

ఆంధ్రప్రదేశ్ ఆంధ్ర ప్రదేశ్ ANDHRA PRADESH M. Saritha Devi R 218037

SL No. : 110 Date: 03-01-2012 Rs.50/-
 Sold to : Harini Narayanaswamy
 W/o : B. Narayanaswamy
 For Whom: Self
 R/o: Plot No.545A, Road No.86, Jubilee Hills, Hyd

M. SARITHA DEVI
 LICENCED. STAMP VENDOR
 LIC. No: 16 - 04 - 1/2005
 REN. No. 16 - 04 - 32/2011
 H. No.8-3-903/F/1, Opp. Image Hospital,
 Nagarjuna Nagar Road, Ameerpet,,
 HYDERABAD (SOUTH) DISTRICT,
 Phone No: 040-23759009, 9290118899.

BEFORE THE NATIONAL INTERNET EXCHANGE OF INDIA

ARBITRATION AWARD

In The Matter Between

Multi Wing International A/s

Complainant

Versus.

Patrick Hogrefe
 Wingfan GmbH

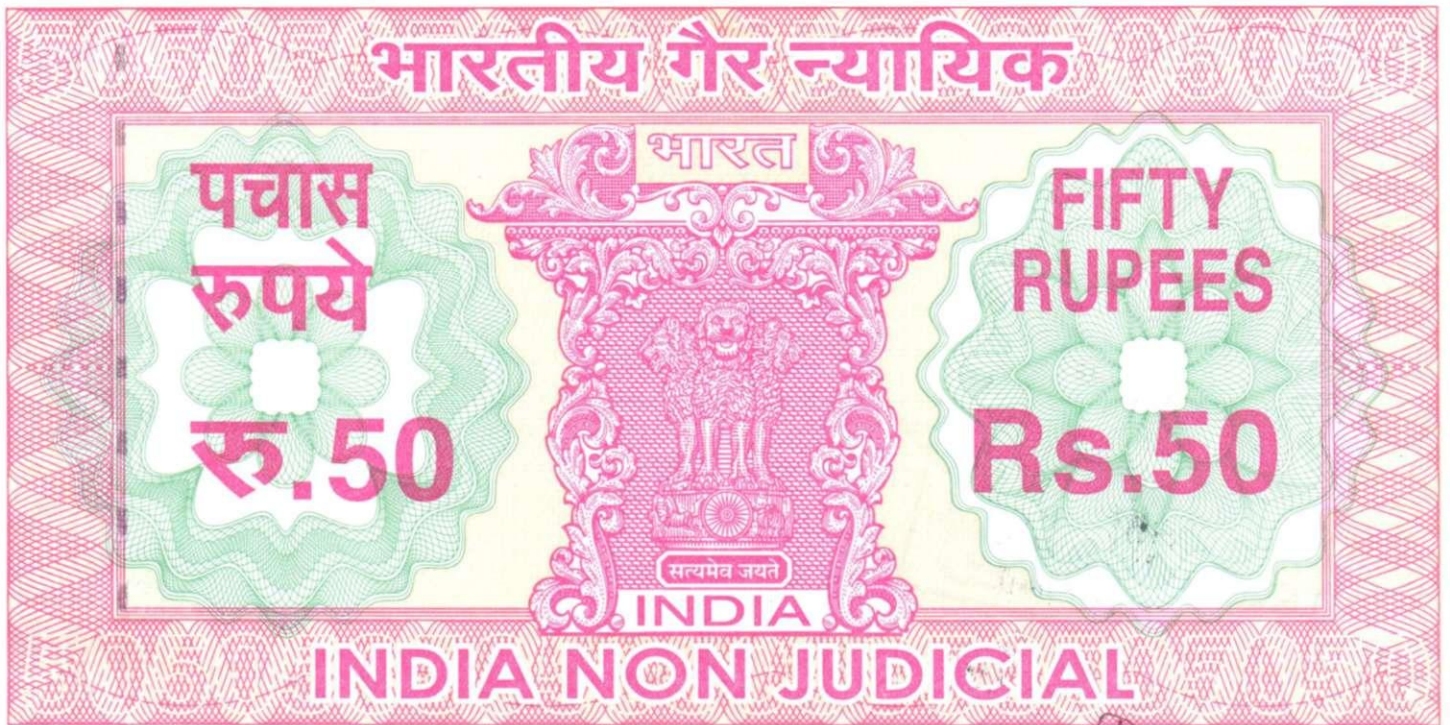
Respondent

1. The Parties

The Complainant is Multi Wing International a/s, of Denmark represented in these proceedings by Link Legal of Delhi, India.

The Respondent is Patrick Hogrefe of Wingfan, GmbH et Co. KG Marlowring 7, Hamburg 22525 German, appearing pro se.

Harini Narayanaswamy



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1. The Domain name, Registrar and Policy

This Arbitration pertains to a dispute regarding the domain name <multiwing.in>. The registrar for the disputed domain name is United-Domains AG.

The Arbitration proceeding is conducted in accordance with the Arbitration and Conciliation Act of 1996 (India), the .IN Domain Name Dispute Resolution Policy (the "INDRP Policy" or "Policy"), and the INDRP Rules of Procedure (the "Rule").

Harini Narayanaswamy

3. Procedural History

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

The Arbitrator received the Complaint from the .IN registry on March 15, 2012 and on March 16, 2012 transmitted by email a notification of commencement of the arbitration proceedings to the Respondent. Under the INDRP Rules, copies of the said notification were sent to other interested parties to the dispute. The Respondent was given twenty-one days time from the date of the notification to file a response. The Respondent did not reply to the notification of March 16, 2012. In response to a second notification dated April 23, 2012 the Respondent sent an email reply on April 27, 2012. The Complainant filed a rejoinder to the response on May 4, 2012 and the Respondent was given time till May 10, 2012 to file a reply to the rejoinder. The Respondent requested for additional time to respond to the Complainant's rejoinder and two days additional time was granted. The Respondent requested for further time till May 22, 2012 to make its submissions. The Arbitrator expressed inability to extend the time unless the parties jointly agreed to extend the date of the Arbitration proceedings, as the decision was due on May 15, 2012 under the INDRP rules. No consensus was received from the parties to extend the date of the proceedings, and the Respondent sent its reply to the rejoinder on May 15, 2012. The Arbitrator now proceeds to determine the case on its merits.

Factual Background

The Complainant is a Danish company that manufactures and markets axial fan impellers under the trademark MULTI WING. It has worldwide trademark registrations for the mark and has filed certified copies of its Indian trademark registrations for MULTI-WING, bearing registration No.1128723 dated August 28, 2002 under class 7 for fan

Harini Narayanswamy

blades (parts of machines) and No. 1128726 dated August 28, 2002 under class 11 for fan blades for ventilation systems included in class 11. The Complainant has also filed a list of several top level and country level domain names that it owns pertaining to its MULTI-WING mark.

The Respondents are German entities; the first Respondent is the Managing Director of the Second Respondent, namely Wingfan GmbH. The second Respondent manufactures and markets axial fan impellers and was formerly known as Karberg & Hennemann GmbH & co. KG. The Complainant and Karberg & Hennemann GmbH & co. KG had entered into a "Knowhow and License Agreement", which *inter alia* included joint use of the trademark MULTI-WING. After forty years of joint use of the trademark by the parties, there was a parting of ways that lead to trademark litigation in Hamburg and the court passed an order on June 29 2004. The Respondent registered the disputed domain name<multiwing.in> on February 16, 2005.

4. Parties contentions

A. Complainant's Submissions

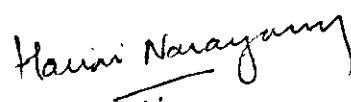
The Complainant states it was established in the year 1938 when its founder Finn Sigurd Andersen set up a company called F.S. Andersen a/s. for trading in hand tools and oil filters. With the invention of an efficient and cost effective thermo plastic impeller by the founder's cousin, Harald and its aggressive marketing undertaken by his son Ole Stig Andersen, the Complainant changed its name to Multi-Wing International a/s in 1987. The Complainant claims to be a world leader of axial fan impeller design and production and has provided documents to supports its contentions that it has a worldwide distribution network for its products. The Complainant states it has used its mark for fifty years and the earliest registration for its WING FAN mark is in the year 1960. The Complainant has provided the year wise turnover figures for goods sold under its mark for period 2005-2010.

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The Complainant states that the term "Multiwing" refers to individual blades fastened separately to the hub in the center of the device and submits that MULTIWING has acquired the status of a unique trademark and is not merely a descriptive term. The Complainant submits that the Respondent is a licensee of the Complainant that has manufactured and distributed products under its trademark MULTIWING for about four decades, but had started clandestinely asserting proprietorship rights over its mark. The Complainant has filed a translated copy of its agreements with Karberg & Hennemann and a translated copy of the German court order. The Complainant emphasizes that the German court order had clarified that both parties can continue to use the mark subsequent to termination of the Knowhow and license agreement, provided such use is made in the agreed territory, which the Complainant states is: "at most Czech Republic and Poland", and that the Respondents have no right to use the domain name in India.

The Complainant argues that the disputed domain name contains the MULTIWING mark in its entirety, and that the disputed domain name is identical or confusingly similar to its mark in which it claims prior rights. The Complainant argues that the Respondent has no rights and legitimate interests in the domain name, as the Respondent is holding the disputed domain name passively and has not developed a website. Further, the Respondent is not known by the domain name and has no trademark rights in the name. The Complainant states it has not assigned or licensed the use of its mark to the Respondent although there was a commercial relationship between the parties. Furthermore as the Complainant has used its mark for about fifty years, the use of its mark by the Respondent, who was a prior licensee, is in contravention of the Hamburg court order. The Complainant argues that the disputed domain name is not used in connection with a *bona fide* offering of goods or services, but is used to compete with the Complainant's business as it misleads users for commercial gain and that the Respondent is not making any legitimate non-commercial fair use of the disputed domain name.

The Complainant argues that the disputed domain name was registered and used in bad faith as the Respondent is a former licensee and seeks to prevent Complainant from reflecting its mark in the ".in" domain space. Further, the Respondent as a former



licensee is also trying to assert adverse proprietor rights in the trademark MULTIWING and by redirecting Internet users by use of meta tags to the Respondent's parent company website and other online locations. As this creates a likelihood of confusion for users, the Complainant contends that the Respondent's bad faith is evident from the circumstances and requests for the transfer of the disputed domain name for the above stated reasons.

Respondent's Submissions

In the email response of April 27, 2012 the Respondent has argued that the Complainant has no right to the disputed domain name. The Respondent states that its predecessor in interest, the German company "Karberg & Hennemann", was in cooperation with the Danish company F.S. Andersen for over forty years and both parties had used a common brand name, even though the brand name was always registered on the Complainant's behalf. According to the Respondent, in the agreement between the two companies it is stated that the Respondent could use the name even after termination of the co-operation agreement between the parties.

The Respondent further states that F.S. Andersen broke the contract with the Respondent and renamed its company Multi-Wing International in an attempt to make people believe that the Complainant represented the brand MULTI WING. The Respondent states that the Complainant is using technology that was designed and patented by its research and development and such technology is still a big part of the Complainant's sales. The Respondent cites the example of its patent for the adjustable pitch angles called the "Z-root (of blades)". According to Respondent, under the agreement between the parties, the Respondent continues to have the right to use the name "Multi- Wing" after termination of the agreement between the parties.

The Respondent claims to have registered domain names with the term "Multi-wing" in every important country like India, China and USA. The Respondent further claims that Germany was the biggest exporter of machines equipped with fans made by Karberg & Hennemann / Wingfan. The Respondent states that many customers are looking for

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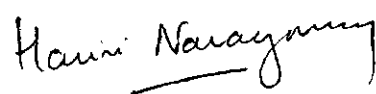
replacement fans manufactured by the Respondent and that the Complainant is copying the technology patented by the Respondent. The Respondent states its reason for registering domain names containing the MULTI WING mark and linking it to the Respondent's main (Wingfan) domain was with the intention of supporting its customers.

The Respondent anticipates that the Complainant will argue that the Respondent's area of sales is limited to most parts of Europe. However, based on the opinion of domain experts, the Respondent claims that it has the right to register domain names with the term "Multi-wing", due to the Respondent's previous contract and history with the Complainant. The Respondent finally argues that all the paper presented by the Complainant will not change the Respondent's rights to use the mark or to register worldwide domain names and therefore requests for denial of the Complaint.

Complainant's Rejoinder

In its rejoinder dated May 4, 2012 the Complainant states that the Respondent has made mere bald assertions with no evidence to substantiate its contentions. The Complainant reiterates and confirms that the Respondent has been its licensee for four decades and refers to the Hamburg court judgment of June 29, 2004 that has held: "...it is incontestable..." that the Complainant has rights in its mark in UK, Singapore and US. The Complainant further states that any right to use the trademark by the Respondent only emanates from a contractual agreement with the Complainant that must be coupled with description of the territory in which the Respondent can make such use. The Hamburg court had prevented the Respondent from using both MULTI-WING as well as MULTIWING marks. The Complainant draws attention to the statement in the said judgment that states that both the use of the contractual cooperation and the termination of the contract / cooperation is according to the agreement as far as the Defendant is concerned.

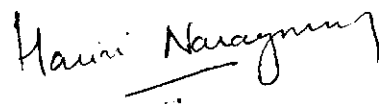
The Complainant explains that the Hamburg court has further clarified that the provision that both parties can "continue to use" the trademark after the possible termination of the



license and know-how agreement in specified territories refers to the Defendant's use of the trademark during the term of the agreement in the agreed territory alone (the Czech Republic and Poland). The Complainant argues that based on this specific finding of the Hamburg court, the Respondent does not have any right to register and use the disputed domain name in the Indian domain name space.

The Complainant rejects the Respondent's contention that F.S Andersen broke the contact with the Respondent "with purpose" and renamed itself to Multi-wing International a.s to mislead customers, as no documents are filed to substantiate these contentions. The Complainant contends that it has exclusive rights over the MULTI – WING mark and has changed its name by a valid procedure in 1987, and the same was publicly notified; however the Respondent has made no protest till date. The Respondent's claims regarding the development of technology allegedly being used by the Complainant is irrelevant to the present dispute, as the present dispute is regarding trademark rights and not regarding technology use. As the successor in interest of Karberg & Hennemann, the Complainant asserts that the Respondent could not have obtained a better title than its predecessor.

Regarding the Respondent's alleged domain name registrations in USA and China, the Complainant states that the Respondent has provided no proof of such registrations. The Complainant further argues that if that were the case, then it constitutes evidence of a pattern of behavior that prevents the owner of the trademark from reflecting its marks in corresponding domain names. As the Complainant is the registered owner of the MULTI-WING trademark in India, and as a mark denotes the origin of goods from a single source, the Complainant argues the registration of the domain name by the Respondent goes against the public policy purpose of trademark rights denoting one source and argues that it is therefore entitled to the transfer of the disputed domain name.


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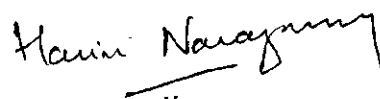
Respondent's reply to the Rejoinder

The Respondent has sent an email dated May 15, 2012, which is a late submission, however in the interests of fairness the Arbitrator allows the Respondent's reply. The Respondent in its email has stated that it has invested more than forty years in building the market for fans and impellers under the name MULTI-WING and WINGFAN and was granted two patents for adjustable blade technology and hollow blade technology. The Respondent states that its interest in "securing the domain name rights" is for the benefit of its long-standing customers and to enable them to find the Respondent on the Internet when searching for replacement impellers or for new projects.

The Respondent further claims that its customers refer to its products as MULTI-WING impellers due to the Respondent's successful marketing of the name Multi- Wing for more than four decades. The Respondent states that the name Karberg & Hennemann was always presented together with the MULTI-WING logo on letterheads, brochures and performance curve till 2001, and has filed a graphic representation as evidence. The Respondent argues that it needs to protect its market share by registering domain names such as "multiwing.de". The Respondent states it has registered the multiwing.in domain name for its European customers who have opened production facilities in India who are looking for its technology and for customers looking for its spare parts. The Respondent refers to the clause in the Agreement that both parties can continue to use the mark after termination of the agreement and based on this, reserves its right to continue using the trademark. Finally, the Respondent submits that paragraph 7 (ii) and (iii) of the INDRP Policy apply to the present case and requests for the Complaint to be denied.

Discussion and Findings

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


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

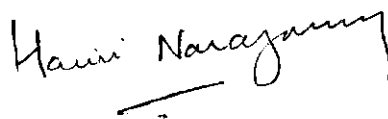
- (i) The domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights, and
- (ii) The Respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) The Respondent's domain name has been registered or is being used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

Identical or Confusingly Similar

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

Trademark registration shows *prima facie* evidence of rights in a mark. The Complainant has demonstrated its rights in the trademark MULTI WING in India and in other jurisdictions by submitting details of its registered trademarks. The documents filed by the Complainant also show that it has used the mark extensively for a considerable period. The Arbitrator is satisfied that the Complainant has established its rights in these proceedings.

The disputed domain name clearly incorporates the MULTI WING mark in its entirety; this is adequate to find that the disputed domain name is identical or confusingly similar to the mark. See *Indian Hotels Company Limited v. Mr. Sanjay Jha*, INDRP case 148 Sept 27, 2010 <gingerhotels.co.in>. (A domain name that entirely incorporates a complainant's mark is sufficient to establish the confusing similarity of the disputed domain name with the mark.) The country code top-level domain (cc TLD) suffix does not lessen the confusing similarity of the domain name with the trademark. See *Morgan Stanley v. Bharat Jain*, INDRP Case No. 156 dated October 27, 2010.



For the reasons discussed, the Arbitrator finds that the Complainant has satisfied the first element under paragraph 4 of the Policy.

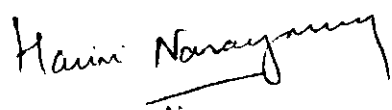
Rights and Legitimate Interests

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

Under Paragraph 7 of the Policy, a Respondent can establish rights in the domain name, if (i) before notice of the dispute, the registrant had used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services or (ii) the registrant (as an individual, business organization) has been commonly known by the domain name, or (iii) The registrant is making legitimate, non commercial or fair use of the domain name without intent for commercial gain.

The facts in the case show the Respondent has used the trademark MULTI WING in connection with a *bona fide* offering of goods or services under a valid license agreement. There is no dispute that the Respondent had been legitimately using the mark under a knowhow and license agreement for forty years as both parties in their pleadings have admit this fact. Further the Hamburg court order has recognized that the Respondent continues to have rights to use the mark in limited territory, which fact has been admitted by the Complainant in its pleading. The relevant question here then is whether such use can be said to constitute *bona fide* use within the meaning of paragraph 7 (i).

Paragraph 7 (i) of the Policy clearly states that the Respondent's use or demonstrable preparations is in relation to the use of the domain name in connection with a *bona fide* offering of goods or services. Clearly, the Respondent here has registered the disputed domain name in February 2005 after the Hamburg court order of June 2004, and the said court order had found the Respondent did not have global rights to use the mark. On the



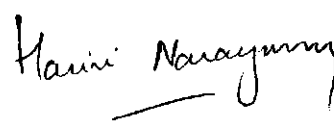
question of whether the Complainant can rely on the judgment of a German court and to what extent the judgment of a German court can have any bearing on a case in India. It is well established that a judgment of an international court has persuasive value as evidence.

Although the Respondent has made *bona-fide* use of the mark prior to the present dispute as a legal licensee of the Complainant, this can be distinguished from the use of the domain name in connection with a *bona fide* offering of goods or services as required under paragraph 7(i) of the Policy. There is nothing on record to suggest that the Respondent used the disputed domain name in connection with a *bona fide* offering of goods and services. Despite assertions of having rights in the mark the Respondent has not submitted any evidence or proof, such as the use of the mark in commerce, or turnover using the mark, or promotional expenses for promoting the mark as a concurrent user of the trademark for four decades.

The safe harbor provisions under paragraph 7 (ii) and 7 (iii) also do not apply to the present case, as the material on record shows the Respondent is not commonly known by the disputed domain name. There is no indication of the Respondent using the disputed domain name for any legitimate noncommercial fair use purposes.

The INDRP Policy applies to classic cases of cyber squatting and domain name disputes that are not primarily in the nature of trademark infringement cases or contractual disputes between parties. There are numerous previous cases¹ that have discussed the issue of legitimate interests of using a domain name by a licensed or unlicensed distributor or licensee if certain conditions are met, these are: (1) a respondent must actually be offering the goods or services at issue; (2) a respondent must use the website to sell only the trademarked goods and not to bait and switch to other goods of a competitor (3) the website must accurately disclose the registrant's relationship with the trademark owner and (4) a respondent must not try to corner the market in all domain names. In the present case these points are subject to interpretation of the contractual

See Oki Data Americas, Inc. v. ASD Inc. WIPO Case No.D2001-0903.



intention of the parties and the agreement they had entered into. In cases that involve interpretation of the contractual intention of the parties such intention can inevitably be gathered by conducting hearings. See *Usha International v. Chinatrust* INDRP Case No. <ushaworld.in> . However hearings are often not contemplated under the Policy, as it would defeat the purpose of speedy resolution that the INDRP process offers for domain name disputes. Indeed some of the complicated issues raised by the parties require the interpretation of the agreement and such issues would be better addressed in court. The Arbitrator wishes to place on record that the findings here does not purport to be an interpretation of the agreement between the parties but is based only on the material placed before this forum.

Accordingly, for the reasons discussed the Arbitrator finds the Complainant has made a *prima facie* case that the Respondent lacks rights and legitimate interests in the disputed domain name and has satisfied the second element under paragraph 4 of the Policy.

Bad Faith

Under the INDRP Policy the Complainant is required to establish that the domain name was registered or is being used in bad faith.

The Complainant has asserted that the Respondent has registered and used the disputed domain name in bad faith as the Respondent is a former licensee and seeks to prevent Complainant from reflecting its mark in the “.in” domain space. The facts show that both parties have used the mark for four decades to the exclusion of others, however after the parting of ways between the parties and the Hamburg court order, the Respondent registered the disputed domain name. The Hamburg court order has found the Respondent does not have global unrestricted rights to the mark, but found that according to intentions of the parties to the agreement, the use of the trademark by the Respondent is restricted to the agreed territory that was assigned to the Defendant.



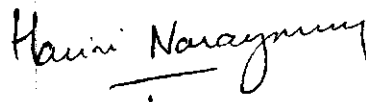
The Respondent has not shown any evidence that it has appealed the order of the Hamburg court or obtained any other order that shows the judgment of the Hamburg court will not operate against its use of the mark, other than in the allowed territories. Given these facts and circumstances, the registration of the disputed domain name by the Respondent, knowing fully well of the Complainant's rights in the mark, shows the registration of the disputed domain name was made in bad faith.

The Complainant has also submitted that the Respondent is redirecting Internet users and that users are redirected to the Respondent's parent company website. Under Paragraph 6 (iii) of the Policy, if the registrant of the domain name in dispute, has used the domain name to intentionally attract Internet users to the Registrant's website or other online location by creating a likelihood of confusion with the trademark of another, it is considered evidence of bad faith. The Arbitrator finds the circumstances here suggest that the Respondent seeks to use the Complainant's mark in the manner mentioned under Paragraph 6 (iii) of the Policy, namely to attract Internet traffic to the Respondent's website, which is considered bad faith registration and use of the disputed domain name under the Policy.

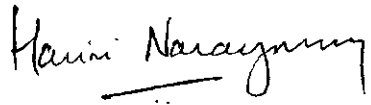
The Arbitrator finds the disputed domain name has been registered and used in bad faith by the Respondent as contemplated under the Policy.

Decision

The Complainant has established the disputed domain name is identical or confusingly similar to a mark in which it has rights, the Respondent has no rights or legitimate interests in the disputed domain name and the disputed domain name has been registered or is being used in bad faith. The Complainant has successfully established the three grounds required under the Policy to succeed in these proceedings.



For the reasons discussed, it is ordered that the disputed domain name:
<multiwing.in> be transferred to the Complainant.

A handwritten signature in black ink, reading "Harini Narayanswamy". The signature is written in a cursive style with a horizontal line underlining the name.

Harini Narayanswamy (Arbitrator)

Date: May 15, 2012