate interest in respect of disputed domain name?**

#### **FINDING**

Neither the Registrant nor the Respondent is holder of any of trade mark / service mark which includes the word 'franke'. No document has been produced in this connection. Similarly the Respondent has not claimed having any such trademark in any of his replies, rejoinders, statements. It is therefore clear that neither the Registrant nor the Respondent have any trademark or service mark which would make them entitle to the disputed domain name.

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## **ISSUE NO.7**

**Whether the disputed domain name was transferred pending court proceedings?**

### **FINDING**

Yes. This is a peculiar case where the Registrant and the Respondent are different. The Complainant No.1 filed a suit in the Regional Court Frankfurt / Main vide Docket No. 2/6 O 617/05 against Mr.Markus Herbig, the Registrant of the disputed domain name. In this case the judgement was given on 9<sup>th</sup> / 23<sup>rd</sup> August 2006 against the Registrant / Defendant Mr.Markus Herbig. But before the judgement was delivered, Mr.Markus Herbig transferred the domain name in favor of the present Respondent pending the court proceeding. Copies of the judgements including its certified English translated versions have been produced by the Complainant.

## **ISSUE NO.8**

**Whether the Registrant / Respondent has registered domain name in bad faith?**

### **FINDING**

The Registrant did not have any trade mark / service mark which could have entitled him to the disputed domain name. Moreover he was promoting shopping portal on the disputed domain name. According to the Respondent, Mr.Markus Herbig, the Registrant was entrusted with the responsibility of registering domain name, developing it and then transferring it to the Respondent. It means that the Respondent was fully aware of what Mr.Markus Herbig was actually doing with the disputed domain name. If this position is admitted, it leads to a conclusion that the Registrant / Respondent registered domain name in bad faith.



#### **ISSUE NO.9**

**Whether the Registrant is using the domain name before notice to him / has demonstrated considerable preparation to use in good faith?**

#### **FINDING**

The Registrant has already transferred the disputed domain name in favor of the Respondent. Before the said transfer to the Respondent, he promoted shopping portal, installed links to various other products / websites including that of the Complainant No.1. This was totally different from the stated objectives of the Respondent for claiming the disputed domain name. Therefore it can be concluded that there were demonstrated considerable preparations for using the domain name but they were not in good faith.

#### **ISSUE NO.10**

**Whether the Registrant has commonly been known by the domain name?**

#### **FINDING**

The name of the Registrant was Mr.Markus Herbig which has no similarity or connection with the domain name. However the Respondent Mr.Andreas Franke has relevance to the disputed domain name to a limited extent of having surname Franke.

#### **ISSUE NO.11**

**Whether the Registrant has registered the disputed domain name to intentionally attempt to attract internet users to the website by creating confusion with the Complainant's name?**

## **FINDING**

The Registrant registered the disputed domain name intentionally to attempt to attract internet users to the website by creating confusion with the Complainant's name. Due to the Court Order the Respondent has suspended use of the domain name and put up a notice to that effect on the disputed domain name.

### **VIII] OTHER IMPORTANT FACTS: -**

1. The instant case is a peculiar case where the Registrant is different from the present Respondent. The Registrant registered the domain name, developed shopping portal and when a law suit was filed by the Complainant, pending decision of the court, transferred the domain name to the Respondent. This fact has been admitted by the Respondent in Para 7 under 'Reply to the facts and circumstances' of his reply to the complainant.

2. The contention of the Respondent that there was an agreement between the Respondent and Mr. Markus Herbig is not supported by any document. Assuming for the sake assumption, that there really did exist such agreement between the Respondent can not shrug off his responsibilities for all misdeeds of Mr. Markus Herbig like promoting shopping portal etc.

3. The Regional Court Frankfurt / Main stated in its judgement as follows: -

**"The Defendant (Mr. Markus Herbig) shall, to avert the payment of a fine of upto EUR 250,000 or in absence of the same, arrest - or arrest for upto six months - for each instance of a violation of said judgement, cease and desist from the use - either on its own or through third parties - the name franke' as a second level domain of an Internet domain** beyond the scope of offering a portfolio . . . .". This clearly goes against the Registrant so far as his intentions and legitimate interests in the disputed domain name are concerned.



4. The Respondent has proved that his surname has direct nexus with the disputed domain name. He has also proved that there are several thousands people in Switzerland and Germany having surname Franke. However other contentions and objections have not been substantiated by the Respondent.

**5. In response to the Plaintiff's Attorney's letter dated 28.04.2005 the Registrant / Defendant refused to delete the domain. However he indicated possible willingness to transfer the domain for a reasonable compensation by projecting anticipated income from the site to be EUR 60000 in five years. This is recorded in the Judgement of Hon. Regional Court. It very clearly establishes the fact that the Registrant in fact registered domain name with the sole objective of selling the same at opportune time.** Upon transfer of the domain to Mr.Andreas Franke (present Respondent) the Registrant jointly with the Respondent declared that Plaintiff's (present Complainant) demand that the Defendant desist from the transfer had been settled. It thus appears to be a conspiracy between the Registrant and Respondent to deprive the Complainant of its lawful rights in the domain.

6. The Hon. Regional Court also stated in the basis of judgement as follows: -

"The company name of Franke GmbH (a company from the group of the Complainant) has been infringed upon by the utilization of the domain by the Defendant. **If an unauthorized party uses a third party name as a domain name, this must be considered a name seizure, as it results in the confusion of identities and infringes upon legitimate interests of the bearer of the said name eligible for protection.**" Thus it is proved beyond doubt that Mr.Markus Herbig did not have any legitimate interest or right to the disputed domain name. The decision of this; court was also confirmed by the Hon. Higher Court, Frankfurt.

7. The Respondent has challenged the present Complaint on the principle of *res judicata*. However it is pertinent to note that German courts have no jurisdiction over Indian



Territory. The Respondent has not made out any case of any other pending litigation in Indian courts. As such the principle can not be applied to present arbitration proceeding.

8. Since the Appeal in the Higher Court Frankfurt am Main has also been decided and copy of the same has been provided to me, the challenge by the Respondent on the basis of Paragraph 18(a) of Uniform Domain Name Dispute Resolution Policy is not tenable.

9. The Respondent has challenged the Complaint on the basis of Section 35 of Trade Marks Act, 1999, with emphasis supplied to certain words. The words read as follows: - "Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with any *bona fide use by a person of his own name*". The emphasis is on bona fide use, which unfortunately the Respondent has failed to establish due to misdeeds of the Registrant and mala fide transfer of disputed domain name in connivance with the Respondent. Similarly the use of his own name for general purpose is not interfered, nor there any intention to interfere, by the Complainant in any way.

10. The Respondent himself in Para 4 of Preliminary Submissions has mentioned: -

However since the trade name issue was not resolved by the said court in favor of Mr. Markus Herbig, and the Respondent, Mr. Markus Herbig decided to file an appeal with the Court of Appeal Frankfurt am Main." It thus becomes very clear that all the acts, deeds and things, which Mr. Markus Herbig did, were with the approval and support of the Respondent.

11. The Respondent has stated that the Complainant is trying to monopoly over the mark / name FRANKE *in rem*. At other place it has also stated that it has not prevented the Complainant from registering the domain names "franke.co.in" and 'franke.com'. If the word Franke is so important and so many thousands of people are going to be affected due to domain dispute pertaining to farnke.in', it is not understood why the same opposition was not made by the Respondent to the Complainant's registering these other domain names.



13. The Respondent has failed to establish that he made demonstrable preparations to use the disputed domain name, except stating about his agreement with the Registrant, the copies of which have not been produced before me.

14. Due to above facts, it becomes clear that the Registrant did not have perfect, legal title to the domain name and became questionable due to his acts like putting up shopping portal on it. It is an established principle of law that no one can transfer perfect title to even a bonafide purchaser, if his own title is imperfect. Therefore even assuming that the Respondent purchased the domain in good faith and for consideration, he can not get perfect title to the disputed domain name.

15. The Complainants have produced several documents in support of their main contentions. Their contention of group companies, rights and interests in registered trade marks, infringement of these rights by the Registrant / Respondent and violation of INDRP / Rules of Procedure by transferring the disputed domain name pending court decision are all substantiated and accepted.


**IX] AWARD: -**

On the basis of findings and foregoing discussion I pass the following award: -

01. The Complainant is entitled to the disputed domain name - 'franke.in'. The Respondent shall transfer the same to the Complainant No. 1.
02. The parties will bear their respective costs of arbitration.

Pune.

Dated: - 05/08/2008

  
(S.C. INAMDAR)  
ARBITRATOR