



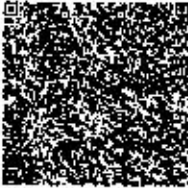
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INDIA NON JUDICIAL

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Certificate No.	: IN-DL61794889381461R
Certificate Issued Date	: 28-Sep-2019 03:56 PM
Account Reference	: IMPACC (IV) dl717303/ DELHI/ DL-DLH
Unique Doc. Reference	: SUBIN-DL71730331849474954794R
Purchased by	: V K AGARWAL
Description of Document	: Article 12 Award
Property Description	: Not Applicable
Consideration Price (Rs.)	: 0 (Zero)
First Party	: V K AGARWAL
Second Party	: Not Applicable
Stamp Duty Paid By	: V K AGARWAL
Stamp Duty Amount(Rs.)	: 100 (One Hundred only)



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Dr. V. K. AGARWAL, Sole Arbitrator
NATIONAL INTERNET EXCHANGE OF INDIA
6C, 6D, 6E, Hansalaya Building,
15, Barakhamba Road,
New Delhi – 110 001

CASE NO. INDRP 1151/2019

V K Agarwal

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2. The onus of checking the legitimacy is on the users of the certificate.
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SUBWAY IP INC., v. Ramaswamy Nathan**AWARD****1. The Parties**

The Complainant is M/s Subway IP Inc., 8400 NW 36th Street, Suite 530, Doral, FL 33166, United States of America .

The Respondent is Mr. Ramaswamy Nathan, No. 43, First Main Road, Raja Annamalaipuram, Chennai, Tamil Nadu 600028, India .

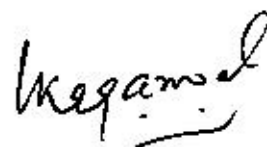
2. The Domain Name and Registrar

The disputed domain name is <www.subway.in>. The said domain name is registered with the Registrar 101domain GRS Limited, 4th Floor, 3, Harbourmaster Place, IFSC, Dublin D01 K8F1, Ireland. The details of registration of the disputed domain name are as follows:

- (a) Domain ID: D2205309 – IN
- (b) Registrar: 101domain, Inc.
- (c) Date of creation: March 09, 2006
- (d) Expiry date: March 09, 2020

3. Procedural History

- (a) A Complaint dated August 27, 2019 has been filed with the National Internet Exchange of India. The Complainant has made the registrar verification in connection with the domain name at issue. The print outs so received are attached with the Complaint as Exhibit B. It is confirmed that the Respondent is listed as the registrant and provided the contact details for the administrative, billing, and technical contact. The Exchange verified that the Complaint satisfied the formal requirements of the Indian Domain Name Dispute Resolution Policy (INDRP) (the "Policy") and the Rules framed thereunder.



- (b) The Exchange appointed Dr. Vinod K. Agarwal, Advocate and former Law Secretary to the Government of India as the sole arbitrator in this matter. The arbitrator finds that he has been properly appointed. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Exchange.
- (c) In accordance with the Policy and the Rules, on 23rd September 2019 an attempt was made by the National Internet Exchange of India to send a copy of the Complaint with all the Annexures, in an envelope, to the Respondent through a courier. However, the courier returned the envelope due to incomplete/wrong address. On the same day, an attempt was also made by the National Internet Exchange of India to send the Complaint with all the Annexures on e mail address of the Respondent. However, no response has been received from the Respondent during this entire period till date. Hence, the present proceedings have to be ex parte.

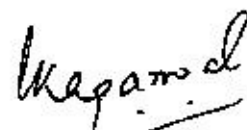
4. Factual Background

From the Complaint and the various annexure to it, the Arbitrator has found the following facts:

Complainant's activities

The Complainant is a public limited company and was founded in the year 1965 in Bridgeport, Connecticut, United States of America. The Complainant is engaged in the business of sandwich shops and the sale of submarine sandwiches (or "subs") in the United States. It also sells wraps, salads, paninis, beverages, chips and baked goods (including cookies).

In the year 1968 the sandwich shop was renamed "Subway". The first Subway shop on the West Coast was opened in Fresno, California, in 1978. The first Subway shop outside of North America was opened in Bahrain in December, 1984. The first Subway shop in the United Kingdom was opened in Brighton in 1996. Complainant now has over 21,000 franchisees — small business owners who operate approximately 40,000 Subway shops in more than 100 countries around the world. Outside of North America, the countries with the most locations are Australia (approximately 1,300), Brazil (approximately 1,900) and the United Kingdom (approximately 2,400). In India alone, Subway has 661 restaurants in operation.



Subway's international headquarters are in Milford, Connecticut, U.S.A. with additional regional centers supporting the company's international operations. The regional offices for European franchises include those located in London (United Kingdom), Amsterdam (Netherlands), Colon (Germany), and Paris (France); the Australian and New Zealand locations are supported from Brisbane (Australia); the Asian locations include offices in China, Japan, South Korea, and Singapore; and the Latin American support center is in Miami, Florida (United States).

The Complainant has also sponsored a number of sporting events, particularly NASCAR races, etc.

Respondent's Identity and Activities

The Respondent's activities are not known.

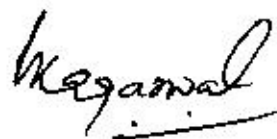
5. Parties Contentions

A. Complainant

The Complainant contends that each of the elements specified in the .IN Domain Name Dispute Resolution Policy is applicable to the present dispute. The said elements are as follows:

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

The Complainant contends that each of the elements specified in the Policy is applicable to this dispute.



In relation to element (i), the Complainant contends that the Complainant is, inter alia, owner of several trademark registrations of the word "SUBWAY" all of which are for the nature of services rendered by the Complainant. These trademarks are registered in different countries. According to the Complaint, following is an illustrative list of such registered trademarks:

Mark	Goods & Services	Reg. No.	Reg. Date
SUBWAY	Cl. 42. Restaurant Services.	1349577 (India)	07-Apr-2005
SUBWAY	Cl. 42 Restaurant services.	1347782 (India)	30-Mar-2005
SUBWAY	Cl. 29 Salads; luncheon meats. Cl. 30 Sandwiches; breads; rolls; pasta, macaroni, rice. Cl. 42 Restaurant services.	000076778 (EUTM)	04-Jul-2001
SUBWAY	IC 042. US 100. G & S: Restaurant Services. FIRST USE: 19670821. FIRST USE IN COMMERCE: 19670821	1174608 (USA)	
SUBWAY	SUBWAY IC 030. US 046. G & S: Relating to the Sale of Food Products-Namely, Specially Prepared Sandwiches Made with Various Ingredients-Namely, Bread, Ham, Pepperoni, Bologna, Roast Beef, Turkey, Pastrami, Salami, Crab, Shrimp, Tuna, Sausage, Meatballs, and Cheese for Consumption On or Off the Premises. FIRST USE: 19670800. FIRST USE IN COMMERCE: 19670800	1307341 (USA)	27-Nov-1984

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Copies of Complainant's abovementioned trademark registrations are provided at Exhibit E. Also provided are copies of trademark assignment documents from Complainant's predecessor Doctor's Associates Inc. to Complainant Subway IP Inc.

According to the Complaint, the said trademark has acquired enormous goodwill and reputation and high degree of distinctiveness, distinguishing and signifying the source of the services as originating from the Complainant's company.

The Complainant contends that the disputed domain name contains the trademark of the Complainant, that is, "SUBWAY". The addition of the generic word "in" in a domain name is insignificant. It does not lead to any distinctiveness or reduce the similarity to the trademark "SUBWAY" of the Complainant. It will not be perceived by the relevant public as a different, eligible to distinguish the Respondent or the services offered under the disputed domain name from the Complainant. Further that, it does not help in distinguishing the disputed domain name from the Complainant's trademark. On the contrary, the disputed domain name leads the public to believe that it relates to the services rendered by the Complainant.

Further, the Complainant is also the registrant and proprietor of domain name registrations at different levels incorporating the word SUBWAY. One such illustration is: <www.domains@subway.com>, etc:

Therefore, the Complainant contends that the disputed domain name is identical and/or confusingly similar to the registered trademark 'SUBWAY' of the Complainant.

In relation to element (ii), the Complainants contend that none of the circumstances mentioned in section 7 of the Policy apply to Respondent in the present dispute.

The Respondent (as an individual, business, or other organization) has not been commonly known by the trademark "SUBWAY". The Respondent does not own any trademark registration as "SUBWAY" or a mark that incorporates the expression "SUBWAY". The Complainant has never assigned, granted, licensed, sold, transferred, or in any way authorized the Respondent to register or use the <Subway.in> domain name or the SUBWAY Mark.

Respondent's actions are not a bona fide offering of goods or services. Respondent's website under the <Subway.in> domain is a classic pay-per-



click page displaying links which divert visitors - likely Complainant's customers and potential customers - to other websites which are not associated with Complainant and, in some instances, are owned by its competitors in the retail restaurant and food business. The Respondent has registered the domain name for the sole purpose of harping upon the goodwill and reputation of the Complainant in the trademark domain name SUBWAY and for creating confusion and misleading the general public.

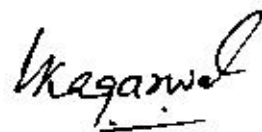
Therefore, the Respondent has no legitimate justification or interest in the disputed domain name.

Regarding the element at (iii), the Complainant contends that the Respondent has registered the disputed domain name in bad faith and for its actual use in bad faith. The main object of registering the domain name <www.subway.in> by the Respondent is to mislead the customers of the Complainant and internet users and the general public. The consumers are visiting the disputed website under the belief that either the said website belongs to the Complainant or there is an association or endorsement of the disputed domain by the Complainant which is not the case.

Respondent uses the domain to confuse and misleadingly divert consumers, or to tarnish the well-known SUBWAY Mark. Such use cannot be considered fair and does not fit into any accepted category of fair use such as comment, criticism, political speech, education, etc. Based upon the global fame of the SUBWAY Mark, those who see the <Subway.in> domain and the resulting pay-per-click links will immediately perceive the domain to refer to Complainant and for the Respondent to claim otherwise would be highly suspect.

Next, bad faith may be found where a Respondent, by using a domain name, intentionally attempts to attract, for commercial gain, Internet searchers to its website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

Therefore, in the present case Respondent intentionally registered and used the disputed domain with knowledge of, and in violation of Complainant's trademark rights. The use of a domain name that appropriates a well-known



trademark to promote competing or infringing products cannot be considered a "*bona fide offering of goods and services*".

The Respondent has not demonstrated any preparations to use the domain name or a name corresponding to the domain name in connection with any bona fide offering of goods or services.

In support of its contentions, the Complaint has relied on a number of decisions. The findings given in the said decisions have been duly considered. It is not necessary to refer them here.

B. Respondent

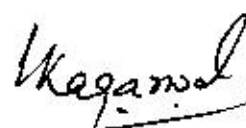
The Respondent did not submit any evidence or argument indicating his relation with the disputed domain name <www.Subway.in> or any trademark right, domain name right or contractual right.

6. Discussion and Findings

The Rules instructs this Arbitrator as to the principles to be used in rendering its decision. It says that, "a panel shall decide a complaint on the basis of the statements and documents submitted by the parties in accordance with the .IN Domain Name Dispute Resolution Policy, the Arbitration and Conciliation Act, 1996, the Rules and any rules and principles of law that it deems applicable".

As has been stated above, according to Clause 4 of the said Policy, the Complainant must prove that:

- (i) The Registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;
- (ii) The Registrant's has no rights or legitimate interests in respect of the domain name that is the subject of Complaint; and



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

A. *Identical or Confusingly Similar*

The disputed domain name <www.Subway.in> was registered by the Respondent on March 09, 2006. The present Complaint is dated August 27, 2019. No explanation is available for the delay of more than 13 (thirteen) years in filing the Complaint.

In the Complaint the Complainant has, as a footnote, stated that, the application of the doctrine of laches has been rejected in domain name disputes. In support of its contentions, the Complainant has relied on the decision in the case of *National Association for Stock Car Auto Racing, Inc. v. Racing Connection/ The Racin' Connection, Inc.*, WIPO Case No. D2007-1524 wherein it has been held that, "...the equitable defence of laches does not properly apply in this Policy proceeding. The remedies under the Policy are injunctive rather than compensatory in nature, and the concern is to avoid ongoing or future confusion as to the source of communications, goods, or services." Since no reply has been received from the Respondent, the same has to be accepted.

The Complainant is an owner of the registered trademark "SUBWAY" as stated above and referred to in the Complaint. The Complainant is also the owner of certain domains with the word "SUBWAY" Most of these domain names and the trademarks have been created and/or registered by the Complainant much before the date of creation of the disputed domain name by the Respondent.

The disputed domain name <www.subway.in> gives rise to the confusion and deception *qua* its origin because the disputed domain name is phonetically, structurally and deceptively similar to the Complainant's trademark/ domain names "SUBWAY". The disputed domain name is instantaneously associated with the Complainants. Further, a possibility that an internet user who wishes to visit the Complainant's website for gathering information, is likely to be taken to the Respondent's website cannot be ruled out. Thus, the internet user may see inaccurate information. It may be detrimental to the Complainant's earned goodwill and reputation.

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Therefore, I hold that the domain name <www.Subway.in> is phonetically, visually and conceptually identical or confusingly similar to the trademark of the Complainant.

B. Rights or Legitimate Interests

According to Clause 7 of the Policy, the Respondent may demonstrate its rights to or legitimate interest in the domain name by proving any of the following circumstances:

- (i) before any notice to the Registrant of the dispute, the Registrant's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the Registrant (as an individual, business or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or
- (iii) The Registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent's response is not available in this case. There is no evidence to suggest that the Respondent has become known by the disputed domain name anywhere in the world. The name of the Registrant/Respondent by which the disputed domain name is registered is Ramaswamy Nathan.

Based on the evidence adduced by the Complainant, it is concluded that the above circumstances do not exist in this case and that the Respondent has no rights or legitimate interests in the disputed domain name.

Further, the Complainant has not consented, licensed or otherwise permitted the Respondent to use its name or trademark "SUBWAY" or to apply for or use the domain name incorporating said mark. The domain name bears no relationship with the Registrant/Respondent. Further that, the Registrant/Respondent has nothing to do remotely with the business of the Complainants.



I, therefore, find that the Respondent has no rights or legitimate interests in the domain name under INDRP Policy, Clause 4(ii) and Clause 7.

C. *Registered and Used in Bad Faith*

According to Clause 6 of the Policy, any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration or use of the domain name in bad faith:

- (i) circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who bears the name or is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented out of pocket costs directly related to the domain name; or
- (ii) the Registrant's has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Registrant has engaged in a pattern of such conduct; or
- (iii) by using the domain name, the Registrant has intentionally attempted to attract the internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.

The contention of the Complainant is that the present case is covered by the circumstances mentioned herein above. There are circumstances indicating that the Respondent has intentionally attempted to attract, for commercial gain, internet users to its web site, by creating a likelihood of confusion with the Complainant's mark. It may also lead to deceiving and confusing the trade and the public.

The Respondent's registration of the domain name <www.subway.in> is

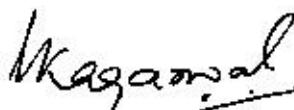
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likely to cause immense confusion and deception and lead the general public into believing that the said domain name enjoys endorsement or authorized by or is in association with and/or originates from the Complainant.

The foregoing circumstances lead to the presumption that the domain name in dispute was registered and used by the Respondent in bad faith.

7. Decision

In light of the foregoing findings, namely, that the domain name is confusingly similar to a mark in which the Complainants have rights, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered in bad faith and is being used in bad faith, in accordance with the Policy and the Rules, the Arbitrator orders that the domain name <www.Subway.in> be transferred to the Complainant.



Vinod K. Agarwal
Sole Arbitrator
Date: 09th October 2019