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R 788266

**BEFORE SHRI SANJAY KUMAR SINGH ARBITRATOR
IN DOMAIN NAME DISPUTE RESOLUTION POLICY (INDRP)**

IN RE:

Lazard Strategic Coordination Company LLC,
Rockfeller Plaza,
New York, NY 10020,
USA.

AND

Lazard India Private Limited,
Express Tower, 20th Floor, Nariman Point,
Mumbai-400021, India.

E-mail: Raghav.Rao@lazard.com

COMPLAINANTS

VERSUS

Mr Liu Jiapeng
Room No. 503. Unit 2,
Fuxing Lou, Shaoshui Dong Road
Shaoyang city Human Pro, Shaoyang 422000
China.

E-mail: aucifer212@gmail.com

RESPONDENT

Sanjay Kumar Singh

THE PARTIES:

The complainant is Lazard Strategic Coordination Company LLC, Rockefeller Plaza, New York, NY 10020, USA, & Lazard India Private Limited, Express Tower, 20th Floor, Nariman Point, Mumbai-400021, India, E-mail: Raghav.Rao@lazard.com through its authorized representative, Mr. Rahul Chaudhry, LLS House, Plot No. B-28, Sector 32 (Institutional Area) Gurgaon-122001, India. E-mail: litigation@lls.in.

The respondent is Mr. Liu Jiapeng, Room No. 503. Unit 2, Fuxing Lou, Shaoshui Dong Road, Shaoyang city Human Pro, Shaoyang 422000, China. E-mail: aucifer212@gmail.com

DOMAIN NAME AND TRADEMARK IN DISPUTE:

Domain name of the respondent is "www.lazardfreres.in"

The trademark of the complainant is "LAZARD FRERES".

The Complainant's preferred method of communications directed to the Complainant in this administrative proceeding is Electronic- only material

1. The complainant has submitted that it is the registered proprietor of the trademark LAZARD and is a subsidiary of Lazard Group LLC, which in turn is a subsidiary of Lazard Ltd and its subsidiaries and associates worldwide are a prominent name in the international financial advisory and asset management and have long specialized in crafting solutions to complex financial and strategic challenges. The First complainant and its affiliates and subsidiaries provide advice on mergers and acquisitions, restructuring and capital raising, as well as asset management services, to corporations, partnerships, instituting and capital raising ,as well as asset management services, to corporations partnerships, institutions, governments and individuals.

2. The complainant has submitted that the second Complainant is a company incorporated in the year 1984 under the seal of the Registrar of Companies, Maharashtra and is an indirect subsidiary of Lazard Group LLC and is the permitted user of the trademark LAZARD and its many variations in India.

3. The complainant has submitted that the origins of the Complainants can be traced back to the year 1848 when it was founded in New Orleans, Louisiana. Its founders, the Lazard Brothers, formed Lazard Freres & Co. as a dry goods

Sanjay K. Singh

business, which later became exclusively engaged in the business of financial services, first with its retail clients and then increasingly with commercial clients. Over time the business expanded into banking and foreign exchange businesses. In May, 2005, Lazard ended 157 years of private ownership and began trading publicly on the New York Stock Exchange under the ticker symbol "LAZ". The complainant has submitted a print- out of the Complainants' history from their website as *Annex- I*

4. The complainant has submitted that the first Complainant is the registered proprietor of the trademark Lazard and its numerous variations including LAZARD FRERES in classes 16, 35 AND/OR 36 in 83 different Jurisdictions of the world and its affiliates are owners and registered proprietors of the trademark LAZARD and its variations including LAZARD FRERES in four other Jurisdictions. The complainant has submitted a schedule of worldwide registrations of the Complainants and affiliates for the trademark LAZARD, along with copies of some of the Registration Certificates, showing the trademark LAZARD including LAZARD FRERES as *Annex- III*.

5. The complainant has submitted that the first Complainant is also the registered proprietor in India of the trademark LAZARD and its variations including LAZARD FRERES in classes 16 AND 36. The complainant has submitted the details of the trademark registrations in the name of the first Complainant in India are given below:

| <u>Reg. No</u> | <u>Class</u> | <u>Trademark</u> | <u>Reg Date</u> |
|----------------|--------------|------------------|-----------------|
| 1039307 | 16 | LAZARD | 24/08/2001 |

Goods printed matter of all kinds with respect to business and financial matters, in class 16.

| | | | |
|---------|----|--------|------------|
| 1240315 | 36 | LAZARD | 29/09/2003 |
|---------|----|--------|------------|

Goods: financial services of all kinds: financial advisory services: financial research services; asset management services; unit trust and global fund investment services; financing services; in the nature of debt, equity, partnership and joint ventures; merger, acquisition, restructuring and other corporate finance activities: capital raising services; marketing structuring, negotiating and executing real; estate sales and purchases for others; venture capital and other forms of private

Sanjay K Singh

4.

equity investments; trading of securities and bank debt: advising government and public entities regarding the privatizing an restructuring of public entitles and other financial matters in Class 36.

| | | | |
|---------|----|--------------|-------------|
| 1039310 | 16 | LAZARD ASSET | 24/ 08/2001 |
| | | MANAGEMENT | |

Goods: printed matter of all kinds with respect to business and financial matters, in class 16.

| | | | |
|---------|----|-----------------|-------------|
| 1039308 | 16 | LAZARD BROTHERS | 24/ 08/2001 |
|---------|----|-----------------|-------------|

Goods: printed matter of all kinds with respect to business and financial matters, in class 16.

| | | | |
|---------|----|---------------|-------------|
| 1039309 | 16 | LAZARD FRERES | 24/ 08/2001 |
|---------|----|---------------|-------------|

Goods: printed matter of all kinds with respect to business and financial matters, in class 16.

| | | | |
|---------|----|-------------------------|-------------|
| 1039313 | 16 | LAZARD ASSET MANAGEMENT | 29/ 09/2003 |
|---------|----|-------------------------|-------------|

GOODS: Financial services of all kinds; financial advisory services; financial research services; asset management services; unit trust and global fund investment services; financing services; in the nature of debt, equity, partnership and joint ventures; merger, acquisition, restructuring and other corporate finance activities; capital raising services; marketing structuring, negotiating and executing real estate sales and purchases for others; venture capital and other forms of private equity investments; trading of securities and bank debt; advising government and public entities regarding the privatizing and restructuring of public entitles and other financial matters in Class 36.

| | | | |
|---------|----|-----------------|-------------|
| 1240316 | 36 | LAZARD BROTHERS | 29/ 09/2003 |
|---------|----|-----------------|-------------|

Goods: financial services of all kinds; financial advisory services; financial research services; asset management services; unit trust and global fund investment services; financing services; in the nature of debt, equity, partnership and joint ventures; merger, acquisition, restructuring and other corporate finance activities; capital raising services; marketing structuring, negotiating and executing real estate sales and purchases for others; venture capital and other forms of private

Sanjay per Singh

equity investments; trading of securities and bank debt; advising government and public entities regarding the privatizing and restructuring of public entities and other financial matters in Class 36

1240314

36

LAZARD FRERES

29/09/2003

Goods: Financial services of all kinds; financial advisory services; financial research services; asset management services; unit trust and global fund investment services; financing services; in the nature of debt, equity, partnership and joint ventures; merger, acquisition, restructuring and other corporate finance activities; capital raising services; marketing structuring, negotiating and executing real estate sales and purchases for others; venture capital and other forms of private equity investments; trading of securities and bank debt; advising government and public entities regarding the privatizing and restructuring of public entities and other financial matters in Class 36.

6. The complainant has submitted a schedule of the registrations mentioned above along with copies of registration certificates are annexed hereto and marked as *Annex- IV*.

7. The complainant has submitted that the Complainants and their affiliates and holding and subsidiary companies are the prior adopters and users of the trademark LAZARD and their numerous variations including LAZARD FRERES. The first use of the said mark can be traced to the year 1848 in United States in India, the marks LAZARD and LAZARD FRERES were used for the first time in the year 1993. The second complainant was incorporated on 16th November, 1984 as Credit capital Finance Corporation Limited (CFC). The first Complainant and its associates and affiliated companies invested 25% of the equity capital of CFC on 19th January, 1989 while the name was changed to Lazard Credit capital Limited on 26 April 1995 and subsequently to Lazard India private Limited, Since the first adoption of the mark, the same has been extensively and continuously used the world over and has come to be associated with the Complainants and their services exclusively.

8. The complainant has submitted that the Complainants are well- known the world over by the name of LAZARD and substantial revenue has been generated by the Complainants under the said name The complainants have submitted that they have advised on nearly 1,000 completed mergers and acquisitions having a

Sangay Kar Singh

cumulative value in excess of USD 1 trillion Annual revenue figures of the Complainants for the period 2001-2010 are given in the table below:-

| <u>Year</u> | <u>Revenue</u> |
|-------------|---------------------|
| 2001 | USD 943,606, 000 |
| 2002 | USD 992,094, 000 |
| 2003 | USD 1,094,830,000 |
| 2004 | USD 1,094,830,000 |
| 2005 | USD 1,301, 442, 000 |
| 2006 | USD 1,493,555000 |
| 2007 | USD 1,917,689,000 |
| 2008 | USD 1,557,207,000 |
| 2009 | USD 1,530,518,000 |
| 2010 | USD1,905,368,000 |

The complainant has submitted that the above mentioned figures have been taken from the 2005 and 2009 Annual Reports of LAZARD Ltd, as filed by Lazard with the U.S. Securities and Exchange Commission, and are based on books and records maintained by Lazard Ltd. in the ordinary course of business. The complainant has submitted the pertinent pages of the said Annual Reports as *Annex- V*.

9. The complainant has submitted that in India, the mark LAZARD is very well-known and has often been referred to in media reports and press releases in relation to the Complainants and their services in India and it has been reported in an article published in the December 25, 2008 edition of the magazine Business Today that the Second Complainant is the sixth largest grossing investment bank in India. The complainant has submitted a copy of the said article as *Annex- VI*. The complainant has also submitted a 2005 press release by proctor & Gamble Hygiene & Health Care Limited identified Lazard India private Limited as "a leading merchant banker" and has the copy of the said press release as *Annex-VII*. The complainant has submitted that the mark has also been extensively promoted by the Complainants, internationally as well as in India leading to substantial recognition amongst the general public as to the mark and its association with the Complainants. The complainant has submitted the copies of promotional material issued by the Complainants bearing the mark LAZARD as *Annex- VIII*.

Sanjay K. Singh

10. The complainant has submitted that the trademark LAZARD has also been extensively over the internet to identify the Complainants and to associate the said mark extensively with the Complainants. Relevant information pertaining to the Company and its well known brand is readily available on the website www.Lazard.com and the Complainants and their associate companies have also registered several domain names containing the mark LAZARD, few of which are listed below.

| S. NO | Domain Name | Registrant | Date of registration |
|-------|-------------------------|---|----------------------|
| 1 | Lazardfreres.Com | Lazard Freres & Co. LLC | 07/07/1997 |
| 2. | Lazard-freres.us | Lazard Freres & Co. LLC | 24/04/2002 |
| 3. | Lazardfreres.gestion.fr | Lazard freres Gestion | 01/07/2002 |
| 4. | Lazardfreres.co.uk | Lazard & Co, Holdings Limited | 15/11 2002 |
| 5. | Lazardfreres-banque.fr | Lazard Freres Banque | 30/06/2003 |
| 6. | Lazard freres.fr | Lazard Freres | 09/07/2003 |
| 7. | Lazardfreres.eu | Lazard& Co, Holdings Limited | 10/07/2006 |
| 8. | Lazardfreres.kr | LazardAsia Limited | 18/08/2007 |
| 9. | Lazardfreres.asia | Lazard Freres & Co, LLC | 06/12/2007 |
| 10 | Lazardfreres.net.cn | Lazard Strategic Coordination Company LLC | 11/03/2008 |
| 11. | Lazardfreres.org.cn | Lazard Strategic Coordination Company | 11/03/2008 |

Lazard per. Singh

| | | | |
|------|---------------------|---|-------------|
| | | LLC | |
| 12. | Lazardfreres666.tel | Lazard Strategic Coordination Company LLC | 21 /04/2009 |
| 13. | Lazardfre.info | Von Maltitz Derenberg (Lazard attorneys) | 04/08/2009 |
| 14. | Lazardfreres.biz | Lazard Freres & Co LLC | 26/09/2009 |
| 15 . | Lazardfreres.com | Lazard Freres & Co LLC | 05/05/2010 |

The complainant has submitted the Print-outs from the Complainants' website alone with a schedule associated domain names registered in name of the Complainants and their affiliated and subsidiaries numbering 300 approximately as *Annex-IX*.

11. The complainant has submitted that the trade mark, corporate name and any domain name with the word LAZARD FRERES is associated extensively with the Complainants and their associated Companies, for all of which, the mark forms the forepart and most distinguishing feature of the name, at the same time tying all the said entities in multiple countries to a common group.

12. The complainant has submitted that recently, the Complainants became aware of the website www.lazardfreres.in . The complainant has submitted a Print-out of the whois status of the said website as Annex- X. The complainant has submitted that the said website appears to be a parking page following pay- per-click' format and listing various websites under titles such as play games on ibibo.com' Full movies for free', 'play games on facebook', Learn Guitar @ Gibson.com' and others, which continue to change periodically. The complainant has submitted the Print- outs of the said website as Annex-XI. The complainant has contended that the website is attempting to create confusion in the minds of consumers by associating itself with the complainants and thereby generating revenue by

Sanjay K. Singh

directing the said users, to other websites and other businesses providing other services.

That the present complaint has filed by the Complainants against the Respondent who is the current registrant of the domain name www.lazardfreres.in on the following grounds:

- A) The domain name is identical and confusingly similar to the complainants trademark LAZARD FRERES;
- B) The Respondent has no rights or legitimate interests in respect of the disputed domain name;
- C) The domain name was registered and is being used in bad faith

GROUND:

A. Identical and/or confusing similarity:

I. The complainant has contended that the First complainants, with its affiliates, is the proprietor of the well- known trademark LAZARD and LAZARD FRERES worldwide which has been in continuous and uninterrupted use for over 162 years. The mark LAZARD and its numerous variations including LAZARD FRERES are registered the world over , including in India as is evidenced from paragraphs 4, and 5 above and the *Annexure-III and IV*. The complainants' domain name www.lazardfreres.com which has been registered since July 07, 1997 has acquired distinctiveness and is associated extensively with the business of Complainants. The Complainants and their related companies are the proprietors of Domain Names www.lazardfreres.com , www.lazardfreres.us , www.lazardfreresgestion.fr , www.lazard-freres.co.uk , www.lazard-freres-banque.fr , www.lazard-freres.fr , www.lazardfreres.eu , www.lazardfreres.kr among several others list of which giving details of approximately 300 domain names has been annexed along with the present complaint as *Annexure- IX*.

II. The complainant has contended that the Respondent's domain name www.lazardfreres.in is identical to the Complainants' LAZARD FRERES mark, as it incorporates Complainants' well- known mark in its entirety, In addition to the identical nature of the marks the impugned website of the Respondent also appears to be a parking page following a pay- per click "format and listing

Sangeeta K. Singh

various websites under titles such as "play games on Ibibo.com" full movies for free" play games on facebook" Learn Guitar @ Gibson . com" and others, The website also goes further by providing links to the other website and is bound to cause confusion amongst users wrongfully directed to the website into believing that the same are either endorsed by or in any manner affiliated with the complainants print -out of the pages of the Respondent's website have also been annexed in the present complainant as *Annexure- XI*.

III. The complainant has contended that the links being hosted by the Respondent direct users to other website websites of such as www.ibibo.com , www.gibson.com , www.xgamestation.com etc. It has also been contended by the complainant that the said website has been specifically designed to redirect users from the website of the Respondent to other service providers rendering other services by creating confusion as to the origin of the website and of the links being hosted therein.

IV. The complainant has contended that given the enormous global reputation and goodwill enjoyed by the Complainants, it is apparent that the Respondent has fraudulently acquired the Domain Name www.lazardfreres.in which is identical to Complainants' trademark LAZARD FRERES and is deceptively similar to the trading name/ corporate name of the Complainants and their subsidiary and associated entities, solely with an intention of diverting the consumers to their website and pass their goods and /or services as and for the goods of the Complainants.

V. The complainant has also contended that the Respondent has made use of the entire trademark and trade name of the Complainants as part of its domain name with no distinguishing feature therein giving the impression that the domain name is that of the Complainants, referring to the Indian affiliate or Indian business of the Complainants.

VI. The complainant has placed reliance on the case of Rediff.com India Limited v. Mr. Abhishek Varma & Anr Case No. INDRP/1 (Decided on 03.04.2006) where the Complainant's Trademark and the corporate name was 'Rediff and the Respondent had the registration of the Domain Name, <rediff.in> It has been observed by the complainant that by registering the Domain Name www.rediff.in the Registrant has intentionally attempted to attract Internet

Sanjay K. Singh

users to the Registrant proposed website by creating a likelihood of confusion with the Complainants' name or mark.

VII. The complainant has placed reliance on the case of Kingston Technology Co. v Web Master, Skype Network Limited, Case No INDRP/033 wherein the domain name www.kingston.co.in was held to be identical to the Complainants' mark KINGSTON and the domain name www.kingston.com. The panel also noted that "The Respondent's domain name www.kingston.co.in consists entirely of their trademark, except for .co and .in i.e. ccTLD, thereby the cyber piracy is in apparent from the Respondent's registration and use of Domain Name is a clear case of cyber squatting whose intention is to take advantage of substantial reputation and its prominent presence on the internet in order to confuse the public to the detriment of the Complainant.

VIII. The Complainants have also relied upon the decision of the panel in Hindustan Petroleum Corporation Limited V, M. Ram Swamy Case No, INDRP/059 wherein it was held that , the domain name hindustanpetroleum.co.in is seemingly similar and near to domain name hindustanpetroleum.com and bound to create confusion among users as to its relatedness with hindustanpetroleum.com". Further, the Complainant have also referred to the case of Kentucky Fried Chicken (KFC) Corporation V Webmaster Casinos Ltd Case no. INDRP/066, wherein it was stated that," The Arbitral Tribunal finds that the Complainant' has provided evidences that it possesses registered trademark and logo being KFC. The Respondent's domain name <kfc.co.in>, consists of entirely Complainant's trademark, except ccTLD. Thus, this Arbitral Tribunal came to the irresistible conclusion that the disputed domain name <kfc.co.in> is confusingly similar or identical to the Complainant's marks'

IX. The complainant has also contended that it is well recognized that incorporating a trade mark in its entirety particularly if the mark is an internationally well- known mark, is sufficient to establish that the Domain Name is identical or confusingly similar to the Complainant's registered mark. (Ingersol-Rand Co Frankly Gully d/b/a Advcomren, WIPO Case No D2000-0021), In Boehringer Ingelheim pharma GmbH & Co. KG v. Philana dhimkana WIPO Case No. D2006-1594' where it was held that, if a well known trade mark was incorporated in entirety into a domain name , that is sufficient to

Sanjay pr. Singh

establish that a domain name is identical or confusingly similar to the Complainant's registered trade mark.

B. NO rights or legitimate interests in the domain name:

I. The Complainants have also contended that the respondent neither has any legitimate interest in the mark LAZARD FRERES nor is the lawful owner of any right relating to the Complainant's mark. The Complainants have also contended that the respondent bears no relationship to the business of Complainant' in any country whatsoever and is neither a licensee nor has obtained authorization of any kind whatsoever to use the Complainant's mark.

II. The Complainants have also contended that the respondent has neither been using the said domain name & any name corresponding to the same in relation to any goods or services, to the best of the Complainant's knowledge, nor has he been commonly known by the domain name, which in fact, corresponds and is associated exclusively with the Complainants.

III. The Complainants have also contended that the Complainants' website www.lazardfreres.com was constructed on July 07, 1997 and the use of the mark LAZARD FRERES by the Complainant's or their related companies had commenced as early as 1848. However, the Respondent's website www.lazardfreres.in was constructed not earlier than November 24, 2010 which is fairly recent and at a time when the trade mark LAZARD FRERES has become well-known, The Complainants' being the prior users of the registered and well-known trade mark LAZARD FRERES are the lawful owners of the trade mark corporate name LAZARD FRERES and the Respondent does not have any legitimate interest in the Domain Name which copies in entirety the trade mark domain name of the Complainants.

IV. The Complainants have also contended that the respondent is making an illegitimate and commercial use of the domain name www.lazardfreres.in and deliberately misleading the internet users and diverting Complainants' consumers to the other website in order to tarnish the well-known trade mark and corporate name of the Complainants'

The Complainants have further contended that it is apparent that the use of a domain name identical with that of the Complainants' domain name and trade mark along with the hosting of websites and search option is clearly an attempt

Sanjay Mr. Singh

to create confusion and illegally profit from the resulting association between the Complainants' and the, Further, the Respondent websites is following a "pay" per- click" format and the said manner of use of the websites is clearly commercial.

V. The complainant has placed reliance on the case of Societe Des prodi Its Nestle SA Switzerland v. Nescafe Limited, Case No INDRP/100, wherein it was held that, 'the Respondent has registered the domain name with full knowledge of the complainant's marks and uses it for the purpose of diverting Internet Traffic, which is neither fair use nor non- commercial use. Such facts and circumstances create a rebuttable presumption that the Respondent has no rights in the domain name and is not using it for any legitimate purpose.

VI. The complainant has placed reliance on the case of Croatia Airlines d. d v. Modern Empire Internet Ltd. WIPO Case No.D2003-0455 whereby it was observed that the "Use of a domain name that identical or confusingly similar to a trademark that applies to goods sold by Respondent is a not a bona fide use, if the Domain Name server as a "bait to attract customers to Respondent's website, rather than merely as a descriptor of the Respondents' products (see e.g. Adobe Systems Incorporated v. Domains OZ, WIPO Case No.D2000-0057, <adobeacrobat.Com> and <acrobatreader.Com>).

VII. The complainant has contended that it is to be noted that it has previously been held that" rights or legitimate Interests cannot be created where the user of the Domain Name at issue would not choose such a name unless he was seeking to create an impression of association with the Complainant e Bay Inc. v. Akram Mehmood WIPO Case No DAE2007-0001) and Drexel University v. David Brouda Case No. D2001-0067.

VIII. The complainant has placed reliance on the decision in the case of Kangaroo Kids Education Ltd v. Anupam Devi, Case No INDRP/146, regarding the domain name<www.Kangarookids.in > wherein the panel found that given the prior use and registrations of the distinctive KANGAROO KIDS mark by complainant, the respondent should be held to have actual or at a minimum constructive knowledge of such uses which would also lead to the inference that the same was registered in order to capitalize on the fame and stated, The Respondent has rights or legitimate inter in the domain name further it is

Sangeet K. Singh

apparent that sole purpose of registering the domain name is to misappropriate the reputation associated with the Complainants' trademarks" In the same case, the panel also concluded that this action of the Respondent amounted to Infringement of the Complainant's rights in its trademarks.

IX. The complainant has also contended that the selection by the Respondent of a domain name that includes a well-known trade mark not owned by the Respondent, which is being used to redirect to the websites not affiliated with the trademarks owner is not a bona-fide use and does not confer rights or legitimate interests in the Respondent (Factory Mutual Insurance Company v Rhianna Leatherwood WIPO Case No D2009). Therefore the Respondent is to strict proof, in case he claims of having any legitimate interest in the mark LAZARD FRERES.

X. The complainant has placed reliance on the case of Owens Corning v. NA, WIPO Case No D2007-1143 that where the Respondent wants to argue that it has a legitimate interest in a domain name in relation to genuine product, it is incumbent upon that entity to bring evidence before the panel to the effect that the Domain Name has been or will be used in a manner that satisfies the condition of use laid down in Oki Data Americas Inc v ASD Inc WIPO case No.D2001- 0903.

XI. The complainant has placed reliance on the case of Luxottica Holdings Corp. v. Lokesh Morade, case no. INDRP /139, it was held that "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 interest in the Domain name.

XII. The complainant has placed reliance on the case of disputed Domain Name <www.foodnetwork.in> being Television food Network, G.P. V. Arif Siddiqui, case No INDRP/138 wherein, holding in favour of the Complainant, the panel noted that the Respondent has registered the disputed domain name on 2 June 2005, which is much subsequent to the Complainant's adoption and use of the mark FOOD NETWORK in respect of similar products services since the year 1996. There is no evidence to suggest that the Complainant had authorized or licensed the Respondent's registration or of the Domain Name."

Sanjay K. Singh

XIII. The Complainants have established, through evidence of long and uninterrupted world wide use of the trademark LAZARD FRERES and the long duration and widespread use of numerous domain names containing the mark LAZARD FRERES, that in fact it is the Complainants who are legitimately entitled to the domain name and that the Respondent does not have any right in relation thereto.

C. Registration and use of the domain name in Bad Faith:

- I. The complainant has also contended that the circumstances indicate that the Respondent has registered or acquired the Domain Name with dishonest intention to mislead and the consumers and to tarnish the well-known trade mark/ corporate name LAZARD FRERES of the Complainants.
- II. The complainant has also contended that the respondent has registered and is using the Domain Name bad faith for commercial gain and to benefit from the goodwill and fame associated with Complainants' LAZARD FRERES marks, and from the likelihood that intermit users will mistakenly believe the Domain Name and its associated website are connected to the Complainants and their services.
- III. The complainant has also contended that the respondent has registered and is using the Domain Name primarily for the purpose of disrupting the business of the Complainants and no prior right in and no authorization to use given by the Complainant concerning the LAZARD FRERES trademark.
- IV. The complainant has also contended that respondent is offering to sale the Domain Name, while, clicking on the link provided on the Respondent' web page, the same takes the user to another website, where one has to make an offer for the purchase of the Domain Name. The offer for sale on the Domain Name is a clear evidence of use of the Domain Name in bad faith by the Respondent.
- V. The complainant has also contended that respondent uses the Domain Name www.lazardfreres.in to operate links farms that provide links to other website promoting different products and services. The same itself amounts to evidence of bad faith. The complainant has placed reliance on the case of

Sanjay K. Singh

Television food Network, G, P. v. Arif Siddiqui , case no. INDRP/138 The Arbitrator finds that there is a likelihood that Internet users will be confused as to the source, sponsorship, affiliation, or endorsement of the Respondents website and the services advertised on it considering the Complainants' prior use and adoption of an identical mark/ domain name. The panel stated that, The aforesaid circumstances suggest bad faith registration and use of the Domain"

Further reference is made once again to the case of Microsoft Corporation v. Chun Man Kam, Case No INDRP/ 119, wherein it was held that, "Respondent's purpose of registering the domain name was in bad faith within the meaning of the policy and the Respondent has no legitimate rights or interests in the disputed domain name and there was no real purpose for registering the disputed domain name other than for commercial gains, and the intention of the Respondent 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 the Complainant itself or any other person that has the potential to cause damage to the ability to the Complainant to have peaceful usage of the Complainant's legitimate interest in using their own trade names and registration has intentionally attempted to attract Internet users to its website for commercial gain by intentionally creating a likelihood of confusion with the Complainant's mark, thus misleading consumers"

- VI. The complainant has also contended that respondent is thus not using the Domain Name for legitimate personal or business purpose Instead, it is apparent that the intention of the Respondent is to create initial-user confusion and divert users to its website and thereafter provide links to websites that provide links to websites providing identical or associated services and thereby generating revenue for itself.
- VII. The complainant has also contended that upon information and belief, particularly considering the International fame of Complainant's trademark, including in India Complainants assert that Respondent intentionally registered domain name that is identical to the Complainant' LAZARD FRERES trademark in order to trade off of the goodwill associated with Complainants' marks.

Sanjay K. Singh

- VIII. The complainant has also contended that a Consumer searching for information concerning Complainants is likely to be confused as to whether the Respondent is connected, affiliated or associated with or sponsored or endorsed by Complainants (Exxon Mobil Corp. v. prop Mgmt. prof I, FA 1059655, available at <http://domains.adforum.com/domains/decisions/1059655.htm> use of the Domain Name Exxon.biz to operate a link farm constituted evidence of bad faith: Exxon Mobil Corp. v Exxon Mobil c/o Internet Coordinator, FA1220454, available at <http://domains.adforum.com/domains/decisions/1220454.htm> operation of link farms at domains exxonmobilco.Com and exxonmobilecorp.com established Respondent's bad faith.
- IX. The complainant has also contended that various website owners who are linked though www.lazardfreres.in website operated by the Respondent presumably provide monetary compensation for placement of their addresses and site links upon the website. Upon information and belief, this compensation is based on the number of this the website owners get from being listed on Respondent's site. Accordingly, Respondent receives a direct financial benefit from its diversion of Complainants' potential customers to its site. By creating a likelihood of confusion with the Complainants' LAZARD FRERES trademark by unlawfully capitalizing on the name recognition and goodwill of the LAZARD FRERES trademark to divert Internet traffic to its site, Respondent has undoubtedly registered and been using the Domain Name in bad faith **See id**, Societe Nationale des Chemins de Fer Francais v. Ostrid co, D2008- 0627, (WIPO JUN. 24. 2008) Respondent's use of confusingly similar voyage-scuif-blog.com domain name for pay per-click website deemed bad faith registration and use Yahoo! Inc v Whois privacy protection Serv, Inc, FA 412705, (Nat Arb. Forum, Mar 17, 2005) Busy BODY, Inc v. Fitness Outlet Inc, D2000-0127, (WIPO Apr. 22, 2000) finding bad faith where Respondent attempted to attract customers to its website and created confusion by offering similar products for sale as Complainant.
- X. The complainant has also contended that as such, the manner of use of the domain name www.lazardfreres.in by the Respondent is a clear example of cyber squatting See Homer TLG V. Kang FA 573872, (Nat. Arb Forum Nov. 22, 2005) finding that Respondent's use of hamptonbayc.om could in

Lanjay Mr. Singh

no way be characterized as fair, because consumers would think that they were visiting a site of Complainant's until they found there were in a directory which would do the Complainant potential harm') 15 U.S.C 1125(d)(1)(B)(1) (using domain to divert consumers could harm the goodwill represented by the mark or tarnish or disparage the mark).

- XI. The complainant has also contended that respondent's bad faith and use of the Domain Name is further evidenced by the fact that Respondent has sought to profit from the Domain Name to create an affiliation with Complainants. Respondent's use of Complainants. LAZARD FRERES mark bolsters the reputation of. Respondent's by creating an affiliation with the Complainants. Famous LAZARD FRERES brand
- XII. The complainant has referred the Judgment of this panel in the case of *Identigene, Inc. v. Genetest Laboratories* Case No D2000- 1100 in which It was decided that" Panelist finds that Respondent's use of the Domain Name at issue to resolve to website where services are offered to Internet users is likely to confuse the user into believing that Complainant is source of or is sponsoring the services offered at the site. This constitutes evidence of bad faith registration and use under the policy Moreover the said principle was also upheld in the case of *America online, Inc. v. Cyber Network LLP* Case No D2000-0977 wherein the panel observed that" Respondent's use of the Domain Name at issue to resolve to website where services are offered to Internet users is likely to confuse the user into believing that Complainant is source of or is sponsoring the services offered at the site. This constitutes evidence of bad faith registration and use under the policy Paragraph 4(b) (iv)."
- XIII. The complainant has also contended that the respondent has also made fraudulent and incorrect claims while registering the impugned Domain name since all registrants are required to warrant at the time of registering the domain name, under paragraph 3(b) of the INDRP that, to the Registrant's knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party" and under paragraph 3 (d) that, "the Registrant will not knowingly use the domain name in violation of any applicable laws or regulations".

Sanjay K. Singh

The complainant has prayed for transfer of the domain name "www.lazardfreres.in" to the complainant.

13. A copy of complaint has already been sent to the respondent by the .IN Registry through e-mail. Upon receipt of the complaint, the Arbitrator sent a notice dated on 28-11-2011 to the respective parties to the complaint.
14. On 28-11-2011, I informed the respective parties to the complaint, about my appointment as an arbitrator. Accordingly, I directed the parties to file their counter/ reply and rejoinder with the supportive document/evidence at the e-mail address within 10 (Ten) days from receipt of the notice. But the respondent did not file/submit his defence / counter to the complaint.
15. On 11-12-2011, I directed the respondent to send his defence / counter to the complaint along with supportive documents / evidence at the e-mail address within further 3 (Three) days positively from receipt of the notice. But the respondent has not filed/submitted his defence / counter to the complaint till date despite notice that complaint would be decided on the merits of the complaint. This was also last and final opportunity granted to the respondent.
16. The respondent despite of earlier notices and reminders failed to send his defence / counter to the complaint though the notices were duly served on E-mail ID of the respondent.
17. Therefore, this matter is being decided ex-parte and on the merits of the complaint and as per law of the land.

18. **OPINION/FINDING:**

The para no.4 of the IN Domain Dispute Resolution Policy (INDRP) is as follows:-

TYPES OF DISPUTES

Any person who considers that a domain name conflicts with his legitimate rights or interest may file complaint to .IN Registry on following premises:

Sanjay K. Singh

- "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 has no rights or legitimate interests in respect of the domain name and
- iii) The Registrant's domain name has been registered or is being used in bad faith."

The Para no.6 of the IN Domain Dispute Resolution Policy (INDRP) is as follows:

19. **EVIDENCE OF REGISTRATION AND USE OF DOMAIN NAME IN BAD FAITH**

The following circumstances, in particular but without limitation, if found by the Arbitrator to be present, shall be evidence of the registration and use of a 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 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
- ii) by using the domain name, the Registrant has intentionally attempted to attract Internet users to the Registrant's website or other online 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 Para no.7 of the IN Domain Dispute Resolution Policy (INDRP):-

Sanjay ver. Singh

20. **REGISTRANT'S RIGHTS TO AND LEGITIMATE INTERESTS IN THE DOMAIN NAME**

Any of the following circumstances, in particular but without limitation, if found by the Arbitrator to be proved based on its evaluation of all evidence presented, shall demonstrate the Registrant's rights to or legitimate interests in the domain name for the purpose of paragraph 4 (ii):

- "i) before any notice to the Registrant of the dispute, the Registrant's use of, or demonstratable preparations to use, the domain name or a name corresponding to the domain name in connection with a bonafide offering of goods or services;
- ii) the Registrants (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 fact which is to be dealt with before going into merit is that, as to whether, the cases decided by WIPO-Administrative Panel could be considered, while deciding the present controversy. Moreover, if these cases throw light upon various important aspects of controversy then they could be considered. As such they would be considered, while deciding the present controversy, in so far as they do not conflict with INDRP.

21. **OPINION AND FINDINGS ON MERITS:**

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

It has been held in Indian decision **M/s Satyam Infoway Ltd. Vs. M/s Sifynet Solution (P) Ltd. JT. 2004 (5) SC 541**, that Domain name has all characteristics of trademark. As such principles applicable to trademark are applicable to domain names also. In the said case the words, "Sify" &

Sangam or Singh

'Siffy' were held to be phonetically similar and addition of work 'net' in one of them would not make them dissimilar.

Thus taking into consideration the facts and circumstances of the matter and further the decision passed by the Apex court in M/s Satyam Infoway Ltd. Vs. M/s Siffynet Solution (P) Ltd. JT. 2004 (5) SC 541, the conclusion is that domain name and trademark, which may be used in different manner and different business or field, or sphere, can still be confusingly similar or identical.

Hence the conclusion is that the domain name of respondent is identical and confusingly similar to the trademark of complainant.

Now the other important aspect that needs consideration is, as to whether the complainant has right in the trademark. It is important to mention here that as per the claim of the complainant the respondent has no trademark right on the said domain name. The complainant has submitted sufficient evidence in support of its claims. However, the respondent has not submitted any reply / defence / document/evidence to the complaint of the complainant in spite of repeated notices from the arbitrator.

Thus the conclusion is that the domain name "www.lazardfreres.in" is identical and confusingly similar to the trademark of complainant "LAZARD FRERES" and the complainant has established that he has right in the trademark "LAZARD FRERES".

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

It is pertinent to mention here that paragraph 4 (ii) of INDRP is to be read with paragraph no.7.

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

Sangeet K. Singh

assertions regarding the fact that respondent has got registered the disputed domain name in the .IN Registry for which the respondent has no right or trademark. As such in above circumstance it is clear that the complainant has prima facie discharged the initial onus cast upon him by virtue of paragraph 4(ii) and 7 of INDRP.

The respondent on other hand has not come forward in spite of repeated notices to file any reply / counter or to provide any positive, cogent and specific evidence that it is known or recognized by domain name. The respondent has neither put forth nor has provided such evidence in his support.

Thus the conclusion is that respondent has no right or legitimate interest in the domain name.

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

It is to be seen as to whether the domain name has been got registered in bad faith. The paragraph no.4 (iii) and 6 are relevant and as already stated, the onus is primarily upon complainant.

Taking in to consideration and keeping in view aforesaid facts and circumstances it is clear that the respondent has registered the disputed domain name and in spite of repeated notices, he has neither filed any reply /counter nor has filed any substantial evidence in its support. The complainant has submitted sufficient evidence in support of the complaint.

Thus, taking in to consideration facts and circumstances of the cases and reliance placed by the complainant, the conclusion is that the respondent has got registered his domain name "www.lazardfreres.in" in bad faith.

RELIEF

In view of the above mentioned facts and reasons, I hold that the respondent has registered in bad faith. Respondent's domain name "www.lazardfreres.in" is identical and confusingly similar to trademark of complainant. The respondent also does not have right or legitimate interest in the domain name. The respondent has got it registered in bad faith as

Sangeet K. Singh

24.

such is not entitled to retain the domain name. The complainant is entitled to transfer of domain name "www.lazardfreres.in", as complainant has established the bonafide rights in trademark as per discussion mentioned above. Hence, I direct that the Domain name "www.lazardfreres.in" be transferred to the complainant by registry as rules and the procedures and on payment of requisite fee to the registry.

No order as to costs.

Delhi

Date: 05-02-2012.



(Sanjay Kumar Singh)
Arbitrator