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C 417263

BEFORE SHRI SANJAY KUMAR SINGH ARBITRATOR

IN DOMAIN NAME DISPUTE RESOLUTION POLICY (INDRP)

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IN RE:

Clariant AG
Rothausstrasse 61
CH-4132 Muttenz
Switzerland

.Complainant

Versus

Workplace
Allmendstrasse 140
CH-8041 Zurich
Switzerland

.Respondent

1. THE PARTIES:

The complainant is Clariant AG Rothausstrasse, 61 CH-4132, Muttenz, Switzerland.

(complainant's authorized representative is Braunpat Braun Edgar AG, Reusstrasse 22, CH-4052 Basel, Switzerland)

The Respondent is Workplace Allmendstrasse, 140, CH-8041, Zurich, Switzerland.

(Respondant through Martin Hochuli, Allmendstrasse 140, CH-041, Zurich, Switzerland)

Sanjay Kumar Singh

2. DOMAIN NAME AND TRADEMARK IN DISPUTE:

Domain name of the respondent is "**clariant.in**"

The trademark of the complainant is "**clariant**". The registry is National Internet Exchange of India (NIXI).

3. BRIEF BACKGROUND:

This arbitral proceeding commenced in accordance with IN Dispute Resolution Policy (INDRP) and rules framed thereunder.

The complainant submitted his complaint in the registry of NIXI. Shri Sanjay Kumar Singh was appointed as Sole Arbitrator in the matter by NIXI.

It is alleged by the complainant that it is the registered owner of the trademark "**clariant**" vide Trade Mark No.668124 dated 05-06-1995 has been duly issued by the trademark registry at Mumbai. It has further alleged that the trademark has been issued in respect of the CHEMICAL PRODUCTS FOR INDUSTRIAL USE, SYNTHETIC RESINS included in the class-1. It is further alleged by the complainant that it has been using this logo trademark for many years and the same is also published in the journal NO.MEGA-6.

It is also alleged by the complainant that it is the registered owner of the trademark "**clariant**" vide Trade Mark No.668125 B dated 05-06-1995 has been duly issued by the trademark registry at Mumbai. It has further alleged that the trademark has been issued in respect of the NATURAL RESINS, DYES, PIGMENTS, MORDANTS AND LACQUERS included in the class- 2. It is further alleged by the complainant that it has been using

Sanjay K Singh

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this logo trademark for many years and the same is also published in the journal NO.1280.

A copy of complaint has already been sent to the respondent by the .In Registry through e-mail. Upon receipt of the complaint, the Arbitrator sent a notice dated 27.11.2006 to the respondent to send his defence / counter to the complaint alongwith supportive documents / evidence at his e-mail address within 10 days from receipt. But the respondent did not come forward and send his defence / counter to the complaint.

Failing to send the defence / counter by the respondent, the Arbitrator again sent a notice dated 09-01-2007 by giving another opportunity to the respondent to send his defence / counter to the complaint with further notice that in default of non-filing or sending of the defence / counter to the complaint, the matter would be proceeded ex-parte and award would be passed ex-parte on merits of the case.

Failing to send the defence / counter by the respondent, the Arbitrator again sent a notice dated 21-01-2007 by giving last and final opportunity to the respondent to send his defence / counter to the complaint with further notice that in default of non-filing or sending of the defence / counter to the complaint, the matter would be proceeded ex-parte and award would be passed ex-parte on merits of the case. It was also stated in the notice that it was last and final opportunity to the respondent and no further opportunity will be given.

Inspite of repeated notices, the respondent has again not come forward and has not sent any reply / defence / counter to the either notice or complaint to the Arbitrator. The respondent has sent two letters vide e-

Sanjay K. Singh

mail but has not sent any reply / defence / counter to the either notice or complaint to the Arbitrator. Therefore, this matter is being decided on the merits of the case as per law of the land.

4. PARTIES' CONTENTIONS:

- (i) The complainant has alleged that domain name of the respondent is identical and confusingly similar to his trademark in which it has rights.
- (ii) The complainant has alleged that respondent does not have rights or legitimate interest in respect of domain name and also the respondent has no registered trademark rights of the said domain name. **The complainant has submitted that it is a very well known and worldwide operating chemical company using its company name and its trade and service marks since many years having spent a lot of financial and business efforts in building up a strong brand and reputation.** The complainant has alleged that respondent clearly intends to mislead potential customers of the complainant to its website taking advantage of the common prejudices that chemical industries cause environmental pollution. The complainant has further alleged that the respondent is seeking the advantage of the well known company name and trademark of the complainant and is thereby tarnishing the reputation and trademark at issue.
- (iii) The complainant has further alleged that the domain name is registered by the respondent and is used by him in bad faith. **The**

Saujeet Kr. Singh

complainant has submitted that its trade marks are well known in India. The complainant has alleged that the respondent is misleading potential customers to their website by taking advantage of prejudices. The complainant has further alleged that the respondent is tarnishing the complainant's the reputation and credit by fomenting publicly common prejudices against chemicals giants as being environmental sinners knowing exactly that the complainant has nothing to do with the pollution of temples and the "holy waters". The complainant has further alleged that the intention of the respondent could be creation of a likelihood of confusion with the complainant's company name and trademark and therefore the respondent has registered the disputed Domain name in bad faith. The complainant has further alleged that the respondent's intention is not to act in good faith but has got registered the disputed Domain name in bad faith.

The complainant has sought the relief of transfer of domain name "**clariant.in**" to him.

5. OPINION/FINDING:

The para no.4 of the IN Domain Dispute Resolution Policy (INDRP) is as follows:-

TYPES OF DISPUTES

Any person who considers that a domain name conflicts with his legitimate rights or interest may file complaint to .IN Registry on following premises:

Sanjay Kr Singh

- 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."

The para no.6 of the IN Domain Dispute Resolution Policy (INDRP) is as follows:

6. EVIDENCE OF REGISTRATION AND USE OF DOMAIN NAME IN BAD FAITH

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

Sanjay KV Singh

reflecting the mark in a corresponding domain name, provided that the Registrant has engaged in a pattern of such conduct; or

- ii) by using the domain name, the Registrant has intentionally attempted to attract Internet users to the Registrant's website or other online 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 para no.7 of the IN Domain Dispute Resolution Policy (INDRP)

is as follows:-

**7. 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 purpose of paragraph 4 (ii):

- i) before any notice to the Registrant of the dispute, the Registrant's use of, or demonstratable preparations to use, the domain name or a name corresponding to the domain name in connection with a bonafide offering of goods or **services;**

Sanjay K. Singh.

- ii) the Registrants (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 other fact, which is to be dealt with before going into merit is, that, as to whether, the cases decided by WIPO- Administrative Panel could be considered, while deciding the present controversy. Moreover these cases throw light upon various important aspects of controversy. As such they would be considered, while deciding the present controversy, in so far as they do not conflict with INDRP.

8. OPINION AND FINDINGS ON MERITS

A) Whether the domain name is identical or confusingly similar to a trademark in which complainant has right.

It has been held in Indian decision **M/s Satyam Infoway Ltd. Vs. M/s Sifynet Solution (P) Ltd. JT. 2004 (5) SC 541**, that Domain name has all characteristics of 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 addition of work 'net' in one of them would not make them dissimilar.

Sanjay kr Singh

It is held in Indian case **JT.2004 (5) SC 541**, 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 conclusion is 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.

Thus the conclusion is that the domain name of respondent is identical and confusingly similar to the trademark of complainant.

Now the other important aspect that needs consideration is, as to whether the complainant has right in the trademark. It is important to mention here that as per the claim of the complainant the respondent has no trademark right on the said domain name.

This principle is settled in many above Indian cases and referred cases **JT 2004(5) SC 541 and 2004(5) SCC 287**. The complainant has made submission that he has legitimate trademark in India, he is using trademark for many years, his Trade Mark was registered and the registration was issued by the Office of the Trade Mark Registry vide Trade Mark No.668124 dated 05-06-1995 duly issued by the trademark registry at Mumbai and vide Trade Mark No.668125 B dated 05-06-1995 duly issued by the trademark registry at Mumbai..

Thus the conclusion is that the domain name "**clariant,in**" is identical and confusingly similar to the trademark of complainant "**clariant**" and the complainant has established that he has right in the trademark.

-Ranjay K. Singh

B) Whether the respondent has no right or legitimate interest in the domain name got registered by him

It is pertinent to mention here that paragraph 4 (ii) of INDRP is to be read with paragraph no.7.

As already stated that paragraph 4 (ii) and 7 of INDRP are to be read together. Their combined effect is that, onus to prove the ingredients of these paras is prima facie on complainant. The onus is not very weak and prima facie, but it heavily shifts on respondent. Respondent can discharge the onus by direct cogent and positive evidence which are in his special knowledge and power. The complainant has made positive assertions that respondent has no legitimate right in domain name and the respondent has no trademark on the domain name. The complainant has made positive assertions regarding the fact that respondent has got registered the disputed domain name in the .IN Registry for which the respondent has no right or trademark. As such in above circumstance it is clear that the complainant has prima facie discharged the initial onus cast upon him by virtue of paragraph 4(ii) and 7 of INDRP.

The respondent on other hand has not come forward inspite of repeated notices to file any reply / counter or to provide any positive, cogent and specific evidence that it is known or recognized by domain name. The respondent has neither put forth and has nor provided such evidence.

Thus the conclusion is that respondent has no right or legitimate interest in the domain name.

Jayjay Kr Singh

Whether the respondent's domain name has been registered or is being used in bad faith

It is to be seen as to whether the domain name has been got registered in bad faith. The paragraph no.4 (iii) and 6 are relevant and as already stated, the onus is primarily upon complainant.

Keeping in view above facts and circumstances it is thus clear that the respondent has registered the disputed domain name and in spite of repeated notices, he has not come forward and has neither provided any substantial evidence in its support.

Thus the conclusion is that the respondent has got registered his domain name "**clariant.in**" in bad faith.

9. CONCLUSION:

The domain name of the respondent is identical and confusingly similar to trademark of complainant. The respondent also does not have right or legitimate interest in the domain name. He has got it registered in bad faith, as such he is not entitled to retain the domain name. The complainant is entitled to transfer of domain name "**clariant.in**" to him, as he has established his bonafide rights in trademark as per law discussed above. Hence I direct that the Domain name be transferred to the complainant by registry on payment of requisite fee to the registry.

No order as to costs.

Delhi

Date: 28-02-2007.

Sanjay K. Singh

(Sanjay Kumar Singh)

Arbitrator