



सत्यमेव जयते

INDIA NON JUDICIAL

Government of National Capital Territory of Delhi

e-Stamp

Certificate No.

Certificate Issued Date

Account Reference

Unique Doc. Reference

Purchased by

Description of Document

Property Description

Consideration Price (Rs.)

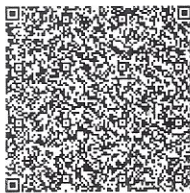
First Party

Second Party

Stamp Duty Paid By

Stamp Duty Amount(Rs.)

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: 27-Jul-2020 02:58 PM
: IMPACC (IV)/ dl717303/ DELHI/ DL-DLH
: SUBIN-DL71730331938017445467S
: V K AGARWAL
: Article 12 Award
: Not Applicable
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: (Zero)
: V K AGARWAL
: Not Applicable
: V K AGARWAL
: 100
: (One Hundred only)



Please write or type below this line.

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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INDRP Case No 1245/2020

SNAP-ON INCORPORATED v. FEIFEI DOUBLEFIST LTD

AWARD**1. The Parties**

The Complainant is SNAP-ON INCORPORATED, 2801, 80th Street, Kenosha, Wisconsin 53143, United States of America

The Respondent is FEIFEI DOUBLEFIST LIMITED, A3, JiaZhaoYe, JiangBei, Huicheng, District, HuiZhou City, GuangDong Province, China (Arbitration Documents to HuiZhou, Wisconsin 56000, US

2. The Domain Name and Registrar

The disputed domain name is <WWW.SNAPON.CO.IN>. The said domain name is registered with Dynadot LLC. The details of registration of the disputed domain name, as indicated in WHOIS (Annexure C - 2 to the Complaint) are as follows:

(a) Domain ID:	D414400000000561421 – IN
(b) Registrar:	Dynadot LLC
(c) Date of creation:	March 26, 2016
(d) Expiry date:	March 26, 2021

3. Procedural History

- (a) A Complaint dated July 07, 2020 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 C - 2. The contact details of the Registrant were privacy protected/hidden. Subsequently is confirmed that the Respondent is listed as the registrant and provided the contact details for the administrative, billing, and technical contact. The Exchange verified that the Complaint satisfied the formal requirements of the Indian Domain Name



Dispute Resolution Policy (INDRP) (the "Policy") and the Rules framed thereunder.

- (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 to send a copy of the Complaint to the Respondent on the given address. However, no response 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

According to the Complaint, the Complainant, SNAP-ON INCORPORATED is incorporated under the laws of the State of Delaware, U.S.A. having its principal office at 2801, 80th Street Kenosha, Wisconsin 53143, U.S.A.

The Complainant was established in the year 1920. The Complainant is a global innovator, manufacturer and marketer of tools, diagnostics and automotive equipment solutions for professional tool users. The Complainant's products and services include hand tools, power tools, tool storage products (including tool control software and hardware), diagnostics, equipment and related accessories, electronic parts catalogues, warranty analysis solutions, business management systems and services, OEM specialty tools and development and distribution and OEM equipment facilitation services.

The Complainant first entered the international arena in 1931. Its products and services can be found in more than 130 countries around the world including Argentina, Belarus, Brazil, China, France, Hungary, Italy, Portugal, Spain, Sweden and United Kingdom,

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The Complainant has also incorporated its subsidiaries in India, namely, **SNAP-ON BUSINESS SOLUTIONS INDIA PRIVATE LIMITED** and **SNAP-ON TOOLS PVT. LTD.** on **November 22, 1994** and **September 19, 2003** respectively. The Complainant operates branch offices in various Indian cities, namely Mumbai, Pune, Ahmedabad, Bengaluru, Chennai, Hyderabad, Lucknow, Chandigarh and Kolkata and has been carrying out active commercial use of its trade mark **SNAP-ON** in India since as early as **December 31, 1970** in respect of the goods/ services for which it has been registered.

Respondent's Identity and Activities

The Respondent's activities are not known.

According to the **Dynadot LLC** WHOIS database, the contact details of the Registrant were privacy protected/hidden. A copy of the **Dynadot LLC** WHOIS search results for the domain **<snapon.co.in>** is annexed and marked as **Annexure C-2** to the Complaint. Upon filing this domain complaint online, it was found out that that the said domain name is registered in the name of **Feifei, Doublefist Limited**.

5. Parties Contentions

A. Complainant

The Complainant contends that each of the elements specified in the .IN Domain Name Dispute Resolution Policy is 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.

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In relation to element (i), the Complainant contends that the Disputed Domain Name is identical with and/or confusingly similar to the Complainant's SNAP-ON Mark. The Disputed Domain Name incorporates the Complainant's trade name and registered trademark **SNAP-ON** in its entirety.

Complainant owns the domain name <snapon.com> through which it conducts a significant portion of its business and their online shop domain <www.shop-snapon.com>. They were registered on May 30, 1995 and thereafter and regularly renewed thereafter.

The Complainant has also registered more than 160 several country specific domain names and websites at international and domestic levels incorporating the designation **snapon**. Some illustrations of such domain names are <snapon.co.uk>; <snap-on.co.uk>; <snapon.co.jp>; <snapondiag.com>; <snap-on.co.za>; <snaptools.com.au>; <snapon.com.sg>; <snapon.in>; etc.

The Complainant is the registered proprietor of the trade mark SNAP-ON and various formatives thereof. The registration certificates in respect thereof are annexed to the Complaint as Annexure C-4. In India also the Complainant's trade make SNAP-ON and its seven (7) variations are registered in Classes 6, 7, 8, 9, 11, 12, 17 and 20. The first trademark was registered on 07.10.1994. The said registrations are renewed from time to time, valid and are subsisting.

The Complainant contends that the disputed domain name contains the entire trademark of the Complainant, that is, SNAP-ON.

Further that, the addition of the generic word ".co.in" in a domain name is insignificant. It does not lead to any distinctiveness or reduce the similarity to the trademark "SNAP-ON" of the Complainant. It will not be perceived by the relevant public as a different, eligible to distinguish the Respondent or the services 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.

Therefore, the disputed domain name is identical and/or confusingly similar to the registered trademark 'SNAP-ON' of the Complainant.

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

Further, the Respondent does not have any rights or legitimate interest in the domain name because the Respondent has not exhibited any preparatory steps for using the domain name in connection with a *bona fide* offering of goods and services. The Respondent registered the domain name for the sole purpose of creating confusion and misleading the general public. The Respondent's use of the Disputed Domain Name is for fraudulent purposes, namely, to imitate a legitimate, well-reputed and trustworthy entity, i.e. the Complainant, so as to deceive e-commerce users into purchasing products through the impugned website that are never provided.

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

Regarding the element at (iii), the Complainant contends that the Respondent has registered the Disputed Domain Name in bad faith and for its actual use in bad faith. The main object of registering the domain name <www.snapon.co.in> by the Respondent is to attract, for commercial gain, Internet users and mislead the customers of the Complainant and the general public. The Respondent was bound to be (or should have been) aware of the Complainant's aforesaid trademarks/ domain name/ corporate names and its enforceable rights in the same, long prior to registering the disputed domain name.

Further that, absence of use and passive holding of a domain name constitutes bad faith. The Complainant has stated that the use of a domain name that appropriates a well-known trademark to promote competing or infringing products cannot be considered a "*bona fide offering of goods and services*".

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Further that, as has been stated earlier, according to the Dynadot LLC WHOIS database, the contact details of the Registrant are privacy protected/hidden. A copy of the Dynadot LLC WHOIS search results for the domain <snapon.co.in> is annexed herewith and marked as Annexure C-2. Upon filing this domain complaint online, it was revealed by NIXI that the said domain name is registered in the name of Feifei, Doublefist Limited (**If you want to acquire this domain name, please visit the website: www.pushuo.com**). Copy of the complete WHOIS details as received from NIXI is annexed herewith and marked as **Annexure C-2(a)**.

Thus. The disputed domain name was available for sale on the website www.pushuo.com.

In support of its contentions, the Complainant has relied on a number of decisions by different entities. They have been duly considered. However, it has not been considered necessary to make their references during the aforesaid discussion.

B. Respondent

The Respondent did not submit any response.

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 Policy, the Arbitration and Conciliation Act, 1996, the Rules and any rules and principles of law that it deems applicable".

According to the Policy, the Complainant must prove that:

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

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A. *Identical or Confusingly Similar*

The disputed domain name <SNAPON.CO.IN> was registered by the Respondent on March 26, 2016. The registration of the said disputed domain name will expire on March 26, 2021. The present Complaint has been filed on July 07, 2020. No explanation is available as to why the Complainant did not take any action for four years. .

The Complainant is an owner of the registered trademark "SNAP-ON" in certain countries of the world. By virtue of long standing use, registration, recognition and extensive promotion globally, including in India, the Complainant's trade mark **SNAP-ON** and its formatives thereof, qualify to be well-known marks, and are liable to be protected as per the provisions of the Trade Marks Act, 1999.

The disputed domain name <snapon.co.on> comprises the Complainant's trademark in full except the omission of the hyphen (-) between the words "SNAP" and "ON" which is an unnoticeable difference to a user/consumer and is therefore visually, phonetically and conceptually identical and confusingly similar to the Complainant's trade mark **SNAP-ON**.

The Complainant is also the owner of a large number of domains with the trademark "SNAP-ON" as stated above and referred to in the Complaint. Most of these domain names and the trademarks have been created by the Complainant much before the date of creation of the Disputed Domain Name by the Respondent. The disputed domain name is <www.snapon.co.in>. Thus, the disputed domain name is very much similar to the name and the trademark of the Complainant.

The Hon'ble Supreme Court of India has recently 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 products of the Complainant in India or elsewhere would mistake the disputed domain name as of the Complainant.



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

B. *Rights or Legitimate Interests*

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 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 is Feifei 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.

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

Further, the Respondent cannot assert that it has made or that it is currently making any legitimate non-commercial or fair use of the domain name, in accordance with Paragraph 7 (iii) of the .IN Policy. In fact, the Respondent is not making use of the impugned domain at all, whether for hosting any



content/ website or otherwise. However the Respondent has also listed the disputed domain name for sale.

I, therefore, find that the Respondent has no rights or legitimate interests in the domain name as per INDRP Policy, Paragraph 4(ii).

C. *Registered and Used in Bad Faith*

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 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
- (iv) 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.

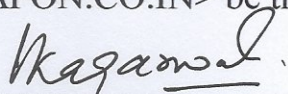
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The Respondent's registration of the domain name <www.snapon.co.in> is likely to cause immense confusion and deception and lead the general public into believing that the said domain name enjoys endorsement or authorized by or is in association with and/or originates from the Complainant. In any case, as has been indicated above, the disputed domain name is also available for sale.

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 Complainant has rights, that the Respondent has no rights or legitimate interests in respect of the domain name, and that the 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.SNAPON.CO.IN> be transferred to the Complainant.



Vinod K. Agarwal

Sole Arbitrator

Date: August 04, 2020