

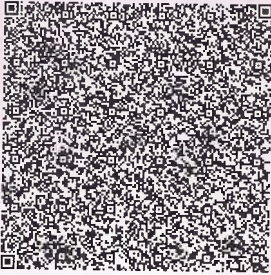


सत्यमेव जयते

INDIA NON JUDICIAL Chandigarh Administration

e-Stamp

Certificate No. : IN-CH15408194698073Q
Certificate Issued Date : 17-Dec-2018 05:06 PM
Certificate Issued By : chvandani
Account Reference : IMPACC (GV)/ chimpsp07/ E-SMP MANIMAJRA/ CH-CH
Unique Doc. Reference : SUBIN-CHCHIMPSP0730772212490077Q
Purchased by : MOHIT
Description of Document : Article 12 Award
Property Description : ASHWINIE KUMAR BANSAL ARBITRATOR
Consideration Price (Rs.) : 0
(Zero)
First Party : TIGER COATING GMBH AND CO KG
Second Party : SUNNY KHAKSE AND ANR
Stamp Duty Paid By : TIGER COATING GMBH AND CO KG
Stamp Duty Amount(Rs.) : 100
(One Hundred only)



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ARBITRATION AWARD

(On Stamp Paper)

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TQ 0010916285

Statutory Alert:

1. The authenticity of this Stamp Certificate should be verified at "www.shcilestamp.com". Any discrepancy in the details on this Certificate and as available on the website renders it invalid.
2. The onus of checking the legitimacy is on the users of the certificate.
3. In case of any discrepancy please inform the Competent Authority.

INDRP ARBITRATION
THE NATIONAL INTERNET EXCHANGE OF INDIA [NIXI]

ARBITRAL TRIBUNAL CONSISTING OF
SOLE ARBITRATOR:
DR. ASHWINIE KUMAR BANSAL, L.L.B; Ph.D.
ADVOCATE, PUNJAB & HARYANA HIGH COURT,
CHANDIGARH

In the matter of:

Tiger Coatings GmbH & Co. KG Negrellistrasse 36, 4600, Wels,
Austria **...Complainant**

VERSUS

1. Sunny Khakse, Orbital Empire, Jaitala, Nagpur, Maharashtra-440036
Email: khakse.sunny@gmail.com, Phone: 8446212878

2. Shri. Sharad Dhariya, S. D. Biochemicals Co., 18, Ayurvedic College Lay
Out, Opposite Sakkardara Lake, Nagpur, Maharashtra- 440024
Email: Support@TigerBrand.in

...Respondents

REGARDING: DISPUTED DOMAIN NAME: TIGERBRAND.IN

1. The Parties:

Complainant:

Tiger Coatings GmbH & Co. KG Negrellistrasse 36, 4600, Wels, Austria

Respondents:

- 1) Sunny Khakse, Orbital Empire, Jaitala, Nagpur, Maharashtra-440036
Email: khakse.sunny@gmail.com, Phone: 8446212878

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2) Shri. Sharad Dhariya, S. D. Biochemicals Co., 18, Ayurvedic College
Lay Out, Opposite Sakkardara Lake, Nagpur, Maharashtra- 440024
Email: Support@TigerBrand.in

2. The Domain Name and the Registrar:

The disputed domain name <tigerbrand.in> is registered with GoDaddy.com, LLC. 14455 North Hayden Road, Suite 219, Scottsdale, AZ 85260, United States (the "Registrar").

3. Procedural History [Arbitration Proceedings]

A Complaint has been filed with the National Internet Exchange of India (NIXI). The Complainant has made the Registrar verification in connection with the disputed domain name <tigerbrand.in>. It is confirmed that at present the Respondent No. 1 is listed as the Registrant and provided the administrative details for administrative, billing and technical contact. NIXI appointed Dr. Ashwinie Kumar Bansal, Advocate, as the sole arbitrator in this matter. The Arbitrator has submitted his Statement of Acceptance and Declaration of Impartiality and Independence, as required by NIXI.

NIXI has intimated that it had sent the Complaint with Annexures by E-mail as well as courier to the Respondents as mentioned in the INDRP complaint. Receipt/Confirmation of the delivery from the courier has also been forwarded by the .IN Registry.

The Respondent No. 1 and 2 had filed their respective response to the Complaint. The Complainant had also filed the rejoinder to the Reply of Respondent No. 2.

Respondent No. 2 through his counsel had filed Preliminary Objections dated 29.10.2018 vide e-mail dated 29.10.2018 as well as by post. The Complainant had also filed reply to the preliminary objections.

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4. Factual Background

The Complainant Tiger Coatings GmbH & Co. KG. was founded in early 1930s in Austria for producing oil-based paints and plaster putties and thinners. The Complainant is an internationally operating enterprise, and a manufacturer of paints, varnishes and powder coatings. The Complainant adopted the Trademark TIGER in the year 1934 for the specified goods and he is using the same since then. The Complainant's Trademark has been extensively advertised in respect of paints, varnishes and powder coatings worldwide.

The Respondent No. 1 has registered the disputed domain name on 25.06.2014 and Respondent No. 2 has been using the disputed domain name. Hence, the present Complaint has been filed by the Complainant against the Respondents.

5. Parties Contentions

A. Complainant:

The Complainant has filed the complaint which is reproduced below:

"[9.] This Complaint is based on the following grounds:
The present Complaint is instituted on account of misappropriation of the Complainant's well know trade mark "TIGER" by the Respondent by using it as a part of its domain name.

Factual Background of the Complainant:

[10.] The Complainant, Tiger Coatings GmbH & Co. KG, commonly referred to as Tiger Coatings, was founded in early 1930's in Austria for producing oil-based paints and plaster putties and thinners. The Complainant honestly and bonafidely adopted the trade mark "TIGER" in the year 1934 for the specified goods and is using the mark since then openly, continuously and extensively, without any interruption from any corner in the world. "TIGER" is not only the trade name but also the corporate name of the Complainant "Tiger Coatings GmbH & Co. KG". The Complainant's trademark has been

extensively advertised in respect of paints, varnishes and powder coatings worldwide.

[11.] The Complainant is a pioneer in the business of the variety of goods falling under "Class-2" as per the International (NICE) Classification. The Complainant is a world-renowned manufacturer of colors, lacquers, thinners, paints, sealants, primers and similar products. The Complainant has been one of the first companies to enter the field of powder coating technology and is ranked amongst the top companies worldwide today.

[12.] The Complainant is the registered proprietor and / or the user of the trademarks "TIGER" and "TIGER DRYLAC" in connection with the aforesaid goods falling under "Class 2" in more than thirty-four countries around the world since 1930's including India. Details of the trademark filed in India are as under:

Trademark No.	Trademark	Date of Filing	Goods details
698150	TIGER	12/02/1996	PAINTS AND VARNISHES.
698151	TIGER-DRYLAC	12/02/1996	PAINTS AND POWDER COATINGS.

[13.] The Complainant apart from having the common law right in the trademark "TIGER", also holds statutory rights in the same. It is submitted that the Complainant is the registered proprietor of the trademark "TIGER" in several countries of the world including but not limited to Algeria, Armenia, Austria, Bosnia and Herzegovina, Belarus, Switzerland, Chile, Colombia, Croatia, Egypt, Kazakhstan, Kenya, Kyrgyzstan, Malaysia, Mexico, Morocco, Monaco, Republic of Moldova, Montenegro, Philippines, Serbia, Russian Federation, Ukraine, Vietnam, Australia, European Community, **India**, Indonesia, Iran, Israel, Japan, Norway, Singapore, South Africa, Taiwan, Tajikistan, Tunisia, Uzbekistan and Turkey under Madrid Protocol. Copies of the registration certificates of trademark "TIGER" are annexed as **Annexure No. 3**.

[14.] The Complainant has built up a distribution network placing itself in the world's top companies in the field of powder coating technology. The Complainant's network is spread across several countries including but not limited to Belarus, Bosnia & Herzegovina, Bulgaria and Romania, Germany, **India**, Croatia, Latvia / Lithuania, Netherlands, Poland, Russia, Switzerland, Serbia

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and Montenegro, Slovenia, Spain, South Africa, Taiwan, Thailand, Ukraine.

[15.] That the Complainant is extremely vigilant when it comes to protection of its trademark in order to prevent the same from becoming generic in nature or getting diluted. Protection of the trademark extends beyond registration activities to enforcement actions, which ranges from opposing trademark applications for the same or similar marks; sending cease and desist letters to infringers of Complainant's trademarks and commencement of legal action, in a court of law, if necessary. Complainant has been successful in taking action against similar and deceptive domain names at UDRP. The domains names against which successful actions taken are:

- In February 2012 vs domain www.tigercoating.com (owner in these days: Mr. Prem Gandhi M.D. Karnal Haryana 132001, India), UDRP Case no.: D2012-0322. As a result of these proceedings, the domain was transferred to the Complainant on 03.04.2012. Case details have been attached as **Annexure No. 4.**
- On 29 October 2012 vs domain www.tigerpaintcoating.com (owner in these days: Vikilinks S C O 21 Mughal Canal, Contact: Mr. Prem Gandhi M.D. Karnal, India), UDRP Case Number D2012-2140. As a result of these proceedings, the domain was transferred to the Complainant on 29.11.2012. Case details have been attached as **Annexure No. 5.**
- On 21.01.2016 vs domain www.tigerpaintcambodia.com (owner in these days: Mr. Kruey Huy Leant /tiger Paint Auto colors, No. 29 Street 207, Phnom Penh, Cambodia), UDRP Case No. D2016-0076. The domain was deleted by the owner and is actually not registered. Case details have been attached as **Annexure No. 6.**

[16.] That by virtue of extensive use and high quality product sold under the mark "TIGER" the Complainant's company "Tiger Coating" has been awarded as "Austria's best professionally managed and family owned company 2014". The Complainant also received the title of "Hidden Champion 3.0" from the Austrian Chambers of Commerce. Recently, the R&D partner of the Complainant has also been awarded with prestigious SURFACE 2015 by Germany's widely respected Fraunhofer Institute for Manufacturing Engineering and Automation (IPA).

[17.] That both the marks "TIGER" and "TIGER DRYLAC" are distinctive to the Complainant's goods alone and the goods distributed under these trademarks have a large-scale sale globally, including in India. By virtue of the said sale and wide advertisements, the trademarks have acquired enviable goodwill and reputation in respect of the goods mentioned above in India as well as abroad. Based on annual sale of the Complainant in the 2017 of around 335.5 million the Complainant has been ranked 44 in the world by the Coatings World Magazine. The details of the said

fact are available on the link https://www.coatingsworld.com/issues/2017-07-01/view_features/2017-global-rankings-of-the-top-manufacturers-of-paints-coatings-adhesives-and-sealants. Copy of the said page is annexed as **Annexure No. 7**.

A. The domain name(s) is confusingly similar to a trademark or service mark in which the Complainant has rights;

(As per INDRP Rules of Procedure, Paragraph 4(i))

[18.] The Complainant owns the trade mark "TIGER". TIGER is not a descriptive word and has also attained distinctiveness over a period of time. The word TIGER is derived the corporate name of the Complainant which was founded as Tigerwerk Lack-u. Farbenfabrik GmbH & Co. KG which was founded and then was later on changed to Tiger Coatings GmbH & Co. KG. General Public associates the said mark with good and efficient products provided by the Complainant. The Complainant is one of the largest manufacturers with respect of paints, varnishes and powder coatings worldwide. The Respondent being aware about the reputation of "TIGER", still registered the domain name www.tigerbrand.in

[19.] It is submitted that the Respondent's Domain name www.tigerbrand.in is confusingly similar to the well-known trademark of the Complainant, "TIGER". The Complainant has overwhelming common law as well as statutory rights in his trade mark "TIGER". Therefore, the Complainant is the sole legitimate owner of the trade mark "TIGER". Use by the Respondent of the "TIGER" trade mark in the disputed domain name is bound to induce the members of the public and the trade to believe that the Respondent has a trade connection, association, relationship or approval with/of the Complainant. Further, the use of the confusingly similar domain name by the Respondent is also resulting in financial losses to the Complainant since the public consider that the said domain name is either sponsored by or affiliated to the Complainant. It is further submitted that the domain name of the Respondent www.tigerbrand.in is confusingly similar to the trade mark of the Complainant on the additional ground that it merely uses the trademark of the Complainant along with a generic word "brand" (Refer: WIPRO Limited v. Igarashi, Katsuhisa, WIPO Case No. D2013-0073, <http://www.wipo.int/amc/en/domains/search/text.jsp?case=D2013-0073>) It is also submitted that on the question of identity or confusing similarity, a comparison and assessment of the disputed domain name to the Complainant's proved trademarks is only required and nothing more needs to be proved. (Refer to: Disney Enterprises, Inc. v.

John Zuccarini, Cupcake City and Cupcake Patrol, WIPO Case No. D2001-0489, <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0489.html>; IKB Deutsche Industriebank AG v. Bob Larkin, WIPO Case No. D2002-0420, <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0420.html>). In undertaking that comparison, in the present circumstances it is permissible to disregard the ".com" component of the disputed domain name as a functional aspect of the domain name system (Refer: Telstra Corporation Limited v. OzurIs, WIPO Case No. D2001-0046, <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0046.html>; Ticketmaster Corporation v. Discover Net Inc., WIPO Case No. D2001-0252, <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0252.html>).

[20.] Therefore, the domain name www.tigerbrand.in is confusingly similar to trade mark "TIGER" in which the Complainant has rights.

B. The Respondent has no rights or legitimate interests in respect of the domain name(s):

(As per INDRP Rules of Procedure, Paragraph 4(ii); Paragraph 7(i), (ii) and (iii).)

It is the Complainant's contention that the Respondent has no rights/legitimate interest in the domain name www.tigerbrand.in for the following reasons:

- The Complainant has not licensed or otherwise permitted the Respondent to use its trademark "**TIGER**" or to apply for any domain name incorporating the said trade/service mark (Refer: Guerlain S.A. v. HI Investments, WIPO Case No. D2000-0494, <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0494.html>).
- It is further stated that there could be no plausible explanation for use of the domain name www.tigerbrand.in by the Respondent. The Respondent is using the impugned domain name for illegitimate commercial purposes with the intent to misleadingly divert the customers by tarnishing the trade mark "**TIGER**".
- The Respondent has also not been the prior user in respect of the trade/service mark "**TIGER**". Thus on this ground alone the Respondent should be taken to have no rights or legitimate interests in respect of the domain name. Moreover, the Respondent cannot establish his rights over the use of the trade/service mark of the Complainant as being his name. Therefore, the Respondent should be stalled on this ground.

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- On the premise that the trade/service mark **"TIGER"** is an arbitrary mark and is an inherently distinctive mark, it is further submitted that the Respondent's use of the same cannot prove its rights or legitimate interest over the domain name. The Respondent has trying to pass his goods in the guise of the trademark of the Complainant (Refer: WIPRO Limited v. Igarashi, Katsuhisa, WIPO Case No. D2013-0073, <http://www.wipo.int/amc/en/domains/search/text.jsp?case=D2013-0073>).

- It is also submitted that it is incumbent on the Complainant to only build a prima facie case under this head. The burden of proof only rests upon the Respondent to rebut the prima facie case (Refer: Shandong Lingong Construction Machinery Co., Ltd. v. Stanley Pace and Whois Privacy Service Pty Ltd., WIPO Case No. D2012-1626, <http://www.wipo.int/amc/en/domains/search/text.jsp?case=d2012-1626>).

C. The domain name(s) was/were registered and is/are being used in bad faith.

(Policy, paragraphs 4(a)(iii), 4(b); Rules, paragraph 3(b)(ix)(3))

[21.]The domain name www.tigerbrand.in was registered by the Respondent in bad faith for the following reasons:

- The Complainant has not licensed or otherwise permitted the Respondent to use its trade/service mark **"TIGER"** or to apply for any domain name incorporating the said trade/service mark (Refer: Guerlain S.A. v. H I Investments, WIPO Case No. D2000-0494, <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0494.html>).

- It is further stated that there could be no plausible explanation for use of the domain name www.tigerbrand.in by the Respondent. The Respondent is using the impugned domain name for illegitimate commercial purposes with the intent to misleadingly divert the customers by tarnishing the trade mark **"TIGER"**.

- The Respondent has also not been the prior user in respect of the trade/service mark **"TIGER"**. Thus on this ground alone the Respondent should be taken to have no rights or legitimate interests in respect of the domain name. Moreover, the Complainant filed an opposition proceeding against Respondent trademark **"REDUCER TIGER BRAND"** on April 7, 2014 and **"TIGER BRAND"** on March 3, 2018, which are still at proceeding stage. The Respondent in order to establish its right in the mark very cleverly registered the disputed domain name on June 14, 2014. Therefore, the Respondent cannot claim to be the honest adopter of the domain name. The Respondent in order to establish his rights over the use of the trademark of the Complainant as

being his name is taking such fraudulent means. Therefore, the bad faith of the Respondent has been established and the Respondent should be stalled on this ground.

- On the premise that the trade/service mark "**TIGER**" is an arbitrary word for the paints and related goods, it is further submitted that the Respondent's use of the same cannot prove its rights or legitimate interest over the domain name. The Respondent has trying to pass his services in the guise of the trade/service mark of the Complainant (Refer: WIPRO Limited v. Igarashi, Katsuhisa, WIPO Case No. D2013-0073, <http://www.wipo.int/amc/en/domains/search/text.jsp?case=D2013-0073>).

- It is also submitted that it is incumbent on the Complainant to only build a prima facie case under this head. The burden of proof only rests upon the Respondent to rebut the prima facie case (Refer: Shandong Lingong Construction Machinery Co., Ltd. v. Stanley Pace and Whois Privacy Service Pty Ltd., WIPO Case No. D2012-1626, <http://www.wipo.int/amc/en/domains/search/text.jsp?case=d2012-1626>).

- It is further submitted that legitimate use of a domain name under the policy must be non-infringing use. Where, as here, Respondent is using a famous mark as a domain name it constitutes non-legitimate infringing use since it has the effect of attracting the public to Respondent's website by trading on the trademark owner's goodwill (Refer: Chanel, Inc. v. Estco Technology Group, WIPO Case No. D2000-0413, <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0413.html>).

- Therefore, the Respondent has no rights/ legitimate interest in respect of the domain name www.tigerbrand.in.

[22.]The effect of the domain name registration www.tigerbrand.in is that consumers looking for Complainant are misdirected to Respondent's website and that Respondent obtains a commercial advantage from using Complainant's trademark. Having attracted consumers to its website by causing confusion with Complainant. As such, Respondent is siphoning off the goodwill in the TIGER name for its own commercial benefit. This constitutes bad faith (Refer: Chanel, Inc. v. Estco Technology Group, WIPO Case No. D2000-0413, <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0413.html>).

[23.]Therefore, the domain name www.tigerbrand.in was registered in bad faith."

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B. Respondents:

Respondent No. 1 has sent his Response vide his E-mail dated 07.12.2018 that he is not interested in the disputed domain name and he is not going to renew this domain name. But subsequently he had sent another email on 16.12.2018 clarifying his stand that the dispute domain name belongs to the Respondent no. 2.

The Respondent No. 2 has filed Preliminary Objections dated 29.10.2018 through his counsel and subsequently he had filed a detailed reply which reproduced below:

"1. That this respondent has already filed preliminary objection to the complaint on the grounds of delay. Same was copied in the email to the complainant as also to the .IN registry. It may kindly be noted that since there occurred a spell off in the email address of Hon'ble arbitrator the mail bounced back and therefore to avoid any confusion preliminary objection copy was sent at "AKBLEX@GMAIL.COM". Screen shot of service and copies to the complainant are attached herewith for kind perusal of this tribunal as ANNEXURE R1.

2. It is further stated that, given this respondent has raised preliminary objection over the issue of delay, which if upheld, defeats any right whatsoever created in favour of the complainant, it would have been in interest of justice to examine that aspect first.

3. However in view of the order of this tribunal to submit reply on merit, and in view of the email order dated 12.10.2018 rejecting request for one weeks time to submit reply, without prejudice to preliminary objection, following reply to the complaint is being presented as under.

4. That the complainant has filed mischievous complaint only with intent to harass this respondent. There is no substance whatsoever in the complaint and therefore deserves to be rejected out rightly.

5. That all the contents of the complaint are denied in totality, if not specifically admitted henceforth.

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PARAWISE RESPONSE

6. As to para.1, it is stated that it would be subject matter of argument and contest as to whether the complaint of the complainant is in accordance with the referred policy or not. Rest of the portion does not require any further comments.

7. As to para 2, it is denied that from the date of inception, complainant became an internationally operating enterprise. The claim of the complainant is contrary to the information provided on their own website. A bare perusal of their website will rather show that they started their first marketing unit in Canada only after year 1984. It is their own claim that they entered the Asia only in year 1996. However there is no information as to when they started their business in India with their alleged brand name. Therefore the claim of the complainant that they became international enterprise is a misleading attempt to create an impression that they were transacting in India from the inception itself. It is denied that there is any advertising with respect to tiger with respect to paints, varnishes and powder coating. There is nothing brought on records to show that there is any such advertising done by the complainant, and therefore claim of the complainant is baseless. It is denied that the complainant has any legal right over the brand name. It is further stated that complainant has mischievously registered atleast 4 domains with respect to India. It is evident from the fact that all four domain

names have been created on 05.04.2012 which is much after registration of the subject matter domain name by this respondent. This again goes onto show that complainant is trying to mislead and create false impression with respect to his illegal use of the subject matter domain name.

8. Para 3 & 4 warrant no comment.

9. With respect to para 5, it is denied that subject matter domain name is registered on June 25, 2014. On the contrary it is submitted that, this respondent purchased the domain name tigerbrand way back in year 2011, i.e on 18.07.2011. an order summary of the same is attached herewith for kind perusal of this tribunal as annexure R-2. It is admitted that this respondent is owner of the subject matter domain name.

10. Para 6 warrants no reply.

11. With respect to para 7, it is reiterated that domain name has been purchased on 18.07.2011 and complainant is trying to mislead the tribunal by showing incorrect records.

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12. Para 8, calls for no comment.

13. With respect to para 9, it is denied that this respondent has ever misappropriated the trade mark of the complainant in any manner. On the contrary it is charged that, Complainant with fraudulent intentions to harass this respondent and burden him financially has filed this complaint.

14. With respect to para 10, it being repetition of the same contents as that of 2 of the complaint and hence reply there under may be read as reply to this para aswell.

15. With respect to para 11, it is denied that complainant is pioneer in the business. On the contrary it is stated that this respondent is pioneer in the business of Turpentine, Thinner and Varnishes, and therefore claim of the complainant is baseless, false and misleading. It is also stated that, respondents product is household name in Indian market, and is first choice of people in the category. It is further added that complainant might be one of the first companies to enter in this business, but that pertains to its country of origin which is Austria. With respect to Indian market its entry is much new and recent and therefore with intent to misguide and mislead this tribunal complainant has purposefully avoided to mention the relevant details and has supplied misleading details.

16. With respect to para 12, contents are denied for want of information. However it is stated that this respondents registration of trademark "*tiger brand*" with Indian authority dates back to 23.02.1988. which is much prior to even entry of the complainant in India. A copy of the registration is attached hereto and marked as ANNEXURE R 3 for kind perusal of this authority.

17. With respect to para 13, it is denied that complainant has any right over the name tiger. Having registration in other countries is of no consequences in this matter.

18. With respect to para 14, contents are denied for the want of knowledge. In any case the information therein is of no consequences in this matter.

19. With respect to para 15, it is denied that complainant is vigilant. On the contrary it is stated that complaint with the help of money power has been initiating various fraudulent litigations and is harassing domestic businessman/ industries to unethically engulf their goodwill. The description given in para 15 of the various complaints filed and litigation taken out substantiate that complainant is trying to create

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monopoly in the business of paints and with malafide intention to outrun small players in playing legal tactics.

20. With respect to para 16, it is denied for want of information that complainant has received any award. Even if it is admitted for the sake of argument, it is clear that those awards are received in Austria and Germany which are of no consequences in this matter. On the contrary it is stated that this respondent has also been honoured by various entities for its quality of products.

21. With respect to para 17, it is stated that, global business of the complainant is of no value in Indian market. In Indian market and particularly in certain parts of Maharashtra, respondents product makes Competitive business. Rests of the contentions are denied for want authentic information.

22. With respect to para 18, all the contentions are denied. It is stated that even before complainant entered in Indian market, and was stranger to Indians, this respondent had established its business and obtained trademark of tiger brand. Rest of the contentions are denied since they are devoid of merit.

23. With respect to para 19, all the allegations and contentions of the complainant are denied, for they are baseless and misleading. Complainant is trying to malafidely exploit goodwill of this respondent by trying to obtain the domain name.

24. With respect to para 20, it is denied that complainant has any absolute right over the name tiger.

25. With respect to para B, it is stated that none of the contentions raised in bullet 1 to 5 has any substance in it. It is stated that respondent has been genuinely using this domain name and brand name since long. Respondent has been conducting business under this name since 5 decades. This respondent is much prior user of the name and therefore also complainant has not right over the said name.

26. With respect to para C it is denied that domain name is being used in bad faith.

27. With respect to bullets under 21, it is stated that, it is repetition of para B and hence reply there under be considered as reply to this para as well.

28. With respect to para 22, it is denied for want of any such information. Rather it is stated that this respondent has its distinct

customers and they know the brand of respondent owing to trust since decades.

29. With respect to para 23, it is denied that there is any bad faith in registration of domain. It is reiterated that this respondent for his bonafide reasons and has been using it for his legitimate business, which he has been conducting since 5 decades.

30. With respect to para 24, 25, 25, 26, 27, 28 no comments are required.

THAT IN ADDITION TO ABOVE FOLLOWING IS STATED FOR EFFECTIVE ADJUDICATION.

31. It is stated that, the Respondent No.1 is the agent of the Respondent No.2 who was assigned with task of maintaining the subject matter website of the Respondent No.2, his interest in the domain is limited to execute the orders of this respondent and does not have independent right over the same.

32. This Respondent, started his business of marketing paints, way back in year 1977. He began his own industrial unit in year 1988. Respondent owns great amount of good will and business on its brand name tiger brand. It has been its prime product and a popular choice since long time. A certificate of registration of the respondent is attached hereto and marked as ANNEXURE R-4 for kind reliance of this tribunal.

33. That the Respondent no.2 owns duly registered entity, carries out genuine business, has been running its business successfully since over 50 years. Products of this respondent are household name in many parts of India. Respondent has Annual turn-over in crores. Respondent has also legally registered the "TIGERBRAND" as its trademark way back in year 1988.

34. Though business of Respondent with respect to its product "TIGERBRAND" was restricted to Nagpur alone at the commencement; quality and result of his products made it very famous in short period.

35. This respondent has been spending a sizeable amount of revenue for advertisement and marketing of his product under brand name "tigerbrand" and has developed his business over period of time.

36. The registered office of the respondent is at 18, Ayurvedic college Lay out, appo. Sakkardara lake 'Tiger House', Nagpur 440024.

37. Respondents have all legal documents to prove that they have been transacting with this brand name since about 50 years. Apart from this Respondents also have records to show, tax returns, various registrations, licenses and certificates obtained from statutory authorities from time to time.

38. There is no any evidence brought on records, by the complaint as provided under para 6 of the Dispute Resolution Policy."

6. **Discussion and Findings**

The INDRP was designed as a fast, efficient mechanism for the resolution of clear-cut cases of cybersquatting. It operates on the basis of an abbreviated record, affords no opportunity for discovery or in-person pleadings, and is conducted on a comparatively rapid schedule. INDRP panels are, therefore, not capable of deciding disputes which involve a "weighing" of respective trademark rights. Nor are they competent to "look behind" a trademark granted by a national authority to question or re-assess its validity. Similar observations have been made regarding UDRP matters in WIPO Case No. D2013-0570 (Mubadala Trade Marks Holding Company, LLC, Al Yah Satellite Communications Company PrJSC, and Al Maisan Satellite Communications Company, LLC v. Emedia Development Ltd. and Whois Privacy Services Pty Ltd).

Status of Respondent no.2:

The Arbitrator had sought a clarification from the parties vide his e-mail dated 14.12.2018 regarding status of Respondent no.2 which has been clarified by the parties in their e-mails reproduced below.

In response to e-mail from the Arbitrator, the Respondent no.1 has submitted through his e-mail dated 16.12.2018 as under:

"Dear Mr. Ashwinie Kumar Bansal,

Please understand that I am a layman and do not understand the legal language or implications. I did not follow the actual purpose of

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this complaint, all I could understand was that the domain name (tigerbrand.in) which was registered for S D Bio Chemicals Co (Prop. Capt. Sharad Dhariya) and the same is being demanded by Tiger Coatings GMBH & Co KG.

Owing to the consistent notices coming from various modes such as email, WhatsApp & by post, etc I got worried and therefore out of tension & or confusion I had replied by sending an email on the 7th of December of 2018. Consider that email as void and consider this email on record. Also clarifying that the domain name www.tigerbrand.in is owned by S D Bio Chemicals Co (Prop. Capt. Sharad Dhariya) and that the domain name was registered by Vivasoft (IT Support Co.) and therefore it is clarified that the said S D Bio Chemicals Co (Prop. Capt. Sharad Dhariya) is the owner of the domain (www.tigerbrand.in) and they have already renewed the domain name on 25/09/2018 by paying the fees till 25/06/2021.

I can't bear this litigation tension and therefore I will transfer the domain name to its owner S D Bio Chemicals Co (Prop. Capt. Sharad Dhariya). This being the situation you are requested to stop sending me the personal notices, email, WhatsApp, etc and you may directly approach S D Bio Chemicals Co (Prop. Capt. Sharad Dhariya).

Kindly accept above said my request and delete my name from the email thread."

In response to e-mail from the Arbitrator, the Counsel for the Respondent no.2 has submitted through his e-mail dated 16.12.2018 as under:

"Hon'ble sir,

In response to your query, dated 14th Dec 2018, i have this short submission to make, while I pray for time of 1 week to file detailed reply with necessary documents in the best interest of justice.

Owing to paucity of time and unavailability of certain documents at the moment i am unable to detail on this query, beyond what is stated hereinunder:

1. I admit that, the policy indeed recognises registrant as "holder" of domain, however very term deployed i.e. "holder" capsulates in itself possessor of the domain name. Which squarely covers this respondent no.2. Meaning of this term has been given by Google itself to include possessor. At the same time any legal dictionary will support this meaning and decreeing it otherwise would result in utter fallacy.

2. Very purpose, term "holder" is deployed in the definition, instead of "owner" or "in whose name" domain registered, itself makes it clear that definition is inclusive and not exhaustive. It recognises the fact that in indian parlance people tend to delegate work to tech support agencies for registering and maintaining their domains. Which is exactly what is the admitted case is here. Therefore the holder has to be read as one who is in possession of the domain name, and his right is therefore recognised by the subject matter policy, for it is matter of equity.

3. Defining registrant to be the person who registered or in whose name it is registered would have been a different scenario altogether, which would have made some impact on the case in hand but as stated earlier "holder" will include everyone who is possessing, or commissioning, the subject matter in any legal capacity.

4. Term "holder" has been interpreted by various constitutional courts in catena of judgments. More importantly it can be deduced from very section 2 (3) of code of civil procedure wherein decree holder is defined to be one "in whose favour" decree is passed.(Emphasis be noted). We are aware that within civil procedure a lis can be initiated by an agent, however that does not give right to the agent itself to claim fruits of decree but to the person in whose interest matter is adjudicated. That makes it abundantly clear that mere registration of domain by an agent will not create equity in that persons favour but equity in favour of person who causes it to be registered and possesses the same for his own use, utility and transacts business.

5. Very importantly, It is not the case of complainant that respondent no.2 is not in possession of the domain name. Rather his very case has been against respondent no.2 that he is transacting from said domain. Therefore the issue raised is without any occasion and not raised by complainant at all, even till now. Therefore does not deserve any consideration or mileage.

6. Respondent no.1 has written to your honour explaining vide his mail dated 16.12.2018 his pitiful position where under he gave his two liner reply Dated 07.12.2018. This goes in very roots of the issue, and makes the issue under reply absolutely irrelevant, redundant. For the very reasons that he has explained to what extent his interest in the subject matter domain is concerned.

7. It will be important to note that all other disputes raised by complainant are without any basis for it is not at all conducting any business in india, and it has not provided any proof of any tax paid to government of india for his alleged business, therefore its claim

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of having its rights recognised are baseless, illegal and without any virtue.

8. In this peculiar situation and more so issue of delay in initiating this proceedings itself is objected by client, creates an exceptional situation and therefore it will be wiser and in interest of justice to hear the counsel for parties over all the issues in totality. If this tribunal grants oral hearing/audience in that situation I would prefer not to seek 1 weeks time to further on the issue, as prayed for at the threshold.

9. It is also submitted that it would be in fitness of things, justice and issue that preliminary objection as raised by my client is adjudicated first, and then issue of merit is gone into. So that it will give fair opportunity to respondent no.2 to take appropriate steps in pursuance of the decision of this tribunal on delay."

In response to e-mail from the Arbitrator, the Counsel for the Complainant has submitted through his e-mail dated 17.12.2018 as under:

"Dear Sir,

In response to your query, we will like to bring to your notice that Respondent No. 2 was made party to the Domain Name Dispute on the ground that the same is the founder of the firm S. D. Biochemicals as reflected on the website "tigerbrand.in", which is trading via the said domain name. Further, it is pertinent to mention that the Respondent No. 2 is the Applicant of the trademark "TIGER BRAND" being used on the website "tigerbrand.in", which is deceptively similar to the Complainant's trademark as well as the domain names.

Further, it is most humbly left to the consideration of the Hon'ble Arbitrator whether the Respondent No.2 is eligible to raise objections in the said domain name dispute or not, as the averment made by Respondent No. 2 of existence of relation of agency with Respondent No.1 has not yet been proved."

Preliminary Objection by the Respondent No. 2:

The Respondent No. 2 has filed Preliminary Objections dated 29.10.2018. The Complainant has denied the averments made by the Respondent No. 2 in his Reply to Preliminary Objections.

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The Respondent no.2 has submitted that complaint is barred by the limitation. The Respondent had registered the website on 18.07.2011 under the disputed dominion whereas complaint dated 27.08.2018 has been filed after a long delay. The disputed domain name was registered on 25.06.2014 and not on 18.07.2011. Hence question of raising objection in 2012 did not arise as stated by the Respondent No. 2. The Complaint can be filed after registration of disputed domain name comes into notice of complainant. The Respondent No. 2 has failed to produce any evidence that the Complainant had the notice of registration of the disputed domain name. Hence, there is no force in the preliminary objection in the absence of any evidence to support the averments.

On Merit:

It is an incumbent on the Complainant to make out its case in all respects under Paragraph 4 of the Policy, which sets out the three elements that must be present for the proceeding to be brought against the Respondent, which the Complainant must prove to obtain a requested remedy. It provides as follows:

"4. Types of Disputes

Any Person who considers that a registered domain name conflicts with his legitimate rights or interests may file a Complaint to the .IN Registry on the following premises:

(i) the Registrant's domain name is identical or confusingly similar to a name, Trademark or service mark in which the Complainant has rights;

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

(iii) the Registrant's domain name has been registered or is being used in bad faith.

The Registrant is required to submit to a mandatory Arbitration proceeding in the event that a Complainant files a Complaint to the .IN Registry, in compliance with this Policy and Rules thereunder."

The Arbitrator will address the three aspects of the Policy listed above.

A. Identical or Confusingly Similar

The Complainant had made application for registration of Trademark TIGER on 12.02.1996 and Registrar of Trademarks, Govt. of India had given the certificate of registration on 22.02.2005. The Complainant had also made application for registration of Trademark TIGER-DRYLAC on 12.02.1996 and Registrar of Trademarks, Govt. of India had given the certificate of registration on 24.08.2005. The Trademark of the Complainant is also registered in many other countries prior to registration in India. Hence, the Complainant is owner of Trademarks TIGER and TIGER-DRYLAC.

The Respondent No. 1 had adopted the disputed domain name <tigerbrand.in> on 25.06.2014 as per WHOIS report. The disputed domain name incorporates the Complainant's Trademark TIGER in its entirety, together with the suffix "brand". The Complainant's Trademark TIGER is clearly recognizable in the disputed domain name, and the addition of "brand" does not serve to avoid a finding of confusing similarity.

The Arbitrator finds that the disputed domain name <tigerbrand.in> is confusingly similar to the Trademark TIGER of the Complainant.

B. Rights or Legitimate Interests

The Complainant has the burden of establishing that the Respondent No. 1 has no rights or legitimate interests in the disputed domain name. Nevertheless, it is well settled that the Complainant needs only to make out a *prima facie* case, after which the burden of proof shifts to the Respondent to rebut such *prima facie* case by demonstrating rights or legitimate interests in the domain name¹.

Para 2.12 of WIPO Overview of WIPO Panel Views on Selected UDRP

¹ See *Hanna-Barbera Productions, Inc. v. Entertainment Commentaries*, NAF Claim No. 0741828; *AOL LLC v. Jordan Gerberg*, NAF Claim No. 0780200.

Questions, Third Edition is relevant in the present matter which provides as under:

"2.12 Does a respondent trademark corresponding to a domain name automatically generate rights or legitimate interests?"

2.12.1 Panels have recognized that a respondent's prior registration of a trademark which corresponds to a domain name will ordinarily support a finding of rights or legitimate interests in that domain name for purposes of the second element.

2.12.2 The existence of a respondent trademark does not however automatically confer rights or legitimate interests on the respondent. For example, panels have generally declined to find respondent rights or legitimate interests in a domain name on the basis of a corresponding trademark registration where the overall circumstances demonstrate that such trademark was obtained primarily to circumvent the application of the UDRP or otherwise prevent the complainant's exercise of its rights (even if only in a particular jurisdiction). Absent evidence of such circumstances indicating pretext however, panels have been reluctant to reject a respondent trademark registration out of hand."

Paragraph 7 of the INDRP provides 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.

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The Respondent had started his business of marketing in the year 1977 and began his industry unit in the year 1988. The Respondent No. 2 has also produced evidence that he had filed application dated 23.02.1988 for registration of Trademark TIGER BRAND which was granted by the Registrar of Trademarks on 13.09.1992. The Respondent no.2 had got the registration of his Trademark TIGER BRAND in the year 1992 prior to registration of Trademark TIGER of the complainant in the year 2005 in India. He is in the business and has been using the Trademark TIGER BRAND since long hence he has common law rights in the Trademark. It is prima facie of evidence of rights and legitimate interest of the Respondent No. 2 in the disputed domain name.

It is pointed out by the Complainant that Respondent no.2 did not renew the Trademark after 23.02.2009 and his petition for restoration of Trademark was dismissed vide order dated 29.02.2012 by the Deputy Registrar of Trademarks.

Cancellation of registration of Trademark TIGERBRAND of Respondent No. 2 due to non renewal in the year 2009 is no ground to allow present Complaint which is to be decided in accordance with INDRP. The Respondent No. 2 had common law rights in the Trademark.

In view of the peculiar facts of this case, it cannot be said that Respondent no.2 does not have any rights or legitimate interests in the disputed domain name <tigerbrand.in> as per Paragraph 7 of the Policy.

Based on the facts as stated above, the Arbitrator finds that the Respondent No. 1 has rights or legitimate interests in respect of the disputed domain name <tigerbrand.in>.

C. Registered and Used in Bad Faith

Paragraph 6 of the Policy identifies, in particular but without limitation, three circumstances which, if found by the Arbitrator to be present, shall be evidence of the registration and use of the Domain Name in bad faith. Paragraph 6 of the Policy is reproduced below:

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"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."

Each of the three circumstances in Paragraph 6 of the Policy (which are non-exclusive), if found, is evidence of "registration and use of a domain name in bad faith". Circumstances (i) and (ii) are concerned with the intention or purpose of the registration of the domain name, and circumstance (iii) is concerned with an act of use of the domain name. The Complainant is required to prove that the registration was undertaken in bad faith and that the circumstances of the case are such that the Respondent No. 1 is continuing to act in bad faith.

The Respondent no.2 had got the registration of his Trademark TIGER BRAND in the year 1992 prior to registration of Trademark TIGER of the complainant in the year 2005 in India. The Respondent had started his business of marketing in the year 1977 and began his industry unit in the year 1988. The Respondent No. 2 has produced a certificate of

registration of Trademark TIGER BRAND granted by the Registrar of Trademarks. The Respondent No. 2 was already in the business and he had been using the Trademark TIGERBRAND when the Complainant had registered the Trademark TIGER in India.

The Complainant has failed to prove that the disputed domain name has been registered in bad faith.

The Arbitrator therefore finds that the disputed domain name <tigerbrand.in> has not been registered by the Respondent No. 1 in bad faith.

7. Decision

Keeping in view all the facts and circumstances of the matter this Complaint is dismissed.

The award has been made and signed at Chandigarh on the date given below.

Place: Chandigarh

Dated: 17.12.2018



Dr. Ashwinie Kumar Bansal
Sole Arbitrator

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