



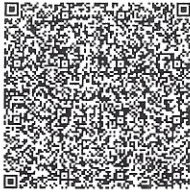
सत्यमेव जयते

## INDIA NON JUDICIAL

Government of National Capital Territory of Delhi

### e-Stamp

Certificate No.	: IN-DL00142416556178R
Certificate Issued Date	: 23-Dec-2019 03:36 PM
Account Reference	: IMPACC (IV)/ dl717303/ DELHI/ DL-DLH
Unique Doc. Reference	: SUBIN-DL71730310050002807421R
Purchased by	: V K AGARWAL
Description of Document	: Article 12 Award
Property Description	: Not Applicable
Consideration Price (Rs.)	: 0 (Zero)
First Party	: V K AGARWAL
Second Party	: Not Applicable
Stamp Duty Paid By	: V K AGARWAL
Stamp Duty Amount(Rs.)	: 100 (One Hundred only)



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

*V K Agarwal*

#### Statutory Alert:

1. The authenticity of this Stamp Certificate should be verified at "www.shcilestamp.com". Any discrepancy in the details on this Certificate and as available on the website renders it invalid.
2. The onus of checking the legitimacy is on the users of the certificate.
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Patagonia Inc., v. Doublefist Ltd.,

**CASE NO. INDRP/1185/2019**

**AWARD**

**1. The Parties**

The Complainant is M/s Patagonia Inc., 259, West Santa Clare Street, Ventura, California, 93001, United States of America.

The Respondent is M/s Doublefist Ltd., 33, Tongji East Road, Chancheng Distract, FoShan City, Guangdong Province, China.

**2. The Domain Name and Registrar**

The disputed domain name is <www.patagonia.co.in>. The said domain name is registered with Dynadit LLC, The details of registration of the disputed domain name, as per Annexure 2 to the Complaint, are as follows:

(a) Domain ID:	D5075092 - IN
(b) Registrar:	Dynadit LLC
(c) Date of creation:	May 28, 2011
(d) Expiry date:	May 28, 2020

**3. Procedural History**

(a) A Complaint dated December 03, 2019 has been filed with the National Internet Exchange of India. The Complainant has made the registrar verification in connection with the domain name at issue. The print outs so received are attached with the Complaint as Annexure 2. It is confirmed that the Respondent is listed as the registrant and provided the contact details for the administrative, billing, and technical contact. The Exchange

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verified that the Complaint satisfied the formal requirements of the Indian Domain Name Dispute Resolution Policy (INDRP) (the "Policy") and the Rules framed there-under.

- (b) The Exchange appointed Dr. Vinod K. Agarwal, Advocate and former Law Secretary to the Government of India as the sole arbitrator in this matter. The arbitrator finds that he has been properly appointed. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Exchange.
- (b) In accordance with the Policy and the Rules, an attempt was made by the National Internet Exchange of India to send a copy of the Complaint to the Respondent through e mail address. However, no reply has been received from the Respondent. Hence, the present proceedings have to be ex parte.

#### **4. Factual Background**

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

##### **Complainant's activities**

The Complainant is a corporation duly organized and existing under the laws of the United States of America. It was founded in the year 1973.

According to the Complaint, the Complainant has been in the business of outdoor apparel company which offers sustainable clothing suitable for alpine climbing, fly fishing, hiking, skiing and snowboarding, surfing, trail running, and yoga, as well as other outdoor activities. Over the years, the Complainant has also become known for its non-sports wear and its general clothing ranges are popular, especially fleeces, rain jackets and

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coats. The Complainant's products and services enable customers to pursue various outdoor activities.

Further that, the Complainant is well-known for its products by: (i) designing and fabricating the highest quality products as defined by durability, multi-functionalism and non-obsolescence; (ii) designing and fabricating products that are easily repaired and made from materials that can be reused or recycled; (iii) designing and fabricating products with minimum impacts throughout the supply chain - including resource extraction, manufacturing and transportation - on water use, water quality, energy use, greenhouse gas emissions, chemical use, toxicity and waste; and (iv) partnering with customers to take mutual responsibility for the life cycle of products, including repair, reuse and recycling.

#### **Respondent's Identity and Activities**

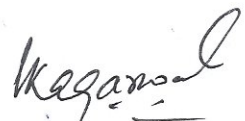
The Respondent's activities are not known.

### **5. Parties Contentions**

#### **A. Complainant**

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

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





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

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

In relation to element (i), the Complainant contends that since the year 1995 the Complainant has continuously used the trademark PATAGONIA (hereinafter to be referred as the 'earlier well-known trade mark') in connection with its products and services. In India the Complainant is the registered proprietor of the trademark PATAGONIA. Some of the details of registration of the said trademark are as follows:

Mark	Reg. No.	Appl. Date
PATAGONIA	1192896	April 21, 2003
PATAGONIA	2218421	April 21, 2003
PATAGONIA	1244448	October 20, 2003
PATAGONIA	1824861	June 06, 2009
PATAGONIA	3158033	January 01, 2016

According to the Complaint, the said registrations are in classes 18, 25 and 35. The said trademark has acquired enormous goodwill and reputation and high degree of distinctiveness, distinguishing and signifying the source of the products and services as originating from the Complainant. The aforesaid registrations are valid and subsisting till date. The Certificates of Registration of the said trademark are available at **Annexure K**.

In addition, the Complainant has also attained registration of the said trademark "PATAGONIA" in several other countries of the world, such as, Argentina, Australia, Bahrain, Bangladesh, Benelux, Brazil, Canada, China, Egypt, European Union, Hong Kong, Iceland, Israel, Japan, Republic of Korea, Kuwait, Malaysia, Mexico, Morocco, Myanmar, Nepal,

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New Zealand, Pakistan, Peru, Qatar, Russia,, Singapore, South Africa, Sri Lanka, Thailand, Turkey UAE, United Kingdom, and United States of America. Copies of the registration certificates of select countries are annexed as **Annexure L**.

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

Further, the Complainant is also the registrant and proprietor of various domain name registrations at different levels incorporating the word PATAGONIA. One such illustration is: <www.patagonia.com>, etc;

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

In relation to element (ii), the Complainants contend that the Respondent (as an individual, business, or other organization) has not been commonly known by the trademark "PATAGONIA". The Respondent does not own any trademark registration as "PATAGONIA" or a mark that incorporates the expression "PATAGONIA". The Respondent has no license or authorization or permission from the Complainant to either use the

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expression "PATAGONIA" or to register the disputed domain name with the said words.

Further, the Respondent is not making a legitimate or fair use of the said domain name for offering goods and services. The Respondent has registered the domain name for the sole purpose of harping upon the goodwill and reputation of the Complainant in the trademark domain name PATAGONIA and for creating confusion and misleading the general public.

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

Regarding the element at (iii), the Complainant contends that The Respondent has created the website with an intention of misleading the members of trade and public that the website under the Disputed Domain Name belongs to or created by the Complainant inasmuch as, on logging on to the Respondent's website, users are directed to a pay-per-click page, containing sponsored links, which are related to the Complainant's business. This clearly evidences the fact that the Respondent is using the disputed domain name in "bad faith" with the intention of diverting traffic by attracting internet users for commercial gain' to its website and creating a likelihood of confusion with the Complainant's well-known mark as to the source, sponsorship, affiliation or endorsement of its website and the services on them.

In addition to the above, it is submitted that the Respondent has registered the Disputed Domain Name primarily for purposes of selling it. A perusal of the website **whois.domaintools.com** reveals that the impugned Domain is being offered for sale. The printouts from the aforementioned website, evidencing the same, are attached to the Complaint as **Annexure S**.

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Thus, the Respondent has registered the disputed domain name in bad faith and for its actual use in bad faith.

The Complainants have stated that the use of a domain name that appropriates a well-known trademark to promote competing or infringing business and products cannot be considered a "*bona fide offering of goods and services*".

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

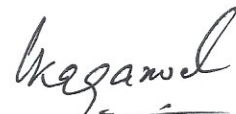
#### **B. Respondent**

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

#### **6. Discussion and Findings**

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

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





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

*A. Identical or Confusingly Similar*

The disputed domain name <www.patagonia.co.in> was registered by the Respondent on May 28, 2011. The present Complaint is dated December 03, 2019. No explanation is available for the delay of more than eight years in filing the Complaint.

The Complainant is an owner of the registered trademark "PATAGONIA". The Complainant is also the owner of a number of domains with the word "PATAGONIA" as stated above and referred to in the Complaint. Most of these domain names and the trademarks have been created and/or registered by the Complainant much before the date of creation of the disputed domain name by the Respondent. The disputed domain name is <PATAGONIA.CO.IN>. Thus, the disputed domain name is very much similar to the name and the trademark of the Complainant.

The disputed domain name <www.patagonia.co.in> gives rise to the confusion and deception *qua* its origin because the disputed domain name is phonetically, structurally and deceptively similar to the Complainant's trademark/ domain names "PATAGONIA". The domain name is instantaneously associated with the Complainant. Further, a possibility that

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an internet user who wishes to visit the Complainant's website for gathering information, is likely to be taken to the Respondent's website cannot be ruled out. Thus, the internet user may see inaccurate information. It may be detrimental to the Complainant's earned goodwill and reputation.

The Hon'ble Supreme Court of India has in the case of *Satyam Infoway Ltd., v. Sifynet Solutions Pvt. Ltd.*, [2004Supp. (2) SCR 465] held that the domain name has become a business identifier. A domain name helps identify the subject of trade or service that an entity seeks to provide to its potential customers. Further that, there is a strong likelihood that a web browser looking for PATAGONIA products in India or elsewhere would mistake the disputed domain name as of the Complainant.

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

#### B. Rights or Legitimate Interests

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

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

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misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent's response is not available in this case. There is no evidence to suggest that the Respondent has become known by the disputed domain name anywhere in the world. The name of the Registrant/Respondent by which the disputed domain name is registered is Doublefist Limited. Based on the evidence adduced by the Complainant, it is concluded that the above circumstances do not exist in this case and that the Respondent has no rights or legitimate interests in the disputed domain name.

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

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

C. *Registered and Used in Bad Faith*

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

- (i) circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who bears the name or is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented

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out of pocket costs directly related to the domain name; or

- (ii) the Registrant's has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Registrant has engaged in a pattern of such conduct; or
- (iii) by using the domain name, the Registrant has intentionally attempted to attract the internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.

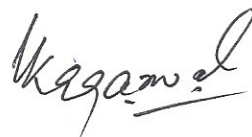
The contention of the Complainant is that the present case is covered by the circumstances mentioned herein above. There are circumstances indicating that the Respondent has intentionally attempted to attract, for commercial gain, internet users to its web site, by creating a likelihood of confusion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

The Respondent's registration of the domain name <www.patagonia.co.in> is likely to cause immense confusion and deception and lead the general public into believing that the said domain name enjoys endorsement or authorized by or is in association with and/or originates from the Complainant.

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

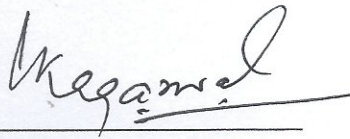
## 7. Decision

In light of the foregoing findings, namely, that the domain name is confusingly similar to a mark in which the Complainants have rights, that





the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered in bad faith and is being used in bad faith, in accordance with the Policy and the Rules, the Arbitrator orders that the domain name <www.patagonia.co.in> be transferred to the Complainant.



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Vinod K. Agarwal  
Sole Arbitrator  
Date: 29<sup>th</sup> December 2019