



उत्तर प्रदेश UTTAR PRADESH

EM 827512

BEFORE THE SOLE ARBITRATOR, ANKUR RAHEJA MCA FCS LLB

.IN REGISTRY

(NATIONAL INTERNET EXCHANGE OF INDIA)

.IN DOMAIN NAME DISPUTE RESOLUTION POLICY (INDRP)

ARBITRATION AWARD – MAHINDRAHOLIDAY.IN

DATED: NOVEMBER 26, 2018

IN THE MATTER OF:

MAHINDRA HOLIDAYS & RESORTS INDIA LTD ... Complainant

versus

MAHINDRA HOLIDAYS ... Respondent

A. Raheja

ARBITRATION AWARD

Dispute Domain Name: www.MahindraHoliday.in

1. The Parties:

a. **Complainant:** The Complainant in this arbitration proceedings is: M/s. Mahindra Holidays & Resorts India Ltd, an Incorporated Company having its registered office at Mahindra Towers, 2nd floor, 17/18 Patulous Road, Chennai - 600002, India represented by Mohan Associates, Ceebros Building, D-4, 3rd Floor, 32, Cenotaph Road, Teynampet, Chennai 600 018, India.

b. **Respondent:** The Respondent in this arbitration proceeding is Mahindra Holidays, Mahindra Towers, 2nd Floor, 17/18, Patullos Road, Mount Road, Chennai - 600002

2. The Domain Name and the Registrar:

a. The Disputed Domain Name is www.MAHINDRAHOLIDAY.in.

- b. Disputed Domain Name is registered with Godaddy.com, LLC.

3. Procedural History [Arbitration Proceedings]

This is mandatory Arbitration proceedings in accordance with the .IN Domain Name Dispute Resolution Policy (“INDRP”), adopted by the National Internet Exchange of India (“NIXI”). The INDRP Rules of procedure (“the Rules”) were approved by NIXI on 28th June 2005 in accordance with Arbitration and Conciliation Act, 1996. By Registering the Disputed Domain Name with the NIXI Accredited Registrar, the Respondent has agreed to the resolution of the domain disputes pursuant to the IN Dispute Resolution Policy and Rules framed thereunder.

According to the information provided by the National Internet Exchange of India [“NIXI”], the history of this proceeding is as follows:

In accordance with the Rules 2(a) and 4(a), NIXI formally notified the Respondent of the Complaint, and appointed Ankur Raheja as the Sole Arbitrator for adjudicating upon the disputed in accordance with the Arbitration and Conciliation Act, 1996 and the Rules framed thereunder, INDRP Policy and

Rules framed thereunder. The Arbitrator submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the NIXI.

In this matter, the arbitration proceeding commenced on 20 October 2018 in terms of INDRP Rules; Relevant Dates are as follows:

Sr No	Particulars	Date
1.	Arbitration Case referred to Arbitrator & Acceptance given	15 October 2018
2.	Date of Handover of Complaint by NIXI and soft copy of Complaint served upon Respondent by the Registry	18 October 2018
3.	Notice of Arbitration issued to the parties, also referred as date of commencement of Proceedings	20 October 2018
4.	Second Notice to the Respondent	05 November 2018
5.	Award Passed	26 November 2018

- In accordance with INDRP read with INDRP Rules of procedure, notice of Arbitration was sent to the Respondent on 20th October 2018, with the instructions to file his reply / response by 3rd November 2018.

- NIXI informed on 05 November 2018 that the Hard Copy sent to the Respondent through courier was delivered successfully, but only due to the fact as Respondent has been falsely using the details of the Complainant Company, including the name and the address.
- That Respondent failed to file any response to the complaint, final opportunity was provided to the Respondent on 05 November 2018, to file the response by 10 November 2018.
- No response was filed by the Respondent to the second notice as well, therefore, an order for ex-parte proceedings was issued on 11 November 2018. The various notices were successfully delivered upon the Respondent at various stages including soft copy of the complaint, therefore, service of notice was deemed to have been complied with in accordance with Rule 2 of the INDRP Rules of Procedure.
- No personal hearing was requested / granted / held.

4. Factual Background

According to the documentary evidence and contentions submitted:

A. The Complainant is a part of the “Mahindra” Group which is a USD 20.7 billion multinational group based in Mumbai, India. “Mahindra” provides employment opportunities to over 240,000 people in over 100 countries. Mahindra operates in the key industries that drive economic growth, enjoying a leadership position in tractors, utility vehicles, information technology, financial services and vacation ownership. In addition, “Mahindra” enjoys a strong presence in the agribusiness, aerospace, components, consulting services, defence, energy, industrial equipment, logistics, real estate, retail, steel, commercial vehicles and two wheeler industries.

B. The Complainant is a part of the Leisure and Hospitality Sector of the “Mahindra” Group. The Complainant’s business was started in the year 1996 and is well known for their reliability, trust and customer satisfaction. The company’s flagship brand ‘CLUB MAHINDRA HOLIDAYS’, today has a fast growing customer base of over 2,35,000 members and several beautiful Resorts at several exotic spots in India and abroad. The Complainant has

recently acquired stake in Holiday Club Resorts Oy, Finland making its foray into 30 Resorts in Finland, Sweden and Spain.

C. The Complainant has on an average around 2.5 lakhs number of visitors to its website www.clubmahindra.com, average monthly traffic on its website is around 4 Lakhs and Google has revealed that there is around 110,000 average monthly searches for “Club Mahindra” and around 9900 average monthly searches for “Mahindra holidays”.

D. The Complainant is one among the Vacation Ownership Company to be ISO 27001 certified. The “Club Mahindra” memberships provided by the Complainant are affiliated to RCI, which gives a Club Mahindra members access to over 4600 resorts globally. The Complainant has a unique distinction of having 29 RCI Gold Crown, 2 RCI Platinum Award and 3 Silver Crown resorts in India, which bears testimony to the high standards of Resort facilities, amenities and services which the Complainant offers. The Complainant was awarded the “Health Brand of the Year”- Food Category at the Indian Health and Wellness summit and Awards 2017 and received more recognition. Also during the year, 2017-18, the Complainant received the

prestigious “Golden Peacock Award Sustainability 2017”. Further the Complainant, is also the first global hospitality Company to participate in EP 100 – a commitment to double energy productivity by 2030. It has also been listed amongst Mumbai’s Hot 50 Brands by Paul Writer and Hindustan Times. The Complainant’s resorts at Goa, Munnar and Coorg have also been accredited with a ‘5 Star’ rating by the Department of Tourism, Government of India.

E. The Complainant has also registered a number of domains consisting of the mark CLUB MAHINDRA, MAHINDRA HOLIDAYS and its variants. A list containing the domain name registrations of the Applicant for the mark “CLUB MAHINDRA” and “MAHINDRA HOLIDAYS” is attached as Annexure with the Complaint.

F. The Complainant has also received various accolades and awards, including ‘India’s Favorite Resort Chain’ by HolidayIQ, “The Creativity Gold Award for its Interactive E-mail Marketing for Use of Big Data Analytics and three Effective Bronze Awards for its Cricket World Cup Twitter Campaign, Silver ABBY award for Slippers Mailer and a Bronze ABBY award for Album

Mailer at the AdClub Goa Fest 2015 and more. A non-exhaustive list containing the various awards and recognition received by the Complainant is attached as Annexure with the Complaint.

G. The Complainant Company has been listed both in the National Stock Exchange (NSE) and Bombay Stock Exchange (BSE) with an increasing share value. This patently shows the rising popularity and the trust that public have towards the Complainant Company and their business. The Complainant's service mark CLUB MAHINDRA, MAHINDRA HOLIDAYS have attained tremendous reputation and goodwill with respect to its services.

5. The Dispute

- a. The Disputed Domain Name is identical or confusingly similar to a trademark in which the Complainant has statutory/common law rights.
- b. The Respondent has no rights or legitimate interests in respect of the disputed domain name.
- c. The disputed Domain Name has been registered or is being used in Bad Faith.

6. Parties Contentions

I. Complainant further contends as follows:

- A. The Complainant states that the mark CLUB MAHINDRA and MAHINDRA HOLIDAYS have become distinctive and has acquired secondary meaning to connote and denote the trade source and origin of the Complainant company's hotels, resorts, clubs and entertainment activities provided thereof. The trade and public exclusively identify the service mark / trade name MAHINDRA HOLIDAYS with services offered by the Complainant Company and none else.
- B. The Complainant states that they are using the service mark/ trade name MAHINDRA HOLIDAYS for its services since the year 1997. The service mark /trade name CLUB MAHINDRA and MAHINDRA HOLIDAYS has become synonym with the Complainant Company and its quality services which offers excellent boarding, quality food and exclusive variety of beverages and memorable camping and entertainment facilities.

- C. The Complainant has also spent substantial sums of money every year towards advertisement and sales promotion activities of their holiday resorts and entertainment activities under the service mark / trade name CLUB MAHINDRA and MAHINDRA HOLIDAYS. The Complainant has advertised its services under the mark CLUB MAHINDRA and MAHINDRA HOLIDAYS in all forms of print and electronic media.
- D. Members of the Complainant are allowed to enjoy the services provided by the Complainant as per the rules framed by the Complainant. The Complainant also adopts various quality control techniques to provide better holidaying experience for their Members. Given the strict standards prescribed therein, the Complainant does not associate with any third party as an agent or associate for resale or any related activity thereof for its holiday plans, and has till date dealt with all such issues by itself.
- E. The Complainant entered into hospitality business in the year 1996. The Complainant, in keeping with modern trends and for customer attraction, has coined and adopted various trademarks and devices with a view to identify their unique services and distinguish the same from third parties. 'CLUB MAHINDRA',

'MAHINDRA HOLIDAYS', "HAPPY FAMILIES" etc" and such other marks including their distinctive colour scheme, logos and other artistic features have all earned sufficient goodwill and reputation in the market and are associated only with the Complainant. The Complainant is the registered proprietor of the mark 'MAHINDRA HOLIDAYS' with several suffixes in respect of hotels, resorts, entertainment activities.

F. The Complainant has also registered its mark 'CLUB MAHINDRA' before the CTM (Community Trade Marks) and United Kingdom. The Complainant coined and adopted the said mark MAHINDRA HOLIDAYS and the same forms a predominant feature in their promotional activities and also forms a predominant feature of the complainant's trading style world over. The Complainant is also keen in protecting their rights with regard to their intellectual property and has thus applied for and obtained registration in respect of the mark MAHINDRA HOLIDAYS per se and along with various prefixes and suffixes, under various classes.

G. The Complainant's resorts are well known and popular all over India and abroad as it is situated in various exotic locations with availability of a variety of cuisines,

thereby being the preferred option for customers from India and abroad. The Complainant's services cover a wide range of customers from all walks of life and different nationalities. The Complainant has spent substantial sums of money towards sales and marketing expenses and towards advertisement and sales promotion activities of their holiday resorts and entertainment activities under the service mark / trade name MAHINDRA HOLIDAYS along with various prefixes and suffix.

H. The Complainant has openly, extensively and continuously used the mark MAHINDRA HOLIDAYS in respect of various goods and services including hotels, holiday resorts, camping services, transport, travel arrangement, accommodation, etc. The annual turnover of the complainant's business under the mark MAHINDRA HOLIDAYS runs to several crores of rupees. The complainant has also spent huge sums of money in advertisement and promotion of their business under the trademark / trading style CLUB MAHINDRA and MAHINDRA HOLIDAYS.

I. The said mark MAHINDRA HOLIDAYS is identified exclusively with the goods and services provided by the complainant alone and none else. In view of its

adoption and continuous use since the year 1997, the trademark MAHINDRA HOLIDAYS enjoys great reputation and goodwill amongst the trade and public.

J. The disputed domain names are identical and confusingly similar to the marks of the Complainant (Policy, paras. 6; Rules, para. 3(1),(2)&(3)). The domain www.mahindraholiday.in as held by Respondent essentially capitalizes on the use of the trademark, trade name, corporate name and domain name of the Complainant per se. As the Complainant is well recognized in India as well as globally, the use of such a misleading term only adds to the confusion in the minds of an internet user that the domain name is associated with the Complainant. This shall expose the Complainant to irreparable loss and hardship and would damage the hard earned reputation and goodwill it has earned in the mind of its customers. In no manner does the domain name serve to distinguish itself from the Complainant's trademark.

K. The Disputed Domain Name misrepresents or has the potential to misrepresent to the trade and public that such website is related to the Complainant and offers services for and on behalf of the Complainant. The Respondent has intentionally misrepresented the name of the Complainant and by using the said domain

name and content therein the Respondent has created a deliberately malafide domain which would cause even the most prudent of customers to believe that it is in fact connected with and operated by the Complainant. The Complainant states, that it is in no way connected, concerned or authorized the Respondent to represent themselves as somehow connected with the Complainant or use the Complainant's name in any manner.

L. Additionally, the Complainant has earned an enviable goodwill and reputation over the years. In order to usurp on this value, the Respondent has deliberately used the domain name www.mahindraholiday.in thereby blatantly misrepresenting the Respondent's services as that of the Complainant's with a view to deceive the public. The Respondent's acts amount to infringement of trademark, passing off and misrepresentation.

M. The acts of the Respondent in registering a domain name comprising of the Complainant's well known trademark/corporate name in its entirety and in a manner clearly intended to cause confusion/deception as to the source/origin of such domain name creates an irrefutable impression of an association/ sponsorship / relationship between the Complainant and the Respondent, which

is not the case in any manner whatsoever. This is nothing but to gain illegally and wrongfully from the goodwill and reputation garnered by the Complainant.

N. Respondent has no rights or legitimate interests in the domain names [Policy, paras. 6; Rules, para. 3 (1), (2) & (3)] “MAHINDRA HOLIDAYS”, which is what the Complainant is popularly known as and which is the predominant part of many of the trademarks of the Complainant, is a coined term, as explained in the foregoing. The trademarks have attained widespread goodwill and reputation not only in India but also in several other countries. In the Disputed Domain Name, the Respondent had used the word “Mahindra Holiday” to falsely indicate that they have a trade nexus with the Complainant, whereas, in fact, the Respondent has no such relationship with the Complainant. The Complainant has several registrations for the word mark and label for “Mahindra Holidays” as mentioned earlier.

O. The Respondent had no legitimate right to use the name “Mahindra Holiday”. The Complainant has not permitted or licensed the Respondent to use the terms “Mahindra Holiday”. The said Disputed Domain Name has been contrived for the express purpose of exploiting the goodwill of the Complainant and to mislead the

general public. Respondent's domain name is phonetically, visually and conceptually similar to as that of the Complainant and in such a nature, which would likely lead public to believe that the Respondent and the domain name is sponsored by or affiliated to the Complainant.

P. Respondent's domain name is an exact copy /imitation and /or arrangement/ combination of the Complainant's corporate name, prior and registered trademarks, domain names for an identical and similar services that is likely to lead persons to believe that the services are provided or rendered by the Complainant and not by the Respondent, Respondent's domain name is taking or would take unfair advantage of and/or be detrimental to the distinctive character and repute of the Complaint's earlier said trademarks, corporate name and domain names.

Q. The trademark is unique to the Complainant and the Complainant has not authorized or licensed its use by the Respondent. Through the Disputed Domain Name the Respondent is offering services under the Complainant's name using the complainant's registered address, which potentially could cause considerable commercial loss to the Complainant herein and cause irreparable dilution to its

brand value. The Disputed Domain Name registered by the Respondent is clearly intended to exclusively “pass off” as the Complainant herein and have a free ride on its reputation and goodwill. The Disputed Domain Name uses the Complainant’s trademark, domain name, corporate name and registered address without any authority from the Complainant. The Disputed Domain Name registered by the Respondent in its name attempts to induce customers of the Complainant to believe that the Disputed Domain Name registered by the Respondent is that of the Complainant and/or associated in some manner with the Complainant. Respondent’s registration and use of the disputed domain name is a clear case of cyber-squatting, intention is to take advantage of the Complainant’s substantial reputation and goodwill in order to confuse the public and the viewer by offering similar services, divert business, tarnish the reputation and goodwill of the Complainant and the said marks and unduly gain.

R. Accordingly, there is prima facie proof of the Respondent’s intent to usurp the reputation of the Complainant and make illegal gains off its worldwide reputation and goodwill. Suffice it to state that the said usage of the Disputed Domain Name by the Respondent has the propensity to cause irreparable loss to the goodwill and reputation of the Complainant. The Respondent cannot be said to have

legitimately chosen to use the domain names unless it was seeking to create an impression of an association with the Complainant. Since there is no such authorized association, the Respondent's use of the domain names cannot be said to be legitimate. (Telstra Corporation Limited v. Nuclear Marshmallows D2000-0003.)(WIPO Decision) & (Rediff.Com India Ltd Vs Abhishek Verma and Anr INDRP/001).

S. The decision in accordance with ACCOR v. Tigertail Partners, D2002-0625 (WIPO Decision) & Microsoft Corporation vs. Yan Wei INDRP/145 provides adequate grounds for such registration made with intention to illegally capture on the Complainant's hard earned reputation and goodwill to be treated as done in bad faith and without any legitimate interest in the same.

T. The disputed domain name leads the user to a page that offers information relating to online travel services. The intention of the Respondent is to capitalize on the Complainant's well known mark, and to mislead internet users searching for the same. The Respondent clearly intends to benefit by creating the impression that the Respondent is in some manner related to the Complainant herein. The respondent in order to deceive the members of the trade and public

has copied even the registered address of the Complainant herein. The Respondent intends to ride on the reputation earned by the Complainant and with the malafide intention to make potential customers believe that the Respondent is somehow associated with the Complainant herein.

U. The Respondent is seeking to take undue advantage of the fame and goodwill of the Complainant. Moreover, as mentioned earlier, the use of the term “Mahindra Holiday” in the Disputed Domain Name creates an illusion of a legitimate or authorized relationship with the Complainant in the minds of an average user. In fact, no such relationship exists between the Complainant and the Respondent at all.

V. By using the term “Mahindra Holiday” in the Disputed Domain Name, which belongs to the Complainant, the Respondent has demonstrated a pattern of conduct calculated to ensure that the Complainant is unable to use the domain names best suited to its organizational interests and statutory rights. It is amply clear that Respondent has engaged in a clear and discernible pattern of conduct, aimed to prevent the Complainant from registering its domain names in desirable combinations and to misuse the wide recognition that the complainant enjoys.

II. Respondent

A. The Respondent was provided various opportunities to file his response to the Complaint by the Arbitrator by its notice dated 20 October 2018 and 05 November 2018 respectively.

B. However, Respondent has failed and/or neglected to file any response to the Complaint filed by the Complainant despite being given an adequate notification.

C. The Arbitrator, therefore, has no other option but to proceed with the proceedings and to decide the complaint on the basis of the material on record and in accordance with the .IN Dispute Resolution Policy and the Rules framed thereunder.

7. Discussion and Findings:

I. Procedural Aspects

A. The Complainant, while filing the Complaint, submitted to Arbitration proceedings in accordance with the .IN Dispute Resolution Policy and the Rules framed thereunder. The Respondent also submitted to the mandatory arbitration proceedings in terms of paragraph 4 of the INDRP Policy, while seeking registration of the disputed domain name.

B. The .IN Dispute Resolution Policy requires the Complainant, to establish the following three elements:

- (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.

II. Respondent's Default

Several domain dispute decisions have established that once a complainant has made a prima facie case that a Respondent lacks legitimate interest or right, the burden shifts to the Respondent to prove its right or legitimate interest in the domain name (**F. Hoffman-La Roche AG v. Steven Pratt, WIPO Case No. D2009-0589** and **Canadian Tire Corporation Limited v. Swallowlane Holdings Ltd., WIPO Case No. D2009-0828**). That is, the Respondent must come forward with the proof that it has some legitimate interest in the Domain Name to rebut this presumption. But the Respondent has failed to come forward with a Response and therefore, in light of Complainant's unrebutted assertion that Respondent has no rights or legitimate interests in the disputed domain name, the Arbitrator may presume that no such rights or interests exist. [**Pavillion Agency, Inc. v. Greenhouse Agency Ltd., WIPO Case No D2000-1221**].

The INDRP Rules of Procedure requires under Rule 8(b) that the Arbitrator must ensure that each party is given a fair opportunity to represent its case. Further, Rule 11 (a) empowers the arbitrator to proceed with an ex-parte decision in case any party does not comply with the time limits. The Respondent was given notice of this administrative proceeding in accordance with the Rules. The .IN Registry

discharged its responsibility under Rule 2(a) of the INDRP Rules of Procedure to employ reasonably available means calculated to achieve actual notice to the Respondent of the Complaint.

The Respondent has not filed its reply or any documentary evidence thereof and has not sought to answer the complainant's assertions, evidence or contentions in any manner. The averments made in the complaint remain unrebutted and unchallenged. There is no dispute raised to the documents relied upon by the Complainant.

In the matter of **Taco Bell Corporation V. Webmasters Casinos Ltd [INDRP/067]**, it was held that the Respondent registered the disputed domain name maliciously and he shows his depraved intention, in the arbitration proceedings by his act because various notices were sent by the arbitrator but he has submitted no reply of anyone. [INDRP/067 - tacobell.co.in - May 29, 2008]. Also in the matter of **Talk City, Inc. v. Robertson, WIPO Case No D2000-0009**, it has been held that because Respondent failed to submit a Response, the Panel may accept all of Complainant's reasonable assertions as true.

The Arbitrator finds that the Respondent has been given a fair opportunity to present his case. The paragraph 12(a) of INDRP Rules of Procedure provides that the Arbitrator shall decide the Complaint on the basis of the statements and documents submitted in accordance with the INDRP and any law that the Arbitrator deems fit to be applicable. In accordance with Rules paragraph 12, the Arbitrator may draw such inferences as are appropriate from the Respondent's failure to reply to Complainant's assertions and evidence or to otherwise contest the Complaint. In the circumstances, the arbitrator's decision is based upon the Complainant's assertions, evidence and inferences drawn from the Respondent's failure to reply.

III. Requirements of Paragraph 4 of the INDRP Policy, i.e. Issues Involved in the Dispute:

The INDRP policy lists the following three elements that the Complainant must prove to merit the finding that the domain name of the Respondent be transferred to the Complainant or whether any other remedy in terms of the paragraph 10 of the INDRP Policy will be available or not:

(i) the Registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights [Para 4(i) of INDRP Policy]

The Complainant has been using the mark MAHINDRA HOLIDAYS extensively and continuously since 1997 in respect of various goods and services including hotels, holiday resorts, camping services, transport, travel arrangement, accommodation, etc. Complainant owns various Trademarks for the marks MAHINDRA HOLIDAYS and CLUB MAHINDRA in different jurisdictions, with several suffixes in respect of hotels, resorts, entertainment activities, etc. Some illustrative certificates of registration and applications for registration made by the Complainant have been annexed with the Complaint.

The Complainant's mark, upon which disputed domain is based, is basically a combination of two words adopted from different languages 'Mahindra' and 'Holidays', and said plural combination was first put to use by the Complainant only. The addition of a plural "s" does not avoid the confusing similarity between the Domain Name and the Trade Marks. [Indivior UK Limited v. Cimpress Schweiz GmbH - Case No. D2018-0421 - indiviors.com]. The domain name in

dispute, <emirate-airlineservices.com>, consists of the singular of Complainant's registered trade mark for or including EMIRATES in combination with the descriptive term "airlineservices". The use of the singular of Complainant's trademark EMIRATES does not distinguish the domain name in dispute from Complainant's trade mark. [Emirates Group Headquarters v. Erica Vennum; Case No. D2008-0883; <emirate-airlineservices.com>].

The tests for comparison of the two word-marks were formulated by Lord Parker in *Planotist Co. Ltd.'s application (1906) 23 RPC 774* as follows : "You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trademarks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion -- that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of

the public which will lead to confusion in the goods -- then you may refuse the registration, or rather you must refuse the registration in that case."

The Complainant's main domain names MahindraHolidays.com and MahindraHolidays.in have been registered since 2004 and 2006 respectively. Since then the Complainant has spent substantial amount in sales and marketing expenses, advertisement and different sales promotion activities of their holiday resorts and entertainment activities in the name of MAHINDRA HOLIDAYS along with various prefixes and suffix.

Complainant contends, that the domain name <mahindraholiday.in> capitalizes on the use of the trademark, trade name, corporate name and domain name of the Complainant per se. The same is further evident from the disputed domain name's WHOIS information, where the name and address of the Complainant only has been provided, without any authority. It is also therefore amply clear that the said domain name is being used by the Respondent in bad faith.

The Complainant further contends that the mark CLUB MAHINDRA and MAHINDRA HOLIDAYS have become distinctive and has acquired secondary

meaning to connote and denote the trade source and origin of the Complainant company's hotels, resorts, clubs and entertainment activities provided thereof. The same is upheld, as Complainant Group first adopted the name Mahindra & Mahindra in 1948 had since then have diversified operations in various fields, including Club, Holiday Resort in 1997, while it has been listed at Bombay Stock Exchange since 1950s. Indeed, numerous courts and UDRP panels have recognized 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); Boehringer Ingelheim Pharma GmbH & Co. KG v Philana Dhimkana (WIPO Case No. D2006-1594); Allied DOMECCQ Spirits and Wine Limited v Roberto Ferrari, (INDRP Case No. 071); Philip Morris USA Inc. v Doug Nedwin/SRSPlus Private Registration (WIPO Case No. D2014-0339)].

Honorable Supreme Court of India in the matter of Satyam Infoway Ltd vs Siffynet Solutions Pvt. Ltd held that "A domain name, is accessible by all internet users and the need to maintain an exclusive symbol for such access is crucial as we have earlier noted. Therefore a deceptively similar domain name may not only lead to a confusion of the source but the receipt of unsought for services...

The doubtful explanation given by the respondent for the choice of the word 'Sify' coupled with the reputation of the appellant can rationally lead us to the conclusion that the respondent was seeking to cash in on the appellant's reputation as a provider of service on the internet." [2004 Supp(2) SCR 465]

Therefore, based on Complainant's clear rights in the Marks, along with the widespread popularity of Complainant's mark MAHINDRA HOLIDAYS, it is quite obvious that an Internet User would likely mistakenly believe that a website accessible by the URL: <mahindraholiday.in> (i.e. Disputed Domain) is managed or endorsed by Complainant, or enjoys the benefit of Complainant's resources. And no doubt, Disputed Domain Name is confusingly similar to Complainant's Mark.

Besides it is also well-established that the extensions such as '.co.in' in a disputed domain name does not affect a finding of similarity. In the INDRP matter of The Hershey Company V. Rimi Sen, 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 [INDRP/289 - Hersheys.co.in].

It was also very recently held in the matter of V-Guard Industries Limited v. Taesong Chong, that the first element of a UDRP complaint “functions primarily as a standing requirement” and entails “a straightforward comparison between the complainant’s trademark and the disputed domain name”. See *WIPO Overview 3.0, section 1.7. [Case No. D2018-2116 - vguard.com]*.

Thus, the Arbitrator finds that Complainant has proven that the domain name in dispute is confusingly similar to the registered trademark in which Complainant has rights. Therefore, it concludes that the Complainant has satisfied the requirement of paragraph 4(i) of the IN Domain Name Dispute Resolution Policy.

(ii) the Registrant has no rights or legitimate interests in respect of the domain name [Para 4(ii) of INDRP Policy]

The circumstances has been elaborated under Paragraph 7 of the INDRP policy as under and the Respondent need to fit in at least one circumstance under this clause in order to prove legitimate interest:

Para 7 of the INDRP Policy: Registrant's Rights to and Legitimate Interests in the Domain Name

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; or

(ii) the Registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or

(iii) the Registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Complainant has been into hospitality industry since two decades, while it started using the mark MAHINDRA HOLIDAYS in late 1990s, when no such mark was in use. *(Documents proving use of the mark MAHINDRA HOLIDAYS since 1997 by the Complainant have been annexed with the Complaint).* The trademark MAHINDRA HOLIDAYS is a coined term, first adopted by the

Complainant only. Complainant contends that the brand and domain name MAHINDRA HOLIDAYS has come to be solely associated with the Complainant and none else. Further, Complainant denies of having assigned, permitted, licenced, transferred or in any way authorized the Respondent to use the distinctive mark MAHINDRA HOLIDAYS or to register the domain name containing its mark. Complainant further submits that the registration of the MAHINDRA HOLIDAYS trademarks preceded the registration of the disputed domain name for decades. WIPO Panels under UDRP Proceedings have found that in absence of any licence or permission from the Complainant to use such widely known trademarks, no actual or contemplated bonafide or legitimate use of the domain name could reasonably be claimed (WIPO Case No D2013-0188, Groupe Auchan v. Gan Yu; WIPO Case No D2010-0138, LEGO Juris A/S v. DomainPark Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host Master).

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. Further, though the WHOIS of the disputed domain name

shows the name as Mahindra Holidays, but the WHOIS address has been provided that of Complainant only. This proves that the Respondent is not known by the Domain Name, but it is evidence of bad faith on behalf of the Respondent, as it is trying to pass off as Complainant. The said misuse further proves malafide intention on behalf of the Respondent to misleadingly divert consumers and to tarnish the complainant's trademark. 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".

At the time the disputed domain name was registered, the Complainant had widespread, extensive use and advertisement of its mark MAHINDRA HOLIDAYS for numerous years. The notoriety of the mark, coupled with its registration in the jurisdiction, where the Respondent is presumed to be located,

make it highly unlikely that the Respondent would not have known of the Complainant's rights in the mark prior to acquiring the disputed domain name.

It is well established that the Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name, and then the burden shifts to the Respondent to come forward with concrete evidence of such rights or legitimate interests. The Arbitrator finds that the Complainant has made such showing in this case but no information has been submitted by the Respondent on what rights or legitimate interests he may have in the disputed domain name. [Document Technologies, Inc. v. International Electronic Communications Inc., WIPO Case No. D2000-0270]. Also Respondents' failure to respond can be construed as an admission that they have no legitimate interest in the domain names [Pavillion Agency, Inc. v. Greenhouse Agency Ltd., WIPO Case No D2000-1221]. Many prior panels have found that complainants only need to establish a prima facie case in relation to the second element of the test under paragraph 4 of the Policy (see Mahindra & Mahindra Limited v. RV ABC Consulting Inc., Roy Smith, WIPO Case No. D2010-1576).

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. In the WIPO matter of American Home Products Corporation vs. Ben Malgioglio, [WIPO Case No. D2000-1602], 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. Further in the WIPO matter of Paris Hilton v. Deepak Kumar, [WIPO Case No. D2010-1364], 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."

Further, it can be concluded that Respondent is not commonly known by that name or carrying on business under the name, corresponding to the disputed

domain name, as the WHOIS information is rather that of Complainant. Further, neither Complainant has never assigned, granted, licenced, sold, transferred or in any way authorized the Respondent or any third party to register the disputed domain name. In the matter of Lockheed Martin Corporation v. Richard Ambrose / Lockheedmartin Incorporation, it was laid down that the WHOIS information associated with the domain name lists Respondent as “Richard Ambrose / Lockheedmartin Incorporation.” Richard Ambrose is the Executive Vice President of Lockheed Martin’s Space business area. Neither Mr. Ambrose, nor Complainant Lockheed Martin Corporation has registered this domain name. Respondent has failed to affirmatively provide evidence of its identity used to register the disputed domain name. Respondent therefore registered the disputed domain name using false WHOIS contact information. As a result, the Panel finds that Respondent is not commonly known by the disputed name under Policy Para 4(c)(ii). [NAF Claim Number: FA1810001813687].

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].

Thus, the Arbitrator finds that Respondent has no Rights or Legitimate Interests in the Domain Name <mahindraholiday.in>. Therefore, it concludes that the Complainant has satisfied the requirement of paragraph 4(ii) of the IN Domain Name Dispute Resolution Policy.

(iii) the Registrant's domain name has been registered or is being used in bad faith [Para 4(iii) of INDRP Policy]

The circumstances have been elaborated under Paragraph 6 of the INDRP policy as under and even single instance proved against Respondent is enough to conclude Bad Faith:

Paragraph 6 of the INDRP policy: Evidence of Registration and use of Domain

Name in Bad Faith:

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
- (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.

The registration of the disputed domain name <mahindraholiday.in> by the Respondent and that too in the name of Complainant, clearly indicates that the Respondent has registered the domain name in order to prevent the Complainant from reflecting the mark in a corresponding domain name and further intentionally attempted to attract Internet users to the Respondent's website 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.

The complainant contends that the Respondent has clearly attempted to use the popularity of the Complainant's well-known MAHINDRA HOLIDAYS brand for his own personal benefits. No doubt, 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 name with mala fide intent and to the Complainant's detriment and prejudice.

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 ?

In the said 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:

- (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,
- (ii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the domain name,
- (iii) the Respondent has taken active steps to conceal its true identity, by operating under a name that is not a registered business name,
- (iv) the Respondent has actively provided, and failed to correct, false contact details, in breach of its registration agreement, and

(v) 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.

Clearly, the above factors are proved in the current matter of <mahindraholiday.in> as well, as the Complainant has a strong reputation on the one hand, on the other hand Respondent has failed to respond or provide any evidence in support and further Respondent seems to have deliberately provided false WHOIS contact details, which belong to the Complainant.

It is impossible that the Respondent was not aware of the Complainant's rights to the mark as the Complainant's Domain names MahindraHolidays.com and MahindraHolidays.in were registered in the year 2004 and 2006 respectively. 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. 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. [LEGO Juris AS V. Robert Martin - INDRP/125 - 14 February 2010]

Clearly, the disputed Domain Name <mahindraholiday.in> incorporates the said Complainant's mark in its entirety. The paragraph 3 of the INDRP policy clearly states that it is the responsibility of the Respondent to find out before registration that the domain name that the registration of the domain name will not infringe upon or otherwise violate the rights of any third party. And a simple google search for the keyword MAHINDRA HOLIDAYS, throws the google results referring to the Complainant only. Therefore, it can be safely presumed that Complainant's use of mark was in the knowledge of the Respondent at the time of registration of the said domain name.

MAHINDRA HOLIDAYS & RESORTS INDIA LTD V MAHINDRA HOLIDAYS
(Domain: MahindraHoliday.in; Arbitrator: Ankur Raheja)

The screenshot shows a Google search for "Mahindra Holiday". The search results include a link to "Club Mahindra™ Holidays | 25 Years Of Family Holidays" with a sub-link "membership.clubmahindra.com/Join_the_Club/Sign_Up_Now". Below this is a promotional text: "Gift your family magical holidays for 25 years at 50+ resorts in India & abroad. Enjoy Free* 3N/4D on a majestic cruise in Malaysia with Club Mahindra membership. All Expense Paid Holiday* EMI starts from INR 8042* 50+ Resorts Worldwide. Explore 4300+ RCI resorts. In-Resort Activities." There are four sub-links: "Know About Membership" (Enjoy 7N/8Ds of Vacations Every Year for 25 years), "Member Reviews" (Read Reviews from our Happy Members Sharing their Holiday Experiences), "Exciting Offers" (Sign Up Now & Enjoy Great Benefits), and "Explore Our 56+ Resorts" (All Inclusive Family Resorts With Many In-resort Activities). At the bottom, there is a link "Explore Top Holiday Destinations In India and Abroad with Club ..." with the URL "www.clubmahindra.com/".

Club Mahindra Holidays
Hospitality company

clubmahindra.com

Club Mahindra Holidays is an Indian travel company founded in 1996. It is a part of the Mahindra Group and provides holidays on a timeshare basis. Mahindra Holiday & Resorts India Limited is a part of the Leisure and Hospitality sector of the Mahindra Group. Wikipedia

In the matter of Mahindra & Mahindra Limited v. Domain Admin [Claim Number: FA1205001442601], it was held that respondent's constructive knowledge of a mark does not appropriately satisfy a finding of bad faith pursuant to Policy Para 4(a)(iii). See Nat'l Patent Servs. Inc. v. Bean, FA 1071869 (Nat. Arb. Forum Nov. 1, 2007) ("Constructive notice does not support a finding of bad faith registration."). However, the Panel finds that Respondent's registration of a domain name identical to Complainant's MAHINDRA mark is evidence of Respondent's actual knowledge of Complainant's rights in the mark and consequently finds that Respondent registered and uses the disputed domain name in bad faith under Policy.

The Complainant had registered domain name MahindraHolidays.in in 2006 and already has official website on the same. Respondent seems to have intentionally registered the disputed domain name, which reproduces Complainant's well-known trademark MAHINDRA HOLIDAYS in singular form, in order to capitalize / profit from the goodwill associated with the famous mark. Only a person who is familiar with Complainant's mark could have registered a domain name that is confusingly similar [Barney's Inc. v B N Y Bulletin Board: WIPO Case No D2000-0059].

In the UDRP matter of PepsiCo, Inc. v. "null", aka Alexander Zhavoronkov, WIPO Case No. D2002-0562, 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. And given the popularity of the Complainant's MahindraHolidays.com website, the Complainant's mark MAHINDRA HOLIDAYS is now acknowledged as a well known mark, and is as such exclusively associated with Complainant's services. 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 of the domain name for more than two years. [Bayer Aktiengesellschaft v. Henrik Monssen, Wipo Case No D2003-0275].

The overriding objective of the Policy is to curb the abusive registration of domain names in circumstances where the registrant seeks to profit from or exploit the trade marks of another. Passive holding of a domain name containing marks with a reputation can be bad faith registration and use. [Telstra Corporation Limited v Nuclear Marshmallows, D2000-0003 (WIPO Feb. 18, 2000)]

Thus, the Arbitrator finds that the Domain Name <mahindraholiday.in> was registered and is being used in Bad Faith. Therefore, it concludes that the Complainant has satisfied the final requirement of paragraph 4(iii) of the IN Domain Name Dispute Resolution Policy.

8. Decision:

In the lights of the circumstances and facts discussed above, Arbitrator decides, “The disputed domain name is identical and confusingly similar to the MAHINDRA HOLIDAYS mark / trade name in which Complainant has rights and the Respondent has no right or legitimate interests in respect of the Domain

Name and the Respondent's Domain Name has been registered and is being used in Bad Faith".

Consequently the Arbitrator orders that **the Domain Name <mahindraholiday.in> be transferred from the Respondent to the Complainant** with no orders as to costs.



Ankur Raheja, MCA FCS LLB
Sole Arbitrator, NIXI, India
Date: 26th November 2018
Place: Agra, UP