



தமிழ்நாடு தமில்நாடு TAMILNADU

AR 886289

D. SARAVANAN

Advocate & Arbitrator

"Orient Chambers", 4th & 5th Floor,
No. 90 / 73, Armenian Street,
Chennai - 600 001.

A. VASANTHA

STAMP VENDOR

L. No. 23824 / 83
HIGH COURT CAMPUS
CHENNAI - 600 104.

BEFORE THE SOLE ARBITRATOR MR.D.SARAVANAN
.IN REGISTRY
(C/o. NATIONAL INTERNET EXCHANGE OF INDIA)

Disputed Domain Name: <IOBAN.IN>

3M Company,
220-9E-01 3M Centre
2501 Hudson Road
Saint Paul, MN 55144

..Complainant

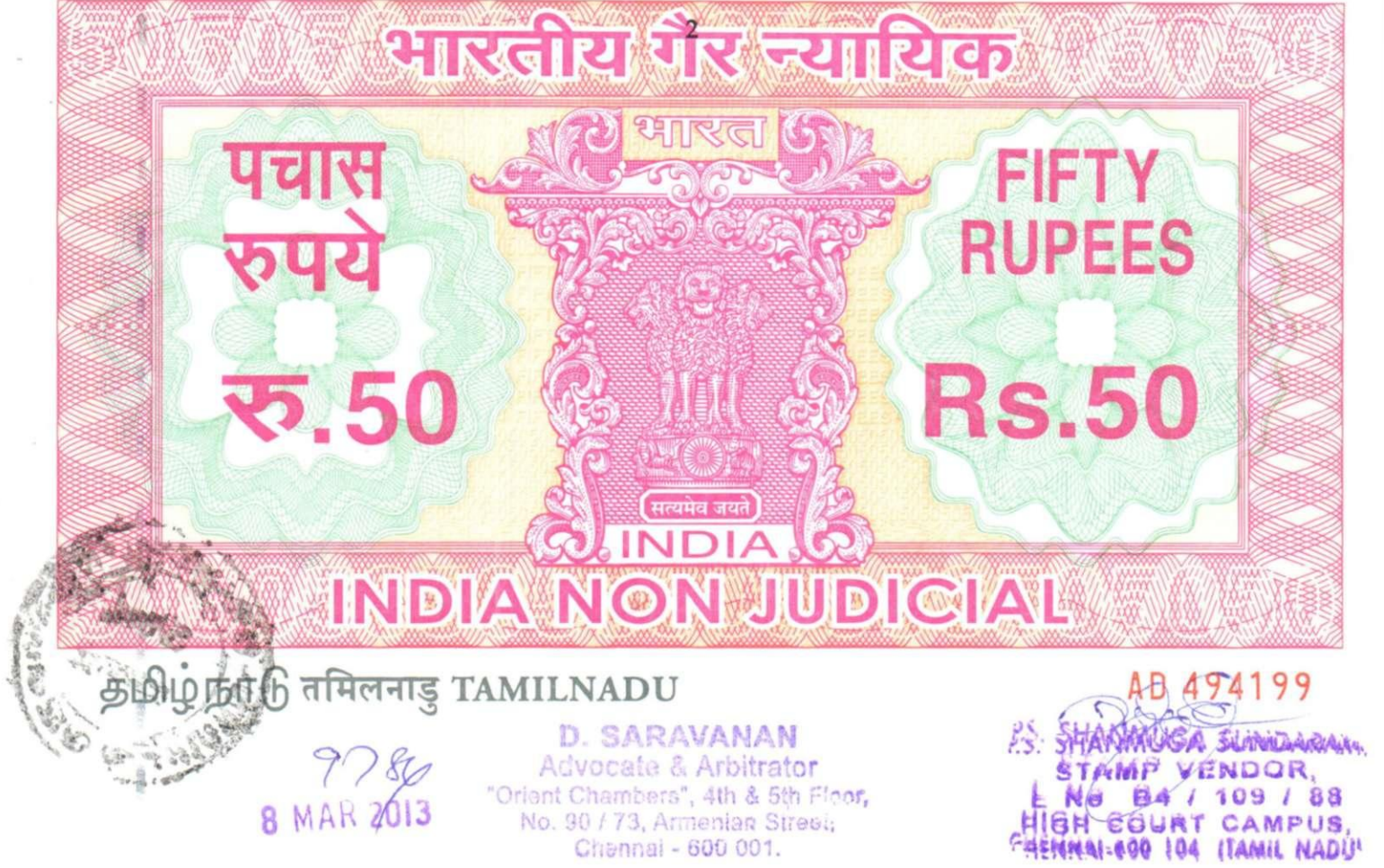
-VERSUS-

Gopinath Goswami
LeBon Impex Private Limited,
401, Deepa Block, Chitra Avenue,
9, Choolaimedu High Road,
Chennai, Tamil Nadu- 600 094
IN.

..Respondent

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1. The Parties:

The complainant is a company registered under the laws of USA having its place of business at 220-9E-01 3M Centre, 2501 Hudson Road, Saint Paul, MN 55144.

The respondent is Gopinath Goswami, LeBon Impex Private Limited, 401, Deepa Block, Chitra Avenue, 9, Choolaimedu High Road, Chennai, Tamil Nadu- 600 094 IN.

2. The Domain Name and Registrar:

The dispute domain name : <IOBAN.IN>

The disputed domain name is registered with .IN Registry through its Registrar Godaddy.com, LLC.

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3. Procedural History:

12.12.2013	The .IN REGISTRY appointed D.SARAVANAN as Sole Arbitrator from its panel as per paragraph 5(b) of INDRP Rules of Procedure.
12.12.2013	Consent of the Arbitrator was given to the .IN REGISTRY according to the INDRP Rules of Procedure.
30.12.2013	Common affidavit and reply statement of the respondent received through email and the same was received through courier on 02.01.2014.
04.01.2014	Notice was sent to the complainant to file rejoinder within 10 days.
14.01.2014	Time was lapsed for filing rejoinder by the complainant.
10.02.2014	Notice of default was sent to the complainant in filing Rejoinder.

4. Factual Background

The complainant is a company registered under the laws of USA having its place of business at 220-9E-01 3M Centre, 2501 Hudson Road, Saint Paul, MN 55144.

4.1 The Complainant:

4.2 Complainant's Activities:

The complainant in the above proceeding is 3M Company founded in 1902. The said company is the owner of IOBAN family of trademarks used in medical products such as antimicrobial incise drapes that contain an iodophor impregnated adhesive and is used for providing a sterile operative surface at the onset of surgery, immobilizing bacteria beneath the drape and reducing the risk of surgical site contamination.



The complainant is renowned for its business in medical products and services such as adhesives, dental products, abrasives, etc. The complainant has global sales of \$30 billion, operating in more than 70 countries, selling its products in nearly 200 countries and employing nearly 88,000 employees globally.

The complainant has authorised third party retailers to sell IOBAN brand dressings globally. The complainant also markets its IOBAN products through its 3M websites in India.

4.3 Complainant's Trading Name:

The complainant has invested substantial sums of money in developing and marketing its products under its IOBAN mark and has developed substantial goodwill and customer loyalty under said marks. The complainant is the owner of numerous registrations for the marks IOBAN in United States. The complainant has provided details of the following marks:

Sr.No.	Trademarks	Goods	Reg.No.	Country
1.	IOBAN	Surgical Drapes	1177064	USA
2.	IOBAN	Surgical Drapes	541723	India

The complainant markets its IOBAN products in its website www.3m.com/ioban. The customers throughout the world recognize IOBAN mark as the complainant's products.

5. Respondent's Identity and activities:

In the above Arbitration proceedings, the respondent is Gopinath Goswami, LeBon Impex Private Limited, 401, Deepa Block, Chitra Avenue, 9 Choolaimedu High Road, Chennai, Tamil Nadu- 600 094, IN.

6. Dispute

The dispute arose when the complainant discovered about unauthorised registration and use of the Disputed Domain name **IOBAN.IN** by the respondent with



Godaddy.com, LLC on or about February 14, 2012. On April 12, 2013, the complainant sent a letter to the respondent demanding to discontinue the usage of alleged domain name.

7. Parties contentions:

A. Complainant:

1) IOBAN.IN is confusingly similar to 3M's IOBAN marks:

The complainant submits that the domain name IOBAN.IN contains 3M's entire IOBAN mark and is identical and confusingly similar to IOBAN mark. The complainant has also relied on following judgements wherein it is held that if a well known trademark was incorporated in its entirety, it is sufficient to establish that a domain name is identical or confusingly similar to the complainant's registered mark: (a) **HSBC Holdings PLC Vs. Hooman Esmail Zedah, M-Commerce Ag**, Case No. L-2/5/R2-HSBC.IN; (b) **Riot Games Inc. Vs. Thomas Lee**; (c) **Google, Inc Vs. Trillion Pay Ltd**; (d) **Bloomberg Finance L.P. Vs. Kanhan Vijay**

2) (i) The respondent does not have any right or legitimate interest in IOBAN.IN

The complainant submits that the respondent has no legitimate right in the domain name since it has had not given permission to use the mark and that the respondent is offering the domain name for sale. The complainant refers to **Lorillard Licensing Co, LLC Vs. Kevin Korho** wherein it was held that the registration of a domain name for the purpose of redirecting the internet users is not a bona fide offering of goods.

(ii) The Respondent has not used the domain name in connection with a bonafide offering of goods or services

The complainant submits that the respondent has registered the domain name with the purpose of tricking the customers into visiting its website instead of trademark owner's website. The complainant submits that such an act is not a bona fide one. The complainant also submits that the sole intention of the respondent is to divert



traffic away from 3M and to commercially benefit from the confusion by having the customers click on the products listed on its website that compete against 3M's own products. The complainant feels that the customers on seeing the domain name in search result are likely to believe that the domain name and the website are affiliated with 3M. Unsuspecting customers are likely to visit the respondent's website because of similar name and the respondent is likely to benefit from such a confusion by making profits which is not bona fide. The complainant relies on following judgements to substantiate its point: **McAfee, Inc Vs. Shenglu; Emirates Vs. Inshallah Ltd; Bank of Am.Corp Vs. Nw.Free Cmty. Access; and Seiko Epson Corporation and Epson America Vs. HM LLC.**

(iii) Respondent has no legitimate right in the domain name as 3M has not granted authorization to respondent to use the name:

The complainant submits that it has not given any permission or authorisation to the respondent to use its mark. The respondent is not a licensee of the complainant. The complainant's prior rights in the domain name precede the respondent's registration and that the respondent is not commonly known by the domain name. The complainant relies on following judgements to substantiate its point: **Riot Games Vs. Thomas Lee; Lorillard Licensing Co, LLC Vs. Kevin Korho; and Gallup Inc Vs. Amish Country Store.**

(iv) Respondent's diversion of traffic to a commercial website is not a legitimate use:

The respondent is using the domain name to commercially compete against 3M. The respondent directs the domain name to a commercial website that displays various commercial products that are linked to a website that sells those and other products. Hence, the respondent benefits the profit gained from such a diversion. The complainant relies on **McAfee, Inc Vs. Shenglu** judgment to substantiate its point:



3) The domain name has been registered and used in bad faith:

The complainant submits that the respondent registering the domain name knowing that the mark is associated with the complainant and with such a knowledge, going ahead with registration, itself shows bad faith.

(i) Respondent registered the domain name in bad faith knowing of 3M's trademark rights in the IOBAN marks:

The complainant submits that the respondent was in notice of 3M's rights at the time of registering the domain name. The complainant further submits that the respondent used 3M's copyrighted images on its websites to create impression that the site was owned and maintained by 3M for its famous IOBAN brand products. Respondent's use of 3M's copyrighted imagery shows respondent knew of 3M and violated 3M's trademark despite that knowledge.

The complainant submits that it had registered its IOBAN mark in India, United States much prior to the registration by the respondent. Hence, the respondent was in constructive notice of knowledge of 3M's trademarks. The complainant relies on following judgements to substantiate its point: **Riot Games Inc Vs. Thomas Lee; Digi Int'l Vs. DDI Sys; Edmunds.com Vs. Ult Search Inc; Lorillard Licensing Co, LLC Vs. Kevin Korho; Immigration Equality Vs. Brent; and Bloomberg Finance L.P. Vs. Kanhan Vijay.**

(ii) Respondent acted in bad faith when it prevented 3M from reflecting its mark in the corresponding domain name:

The complainant submits that the respondent has acted in bad faith by preventing 3M from reflecting its IOBAN trademark in corresponding IOBAN.IN domain name. This leads to respondent capturing the traffic than the complainant. The complainant relies on **Bacarrat SA Vs. Doreen Jungnickel** judgment to substantiate its point:



(iii) Respondent acted in bad faith by intentionally attempting to attract internet users to its website for commercial gain by creating a likelihood of confusion with 3M's marks:

The complainant submits that the respondent has registered the trade mark to trade on the goodwill earned by the complainant by creating likelihood of confusion. The complainant relies on following judgements to substantiate its point: **Lorillard Licensing Co, LLC Vs. Kevin Korho; G.D.Searle & Co Vs. Celebrex Drugstore; and Alta Vista Co Vs. Krotov**

B. Respondent:

The respondent submitted its common response for various challenge of domain names registered by him such as <steridrapien> and <tegaderm.in> including <ioban.in>. The respondent defends himself on the ground that the brand name IOBAN is no longer considered as brand name in India by medical fraternity, but as a generic name only. The respondent submits that he has not registered the domain name in bad faith. The respondent further submits that he is using the domain name for legitimate purpose of SEO (Search Engine Optimisation). The respondent has also invoked the defense of Delay and Laches as the complainant being in existence for so many years failed to register the domain name. Having stated so, the respondent has further stated that he is agreeing for transfer of ownership of the said domains to the complainant unconditionally provided he is paid with an exgratia and compensation.

8. Discussion and Findings:

It has to be asserted as to whether the Constitution of Arbitral Tribunal was proper? Whether the Respondent has received the notice of this Arbitral Tribunal?

Having gone through the procedural history, this Tribunal comes to the irresistible conclusion that the Arbitral Tribunal was properly constituted and Respondent has been notified of the complaint of the Complainant. The Respondent did not object to the constitution of this Tribunal.



Under paragraph 4 of the IN Domain Name Dispute Resolution Policy (INDRP), the Complainant must prove each of the following three elements of its case:

- i. **IOBAN.IN is confusingly similar to 3M's IOBAN marks;**
- ii. **The respondent does not have any right or legitimate interest in IOBAN.IN; and**
- iii. **The domain name has been registered and used in bad faith.**

(a) Identical or confusing similarity:

(i) The Arbitral Tribunal finds that the trade mark **IOBAN** and the disputed domain name **IOBAN.IN** are identical and confusingly similar. The Complainant in its Exhibits 1A & 1B has satisfied this Tribunal that it is the owner of IOBAN Mark. The Complainant uses IOBAN Mark in connection with antimicrobial incise drapes since 30 years. The Complainant owns numerous registrations for trademark IOBAN. The Complainant has given sufficient evidence to prove extensive global trademark rights on the disputed domain name. Moreover, even the respondent in his reply statement and affidavit has not disputed regarding ownership of the Complainant over IOBAN mark. Hence, it is not disputed that the Complainant is owner of IOBAN Mark.

(ii) The Arbitral Tribunal finds that the disputed domain name is simply a combination of the Complainant's IOBAN mark with a suffix .IN. It is very clear that the domain name consists of Complainant's mark in entirety. Hence, this Tribunal comes to the conclusion that the disputed domain name and Complainant's trade mark are identical and confusingly similar.

The Arbitral Tribunal concludes that the Complainant has established paragraph 4(i) of the IN Domain Name Dispute Resolution Policy.



(b) Respondent's Rights or Legitimate Interests:

i) The Complainant contends that the Respondent has no legitimate interest in the trademark IOBAN or the disputed domain name as the respondent is not connected with the Complainant in any way. Paragraph 7 of the IN Dispute Resolution Policy sets out three elements, any of which shall demonstrate the Respondent's rights or legitimate interests in the disputed domain name for the purposes of paragraph 4(ii) of the Policy. The Respondent had been given the opportunity to respond and to present evidence in support of the elements in paragraph 7 of the INDRP. The Respondent in his reply statement and affidavit failed to establish any circumstances that could assist the tribunal in establishing his rights or legitimate interests in the disputed domain name. The Complainant has established a prima facie case of lack of respondent's rights or legitimate interest. The Complainant has established that he is true owner of the IOBAN Marks and it is not disputed by the respondent in his reply statement.

ii) Based on the record, the Respondent does not have rights or legitimate interests in the disputed domain name as the Respondent's current use is neither an example of a bona fide offering of goods or services as required under paragraph 7(i) of the Policy nor is there any legitimate non-commercial or fair use of the disputed domain name and as such there is no evidence that paragraphs 7(ii) or 7(iii) of the Policy apply. The Complainant asserts that they have not licensed or otherwise authorized the Respondent to use their trademark.

iii) The Arbitral Tribunal finds that there is no evidence on record to show that Respondent is known by the disputed domain name or that he has used the disputed domain name in connection with a bona fide offering of goods or has any rights in the disputed domain name.

iv) The Arbitral Tribunal thus holds that the circumstances listed above demonstrate rights or legitimate rights of the complainant in the domain name and holds that the respondent has infringed the rights of the complainant by registering the trademarks of the complainant.



v) The Arbitral Tribunal is satisfied that the Respondent has no rights or legitimate interests in respect of the disputed domain name and, accordingly paragraph 4(ii) of the Policy is satisfied.

(c) Registration and Use in Bad faith:

i) Paragraph 6 of the Policy provides the circumstances evidencing registration and use of a domain name in bad faith are that, by using the same, the Respondent has engaged in a pattern of such conduct and the Respondent has intentionally attempted to attract, for commercial gain, internet users to the Respondent's web site or other online locations, 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 the Respondent's web site or location. It is the specific case of the Complainant that the respondent's modus operandi is by creation of the website under the registered **IOBAN.IN** mark with generic suffix, is seeking illegal commercial gain through its opportunistic bad faith registration of the disputed domain name.

ii) The respondent ought to have known about the brand IOBAN of the complainant as the complainant has been using this brand for more than 30 years and the respondent has been in the same field for about 20 years.

iii) The Respondent has registered the domain name which appears to have been selected precisely for the reason that it is identical or confusingly similar to registered trademarks and trade names of the Complainant. The Respondent has no affiliation with the Complainant. Registration of a domain name that is confusingly similar or identical to a famous trademark by any entity, which has no relationship to that mark, is itself sufficient evidence of bad faith registration and use.

iv) The Arbitral Tribunal finds that the domain name **IOBAN.IN** resolves to a website where the respondent operates an unauthorized online store for Internet users to purchase products identical to the products offered by the complainant.



v) In view of the submitted evidence and in the specific circumstances of this case, this Arbitral Tribunal draws the legal inference that Respondent's purpose of registering the domain name was in bad faith within the meaning of the Policy. The Respondent has no legitimate rights or interests in the disputed domain name and there was a malafide intent for registering the disputed domain name other than for commercial gains, and that the intention of the Respondent was simply to generate revenue, either by using the domain name for its own commercial purpose or through the sale of the disputed domain name to a competitor or any other person that has the potential to cause damage to the ability of the Complainant to have peaceful usage of the Complainant's legitimate interest in using their own trade names.

(d) The respondent attributes delay and laches against the complainant in challenging the domain name. This Tribunal comes to the irresistible conclusion that mere passage of time does not give the respondent right over any trademark. A mere delay in filing of complaint before INDRP or any other dispute resolution body does not lead to forfeiture of rights that would otherwise have which has been upheld by a plethora of cases. If the requirements of a valid complaint under INDRP policy are established, the policy does not provide any defence of delay and laches. Moreover, there is no finding that the complainant did delay unreasonably after first becoming aware of respondent's registration of the disputed domain name. In the case on hand, the disputed domain name came to be registered by the respondent on February 14, 2012 and that the complainant had protested the same on April 12, 2013. Hence, neither delay nor laches can be attributed against the complainant.

(e) The respondent further contends that in India, IOBAN mark is used as generic term by the medical fraternity and that it has lost its trademark status. Such a defence has no merit. And the respondent also failed to prove that the mark has become generic term.

(f) The arbitral tribunal finds that the respondent has 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 anybody's rights. It is the duty of the respondent to ensure that nobody's rights are encroached. The tribunal finds that the respondent has failed to prove that he had accurately and completely made the application form for registration of the domain name; that his registration will not infringe upon third party's rights; that he is not registering for an unlawful purpose and that he will not knowingly use the domain name in violation of any applicable laws.

(g) In the light of the above, this Arbitral Tribunal finds that the Complainant has established that the disputed domain name IOBAN.IN was registered and is being used in bad faith. The respondent has no legitimate interest or rights in the domain name.

9. Decision:

For all the foregoing reasons, in accordance with paragraph 10 of the Policy, the Arbitral Tribunal orders that the disputed domain name <IOBAN.IN > be transferred to the Complainant.

Dated at Chennai (India) on this 3rd day of March, 2014.


(D.SARAVANAN)
Sole Arbitrator