

தமிழ்நாடு தமில்நாடு TAMILNADU D. SARAVANAN

Advocate & Arbitrator

Orient Chambers", 4th & 5th Floor  
No 90/73, Armenian Street,  
Chennai 600 001.

BH 409058

P.S. SHANMUGA SUNDARAM  
STAMP VENDOR  
L.No. B4 / 109 / 88  
HIGH COURT CAMPUS  
CHENNAI - 600 104. (TAMIL NADU)

49858  
28 SEP 2018

**BEFORE THE SOLE ARBITRATOR MR.D.SARAVANAN  
.IN REGISTRY  
(C/o. NATIONAL INTERNET EXCHANGE OF INDIA)**

Disputed Domain Name: [www.deloitte.in](http://www.deloitte.in)

Deloitte Touche Tohmatsu  
Schützengasse 1  
8001 Zurich, Switzerland

**..Complainant**

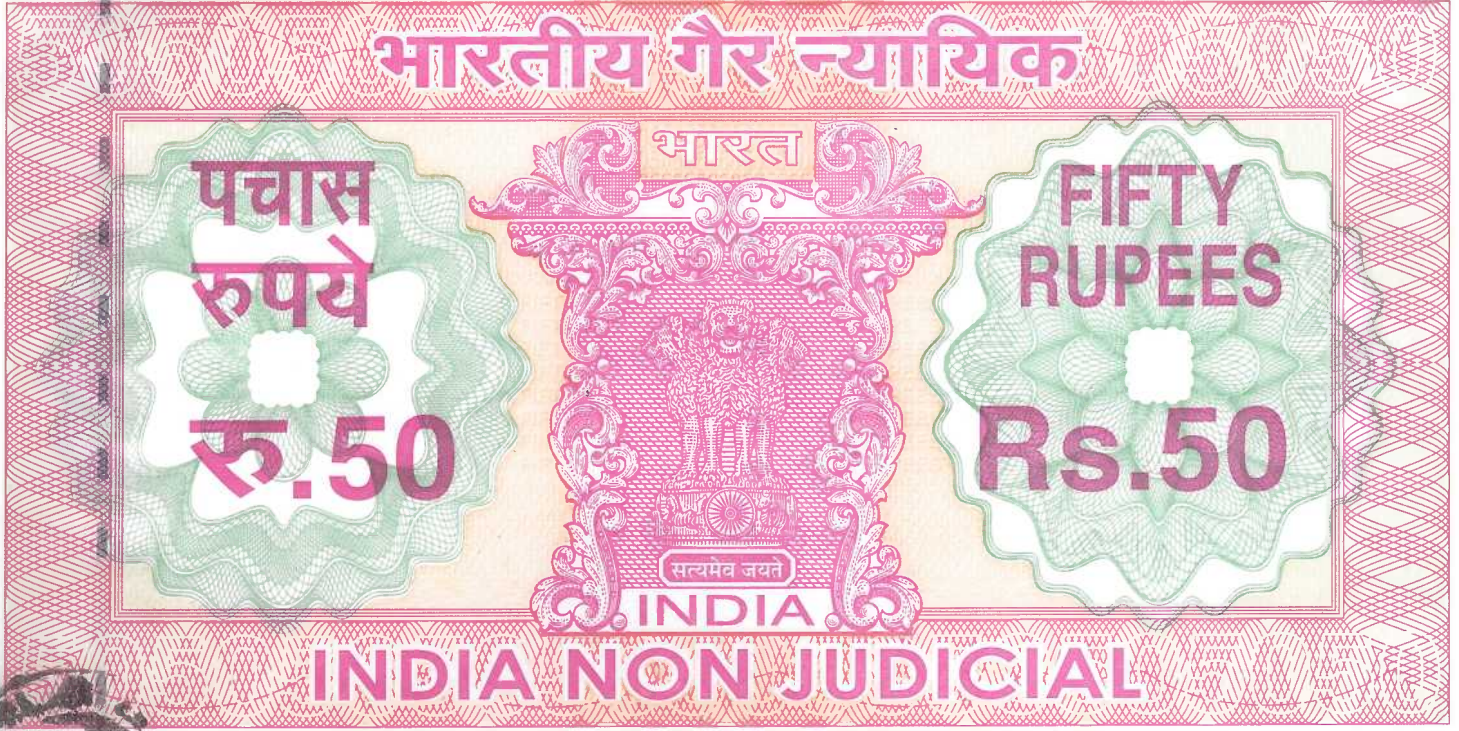
**Vs.**

Lina  
Doublefist Limited  
4-501, Tao Li Hua Yuan  
Huaiyin District, Huai'an  
Jiangsu, China  
Phone 17130529989, Zip Code 223300, Huaian  
Wisconsin-53202  
USA  
Phone: +222.2710700  
Email: [ymgroup@msn.com](mailto:ymgroup@msn.com)

**..Respondent**

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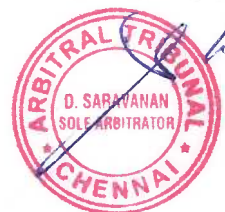
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**1. The Parties:**

The Complainant is Deloitte Touche Tohmatsu, having address at Schützengasse. The Complainant is represented through its Attorneys, M/s. Remfry & Sagar, having office at Remfry House at the Millenium Plaza, Sector-27, Gurgaon-122009.

The Respondent is the current Registrant of the disputed domain name <deloitte.in>. All the information known and available to the Complainant regarding the Respondent is as follows: Lina, Doublefist Limited, 4-501, Tao Li Hua Yuan, Huaiyin District, Huai'an, Jiangsu, China, Phone: +17130529989, Zip Code 223300, Huaian Wisconsin- 53202 Email: [ymgroup@msn.com](mailto:ymgroup@msn.com). Neither the Respondent represented himself nor represented by any one.

..3.



**2. The Domain Name and Registrar:**

The disputed domain name is www.deloitte.in. The domain name has been registered with .IN REGISTRY through its Registrar Netlynx Technologies Pvt. Ltd.

**3. Procedural History:**

12 <sup>th</sup> September, 2018	:	The .IN REGISTRY appointed D.SARAVANAN as Sole Arbitrator from its panel as per paragraph 5(b) of INDRP Rules of Procedure.
19 <sup>th</sup> September, 2018	:	Consent of the Arbitrator along with declaration was given to the .IN REGISTRY according to the INDRP Rules of Procedure.
24 <sup>th</sup> September, 2018	:	.IN REGISTRY sent an email to all the concerned intimating the appointment of arbitrator. On the same day, the complete set of the soft copy of the Complaint with Annexure was sent to the Respondent by email while sending the hard copy of the same to the address of the Respondent by NIXI through post which was returned with endorsement as "double address".
27 <sup>th</sup> September, 2018	:	Notice was sent to the Respondent by e-mail directing him to file his response within 10 days, marking a copy of the same to the Complainant's representative and .IN Registry.
7 <sup>th</sup> October, 2018	:	Due date for filing response.
9 <sup>th</sup> October, 2018	:	Notice of default was sent to the Respondent notifying his failure in filing the response, a copy of which was marked to the Complainant's representative and .IN Registry.



#### **4. Factual Background:**

##### **4.1 The Complainant:**

The Complainant is Deloitte Touche Tohmatsu, having address at Schützengasse. The Complainant is represented through its Attorneys, M/s. Remfry & Sagar, having office at Remfry House at the Millenium Plaza, Sector-27, Gurgaon-122009. The stamped copy of the Authorization is provided in **Annexure-L** marked by the Complainant.

##### **4.2 Complainant's Activities:**

- (i)** The Complainant submits that it is a Swiss Verein with a place of business at Schützengasse 1, 8001 Zurich, Switzerland. The Complainant has licensed the DELOITTE Marks to its network of independent member firms ("Deloitte Member Firms") that provides services to clients around the world (including both public and private entities) such as accounting, auditing, consulting, financial advisory, risk management and tax services (either directly or through their affiliated entities). All goodwill developed from the use of the DELOITTE marks (and domain names incorporating the DELOITTE Marks) by Deloitte Member Firms inures to the benefit of Complainant.
- (ii)** The Complainant states that the Complainant and the Deloitte member Firms collectively comprise one of the world's largest multinational professional services organizations. The Company now known as Deloitte was first established in the year 1845 and is one of the four largest professional services networks in the world, offering audit, assurance, tax, consulting, advisory, actuarial, corporate finance and legal services. DELOITTE is the



brand of the Complainant under which tens of thousands of dedicated professionals in independent firms throughout the world collaborate to provide audit, consulting, financial advisory, risk advisory, tax and related services to select clients.

- (iii)** Each Deloitte Member Firm provides services in a particular geographic area and is subject to the laws and professional regulations of the particular country or countries in which it operates. Complainant itself does not provide services to clients. Complainant and the Deloitte Member Firms around the world are each separate and distinct legal entities, which cannot obligate the other entities, and which are each only liable for their own acts or omissions and not those of one another.
- (iv)** Deloitte serves approximately four out of every five Fortune Global 500 companies through a globally connected network of member firms in more than 150 countries. Together, this network brings world-class capabilities, insights and high quality service to address the needs of Complainant's clients that often involve the world's most complex business challenges.
- (v)** In India, Deloitte Touche Tohmatsu India LLP, a member firm, has been present for more than 20 years through its various successors and subsidiaries such as Deloitte Consulting India Private Limited (incorporated on March 15, 2003), Deloitte & Touche consulting India Private Limited (incorporated on April 2, 2007), Deloitte Tax Services India Private Limited (incorporated on June 9, 2004), Deloitte Support Services India Private Limited (incorporated on June 7, 2004), Deloitte Touche Tohmatsu India LLP (incorporated on January 10, 2015), Deloitte Financial Advisory Services India Private Limited (incorporated on June 7, 2004), Deloitte & Touche Assurance



& Enterprise Risk Services India Private Limited (incorporated on June 14, 2004), and Deloitte Special Projects India Private Limited (incorporated on May 27, 2014) etc. In the year 1995, Deloitte Touche Tohmatsu India LLP (previously known as Deloitte Touche Tohmatsu India Private Limited) opened at the address-12, Dr. Annie Besant Road, Opp. Shivsagar Estate, Worli, Mumbai-400018, Maharashtra, India, and since has expanded its offices to various locations in India. As of now, Deloitte Touche Tohmatsu India LLP has offices across various locations including Ahmedabad, Bangalore, Chennai, Gurgaon, Hyderabad, Kolkata, Mumbai and Pune.

#### 4.3 Complainant's Trading Name:

- (i) As is evident from the Complainant's activities, the Complainant and the Deloitte Member Firms use the well-known trade/service marks/names 'DELOITTE', 'DELOITTE & TOUCHE' and other DELOITTE formative marks upon and in relation to its business, which is its extremely valued intellectual property. The trade/service mark/name DELOITTE also forms integral part of the corporate name of the Complainant and serves as its principal trade/service mark and domain name. The trade/service mark/name DELOITTE/DELOITTE formative marks being the most valued Intellectual property, the Complainant has taken utmost care to secure statutory rights therein through trade/service mark registrations in numerous jurisdictions of the world including in India. The Complainant's trade/service mark/name DELOITTE is subject of around more than 500 trade/service mark registrations/applications in about 150 jurisdictions around the world. A list showing a sampling of the Complainant's worldwide registrations for the trade/service mark DELOITTE is annexed herewith and marked by the Complainant as **Annexure-A** and also annexed collectively and marked as



**Annexure-B (Colly)** are copies of Registration certificates in respect of the Complainant's trade/service mark DELOITTE from the United States of America, Canada and various other jurisdictions including international marks registered under the World Intellectual Property Organization's Madrid system.

(ii) In India, the Complainant's earliest registration for a DELOITTE formative mark was first filed in 1996. Details on each of the Complainant's Indian trade/service mark registrations for the DELOITTE mark follow below:

- Trade mark: **DELOITTE** – Registration No.1261053 dated January 14, 2004 in Classes 9, 35, 36 and 42. The said mark was advertised in Trade Marks Journal No. 1328 dated February 14, 2005 and is valid and subsisting on the Register.
- Trade mark: **DELOITTE & TOUCHE** - Registration No. 731601 dated September 4, 1996 in Class 9. The said mark was advertised in Trade Marks Journal No. MEGA 1 Vol. D dated August 23, 2003 and is valid and subsisting on the Register.
- Trade mark: **DELOITTE & TOUCHE** - Registration No. 733866 dated September 13, 1996 in Class 16. The said mark was advertised in Trade Marks Journal No. 1340 dated March 15, 2006 and is valid and subsisting on the Register.
- Trade mark: **DELOITTE GREENHOUSE** - Registration No. 2610037 dated October 9, 2013 in Classes 35, 36 and 42. The said mark was advertised in Trade Marks Journal No. 1707 dated August 24, 2015 and is valid and subsisting on the Register.



The aforesaid are valid and subsisting on the register of trademarks and the copies of the certificates of registration issued by the Indian Trademark registry in respect of the aforesaid registrations are annexed herewith and marked by the Complainant as **Annexure C**.

- (i) The Complainant and the Deloitte Member firms have invested time, capital, efforts and resources in advertising and promoting its products under the trade/service mark/name DELOITTE across the globe through all forms of media in various countries of the world. The Complainant and the Deloitte Member Firms have also been featured in a wide variety of press releases and coverage by the press. The aforesaid press releases and coverage have left an indelible impression in the minds of the public so much so that the trade/service mark/name DELOITTE is exclusively associated with the Complainant and the Deloitte Member Firms and none other. Copies of press releases and other media coverage featuring the Complainant's trade/service mark/ name DELOITTE in various jurisdictions of the world including India are annexed and marked by the Complainant as **Annexure-D**. The Complainant operates a comprehensive website at [www.deloitte.com](http://www.deloitte.com) which provides a detailed overview of the professional services offered by the Complainant and the Deloitte Member Firms under the trade/service mark/name DELOITTE, as well as a wealth of information for consumers, business and investors, including market reports, newsletters, research and other commentary and publications. Complainant has a dedicated site for its member firm in India at [http://www2.deloitte.com/in/en.html?cid=site\\_selector](http://www2.deloitte.com/in/en.html?cid=site_selector) in. The mark/name DELOITTE is prominently displayed on all the pages of the website, on all publications, and on all related online social media accounts and pages, including those at Facebook, LinkedIn, You Tube, Twitter, Instagram and





Google+. The [www.deloitte.com](http://www.deloitte.com) website and the pages dedicated to the Indian member firm are extremely popular and provide a valuable source of information and knowledge with respect to the Complainant, its Indian member firm, and the products and services offered by the Complainant under the trade/service mark/name DELOITTE. Complainant's [www.deloitte.com](http://www.deloitte.com) website is visited by a significant and noteworthy number of unique visitors every month. To elaborate, for the period of January 1, 2015 to October 27, 2015, there was more than 34.2 million hits on the said website. Therefore, it is apparent that the goodwill and reputation of the Complainant as regards the trade/service mark/name DELOITTE pervades both the real and online worlds. Relevant extracts from the Complainant's [www.deloitte.com](http://www.deloitte.com) website and the pages dedicated to its member firm in India reflecting extensive, exhaustive and substantial use of the mark/name DELOITTE are annexed and marked herewith by the Complainant as **Annexure-E**.

- (ii) The Complainant has registered numerous domain names that incorporate the trade/service mark/name DELOITTE at several generic top level domain names (gTLDs) such as 'deloitte.com', 'deloitte.net', 'deloitte.org', 'deloitte.biz', etc. Complainant has also registered "DELOITTE" domain names at a number of country code top level domain names (ccTLDs) such as 'deloitte.hk', 'deloitte.au', etc. In addition to the aforesaid, Complainant also has 'deloitte', as gTLD for instance: 'nic.deloitte'. Further to safeguard Complainant's rights over the mark/name DELOITTE, and to prevent misusers from exploiting the goodwill/reputation vested in the mark DELOITTE, the Complainant has registered domains for variants and common misspellings of the mark/name DELOITTE such as 'deloitte.biz', 'deloitte.org', 'deloiite.com',



'deloitte.biz', 'deloitte.net', 'deloitte.org', 'deloittee.com' etc. A list of over 600 domain names registered in favour of the Complainant along with the WHOIS details in favour of the Complainant along with the WHOIS details in respect of a few domains are annexed collectively herewith and marked by the Complainant as **Annexure-F (colly)**.

- (iii) Owing to the excellent quality of the services provided by Complainant and the Deloitte Member Firm under the trade/service mark/name DELOITTE, the same commands tremendous popularity and has been used extensively the world over. As mentioned above, the Complainant's network's aggregate revenues exceeded \$36.8 billion in 2016 and \$38.8 billion in the year 2017, clearly establishing the reputation and goodwill of its trade/service mark/name DELOITTE. The DELOITTE brand of the Complainant has achieved substantial commercial success and accomplishment worldwide and products/services under the mark/name DELOITTE are consistently ranked among the world's best in the fields of accounting, auditing, management consulting and tax advisory. Further, the Complainant's and its member firms' businesses under the trade mark/ name DELOITTE is continually advertised and reviewed in major newspapers, magazines and internet publications and international distribution. The Complainant also promotes activities, achievements and sponsorship under the mark/name DELOITTE via the website [www.deloitte.com](http://www.deloitte.com) and by distributing global press releases available internationally including India. Complainant has successfully enforced its rights in the mark/name DELOITTE and the said mark has been held to be internationally well-known by different Tribunals: *Deloitte Touche Tohmatsu v. Deloitte Daniel Consulting/ Whois Privacy (enumDNS dba)*, WIPO Case No. D2015-1901, at §6.B; *Deloitte Touche Tohmatsu v. Richard Yaming, Trademark Worx, LLC*, WIPO Case No.D2014-1360, at §6.A; *Deloitte Touche*



*Tohmatsu v. Supervision Audio Video Inc., Search- Universal.com*, WIPO Case No.D2011-0187, at §6.B; *Deloitte Touche Tohmatsu v. H3B*, WIPO Case No. D2011-0181, at §6.B; *Deloitte Touche Tohmatsu v. Open Water Enterprises Limited Louise S.*, WIPO Case No.D2008-1632 at §6.C; *Deloitte Touche Tohmatsu v. Pluto Domain Services Private Limited/Private Whois for dpelprip 1703*, WIPO Case No.D2008-1617, at §6.C; *Deloitte Touche Tohmatsu v. CostNet aka Domain Manager*, WIPO Case No.D2003-0619, at §6.A.

#### 4.4 Respondent's Identity and activities:

- (i) The Respondent is the current Registrant of the disputed domain name <deloitte.in>. The Complainant has become aware of a domain name deloitte.in registered in the name of 'Lina of Doublefist Limited' (hereinafter referred to as the "Registrant"). It is pertinent to mention that the domain, created on February 12, 2013 was previously owned by GaoGou of Yerect in Toronto, Canada until around July, 2016 whereafter around January, 2017, Zhaxia changed the Registrant Organization from Pfister Hotel and thereafter to Doublefist Limited around March, 2017. To substantiate the same, the Complainant herewith annexed and marked **Annexure-G**, the history of the domain 'deloitte.in'. The domain was and is being used in connection with a parked website at which the domain name is offered for sale by the Registrant without using or making any bona fide use of the same. It is pertinent to mention here that the Registrant of the domain name deloitte.in has no affiliation with the Complainant. Interestingly, the domain name was earlier registered in the name of 'Zhaxia' against which this Tribunal had passed an award for registering the domain name in bad faith. The address



of 'Zhaxia' and the present Registrant is identical thereby proving a connection between them. The present WHOIS records in respect of the domain name in question along with the copy of the award passed against 'Zhaxia' are annexed herewith and marked by the Complainant as **Annexure-H.**

(ii) The only website associated with the domain name in question is a parked website which requests viewers to fill up certain details including the price (in USD) for which they may be willing to purchase the disputed domain name. In addition, on the impugned website, an advertisement for sale of the said domain with the caption '*the domain deloitte.in may be for sale. Click here to inquire about this domain*' is reflected. Copy of the webpage of the website pertaining to the domain deloitte.in is annexed herewith and marked as **Annexure-I.**

(iii) Further a search of all WHOIS for other domains also registered by the Registrant identified 444 additional domain names on which the Registrant is the listed owner. Details of the reverse WHOIS records are attached herewith and marked as **Annexure-J** by the Complainant. The Complainant states that the perusal of **Annexure J** clearly indicates that the Registrant has not only registered over 400 domain names but nearly all the domain names owned by the Registrant are at the .IN ccTLD, further the domain names incorporate well-known trademarks. Examples of the Registrant's other domain names that incorporate globally well-known trade/service names/marks include aeropostale.in, apollotyres.in, appletv.in, armanijean.in and colgate.in, to name just a few.



- (iv) Under paragraph 6(ii) of the policy, the Registrant's pattern of extensive domain registrations and cybersquatting to prevent trade/service mark owners from reflecting their marks in corresponding domain names further demonstrates the Registrant's bad faith registration of the domain in question. The exorbitant number of domain names that the Registrant has engaged in a clear pattern of registering domain names in bad faith to block the legitimate and superior rights of trademark owners in those domain names only to later ransom the domain names to the trademark owner. See *Reebok International Limited v. C J Reebok*, INDRP Case No.618 (Oct, 10, 2014).
- (v) Further, on November 3, 2016, the Complainant received an unsolicited email from "name So" using the email address 'sonamesint@gmail.com' (an email address not referenced in the Whois records for the domain name) asking the Complainant to contact [ymgroup@msn.com](mailto:ymgroup@msn.com) (the email address of the Registrant as was previously mentioned on the WHOIS records of the domain deloitte.in) in the event the Complainant was interested in purchasing the domain name 'deloitte.in'. A copy of the email forwarded to the Complainant in this regards is attached herewith and marked by the Complainant as **Annexure-K**.
- (vi) The Complainant further states that it is writ large from the above that the Registrant is a habitual cyber squatter who is set out at making illicit gains by registering domain names identical to well-known trade/service marks, corporate names/trading styles, domain names, etc.



- (vii) The Complainant further states that it is evident that the Registrant is using the objectionable domain name illegally and dishonestly to derive unjust pecuniary gains.
- (viii) There is no iota of doubt that the impugned domain name is identical to the Complainant's trade/service mark/name/domain name DELOITTE. In these circumstances, the Complainant submits that the Registrant's impugned domain name 'deloitte.in' maybe transferred to the Complainant or the same may be cancelled forthwith on the following, amongst other grounds, which are exclusive and without prejudice to each other.

## 5. Dispute

The dispute arose when the Complainant came to know about the disputed domain name in the name of the Respondent. The Complainant had also never authorized the Respondent to use the disputed domain name. The Respondent is also not affiliated with the Complainant. In these circumstances, the Complainant requested this Tribunal to transfer the disputed domain name in favour of the Complainant.

## 6. Parties contentions:

### A. Complainant:

- (i) The domain name www.deloitte.in is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights [Para 3(b)(vi)(1) INDRP Rules of Procedure to be read with para 3 of INDRP] :



- (ii) The Complainant submits that Paragraph 3(b) of the INDRP enjoins the Registrant to ensure that *'to the Registrant's knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party'*. The Complainant submits the following in support of paragraph 4(i) of the INDRP and paragraph 3(b) (vi)(1) of the INDRP Rules of Procedure, that the registrant's domain name is identical to the trademark in which the Complainant has rights:
- (iii) The Registrant's impugned domain name 'deloitte.in' is identical to and comprises in entirety the Complainant's trade/service mark/name DELOITTE which was registered in a number of countries prior to the creation of the domain name, including India. It is submitted that the Registrant has registered the impugned domain name 'deloitte.in' with the *mala fide* intent to trade upon the immense goodwill and reputation enjoyed by the Complainant in its well-known mark/name/domain name DELOITTE and thereby gain undue leverage from it and make illicit pecuniary gains. It is evident that the objectionable domain name has no significance independent of the Complainant's trade/service mark/name DELOITTE. This is a clear case of infringement and passing off which is violative of the rights enjoyed by the Complainant in its well-known and established trade/service mark/name/domain name DELOITTE. Moreover, the Registrant's use of the Complainant's well known and reputed trade/service mark/name/domain name DELOITTE clearly establishes that the registrant registered the impugned domain name with full knowledge of the Complainant, its business activities and intellectual property.



- (iv) The Complainant further states that the impugned domain name 'deloitte.in' is identical to, inter alia, the following domain names registered in the name of the Complainant:

S.No	Domain names	Registrant's domain name
1.	<u>deloitte.com</u>	<u>Deloitte.in</u>
2.	<u>deloitte.net</u>	
3.	<u>deloitte.org</u>	
4.	<u>deloitte.hk</u>	
5.	<u>deloitte.au</u>	
Note: The list is illustrative and not exhaustive		

- (v) It is further submitted by the Complainant that the impugned domain was created on February 12, 2013 and it appears that the present Registrant acquired the same from Zhaxia in early 2017 whereas the Complainant's domain name 'deloitte.com' was created on April 20, 1995. Further, the Complainant's establishment goes back to the year 1845 and the earliest trade/service mark/name DELOITTE back to July 10, 1989 in United Kingdom. The trade/service mark/name/domain name DELOITTE & TOUCHE is also registered in India under No.731601 since September 4, 1996 and the mark/name DELOITTE per se is registered since January 14, 2004 under No. 1261053. Thus, the Complainant's adoption of the trade/service mark/name/domain name DELOITTE is much prior to the Registrant's registration of the impugned domain name 'deloitte.in'. In view of the same, it is crystal clear that the Complainant has prior rights in the trade/service mark/name/domain DELOITTE *vis-à-vis* the Registrant.





- (ii) **The Respondent has no rights or legitimate interest in the domain name www.deloitte.in [Para 3(b)(vi)(2) INDRP Rules of Procedure to be read with Para 7 of .INDRP] :**

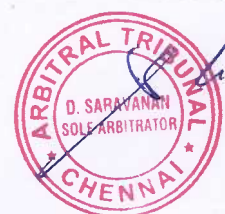
The Complainant submits that Paragraph 7 of the INDRP states as under:

**"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 purposes of Paragraph 4(ii):

- (i) before any notice to the Registrant of the dispute, the Registrant's use of or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services;
- (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."

Therefore, the Registrant has to establish one or more of the circumstances enumerated in paragraph 7 of the INDRP to assert proprietary rights over the domain in question. It is submitted that the Registrant cannot take refuge in any of the referred conditions. This is unequivocally demonstrated herein below by the Complainant:



- (iv) As regards paragraph 7(i), it is submitted that the registrant is not offering any goods/services under the domain name 'deloitte.in'. A review of the website under the objectionable domain name 'deloitte.in' reflects that the said domain is parked and being offered for sale by the registrant. Further, the statement '*the domain deloitte.in may be for sale. Click here to inquire about this domain*' clearly evidences that the registrant hopes to sell the domain name at a profit and has no intent to use the domain name in connection with any other businesses or services. Therefore, by no stretch of imagination, can the Registrant demonstrate any use of the domain name relating to a *bona fide* offering of goods or services before any notice of this dispute or at any point in time whatsoever.
- (v) Regarding paragraph 7(ii), it is submitted that the registrant is not commonly known by the domain names 'deloitte.in' or "Deloitte" and has been authorized or licensed by the Complainant to use its mark/name DELOITTE in a domain name or in any other manner. The Complainant's domain deloitte.com and various other domains comprising the mark DELOITTE is identified exclusively with the Complainant by the trade and public at large. Further, the Complainant has registered the DELOITTE mark in approximately 150 jurisdictions around the world, including in India, with the earliest registration secured for the DELOITTE mark dating back to July 10, 1989 in the United Kingdom. Due to the extensive and continuous use of the trade/service mark/name DELOITTE for many years, the same has become well-known and come to be exclusively associated with the Complainant and the Deloitte member Firms and no one else. Hence, the Registrant cannot establish any association with the domain name in question for any reason/s whatsoever.



(vi) With respect to paragraph 7(iii), it is submitted that the Registrant is not making any legitimate non-commercial or legitimate fair use of the domain name. In fact, the conduct of the Registrant as highlighted above cannot come under the definition of *bona fide* use. Registration of the impugned domain is aimed to gain leverage from the immense goodwill and reputation of the Complainant's trade/service mark/name DELOITTE, divert visitors/customers by creating confusion and thereby commercially profit from us of the Complainant's trade/service mark/ name DELOITTE. Thus, the Registrant is (i) indulging in unfair use of the domain name with an intention to reap profits therefrom, (ii) misleading/diverting customers to competitor websites, and (iii) tarnishing the goodwill and reputation enjoyed by the Complainant's well-known trade/service mark/ name DELOITTE. The Registrant, therefore, cannot justify any legitimate interest in the domain name 'deloitte.in'.

(iii) **The domain name was registered and is being used by the Respondent in bad faith [Para 3(b)(vi)(3) INDRP Rules of Procedure to be read with para 6 of .INDRP:**

The Complainant submits that paragraph 6(i), (ii) and (iii) of the INDRP provides guidelines to the Arbitrator to adjudicate on the 'bad faith' of the Registrant in registering the domain name and subsequent use thereof. The said paragraph states as under:

**"6. Evidence of Registration and use of Domain Name in Bad Faith**

*For the purposes of Paragraph 4(iii), the following circumstances, in particular but without limitation, if found by the Arbitrator to be present, shall be evidence of the registration and use of a domain name in bad faith:*



- (i) *circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the Complainant, who bears the name or is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented out-of-pocket costs directly related to the domain name; or*
- (ii) *the Registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Registrant has engaged in a pattern of such conduct; or*
- (iii) *by using the domain name, the registrant has intentionally attempted to attract Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location."*

Further, Paragraph 3(b)(vi)(3) of the INDRP Rules of Procedure states that the Complainant needs to prove 'why the domain name in question should be considered as having been registered and being used in bad faith'. 'Bad faith' is a legal term which the Black's Law Dictionary (Seventh Edition) defines as "*dishonesty of belief or purpose. Also termed as mala fides*". The Complainant submits that its case is established under the circumstances covered in paragraph 6 (i), (ii), and (iii) of the INDRP and paragraph 3(b)(vi)(3) of the INDRP Rules of Procedure as under:

- (i) Insofar as Paragraph 6(i) is concerned, it is submitted that the Registrant has registered the impugned domain name 'deloitte.in' with the sole purpose of



selling/transferring the same for excessive consideration to make illicit gains, as is evident from the Registrant's website extract filed herein evidencing that the domain is available for sale (**Annexure I**). Further, registration of the objectionable domain name much subsequent to the Complainant's registration of more than 600 domains comprising the name/mark DELOITTE since the year 1998 onwards clearly establishes (mis)use of the Complainant's well-known trade/service mark/name/domain DELOITTE to gain illegal benefits. The Registrant's *mala fide* intention to register the domain is further established by the fact that the domain was earlier registered in the name of one 'Zhaxia' against which this Tribunal has passed an award for registering a domain with the sole intention of making commercial gains and in bad faith.

- (ii) Insofar as Paragraph 6(ii), it is beyond doubt that the registrant registered the impugned domain name 'deloitte.in' knowing fully well of the Complainant, the Deloitte Member Firm, and their affiliated businesses. Mere registration of the domain name comprising Complainant's well-known trade/service mark/ name DELOITTE and not using the same establishes Registrant's intention to prevent the Complainant from reflecting the mark in corresponding domain name. The registration of the domain name 'deloitte.in' by the registrant has resulted in the Registrant's mis(use) of the Complainant's trade/service mark/name/domain(s) DELOITTE for undue pecuniary gains. Further, a reverse WHOIS indicates that the Registrant has registered 444 domains, nearly all of which, like deloitte.in, incorporate the trademarks of well-known global companies, and which are currently being offered for sale. (see armanijeans.co.in/, colgate.in/, aeropostale.in, etc)
- (iii) As regards, paragraph 6(iii), the website appearing at the Registrant's domain name has been constructed in a manner so as to portray an association/affiliation with the Complainant and/or the Deloitte Member



Firms. The conduct of the Registrant amply proves its *mala fide* intention to attract Internet users to its website by using the mark/name of the Complainant and consequently creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the Registrant's website. Further, Internet users desirous of accessing the Complainant's website may get attracted to the impugned website/domain comprising Complainant's trade/service mark/name, thereby creating confusion in their minds. Such conduct of the registrar clearly establishes the Registrant's *mala fide* to gain illicit benefits and cause harm to the Complainant's and its member firms' businesses.

**(iv) Other grounds**

- (i) The Complainant submitted that Paragraph 3(b) of INDRP obligates that the Registrant's registration of the domain name does not infringe upon or otherwise violate the rights of any third party. In the instant case, as elaborated hereinabove, the Registrant's domain name 'deloitte.in' comprising the Complainant's registered trade/service mark DELOITTE and DELOITTE formative marks infringes upon the statutory and proprietary rights of the Complainant vesting in the said trademark.
- (ii) Paragraph 3(c) of INDRP states that 'the Registrant is not registering the domain for an unlawful purpose'. In the instant case, the Registrant has registered the impugned domain name 'deloitte.in' with mala fide intention to mislead innocent customers and prospective customers of the Complainant's Indian member firm to its website thereby making unjust pecuniary gains therefrom and in the process tarnish the Complainant's and its member firms' goodwill and reputation vesting in the trade/service mark/name DELOITTE.



- (iii) Paragraph 3(d) of INDRP obligates the Registrant not to use the domain name in violation of any applicable laws or regulations. In this regard, it is humbly submitted that registration of the impugned domain name 'deloitte.in' violates not only INDRP/ INDRP Rules of procedure but is also in violation of the provisions of the (Indian) Trade Marks Act, 1999 and opposed to the principles of business ethics.

**B. Respondent:**

The Respondent, in spite of notice dated 27<sup>th</sup> September, 2018 and default notice dated 7<sup>th</sup> October, 2018 did not submit any response.

**7. Discussion and Findings:**

It has to be asserted as to whether the Constitution of Arbitral Tribunal was proper and whether the Respondent has received the notice of this Arbitral Tribunal?

Having gone through the procedural history, this Tribunal comes to the irresistible conclusion that the Arbitral Tribunal was properly constituted and Respondent has been notified of the complaint of the Complainant. However, the Respondent did not choose to submit any response and that non-submission of the response by the Respondent had also been notified to the Respondent on 7<sup>th</sup> October, 2018.

Under paragraph 4 of the .IN Domain Name Dispute Resolution Policy (INDRP), the Complainant must prove each of the following three elements to establish their case, that:

- (i) The Respondent's domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;



- (ii) The Respondent has no rights or legitimate interest in respect of the domain name; and ;
- (iii) The Respondent's domain name has been registered or are being used in bad faith.

(a) **Identical or confusing similarity:**

- (i) The Arbitral Tribunal finds that the Complainant has provided evidences that it possesses registered trademark "Deloitte" around the world, including in India. The same is evident from **Annexure A, B and C** marked by the Complainant. From **Annexure A**, this Tribunal perceives that the earliest registration of the Complainant's mark dates back to 10<sup>th</sup> July, 1989. Whereas, from **Annexure G**, this Tribunal perceives that the disputed domain name is registered on February 12, 2013 much later to the registration of the Complainant's mark. This Tribunal is therefore convinced from the documents marked by the Complainant that it possess the mark "DELOITTE" since 10<sup>th</sup> July, 1989.
- (ii) In *Perfetti Van Melle Benelux BV v. Lopuhin Ivan, IPHOUSTER* (WIPO Case No. D2010-0858) and *Inter-Continental Hotels Cooperation v. Abdul Hameed* (NIXI Case No. INDRP/278, February 10, 2012), it was held that the trademark registration constitutes *prima facie* evidence of the validity of trademark rights. This Tribunal also concurs with the decision stated supra.
- (iii) Further, the disputed domain name, [www.deloitte.in](http://www.deloitte.in), in toto, incorporates the complainant's mark, namely 'Deloitte'. In *Kenneth Cole Productions V. Viswas Infomedia* INDRP/093, it has been held that there is confusing similarity where the disputed domain name wholly incorporates the Complainant's





trademark. Similarly, the domain name www.deloitte.in is confusingly similar to the Complainant's mark and also wholly incorporates the Complainant's mark, "Deloitte". Thus, this Arbitral Tribunal finds that the disputed domain name www.deloitte.in is identical or confusingly similar to the Complainant's mark.

(iv) The Arbitral Tribunal concludes that the Complainant has established paragraph 4(i) of the .IN Domain Name Dispute Resolution Policy.

**(b) Respondent's Rights or Legitimate Interests:**

(i) The Complainant contends that the Respondent has no legitimate interest in the disputed domain name. Paragraph 7 of the IN Dispute Resolution Policy sets out three elements, any of which shall demonstrate the Respondent's rights or legitimate interests in the disputed domain name for the purposes of Paragraph 4 (ii) of the Policy. The Respondent had been given the opportunity to respond and to present evidence in support of the elements in paragraph 7 of the INDRP. The Respondent has not chosen to do so and has not filed any response in these proceedings to establish any circumstances that could assist it in demonstrating, any rights or legitimate interests in the disputed domain name. Although, the Complainant is not entitled to relief simply by default of the Respondent to submit a Response, the Arbitral Tribunal can however and does draw evidentiary inferences from the failure of the Respondent to respond. It is also found that the respondent has no connection with the mark "Deloitte". The Respondent has failed to rebut the presumption of absence of rights or legitimate interests.

(ii) It is further seen that the WHOIS lookup in **Annexure H**, it relates the Respondent to the Disputed Domain name. However, it identifies the



registrant as 'Doublefist Limited', which is not in the slightest way similar to the Disputed Domain name. The Respondent is found to have acted in a way that tarnishes the Complainant's well known mark "Deloitte", by using the mark without any proper authorization.

- (iii) Further from **Annexure I**, this tribunal perceives that the Respondent website hosted at the disputed domain name displays "*The domain deloitte.in may be for sale. Click here to inquire about this domain,*" which implies that the Resgistrant is not offering any goods/services in the disputed domain name and the intention of the Respondent to make unjust commercial profits consequently creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the Registrant's website.
- (iv) The above establishes that the Respondent does not have any rights or legitimate interest in the domain name and it intends to make unjust commercial profits.
- (v) Based on the record, the Respondent does not have rights or legitimate interests in the disputed domain name as the Respondent's current use is neither an example of a bona fide offering of goods or services as required under paragraph 7(i) of the Policy nor is there any legitimate non-commercial or fair use of the disputed domain name and as such there is no evidence that paragraphs 7(ii) or 7(iii) of the Policy apply. The Complainant asserts that they have not licensed or otherwise authorized the Respondent to use their trademark.
- (vi) The Arbitral Tribunal is satisfied that the Respondent has no rights or legitimate interests in respect of the disputed domain name and, accordingly paragraph 4(ii) of the Policy is satisfied.



**(c) Registration and Use in Bad faith:**

- (i)** It is seen from **Annexure-H**, the Respondent had registered the disputed domain name on February 12, 2013 which is very much after the date of registration of the Complainant's trademark. By that time, the Complainant's DELOITTE Mark, through extensive and continuous use, had acquired immense goodwill and reputation amongst the public and trade. The rights of the Complainant in the mark is also well established by various precedents submitted by the Complainant viz. *Deloitte Touche Tohmatsu v. Deloitte Daniel Consulting/ Whois Privacy (enumDNS dba)*, WIPO Case No. D2015-1901, at §6.B; *Deloitte Touche Tohmatsu v. Richard Yaming, Trademark Worx, LLC*, WIPO Case No.D2014-1360, at §6.A; *Deloitte Touche Tohmatsu v. Supervision Audio Video Inc., Search- Universal.com*, WIPO Case No.D2011-0187, at §6.B; *Deloitte Touche Tohmatsu v. H3B*, WIPO Case No. D2011-0181, at §6.B; *Deloitte Touche Tohmatsu v. Open Water Enterprises Limited Louise S.*, WIPO Case No.D2008-1632 at §6.C; *Deloitte Touche Tohmatsu v. Pluto Domain Services Private Limited/Private Whois for dpelprip 1703*, WIPO Case No.D2008-1617, at §6.C; *Deloitte Touche Tohmatsu v. CostNet aka Domain Manager*, WIPO Case No.D2003-0619, at §6.A.
- (ii)** Further from **Annexure I**, this Tribunal perceives that the Respondent website hosted at the disputed domain name displays "*The domain deloitte.in may be for sale. Click here to inquire about this domain,*" which implies the intention of the Respondent to make unjust commercial profits. Further from, **Annexure J**, the reverse WHOIS in respect of the Registrant, this Tribunal perceives that the Registrant is the listed owner for about 444 additional domain names including that of well known marks., viz. appletv.in, colgate.in. In addition, the Registrant has sent a e-mail dated November 3, 2016 to the Complainant for sale of the domain name deloitte.in, which is evident in **Annexure K** marked by the Complainant.



- (iii) The above implies that the Respondent is involved in cyber squatting by registering domain names containing well known trademarks and thereby making illegal benefits by sale which would also amount to registration and use in bad faith.
- (iv) The Respondent has no legitimate rights or interests in the disputed domain name and there was a *mala fide* intent for registering the disputed domain name other than for commercial gains, and that the intention of the Respondent was simply to generate revenue, either by using the domain name for its own commercial purpose or through the sale of the disputed domain name to a competitor or any other person that has the potential to cause damage to the ability of the Complainant to have peaceful usage of the Complainant's legitimate interest in using their own trade names.
- (v) The Arbitral Tribunal is satisfied that the Respondent used the Complainant's domain name in bad faith and, accordingly paragraph 4(iii) of the Policy is also satisfied.
- (vi) In the light of the above, this Arbitral Tribunal finds that the Complainant has established that the disputed domain name was registered and is being used in bad faith.

**8. Decision:**

For all the foregoing reasons, in accordance with paragraph 10 of the .INDRP, the Arbitral Tribunal orders that the Respondent shall cease to use the mark "Deloitte" and also the disputed domain name [www.deloitte.in](http://www.deloitte.in) be transferred to the Complainant.

  
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**D.SARAVANAN**  
**Sole Arbitrator**  
20<sup>th</sup> October, 2018  
Chennai, INDIA