



दिल्ली DELHI

P 576708

**BEFORE THE SOLE ARBITRATOR UNDER THE
.IN DISPUTE RESOLUTION POLICY**

IN THE MATTER OF

Ray Marks Co. LLC
9D0 Broadway, Suite 1001
New York, NY 10003

.The Complainant

Versus

Rachel Ray Techniques Pvt. Ltd
4/44 Madhuban, Shivdham
Film City Road, Malad (E)
Mumbai, Maharashtra
India 400097

.The Respondent

THE PARTIES

The complainant in the present proceeding is Ray Marks Co. LLC, 900 Broadway, Suite 1001, New York, NY 10003.

The complainant in this proceeding is represented through its authorised representative, D.P. Ahuja & Co., 53 Syed Amir Ali Avenue, Ballygunge, Kolkatta-19, India.

The respondent in this proceeding is Rachel Ray Techniques Pvt. Ltd, 4/44 Madhuban, Shivdham, Film City Road, Malad (E), Mumbai, Maharashtra, India 400097.

THE DOMAIN NAME, REGISTRAR AND REGISTRANT

The Domain Name in dispute is "RACHELRAY.IN". The Registrar is Directi Internet Solutions Pvt. Ltd. d/b/a PublicDomainRegistry.com. The Registrant is Rachel Ray Techniques Pvt. Ltd, 4/44 Madhuban, Shivdham, Film City Road, Malad (E), Mumbai, Maharashtra, India 400097.

PROCEDURAL HISTORY:

I was appointed as the Arbitrator by .IN Registry, to adjudicate upon the complaint of the Complainant, regarding the dispute over the domain name RACHELRAY.IN.

.In Registry has supplied the copy of the Complaint and Annexures to me.

On 03.05.2011, I sent an email to the parties informing them about my appointment as an Arbitrator.

Thereafter on 03.05.2011, myself I sent an email to Complainant requesting them to supply the copy of the complaint with annexure to the Respondent and in case if they have already served it, then to provide me with the details of service record.

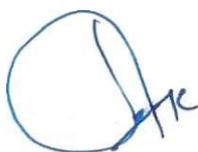
On 06.05.2011, I received an email from the Counsels/Representative of the Complainant, informing about the details of the service of the copy of Complaint to the Respondent. According to this mail copy of the complaint was duly sent to the postal address as well as on the email Id of the Respondent.

In accordance with INDRP read with INDRP Rules of Procedure, notice of arbitration was sent to the Respondent on 07.05.2011 with the instructions to file his say latest by 22.05.2011.

The Respondent filed his reply on 13.05.2011.

The Complainant filed the Rejoinder to the Response of the Respondent on 25.05.2011.

Thereafter, on 03.06.2011, in the interest of justice the Counsels/Representative of the Respondent or the Respondent was directed to file the Reply to the Rejoinder of the Complainant within 2 days as certain new pleas were raised in the Rejoinder filed by the Complainant.



The Respondent filed his reply to the Rejoinder of the Complainant on 04.06.2011.

On 08.06.2011, the Complainant vide an email, commented upon the Respondent's Reply dated 04.06.2011. But no permission was taken for giving such comments from the Tribunal and as they have not been taken into consideration while passing the present award.

Thereafter in the interest of justice and fairness, on 28.06.2011, certain queries were raised by the Tribunal on the Respondent to get clarity about certain issues. In response of which, the Respondent vide an email dated 30.06.2011, alleged that the Tribunal had exceeded its jurisdiction in raising such queries.

On 02.07.2011, the Complainant was given an opportunity to comment upon the issue raised by the Respondent with respect to the Tribunal exceeding its jurisdiction. The Complainant on 02.07.2011 itself clearly stated that the Tribunal was justified in raising such queries in the interest of justice and in no way had exceeded its jurisdiction.

The Complainant via an email dated 02.07.2011, filed certain documents in support of its contentions. On 04.07.2011, The Tribunal therefore directed the Complainant to file the "True Certified Hardcopy of documents" in the interest of justice and equity.

On 09.07.2011, the Tribunal received the "True Certified Hardcopy of documents" sent by the Complainant.

The Complainant and the Respondent have filed various documents as Annexures in support of their contentions.

I have perused the record and Annexures / documents.

JURISDICTION OF THE TRIBUNAL:

During the pendency of the arbitration proceedings, in the interest of justice and fairness the Tribunal had raised the following queries against the Respondent for getting clarity on certain issues:

- a. What is the reason for adoption and registration of the name "Rachel Ray" for their business?
- b. What is the evidence for showing the continuous working and management of the business of the Respondent from the date of its starting the business to till date?

The Respondent in its response dated 30th June, 2011, alleged that the Tribunal had exceeded its jurisdiction in raising such queries. The Complainant was given an opportunity to

comment upon the issue of the jurisdiction of the Tribunal, where, the Complainant vide an email dated 2nd July, 2011, disagreed with the Respondent and clearly stated that:

"It is the firm opinion and belief of the Complainant that this Tribunal has not exceeded its jurisdiction by raising the questions in its email of 28 June, 2011. In fact, the Complainant believes that the queries raised were pertinent and relevant to the present proceeding which aims to resolve an IPR dispute arising out of trademark violation. It is an established practice in every jurisdiction of the world that a person claiming any right to a trademark/trade name can be asked to explain the reason for his adoption of the said expression, or more specifically, the significance of the name/mark, in a contested proceeding.

Furthermore, the INDRP Policy and Rules requires the respondent to prove beyond doubt his "legitimate right or interest" in the disputed domain name. To that end, the respondent can be asked to explain the significance of his business name/trade name/trading style on the basis of which the respondent has claimed some kind of right to the disputed expression/domain name".

Hence, the Tribunal is of the strong belief that the queries raised by the Tribunal were necessary and essential in the interest of justice. As per Rule 8 of the INDRP Rules, the Arbitrator has all the powers and jurisdiction in accordance with the Arbitration and Conciliation Act, 1996, Dispute Resolution Policy etc.

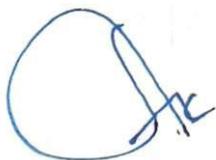
The Tribunal raised the said queries as a part of the arbitration procedure which was important and crucial for the Tribunal to take a fair and justified decision. Therefore, the Tribunal has in no way exceeded its jurisdiction in raising such queries.

FACTUAL BACKGROUND:

COMPLAINANT

The Complainant is a company formed by the television personality, celebrity chef, talk show host and author Ms. Rachael Ray. The Complainant is the registered proprietor of the Rachael Ray formative marks in the USA, the same has been used since 1999 for a range of products and services falling under various classes of the International Classification List.

The Complainant has various trademark registrations already existing in the USA and few which are pending including the ones in India, U.K. and European Union (CTM) a list of which is provided by the Complainant.



In addition to this, the Complainant is also the owner of various websites, with the trademark Rachael Ray as a part of their domain names through which it promotes its goods and services. The Complainant has promoted the said trademark Rachael Ray through various media including various popular TV shows, newspaper articles and other publications.

The Complainant has invested an enormous sum of money in its promotional activities involving advertising its products and services. It claims that the "Rachael Ray" trademark is distinctive, has acquired substantial goodwill and is an extremely valuable asset of the Complainant Company.

The Complainant alleges that the respondent through the disputed domain name www.rachelray.in is seeking to capitalize on the goodwill associated with the trademark of the Complainant and has registered the disputed domain name in bad faith with the view to create confusion and deception in the minds of the public.

The Complainant alleges that respondent's domain name www.rachelray.in incorporates the trade name of the Complainant and is also identical to the trademark Rachael Ray. That the respondent has no legitimate rights or interests in respect of the domain name "rachelray.in". That the disputed domain name is registered and is being used in bad faith by the respondent.

RESPONDENT

The Respondent is Rachel Ray Techniques Private Limited which is a company incorporated under the Companies Act 1956 in India on 23rd July 2009, providing goods and gift articles using the technology involving Laser Rays. Before this the company was incorporated as a partnership firm under the name of Rachel Ray techniques from 10th April 2007.

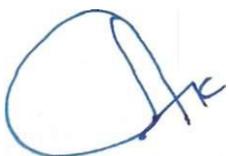
The Respondent has registered the disputed domain name <rachelray.in> on 21st April, 2009 as per the Whois Database.

The respondent has goods and services which are dealt in by the respondent fall in class 08, 09, 16 & 40 and that the complainant does not have any rights to the name Rachel Ray in the above mentioned classes.

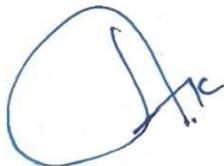
PARTIES CONTENTIONS:

Complainant

- a. The Complainant contends as follows in the Complaint:
 - i. The Respondent's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has the rights.



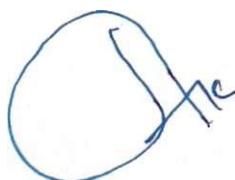
- ii. The Respondent has no rights and legitimate interest in respect of the domain name.
- iii. The Respondent has registered and is using his domain name in bad faith.
- iv. The complainant claims to be limited liability Company formed by the television personality, celebrity chef, talk show host and author Ms. Rachael Ray who is the host of various television shows as well as a well known celebrity in abroad and has been operating since 1999.
- v. The Complainant claims that it has invested an enormous sum of money in its promotional activities involving advertising its products and services through various media. The Complainant has further submitted that Ms. Rachael Ray is a very popular celebrity who has made appearances in various famous T.V. Shows and featured in various articles and issues of popular and well known magazines by which the Trademark "Rachael Ray" has acquired and gained a significant goodwill worldwide.
- vi. The Complainant claims that it has various trademarks registered in its name in various countries and few applications are pending for registration in several countries including India.
- vii. The Complainant further claims that the Respondent had also registered a domain name www.rechelrav.com on 20th September 2001, which was duly transferred to the Complainant, vide an award dated 7th July, 2010 by National Arbitration Forum. A suit filed by the Respondent against the said award is pending before the Hon'ble Bombay High Court.
- viii. The Complainant claims that its website wmv.rachaelray.com provides extensive information about the services rendered by it. The Complainant further submits that the Respondent filed an application for registration of "Rachel Ray Techniques" dated 3rd December, 2009 in several classes of trademark and the Complainant had filed oppositions against the same.
- ix. The Complainant claims that the respondent through the disputed domain name www.rachelray.in is seeking to capitalize on the goodwill associated with the trademark of the Complainant and has registered the disputed domain name in bad faith with the view to create confusion and deception in the minds of the public.



- x. The Complainant claims that the disputed domain name is an instrument of fraud and deception and its registration is causing irreparable loss and injury to the Complainant's reputation and goodwill.
 - xi. The Complainant as such has filed the present complaint praying therein to transfer the disputed domain name in its favour and award cost.
- b. The Respondent has contended the following in the Reply to the Complaint filed by him on 13.05.2011:
- i. The Respondent submits that "Rachel Ray Techniques Pvt. Ltd" is a company incorporated under the Companies Act, 1956, in India on 23rd July, 2009, providing goods and gift articles using the Technology involving Laser Rays. It is further submitted by the Respondent that prior to the Incorporation of the Company, the Respondent was working and operating as a partnership firm under the name "Rachel Ray Techniques" from 10th April, 2007.
 - ii. The Respondent submits that goods and services which are dealt in by the Respondent fall in Class 08, 09, 16 & 40 of the Trademarks. The Respondent further submits that the Complainant has no exclusive rights in the classes of the Trademark mentioned above and hence has no right in the disputed domain name.
 - iii. The Respondent alleges that the Respondent's domain name is not identical to the Complainant's domain name as they both are working and operating in totally different geographical areas and the Respondent does not supply its goods and services in the geographical zone where the Complainant deals with.
 - iv. The Respondent claims that the Respondent, and for that anyone in India, had ever heard of existence of domain name/trademark "Rachael Ray". The Complainant had no existence or presence in India when the Respondent adopted their said domain name "rachelray.in" as the Complainant does not have any business interest as well as any trademark registered in India.
 - v. The Respondent claims that the Complainant's mark "Rachael Ray" is related to completely different services of selling food and diet products in United States, whereas the Respondent's domain name "rachelray.in" is used in relation to Respondent's products, gift and other articles made using Laser Ray Techniques and hence does not in any manner affect the trademark of the Complainant.

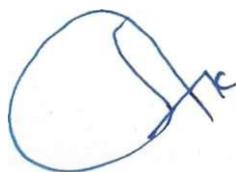


- vi. The Respondent claims that it has various trademark applications pending for registration and has not idea about any objections or oppositions made in regards to it.
 - vii. The Respondent submits that they have all the right and legitimate interest in the domain name and they have used the same in good faith and not for the purpose of fraud.
 - viii. The Respondent further submits that the Complainant has the intention to grab the domain name of the Respondent and reverse hijack the domain name of the Respondent.
- c. The Respondent has filed the following documents along with its response:
- i. Copy of the PAN Card in the name of the Respondent.
 - ii. Cover page of the Memorandum of Association of the Company.
 - iii. Cover page of the Articles of Association of the Company.
 - iv. Copy of the Incorporation Certificate showing incorporation of the company from 23rd July, 2009.
 - v. Copy of the various advertisements published in several magazines and directories.
 - vi. Copy of the Visiting card of manager of the company.
 - vii. Copy of the bill book and the cheque book of the company.
 - viii. Copy of the documents regarding purchase of a shop for the company.
- d. The Complainant filed its rejoinder on 25.05.2011 and contended the following:
- i. The Complainant claims that it does not possess any intentions of reverse hijacking and such are just false allegations by the Respondent.
 - ii. The Complainant contends that the Respondent after filing of the complaint has removed all the contents of the website of the said disputed domain name and is itself parked with Sedo's Domain Parking.
 - iii. The Complainant submits that the Respondent has failed to show a justified proof of its legitimate working and adoption of the domain name in good faith as



immediately after filling of the present complaint by the Complainant, the Respondent had removed all the contents of its website.

- iv. The Complainant further submits that the Respondent was very well aware about the opposition made to its trademark registration application and for the Respondent's further clarification explained the Opposition made against the registration procedure.
- v. The Complainant alleges that the since all the transaction of the business of the Complainant are conducted over the internet where the traditional concepts of territorial boundaries do not exist, hence the contention of the Respondent of different geographical zones is vague. The Complainant further alleges that the Respondent has indulged in the practice of "Typo-squatting" by merely misspelling the trademark of the Complainant "Rachael Ray" in order to divert the potential customers to its website.
- vi. The Complainant claims that the Respondent has not produced any document to show its actual working like procuring of any order from any corporate house or a list of its manufactures, distributors or sellers etc. The clearly signifies that the Respondent is not carrying on any legitimate or bonafide business under the contested domain name.
- vii. The Complainant claims that the copies of the first page of MOA and AOA of the Company, PAN Card of the Rachel Ray Techniques Pvt. Ltd. and Incorporation Certificate of the Company are not original and are no evidence of actual commencement and conducting of business. The Complainant further claims that cash memo and cheque book filed by the Respondent are fabricated and procured only for the purpose of reflecting use of the mark "Rachel Ray".
- viii. The Complainant claims that there are no evidences filed by the Respondent to show that the copies of the advertisements filed by it are genuine or true. The Complainant further submits that the evidences or documents filed by the Respondent, bears an address different from the registered address of the Respondent.
- ix. The Complainant submits that the Respondent has intentionally attempted to attract internet users to the disputed website and from there to its other online location, by creating confusion with the Complainant's trademark and hence, it



does not prove that the Respondent has been commonly known by the domain name.

e. The Respondent filed the Response to the Rejoinder of the Complainant on 04.06.2011 and submitted the following points:

i. The Respondent submits that its domain name has been locked by the registry and hence not accessible till the time current arbitration proceedings are complete.

(This fact has been admitted by NIXI vide its email dated 08.07.2011 sent through Sh. Rajiv Kumar, in response to the query raised by the Tribunal.)

ii. The Respondent submits that the documents filed by the Respondent as evidences are duly attested by the Notary for authentication. The Respondent further submits that with reference to the address of the Respondent mentioned in the documents of the Company, the mentioned address is the registered address of the two Directors of the Company.

iii. The Respondent claims that it is the honest adopter and registrar of the domain name "Rachel ray" and has been carrying on the continuous business since the time of incorporation of the Company.

iv. The Respondent has filed the various documents along with its response as evidences like copies of the directories, newspapers and magazines etc.

DISCUSSIONS AND FINDINGS:

Rule 8 (b) of the INDRP Rules of Procedure provides that *"In all cases, the Arbitrator shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case"*.

As mentioned above fair opportunity has been given to both the Parties to file their contentions and after perusal, the following Arbitration proceedings have been conducted.

Rule 12 (a) of the INDRP Rules of Procedure provided that *"An Arbitrator shall decide a Complaint on the basis of the statements and documents submitted to it and in accordance with the Arbitration and Conciliation Act, 1996, Dispute Resolution Policy, the Rules of Procedure and any bye-laws, rules and guidelines framed there under, and any law that the Arbitrator deems to be applicable"*



In the present circumstances, the decision of the Arbitrator is based upon the contentions and evidence filed by both the parties respectively and conclusion drawn from the same.

Having perused the submissions and documentary evidence placed on record, the Complainant has proved that he has statutory and common law rights in the mark "RACHAEL RAY".

Further, the Arbitrator is of the view that the Complainant has satisfied all the three conditions outlined in the paragraph 4 of .IN Domain Name Dispute Resolution Policy, viz.

- (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.

BASIS OF FINDINGS:

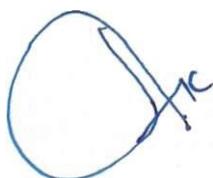
The Domain Name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights:

The Complainant contends in the complaint that the domain name of the respondent i.e. <rachelray.in> is identical and confusingly similar to RACHAEL RAY, its trademark and its domain names associated like <rachaelray.com>.

It is further stated that the complainant is the registered proprietor of the "RACHAEL RAY" trademark in numerous countries in the world and various registration applications are pending in countries including India and therefore, has gained significant reputation and its mark can be termed as a well known brand. The complainant is also the registrant and proprietor of various Domain name registration at International and domestic level.

After analyzing the trademark of the Complainant "RACHAEL RAY" and the disputed domain name <rachelray.in>, the Tribunal is of the opinion that the mere difference and distinguishing factor between them is the alteration of "a" in the name. Whereas, both of them are phonetically similar and are pronounced exactly in the same manner.

The Tribunal is of the opinion that the disputed domain name is confusingly similar to the Complainant's Trademark as sheer deletion of an alphabet or misspelling a word does not distinguish a domain name from a Trademark.



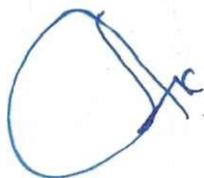
This proposition was also upheld in the following cases:

1. M/s Satvam Infowav Ltd. Vs. M/s Sifvnet Solution (P) Ltd. 1AIR 2004 SC 35401, it has been held that domain name has all the characteristics of a trademark. As such principles applicable to trademark are applicable to domain names also. In the said case the words, "Sify" & "Siffy" were held to be phonetically similar and deletion of an alphabet would not make them dissimilar.
2. Rediff Communication Limited Vs. Cyberbooth & another. [AIR 2000 Bom 27], it was held that there can be no doubt that two marks/domain names, "REDIFF" of the plaintiff and "RADIFF" of the defendants are almost similar. When both the domain names are considered it is clearly seen that two names being almost similar in nature there is every possibility of Internet user being confused and deceived in believing that domain names belong to one common source and connection although belong to two different persons.
3. Myspace, Inc vs. Junghu Kang. FA 672160 (National Arbitration Forum. June 19, 2006), where it was held that the disputed domain name <mypce.com>, was confusingly similar to the mark <MYSPACE>, and that a slight difference in spelling between the Mark and the disputed domain name does not reduce the confusing similarity.
4. Billy Connolly vs. Anthony Stewart. D2000-1549 (WIPO February 05, 2001), it was held that <billiconnelly.com> was confusingly similar to Billy Connolly and the names are phonetically equivalent and a likelihood of confusion must exist.
5. Alliance & Leicester Plc Vs. Henao Berenice, WIPO Case D-2005-0736, it was held that <aliance-leicester.com> was confusingly similar to the Complainant's Trademark Alliance & Leicester as there was a mere spelling difference in both.

The Tribunal further notes that the Respondent's domain name is created by mere deletion of space between the two names of the Trademark of the Complainant and addition of cCTLD ".in" in the end. Such is not sufficient to make the domain name distinct and hence the disputed domain name is confusingly similar to the Complainant's Trademark.

The Tribunal also gets support to the finding from the following cases:

1. Bond & Co. Jewellers, Inc. Vs. Texas International Property Associates, FA 937650 (National Arbitration Forum 30th April 2007), it was held that the elimination of the space between the two words of the Complainant's mark insufficiently establish distinctiveness from the mark pursuant to Policy 4 (a)(i).



2. Lego juris A/S v. Robin Martin, INDRP/118 (February 14, 2010), it was held that has the addition of country code ("CTLD") in the domain name is not sufficient to distinguish from the mark and does not change the overall impression of the designation as being connected to a trademark of the Complainant.

The other aspect, which is asserted by the parties, is that the spheres of user of trademark and domain name, and the manner in which they are used or sought to be use. The Respondent has alleged that the disputed domain name is related and used in different manner and different business or field, or sphere.

The Tribunal concludes that domain name and trademark, which may be used in different manner and different business or field, or sphere, can still be confusingly similar or identical.

This proposition was also upheld in the following cases:

1. J.D. Edwards & co. Vs. Nadeem Bedar, WIPO Case D-2000-0693, wherein it was held that its irrelevant that domain name or trademark carry on business in different fields, when they are similar phonetically or in appearance.
2. M/s Satvam Infoway Ltd. Vs. M/s Sifynet Solution (P) Ltd, TAIR 2004 SC 3540f it was held that in modern times domain name is accessible by all internet users and thus there is need to maintain it as an exclusive symbol. It is also held that it can lead to confusion of source or it may lead a user to a service, which he is not searching.

Thus the conclusion is that the domain name of the Respondent is identical and confusingly similar to the Trademark of the Complainant.

The Registrant has no rights or legitimate interests in the respect of the domain name

It is clear that once a Complainant makes a prima facie case, then the burden shifts to the Respondent to provide evidences to establish rights or legitimate interests in the disputed domain name.

This proposition was also upheld in the following cases:

1. Croatia Airlines d.d. v. Modern Empire Internet Ltd, WIPO case No. D2003-0455, where it was held that the complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, respondent carries the burden of proving rights or legitimate interests in the domain name. If the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4 (a) (ii) of UDRP.



2. Hanna-Barbera Productions, Inc. Vs. Entertainment Commentaries, FA 741828 (National Arbitration Forum, September 25, 2006), where it was held that the Complainant must first make a prima facie case showing that the Respondent does not have rights or legitimate interests in the subject domain name. If the Complainant satisfies its burden, then the burden shifts to the Respondent to show that it does have rights or legitimate interests in the subject domain name.

The Tribunal determines that the Complainant has made positive assertions and concrete evidences making a prima facie case showing that the Respondent does not possess rights or legitimate interests in the subject domain name. Hence, the burden shifts on the Respondent to prove that it has rights or legitimate interests in the subject domain name. Whereas the Respondent has not discharged the onus positively, which had shifted upon him as the Respondent neither put forth and has nor provided such evidence, except that he has only made bald assertions which will be clear from the following:

According to the paragraph 7 of the .IN Dispute Resolution Policy, the following circumstances show Registrants rights or legitimate interest in the domain for the purpose of paragraph 4(h)

- 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*
- 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.*

- a. While considering paragraph 7 (i) of the .IN Dispute Resolution Policy, "*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*", the Complainant has contended that Respondent has no intentions or purpose to use the disputed domain name for bona fide offering of goods and services in relation to it. The Complainant claims that the Respondent has not produced any document to show its actual working like procuring of any order from any corporate house or a list of its manufactures,

distributors or sellers etc. The clearly signifies that the Respondent is not carrying on any legitimate or bonafide business under the contested domain name.

The Respondent has argued that the before any notice of the dispute, it was using, or had 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. It has further contended that the Respondent is a company incorporated under the Companies Act 1956 in India on 23rd July 2009, providing goods and gift articles using the technology involving Laser Rays. Before this the company was incorporated as a partnership firm under the name of Rachel Ray techniques from 10th April 2007. As such the Respondent argued that he has proved and satisfied the conditions of paragraph 4(ii) & 7 of INDRP.

The Respondent to show his bona fide offering of goods or services has produced evidences to the Tribunal like advertisements in the newspapers and telephone directories, copy of incorporation certificate and copy of PAN Card etc.

The Tribunal does not find such evidences and documents to be sufficient enough to show or demonstrate bona fide offering of goods or services in the name of the disputed domain name. It is pertinent to note that the Tribunal had directed the Respondent to furnish hard evidence of its continuous working and offering of its services since its incorporation. But on the other hand, the Respondent has not provided any positive, cogent and specific evidence that he is known or recognized by domain name, by its user and that he in fact uses it for providing goods or services. At least he could have shown that he made demonstrable preparations to use the domain name for providing goods or services.

The Respondent has shown no solid, direct and hard evidence like copy of balance sheet of the company, sales volume, bills, vouchers etc and revenue in connection with its products for showing his continuous running business. On directions of the Tribunal dated 28th June, 2011, to produce such evidence, the Respondent sent only two certificates from its Chartered Accountant which does not show that the Respondent is continuously doing effective business. More so when he knew that his alleged use or preparations to use domain name is challenged by the Complainant.

Hence, the Tribunal is at a conclusion that the Respondent has neither put forth or provided any evidence to show that the Respondent is not engaged in or demonstrably prepared to engage in offering any bonfide goods or services in the name of the disputed domain name.

This proposition was also upheld in the following cases:



1. Pfizer Inc. Vs. Deep Soni and Ashok Soni, (Case No. D2000-0782), it was held that the respondent to prove his right or legitimate interest in domain name, must show that he is using the domain name for offering of goods and services or that he is making a demonstrable preparation to use the domain name for offering goods and services.
2. Madonna Ciccone v. Dan Parisi, ICANN Case No.D2000-0847.in which it was held that a use which intentionally trades on the fame of another cannot constitute a 'bona fide' offering of goods or services.
 - (b) While considering paragraph 7 (ii) of the .IN Dispute Resolution Policy, "*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*", the Complainant has stated that Respondent is neither commonly known by the disputed name, nor it is a personal name.

The Respondent has argued that it has been working under the name "Rachel Ray Techniques" since 2007 in India and has gained significant recognition in the said name. The Respondent has further contended that anyone in India, had never heard of existence of domain name/trademark "Rachael Ray" of the Complainant. The Complainant had no existence or presence in India when the Respondent adopted their said domain name "rachelray.in" as the Complainant does not have any business interest as well as any trademark registered in India.

It is pertinent to note that on 28th June, 2011, the Tribunal raised a query to the Respondent to clarify as to why it had adopted the said domain name. The Respondent has given the following reason for adopting the said domain name vide email dated 30th June, 2011:

"Without prejudice to what is stated herein above and herein after the respondent states that the name was initially chosen by one of the previous partners. The respondent believed that the name was derived from the name of some family member of the said previous partner. But it was brought to the notice of the respondent by the previous partner that the firm's name was derived from the business he planned to do at that stage. 'R' from Random, 'A' from Art, 'C' from Craft, 'H' from Hologram, 'E' from Etching & 'L' from Laser Cutting. As the technology was used Laser Rays, hence the name was derived to "Rachel Ray".

The Complainant has refuted the above contention of the Respondent in regard to the adoption of the name as in the earlier Arbitration Proceedings (National Arbitration Forum, FA No. 1004001319966, decided on 7th July, 2010) between both the parties for some other



domain name, the Respondent had given the reason for adoption of the "Rachel Ray" name as the said name was the founder's daughter's name and because of numerology factors. The Complainant has filed true copy of the Respondent's response before the National Arbitration Forum in respect of the dispute relating to domain name www.rachelray.com. The relevant portion of paragraph 6 of the said Response is reproduced hereunder:

"With reference to the unnumbered Paras on Page 3 the respondent states that the reasons for choosing the name are personal. The daughter of the technical partner of the original firm was Rachel. It was decided to name the firm as "Rachel Lazer Techniques ". But as the name was not in tune with numerology in which the respondent believe, it was decided to make some changes in the name. The word "Lazer" was replaced by "Ray" as all lazars and just Rays. "

The Complainant has also filed true copy of the Respondent's Complaint in Suit No. 2789/2010 pending before the High Court of Mumbai. The Paragraph 4 (c) of the said complaint is reproduced hereunder:

"the firm name viz, "Rachel Ray Techniques " was chosen from the name of the daughter of the original technical partner, whose name is "Rachel". As aforesaid, the Firm, while carry on its business was using Lazer Technology. In view of the above it was at one stage decided to name the firm as "Rachel Lazer Techniques ". However, as the name was not in tune with the numerology, in which the Plaintiff believe, it was decided to make some changes in the name. In view of the above, the word "Lazer" was substituted by a word "Rays " as all Lazer and Just Rays ".

These contradictory stands of the Respondent in different proceedings smell rat about the Respondent's explanation in choosing similar name as that of the Complainant. It is difficult to believe that the Respondent made categorical statement about adopting of the name of the company from the name of daughter of original technical partner without verifying it from the said partner. In the complaint, filed before the Hon'ble High Court of Mumbai, it is specifically mentioned that the name of the daughter of the original technical partner is "Rachel". It is pertinent to note that the said Complaint is duly verified.

In view of contradictory stand of the Respondent in different proceedings about choosing similar name as that of the Complainant, this Tribunal is of the view that the Respondent has failed to give any plausible and acceptable reason for choosing similar name as that of the Complainant.



As discussed above, the tribunal is of the view that the Complainant has legitimate rights and interest in the Trademark irrespective of the fact as contended by the Respondent that the Trademark of the Complainant was not known in the India and anyone in India wasn't aware about the said Trademark and the Complainant had no Trademark registered in India.

The Tribunal also gets support to the finding from the following cases:

1. Uniroyal Engineered Products, Inc. Vs. Nauga Network services (WIPO Case No. D2000 - 0503) & Consorzia del Formaggio Parmigiano Reggiano Vs. La casa del Latte di Bibulic Adriano (WIPO Case No. D2003-0661). it was held in both the cases that the location of the registered Trademark are irrelevant when ascertaining or finding rights in the mark.

The Tribunal concludes that the Respondent has failed miserably in providing any substantial evidence to show that it is commonly known by that name or is conducting any business in the said name. In order to prove that the Respondent is commonly associated or known by the said name "Rachel Ray", it must supply some hard and material evidences as to why it chose the name rather than few documents and indistinguishable paper of the company which establishes no distinguishable factor between the Trademark of the Complainant and the disputed domain name of the Respondent.

The Tribunal also gets support to the finding from the following cases:

1. Morgan Stanley v. Keep Guessing, INDRP/024 (June 27, 2007), has been relied upon, where it was held that Respondent has failed to show that he has a right or legitimate interest in the domain name, as he is neither known by the domain name, nor is it his personal name.
2. Pauleka Vs. Paula Korenek, (WIPO Case No. D2003-0453. July 24. 2003). it was held that "in order to have rights or legitimate interests under the "commonly known" provision of the policy the Respondent must be commonly known by the domain name prior to registration of the domain name in issue".

Thus the Tribunal concludes that the Respondent has failed to show evidences to prove that it is commonly known by the disputed domain name.

- (c) While considering paragraph 7 (iii) of the .IN Dispute Resolution Policy, "*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 contended that Respondent is not making a legitimate non commercial or fair use of the domain name.

According to Complainant, disputed domain name has been only adopted by the Respondent for commercial gain. The sole purpose of the Respondent is to divert Internet users to its web site. The Complainant further alleges that the Respondent has indulged in the practice of "Typo-squatting" by merely misspelling the trademark of the Complainant "Rachael Ray" in order to divert the potential customers to its website.

The Respondent has refuted the above contentions of the Complainant by stating that the Complainant is related to completely different services of selling food and diet products in United States, whereas the Respondent's domain name "rachelray.in" is used in relation to Respondent's products, gift and other articles made using Laser Ray Techniques and hence does not in any manner affects the trademark of the Complainant.

The Tribunal notes and concludes that as stated earlier the Respondent has not produced any substantial evidence to show its bonfide using or offering of goods and services in the said disputed domain name. By the documents provided by the Respondent it appears that a company has been formed in hurry without having any legal documents to show its working since 2007. The Tribunal believes that even if the Respondent has different working sphere then as of the Complainant, it may still lead to confusion to the internet users. This may lead to diversion of the potential customers and users of the Complainant to the website of the respondent.

The Tribunal also gets support to the finding from the following cases:

1. J.D. Edwards & co. Vs. Nadeem Bedar, WIPO Case D-2000-0693, wherein it was held that its irrelevant that domain name or trademark carry on business in different fields, when they are similar phonetically or in appearance.
2. M/s Satvam Infoway Ltd. Vs. M/s Sifynet Solution (P) Ltd, TAIR 2004 SC 3540], it was held that in modern times domain name is accessible by all internet users and thus there is need to maintain it as an exclusive symbol. It is also held that it can lead to confusion of source or it may lead a user to a service, which he is not searching.
3. Alliance & Leicester Plc Vs. Henao Berenice, WIPO Case D-2005-0736, it was held that use of the domain name by the Respondent should be bonafide without the intent to mislead internet users or consumers or to divert them to his website and without our intent to tarnish trademark of Complainant.

The Tribunal finds that the above submission of the Complainant has not been rebutted by Respondent in a proper way and by giving insufficient evidences, as such they are deemed to be admitted by him. Even otherwise the above facts and annexures establish that the



Respondent has no right or legitimate interest in the disputed domain name under INDRP paragraph 4(ii).

The Registrant domain name has been registered or is being used in bad faith

The Complainant alleges that the Respondent has registered the domain name only with the intention to create confusion in the mind of the internet users and to attract them to its impugned domain name. The Complainant has contended that the Respondent has the full knowledge and has intentionally attempted to divert the users from the domain name/website of the Complainant and also to deceive the consumers into believing that there is a connection or association between the Complainant and Respondents website.

The Respondent has argued the above contentions of the Complainant by stating that it has been using the disputed domain name by offering bonafide services and goods and has not registered the domain name in bad faith.

The Tribunal notes that the Respondent as stated above has failed to produce any evidence or document showing that the said domain name was not registered in bad faith and for providing bonafide services and goods. The Respondent's contradictory version about selection of name "Rachel Ray" in previous proceedings, detailed supra and present arbitration proceedings also demonstrate so.

The Tribunal concludes that the Complainant is a well known trademark in domestic and international market and has adopted "Rachael Ray" as its trademark in numerous countries. The Complainant has provided enough substantial evidence showing the number of countries in which it has acquired "Rachael Ray" as its domain name/Trademark and has proved that the Respondent is seeking to capitalize on the goodwill associated with the Complainant.

The Tribunal also gets support to the finding from the following cases:

1. Barney's Inc. Vs. BNY Bulletin Board. (WIPO Case No. D2000-0059), it was held that registration of a domain name containing a famous mark is strong evidence of bad faith.
2. N.R Dongre & Ors. Vs. Whirlpool Corp. and Anr. (JT 1996 (7) SC555), it was held that a well known Trademark even if only has existence or presence outside India, any registration with incorporation of such Trademark would amount to Bad faith and Infringement.

The Tribunal further concludes that the Respondent has registered the domain name in bad faith as it does not have any fix or concrete evidence to show that reason behind the adoption



of the disputed domain name. As stated in above points, the Respondent has been taking contradictory and false stands with respect to registration and adoption of the disputed domain name. This act of the Respondent clearly shows the bad intention and bad faith in registering the disputed domain name.

The Tribunal is of the view that as per the facts and circumstances it is clear that the Respondent has countered many contentions of the Complainant but it is also evident that they got the domain name registered in bad faith.

DECISION

In view of the above facts and circumstances, it is clear that the Complainant has succeeded in its complaint. In the facts and circumstances of the case it can be presumed that only purpose for the registration of the disputed domain name was to capitalized on the fame and reputation of Complainant and to make monetary benefit.

The Respondent has got registered and used the disputed domain name in bad faith .IN Registry of the NIXI is hereby directed to transfer the domain name of the Respondent i.e. <rachelray.in> to the Complainant. In the facts and circumstances of the case no cost or penalty is imposed upon the Respondent. The Award is accordingly passed on this 9th day of July, 2011.

It consumed a little more time in passing the present award as the Tribunal wanted to arrive at the right decision and as such directed parties to produce certain information and documents which consumed some time.



Sole Arbitrator

Date: 9th July, 2011