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NATIONAL INTERNET EXCHANGE OF INDIA
Incube Business Centre, 5th Floor,
10, Nehru Place,
NEW DELHI -110 019

Advance Magazine Publishers, Inc., ILS.A. v. JF Limited, England

AWARD

1. The Parties

The Complainant is Advance Magazine Publishers, inc., Four Times Square, New York, New York - 10036, U.S.A.

The Respondent/Registrant is JF Limited, 204, Woodwich Road, Concept Office, LONDON SE7 QY England

2. The Domain Name and Registrar

The disputed domain name www.vogue.co.in is registered with Directi Internet Solutions Pvt. Ltd., dba PublkiDomainRegistry.com.

3. Procedural History

- (a) The undated Complaint has been filed by the Complainant with the National Internet Exchange of India along with the Registrar verification. The print out of the said Registrar verification (WHOIS Report) is attached with the Complaint as Annexure K (pages 854 - 855). It is confirmed by the said WHOIS Report that the Respondent is listed as the registrant of the disputed domain name and the contact details for the administrative, billing and technical contact for the disputed domain name are that of the Respondent. At the time of registering the domain name, the Respondent has signed an agreement with the Registrar containing an arbitration clause for the resolution of domain name dispute through arbitration. The Exchange verified that the Complaint satisfied the formal requirements of the .IN Domain Name Dispute Resolution Policy (INDRP) (the "Policy") and the Rules framed thereunder.
- (b) In accordance with the Rules, on 27th December 2010 the Sole Arbitrator formally notified the Respondent of the Complaint. The Respondent was required to submit his defence within 15 days from the date of receipt of the letter, that is, by 23rd January 2011 (taking 6 days in the transit of the communication each side). The Respondent was informed that if his response was not received by that date, he would be considered in default and the matter will proceed ex-parte.
- (c) The National Internet Exchange of India appointed Dr. Vinod K. Agarwal, Advocate and Solicitor, former Law Secretary to the Government of India, as the Sole Arbitrator to decide the domain name dispute. The Arbitrator finds that he was properly appointed. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence as required by the Exchange.

4. Factual Background

From the complaint and the various annexure to it, the Arbitrator has found the following facts;

Complainant's activities

The Complainant is an organization existing under the laws of the State of New York, United States of America. The Complainant



carries on business of publication and distribution of magazines and journals in various names, such as, Vogue, The New Yorker, Vanity Fair and Glamour, etc. According to the Complaint, the trademark "VOGUE" was first adopted as a name of a magazine in the year 1892. The magazine VOGUE became international in 1910. In the year 1973 it became a monthly publication. Presently, the magazine VOGUE is circulated/sold in more than 145 countries in the world including India.

The Complainant has wholly owned subsidiaries in various countries, such as, China, France, Germany, Italy, Japan, Russia, Spain, United Kingdom, etc., which carry out the function of publication and distribution of the magazine VOGUE. The names of these magazines are also country based, as VOGUE CHINA, VOGUE INDIA, VOGUE RUSSIA, VOGUE UK, etc. The magazine VOGUE has many versions, such as, TEEN VOGUE, VOGUE LIVING, VOGUE HOMMES INTERNATIONAL, L'UOMO VOGUE, etc.

In India, the Complainant incorporated a wholly owned subsidiary with the name Conde Nast (India) Private Limited in the year 2005. The said subsidiary has been using the trademark VOGUE.

Respondent's activities

The Respondent did not file any reply to the Complaint. Hence, the Respondent's activities are not known.

5. Parties Contentions

A. Complainant

The Complainant contends that each of the elements specified in Article 4 of the Policy are applicable to this dispute.

In relation to element (i) that is, the Respondent's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights, the Complainant contends that it is known amongst its customers worldwide as VOGUE. The word "VAGUE" along with its variants is a registered trademark of the Complainant in many countries. Further that, the Respondent's intention is to take advantage of the goodwill and reputation enjoyed by the Complainant's trademark/domain name VOGUE.



In relation to element (ii) that is, the Respondent has no rights and legitimate interests in respect of the domain name, the Complainant contends that the Respondent (as an individual, business or other organization) has not been commonly known by the name or mark VOGUE. Further that, the Respondent is not making a legitimate or fair use of the said domain name for obtaining goods or services. The Respondent registered the said domain name for the sole purpose of creating confusion and misleading the general public and the customers/users of the Complainant's domain name.

Regarding the element at (iii), that is, the Respondent's domain name has been registered or is being used in bad faith, the Complainant contends that the main object of registering the domain name <www.vogue.co.in> by the Respondent is to earn profit and to mislead the general public and the customers/users of the Complainant's domain name. The Complainant has stated that the use of the domain name that appropriates the well known name or mark to promote competing or infringing products cannot be considered a "bona fide offering of goods and services". A visit to the site also indicates that it is available for sale.

In support of its contentions, the Complainant has also relied on a number of decisions (about 15) of various courts and quasi-judicial bodies (including of World Intellectual Property Organization, Arbitration and Mediation Center). For deciding this case, it is not necessary to refer them.

B. Respondent

The Respondent did not file any reply to the Complainant. Hence, the Respondent's contentions are not known.

6. Discussion and Findings

The Rules instructs this Arbitrator as to the principles to be used in rendering its decision. It says that, "an arbitrator shall decide a complaint on the basis of the statements and documents submitted to it and in accordance with the provisions of 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."

According to the .In Domain Name Dispute Resolution Policy, the Complainant must prove that:

- (i) The Respondent's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;
- (ii) The Respondent has no right or legitimate interests in respect of the domain name; and
- (iii) The Respondent's domain name has been registered or is being used in bad faith.

(i) Identical or confusingly similar

The Complainant has obtained trademark registration for its mark "VOGUE" (along with addition of some words to it in few cases) in many countries of the world, such as, Albania, Argentina, Austria, Australia, Bulgaria, Bolivia, Brazil, Canada, China, Czech Republic, Denmark, German, Egypt, France, Greece, Hungary, Ireland, Israel, Italy, Japan, Malaysia, Mexico, Morocco, New Zealand, Norway, Poland, Portugal, Romania, Singapore, South Korea, Spain, Sudan, Switzerland, Taiwan, United Kingdom, United States of America, etc. A detailed list of such countries is given in Annexure B (Pages 5 to 69) to the Complaint.

In the Complaint it is stated that in India, the Complainant's mark "VOGUE" and with the addition of some words, was registered on various dated in different classes including the earliest being dated June 11, 1976 under No. 315672B in respect of class 16 items, i.e., for magazines, books and printed material (publications). These registration certificates are available as Annexure F (pages 794 to 805) of the Complaint. It appears that the first issue of the magazine "VOGUE INDIA" was brought out in India in October 2007 by a wholly owned subsidiary of the Complainant. It is further stated that about 9 more applications for the registration of the trademark VOGUE (with addition of various words in some cases) are also pending consideration and registration for different classes of items with the trademark authorities in India.



The present dispute pertains to the domain name <www.vogue.co.in>. The Complainant has business interests in many countries and it uses the trade name and trademark VOGUE (along with addition of some words in some cases) in these countries. The Complainant's mark and domain name VOGUE is a coined word and highly distinctive in nature. The trademark "VOGUE" and its variants have become well known in relation to the magazine and other publications. As such, consumers looking for VOGUE may instead reach the Registrant's website. Therefore, I hold that the domain name <www.vogue.co.in> is confusingly similar to the Complainant's trademark.

B. Rights or Legitimate Interests

According to the Policy, the Registrant may demonstrate its rights to or legitimate interest in the domain name by proving any of the following circumstances:

- (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 registered the disputed domain on February 16, 2005. Since then the website has not been constructed. The Respondent has not filed any response in this case. There is no evidence to suggest that the Respondent has become known by the disputed name 'vogue' anywhere in the world. VOGUE is the name and mark of the Complainant. It is evident that the Respondent can



have no legitimate interest in the domain name. Further, the Complainant has not licensed or otherwise permitted the Respondent to use its name or trademark or to apply for or use the domain name incorporating said name. Based on the default and the evidence adduced by the Complainant, it is concluded that the above circumstances do not exist in this case and that the Respondent has no rights or legitimate interests in the disputed domain name. I, therefore, find that the Respondent has no rights or legitimate interests in the domain names.

C. Registered and Used in Bad Faith

Any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration or use of the 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 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
- (iv) 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 its website or location.

The contention of the Complainant is that the present case is covered by the above circumstances. There are circumstances indicating that the Respondent has intentionally attempted to attract, internet users to its web sites, by creating a likelihood of confusion



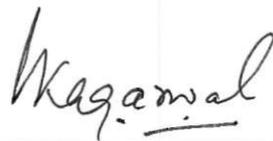
with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of its web sites. Further, the Complainant has submitted that the registration of the domain name <www.vogue.co.in> cannot be incidental. The intention of the Respondent is primarily to register the domain name so as to offer it to a third party for sale. Therefore, the registration of the disputed domain name is in bad faith.

The Complainant has also sent a Cease and Desist notice to the Respondent on the contact details provided in the WHOIS records. However, the same was not delivered by the postal authorities. It indicates that the Respondent has given incorrect address at the time of registration of the said website, thus violating the Terms and Conditions of Registration.

The foregoing circumstances lead to the presumption that the domain name in dispute was registered and used by the Respondent in bad faith. As the Respondent has failed to rebut this presumption, I conclude that the domain name was registered and used in bad faith.

7. Decision

In the light of the foregoing findings, namely, that the disputed domain name is confusingly similar to the domain name of the Complainant in which the Complainant has rights, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered in bad faith, in accordance with the Policy and the Rules, the Arbitrator orders that the domain name <www.vogue.co.in> be transferred to the Complainant.



Vinod K. Agarwal

January 27, 2011