



L.S.V. No.

महाराष्ट्र MAHARASHTRA

- 9 MAY 2006

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तळमजला, रूम नं. ७, गिरगांध, मुंबई-४०

क्र. ६७६ दिनांक

सर्वश्री/श्री/श्रीमती

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ARBITRATION PANEL DECISION

Direct Information Pvt Ltd vs. Daniel Fuehrer

Case No. AA 2006-0002, Domain Name : hotels.in

1 The Parties

The Complainant in this Arbitration proceeding is Direct Information Pvt Ltd ("the Complainant") incorporated and existing under the Indian Companies Act, 1956 having a place of business in 330, Link-Way Estate, Linking Road, Malad(W), Mumbai, India

The Respondent in this Arbitration proceeding is Mr Daniel Fuehrer ("the Respondent"), with a postal mailing address listed as Gustav-Heinemann-Str. 15a, Linden, Hessen - 35440, DE

2. The Domain Name and Registrar

The disputed domain name is <hotels.in>. The Registrar of the domain name is InternetX ("the Registrar").

3. Procedural History

This is a mandatory administrative proceeding submitted for decision in accordance with the INDRP (.IN Domain Name Dispute Resolution Policy) for Domain Name Dispute Resolution, adopted by the National Internet Exchange of India ("NIXI") on 28th June, 2005, (the "Policy"), INDRP Rules of Procedure, approved by NIXI on 28th June, 2005, (the "Rules") and The Indian Arbitration and Conciliation Act, 1996, any by-laws, rules and guidelines framed there under and the governing law prevailing in India.

By registering the disputed domain name with the Registrar, the Respondent agreed to the resolution of certain disputes pursuant to the Policy and Rules.

According to the information provided by the National Internet Exchange of India (the ".IN Registry"), the history of this proceeding is as follows:

The Complainant filed its Complaint with the .IN Registry by email and in hardcopy along with the referenced annexure.

The .IN Registry requested and obtained from InterNetX GmbH, the registrar of the disputed domain name, verification that the domain name is registered with InterNetX GmbH and the Respondent is the registrant for the domain name.

The .IN Registry having verified that the Complaint satisfied the formal requirements of the Policy and the Rules, the .IN Registry formally commenced this proceeding and delivered to the Respondent notice of the Complaint and commencement of this proceeding. The hard copy of the Complaint along with all annexure was successfully delivered to the Respondent on 10th March 2006.

The Arbitrator with .IN Registry, Uttam Prakash Agarwal ("the Arbitrator"), agreed to act as Arbitrator in this proceeding and filed the necessary Statement Of Acceptance and Declaration Of Impartiality And Independence, and on 20th Feb, 2006, was duly appointed by the .IN Registry.

The Respondent requested an extension for filing a reply, which was granted, and the Respondent filed the reply on 31st March 2006.

The Complainant filed a rejoinder on 17th April 2006.

4. Factual Background

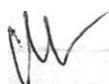
The following information is derived from the Complaint and supporting evidence submitted by the Complainant.

(1) Complainant is a well-known reputed Web Services provider in India and worldwide and provides various products and services across the globe.

(2) Complainant owns a trademark on and is actively using the name "hotel" in India since year 2000.

(3) Complainant also runs websites by the name www.hotel.in and <http://hotel.in.directi.com>

(4) The disputed domain name was registered by the Respondent on 16th Feb 2005



5. Parties' Contentions

(a) Complaint

The Complainant in their complaint stated the following:

1. The disputed domain name is confusingly similar to Complainant's mark in that it is simply the plural form of the mark.
2. The disputed domain name is identical to the name of the Complainant in that it is the same as the website run by the Complainant <http://hotels.in.directi.com>.
3. The Respondent has no legitimate rights to the said domain name and the Respondent is a domain name speculator in the business of buying and selling domain names.
4. The Respondent has registered the domain name in bad faith for the sole intention of selling it at high profits.

(b) Response

The Respondent in their response stated the follows:

1. The "burden of proof" for proving the criteria under para 4 of the Policy rests upon the Complainant.
2. The trademark of the Complainant is graphical in nature and as such does not represent the text form "hotels".
3. The trademark certificate shows that the said trademark was registered for the purpose of stationary and publishing.
4. The domain name has been registered by the Respondent not: with the intention of selling it, but with the intention to develop it into a website.

(b) Rejoinder

The Complainant in their rejoinder stated the following:

1. The "burden of proof" for invalidating the criteria in para 4 of the Policy rests upon the Respondent.
2. The trademark registry records both the graphical and the word form of the trademark. In this case the word form of the trademark is "hotel".
3. The trademark was registered under class 16 since that was the most appropriate class for online publishing at that time.
4. The registration of the domain name by the Respondent is in violation of INDRP Rule 3 in as much as the Respondent was made aware of existing trademark rights of the Complainant, and the Respondent made no effort to ensure that the registration of their domain name was not in violation of the rights of the Complainant.
5. The registration of the domain name by the Respondent is in violation of NIXI's agreement with the Registrar, as well as the Registrar's agreement with the Respondent.
6. The Respondent was in communication with the Complainant for the purpose of selling the domain name.



7. The Respondent has no legitimate rights to the said domain name.
8. The Respondent has registered the domain name in bad faith for the sole intention of selling it at high profits.

6. Discussion and Findings

The Complainant in their complaint alleges -

- (i) the Respondent's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the Respondent's domain name has been registered or is being used in bad faith.

As per para 4 of the Policy, the above premises would be the grounds for filing a complaint. The Policy is silent on the "burden of proof" of the above points. Para 3 of the policy further states that it is the responsibility of the Registrant to ensure they do not violate any policies or infringe any rights by the registration of their domain name.

In the absence of a specific statement about the "burden of proof" one can surmise that the INDRP policy requires the Complainant to file a complaint if the Complainant believes and can demonstrate the existence of the above 3 points, however **the Respondent must prove** that atleast one of the above three points do not exist in the case in order to find in favor of the Respondent. Therefore the **Respondent has the burden of proving** in their response that the above criteria have not been met

The Arbitrator has investigated each of these criteria one by one -

A. Identical or Confusingly Similar

This question raises two issues: (1) does the Complainant have rights in a trademark or name; and (2) is the domain name identical or confusingly similar to such trademark or name.

The Complainant has a trademark in both graphical and textual form representing the word "hotel". A letter from the trademark Registry confirms that the trademark has no objections against it.

The Complainant has produced ample evidence of the usage of the trademark -

- The Complainant has been running a website using the trademark since 2000.
- The Complainant has spent resources in advertising the trademark and the website.
- The Complainant has received a large number of inquiries through this website, of which the Complainant has produced a sample set in their original complaint.
- The Complainant's website features on search engines.

The Respondent's allegations with regards to the form of the trademark (i.e. it being stylized and graphical) are irrelevant. The Policy does not differentiate between graphical or textual marks. The Registry made no such differentiation during the Sunrise Registration process and no such mention has been made in the Policy or the Rules. Additionally the Complainant has provided sufficient evidence to demonstrate that the Trademark Registry records both the graphical and textual form of the trademark.



The Respondent's allegations with regards to the class of the trademark (ie the fact that the trademark was registered in class 16) are irrelevant. Firstly the Policy does not distinguish or differentiate between classes of trademarks. Secondly, as clarified by the Complainant, class 16 was the appropriate class for registering the Complainant's trademark during the time when service marks were not existent in India. As such, the intentions and purpose of the Complainant behind registering the trademark are quite clear. The Complainant also provides evidence of stated usage of the trademark in their application which contains the fact that the Complainant was to use the trademark for a "website".

The Respondent had also been notified by the Complainant about the existence of IP rights in the said "word". Despite that, the Respondent failed to verify the same by conducting a simple search in the Indian Trademark Registry, and therefore failed in fulfilling their obligations under Para 3 of the Policy.

There can be no doubt that the domain name "hotels.in" is confusingly similar, and can be held to be identical to the trademark of the Complainant as well as the name in which the Complainant has setup a business.

Accordingly, the Arbitrator finds that the Complainant has satisfied the first element required by para 4 of the Policy.

B. Rights or Legitimate Interests

The Complainant submits that the Respondent has no rights or legitimate interests in the disputed domain name.

The tests to be applied to determine whether the Respondent has rights or legitimate interests in the disputed domain name are covered in para 7 of the Policy as follows -

Any of the following circumstances, in particular but without limitation, if found by the Arbitrator to be proved based on its evaluation of all evidence presented, shall demonstrate the Registrant's rights to or legitimate interests in the domain name for the purposes of Paragraph 4 (ii):

- (i) before any notice to the Registrant of the dispute, the Registrant's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services;*
- (ii) the Registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or*
- (Hi) 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.*

On the basis of the statements and documents submitted, the Arbitrator is satisfied that the Respondent has no rights or legitimate interests in respect of the domain name, for the following reasons -

- To satisfy the requirements of para 7(i) of the Policy, the Respondent's use of the disputed domain name must be in connection with a "bona fide" offering of goods or services. In the circumstances of this case, however, the Respondent has not provided any evidence of offering bonafide goods and services through the domain name. Infact the domain name showed a "SEDO" parking page with a "for sale" sign until the Respondent received notice of the complaint. The same does not constitute a "bona fide" offering of goods and services.



- The Respondent does not provide any evidence that, the Respondent has been commonly known by the disputed domain name or that the disputed domain name is derived from one of Respondent's trademarks or trade names. The Complainant has not licensed or otherwise permitted the Respondent to use his name or any of its trademarks or to apply for any domain name incorporating his name or trademarks. The Respondent has not been commonly known by the domain name and there is no relationship between the Respondent and the name "hotels"
- ".in" represents a certain nexus and connection with India. The Respondent has not shown any nexus with India. The Respondent is a citizen of Germany and has been residing there. The Respondent has no assets or immovable property in India nor any association with India. The Respondent has not provided any evidence of any business or connection or nexus with hotels either. The Respondent as of the date of the complaint does not have any online website that has any business interest with India.
- There is no evidence indicating that the Respondent is making a legitimate non-commercial use of the domain name. The Respondent has stated in their response that they intended to develop the domain name into a website. However evidence submitted by the Complainant shows that the Respondent had setup a "for sale" page on the domain name and that the Respondent was actively in communication with the Complainant in an effort to sell the domain name.
- The Respondent's assertions that the domain name is generic do not bestow rights to the domain name upon the Respondent. The Policy is clear in this matter. The Respondent has failed to show evidence as required by para 7 of the Policy
- Thus Respondent has failed to show evidence as required by para 7 of the Policy

Therefore, the Arbitrator finds that the Respondent has no rights or legitimate interests in respect of the domain name.

C. Bad Faith

The Complainant submits that the Respondent has registered and used the domain name in bad faith.

The tests to be applied to determine whether the Respondent: has registered or used the domain name in bad faith are covered in para 6 of the Policy as follows -

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:

- (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*
- (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*
- (Hi) *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.

On the basis of the above statements and documents submitted, the Arbitrator is satisfied that the Respondent has registered and used the domain name in bad faith, for the following reasons -

- After registering the domain name the Respondent put up a page on the domain name, which clearly stated that the domain name was "for sale".
- The Domain Name was parked with "SEDO.COM" which is the world's largest marketplace for buying and selling domain names.
- The Respondent had registered several other .IN Domain Names - COMMUNITY.IN, DRIVE.IN, FOOTBALL.IN, FORUM.IN, GUIDE.IN, HARDWARE.IN, HOTELS.IN, HOUSE.IN, JOBS.IN, REALESTATE.IN, RINGTONES.IN, STORE.IN, all of which were listed for sale on their respective websites.
- Only upon receiving the complaint, did the Respondent take the "for sale" pages down from the above .IN Domain Names
- Registering a domain name solely for the purpose of selling it is against the NIXI policy as per their advisory available at http://www.inregistry.in/policies/advisory_laO/
- The Respondent has also registered many such domain names in another ccTLD which still continue to be listed on sale - 24-h.us, bocks.us, briefcase.us, buymusic.us, camps.us, cdshop.us, clans.us, clients.us, cup.us, cyberradio.us, every.us, flirting.us, flirts.us, freak.us, goods.us, high.us, i-t.us, million.us, mrpresident.us, opinion.us, p2p.us, picks.us, porncam.us, quiz.us, roboter.us, series.us, social.us, strange.us, webchat.us, webnews.us, xchange.us,, board.us, flirt.us, junior.us, last-minute.us, mails.us, pocket.us, t-v.us, webradio.us
- The Complainant had contacted the Respondent inquiring to purchase the Domain Name and the Respondent had clearly engaged in proactive communication with the Complainant to sell the said domain name for profit
- Finally the Arbitrator takes into account the Respondent's allegations that the claims of the Complainant are false. The overwhelming evidence produced by the Complainant clearly shows that the Respondent is making a misrepresentation

Therefore, the Arbitrator finds that the Respondent has registered and used the domain name in bad faith

7. **Decision**

The Respondent has failed to fulfill their responsibilities and obligations under para 4 of the Policy. The Respondent has failed to fulfill their obligations under para 3 of the Policy.

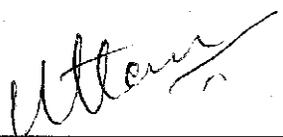
For all the foregoing reasons, in accordance with para 4 of the Policy, the Arbitrator finds in favor of the Complainant and directs that the registration of the disputed **domain name be transferred** from the Respondent to the Complainant.

Further the Arbitrator finds that the Respondent has acted in bad faith in the arbitration process by misrepresenting facts, and stating incorrect information. The Respondent claims that he never intended to sell the domain name and presented



false evidence of wanting to put up a website on it, when significant evidence exists to prove otherwise. The Respondent has violated polices established by NIXI, the Registrar, INDRP and the Rules of Procedure.

As per para 10 of the Policy the Arbitrator further awards costs of Rs 5,000 to the Complainant to be paid by the Respondent.



Uttam Prakash Agarwal
Arbitrator.
Dated: 20th May, 2006.