उत्तर प्रदेश UTTAR PRADESH

BK 267923

INDRA ARBITRATION
CHIVAS HOLDINGS (IA) LIMITED
v.
WEB MASTER JF LIMITED

INDRP ARBITRATION
THE NATIONAL INTERNET EXCHANGE OF INDIA [NIXI]

ADMINISTRATIVE PANEL DECISION
SOLE ARBITRATOR: RODNEY D. RYDER

CHIVAS HOLDINGS [IP] LIMITED

V.

WEBMASTER JF LIMITED

Disputed Domain Name: www.chivas.co.in

The Parties

The Complainant in this arbitration proceeding is Chivas Holdings [IP] Limited, a company incorporated under the laws of Scotland, having its registered office at 111-113, Renfrew Road, Paisley PA3 4DY, Scotland, United Kingdom. The Respondent in this arbitration proceeding is Webmaster JF Limited having its office at 204 Woodwich Road, Concept Office, London, England. As per the details given by the Whois database maintained by the National Internet Exchange of India [NIXI].

The Domain Name and Registrar

The disputed domain name is www.chivas.co.in. The Registrar with which the disputed domain name is registered is Directi Internet Solutions Pvt Ltd, Directiplex [Dba PublicDomainRegistry.com (RF-AFIN)], Next to Andheri Subway, Old Nagardas Road, Andheri (East), Mumbai, Maharashtra 400069 India.

Procedural History [Arbitration Proceedings]

This arbitration proceeding is in accordance with the .IN Domain Name Dispute Resolution Policy [INDRP], adopted by the National Internet Exchange of India ["NIXI"]. The INDRP Rules of Procedure [the Rules] were approved by NIXI on 28th June, 2005 in accordance with the Indian Arbitration and Conciliation Act, 1996. By registering the disputed domain name with the NIXI accredited Registrar, the Respondent agreed to the resolution of the disputes pursuant to the IN Dispute Resolution Policy and Rules framed thereunder.

According to the information provided by the National Internet Exchange of India ["NIXI"], the history of this proceeding is as follows:

In accordance with the Rules, 2(a) and 4(a), NIXI formally notified the Respondent of the Complaint, and appointed Rodney D. Ryder as the Sole Arbitrator for adjudicating upon the dispute in accordance with the Arbitration and Conciliation Act, 1996, and the Rules framed thereunder, .IN Domain Name Dispute Resolution Policy and the Rules framed thereunder. The Arbitrator submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by NIXI.

The request for submission with a complete set of documents was dispatched to the Respondent by the National Internet Exchange of India [NIXI]. A reminder was sent on April 5, 2013 by the Arbitrator. The Respondent did not reply.

Grounds for the administrative proceedings

1. The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has statutory/common law rights.
2. The Respondent has no rights or legitimate interests in respect of the disputed domain name.
3. The disputed domain name has been registered or is/are being used in bad faith.

Statutory rights of the Complainant:

The Complainant belongs to the Pernod Ricard Group which features as one of the leading players of the wines and spirits. One of the premium and best selling whiskies in the world available in over 90 countries is Scotch whiskey marketed/sold by the Complainant under the trademark Chivas Regal. The Complainant contends that it is the owner of the trademark "Chivas" and "Chivas Regal" and has been using the brands for more than 100 [One hundred] years. The Complainant started using the brand "Chivas Regal" as early as1909, i.e. the year of its incorporation. The mark "Chivas" was derived from the surname of the Chivas Brothers, who ran a grocery business, which later became Chivas Brothers. The Chivas Brothers were renowned for exceptional quality and specialized wines and spirits, maturing and blending their quality whisky in the cellars of at their shop. By the year

1994, Scotch Whisky bearing the trademark "Chivas Regal" was sold in over 150 countries and as of today it is sold in more than 90 countries globally. In 2012 alone, "Chivas Regal" sold a total of 4.9 million litre cases with main markets being USA, Europe, Mexico, China and travel retail outlets including duty free shops in various international airports of several countries including India. The goods of the Complainant bearing the trademark "Chivas" and "Chivas Regal" have been available in various countries globally including Australia, Canada, China, France, Germany and several other countries including India for the past several decades

The complainant holds several domain name registrations incorporating the "Chivas" and "Chivas Regal" trademark, including chivas.com and chivasregal.com

Respondent
The Respondent failed to reply to the notice regarding the complaint.

Discussion and Findings
The Respondent does not have any relationship with the business of the Complainant or any legitimate interest in the mark/brand "Chivas" or "Chivas Regal". Moreover, the Complainant has neither given any license nor authorized the Respondent to use the Complainant's mark. It is a well established principle that that once a complainant makes a prima facie case showing that a respondent lacks rights to the domain name at issue, the Respondent must come forward with the proof that it has some legitimate interest in the domain name to rebut this presumption.

The Respondent's Default
The INDRP Rules of Procedure require under Rule 8(b) that the arbitrator must ensure that each party is given a fair opportunity to present its case. Rule 8(b) reads as follows

> *"In all cases, the Arbitrator shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case."*

Rule 11(a) empowers the arbitrator to proceed with an ex parte decision in case any party does not comply with the time limits or fails to reply against the complaint. Rule 11(a) reads as follows:

> *" In the event that a Party, in the absence of exceptional circumstances as determined by the Arbitrator in its sole discretion, does not comply with any of the time periods established by these Rules of Procedure or the Arbitrator, the Arbitrator shall proceed to decide the Complaint in accordance with law."*

The Respondent was given notice of this administrative proceeding in accordance with the Rules. The .IN Registry discharged its responsibility under Rules paragraph 2(a) to employ reasonably available means calculated to achieve actual notice to the Respondent of the Complaint.

As previously indicated; the Respondent failed to file any reply to the Complaint and has not sought to answer the Complainant's assertions, evidence or contentions in any manner. The Arbitrator finds that the Respondent has been given a fair opportunity to present his case.

The 'Rules' paragraph 12(a) provides that the Arbitrator shall decide the Complaint on the basis of the statements and documents submitted in accordance with the INDRP and any law that the Arbitrator deems fit to be applicable. In accordance with Rules paragraph 12, the Arbitrator may draw such inferences as are appropriate from the Respondent's failure to reply to the Complainant's assertions and evidence or to otherwise contest the Complaint. In the circumstances, the Arbitrator's decision is based upon the Complainant's assertions and evidence and inferences drawn from the Respondent's failure to reply.

The issues involved in the dispute
The Complainant in its complaint has invoked paragraph 4 of the INDRP, which reads:

"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 Respondent's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;
(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.

The Respondent 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."

According to paragraph 4 of the INDRP, there are 3 essential elements of a domain name dispute, which are being discussed hereunder in the light of the facts and circumstances of this case.

Parties Contentions

Complainant
The Complainant in his complaint, interalia, contended as follows:

I. The Respondent's domain name is identical and confusingly similar to a name, trademark or service in which the Complainant has rights.

The Complainant, based on various Indian and international trademark registrations across various classes owns the trademarks "Chivas" and "Chivas Regal" and several other trademarks bearing the word "Chivas" or "Chivas Regal". As a cumulative result of prior and bonafide use of the trademark "Chivas" in relation to the goods offered by the Complainant, the extensive and continuous use and the resultant accrual of reputation and goodwill, the Complainant has acquired common law rights in the use of the trademark Chivas Regal.

The Complainant submits that as the disputed domain name is 'www.chivas.co.in, it is clearly identical/confusingly similar to the Complainant's trademark – "Chivas" in which the Complainant has exclusive rights and legitimate interest.

It has been proved by the Complainant that it has intellectual property, particularly trademark rights, and other rights in the mark "Chivas" by submitting substantial documents. The mark has been highly publicized and advertised by the Complainant in both the electronic and print media; both in India and globally and the disputed domain name is similar to that of the Complainant's mark, services and domain names.

The Supreme Court of India passed a judgement in 2004 where it held that a domain name has all the characteristics of a trademark, thus trademark and a domain name although used in a different manner and in different fields, can be identical or confusingly similar. **[Relevant Decision:** *M/S Satyam Infoway Ltd. V. M/S Siffynet Solutions (P) Ltd.,* JT 2004 (5) SC 41]

The blatant and malafide adoption by the Respondent also leads to dilution and erosion of the uniqueness and exclusivity associated with the Complainant's trademark, by reducing the Complainant's capacity to identify and distinguish the goods as originating from a particular source, regardless of the presence or absence of likelihood of confusion, mistake or deception.

A mere glance at the disputed domain name gives rise to enormous confusion as to its origin. The disputed domain name registered by the Respondent is identical to the Corporate as well as the trademark of the Complainant. The complainant enjoys statutory and common law proprietary rights over the trademark "Chivas" and the public identify the said trademark exclusively with the complainant and no one else. When a domain name contains a trademark in its entirety, the domain name is identical or at least confusingly similar to the trademark. [**Relevant Decisions**: *Lego Juris A/S v. Robert Martin,* INDRP/125, (February 14, 2010)*; G.A. Modefine S.A. v. Naveen Tiwari,* INDRP/286, (February 20, 2009)]

According to the INDRP paragraph 3, it is the responsibility of the Respondent to find out before registration that the domain name he is going to register does not violate the rights of any proprietor/brand owner.

Paragraph 3 of the INDRP is reproduced below:

"The Respondent's Representations -
By applying to register a domain name, or by asking a Registrar to maintain or renew a domain name registration, the Respondent represents and warrants that:

- *the statements that the Respondent made in the Respondent's Application Form for Registration of Domain Name are complete and accurate;*
- *to the Respondent's knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party;*
- *the Respondent is not registering the domain name for an unlawful purpose; and*
- *the Respondent will not knowingly use the domain name in violation of any applicable laws or regulations.*

It is the Respondent's responsibility to determine whether the Respondent's domain name registration infringes or violates someone else's rights."

Respondent
The Respondent as stated above has failed to respond to the Complainant's complaint and assertions. The Respondent has failed in his responsibility discussed above and in the light of the pleadings and documents filed by the Complainant; The Panel comes to the conclusion that the disputed domain name is identical with or deceptively similar to the Complainants' marks and its business. Accordingly, the Panel concludes that the Complainant has satisfied the first element required by Paragraph 4 of the INDRP.

II. The Respondent has no rights or legitimate interests in respect of the disputed domain name

Complainant
The second element that the Complainant needs to prove and as is required by paragraph 4(ii) of the INDRP is that the Respondent has no legitimate right or interests in the disputed domain name.

Once the Complainant makes a prima facie case showing that the Respondent does not have any rights or legitimate interest in the domain name, the evidentiary burden shifts to the Respondent to rebut the contention by providing evidence of its rights or interests in the domain name.

The Respondent cannot have any right or legitimate interest in the disputed domain name because the disputed domain name incorporates the "Chivas" mark in its entirety, a mark in which the Complainant has the sole and exclusive right and that has become well known owing to the Complainant's efforts.

Furthermore, the Respondent whose name is Webmaster JF Limited is not commonly known by the disputed domain name nor does the Respondent actually engage in any business or commerce under the name "Chivas Regal" or "Chivas". [**Relevant Decision:** *Etro S.p.A v. M/S Keep Guessing*, INDRP/024 (June 27, 2007)].

The Respondent has no active business in the name of "Chivas" or "Chivas Regal". The Respondent is not a licensee of the Complainant, nor has the Respondent ever been authorized by the Complainant to use the Complainant's trademarks or register the disputed domain name. The Complainant has no relationship with the Respondent. [**Relevant Decision:** *Charles Jourdan Holding AG v. AAIM*, D2000-0403 (WIPO, June 27, 2000)]

Respondent
The Respondent has failed to respond to the Complainant as noted above.

For these reasons, the Arbitrator finds that the Respondent has no rights or legitimate interests in the disputed domain name.

III. The disputed domain name has been registered or is being used in bad faith.

Complainant
It has been contended by the Complainant that the Respondent has registered the disputed domain name in bad faith. The language of the INDRP paragraph 4(iii) is clear enough, and requires that either bad faith registration or bad faith use be proved.

Paragraph 6 of the INDRP provides that the following circumstances are deemed to be evidence that a Respondent has registered and used a domain name in bad faith:

"Circumstances indicating that the Respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or

the Respondent 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 Respondent has engaged in a pattern of such conduct; or

by using the 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 its Website or location or of a product or service on its Website or location."

From the circumstances of the case and from the evidences put before the Panel by the Complainant, the Panel is of the opinion that the Respondent had no previous connection with the disputed domain name and any use of the disputed domain name by the Respondent, would result in confusion and deception of the trade, consumers and public, who would assume a connection or association between the Complainant and the Respondent. It must also be noted that the registration of the domain name www.chivas.com by the Complainant was a constructive notice to the Respondent on the Complainant's rights in the "Chivas" or "Chivas Regal" mark and the domain name. Thus, the adoption of an identical trademark/domain name **[www.chivas.co.in]** by the Respondent is very much in bad faith.

It is also a well settled principle that the registration of a domain name that incorporates a well-known mark by an entity that has no relationship to the mark is evidence of bad faith. [**Relevant Decision**: *The Ritz Carlton Hotel Company LLC v. Nelton! Brands Inc.,* INDRP/250 (December 30, 2011)]

Further, the disputed domain name does not resolve to any website. It is well settled that the registration of a domain name that incorporates a third party mark without any legitimate commercial interest is evidence of bad faith registration and use of the domain name. [**Relevant Decision:** *Franklin Resources, Inc. and Franklin Templeton Asset Management (India) Pvt. Ltd v. Mr. David Dlugitch,* INDRP/076 (January 15, 2009)]

The Respondent's registration of the domain name meets the bad faith elements set forth in the INDRP. Since the trademarks of the Complainant are so distinctive and famous that the Respondent must have had actual knowledge of the trademarks prior to registering the disputed domain name. The Complainant has a long and well-established reputation in the Complainant's marks through its exclusive production of high quality scotch. There cannot be any doubt from the evidence put before this panel that the Complainant's marks are well known and that the Respondent intended to capitalize on that confusion. Therefore the panel comes to the conclusion that the registration is in bad faith. By registering the disputed domain name with actual knowledge of the Complainant's trademark, the Respondent acted in bad faith by breaching its service agreement with the registrar because the Respondent registered a domain name that infringes upon the Intellectual Property rights of another entity, which in the present scenario is the Complainant. [**Relevant Decision:** *Ray Marks Co. LLC v. Rachel Ray Techniques Pvt. Ltd.*, INDRP/215 (July 9th 2011); *Kenneth Cole Production Inc. v. Viswas Infomedia,* INDRP/93 (April 10, 2009)]

Respondent

The Respondent has failed to respond to the Complainant as noted above.

Consequently it is established that the disputed domain name was registered in bad faith as well as used in bad faith

Decision

The following circumstances are material to the issue in the present case:

(i) the Complainants' trademark has a strong reputation and is widely known on a global basis;

(ii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the disputed Domain Name;

(iii) taking into account the nature of the disputed domain name and in particular the .in extension alongside the Complainant's mark, which would inevitably associate the disputed domain name closely with the Complainant's group of domains in the minds of consumers, all plausible actual or contemplated active use of the disputed Domain Name by the Respondent is and would be illegitimate. Use by the Respondent as such would amount to passing off, an infringement of

consumer protection legislation, or an infringement of the Complainant's rights under trademark law.

The Respondent failed to comply with Para 3 of the INDRP, which requires that it is the responsibility of the Respondent to ensure before the registration of the impugned domain name by him that the domain name registration does not infringe or violate someone else's rights. The Respondent should have exercised reasonable efforts to ensure there was no encroachment on any third party rights. [**Relevant Decisions**: *Salmi Oy v. PACWEBS* WIPO Case No. D2009-0040; *Graco Children's Products Inc. v. Oakwood Services Inc.* WIPO Case No. D2009-0813; *Artemides Holdings Pty Ltd v. Gregory Ricks,* WIPO Case No. D2008-1254; *Ville de Paris v. Jeff Walter,* WIPO Case No. D2009-1278].

The Complainant has given sufficient evidence to prove extensive global trademark rights on the disputed domain name. Further, the Respondent's adoption and registration of the disputed domain name is dishonest and malafide.

While the overall burden of proof rests with the Complainant, panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is often primarily within the knowledge of the Respondent. Therefore a Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests. Once such *prima facie* case is made, Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. Thus it is clear that the Respondent is using the disputed domain name in bad faith and 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.

[**Relevant decisions**: *Lego Juris AS v. Robert Martin* INDRP/125; *Societe Air France v. DNS Admin* INDRP/075; *Kelemata SPA v. Mr Bassarab Dungaciu WIPO D2003-0849; Croatia Airlines d.d. v. Modern Empire Internet Ltd.* WIPO D2003-0455; *Uniroyal Engineered Products , Inc. v. Nauga Network Services* WIPO D2000-0503; *Microsoft Corporation v. Chun Man Kam* INDRP/119; D2012-0466 WIPO *Luigi Lavazza S.p.A. v. Noori net;* D2008-1474 WIPO *Serta Inc. v. Charles Dawson*; *Netflix, Inc. v. Sharma,* INDRP/216 (INDRP July 1, 2011); *Guerlain S.A. v. Peikang*, D2000-0055 (WIPO March 21, 2000]; *Univ of Houston Sys, v. Salvia Corp.*, FA 637920(Nat. Arb. Forum March 21st 2006); *Red Hat, Inc. v. Haecke*, FA 726010 (Nat. Arb. Forum July 24th 2006; *Lockheed Martin Corporation v. Steely Black,* INDRP/183 (January 5, 2011); *Equifax Inc. v. The Admin,* INDRP/163 (November 23, 2010);, *Revlon Consumer Products Corporation of New York v. Ye Genrong, et al,* D2010-1586 WIPO November 22, 2010]

The Respondent's registration and use of the domain name [www.chivas.co.in] is abusive and in bad faith. The Respondent has no rights or legitimate interests in respect of the domain name. In accordance with Policy and Rules, the Panel directs that the disputed domain name [www.chivas.co.in] be transferred from the Respondent to the Complainant; with a request to NIXI to monitor the transfer.

Rodney D. Ryder
Sole Arbitrator
Date: May 1, 2013