



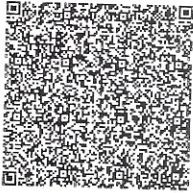
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INDIA NON JUDICIAL

Government of National Capital Territory of Delhi

e-Stamp

Certificate No.	: IN-DL99162490887686R
Certificate Issued Date	: 06-Jun-2019 10:40 AM
Account Reference	: IMPACC (SH)/ dlshimp17/ ROHINI/ DL-DLH
Unique Doc. Reference	: SUBIN-DLDSLHIMP1703795924468407R
Purchased by	: JAMES M
Description of Document	: Article 12 Award
Property Description	: Not Applicable
Consideration Price (Rs.)	: 0 (Zero)
First Party	: JAMES M
Second Party	: Not Applicable
Stamp Duty Paid By	: JAMES M
Stamp Duty Amount(Rs.)	: 150 (One Hundred And Fifty only)



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INDRP ARBITRATION
THE NATIONAL INTERNET EXCHANGE OF INDIA [NIXI]
ADMINISTRATIVE PANEL DECISION
SOLE ARBITRATOR: JAMES M.

Orange Brand Services Limited
V.
Anirban Mukherji

ARBITRATION AWARD
Disputed Domain Name: www.miniorange.co.in

Statutory Alert:

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2. The onus of checking the legitimacy is on the users of the certificate.
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The Parties

The **Complainant** in this arbitration proceeding is *Orange Brand Services Limited*, a company incorporated under the laws of England and Wales. Its office is at 3 more London Riverside, London, United Kingdom, SE1 2AQ.

The **Respondent** in this arbitration proceeding is *Anirban Mukherji*, located at 228 Park Ave S#87831 New York 10003-1502 as per the details in response given by the Respondent.

The Domain Name and Registrar

The disputed Domain name is *www.miniorange.in*. The Registrar with which the disputed domain name is registered is *Net 4 India Limited*.

Procedural History [Arbitration Proceedings]

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

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

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

The request for submission with a complete set of documents was dispatched to the Respondent by the National Internet Exchange of India [NIXI] on 4th June, 2019. Electronic copy of the complete set of documents was also sent to the Respondent on 4th June, 2019. The Respondent was requested to send in all such documents by 29th July, 2019. The Respondent sent all documents vide mail dated 29th July, 2019 that had been confirmed to have been served on the complainant as well vide mail dated 30th July, 2019.

Grounds for the administrative proceedings

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

Background of the Complainant and its statutory and common law rights Adoption:

The complainant in this arbitration proceeding is *Orange Brand Services Limited*, incorporated under the laws of England and Wales. It is owned by a French Company



Orange SA and is a part of Orange Group of Companies. The Orange Brand is the international flagship brand of the group.

Statutory rights:

The Complainant contends that the trademark "Orange" and its variants in all forms of multiple classes (including classes 9, 12, 14, 16, 18, 25, 28, 35, 36, 37, 38, 39, 41 and 42) have acquired global reputation and goodwill and are well known marks. The Complainant holds several domain name registrations incorporating the "Orange" trademark.

Respondent

The Respondent in his response does not dispute the Complainant's Right in the Mark 'Orange' as a registered trademark. However, the Respondent submits that there is no likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its web site or location or of a product or service on its web site or location.

Discussion and Findings

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

The Respondent's Default

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

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

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

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

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

The Respondent has replied to the Complaint. The panel finds that the Respondent has been given a fair opportunity to present his case and has taken into account the contentions of the Respondent while deciding on the three essential elements for proving ownership over

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the disputed domain name.

The 'Rules' paragraph 12(a) provides that the Arbitrator shall decide the Complaint on the basis of the statements and documents submitted in accordance with the INDRP and any law that the Arbitrator deems fit to be applicable. In accordance with Rules paragraph 12, the Arbitrator may draw such inferences as are appropriate from the Respondent's replies to the Complainant's assertions and evidence or to otherwise contest the Complaint or otherwise to not to contest the complaint. In the circumstances, the Arbitrator's decision is based upon the Complainant's assertions, evidence and inferences drawn from the Respondent's replies.

The issues involved in the dispute

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

"Types of Disputes -

Any Person who considers that a registered domain name conflicts with his legitimate rights or interests may file a Complaint to the .IN Registry on the following premises:

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

The Respondent is required to submit to a mandatory Arbitration proceeding in the event that a Complainant files a complaint to the .IN Registry, in compliance with this Policy and Rules thereunder."

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

Parties Contentions

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

Complainant

The Complainant, based on various Indian and international trademark registrations across various classes owns the trademark "Orange". Based on the use of the said trademark in India and other countries submitted that it is the sole proprietor of and has sole and exclusive rights to use the said trademark "Orange".

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

It has been proved by the Complainant and admitted by the Respondent that the Complainant has the intellectual property, particularly trademark rights, and other rights in the mark "Orange" and its variants including but not limited to any word containing the mark "Orange" by submitting substantial documents. The mark has been highly publicized and advertised by the Complainant in both the electronic and print media; both in India and globally and the disputed domain name is similar to that of the Complainant's mark, services and domain names.

Famous marks/Well known marks can be understood as those that enjoy a high degree of consumer recognition in a particular jurisdiction or in a specific field of commerce or industry. It is essential to show that the mark is commonly known by the consumers or general public as the owner's mark. In India the Indian Trademarks Act 1999 does not refer to famous marks. Section 2(1)(zg) defines "well known trademarks", which in relation to any goods or services, means a mark which has become well-known to a substantial segment of the consumer public.

It is also a fact that the Complainant has licensed its "Orange" brand in India to a leading telecommunications provider. Also the Complainant has given ample evidence of its presence in the field of Cyber defence in the design of their cyber defence strategy, access control and enhancement, protection of sensitive assets, knowledge of vulnerabilities and validation of the effectiveness of cyber defence devices.

A mere glance at the disputed domain name gives rise to enormous confusion as to its origin. The disputed domain name registered by the Respondent is identical to the Corporate as well as the trademark of the Complainant. The complainant enjoys statutory and common law proprietary rights over the trademark 'Orange' and the public identify the said trademark exclusively with the complainant and no one else. This panel comes to a conclusion that when a domain name contains a trademark in its entirety, the domain name is identical or at least confusingly similar to the trademark. [Relevant Decisions: *International Business Machines Corporation v. Zhu Xumei*, INDRP/646, (January 30, 2015); *Jaguar land Rover v. Yitao*, INDRP/641, (January 4, 2015)]

The public that has to be considered for the element of the likelihood of confusion is that segment that has been exposed to the brand.

The mark has been highly publicized, advertised by the Complainant in both the electronic media and print media. Furthermore the same has been done globally. The Complainant has licensed its brand to a leading telecom operator offering services in India and acquired the status of well-known trademark in the territory of India.

The complainant has painstakingly built up an admirable reputation globally for itself and has invested substantial amounts of resources in advertising its products under the trademark "Orange". The Orange mark is distinctive and has gained fame in the years it has been used. It has become widely popular and accepted among the public because of its quality and kind of services it provides. The complainant has adopted, conceived and used the mark and the domain name for a considerable time and now the mark has become exclusively associated with the complainant.

The fame of Orange mark and the non-distinctiveness of the added terms ('com' or 'mini') will cause the users into mistakenly believe that it originates from, is associated with or is sponsored by the complainant.

Therefore, the panel agrees that the mark "Orange" is used and known extensively as complainants mark. And using it in any another form will mislead the public and will cause unfair advantage. [Relevant Decisions: *Aktiengesellschaft v. Hybo Hindustan*, 1994 PTC 287; *HONDA case*, 2004(28) PTC 332 and *TATA case* 2003 (27) PTC 422] A mere glance at the disputed domain name gives rise to enormous confusion in the minds of users because of it being well-known mark/famous mark. [Relevant Decisions: *Ferrero S.p.A. v. Jacques Stade*, Case No. DBZ2003-0002 (WIPO August 25, 2003); and *Ferrari S.p.A. v. American Entertainment Group, Inc*, Case No. D2004-0673 (WIPO October 10, 2004)]

The disputed domain name registered by the Respondent is identical to the Corporate as well as the trademark of the Complainant. Also it has been proved that the mark has acquired the status of a well-known mark in India.

Now to consider two different scenarios. It has been held that the standard to decide what amounts to infringement in cases of dissimilar goods & products is "likelihood of deception". [*Hamdard National Foundation v. Abdul Jalil* (2008 (38) PTC 109 (Del.)); *Mattel, Inc v. 3894207 Canada Inc.*, [(2006) 1 S.C.R. 772]; *Moseley, Victor's Little Secret, Petitioners v. Secret Catalogue, Inc.* (537 U.S. 418 (2003); *Ford Motor Co. & Anr. V Mrs. C R Borma & Anr* (2008 (2) CTMR 474 (Delhi)(DB)]. If the facts were the similar to the aforementioned cases the complainant still would have its rights protected under Section 29(4) of the Trademark Act 1999. This is so as the registered trade mark has a reputation in India. Any unauthorized use without due cause would be taking unfair advantage of or is detrimental to, the distinctive character or repute of the registered trademark of the complainant. Even the courts have recognized the same and give due credence to the international character of trademarks and recognize the well-known status in order to protect consumer interests and also to protect the interest of brand owners. [*Bloomberg Finance LP v Prafull Saklecha* 207 (2014) DLT 35; *Microsoft Corporation v Kurapati Venkata Jagdeesh Babu* [CS (OS) 2163/2010 decided on 3.02.2014]

However, in the present dispute, the well-known trademark has been used in relation to similar services. Therefore provisions of Section 29(5) of the Trademark Act 1999 also has direct bearing and has been fulfilled in full. The above provision sets out that if a registered trademark is used by a defendant as a part of the trade name (and by extension & interpretation of law can be said to now include domain names) and the defendant is dealing in the same goods/services in relation to which the trademark is registered, then such use will amount to infringement. [*Bloomberg Finance LP v Prafull Saklecha* 207 (2014) DLT 35; *Microsoft Corporation v Kurapati Venkata Jagdeesh Babu* [CS (OS) 2163/2010 decided on 3.02.2014] For the purposes of Section 29(5) of the Trademarks Act 1999, there is no requirement to show that the mark has a distinctive character or that any confusion is likely to result from the use of a registered mark by the infringer as part of its trade name or the name of its business concern. Therefore in either scenario the complainant has proved that the complainant has rights in the disputed domain name www.miniorange.in through the mere fact that the trademark of the complainant has been used in it. The complainant enjoys statutory and common law proprietary rights over the trademark 'Orange' in the

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United States and India and various other jurisdictions as well and the public identifies the said trademark exclusively with the complainant and no one else. A small segment of public would not be sufficient to disprove the conclusion that the majority would still associate the mark with the Complainant.

It has to be noted that the paragraph no. 4 of the INDRP policy starts with following words, "Any person who considers that a registered domain name conflicts with his legitimate rights or interest may file complain to the in registry on follow premises." This is a positive assertion and sentence. Further paragraph 4(i) also constitutes a positive assertion and sentence. Paragraph 4(iii) and paragraph no.6, which is supplementary/explanation to it, also have positive assertions/sentences. The above clearly indicates that the onus of proving the contents of para no.4 (1) and 4(iii) are upon complainant. To succeed he must prove them.

Also, the provisions of sections 101 to 103 of Indian Evidence Act also show that onus in present proceedings is primarily on complainant.

The panel notes that all the proofs given by the complainant has proven his trademark in "Orange" and in "www.orange.com".

It has been held by the Hon'ble Supreme Court of India that the criteria to be considered while deciding on the similarity/dissimilarity of the marks the following criteria need to be considered; the nature of the marks (i.e. whether they are word, label or composite marks); the degree of resemblance between the marks; the nature of the goods for which they are used as trademarks; similarities in the nature, character and performance of goods of rival traders; the class of purchasers who are likely to buy goods bearing the marks, the method of purchasing the goods or placing orders; and other circumstances that may be relevant. It is immaterial whether the plaintiff and defendant trade in the same field or in the same or similar products. [(**Relevant decision:** Cadila Health Care Ltd. V. Cadila Pharmaceuticals Ltd. 2001 (5) SCC 73)]

This panel holds that a trademark has to be considered in its entirety. It has been held that when a domain name contains a trademark in its entirety, the domain name is identical or at least confusingly similar to the trademark. [**Relevant Decisions:** Sony Ericsson Mobile Communications AB v Salvatore Morelli, INDRP/030; Orange Brand Services Limited v PRS Reddy, INDRP/644; International Business Machines Corporation v. Zhu Xumei, INDRP/646, (January 30, 2015); Jaguar land Rover v. Yitao, INDRP/641, (January 4, 2015)]

The panel while following the rule of law is of the opinion that while considering the trademark "Orange" in its entirety, the domain name www.miniorange.in is identical or confusingly similar to the trademark of the complainant.

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

Paragraph 3 of the INDRP is reproduced below:

"The Respondent's Representations -

By applying to register a domain name, or by asking a Registrar to maintain or renew a domain name registration, the Respondent represents and warrants that:

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


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

Respondent

The respondent in his response contends that he is in the business of providing authentication solutions. He also contends that since 2013 he has been advertising and showcasing the brand "miniOrange" at various platforms and conferences. He also has annexed copies of communications and other documents to show that his customers are sign one-on-one basis.

The various contentions of the respondent also include that they have spent a substantial amount on advertising and promoting the "miniOrange" brand. He also submits that the desire to use the name from inspiration from "Microsoft" and "Apple". Also he submits that the mark as written is different from that of the Complainant.

The Panel in its findings takes the view that the Respondent has not annexed any proof of trademark in the word "miniOrange". The respondent is relying on the principle of acquired secondary meaning for the grant of trademark rights in "miniOrange". However it is also equally true that in the event there is already an existing trademark "Orange". In the event Respondent is seeking rights against and/or in the trademark "Orange" then it has to be done so at a proper forum. Also, the panel finds that the authentication protocols can be said to be part of broader spectrum that comes under the genre of cyber defence. Therefore the fact remains that the services that are being offered are in similar fields. It may be that the Respondent did not have any intention to capitalise on the "Orange" brand but it remains an irrefutable fact that the brand is part of the disputed domain name and the corporate name of the Complainant. Moreover, the settled law remains in cases of domain name disputes which consist of registered trademarks, violation would occur in simple use of the established trademark in the domain name. In the event, Respondent sought rights in the disputed domain name www.miniorange.co.in, he would have to prove trademark rights in the same. A simple prefix "mini" would not detract from the trademark "Orange" in places where font sizes and shapes of oranges will not be visible that is to say in domain names.



Therefore, the Panel comes to the conclusion that the disputed domain name is identical or deceptively similar to the Complainants' marks and its business. Accordingly, the Panel

concludes that the Complainant has satisfied the first element required by Paragraph 4 of the INDRP.

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

Complainant

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

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

The Respondent cannot have any right or legitimate interest in the disputed domain name because the disputed domain name incorporates the "Orange" mark; a mark in which the Complainant has the sole and exclusive right and that has become famous globally owing to the Complainant's efforts.

The panel would like to notice that the disputed domain name www.miniorange.co.in is giving authentication services to its customers. But the Complainant has also given evidence that it is also in the field of cyber defence that also may include authentication services. It can be in no way be termed a legitimate use of the brand "Orange".

The panel agrees that Respondent is not authorized by the Complainant to use its trademark. In the present case then in the absence of any license or permission from the Complainant to use any of its trademarks or to apply for or use any domain name incorporating those trademarks, it is clear that no actual or contemplated bonafide or legitimate use of the domain name could be claimed by the Respondent. [Relevant Decisions: *Statoil ASA v. Bright, AK, D2014-1463 (WIPO October 14, 2014)* and *Swiss Eco Patent S.A. v. Verdicchio Simon, D2014-1804 (WIPO November 21, 2014)*]

The panel would also take into account the correspondence between the Complainant and Respondent. It is also submitted by the Complainant that the respondent is using the disputed domain name www.miniorange.co.in to divert users to another website www.miniorange.com both of which incorporate the "Orange" trademark. However, the complainant has failed to adduce sufficient evidence as to this contention. However, even if one accepts the contention that such diversion has happened, it fails to provide any evidence to support the Complainants view that the Respondent intends to cash in on the Complainants reputation when the second website that is owned by him (Respondent), and is also is the matter of arbitration under the UDRP.

Respondent

The Respondent claims that the issue of whether trademarks exist in the word "orange" or

"miniOrange" is not under the purview of this panel. This panel agrees with the Respondent. However, use of a registered trademark ["Orange" in this case] in a disputed domain name does give this panel the right to give a decision as to whether the disputed domain name has been proved by the Complainant to belong to it.

The respondent also contends that the Complainant entered into the field of Cyber-defence in 2016, 4 years after the Respondent was providing its services. However, the fact remains, the brand "Orange" was a well-known mark before the Respondent began offering services under the disputed domain name "www.miniorange.co.in".

The question for the Panel to decide is that whether the Respondent can be said to be having a legitimate interest in the disputed domain name. As discussed above a trademark is a sum of all its parts that includes a word. In the event there is a part of a registered trademark in a location that does not have the benefit of visual, phonetic, olfactory, touch, then the mere use of a registered trademark with a simple prefix would not generate any legitimacy for the person infringing the trademark. This becomes more so when the said trademark is part of the Corporate name of the Complainant. The Panel cannot accept the use of the registered trademark would be termed a legitimate use.

For these reasons, the Panel holds that the complainant has proved that the respondent does not have any rights or legitimate interests or is infringing the trademark of the complainant in the disputed domain name.

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

Complainant

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

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

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

the Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or

by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its Website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of its Website or location or of a product or service on its Website or

location."

From the circumstances of the case and from the evidences put before the Panel by the Complainant, the Panel is of the opinion that the complainant had no previous connection with the disputed domain name and any use of the disputed domain name by the Respondent, would result in confusion and deception in trade, consumers and public [at large and not specific segments], who would assume a connection or association between the Complainant and the Respondent. It must also be noted that the registration of the domain name www.orange.com by the Complainant was a constructive notice to the Respondent on the Complainant's rights in the "Orange" mark and domain name. This all points towards usage in bad faith. Thus, the adoption of an identical trademark/domain name [www.miniorange.co.in] by the Respondent is very much in bad faith.

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

The Respondent's registration of the domain name meets the bad faith elements set forth in the INDRP. Since the trademarks of the Complainant are so distinctive and famous that the Respondent must have had actual knowledge of the trademarks prior to registering the disputed domain name. There cannot be any doubt from the evidences put before this panel that the Complainant's marks are well known and that the Respondent intended to capitalize on that confusion. Therefore the panel comes to the conclusion that the registration is in bad faith. By registering the disputed domain name with actual knowledge of the Complainant's trademark, the Respondent acted in bad faith by breaching its service agreement with the registrar because the Respondent registered a domain name that infringes upon the Intellectual Property rights of another entity, which in the present scenario is the Complainant. [Relevant Decision: *Swarovski Aktiengesellschaft v. WhoisGuard, Inc. / Person, Johnny D.*, D2013-1450, (WIPO October 2, 2013); *zingametall BVBA v. Mister Alexey Navalny* INDRP/639 (January 21, 2015)]

Therefore the panel comes to the conclusion that the registration is in bad faith.

Respondent

The Respondent submits that the delay of 7 years on the part of the Complainant extinguishes his rights in the domain name. It is also pertinent to note that the respondent did not in 7 years get a registered trademark right in the word "miniOrange". Therefore to allow the Respondent to use a well-known trademark just on the defence of laches would be inappropriate.

Consequently it is established that the disputed domain name was registered in bad faith or used in bad faith.

Decision

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

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

- global basis;
- (ii) the Respondent has failed to prove the good faith use of the disputed Domain Name;
 - (iii) taking into account the nature of the disputed domain name and in particular the .in extension alongside the Complainant's mark, which would inevitably associate the disputed domain name closely with the Complainant's group of domains in the minds of consumers, all plausible actual or contemplated active use of the disputed Domain Name by the Respondent is and would be illegitimate. Use by the Respondent as such would amount to passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law.

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

It is Registrant's/Respondent's duty under para. 3 of the .IN Dispute Resolution Policy to warrant and prove to the contrary that:

"(a) the Registrant/Respondent has accurately and completely made the Application Form for registration of the domain name;

(b) to the Registrant's knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party;

(c) the Registrant is not registering the domain name for an unlawful purpose; and

(d) the Registrant will not knowingly use the domain name in violation of any applicable laws or regulations.

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

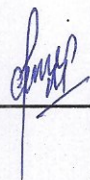
The Complainant has given sufficient evidence to prove extensive global trademark rights on the disputed domain name. Further, the Respondent's adoption and registration of the disputed domain name is dishonest and malafide.

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

Respondent is using the disputed domain name in bad faith and has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name.

[Relevant decisions: PJS International S.A. v. Xianwang INDRP/616 (September 1, 2014); Mozilla Foundation v. Mr. Chandan INDRP/642 (January 15, 2015); Mr. Marcus Angell v. Mr. Mohit Mehta INDRP/621 (September 22, 2014); Walcom Co. Ltd v. Liheng INDRP/634 (November 24, 2014) ; AB Electrolux v. GaoGou of Yerec INDRP/630 (October 19, 2014) Kelemata SPA v. Mr Bassarab Dungaciu WIPO D2003-0849; Croatia Airlines d.d. v. Modern Empire Internet Ltd. WIPO D2003-0455; Uniroyal Engineered Products , Inc. v. Nauga Network Services WIPO D2000-0503; Microsoft Corporation v. Chun Man Kam INDRP/119; D2012-0466 WIPO Luigi Lavazza S.p.A. v. Noori net; D2008-1474 WIPO Serta Inc. v. Charles Dawson; Guerlain S.A. v. Peikang, D2000-0055 (WIPO March 21, 2000); Univ of Houston Sys, v. Salvia Corp., FA 637920(Nat. Arb. Forum March 21st 2006); Red Hat, Inc. v. Haecke, FA 726010 (Nat. Arb. Forum July 24th 2006; Lockheed Martin Corporation v. Steely Black, INDRP/183 (January 5, 2011), Revlon Consumer Products Corporation of New York v. Ye Genrong, et al, D2010-1586 WIPO November 22, 2010]

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



JAMES M.
Sole Arbitrator
Date: 10th August, 2019