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BEFORE SH. SANJAY KUMAR SINGH, SOLE ARBITRATOR,  
NATIONAL INTERNET EXCHANGE OF INDIA,  
IN DOMAIN NAME DISPUTE RESOLUTION POLICY (INDRP)  
FUTURE LIFESTYLE FASHIONS LIMITED - (Complainant)  
vs.  
PHANI KIRAN CHIKKALA - - - RESPONDENT

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### Statutory Alert:

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**BEFORE SHRI SANJAY KUMAR SINGH, SOLE ARBITRATOR,**  
**NATIONAL INTERNET EXCHANGE OF INDIA**  
**IN DOMAIN NAME DISPUTE RESOLUTION POLICY (INDRP)**

**IN RE:**

Future Lifestyle Fashions Limited,  
Knowledge House, Shyam Nagar,  
Off. JogeshwariVikhroli Link Road  
Jogeshwari (East), Mumbai,  
Maharashtra-400060, India.

**Through its authorized representative**

KRISHNA & SAURASTRI ASSOCIATES LLP,  
New Excelsior Building, 7<sup>th</sup> Floor, A.K. Nayak Marg,  
Wallace Street, Fort, Mumbai-400001.

COMPLAINANT

Versus

PhaniKiranChikkala, CBS, SR Nagar,  
Hyderabad, Andhra Pradesh-500038  
India

E-mail: [kiran.chikkala@gmail.com](mailto:kiran.chikkala@gmail.com)

RESPONDENT

**I. THE PARTIES:**

**A. THE COMPLAINANT:**

Future Lifestyle Fashions Limited, Knowledge House, Shyam Nagar, Off.  
JogeshwariVikhroli Link Road Jogeshwari (East), Mumbai, Maharashtra-  
400060, India. Email: [rajendra.nikam@futureretail](mailto:rajendra.nikam@futureretail).

Through its authorized representative KRISHNA & SAURASTRI  
ASSOCIATES LLP, New Excelsior Building, 7<sup>th</sup> Floor, A.K. Nayak Marg,  
Wallace Street, Fort, Mumbai-400001, Email:

[anuja@krishnaandsaurastri.com](mailto:anuja@krishnaandsaurastri.com) ; [info@krishnaandsaurastri.com](mailto:info@krishnaandsaurastri.com)

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**B. THE RESPONDENT**

The Respondent in this administrative proceeding is  
PhaniKiranChikkala, CBS, SR Nagar,  
Hyderabad, Andhra Pradesh-500038  
India  
E-mail: [kiran.chikkala@gmail.com](mailto:kiran.chikkala@gmail.com)

**II. THE DOMAIN NAME:**

[www.brandfactory.in](http://www.brandfactory.in)

**III. The registrar with which the domain name is registered is:****IV. Factual and legal Grounds:****V. The complainant's contentions:**

A. The complainant has at the outset submitted that in the year 2009, the complainant had filed a complaint under the .INDRP Dispute Resolution mechanism against the disputed domain name i.e. [www.brandfactory.in](http://www.brandfactory.in), in pursuant to which the disputed domain name was ordered to be transferred in favour of the complainant's predecessor (the erstwhile proprietor of the said name and mark BRAND FACTORY) by award dated 11<sup>th</sup> March 2009 passed by the sole arbitrator, Mr. D Sarvanan appointed by the National Internet Exchange of India.

The complainant has submitted that it was already decided by the Arbitrator that all right(s), title(s) and interest(s) in and to the disputed name [www.brandfactory.in](http://www.brandfactory.in) ought to vest in the complainant and none other. However, due to oversight and

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inadvertence, the procedural formalities for renewal of the disputed domain name in the name of the complainant could not be completed. Recently during the course of its due diligence, the complainant was shocked to discover that the disputed domain name

had again been purchased by a third party, the present Respondent, in violation of the complainant's rights and the award passed in the year 2009. The complainant has annexed the copy of the Award dated 11-03-2009 passed in favour of the complainant. In the said arbitral award it was held that the aforementioned disputed domain name containing "brandfactory", was identical to the complainant's said name and mark "BRAND FACTORY", that the Respondent in the aforesaid arbitration proceedings had no legitimate interest in the disputed name and that aforementioned disputed domain name was registered and being used in bad faith as per paragraphs 4(i) and 4(iii) of the policy respectively. In the said Arbitral Award, the Respondent was ordered to transfer the disputed domain name to the complainant, the rightful owner of the said domain name to the complainant, to the rightful owner of the said name and mark "BRAND FACTORY". The complainant has submitted that by virtue of such prior Award alone which relates to the disputed domain name, the complainant is entitled to the disputed domain name which must be transferred to the complainant.

The complainant has submitted that in view of the equity and justice the disputed domain name be transferred to the complainant.

- B. The Complainant has submitted that it belongs the renowned Future Group, which is India's largest private sector conglomerate

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and pioneers in retail and multiple retail formats. The Future Group brings multiple products, opportunities and services to millions of customers in India. Through more than over 24 million square feet of retail space, the Future Group of companies serve more than 350 cities across the country. The said companies employ around 60,000 people directly from every section of the Indian society, source their supplies from enterprises across the country, create employment, impact livelihoods, empower local communities and foster growth. It is one of the Future Group and owns and markets over two dozen fashion brands through exclusive brand outlets, department stores and multi brand outlets, as well as company operated chains such as Central, Brand Factory and several other exclusive brand outlets. The complainant is one of the major players in the fashion industry that is primed to gain leadership in building both fashion brands and fashion retailing in India collectively operating around 400 stores in more than 240 cities across the country through over 11 million square feet of retail space. Through multiple retail formats, the complainant connects diverse and passionate community of Indian buyers, sellers and business.

- C. The Complainant has submitted that it brings together the four key components in the fashion industry- a strong portfolio of owned and licenced brands, a well-established retail presence, a pan India reach for its brands through a strong distribution network and investments in fast growing fashions brands into a single entity. The Complainant has also submitted that as an integrated fashion company with presence across all key segments within the fashion industry, the complainant benefits from operating mature business that have built its presence and strengths for well over a decade.

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D. The Complainant has submitted that over the years, the complainant has acquired significant amount of reputation and goodwill having won numerous accolades and awards.

The Complainant has enumerated some of these awards as under:

- India Content Leadership Awards 2018.
- IFA- Images Most effective Marketing & Promotions Campaigns of the Year 2018.
- Awards for retail excellence- Retail Marketing Campaigns of the Year 2017;
- Images Retail Awards 2018.
- Star ReImaging Awards for exceptional work broadcast during VIVO IPL 2018.

E. The Complainant has submitted that amongst the several retail formats operated by the complainant, the complainant runs a very popular retail stores under the name, style and mark " BRAND FACTORY" (hereinafter referred to as the said name and mark) and/or the logo of BRAND FACTORY as well as several marks wholly incorporating the said name and mark BRAND FACTORY, which gives the Indian consumers revolutionary discount shopping experience by offering customers the widest range of brands and categories possible at absolutely discounted and/or reasonable and/or reduced and/or competitive prices in an ambience that befits the brand. The complainant has further submitted that under the said name and the mark the complainant presents brands in a fully air-conditioned, slick environment varying between 70,000 to 1,50,000 square feet. The stores bearing the said name and mark "BRAND FACTORY" offer more than 200 Indian and International brands of

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products / services inter alia apparels for men and women, infant wear, accessories, cosmetics, footwear, sportswear, luggage, home linen and much more at 20-70% discount, 365 days of the year. The complainant has submitted that it hosts several Indian and International fashion brands including but not limited to Levis, Pepe Jeans, Dockers, Wrangler, Provogue, Arrow, Nike, Adidas, Reebok, Louis Phillip, Allen Solly, Reid & Taylor, and Gini&Jony amongst others under the said name and mark.

- F) The complainant has submitted that said name and mark "BRAND FACTORY" was initially adopted and put to use by the Complainant's predecessors in business, right(s), title(s) and interest(s) namely, "Pantaloon Retail (India) Limited", and has been in open, extensive, exclusive and uninterrupted use at least since the year 2006. The Complainant became entitled to the said name and mark by virtue of the composite Scheme of Arrangement between Pantaloon Retail (India) Limited" and "Future Lifestyle Fashions Limited sanctioned by the Hon'ble High Court of Bombay by its order dated May 10, 2013. By virtue of the said arrangement, the lifestyle fashion business and goodwill of "Pantaloon Retail (India) Limited" along with the trade mark "BRAND FACTORY" and its other properties came to be vested with the Complainant, who continues to carry on business under the said name and mark. The complainant has enclosed a copy of the said order of the Hon'ble High Court of Bombay dated May 10, 2013 and marked it as "ANNEXURE-C".
- G) The complainant has submitted that the said name and mark has been in open continuous, extensive, exclusive and uninterrupted use since at least the year 2006, with the Complainant's first store launch in Marathahalli, Bengaluru. The Complainant has submitted that its stores under the said name and mark are spread throughout the length and breadth of India with 91 stores spread across 41 cities. The complainant has annexed a list of all the stores under the said name and mark along with their locations and marked it as "ANNEXURE-D". The complainant has enclosed several in-store photographs evidencing the display of the said name and mark all

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through-out the stores including those displayed on banners and hoardings and marked it as "ANNEXURE E-Colly". Moreover, the shopping bags in which the Complainant's said goods are sold too prominently display the said name and mark as is evidently clear from various customer photographs has been enclosed and marked by complainant as "ANNEXURE F-Colly".

- H) The complainant has submitted that the said name and mark has come to be exclusively associated and identified wholly and solely with the Complainant alone and/or connected with the Complainant in the course of trade and has garnered a-substantial reputation and goodwill. The exclusive association, efficacy and popularity of the said name and mark is reflected and apparent from the voluminous customer base of the Complainant across India. A statement showing annual sales figures for the sale of goods sold under the said name and mark across India from 2006-2018 duly certified by a Chartered Accountant has been enclosed with the complaint and marked as "ANNEXURE-G". The complainant has enclosed and marked as "ANNEXURE H-Colly" the random copies of some of the system saved copies of customer invoices depicting the sale of goods under the said name and mark, as are readily available.
- I) Further, the Complainant has also taken efforts to publicize and aggressively promote the said name and mark through varied platforms of media and has spent enormous amounts of money and time on publicity, advertisement and sales promotional activities through both electronic and print media such as advertisements in numerous newspapers, on hoardings and banners displayed across several cities through-out India. A statement showing annual marketing expenditure from 2006-2018 duly certified by a chartered Accountant has been enclosed by the complainant and marked as ANNEXURE-I". The complainant has also enclosed and marked as "ANNEXURE J-Colly" the copies of the varied newspaper advertisements prominently displaying the Complainant's said name and mark along with copies of random media invoices of the Complainant for the advertisement and marketing of the said name and mark. The Complainant has taken several efforts to further publicize the said

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name and mark by sponsoring of events such as the Vasai-Virar marathon, Radio City Freedom Awards 4 Event to name a few. The complainant has enclosed and marked as "ANNEXURE K-Colly" the numerous advertisements as well as photographs from the said events distinctly displaying the Complainant's said name and mark.

- J) The complainant has submitted that additionally, the Complainant also maintains a website under the domain name "www.brandfactorvonline.com" which prominently displays the said name and mark, and which provides details about its products sold under said name and mark "BRAND FACTORY". Additionally, the Complainant's said name and mark is prominently displayed on varied ' social networking platforms including but not limited to Facebook, Twitter, Pinterest, Instagram and YouTube, all of which have an abundant following. The said website and social networking platforms distinctly display the said name and mark and are freely accessible from anywhere across the globe. The complainant has enclosed herewith and marked as "ANNEXURE L- Colly" the copies of extracts from the said websites and social networking platforms, all of which prominently display the said name and mark. The complainant has further submitted that with the advent of technology, the internet and social media being in the forefront for imbibing widespread recognition, the said name and mark has further acquired immense recognition and reputation across geographical boundaries, in numerous countries around the globe.
- K) The complainant has further submitted that popularity of the Complainant's said name and mark is so wide and large that a mere google search for the said name and mark carried out on 30,h January 2019 gives a whopping 20,10,000 results. All the top results reflect the Complainant and the Complainant's said name and mark as is evident from the "ANNEXURE-M enclosed by the complainant.
- L) The Complainant has submitted that it is also the Registered Proprietor of the said name and mark "BRAND FACTORY" as well as numerous marks wholly incorporating the said name and mark "Brand Factory". The details particulars of the said registrations in India are as follows-

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Sr. No.	Trade mark	Registration No.	Status
1.	Brand Factory	1472128	Registered Valid Upto" 21/07/2016
2	Logo Brand Factory Best Brands Smart price	2273265	Registered Valid Upto" 27/01/2022
3	Logo Brnad Factory Free Shopping Weekend	3645499	Registered Valid Upto" 27/09/2027
4	Logo Brand Factory National Brand Week	3645500	Registered Valid Upto" 27/09/2027

The complainant has submitted that all the aforesaid registrations are valid, subsisting and in force. The complainant has enclosed herewith and marked as "ANNEXURE N-COLLY" the copies of the various Registration Certificates evidencing the aforesaid registrations in India.

- M) The Complainant has submitted that it has acquired statutory as well as common law rights in the said name and mark "BRAND FACTORY". By virtue of the longevity, scale of use, the intrinsic and superior quality of

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the goods manufactured, marketed and sold under the Complainant's said name and mark, the regular, continuous and large sale of the goods under the said name and mark effected during the past several years as well as the extensive sales promotional activities undertaken by Complainant to popularize and promote the said goods under the said name and mark, and the valid and subsisting registrations for the said name and mark as well as several marks containing the said name and mark "BRAND FACTORY" coupled with the widespread presence on the world wide web, the said name and mark has become embedded in the minds of the consumers, end users and public at large and enjoys tremendous recall value, so much so that the same creates an instant association with and is reminiscent with the Complainant alone, to the complete exclusion of all others.

- N) The complainant has submitted that the Complainant is the legal proprietor of all right(s), title(s) and interest(s) in and to the said name and mark "BRAND FACTORY" including but not limited to all domain name(s), key word(s), ad-word(s), meta-tag(s) etc. containing the said name and mark and is entitled to protect and enforce the proprietary rights vested in it in respect of the said name and mark.
- O) The complainant has reiterated that in the Arbitral Award annexed with the complaint and marked as "ANNEXURE-B" the Ld. Sole Arbitrator was satisfied that the disputed domain name "www.brandfactory.in" A containing "brandfactory", was identical to the Complainant's said name and mark "BRAND FACTORY", that the Respondent in the aforesaid arbitration proceedings had no legitimate interest in the disputed domain name and that the aforesaid disputed domain name was registered and being used in bad faith as per Paragraphs 4(i), 4(ii) and 4(iii) of the Policy respectively. In light of the aforesaid Order alone, which relates to the disputed domain name, the Complainant is entitled to protection of said name and mark "BRAND FACTORY" including but not limited to all domain name(s), key word(s), ad-word(s), meta-tag(s) etc. containing the said name and mark and is entitled to protect and enforce the proprietary rights vested in it in respect of the said name and mark.

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**VI The domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights:**

- a) The Complainant has reiterated that in a prior complaint relating to the disputed domain name "www.brandfactory.in" filed by the Complainant's predecessor, an Arbitral Award dated 11th March 2009 was passed in favour of the Complainant as mentioned in paragraph 11(a) and 11 (p) herein above and attached hereto as "ANNEXURE-B" hereto. In the said decision, the Ld. Arbitrator recognized the Complainant's proprietary rights in the said name and mark "BRAND FACTORY" and was convinced that all the requirements as per Paragraph 4 of the Policy were established, in particular that the disputed domain name "www.brandfactory.in", was identical and closely similar to the Complainant's registered said name and mark "BRAND FACTORY", the Registrant had no legitimate rights in and to the disputed domain name and that the disputed domain name was registered in bad faith. On the basis of this prior Arbitral Award alone, it is amply clear that the disputed domain name ought to be transferred to the Complainant.
- b) Without prejudice, the Complainant has submitted as follows:  
It may be observed from several decisions before the National Internet Exchange of India such as in the matter of Morgan Stanley, U.S.A. vs. Bharat Jain, U.S.A. the complainant has enclosed and marked as "ANNEXURE-O", that a mere addition of the Country Code Top Level Domain Name (ccTLD) such as ".co.in" to an identical registered trademark is insufficient to render the domain name dissimilar from the registered trade mark. In the aforementioned case, an Award was passed in favour of the Complainant rendering the disputed domain name, which was obtained by the mere # addition of ".co.in" to the registered trade mark of the Complainant, as confusingly similar to the registered mark of the Complainant. Relying on the said case, it is amply clear that the disputed domain name in the subject Complaint was too arrived at by a mere addition of the Country Code Top Level Domain Name (ccTLD) ".in" to the registered trade mark "BRAND FACTORY" of the Complainant.

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The disputed domain name "www.brandfactory.in" is identical to and contains the registered and well-known name and mark "BRAND FACTORY" of the Complainant. It is submitted that the registration of the disputed domain name www.brandfactory.in in the name of the Respondent is bound to result in confusion and/or deception among the public who will assume some nexus, affiliation or endorsement of the Complainant with the disputed domain, which is not true. Such confusion and/ or deception is bound to tarnish the hard-earned reputation and/ or goodwill of the Complainant and also cause it huge monetary losses. The subject identical disputed domain name inter alia violates the Proprietary rights and/or infringes the trade mark "BRAND FACTORY" of the Complainant. Any use of the subject disputed domain name also amounts to passing off the goods/business of the Respondent as and for that of the Complainant.

- c) The Complainant has submitted that it is the proprietor of the trade mark "BRAND FACTORY" along with its numerous variations, in various classes of goods and services in India. The first trade mark registration in India dates as far back as the year 2006 as in evident from the varied copies of the Registration Certificates annexed with the complaint and marked as "ANNEXURE N-Colly".
- d) The Complainant has submitted that a search conducted on Google's search engine for "BRAND FACTORY" carried out on 30th January 2019 gives you a whopping 20,10,000 results, most of which are associated with the Complainant. The Complainant has submitted that it is evident from "ANNEXURE-M" enclosed with the complaint.
- e) The Complainant has submitted that the said name and mark has gained tremendous reputation and goodwill amongst the consumers, end users and public at large, over the years and the same has acquired the status of well-known mark considering inter-cilia the longevity, the scale of use, superior quality of the goods manufactured, marketed and sold under the Complainant's said name and mark, the regular, continuous and large sale of the goods under the said name and mark effected during the past several years as well as the extensive sales promotional activities

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undertaken by Complainant to popularize and promote the said goods under the said name and mark, and the valid and subsisting registrations for the said name and mark as well as several marks containing the said name and mark "BRAND FACTORY" coupled with the widespread presence on the world wide web.

- f) The Complainant has submitted that there are several case laws wherein the primary matter to be decided before the Hon'ble Court(s) was whether internet domain names are recognizable as other intellectual properties such as trademarks. In particular, the Complainant lays emphasis on the case of Yahoo! Inc. v Akash Arora [78 (1999) DLT 28] wherein, for the very first time the courts in India decided upon the issue of domain names as trademarks. It was held by the Delhi High Court that "In an Internet service, a particular Internet site could be reached by anyone anywhere in the world who proposes to visit the said Internet site. With the advancement and progress in technology, services rendered on the Internet has come to be recognized and accepted and are being given protection so as to protect such provider of service from passing off the services rendered by other as that of the plaintiff. As a matter of fact in a matter where services rendered through the domain name in the Internet, a very alert vigil is necessary and a strict view is to be taken for its easy access and reach by anyone from any corner of the globe." The Complainant has enclosed and marked as "ANNEXURE-P" a copy of the said Case Law. Further, in the case of Satyam Infoway Ltd. Vs Sifynet Solutions Pvt. Ltd. [AIR 2004 SC 3540], it was held by the Supreme Court of India that though there was no law in India which explicitly deals with the domain names, it falls within the ambit of the Trade Marks Act. The Apex Court further observed that "The original role of a domain name was no doubt to provide an address for computers on the internet. But the internet has developed 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 a business identifier. The Complainant has submitted that the domain name not only serves as an address for internet communication but also identifies the specific internet

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site, and distinguishes specific businesses or services of different companies. The Complainant has submitted that, a domain name as an address must, of necessity, 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." "As more and more commercial enterprises trade or advertise their presence on the web, domain names have become more and more valuable and the potential for dispute is high'." The Complainant has submitted that enclosed herewith and marked as "ANNEXURE-O" a copy of the said Case Law. The Complainant has submitted that it is amply clear that the disputed domain name being identical to the registered trade mark of the Complainant, will in all likelihood cause confusion and/or deception among the public who is bound to assume some nexus, affiliation or endorsement of the Complainant with the disputed domain, which is not true. The Complainant has further submitted that as mentioned in the aforesaid case laws, registration of such an identical domain name must, under all circumstances be refused in order to avoid any kind of confusion and/or deception as to the source of origin, such confusion being inevitable.

- g) The complainant has further submitted that in view of the valuable common law and statutory trade mark rights acquired by the Complainant in the said name and mark "BRAND FACTORY", the Complainant is entitled to prevent any other person/party, more particularly the Respondent in the present matter, from using the same without its permission/license. The disputed domain name wholly incorporates the registered trademark/name "BRAND FACTORY" of the Complainant which amounts to infringement of the Complainant's registered trade mark and passing off of the disputed domain name as that of the Complainant.

**VII. The Respondent has no rights or legitimate interests in respect of the domain name that is the subject of the Complaint:**

- a) The complainant has submitted that the Respondent is not commonly known by the name "BRAND FACTORY", which is the essential and prominent part of the disputed domain name. The said name and mark

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"BRAND FACTORY" is well-known and exclusively associated and identified with the Complainant alone since the past several years. The Complainant is the prior adopter, user and registered proprietor of the said name and mark as mentioned hereinabove. The Respondent has therefore no right to adopt, use or register the disputed domain name except with the permission/license of the Complainant.

- b) The complainant has submitted that the Respondent is not a licensee of the Complainant or its group companies, neither has the Complainant or its group companies granted any permission or consent to the Respondent to use the said name and mark "BRAND FACTORY" in any manner or to incorporate the same in a domain name.
- c) The complainant has submitted that the Respondent has neither used nor has made any demonstrable preparations to use "BRAND FACTORY" in connection with a bona fide offering of goods or services. On the contrary, the Complainant has produced ample evidence to show proprietorship and use of the said name and mark "BRAND FACTORY" much prior to the date of registration of the disputed domain name.
- d) The complainant has submitted that the Respondent is not making any legitimate or fair use of the disputed domain name without intent for commercial gain. The Respondent has simply registered the disputed domain name and parked it to further sell it for a hefty sum of money thereby, committing fraud and make illicit gains by usurping the reputation and goodwill acquired by the Complainant in the said name and mark.
- e) The complainant has submitted that it is apparent that the Respondent has no rights or legitimate interests in respect of the disputed domain name, i.e. "www.brandfactory.in."

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**VIII. The domain name in question is registered and being used in bad faith:**

- a) The complainant has submitted that the Respondent's dishonest and malicious intention is amply evidenced by the fact that the Respondent has registered the disputed domain name which is identical to the said name and mark "BRAND FACTORY of the Complainant.
- b) The complainant has submitted that the Respondent is not carrying out any business under the subject disputed domain name and/or using the subject disputed domain name for any legitimate purpose. The complainant has submitted that it is evident therefore that the Respondent has registered or acquired the impugned identical domain name "www.brandfactory.in" primarily for the purpose of selling, renting or otherwise transferring the domain name registration either to the Complainant who is the owner of the said name and mark "BRAND FACTORY", or to a competitor of the Complainant for valuable consideration in excess of the Respondent's out-of-pocket costs directly related to the domain name. The Complainant submits that such registration of the Complainant's well-known and widely recognized mark "BRAND FACTORY" with the mala fide motive of trading upon the reputation and goodwill of the Complainant so as to sell the domain name to the Complainant or its competitor for a profit amounts to "cybersquatting" and must strictly be prohibited. The availability of the disputed domain name for sale is amply evident from the web page of the disputed domain name which reads as "the premium domain name is available for purchase". The complainant has enclosed and marked as "ANNEXURE-R" a screen shot of the aforementioned web page.
- c) The complainant has submitted that it must be noted that the disputed domain name was registered in the year 2013. However, till date, the Registrant has simply been passively holding the disputed domain name with the intention of selling, renting or otherwise transferring the domain

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name registration either to the Complainant who is the owner of the said name and mark "BRAND FACTORY", or to a competitor of the Complainant for valuable consideration in excess of the Respondent's out-of-pocket costs directly related to the domain name. The Complainant has relied upon the decisions of the Administrative Panel of the WIPO Arbitration and Mediation Center in the cases of Telstra Corporation Limited v. Nuclear Marshmallows [Case No. D2000-0003] and Oberoi Hotels Pvt. Ltd. v. Arun Jose [Case No. D2000 0263] wherein, it was held that cybersquatting and passively holding of domain names are prima facie evidence of registration and use in bad faith. The complainant has enclosed and marked as "ANNEXURE-S" and "ANNEXURE-T" the copies of the aforesaid decisions respectively.

- d) The complainant has submitted that it is observed that the Respondent has concealed its contact details in the Whois information database through privacy settings, which further established the lack of bona fides of the Respondent.
- e) The complainant has submitted that the Respondent has registered the disputed domain name on 25th March 2013, much later than the Complaint's adoption and use of the widely recognized and hugely popular said name and mark "BRAND FACTORY", which further makes it evidently clear that the disputed domain name was adopted in bad faith to simply sail close to and tide upon the enormous reputation and goodwill acquired by the Complainant in the said name and mark "BRAND FACTORY".
- f) The complainant has submitted that by virtue of the widespread reputation and presence of the said name and mark "BRAND FACTORY" of the Complainant as set out in the preceding paragraphs of this Complaint, the Respondent was bound to have been aware of the reputation and goodwill subsisting in the said name and mark. The Respondent has evidently adopted the impugned identical domain name

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with a clear mala fide intention of trading upon the reputation and goodwill acquired by the Complainant in the said name and mark. Further the complainant has reiterated that the Respondent is not using the impugned domain name for any legitimate purpose and the same has been registered without any bona fide use which is clearly indicative of the respondent's intention to hoard domain names for the purpose of selling, renting or otherwise transferring the same to the complainant or its competitor(s) for a valuable consideration.

- g) The complainant has submitted that respondent has registered the impugned identical 'domain name for the purpose of capitalizing on complainant's immense goodwill and more particularly the popularity that the said name and mark has acquired world over.

**RESPONDENT'S CONTENTION:**

Despite notices to the complainant has not come up with the evidence in his / her favour. The respondent has not filed any document in support of his / her claim. The Respondent has neither filed any proper response nor any document in his defense despite repeated notices. The respondent has submitted as under:

- i. I respect the trademarks and domain brandfactory.in is not registered with any intent to sell or use this domain to have conflict of interest with existing business.
- ii. The respondent has further submitted that the domain name brandfactory.in was parked with my other domain which are planned for future use and parked page will have some kind of standard form/information nothing to conflict with any existing business.

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Hence the complainant is being decided on the merit of the complaint, response of the respondent, rejoinder of the complainant wherein the complainant has reiterated the contentions raised in the complaint and as per law of the land.

### AWARD

1. This arbitral proceeding commenced in accordance with IN Dispute Resolution Policy (INDRP) and rules framed there under.
2. The complainant submitted his complaint in the registry of NIXI against the respondent in respect to the respondent's disputed Domain name "**www.brandfactory.in**".
3. I was appointed as Sole Arbitrator in the matter by NIXI.
4. The complainant submitted the said complaint under In Domain Name Dispute Resolution Policy (INDRP).
5. On 23-02-2019, I informed the respective parties to the complaint, about my appointment as an arbitrator. Accordingly, I called up on the parties to file their counter/ reply and rejoinder with the supportive document/evidence within *TEN* days from receipt of the notice.
6. On 24-02-2019, the respondent sent an email stating that he purchased the domain name "brand factory" is a generic keyword for logo / brand design.
7. On 06-03-2019, the respondent sent an email as his response to the complaint of the complainant.
8. On 09-03-2019, the complainant was directed to file the rejoinder
9. The complainant submitted the rejoinder to the response of the Respondent.

### OPINION AND FINDINGS ON MERITS

- A) Whether the domain name is identical or confusingly similar to a trademark in which complainant has right.

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It has been held in Indian decision M/s Satyam Infoway Ltd. vs. M/s Sifynet Solution (P) Ltd. JT. 2004 (5) SC 541, that Domain name has all characteristics of trademark. As such principles applicable to trademark are applicable to domain names also. In the said case the words, "Sify" & "Sify" were held to be phonetically similar and addition of word 'net' in one of them would not make them dissimilar. It is held in Indian case JT.2004 (5) SC 541, that in modern times domain name is accessible by all internet users and thus there is need to maintain it as an exclusive symbol. It is also held that it can lead to confusion of source or it may lead a user to a service, which he is not searching.

Now the other important aspect that needs consideration is, as to whether the complainant has legitimate right in the trademark. It is important to mention here that as per the claim of the complainant the respondent has no trademark on the said domain name and has no affiliation with the trademark. Considering the complainant's submission that the domain name "**www.brandfactory.in**" "**www.brandfactory.in**" directly and entirely incorporates Complainant's well-known mark. The complainant has rightly contended that the Domain Name would be perceived by internet users as descriptive of a website where they could find information about Complainant's well-recognized products.

Thus conclusion is that domain name and trademark, which may be used in different manner and different business or field, or sphere can still be confusingly similar or identical. Thus the conclusion is that the domain name of respondent is identical and confusingly similar to the trademark of complainant.

This principle is settled in many Indian cases and referred cases JT 2004(5) SC 541 and 2004(5) SCC 287 and the cases relied upon by the complainant.

The complainant has further submitted that a reading of the domain name indicates that the Respondent has only added the word "me" to "BRANDFACTORY" and changed it to "BRANDFACTORY" and therefore, the Complainant has contended that this leads to irreparable damage to the goodwill and brand name of the Complainant owing to the confusion created in the minds of the general public.

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Thus the conclusion is that the domain name "www.brandfactory.in" is identical and confusing similar to the trademark of complainant "www.brandfactory.in" and the complainant has right in the trademark.

**B) Whether the respondent has no right or legitimate interest in the domain name got registered by him**

The paragraph 4(ii) of INDRP is to read with paragraph no.7. As already stated that paragraph 4(ii) and 7 of INDRP are to be read together. Their combined effect is that, onus to prove the ingredients of these paras is prima facie on complainant. The onus is not very weak and prima facie, but it heavily shifts on respondent. Respondent can discharge the onus by direct congest and positive evidence which are in his special knowledge and power.

In the instant complaint the complainant has made positive assertions that respondent has no legitimate right in domain name and there is no evidence of its use and the respondent has no trademark on the domain name neither he has affiliation with it in India. The complainant has made positive assertions regarding the fact that respondent has got registered domain name, in the .IN Registry for which the respondent has no right or trademark. The respondent has got registered disputed domain name as stated above. As such in above circumstance it is clear that the complainant has prima facie discharged the initial onus cast upon him by virtue of paragraph 4(ii) and 7 of INDRP.

The respondent on other hand has failed to provide any positive, cogent and specific evidence that he is known or recognized by domain name, by its user and that he in fact uses it for providing goods or services. The respondent has neither put forth nor provided such evidence. The assertion of complainant is that the respondent at time of registering his domain knew or ought to have known about his trademark and so he has violated complainant's right. The respondent has filed trademark application only after the filing of the present complaint by the complainant before the INDRP. Thus the conclusion is that respondent has no right or legitimate interest in the domain name.

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**Whether the respondent's domain name has been registered or is being used in bad faith**

It is to be seen as to whether the domain name has been got registered in bad faith. The paragraph no.4 (iii) and 6 are relevant and as already stated, the onus is primarily upon complainant. The complainant has contended that the respondent has got registered the domain name I bad faith and the continuation of the ownership of the disputed domain name will render irreparable harm to the complainant.

Further by using the said domain name, the Respondent has intentionally attempted to attract, for commercial gain, internet users to its website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on its website or location.

Keeping in view above facts and circumstances and in view of the complaint, the response of the respondent it is thus clear that the respondent has registered domain name and he has not provided any substantial evidence of using them for business or for offering of goods and services. The obvious purpose for registering domain names is to sell, rent or transfer it or to prevent other owner of mark from reflecting it in corresponding domain name. Thus the conclusion is that the respondent has got registered his domain name "**www.brandfactory.in**" in bad faith.

In view of above facts of the complaint, the response of the respondent, the rejoinder of the complainant to the counter statement of the respondent, the law of the land and the case laws relied upon by the complainant as discussed above it is clear that the complainant has made positive assertions that respondent has no legitimate right in domain name and the respondent has no trademark on the domain name. The complainant has made positive assertions regarding the fact that respondent has got registered the disputed domain name in he .IN Registry for which the respondent has no right or trademark. As such in above circumstance it is clear that the complainant has prima facie discharged the initial onus cast upon him.

*Sanyam K. Singh*  
22-04-2019

**RELIEF**

The domain name of the respondent is identical and confusingly similar to trademark of complainant. The respondent also does not have right or legitimate interest in the domain name. He has got it registered in bad faith, as such he is not entitled to retain the domain name. The respondent also does not have right or legitimate interest in the domain name. The complainant is entitled for transfer of domain name "**www.brandfactory.in**" as it has established its bonafide rights in trademark. Hence I direct that the Domain name be transferred to the complainant by the registry.

No order as to costs.

Delhi

Date: 22-04-2019.

*Sanjay Kumar Singh*  
(Sanjay Kumar Singh)

Arbitrator