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BEFORE THE INTERNET EXCHANGE OF INDIA
ARBITRATION AWARD

ARBITRATOR: S. SRIDHARAN

DATED: 10th April 2009

Kenneth Cole Productions Inc --- Complainant

-Vs-

Viswas Infomedia --- Respondent

Sridharan
(Arbitrator)

BEFORE THE INTERNET EXCHANGE OF INDIA

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DATED: 10th April 2009

Kenneth Cole Productions Inc

Complainant

Versus

Viswas Infomedia

Respondent

1. The Parties

1.1 The Complainant is Kenneth Cole Productions Inc, a corporation organized and existing under the laws of the state of New York, United States of America represented by its counsel, Mr.Pravin Anand of Anand & Anand at B 41 Nizamuddin East, New Delhi 110 013.

1.2 Respondent is Viswas Infomedia at 5 Ramdham, Kalawal Road, Rajkot, 360 005.

The Domain Name and Registrar

1.3 The disputed domain name **<kennethcole.in>** is registered with Directi Internet Solutions Pvt Ltd.

2. Procedural History

2.1 On 19th March 2009, the Arbitrator was asked telephonically and through email by NIXI about his availability and consent to take up the Complaint



for arbitration. Arbitrator informed his availability and consent telephonically. On the same day the Arbitrator by email confirmed his consent and sent an electronic version of signed Statement of Acceptance and Declaration of Impartiality and Independence.

- 2.2 On 20th March 2009, the Arbitrator received hardcopy of the Complaint along with Annexures.
- 2.3 On 20th March 2009, the Arbitrator issued by email a Notice to the Respondent setting forth the relief claimed in the Complaint and directing him to file his reply to the Complaint within 15 days. Arbitrator also sent an email about his appointment to arbitrate the complaint to the Complainant.
- 2.4 On 23rd March 2009, Arbitrator received a soft copy of the Complaint from the Complainant.
- 2.5 On 5th April 2009, the Arbitrator informed all by email that the Respondent had not filed any response to the Complaint and he would pass an award on 10th April 2009 on the basis of the materials made available by the Complainant. The Respondent was permitted to file response till 8th April 2009.
- 2.6 The Respondent has not entered appearance. He has not filed any reply to the Complaint of the Complainant.
- 2.7 Email is the medium of communication of this arbitration and each email is copied to all, Complainant, Respondent and NIXI.



3. **Factual Background**

A **Complainant**

3.1 The Complainant is a well known fashion house founded by Mr. Kenneth Cole in 1982. The Complainant specializes in the manufacture and distribution of clothing, men's and women's footwear, handbags and accessories such as watches, sunglasses.

3.2 The Complainant is using many trade marks including Kenneth Cole in respect of its products. The Complainant has also registered its mark Kenneth Cole in various classes in many countries including India. It has two Indian registrations in class 18 with effect from 29th January 1997 and class 25 with effect from 08th August 2001 and a copy of certificates of registrations is filed at Annexure B to the Complaint. A computer print out of two US registrations in class 25 with effect from August 4, 1998 and class 14 with effect from June 30, 1998 is filed at Annexure A to the Complaint along with a list of countries where it has registrations for the mark Kenneth Cole.

3.3 The Complainant is currently offering 30 product categories under the mark Kenneth Cole through more than 6000 departmental and specialty stores in many countries. The Complainant is also offering its Kenneth Cole products through its web site www.kennethcole.com .

The Complainant has been on the *Forbes* annual list of the world's 200 Best Small Companies since 1994. The Complainant has ever since been

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named on *Business Week's* list of top Hot Growth Companies. An Article depicting listing of the Complainant on *Business Week* is attached at Annexure C to the Complainant. I have gone through the article. Kenneth Cole is nowhere found expressed in a trade mark sense and as such Annexure C is not material to the determination of this Complaint.

3.5 Indian consumers who have traveled abroad for tourism or study are invariably exposed to and are fully aware of the reputation and goodwill enjoyed by the Complainant under its trade mark Kenneth Cole. The Complainant's trade marks are advertised in a variety of magazines and media which is also freely available in the Indian markets.

3.6 The extent of the Complainant's global presence can be gauged from the enormous sales revenue that the Complainant has generated in the last couple of years. An article depicting the revenue of the Complainant is attached at Annexure D to the Complainant. I have gone through the article. The article gives figures only for the first quarter of 2008 of the Complainant.

3.7 The Complainant has also been involved in extensive philanthropic work across the globe. Certain articles pertaining to the Complainant's philanthropic activities are attached at Annexure E to the Complainant. The Complainant is widely traded on the New York Stock Exchange under the symbol KCP with an enormous amount of shares traded on the NYSE. An article depicting the sale and trading of the Complainants stock is attached at Annexure-F.



- 3.8 The Complainant offers its goods through its active web site www.kennethcole.com . People can select and order the products of the Complainant through this web site. The home page of the web site is attached at Annexure G and print outs some of the web pages are attached at Annexure H.
- 3.9 Complainant submits that the Respondent has registered the disputed domain name **<kennethcole.in>** by misappropriating illegally and without authority the trademark Kenneth Cole of the Complainant. A copy of the Whois database depicting the Respondent as the registrant is attached at Annexure-J.
- 3.10 The Complainant issued a notice on 8th September 2008 to Respondent stating, among others, that the Respondent had created the disputed domain name **<kennethcole.in>** on 27th December 2007. The disputed domain name wholly incorporates the registered trade mark Kenneth Cole of the Complainant. The Respondent had no authority to adopt the mark Kenneth Cole for his domain name. The Complainant had asked the Respondent to transfer the disputed domain name **<kennethcole.in>** to the Complainant.
- 3.11 Respondent sent a reply dated 17th September 2007 refusing to transfer the disputed domain name **<kennethcole.in>** to the Complainant. The reply will be fully dealt with herein below.
- 3.12 Complainant again sent a notice on 31st October 2008. There was no reply from the Respondent.

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Since the Respondent did not respond favorably to the notices of the Complainant, Complainant has initiated this arbitration.

Respondent

The Respondent has not filed any reply to the Complainant's Complaint in this arbitration.

Respondent, however, replied the notice issued by the Complainant. Respondent in his reply dated 17th October 2008 stated that the Complainant failed to register the disputed domain name **<kennethcole.in>** during the sunrise period granted to the registered proprietors. The Respondent registered the disputed domain name **<kennethcole.in>** to provide platform to all domestic models to share their talents, ideas and their life time images with their relatives and friends. Respondent had priority right over the Complainant. The disputed domain name **<kennethcole.in>** was the property of the Respondent. The Complainant could not claim the disputed domain name **<kennethcole.in>** for all commodities and services offered all over the world. The notice failed to reveal whether the Complainant was ready to purchase the disputed domain name **<kennethcole.in>**

4. **Parties Contentions**

A **Complainant**

- 4.1 The disputed domain name **<kennethcole.in>** wholly incorporates the registered and well known trade mark Kenneth Cole of the Complainant.



- 4.2 The disputed domain name **<kennethcole.in>** is identical and confusingly similar to the well-known and registered trademark Kenneth Cole of the Complainant.
- 4.3 The trademark Kenneth Cole has acquired distinctiveness and is exclusively identified with the Complainant's goods. As such the use of the word Kenneth Cole in the disputed domain name **<kennethcole.in>** would be understood as a reference to the Complainant thus perpetuating confusion among consumers who wish to access the Complainant's web page.
- 4.4 The complainant placed reliance on *KFC Corporation v. Webmaster Casinos Ltd.* (L-2/6/R4) attached at **Annexure-K**. The case involved the domain name www.kfc.co.in . It was transferred to the complainant as it incorporated the KFC Trademark in whole.
- 4.5 Respondent is not commonly known by the disputed domain name **<kennethcole.in>** nor has he made any demonstrable preparation to use the disputed domain name **<kennethcole.in>** in connection with a commercial purpose.
- 4.6 The Respondent has no rights or legitimate interest in the disputed domain name **<kennethcole.in>** for the following reasons:
- (a) The Respondent is not a licensee of the Complainant. The Complainant has not granted any permission or consent to the



Respondent to use the trademark Kenneth Cole in any manner or to incorporate the same in a domain name **<kennethcole.in>**.

(b) The Respondent's web site under the disputed domain name **<kennethcole.in>** is not bonafide. The Respondent has registered the disputed domain name **<kennethcole.in>** only with intent to cause initial interest confusion and bait internet users to accessing its website under the disputed domain name **<kennethcole.in>**. No website has been uploaded on the disputed domain name **<kennethcole.in>** nor is it being used for any legitimate commercial use.

(c) The complainant placed reliance on the case of *Google Inc. v. R. Jain (L-2/10/R4)* attached at Annexure-K wherein the domain name www.orkut.in was transferred to the complainant as the respondents didn't have any legitimate interests in respect of the domain name. Under Para 5, p.8, of the above cited case the arbitrators found that, "the Respondent ought to have been aware of the complainant's rights in ORKUT Trademark" and it further held that, "the Respondents has no rights or legitimate interests in the domain name".

4.7 The Respondent is presumed to have had knowledge of Complainant's registered well known mark Kenneth Cole at the time it registered the disputed domain name **<kennethcole.in>**. No web site has been uploaded for the disputed domain name **<kennethcole.in>**. Registration



of a famous trademark without legitimate commercial interests in the same is prima facie evidence that the Respondent was well aware of the reputation and goodwill attached to the Complainant's trademark/name. Thus the Respondent has registered the web site in bad faith. The complainant would like to place reliance on *Rediff.com India Limited v. Mr. Abhishek Verma & Others.* (L-1/1/R1), wherein the disputed Domain Name rediff.in was ordered to be transferred to the complainants. The panel held, *"the disputed domain name was registered for the sole purposes selling renting or transferring the same for monetary gains over and above the documented registration expenses"*. Therefore, the disputed domain name **<kennethcole.in>** has only been registered in bad faith for monetary gains.

4.8 Respondent's lack of response to the second notice dated 31st October 2008 of the Complainant indicates that the Respondent has no reason and/or justification for the adoption of the Complainant's trademark Kenneth Cole. The fact that the Respondent has made no such efforts to desist from the use of the disputed domain name **<kennethcole.in>** is prima facie proof of the Respondent's mala fide intentions.

4.9 There is a great likelihood that an actual or potential visitor to the Respondent's present web page or any future web page that the disputed domain name **<kennethcole.in>** resolves to, will be induced to (a) believe that the Complainant has licensed its trademark Kenneth Cole to the Respondent or has authorized the Respondent to register the disputed



domain name <kennethcole.in>, (b) believe that the Respondent has some connection with the Complainant in terms of a direct nexus or affiliation with the Complainant or has been authorized by the Complainant. Therefore the disputed domain name <kennethcole.in> has been registered and is being used in bad faith.

B. Respondent

4.10 Respondent has not filed any reply to the Complainant's Complaint in this arbitration.

5. Discussion and Findings

5.1 Since the Respondent has chosen not to respond to this Complaint within the time granted to him, I am proceeding to determine this Complaint on merits based on the materials available on record. Though the Respondent has not filed any reply to this Complaint, he had effectively answered the Notice dated 8th September 2008 of the Complainant. I discuss appropriately the answer of the Respondent herein below.

5.2 The Complainant in order to succeed in the Complaint must establish under Paragraph 4 of .IN Domain Name Dispute Resolution Policy (INDRP) the following elements:

- (I) Respondent's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;

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- (II) Respondent has no rights or legitimate interests in respect of the domain name; and
- (III) Respondent's domain name has been registered or is being used in bad faith.

5.3 Each of the aforesaid three elements must be proved by a Complainant to warrant relief.

Disputed domain name is identical or confusingly similar to a trade mark of the Complainant.

5.4 The Complainant is the proprietor of the mark Kenneth Cole and has been using the mark Kenneth Cole since 1982. The Complainant has registrations for the mark Kenneth Cole throughout the world, including India. The Complainant is also offering its products through its active web site www.kennethcole.com wholly comprising its registered trade mark Kenneth Cole. The Complainant's trade mark was registered first in India in 1997. The disputed domain name **<kennethcole.in>** was registered by the Respondent only on 27th December 2007. The Complainant is the prior adopter of the mark Kenneth Cole. The above facts have established that the Complainant has both common law and statutory rights in respect of its trade mark Kenneth Cole.

5.5 The Complainant's Kenneth Cole mark is well known throughout the world including India. It is clearly seen that the disputed domain name

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<kennethcole.in> wholly incorporates Kenneth Cole, the prior registered trade mark of the Complainant.

5.6 I, therefore, find that:

- (a) The Complaint has both common law and statutory rights in respect of its trade mark Kenneth Cole.
- (b) The disputed domain name **<kennethcole.in>** is confusingly similar to the Complainant's prior registered trade mark Kenneth Cole.

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

5.7 It is already seen that:

- (a) The Complainant is the prior adopter and user of the mark Kenneth Cole. The Complainant's mark Kenneth Cole is well known in many countries across the globe including India.
- (b) The Complainant's trade mark was adopted in the year 1982. It was registered first in India in 1997. The disputed domain name **<kennethcole.in>** was registered by the Respondent only on 27th December 2007.

5.8 I visited the web site of the Respondent under the disputed domain name **<kennethcole.in>**. The disputed domain name did not resolve into any web site. I used two browsers namely (1) Internet Explorer and (2) Mozilla Firefox. The response returned by Mozilla Firefox is: "Address Not found

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- Firefox can't find the server at www.kennethcole.in ". Internet Explorer returned similar response as: "DNS error - cannot find server, Oops! This link appears broken". Therefore, I fully accept the contention of the Complainant that:

- (a) The Respondent's web site under the disputed domain name **<kennethcole.in>** is not bonafide. The Respondent has registered the disputed domain name **<kennethcole.in>** only with intent to cause initial interest confusion and bait internet users to accessing its website under the disputed domain name **<kennethcole.in>**. No website has been uploaded on the disputed domain name **<kennethcole.in>** nor is it being used for any legitimate commercial use.
- (b) Respondent is not commonly known by the disputed domain name **<kennethcole.in>** nor has he made any demonstrable preparation to use the disputed domain name **<kennethcole.in>** in connection with a commercial purpose.

I gather from the Notice of the Complainant and the reply thereto by the Respondent that the Respondent is not a licensee of the Complainant. The Complainant has not granted any permission or consent to the Respondent to use the trademark Kenneth Cole in any manner or to incorporate the same in a domain name **<kennethcole.in>**.



5.10 Therefore, I have no hesitation to hold, for the above reasons that the Respondent has no right or legitimate interest in respect of the disputed domain name **<kennethcole.in>**

Respondent's domain name has been registered or is being used in bad faith.

5.11 The Complainant's well known trade mark Kenneth Cole was adopted in the year 1982. It was registered first in India in 1997. The Respondent got registered the disputed domain name **<kennethcole.in>** on 17th April 2007. The Respondent could not have ignored, rather actually influenced by, the well-known trade mark Kenneth Cole of the Complainant at the time he acquired the disputed domain name **<kennethcole.in>**. The Respondent registered the disputed domain name **<kennethcole.in>** to provide platform to all domestic models to share their talents, ideas and their life time images with their relatives and friends. Respondent could have adopted any other name for his web site. He has not come out with any reason for adopting particularly the disputed domain name **<kennethcole.in>** for his web site. The Respondent is no way connected with the Complainant. In the absence of any particular reason, Respondent's adoption of the disputed domain name **<kennethcole.in>** is nothing but an unjust exploitation of the well known reputation of the Complainant's prior registered trade mark Kenneth Cole.

5.12 No web site has been uploaded for the disputed domain name **<kennethcole.in>**. Registration of a famous trademark without legitimate

commercial interests in the same is prima facie evidence that the Respondent was well aware of the reputation and goodwill attached to the Complainant's trademark/name. Thus the Respondent has registered the web site in bad faith.

5.13 Respondent's lack of response to the second notice dated 31st October 2008 of the Complainant indicates that the Respondent has no reason and/or justification for the adoption of the Complainant's trademark Kenneth Cole. The fact that the Respondent has made no such efforts to desist from the use of the disputed domain name **<kennethcole.in>** is prima facie proof of the Respondent's mala fide intentions.

5.14 The Respondent's argument that the Complainant failed to register the disputed domain name **<kennethcole.in>** during the sunrise period will not hold good. Even in the absence of a necessity to hold a web site, the Complainant is entitled to take action against the Respondent for the adoption of the disputed domain name **<kennethcole.in>**. It is because the disputed domain name **<kennethcole.in>** wholly incorporates the prior registered well known trade mark Kenneth Cole of the Complainant.

5.15 I understand from the Respondent's reply that he was ready to sell the disputed domain name **<kennethcole.in>** to the Complainant. Respondent's bad faith registration is evidently clear from his offer to sell the disputed domain **<kennethcole.in>** to the Complainant.

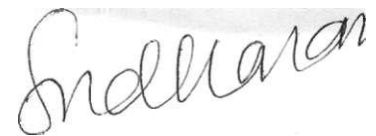
5.16 There is a great likelihood that an actual or potential visitor to the Respondent's present web page or any future web page that the disputed



domain name <kennethcole.in> resolves to, will be induced to (a) believe that the Complainant has licensed its trademark Kenneth Cole to the Respondent or has authorized the Respondent to register the disputed domain name <kennethcole.in>, (b) believe that the Respondent has some connection with the Complainant in terms of a direct nexus or affiliation with the Complainant or has been authorized by the Complainant. Therefore the disputed domain name <kennsthole.in> has been registered and is being used in bad faith.

5.17 The above facts have clearly established the bad faith registration of the disputed domain name <kennethcole.in> by the Respondent.

5.18 The actions of the Respondent should not be encouraged and should not be allowed to continue. The conduct of the Respondent has necessitated me to award costs of the Complaint to and in favour of the Complainant.

A handwritten signature in black ink, appearing to read "Indrakaran", is written in a cursive style on a light-colored background.

6. Decision

6.1 For all the foregoing reasons, the Complaint is allowed as prayed for in the Complaint.

6.2 It is hereby ordered that the disputed domain name **<kennethcole.in>** be transferred to the Complainant.

6.3 Respondent is ordered to pay the Complainant a sum of Rs.5,00,000/- (Rupees five lakhs only) towards costs of the proceedings.



S.Sridharan
Arbitrator