



ఆంధ్రప్రదేశ్ ఆంధ్ర ప్రదేశ్ ANDHRA PRADESH

K.Rama Chandravathi
31AA 398056

Sl. No: 47206 Date: 14/11/2011.
Sold To : Harini Narayana Swamy
W/o : B. Narayanaswamy.
To Whom : Self, R/o. Plot No 545A, J.Hiis, Hyderabad.

K.RAMA CHANDRAVATHI

Licenced Stamp Vendor

LIC No.16-11-27/1999

REN. No.16-11-5/2011

H.No.6-3-387, Near Himalaya Book World
Beside Petrol Pump Punjagutta
HYDERABAD (SOUTH) DISTRICT
PHONE NO.23351799, 9392490025

**BEFORE THE NATIONAL INTERNET EXCHANGE OF INDIA
ARBITRATION AWARD**

In The Matter Between

BNP Paribas

Complainant

Versus.

Nathan Muran

Respondent

Harini Narayana Swamy
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ఆంధ్రప్రదేశ్ ఆంధ్ర ప్రదేశ్ ANDHRA PRADESH

K.Rama Chandravathi
31AA 398054

Sl. No: 47244 Date: 14/11/2011.
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PHONE NO.23351799, 9392490025

1. The Parties

The Complainant is BNP Paribas having its registered office at 16 boulevard des Italiens, 75009 Paris France represented in these proceedings by Chemouli, Dauzier & Associates of Paris France.

The Respondent is Mr. Nathan Muran of 21 rue Jean Jaures 93140, Bondy, France, and is represented in these proceedings by Randy Yaloz of Paris, France

2. The Domain name, Registrar and Policy

This Arbitration pertains to a dispute regarding the domain name <bnpparibas.in>. The registrar for the disputed domain name is eNom Inc.

Harini Narayana Swamy 2



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Sl. No: *11/2011* Date: 14/11/2011.
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The Arbitration Proceeding is conducted in accordance with the Arbitration and Conciliation Act of 1996 (India), the current .IN Domain Name Dispute Resolution Policy (the "INDRP Policy"), and the INDRP Rules of Procedure (the "Rules").

3. Procedural History

The sole arbitrator appointed in the case is Mrs. Harini Narayanswamy. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, in compliance with the Rules.

The Arbitrator received the Complaint from the .IN registry on August 29, 2011 and on August 31, 2011 transmitted by email a notification of commencement of the arbitration proceedings to the Respondent. Under the INDRP Rules, copies of the said notification were sent to other interested parties to the dispute. The Respondent was given twenty-one days time from the date of the notification to file a response. The Respondent through his

Harini Narayanswamy



ఆంధ్రప్రదేశ్ ఆంధ్ర ప్రదేశ్ ANDHRA PRADESH

K. Rama Chandravathi
31AA 398398

47669 16/11/2011

Sold To..... *Harini Narayana Swamy*

By/W/o./D/o..... *B. Narayana Swamy*

Whom..... *Self Plot 545, J. Hills. Hyderabad*

K. RAMA CHANDRAVATHI
Licenced Stamp Vendor
LIC No.16-11-27/1999
REN.No.16-11-5/2011
H.No.6-3-387 Near Himalaya Book World
Beside Petrol Pump Punjagutta
HYDERABAD (SOUTH) DISTRICT
Phone No 23351799 9392490028

counsel sent his response by email on September 21, 2011. Based on the material on record the Arbitrator now proceeds to determine the case on its merits.

Factual Background

The Complainant is a leading international bank originating from France and has setup operations in many countries. It has a presence in India for an extensive period and has filed an application for the Indian Trademark "BNP PARIBAS", application No. 1261126 dated January 14, 2004. The said trademark application covers the following classes: Class 35 for Business Management Assistance or Commercial functions and related services, Class 36 for Banking services and related services and Class 38 for telecommunications information and related services.

The Respondent registered the disputed domain name <bnpparibas.in> on February 21, 2005 and the domain name is registered with the registrar eNom Inc.

Harini Narayana Swamy



ఆంధ్రప్రదేశ్ ఆంధ్ర ప్రదేశ్ ANDHRA PRADESH

31AA 398399

No. 47670 Dt. 16/11/2011
 Sold To..... Haini Narayana Swamy
 No. 1W10-1D10..... B. Narayana Swamy
 Whom..... SPN Plot 545, J. Hills, Hya

K. RAMA CHANDRAVATHI
 Licenced Stamp Vendor
 LIC No.16-11-27/1999
 REN.No.16-11-5/2011
 H.No.6-3-387 Near Himalaya Book World
 Beside Petrol Pump Punjagutta
 HYDERABAD (SOUTH) DISTRICT
 Phone No. 23351799 9392490025

4. Parties contentions

A. Complainant's Submissions

The Complainant BNP Paribas, states it is a Joint Stock Company of France with a capital of 2.397.320.312 EUROS registered with the Register of Trade and Companies of Paris under number 662042449. The Complainant bases its complaint on the following grounds:

The Complainant has registered trademarks and has applied for Indian trademark registration on January 14, 2004 for its mark "BNP PARIBAS" bearing application No. 1261126. In the year 2010 the Complainant states it had celebrated the 150th anniversary of its presence in India.

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The Complainant states it had sent a letter dated October 8, 2010 to Respondent to cancel the registration of the disputed domain name and to cease using its mark BNP PARIBAS. Mrs. Sabine Bonneh, the legal counsel of the Respondent, replied by email dated October 19, 2010, stating that the Respondent would agree to transfer the disputed domain name to the Complainant for a financial compensation. On November 24, 2010 Mrs. Sabine Bonneh wrote another email to the Complainant that the Respondent expected an amount of 20,000 EUROS to transfer the disputed domain name to the Complainant.

The Complainant contends the disputed domain name is identical or confusingly similar to the trademark in which it has rights. The Complainant states it has registered trademark rights in the mark BNP PARIBAS and has filed an Indian trademark application for the said mark. The Complainant has also registered the domain name <bnpparibas.co.in> on November 6, 2010. The Complainant argues the disputed domain name being confusingly similar to its mark is likely to cause confusion among the public and therefore infringes its mark.

The Complainant argues that the Respondent has no rights or legitimate interest in respect of the disputed domain name as the Respondent has no connection with the Complainant and has therefore registered the disputed domain name at his own risk. The fame of the BNP PARIBAS mark excludes the possibility that the Respondent's choice of the domain name was a coincidence; further the Respondent is seeking a lucrative payment of 20,000 Euros for the transfer of the disputed domain name. The reservation of the disputed domain name is therefore illegitimate and dishonest argues the Complainant. The Complainant states it has been precluded from registering and using a domain name with its mark BNP PARIBAS in which it has legitimate rights.

The disputed domain name has been registered and used in bad faith argues the Complainant as the email dated October 19, 2010 from the Respondent's legal counsel clearly shows the money making motive of the Respondent. Such behavior shows bad faith intentions on the part of the Respondent and the Complainant requests for the transfer of the disputed domain name.

B. Respondent's Submissions

The Respondent, Mr. Paramathan (Nathan) Mauran states he is domiciled at: 21 rue Jean Jaures, 93140 Bondy, France. The Respondent describes himself as innovative creative entrepreneur of Indian origin. The Respondent states that during the Sunrise period for ".in" registrations, between January 1st 2005 and January 25, 2005 trademark owners were allowed to register their domain name based on their registered marks on a priority basis in the ".in" domain. It was only subsequent to the Sunrise period that the domain name registrations were open to the general public. The Respondent argues that the Complainant, as the trademark owner of BNP PARIBAS, ought to have registered the disputed domain but has failed to purchase the disputed domain name during the sunrise period.

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The Respondent states that in 2004 and 2005 with the expansion of Internet in conservative India he came up with the idea of creating and developing a human assisted matrimonial service and website to help people in North India find their perfect love partner. The Respondent asserts the concept of his business is based on characters from an Indian Fairy tale. The Respondent then narrates the alleged fairytale from Indian folklore of a girl named Bubly and boy called Papu who are brought together by a fairy "pari" ("pari" is a fairy in Hindi) and states that his webpage "Bubly & Papu Pari Bas" is based on this story. On February 20, 2005 the Respondent states he registered the disputed domain name for developing an Indian online personalized matrimonial service.

On June 27, 2005 the Complainant's counsel Dreyfus & Associates sent a cease and desist notice to the Respondent providing forty-eight hours to transfer the disputed domain name to the Complainant and to sign a covenant to refrain from use of such domain name. After receipt of the notice, the Respondent states that it refused to reply or give in to the threats of the Complainant, a wealthy multinational bank, with its army of lawyer was trying to force a young Indian Entrepreneur to abandon his pursuit of his original business idea under the concept of "Bubly & Papa Pari Bas".

The Respondent further states that between July 2005 and October 2010, he did not receive any further notices from the Complainant nor did the Complainant take any legal action against Respondent until February 2011. The Respondent says that during 2005 and 2006 he put in much work on his business and sourced funding for his website and has filed an invoice showing an amount for Euros 14,352 (equivalent to Rupees 952421.31 INR) expended for developing his website. The Respondent states that ignoring the Respondent's business interests; the Complainant has filed the present complaint to harass the Respondent. The Respondent argues that the Complainant has no standing to bring this lawsuit due to the Complainant's failure to file a suit within the three year limitation period and therefore the action is time barred under the equitable doctrine of delay and laches. The Respondent further argues that he has a legitimate valid business and financial interests in his matrimonial business "B and P PARIBAS .IN" from 2004.

The Respondent argues that no valid trademark certificate has been filed with the complaint and the document for the Indian trademark "BNP PARIBAS", No. 1261126 filed by the Complainant as evidence shows only an application filed and is not a registered mark. Filing of a trademark application without a registration certification does not "create" rights argues the Respondent. The Respondent also argues that its online matrimonial services are covered under classes 41 and 45, whereas the business activities of Complainant are under classes 35, 36 and 38. The Respondent further argues that even if the Complainant has a valid trademark, the Complainant is precluded from bringing this arbitration action as it failed to commence the proceedings within a period of three years from the date of infringement. Under the Limitation Act of 1963, the period to file a suit for limitation for infringement of a trademark is three years from the date of infringement. Respondent argues that failure to file a suit within the stipulated limitation period makes the action time barred and the complaint is liable to be dismissed.

Hanin Narayana

The Respondent argues that Indian law recognizes that a plaintiff is prevented from asserting any claims and action against a defendant under the equitable doctrine of “estoppel”, “acquiesce”, “delay” and “latches” in trademark infringement cases and cites the case of *Cable News Networks vs. Cam News Network Limited* (C.S. (O.S.) No. 1815/2006 High Court of Delhi, New Delhi): where the Court said “delay by itself not a sufficient defense to an action for interim injunction..... but delay coupled with prejudice caused to the defendant would amount to latches”. The Respondent argues that in 2005 it started its matrimonial portal “Bubly and Papu Pari Bas “ and states that the Respondent has developed its website at a considerable price as the Complainant had abandoned its threat of taking action within forty eight hours as per its notice of June 27 2005.

The Respondent further argues that the disputed domain name does not create any confusion with the Complainant’s trademark due to different classes and areas of business. The Respondent also asserts that the Complainant has failed to show that the Respondent lacks rights in the disputed domain name and reiterates the alleged fairy tale based on which he has registered the disputed domain name and developed his website.

The Respondent contends the disputed domain name ought to be considered as being registered in good faith as the Respondent has shown evidence of its being used in good faith and has not shed any negative light on the Complainant. The Respondent explains that at one time he was willing to accept 20,000 Euros as a settlement payment in good faith to recover the costs of developing of his website. The Respondent states the Complainant’s bad faith is shown by intentionally portraying the Respondent as a cyber squatter and in not recognizing another person’s concurrent business interest for using the name for a totally different purpose. The Respondent reiterates the Complainant’s silence for failing to register the disputed domain name during the Sunrise period and requests for complaint to be dismissed with costs.

Discussion and Findings

Under the .IN Policy, the registrant of the domain name is required to submit to a mandatory arbitration proceeding in the event that a complaint is filed in the .IN Registry, in compliance with the .IN Policy and the INDRP Rules.

The .IN Policy, Paragraph 4 requires the Complainant, to establish the following three elements:

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

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Identical or Confusingly Similar

The first element requires the Complainant to prove that the domain name registered by the Respondent is identical or confusingly similar to a mark in which the Complainant has rights.

The Arbitrator finds from the documents on record¹ that the Complainant is the owner of international trademark registrations including the Community Trademark registration CTM No. 473639 for the word mark BNP PARIBAS in classes 9, 35, 36 and class 38.

The Complainant has also submitted a document that shows that it has filed a trademark application in India in the year 2004 for its trademark BNP PARIBAS² in classes 35, 36 and class 38. This establishes the Complainant had adopted the mark in India prior to the registration of the disputed domain name.

The Arbitrator further finds that the Respondent has acknowledged the Complainant's rights in the BNP PARIBAS mark by asserting that the Complainant as the owner of the mark and ought to have registered the disputed domain name during the sunrise period. Based on these materials on record the Arbitrator finds that the Complainant is the owner of the BNP PARIBAS mark and has valid rights in the said mark.

The Arbitrator finds the disputed domain name entirely incorporates the Complainant's trademark BNP PARIBAS. When a trademark is found to be the distinctive part of a domain name in dispute it is considered to be identical or confusingly similar to the trademark. See *DHL v. DHL Packers*, WIPO Case No. D2008-1694. The country code top-level domain (cc TLD) suffix ".in" does not lessen the confusing similarity of the domain name with the trademark. See for instance *Morgan Stanley v. Bharat Jain*, INDRP Case No. 156 dated October 27, 2010. For the reasons discussed the Arbitrator finds the disputed domain name is virtually identical and is confusingly similar to the Complainant's mark BNP PARIBAS.

The Arbitrator finds that the Complainant has satisfied the first element under paragraph 4 of the Policy.

Rights and Legitimate Interests

The second element requires the Complainant to show that the Respondent has no rights and legitimate interests in the disputed domain name.

¹ From the communication of Complainant to Respondent dated October 8, 2010. The Arbitrator had verified online the validity of the Complainant's CTM trademark as the Complainant has omitted filing the documents of its valid trademark registrations.

² BNP PARIBAS Indian Trademark application No. 1261126 dated January 14, 2004.

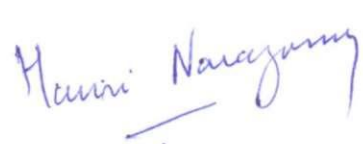
Havini Narayana ⁹

The Complainant has asserted that the Respondent has no rights or legitimate interests in the disputed domain name, as the Respondent has not been given any authorization to use the Complainant's mark. Paragraph 7 of the Policy states that a Respondent can establish rights in the disputed domain name, if (i) before notice of the dispute, the registrant had used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services or (ii) the registrant (as an individual, business organization) has been commonly known by the domain name, or (iii) The registrant is making legitimate, non commercial or fair use of the domain name without intent for commercial gain.

The Respondent has argued that he has rights in the disputed domain name as he uses it in connection with his business of providing matrimonial services and has submitted screen shots of his website titled "Bubly and Papu Pari Bas" as evidence. The Arbitrator has considered these arguments and the material submitted by the Respondent and finds the Respondent has not established rights and legitimate interests in the disputed domain name for the reasons that: First, the Respondent has not established that the name "Bubly and Papu Pari Bas" is known as BNP PARIBAS or that it has acquired secondary meaning in an abbreviated form or that the Respondent or his business is commonly known by the disputed domain name. Second, although the Respondent claims use and rights from 2004, he has registered the disputed domain name in 2005 and the Respondent has not provided any material to demonstrate that any preparations were made in connection with a business for a *bona fide* business or offering of goods and services prior to registration of the domain name. Third, after receiving the cease and desist notice from the Complainant, the Respondent has continued to use the domain name and to develop a website. The Respondent was therefore aware that the risk of the Complainant taking action for the recovery of the disputed domain name existed when he developed his website as he was already put on notice. Fourth, the Respondent has not provided convincing material that justifies the adoption of a name that is clearly the trademark or the service mark of the Complainant and was widely associated with the Complainant and its business at the time of registration of the disputed domain name.

The material on record does not show that the Respondent is commonly known by the disputed domain name. The record shows the Respondent is called Nathan Muran and his matrimonial business and website is title "Bubly and Papu Pari Bas", and as discussed the evidence does not support a finding that the Respondent is making any legitimate noncommercial fair use of the disputed domain name. The arguments of the Respondent's business being in a different class or of being an honest concurrent user also do not help the Respondent's case due to the reasons discussed.

In the Arbitrator's view, under the circumstances of the present case, the use of the Complainant's mark in the disputed domain name is likely to mislead the public and Internet users that the disputed domain name may refer to the Complainant and its business. Misleading users by incorporating others trademarks in a domain name gives a false impression to users and does not constitute a *bona fide* offering of goods and services under the Policy. This view has been upheld in several prior decisions including several UDRP cases. See for instance, *Zurich American Insurance Company v.*

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Administrator, Domain, WIPO Case No. D2007-0481 (Use of a confusingly similar or identical domain name to divert Internet users is not use that can be termed a *bona fide* offering of goods and services). For these reasons it is found that the Respondent has not successfully established rights or legitimate interests to use the Complainant's mark in the disputed domain name.

The Arbitrator finds the Complainant has made a *prima facie* case that the Respondent has no rights and legitimate interests in the disputed domain name and has satisfied the second element under paragraph 4 of the Policy.

Bad Faith

The third element under the Policy requires the Complainant to establish that the disputed domain name was registered or is being used in bad faith.

The Complainant has filed documents that establish its prior adoption of the name BNP PARIBAS mark. The Complainant's Indian trademark application was clearly made before the disputed domain name registration. The Complainant's trademark is undoubtedly well known and the Respondent acknowledges and admits the fame of the Complainant's mark as he asserts the Complainant was entitled to make a Sunrise period registration for the disputed domain name.

The geographic location of the parties also does not favor the Respondent's case. The Complainant is a well-known French bank and the Respondent is domiciled in France. It is therefore highly unlikely that the Respondent lacked knowledge of the Complainant's mark that is well known in France and in other countries.

Given these facts it is unlikely that the Respondent did not know of the Complainant's prior rights in the mark when he registered the disputed domain name. The very choice of the domain name is therefore not a mere coincidence but is likely to be a deliberate use of a well-recognized mark to attract unsuspecting users to the Respondent's site. Registration of a domain name, based on awareness of a complainant's trademark rights is recognized as bad faith registration under the Policy *Lego Juris v. Robert Martin*, INDRP / 125.

The facts and circumstances in the present dispute show that the Respondent has not been able to establish that he is a senior user of the mark or that he has rights in the disputed domain name. Under Paragraph 6 (iii) of the Policy, if the registrant of the domain name in dispute, has used the domain name to intentionally attract Internet users to the Registrant's website or other online location by creating a likelihood of confusion with the trademark of another, it is considered evidence of bad faith.

The Panel finds the circumstances here suggest that there is no reasonable explanations for the registration and use of the disputed domain name except that the Respondent seeks to exploit the reputation and goodwill associated with the Complainant's mark to attract

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Internet traffic to the Respondent's website and to mislead customers using the fame associated with the Complainant's mark. The registration and use of a domain name that exploits the goodwill of another's trademark is considered bad faith under the INDRP Policy. See *Eli Lilly and Company v Andrew Yan*, INDRP Case 195, dated February 16, 2011, or See *Genpact Limited v. Manish Gupta*, INDRP/056, or *Advance Magazines Publishers Inc. v. JF Limited, England*, INDRP Case 184, January 27, 2011.

The material on record also shows the Respondent has sought to sell the disputed domain name for an amount in excess of documented out of pocket expenses. The Respondent's counsel has indicated in the communication dated November 23, 2010: "My client will only voluntarily transfer the bnpparibas.in domain name in exchange for financial consideration estimated at 20,000 Euros." The Respondent has filed an invoice showing an amount of Euros 14,352 has been expended towards developing his website and there are no other documents filed by the Respondent to justify the figure of 20,000 Euro that the Respondent expected for the transfer of the disputed domain name.

The Respondent has argued that the Complainant has delayed in filing the present complaint and that the delay in bringing this action ought to be a ground for dismissing the complaint. The Arbitrator recognizes that the Complainant has delayed in taking the action, however it is to be noted that the remedy under the INDRP Policy is an injunctive nature rather than compensatory nature and the basic underlying principle of the Policy is to prevent future confusion of the source of goods or services and delay and laches are generally not a defense in such proceedings. See *Pharmaceutical Product Development, Inc., Pharmaco Investments Inc. v. Damian Macafee (a.k.a James M. VanJohns) QTK Internet/NameProxy/Private Registration*, WIPO Case No.D2011-0637 <ppd.com>. Further the Arbitrator notes the plea of delay and laches was denied in the CNN case cited by the Respondent, (*Cable News Networks vs. Cam News Network Limited* (C.S. (O.S.) No. 1815/2006 High Court of Delhi, New Delhi) .

The delay in taking action or not choosing to register during the sunrise period by the Complainant does not justify the Respondent's use of the Complainant's trademark or condones infringing use of another's trademark³. The Arbitrator is convinced from Complainant's communication to Respondent that the Complainant has informed the Respondent of its rights in the mark in yet the Respondent continued to use the domain name and build a website knowing of the risks in doing so.

The Arbitrator also notes that the Complainant has not objected to the Respondent's original business idea or to the use of the name "Bubly & Papa Pari Bas" by the Respondent. Further, the Respondent can transfer the website he has developed and his business to another non-infringing domain name. Whereas based on the preponderance of the evidence on record and the facts and circumstance in the present case, the Arbitrator finds the Respondent most likely registered the disputed domain name for creating a likelihood of confusion with the Complainant's trademark as to the source of

³ See *Orkin v. Pesco* 80 RPC 153, "A company's reputation in an area where it does not carry on business, is like an asset which has not been put to work, which needs protection. Its non exploitation may be on account of many reasons but there is no reason why the law should not protect such an asset .."

Hanni Narayana

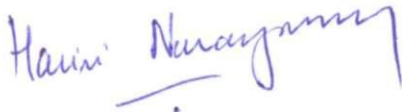
endorsement, which is recognized as bad faith registration and use under the Policy.

For the reasons discussed, the Arbitrator finds the Complainant has established the third element under the Policy.

Decision

The Arbitrator orders costs of One thousand five hundred Euros (1500 EUR) to be paid by the Complainant to the Respondent due to delay in taking the present action.

Upon proof of receipt of the costs of One thousand five hundred Euros (1500 EUR) being paid to the Respondent, the Arbitrator orders the registrar to transfer the disputed domain name <bnpparibas.in> to the Complainant.



Harini Narayanswamy (Arbitrator)

Date: October 31, 2011