

INDIA NON JUDICIAL

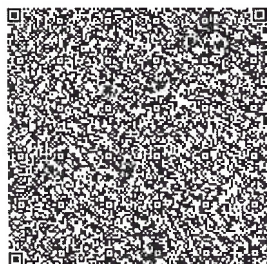
Government of National Capital Territory of Delhi



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e-Stamp

Certificate No. : IN-DL42020210769853P
Certificate Issued Date : 27-Jan-2017 11:44 AM
Account Reference : IMPACC (IV)/ dl921303/ DELHI/ DL-DLH
Unique Doc. Reference : SUBIN-DL92130384509145886395P
Purchased by : ASHOK KUMAR SINGH
Description of Document : Article 12 Award
Property Description : Not Applicable
Consideration Price (Rs.) : 0
(Zero)
First Party : ASHOK KUMAR SINGH
Second Party : Not Applicable
Stamp Duty Paid By : ASHOK KUMAR SINGH
Stamp Duty Amount(Rs.) : 100
(One Hundred only)



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BEFORE THE SOLE ARBITRATOR UNDER THE .IN DISPUTE RESOLUTION POLICY

IN THE MATTER OF:

Zippo Manufacturing Company Inc.,
33 Barbour Street, Bradford,
Pennsylvania 16701, U.S.A

...Complainant

Vs.

Zhaxia
Milwaukee, WI 53214, U.S.A
Email: ymgroup@msn.com

...Respondent

Statutory Alert:

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A. THE PARTIES

The Complainant in this administrative proceeding is Zippo Manufacturing Company, a company organized and existing under the laws of the state of Pennsylvania, USA, having its registered office at 33 Barbour Street, Bradford, Pennsylvania 16701, U.S.A.

The respondent in this proceeding is Zhaxia, Milwaukee, WI 53214, USA

THE DOMAIN NAME, REGISTRAR AND REGISTRANT

The disputed domain name is **www.zippo.co.in** and it is registered with Endurance Domains Technology Pvt. Ltd., Unit no. 501, 5th floor and unit no. 402, 4th floor, IT building, NESCO IT park, Nesco complex, western express highway, Goregaon (East), Mumbai, Maharashtra 400063, India.

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 **<www.zippo.co.in>**.

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

On 07.12.2016, NIXI sent the soft copy of the complaint along with the annexures to the respondent.

On 09.12.2016, I sent an email to the parties informing them about my appointment as an Arbitrator.

In the above mentioned email itself, the Tribunal directed NIXI to supply the copy of the complaint with annexures to the Respondent and to provide the tribunal with the details of service record.

In accordance with INDRP read with INDRP Rules of Procedure, notice of arbitration was sent to the Respondent on 09.12.2016 with the instructions to file his reply within 15 days from the receipt of the above stated email or the receipt of the copy of the Complaint, whichever is later.



On 12.12.2016, Counsels/Representative of the Complainant sent the soft copy of the Complaint and the annexures to the Tribunal.

On 15.12.2016, NIXI informed the tribunal that the consignment containing the complaint and the annexures has been delivered to the respondent on 14.12.2016.

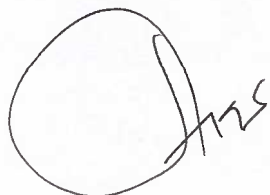
On 29.12.2016, The tribunal informed the parties that NIXI vide its email dated 15.12.2016 has confirmed that the courier containing the complaint and the annexures are duly served on the respondent. The tribunal granted last opportunity to the respondent to file its reply in 3 days after which the tribunal will proceed with the matter on the basis of the pleading and documents already on record. On 06.01.2017, the Complainant informed the Tribunal that they have received a letter from Marcus Hotels and Resorts on behalf of Pfister Hotel which has been mentioned as the registrant organization on the WHOIS details. As per the letter enclosed with the said email, according to Pfister Hotel, Zhaxia (the registrant of the domain name zipppo.co.in) has fraudulently associated their address with the said domain name.

The Respondent has failed to file his say/ reply to the Complaint of the Complainant. The Tribunal feels that enough opportunity has been given to the Respondent and genuine efforts have been made to make him a part of this proceeding. Since he has failed to join the proceedings, or to file any response, the present award is passed on the basis of the pleadings and the documents, placed on record by the complainant and .IN Registry.

On perusal of the entire pleadings and the documents placed on record, the Arbitrator's finding is as under:-

B. FACTUAL BACKGROUND:

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



C. COMPLAINANT:

The case of the Complainant is that:

1. The Complainant submits that it is a world leader in manufacture and trade of lighters under the invented and well-known trademark ZIPPO. The Complainant's world famous ZIPPO branded lighters are windproof and are sold with a lifetime guarantee. The Complainant also submits that the world famous lighters are of various types including, Metal Finish, Vintage Series, Zippo at Work Series etc. The Complainant submits that it uses a variety of high quality finishes and produce a wide range of licensed designs and high quality custom lighters using laser engraving, emblems and color imaging.
2. The Complainant submits that the history of ZIPPO Lighters dates back to 1932, when the Complainant's founder Mr. George G. Blaisdell came up with the idea of making a cigarette lighter that was easy to use and would look good. The Complainant also submits that Mr. Blaisdell secured the rights to an Austrian windproof lighter with a removable top and modified the design. The design, even retained today, has the lighter resting in a rectangular casing, split into two parts. Both, the shape of the lighter as well as the windscreen chimney are unique to the Complainant and have acquired a secondary meaning to denote the Complainant's cigarette lighters by virtue of long standing user.
3. The Complainant submits that ZIPPO lighters are sold in over 160 countries, strong sales in both the domestic market and emerging markets overseas, particularly China and India, contributed to record sales increases in numerous years.
4. The Complainant submits that, apart from the use of the ZIPPO trademark by the Complainant in relation to cigarette lighters, the Complainant has also extended use of the well-known trademark ZIPPO to various other products, including Desk Accessories,



Writing instruments, Travel accessories, outdoor products, Golf Accessories, Money Clips, key Holders, Tape Measures, Shoes, Belts and Suspenders, Work wear, lighter accessories, watches, men's and women's fragrance etc. The Complainant also submits that all these products are manufactured either by the Complainant or by its licensees situated in several countries of the world.

5. The Complainant submits that ZIPPO trademark was first used in the course of trade in 1933. The Complainant also submits that it has, in the past over 80 years, manufactured and sold over 400 million lighters under the trademark ZIPPO, across 120 countries. It further submits that it is one of the largest and the world's most popular manufacturers of cigarette lighter.
6. The Complainant submits that the word ZIPPO also forms part of the Complainant's trading style, enhancing the exclusive association of the ZIPPO trademark with the Complainant. It further submits that by virtue of such continuous and longstanding use of the ZIPPO trademark in connection with and relation to, inter alia, cigarette lighters, and owing to the continuous delivery of high quality products, the Complainant's ZIPPO trademark has acquired the status of a well-known trademark.
7. The Complainant submits that it is the exclusive and sole beneficial owner of the trade mark ZIPPO, which enjoys the status of a well-known and famous trade mark world over including India. The Complainant further submits that its trademark ZIPPO is well known to the Indian and global consumers due to the exposure of such consumers to advertisements of products under the trademark ZIPPO in various prominent magazines including in-flight magazines in domestic and international airlines operating in and from India.
8. The Complainant submits that it is also engaged in a co-branding campaign wherein Complainant's ZIPPO lighters are co-branded with other well-known trademarks including HARLEY DAVIDSON.



The Complainant submits that it also publishes the ZIPPO Lighter Collector's Guide, which is widely circulated and has numerous illustrations of the ZIPPO lighters and description of the series as well.

9. The Complainant submits that it has also invested huge sums of money and effort in relation to promotional activities and publicity concerning the sale of goods using the ZIPPO trademark. Such efforts have contributed in the exponential growth and reputation of Complainant's ZIPPO trademark.
10. The Complainant submits that the Complainant owns and maintains various websites, whose domain names have the word ZIPPO as a prominent part. These websites include www.zippo.com, 5zippo.com, zippo.gen.in, zippo.in, zippobags.in, zippoclothing.in, zippofashion.in, zippogear.in, zippoindia.com etc. The websites provide exhaustive information on the Complainant's business, divisions and product range under its trademark / trade name ZIPPO.
11. The Complainant submits that their trademark ZIPPO belongs to the category of well-known, well-reputed and famous trademarks. It is instantly identifiable and recognizable by both the members of trade and public as being exclusively associated with the goods and business of the Complainant. The Complainant further submits that the trademark and trade name ZIPPO acts as a source identifier inasmuch as it stands for the high standards and superior quality of goods manufactured by the Complainant and sold the world over.
12. The Complainant submits that the trademark ZIPPO has, as a cumulative result of its innate distinctiveness, wide-ranging products, extensive sales network, widespread promotion and publicity given thereto, acquired the status of a well-known trade mark, the reputation of which pervades to goods and services



beyond those actually manufactured and provided respectively by the Complainant.

13. The Complainant submits that as the owner of the said goodwill and reputation built up over a period of nine decades are entitled to the exclusive use and benefits from the trademark ZIPPO. It further submits that ZIPPO has been defined by the Oxford English Dictionary as *'the proprietary name of a make of cigarette letter'* thus identifying the brand with the complainant. It is also submitted that ZIPPO has found mention in 'World's Greatest Brands' published by Inter brand which lists the Complainant's brand as 78th in the world and 4th amongst 'Tobacco and Accessories' along with a profile of the Complainant's brand. It submits that the worldwide popularity of ZIPPO Lighters is evident from the fact that it has been regularly featured in over 1200 Hollywood movies.

D. RESPONDENT:

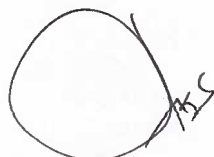
1. The respondent in this proceeding is Zhaxia, Milwaukee, WI 53214, USA
2. The respondent has failed to file his say/ reply to the Complaint of the Complainant within the stipulated time nor has he communicated anything on the complaint till the date of this award.

E. PARTIES CONTENTIONS:

1. Complainant

From the factual background given above, it is evident that in nutshell the contentions of the Complainant are as follows:

- a. The Respondent's domain name is identical and / or confusingly similar to the Complainant's Trade Mark(s).
- b. The Respondent has no rights or legitimate interest in respect of the domain name.



c. The Domain Name was registered and used in bad faith.

2. Respondent

The Respondent has failed to file any reply to the Complaint and thus has not rebutted the contentions made by the complainant.

F. 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"*.

A fair opportunity had been given to the Respondent to file the reply but no response has been received from him. Therefore, the Arbitration proceedings have been conducted on the basis of the records made available to the Arbitrator.

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."*

After examining the complaint and the documents placed on record by the complainant and INDRP Rules of Procedure and policy, the Arbitrator's finding on the contentions of the claimant is as follows:

(i) The Registrant's Domain Name is identical or confusingly similar to a trademark in which the Complaint has rights:

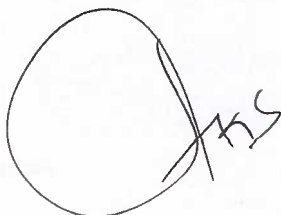
The complainant's submissions as per the complaint in this regard are:

1. That the disputed domain name www.zippo.co.in of the Respondent is identical to the Complainant's and well known trademark ZIPPO.



There is nothing in the Respondent's domain name to distinguish it from the Complainant's well-known trademark or its domain name. The Complainant has overwhelming common law as well as statutory rights in its trade mark ZIPPO. Therefore, the Complainant is the sole legitimate owner of the trade/service mark ZIPPO.

2. That due to the above mentioned factors, the trademark ZIPPO has acquired fame and is exclusively identified with the Complainant's goods. As a result of which, the use of the mark ZIPPO as a domain name by the Respondent would be understood with reference to the Complainant, thus perpetuating confusion among consumers who wish to access the Complainant's web page. The Complainant placed reliance on *Canon Kabushiki Kaisha v. Price-Less Inkjet Cartridge Company (WIPO Case No. D2000- 0878)* and on *Magnum Piering Inc. vs. The Mudjackers (WIPO case No. D2000-1525)* wherein it was held that when the dominant feature of an impugned domain name is the Complainant's trade mark and a generic term indicating goods or services offered by the Complainant has been added to it, the resultant domain name would still be deemed as identical or confusingly similar. This case is on an even higher footing as the Respondent has picked up the mark 'ZIPPO' of the Complainant without changing even a single letter. Reliance is also placed on *KFC Corporation v. Webmaster Casinos Ltd. (L-2/6/R4)* by the complainant wherein it was held that when a domain name wholly incorporates a complainant's registered mark, that is sufficient to establish identity or confusing similarity for purposes of the Policy.
3. The Complainant has spent substantial time, effort and money advertising and promoting the ZIPPO trademark throughout the world. As a result, the ZIPPO trade mark has become famous and well-known, and the goodwill and reputation has been recognized by Courts and Tribunals throughout the world.




Since the above submissions of the Complainant have not been rebutted by Respondent, as such they are deemed to be admitted by him. Even otherwise the above facts and annexures attached with the complaint establish that the domain name of the Respondent is similar and identical to the well-known trademark of the Complainant and as such this issue is decided in favour of the complainant.

(ii) The Registrant has no rights or legitimate interests in respect of the domain name:

The complainant's submissions as per the complaint in this regard are:

- a. Since the disputed domain name comprises the well-known and famous trademark ZIPPO, it is evident that the Respondent neither has any legitimate interest nor is using the same for any legitimate purpose.
- b. The website www.zippo.co.in registered by the Respondent is not an active website and in fact states at the top that "*The domain zippo.co.in may be for sale*", thus it becomes apparent that the sole purpose of registering the impugned domain name is for selling the domain name for the purpose of generating revenue and to misappropriate the reputation associated with the well-known trademark ZIPPO and to encash the goodwill attached to the Complainant's trademark and cause confusion in the mind of consumers with respect to the source of the products of the Complainant.
- c. The Respondent is not commonly known by the domain name and his use of the disputed domain name www.zippo.co.in for a commercial gain is not bona fide in nature. The Complainant places reliance on ***The Chip Merchant, Inc. v. Blue Star Electronics, d/b/a Memory World*** (WIPO Case No. D2000-0474), wherein it was held that the only reason for the use of specific domain names

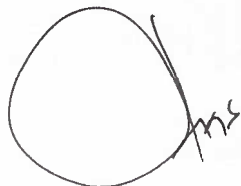


that are virtually identical to the Complainant's name, for a commercial website bearing its own name that bears no relation to the domain names, would be to divert online consumers seeking one of its successful competitors, thereby trading on its goodwill and reputation.

- d. The Respondent is not a licensee of the Complainant and neither has the Complainant granted any permission or consent to the Respondent to use the trademark ZIPPO in any manner or to incorporate the same in a domain name.
- e. The Respondent's use of the domain name has been for commercial gain.
- f. It is very clear from the conduct of the Respondent that he has been trying to reap unfair rewards by registering the domain name <www.zippo.co.in>. The Respondent has failed to demonstrate any bona fide use of the <www.zippo.co.in> domain name.

According to the paragraph 7 of the .INDRP, the following circumstances show Registrants rights or legitimate interest in the domain for the purpose of paragraph 4(ii)

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



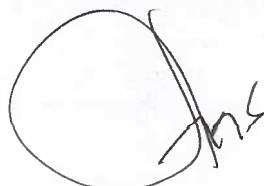
The Respondent has neither responded nor has put forth or provided any evidence to show that the circumstances as required under paragraph 7 of the INDRP exists in his favour. The Respondent is also not engaged in or demonstrably prepared to engage in offering any bonafide goods or services in the name of the disputed domain name. The Arbitrator thus, accepts the submissions made by the complainant.

Even otherwise also the above facts establish that the Respondent has no right or legitimate interest in the domain name < **zippo.co.in** > as the Respondent is not making a non-commercial or fair use of the domain name under INDRP paragraph 4(ii). Therefore this issue is also decided in favour of the complainant.

iii. The Respondent has registered and is using his domain name in bad faith:

The complainant in support of the above contention has stated as under in the complaint:

- a. The Complainant's mark ZIPPO is a well-known trademark, and the Respondent is presumed to have had knowledge of Complainant's mark at the time it registered the identical domain name. Thus, this is prima facie evidence of the Respondent's bad faith use and registration. Further, the fact that the website <www.zippo.co.in> registered by the Respondent is not an active website and in fact states at the top that "*The domain zippo.co.in may be for sale*", indicates towards the obvious malafide intention of the Respondent in registering the impugned domain name for selling the domain name for the purpose of generating revenue. Therefore, it is submitted that the domain name has only been registered in bad faith for monetary gains.
- b. That registration of a famous trademark without legitimate commercial interests in the same is prima facie evidence that the Respondent was well aware of the reputation and goodwill attached



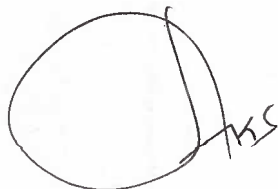
to the Complainant's trademark. The Complainant also submits that the proposition that the registration of a domain name incorporating a well-known trademark of the Complainant is bound to be in bad faith has been upheld by numerous UDRP decisions. Some notable cases which have upheld this proposition are **Marie Claire Album v. Marie-Claire Apparel Inc**, WIPO Case No. D2003-0767, **VeuveClicquotPonsardin, MaisonFondee en 1772 v. Herreveld**, WIPO Case No. D2000-0776, **Adidas-Salomon AG v. Domain Locations**, WIPO Case No. D2003-0489 wherein it has been held that registration of a well-known trademark of which the Respondent must reasonably have been aware is in itself sufficient to amount to bad faith. Therefore, it is submitted that the domain name has only been registered in bad faith for monetary gains.

- c. That the Respondent has been a habitual infringer and has got various other domain names registered in its name like www.colgate.in, www.exide.in and www.praxair.in which are not active websites like the impugned website www.zippo.co.in.
- d. That the bad faith of the Respondent becomes clear from the fact that earlier also a domain name complaint was made against it by Nike Inc. and Nike Innovative C.V. for maliciously registering the domain name www.nike.co.in comprising the registered and well-known trademark NIKE. The Complainants' prayer was thus allowed vide Arbitration award dated July 12th, 2016, wherein the impugned domain name www.nike.co.in was transferred to the Complainants.
- e. That there is likelihood that a potential visitor to the Respondent's webpage will be induced to believe that the Complainant has licensed their trademark ZIPPO to the Respondent or has authorized the Respondent to register the disputed domain name, creating initial interest confusion in the mind of the consumer. The Complainant places reliance on *Volvo Trademark Holding AB vs. Riguo Ding (INDRP 225)*, wherein it was held that "registration of a



domain name that is confusingly similar or identical to a famous trademark by any entity, which has no relationship to that mark, is itself sufficient evidence of bad faith registration and use...there was no real purpose for registering the disputed domain name other than for commercial gains, and that the intention of the Respondent was simply to reap unfair rewards through the sale of the disputed domain name...".

- f. That there is a further possibility that the potential visitor to the Respondent's website will be duped into believing that the Respondent has some connection with the Complainant in terms of a direct nexus or affiliation with the Complainant or has been authorized by the Complainant and has been registered merely to prevent the legitimate owner of the trademark i.e. the Complainant from reflecting the trademark ZIPPO in the domain name.
- g. That the Complainant's mark was already registered and recognized as a well-known trade mark at the time the disputed domain name was registered by the Respondent in March 2012. Therefore, the Respondent is deemed to have had knowledge of the Complainant's statutory and common law rights at the time that the impugned domain name was registered. Despite this, the Respondent proceeded to get an identical or confusingly similar domain name registered, an act which clearly depicts bad faith and crass opportunism.
- h. That alongwith the email dated 06.01.2017 the Complainant has attached the letter of Marcus Hotels and Resorts on behalf of Pfister Hotel, which has been mentioned as the registrant organization on the WHOIS details wherein according to Pfister Hotel, Zhaxia (the registrant of the domain name zippo.co.in), their address has been fraudulently associated with the said domain name and that the Pfister Hotel in no way uses the ZIPPO mark in India, nor anywhere else in the world.



All above submissions made by the Complainant have not been rebutted by Respondent, as such they are deemed to be admitted by him. The unrebutted facts and annexures give no reason to doubt that the respondent has registered and used the domain name <**zippo.co.in**> in bad faith. This issue is decided accordingly.

G. DECISION:

In view of the above facts and circumstances and finding of the Arbitrator, the Complainant has succeeded in his complaint. .IN Registry of the NIXI is hereby directed to transfer the domain name of the Respondent i.e. <**zippo.co.in**> to the Complainant. The parties are left to bear their own cost. The Award is accordingly passed on this day of 27th January, 2017.

A handwritten signature in black ink, appearing to read 'Ashok Kumar Singh', is written over a circular stamp. The signature is fluid and cursive.

Ashok Kumar Singh

Sole Arbitrator

Date: 27th January, 2017