



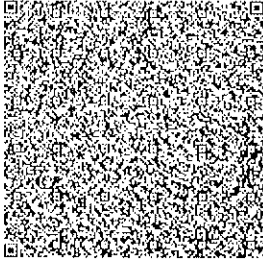
सत्यमेव जयते

INDIA NON JUDICIAL

Government of National Capital Territory of Delhi

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Certificate No. : IN-DL36686306779062Q
Certificate Issued Date : 11-Jun-2018 12:12 PM
Account Reference : IMPACC (IV)/ dl831103/ DELHI/ DL-DLH
Unique Doc. Reference : SUBIN-DL83110377318027925485Q
Purchased by : SUDARSHAN KUMAR BANSAL
Description of Document : Article 12 Award
Property Description : Not Applicable
Consideration Price (Rs.) : 0
(Zero)
First Party : SUDARSHAN KUMAR BANSAL
Second Party : Not Applicable
Stamp Duty Paid By : SUDARSHAN KUMAR BANSAL
Stamp Duty Amount(Rs.) : 100
(One Hundred only)



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.IN Registry
(NATIONAL INTERNET EXCHANGE OF INDIA)

COMPLAINANT
STAEDTLER Mars GmbH & Co. KG,

Vs.

RESPONDENT
Suresh Jain

ARBITRATION AWARD

JK. Bansal

Statutory Alert:

1. The authenticity of this Stamp Certificate should be verified at "www.shicilestamp.com". Any discrepancy in the details on this Certificate and as available on the website renders it invalid.
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.IN Registry
(NATIONAL INTERNET EXCHANGE OF INDIA)

ADMINISTRATIVE PANEL DECISION
SOLE ARBITRATOR: SUDARSHAN KUMAR BANSAL

INDRP Case No. 977

COMPLAINANT

STAEDTLER Mars GmbH & Co. KG,
Moosaeckerstrasse 3,
90427 Nurnberg,
Germany
E-Mail : bettinger@bettinger.de

VERSUS

RESPONDENT

Suresh Jain
38 Jermiah Road,
604 Rainjith Apartments,
Chennai TN 600007,
India

E-Mail : stationeryworld@gmail.com
info@stationeryworld.com

ARBITRATION AWARD

1. The Complainant is aggrieved by the domain name staedtlerindia.in being registered with the sponsoring Registrar GoDaddy.com LLC(R101-AFIN) in the name of the Respondent and being so used by the Respondent and has accordingly made this Complaint seeking the relief that this domain name staedtlerindia.in be transferred to it.
2. The Complainant has preferred this Complaint on the basis of its

J.K. Bansal

claim proprietary rights in its trade mark STAEDTLER and trade name and formative domains bearing the word/mark on the following averments in gist:

2.1 The Complainant is a company organized under the laws of Germany and claims to be a global player in the field of writing, coloring, drawing and creative products, wood-cased pencils, ORP pens, erasers, mechanical pencil leads, and modeling clays (referred to as the "said goods" and/or "business"). Under its umbrella brand STAEDTLER the Complainant claims to provide the consumer a diverse product portfolio for all age groups and activities, including schools, clubs, businesses and creative hobbyists. The Complainant claims to have over 2,000 employees worldwide, and world-wide distribution partners in more than 150 countries, including 21 subsidiaries and 6 production sites. These products are provided/distributed in many regions across the globe under the registered trademark "STAEDTLER" of the complainant through its authorized resellers and online. The Complainant claims to have built up a good business goodwill and reputation and to be carrying on its said business under its trade mark trade name and domain bearing the word/mark STAEDTLER.

2.2 The Complainant claims to own right in the trade mark STAEDTLER (herein after referred as "the Trademark") in various jurisdictions of the word, including India and particulars of which registrations/filings have been filed alongwith the Complaint.

2.3 The Complainant claims that it markets its product in India since 1920s and at present to be distributing its products in India through its authorized reseller Alpha International, L-37, Mittal Chambers, 2-2-51, M.G. Road, Secunderabad - 500 003, Telangana, India (online vide <http://www.alphafirst.in>). The Complainant currently owns numerous domain names which utilize the "STAEDTLER" trademark and are

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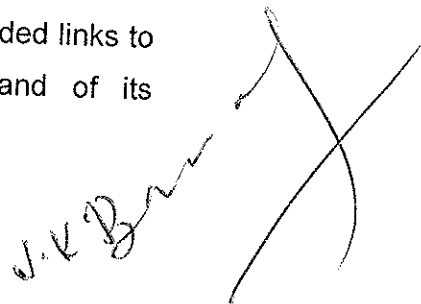
operational in India, including <staedtlerindia.com>, <staedtler-india.com>, <staedtler.co.in> and <staedtler.in> (redirecting link to <staedtler.com>). The Complainant's and its affiliates turnover regarding India is 782.000 EUR (for year 2016) and 751.000 EUR (until 11.2017).

2.4 According to the Complainant the Respondent is an independent reseller of stationery products based out of Chennai, India and offers goods of various brands online including goods bearing Complainant's Trademark "STAEDTLER".

2.5 According to the Complainant the rival disputed and impugned domain name staedtlerindia.in in the name of the Respondent is in violation of the Complainant's STAEDTLER trade mark, trade name and domains and its rights thereunder and the goodwill and reputation associated therewith being identical with and confusingly similar thereto and whereby consumer deception is being caused and in which impugned domain the Respondent has no rights or legitimate interest and which impugned domain is in bad faith. The Respondent by its impugned domain name and usage is making illegal pecuniary gains to cash upon the goodwill and reputation associated with the Complainant STAEDTLER trade marks and domains causing loss and injury to the Complainant.

2.6 According to the Complainant, the Respondent on its website available under the impugned domain name is prominently using the Complainant's STAEDTLER trade mark and artistic logo and copyright protected photographs/artistic works/illustrations.

2.7 The Complainant has further alleged the Respondent in its website accessible under the impugned domain to have provided links to separate websites offering goods of the Complainant and of its competitors.

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2.8 The Complainant alleges the Respondent to be demeaning the Complainant and its business by using the name of the Adolf Hitler on its website under the impugned domain name.

2.9 According to the Complainant even in the past it has successfully taken action against the very same Respondent against the then disputed domain staedtlerindia.com before the WIPO Arbitration and Mediation Center and has relied upon the findings recorded by the Panel therein in its favour. The Complainant has claimed to have issued a cease and desist notice upon the Respondent prior to the filing of the present Complaint to which the Respondent has not cared to reply.

2.10 According to the Complainant the impugned activities of the Respondent including in the adoption and use of the impugned domain is without its leave and license.

2.11 Vide the present Complaint, the Complainant has sought an order that the disputed domain name staedtlerindia.in be transferred to it.

2.12 In support of its case the Complainant has filed documents being **Exhibit 1 to 15** which would be dealt with in so far as they are relevant in the course of this Award.

3. The .IN Registry appointed me as an Arbitrator to adjudicate this Complaint in accordance with the Arbitration and Conciliation Act, 1996; .IN Domain Name Dispute Resolution Policy; Rules of Procedure and/or bye-laws; rules and guidelines made therein and notified the factum thereof to the Complainant through its attorneys and authorized representatives as well as to the Respondent. The .IN Registry appointed me as the sole Arbitrator of this case on April 24, 2018 and served upon me (the Arbitral Tribunal) the physical set of the entire Complaint paper

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book.

4. Thereafter, I (Arbitral Tribunal) issued a notice to the Respondent vide E-mail dated 28/04/2018 with copy of the Complaint and Annexures/documents filed therewith wherein the Respondent was notified about my appointment as the Arbitrator and was given an opportunity to submit its written response to the Complaint stating its defense with supporting documents within a period of ten(10) days.

4.1 The Respondent duly responded to the said notice vide its two E-mails each dated 28.04.2018. In the first E-mail the Respondent stated to have invested lot of money for selling staedtler products online and sought an "offer" from the Complainant. In the second E-mail the Respondent has stated that all logos, trade marks, designs are the property of the respective owners and all products are procured from official Staedtler importers.

4.2 Thereafter I issued notice dated 02.05.2018 on the Complainant and the Respondent bringing to their notice of the aforesaid two E-mail dated 28.04.2018 and gave an opportunity to the Complainant to furnish its comments thereon within seven(7) days. In the same notice the Respondent was called upon to explain whether the said two E-mails were to be considered as a reply/response to the Complaint and if the Respondent wishes to file any further reply/response it could do so within seven(7) days. Both the Complainant and the Respondent were further notified in the said notice that the Arbitral Tribunal cannot in any way facilitate any negotiation on proposed offers/counter offers and would proceed with the matter as per law on merits.

4.3 The Complainant vide its E-mail dated 07.05.2018 responded to the said notice dated 02.05.2018 stating its unwillingness to make any payments to the Respondent in view of its claim of the abusive

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registration and use of the disputed domain name by the Respondent.

4.4 The Respondent vide its E-mail dated 11.05.2018 addressed to this Arbitral Tribunal stated that it (Respondent) has nowhere mentioned the brand STAEDTLER to be owned by it and it to have clearly mentioned that all brands and trade marks belong to their respective owners. The Respondent further stated therein that it purchases these goods from the authorized STAEDTLER distributor being Alpha international and it was willing to make changes as requested by the Complainant without transferring the ownership of the website and requested the Complainant for a list of changes to be made to its website.

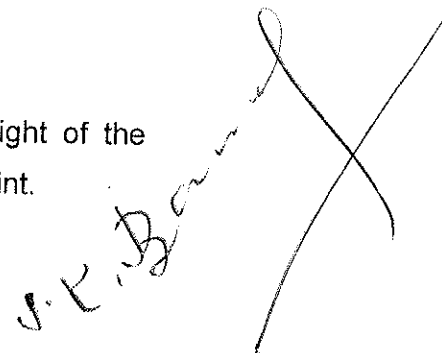
4.5 Thereafter, I issued a notice upon the Complainant and Respondent vide E-mail dated 12.05.2018 serving upon the Complainant the Respondent's E-mail dated 11.05.2018 and seeking its response thereto within seven(7) days. The Complainant thereafter vide its E-mail dated 15.05.2018 furnished its comments on the Respondent's said E-mail dated 11.05.2018 and made detailed submissions in contest thereof.

4.6 Thereafter, I issued a notice on the Complainant and the Respondent vide E-mail dated 17.05.2018 serving upon the Respondent the Complainant's said response dated 15.05.2018 with opportunity to file its response thereto within seven(7) days. In the said notice it was further notified that no further opportunity would be granted and thereafter the Tribunal would proceed to give its Award.

4.7 The Respondent did not file any response thereto.

5. In the aforesaid facts and circumstances and in light of the material on record I now proceed to adjudicate this Complaint.

S. K. Banerjee



6. The Trade Mark STAEDTLER (stylized) is duly registered in India under the Trade Marks Act, 1999 (the Trade Marks Act for short) in favour of the Complainant under Trade Mark No.341272 as of 29.09.1978 in relation to writing, painting and modeling articles and parts thereof, drawing instruments, teaching aids (other than apparatus) and office equipments (except furniture) included in Class 16 and which registration is valid, subsisting on the Register. The Complainant has placed on record as Exhibit-8 the search report obtained from the e-records of the Registrar of Trade Marks as well as copy of the Registration Certificate to that effect.

7. The Complainant owns, as per the list filed as Exhibit-7 to the Complaint 110 Trade Mark registrations across various overseas countries for the Trade Mark STAEDTLER; as also various domains bearing the word/mark STAEDTLER and as per particulars filed as Exhibit-5. Some such STAEDTLER formative domains are staedtlerindia.com duly registered with the sponsoring Registrar with the creation date of 24.03.2014; staedtler-india.com duly registered with the sponsoring Registrar with the creation date of 22.04.2000; staedtler.co.in duly registered with the sponsoring Registrar with the creation date of 09.07.2012 and staedtler.in duly registered with the sponsoring Registrar with the creation date of 16.02.2005.

8. Print outs from the Complainant's website www.staedtler.com filed as Exhibit-4 and from the website www.alphafirst.in of the Complainant's authorized distributor in India viz. Alpha International at L-37, Mittal Chambers, 2-2-51 M.G. Road, Secunderabad-500003 through whom the Complaint has been distributing and selling its products bearing the STAEDTLER Trade Mark in India filed as Exhibit-6 establish the sale and trade of the Complainant's products relating to its STAEDTLER Trade Mark.

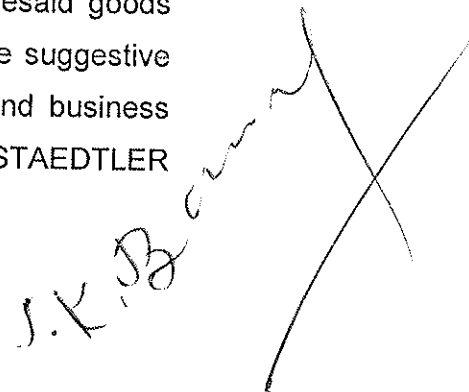
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9. The Complainant claims to be marketing its products in India since the 1920's and the Complainant has claimed the turnover figures of itself and its affiliates in India in the year 2016 to be 782000 EUROS and in the year 2017 (till November, 2017) to be EUROS 751000. The Respondent in its E-mail dated 11.05.2018 and 28.04.2018 addressed to this Tribunal itself has admitted to be selling the goods of the Complainant procured from its authorized distributor Alpha International and to have invested a lot of money for selling the Staedtler products online.

10. The Complainant's company profile available from its website www.staedtler.com and filed as **Exhibit-2** details the activities and standing of the Complainant while the article published on the informatory website Wikipedia filed as **Exhibit-3** comments upon various aspects of the Complainant's corporate personality.

11. As per the .IN Registry's WHOIS database, filed as **Exhibit-1** by the Complainant, the disputed/impugned domain name staedtlerindia.in in the name of the Respondent Registrant was registered with the sponsoring Registrar GoDaddy.com LLC (R101-AFIN) with the date of creation of 27.11.2016. This rival domain registration is much subsequent to the Complainant's aforesaid noticed Indian Trade Mark registration under No.341272 which is dated 29.09.1978 as per **Exhibit-8** as well as the Complainant's various domains as noticed above as per **Exhibit-5**.

12. In my considered view the word/mark STAEDTLER is an arbitrary and fanciful Trade Mark in relation to the aforesaid goods and business of the Complainant and has no descriptive suggestive or generic connotation with the Complainant's goods and business and more so in the Indian context where the word/mark STAEDTLER

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does not form part of the ordinary Indian languages. As such the Trade Mark STAEDTLER and domains bearing the same enjoy inherent distinctiveness in addition to their acquired and factual distinctiveness and secondary significance and as such they are strong Trade Marks and domains.

13. The Respondent has not contested the Complainant's rights and use in the Complainant's said STAEDTLER Trade Mark and domains and in fact has impliedly admitted the same by selling the Complainant's said goods and investing a lot of money therein.

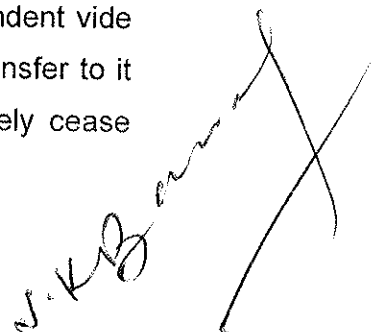
14. In light of the aforesaid I am of the considered view that the Complainant has been able to establish that it has been in active business under its said STAEDTLER Trade Marks and domains in the domestic and international market through e-commerce and over the internet as the Complainant's website have global access. The Complainant's Trade Mark and domains in relation to its said products was already in existence, in vogue and in use in the market enjoying noticeable goodwill and reputation to the knowledge and understanding of the Respondent much prior to the adoption and alleged use of the impugned domain by the Respondent. In fact the Respondent itself has been selling the Complainant's goods under the STAEDTLER Trade Mark and to have invested a lot of money for selling the said products online. The Respondent would so do so only if the Complainant's products under the STAEDTLER Trade Mark enjoyed goodwill, reputation and standing in the market which would bring profits to the Respondent or why else would the Respondent so do so. As such it can safely be held that in addition to the Trade Mark registration being held by the Complainant in India as per **Exhibit-8** and the various domain names registered with the respective sponsoring Registrar as per **Exhibit-5** the Complainant's business under its STAEDTLER Trade Marks enjoy commercial visibility,

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market presence, popularity both in India and overseas and of the market and trade being aware of the Complainant and the Complainant's said business and the Complainant's said STAEDTLER Trade Mark. Accordingly, in my considered view the Complainant has been able to establish its rights, entitlements, legitimate claims and interests in its Trade Mark STAEDTLER and STAEDTLER formative domains in relation to its said goods and business.

15. In my considered view the disputed domain name is identical with and deceptively similar to the Complainant's prior and well established STAEDTLER Trade Mark and Domain. The word/mark STAEDTLER is an essential dominant and distinguishing feature of the disputed domain name. It is with reference to the word/mark STAEDTLER that the disputed domain name would be remembered or accessed to by an average consumer [See B.K. Engineering Company Vs. U.B.H.I. Enterprises AIR 1985 Delhi 210 (DB); Kirorimal Kashiram Mktg & Agencies Pvt.Ltd., Vs Shree Sita Chawal Udyog Mill 2010 (44) PTC 293 (Del) (DB); South India Beverages Pvt. Ltd., vs. General Mills Marketing Inc., 2015 (61) PTC 231 (Del) (DB)]. In addition the nature of goods and services being offered on the Respondent's website accessible through the disputed domain name undisputedly are same/similar to the goods and services being offered by the Complainant under its STAEDTLER Trade Mark and Domains.

16. The adoption and use of the disputed domain name by the Respondent is without the leave, license or approval of the Complainant. This is apparent from the fact that prior to the filing of this Complaint, the Complainant had requested the Respondent vide its letter dated 11.08.2017 and as filed as Exhibit-14 to transfer to it (the Complainant) the impugned domain and to immediately cease

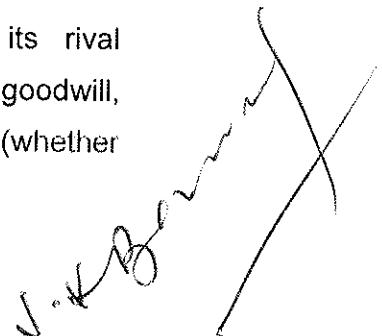


with its use. Not only that the Complainant had successfully impugned another domain of the Respondent staedlerindia.com by way of a Complaint before the WIPO Arbitration and Mediation Centre under Case No.D2016-1918 and where under the adjudicating Panel vide its decision dated 14.11.2016 had ordered the said disputed domain to be transferred to the Complainant. The copy of the said Complaint and decision have been filed as Exhibit-12 & 13 respectively with this Complaint.

17. There is a close relationship between Trade Marks and Domain Names. "Trade Marks" are source identifiers of goods or service from a particular source and distinguish them from those of others while "Domain Names" are source identifiers of the business of a particular entity. The basic principles of trade mark and passing off laws apply to domain name disputes [Satyam Infoway Ltd. Vs. Sifynet Solutions Pvt. Ltd., 2004 (28) PTC 566 (SC)].

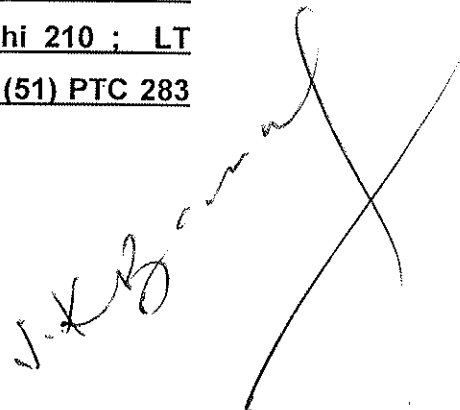
18. The right conferred on a trade mark by virtue of its registration or by virtue of its prior user acquired goodwill reputation and distinctiveness encompasses within its fold the right to so use and exploit it as a domain name or part thereof. A domain name use "of a trade mark" in relation to goods or services amounts to the use thereof "as a trade mark" **[Section 2 (2), 27, 28 of the Trade Marks Act]**. This is more so as under the impugned Domain Name and the website triggered thereby there is an offer of services. Both the Complainant and the Respondent are using the respective domain name in the context of a commercial activity with the view to economic advantage and hence in the course of trade.

19. A Registered trade mark can be infringed by its rival unauthorized use as a part of a domain name ; as also the goodwill, reputation and distinctiveness attached to a trade mark (whether

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registered or unregistered) can be violated by way of passing off by a rival unauthorized use as a part of domain name. In either case the Trade Mark registration or the goodwill and reputation attached to a trade mark has to be protected against such unauthorized domain name use. [See Bharti Airtel Limited Vs. Rajiv Kumar-2013 (53) PTC 568(Del); Tata Sons Limited Vs. D. Sharma & Anr.-2011 (47) PTC 65 (Del.); Dr. Reddy's Laboratories Limited Vs. Manu Kosuri & Anr.-2001 PTC 859 (Del); Mars Incorporated Vs. Kumar Krishna Mukherjee & Ors.-2003 (26) PTC 60 (Del)].

20. Such rights and specially the rights conferred by Trade Mark registrations under the Trade Marks Act or by priority in adoption and use, goodwill, reputation and distinctiveness have to be protected and upheld even if it is against a rival domain bearing the said trade mark STAEDTLER as interalia there is a close relationship between trade marks and domain names and as the basic principles of trade mark and passing off laws apply to domain name dispute as well. Trade Mark Registrations have a presumptive validity attached to them and are a presumptive evidence of title in favour of the Registrant/Complainant. The trade mark registrations or common law rights therein or its goodwill or reputation and distinctiveness attached thereto can be violated even against the rival unauthorized use thereof as part of a rival domain name. [See American Home Products Corporation Vs. Mac Laboratories Pvt. Ltd., & Anr. Reported in AIR 1986 SC 137 ; Satyam Infoway Ltd., Vs. Sifynet Solutions Pvt. Ltd., 2004 (28) PTC 566 (SC) ; Bharti Airtel Limited Vs. Rajiv Kumar-2013 (53) PTC 568 (Del) ; B.K. Engineering Co. Vs. U.B.H.I. Enterprises reported in AIR 1985 Delhi 210 ; LT Foods Limited Vs. Sulson Overseas Pvt. Ltd., 2012 (51) PTC 283 (Del)].



21. A consumer or internet user seeking to access the Complainant or its services by erroneously or inadvertently suffixing the ".in" as the ccTLD (country code top-level domain) would be misled to the Respondent and consequently would be deceived by reaching somewhere else and not to the Complainant as it had intended.

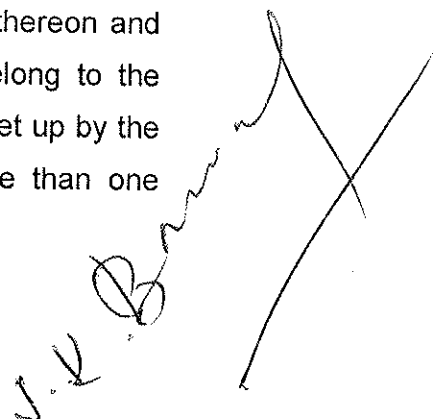
22. The Respondent has provided in its website accessible under the disputed domain name various redirecting links to other websites accessible under different domains like rotring.co.in selling thereon the products of the Complainant's competitors under Trade Marks not those of the Complainant. Such products of the Complainant's competitors are the same/similar to those of the Complainant. The domain rotring.co.in is of the Respondent itself. In evidence thereof the Complainant has filed as **Exhibit-9** the Respondent's home page from the impugned website accessible under the impugned domain name and as **Exhibit-10** the print-out of the WHOIS Report showing the disputed domain rotring.co.in to belong to the Respondent. By such an act the consumers seeking to buy the Complainant's products would be led and/or redirected by the Respondent to the Complainant's competitors which would cause loss in business to the Complainant.

23. Besides, the Complainant would have no hold on the Respondent's disputed domain name usage and would always suffer by the transfer of traffic to the other website through the redirecting links displayed on the website. Also, since the Respondent is using the trademarks of the Complainant, the Complainant's goodwill and reputation would be left in the hands of the Respondent or a third party over whom the Complainant would have no control. **[See Baker Hughes Limited Vs Hiroo Khushalani 1998 (18) PTC 580 (Del)]**.

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24. All these violative acts of the Respondent through the disputed domain would perpetually and irreparably not only tarnish the business of the Complainant but also dilute diminish, erode and eclipse the goodwill, reputation and distinctiveness attached to the Complainant's registered and prior adopted and prior in use trade mark STAEDTLER and its official domains. Not only that even the consumers would suffer as they would not get what they expected and instead would be deceived. Consumer deception and loss and injury being caused to the Complainant as well as to the consuming public is inevitable.

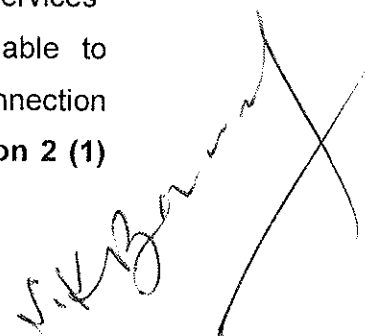
25. In response to the notices issued upon it the Respondent has addressed two E-mails dated 28.04.2018 and 11.05.2018 to this Tribunal wherein the Respondent has pleaded of its selling the STAEDTLER branded goods after purchasing the same from the Complainant's authorized distributor and without claiming any rights in the said STAEDTLER brand and by clearly indicating that all brands and Trade Marks belong to their respective owners. The Respondent vide its E-mail of 11.05.2018 while making an offer to make changes in its website was not willing to transfer the ownership of the website even though in its earlier e-mail of 28.04.2012 it had sought an "offer" from the Complainant as it (Respondent) had invested a lot of money for selling the STAEDTLER brand products online. From the said responses it appears that the Respondent has sought to justify its impugned domain name by claiming to sell the Complainant's STAEDTLER Trade Mark products, by investing money thereon and to have clearly indicated that the Trade Mark rights belong to the respective owners. In my view the case and justification set up by the Respondent is fallacious and is a legal wrong for more than one reasons:-

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25.1. Domain names into and by themselves have a distinct and recognizable legal connotation and identity and on which a successful cause can be based. The Hon'ble Supreme Court in its celebrated decision in Satyam Infoway Ltd. Vs. Sifynet Solution (P) Ltd. 2004 (28) PTC 566 (SC) has observed as under:-

“The original role of a domain name was no doubt to provide an address for computers on the internet. But the internet has development from a mere means of communication to a mode of carrying on commercial activity. With the increase of commercial activity on the internet, a domain name is also used as business identifier. Therefore, the domain name not only serves as an address for internet communication but also identifies the specific internet site. In the commercial field, each domain name owner provides information/services which are associated with such domain name. Thus domain name may pertain to provision of services within the meaning of Section 2(z). A domain name is easy to remember and use, and is chosen as an instrument of commercial enterprise not only because it facilitates the ability of consumers to navigate the Internet to find websites they are looking for, but also at the same time, services to identify and distinguish the business itself, or its goods or services, and to specify its corresponding online internet location. Consequently a domain name as an address must, of necessary, be peculiar and unique and where a domain name is used in connection with a business, the value of maintaining an exclusive identity becomes critical.”

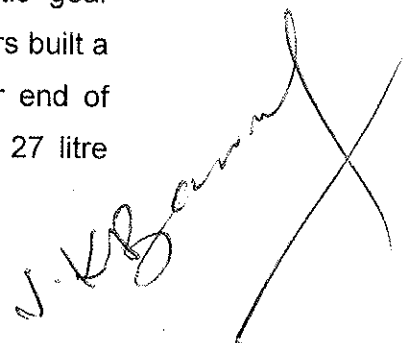
25.2. The Respondents alleged justification further over looks the basic and fundamental difference between trade marks/domain names on the one hand and the goods or services on the other. Trade Marks in gist are words/devices used in relation to goods or services to identify and distinguish such goods or services from a particular source and differentiate them from those of others [Section 2(1) (zb) of the Trade Marks Act]. On the other hand “goods” could be anything that are a subject of trade and manufacture ; while “services” means services of any description which is made available to potential users and includes the provision of services in connection with business of any industrial or commercial matters [Section 2 (1)

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(j) & 2 (1) (z) of the Trade Marks Act]. Trade Marks/Domains and the goods or services in relation to which they are used are two different and distinct concepts. Just because the Respondent may be rendering services (like retailing and selling goods etc.,) pertaining to the Complainant's products under the Complainant's Trade Mark STAEDTLER does not give to the Respondent any entitlement or right over the Complainant's Trade Mark/Domain STAEDTLER. This is more so as it is nobody's case, and nor can it be, that the word/mark STAEDTLER is generic or a descriptor with no secondary significance in relation to the goods and business offered by the Complainant thereunder.

26. Even if it was to be taken for the sake of argument that the Respondent could sell the Complainant's goods under the STAEDTLER Trade Mark after procuring them from the Complainant's authorized dealer, the Respondent cannot in any manner use the Complainant's STAEDTLER Trade Mark/Domain by itself or part of its domain name to create any mental image in the minds of the market and trade suggesting its (Respondent) said business to be of the Complainant or to be associated, sponsored, affiliated or in some way connected with the Complainant or of some relationship to exist between it (the Respondent) and the Complainant and moreso as the Respondent's impugned domain and usage thereunder is without the leave, license and permission of the Complainant.

26.1. In this regard a celebrated judgment in the case of Rolls-Royce Motors Ltd. Vs DODD reported in 1981 Fleet Street Reports 517 can be safely cited. In this case the defendant a Motor Engineer principally concerned with the repair of automatic gear boxes of the kinds used in Rolls-Royce and Bentley Motor Cars built a motor car and whereon, amongst other things on the lower end of each of its car wings incorporated the words "Powered by 27 litre



Rolls-Royce Merlin". In an action brought against it by the Rolls-Royce Motors Ltd. the Defendant asserted that the use of the word Rolls-Royce on the engine and wings thereon merely illustrated the true fact that the car was powered by a Rolls-Royce Merlin Aero Engine and that no injury of any kind or type could be caused or have been caused to the Plaintiff by such use. The Court rejected the defendant's assertions and held that such use by the defendant amounted to a misrepresentation in as much as the Defendant was indicating that he is capable of doing repair work in connection with such a car as Rolls-Royce and that the Defendant is in some way connected with the Plaintiff or responsible to the Plaintiff. This decision was approved and followed by the Hon'ble Delhi High Court in its notable case of Rolls-Royce PLC Vs R.R. Motors P. Ltd. reported in 1997 PTC (17) 60 wherein the Hon'ble High Court restrained the Defendant from using the Plaintiff's Trade Marks being used by the Plaintiff in relation to the motor cars in relation to the Defendant's trading style in connection with the defendant's business of running a motor car repair workshop or garage.

27. Thus having regard to the close similarity of the impugned domain name to the trade mark/domain STAEDTLER and of the goods and business there under the market and trade would definitely take and construe the disputed domain to be an extension or part of the Complainant's domains or in some way related, sponsored, affiliated, associated or connected thereto. Consequently, by the disputed domain and its use whether present or prospective an unjust association would be formed between the Complainant and the Respondent leading to market and consumer deception amounting to mis-representation whereby loss and injury would be and/or potentially can be caused to the Complainant. [See Montari Overseas Ltd., Vs. Montari Industries Ltd., 1996 (16) PTC 142 Del (DB) ; Ravenhead Brick Company Ltd., Vs. Ruaborn Brick & Tera

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Cotta Co. Ltd., (1937) 54 RPC 341 (Ch.D) ; Semigres TM (1979) RPC 330]. The Complainant would have no hold over the Respondent or on the nature of the services being offered by the Respondent and would always suffer by any inferior quality services being offered by the Respondent even if pertaining to the genuine products of the Complainant. The Complainant's goodwill and reputation would be at the mercy of the Respondent.

28. All the aforesaid acts of the Respondent in my considered view clearly establish the Respondent's very adoption of the disputed domain name and its registration with the sponsoring Registrar to be actuated in bad faith, malafide and fraud and of the Respondent to have no legitimate rights and interest in the disputed domain name. This in addition also apparent from the following:-

(a) The Respondent has not furnished any explanation on its adoption of an identical, prior Trade Mark and domain STAEDTLER belonging to the Complainant. This is more so as the Complaint's said STAEDTLER Trade Mark is duly registered under the Trade Marks Act in India as also registered in various overseas countries. The Complainant's said STAEDTER Trade Mark/Domain Name are arbitrary and fanciful Trade Marks in relation to the nature of goods and services been dealt with in the course of trade by the Complainant enjoying noticeable goodwill and reputation with the Complainant and they are all prior to the Respondent's impugned domain

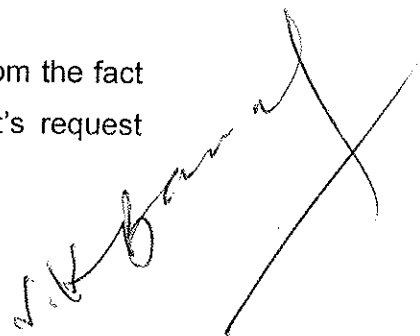
(b) The Respondent was well aware of and ought to be well aware of the Complainant's said STAEDTLER Trade Mark and domain name rights before its alleged adoption and registration with the sponsoring Registrar of the disputed domain in as much as the

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Respondent itself has been selling the Complainant's STAEDTLER products on its website accessible through the impugned domain.

(c) Even in the past the Respondent had adopted and registered with the sponsoring Registrar a domain name staedtlerindia.com. Aggrieved thereby the present Complainant filed a Complaint against this very Respondent before the WIPO Arbitration and Mediation Center under Case No.D2016-1918 titled Staedtler Mars GmbH & Co. KG Versus Suresh Jain and copy whereof is filed as Exhibit-12 with the Complaint . In the said proceedings the Respondent's disputed domain staedtlerindia.com was found to be in bad faith and in violation of the Complainant's rights in the STAEDTLER Trade Mark and accordingly vide the decision dated 14.11.2016 the said disputed domain name was ordered to be transferred to the Complainant by the Panel and which decision has been filed as Exhibit-13 with the Complaint. Despite the said WIPO Panel decision and thereafter the Respondent created the impugned domain name staedtlerindia.in (being the subject matter of the present dispute) on 27.11.2016 and sought its registration with the sponsoring Registrar as per Exhibit-1. The present impugned domain name staedtlerindia.in in each and every respect is identical with the domain staedtlerindia.com except for the TLD. Such an act on the part of the Respondent can only be considered to be a gross abuse and in bad faith of the highest order and in no circumstances can be taken as an acceptable commercial behavior. The Respondent's impugned malafide conduct in adopting and registering with the sponsoring Registrar in its name the disputed domain name staedtlerindia.in despite the decision dated 14.11.2016 wherein its earlier domain of staedtlerindia.com was ordered to be transferred to the Complainant speaks for itself (*res ipsa loquitur*).

(d) The bad faith of the Respondent is also apparent from the fact that the Respondent did not respond to the Complainant's request

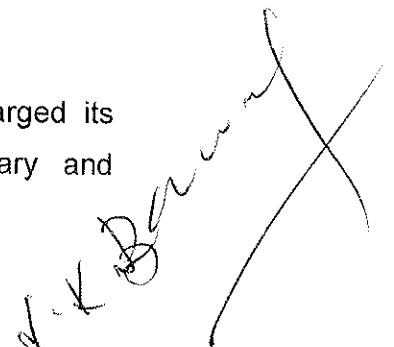


vide letter dated 11.08.2017 as per Exhibit-14 filed with the Complaint to transfer to it the impugned domain and to immediately cease with its use leading to the filing of the present Complaint. Even in the present Complaint proceedings the Respondent only offered to make certain changes in its website without actually transferring it to the Complainant.

(e) On its website accessed through the disputed domain wherein the Respondent is selling the Complainant's said products the Respondent is using thereon a cartoon bearing the name Adolf Hitler and having reference to Adolf Hitler and a screenshot whereof is attached with the Complaint as Exhibit-11. Such a use is extremely offensive and can be deeply distasteful to the Complainant which is a German Company especially as Adolf Hitler is a disgraced, infamous and notorious political figure. Such a usage can potentially be adversely related by the market, trade and public at large to the Complainant, the Complainant's business and trade marks and who would thereby be dissuaded from dealing with the Complainant or its products causing irreparable loss to the Complainant and its standing including to the Complainant's STAEDTLER Trade Mark/Domain.

29. As the Respondent's very adoption of the impugned domain is tainted at inception the Respondent must be held to be aware of the consequences which would ensue from such a malafide and bad faith adoption and/or use and as such its impugned adoption cannot be given any credence even if the Respondent has invested a lot of money in its business of selling the Complainant's STAEDTLER Trade Mark products online [see Hindustan Pencils Pvt.Ltd., Vs. India Stationery Products 1989 PTC 61 (Del)]

30. In my considered view the Complainant has discharged its onus/burden of proof and has established its proprietary and



enforceable rights in its trade mark/domains STAEDTLER and which have been violated by the impugned domain. The Respondent has neither traversed nor challenged the Complaint facts against it. Such a non-traverse has to be taken against the Respondent **[Uttam Singh Dugal & Company Limited V/s Union Bank of India & Ors – reported in AIR 2000 SC 2740].**

31. Trade Marks, trade names and domains have been accepted to be valuable business assets to be protected against their wrongful adoption and use as rival domains and such violations have to be removed in the interest of the right holder and consumers swiftly and effectively.

32. I have no reservation in holding that the Complaint must be allowed.

Accordingly it is decided that the disputed domain name www.staedtlerindia.in be transferred to the Complainant.

Signed at New Delhi, India on this 11th day of June, 2018.


Sudarshan Kumar Bansal
Sole Arbitrator