

G. JYOTHI
S.V.L.NO.2/2005, H.NO.25/3 RT.
BESIDE UDIPI HOME COMPLEX.
OPP. CHAITRYA COLLEGE
S.R. NAGAR
HYDERABAD - 500 038
AP-23/GSO/KL-(PB)-21/2005

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2. The Domain Name, Registrar and Policy

The present Arbitration pertains to the domain name <saharaforceindiafl.co.in> registered by the Respondent. The sponsoring registrar for the disputed domain name is Directi Internet Solutions Pvt. Ltd., d/b/a Public Domain Registry.com.

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 “Rules”).

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 July 7, 2012 and on July 8, 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 requested further time and submitted his reply by email on August 14, 2012. The Arbitrator now proceeds to determine the case on its merits.

Factual Background

The Complainant is the registered proprietor of the trademark FORCE INDIA and has submitted copies of its trademark registrations for the mark. The Complainant’s registered trademarks under numerous classes for the FORCE INDIA mark are: International Madrid (EU) Trademark number U00000978682 and International Madrid (EU) Trademark number U00000978683, and International trademark number 2472102, registered on July 2009.



The Complainant has filed for Community trademark registration on April 23, 2012 for the device mark SAHARA FORCE INDIA, numbered as CTM Application number 010830529 and CTM Application number 010830503.

The Respondent registered the disputed domain name <saharaforceindiafl.co.in> on October 12, 2011.

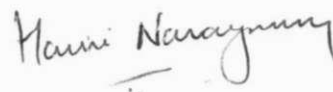
4. Parties contentions

A. Complainant's Submissions

The Complainant states it is a company based in Silverstone England that owns and runs the Formula One racing team called "Force India Formula One Team". The team was formed in 2007 and was known by the name "Force India Formula One Team" until 2011 when Sahara Adventure Sports India limited, an Indian Company and part of the Sahara Group, purchased 42.5% of the Orange Indian holdings S.A.R.L, the parent company of the Complainant and the team was then renamed as "Sahara Force India F1 Team". The Complainant states it uses the domain name <forceindiafl.com> as its website and has provided copies of its WebPages to show use of the trademark SAHARA FORCE INDIA on the said WebPages.

The Complainant submits that it is the registered proprietor of a large number of trademarks for the mark FORCE INDIA covering a wide range of classes and in many jurisdictions, and the earliest registration date and use of the mark is from May 2008. The Complainant has filed the registration details of some of the said marks. The Complainant states the term "Sahara" is owned by Sahara Group and has been extensively registered by the Sahara Group as a trademark in India since 1987 in relation to a wide range of business interests.

The Complainant states that the composite brand "Sahara Force India" has not yet been registered as a trademark, but it has made three trademark applications under the European Community registration system (one word mark and two logo marks). The Complainant states that it has used the name Sahara Force India extensively since

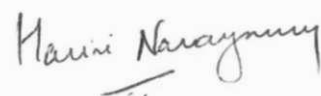


October 2011 and claims that it is now a globally recognized mark in the field of motor racing.

The Complainant argues that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name as the Respondent is not known by the domain name in question and has not acquired or attempted to acquire any corresponding marks, further there is no evidence that the Respondent has used the disputed domain name for a *bona fide* offering of goods or services or that the Respondent is making legitimate non-commercial fair use of the domain name. The Complainant asserts that the Respondent appears to have registered the disputed domain name solely with the intention of making commercial gain out of the sale of the disputed domain name to Complainant.

The Complainant states the Respondent's bad faith acts include registration of domain names that are identical or confusingly similar to its trademark and attempting to sell the domain names to the Complainant. The Complainant claims the rebranding of the Complainant took place after a substantial shareholding in the Complainant's parent company was acquired by the Sahara Group that was announced on October 12, 2011. The Respondent registered the disputed domain name on the very same day. On October 14, 2011 the Complainant discovered that two domain names <sharaforceindia.com> and <saharaforceinidafl.com> were registered by the Respondent, and these domain names are the subject of complaints at WIPO under the UDRP. The Complainant states it contacted the Respondent in a bid to acquire the domain names from the Respondent and offered Rs 8000 which was refused by the Respondent. Further investigation by the Complainant revealed that the Respondent had also registered three other similar .IN domain names.

On November 15, 2011, the Complainant states that further offers were made to the Respondent in the form of (i) a pair of free domestic return tickets on Kingfisher airlines and (ii) an all expenses trip to attend one of the international Grand Prix scheduled for 2012. Initially the offer was for one person and later the Complainant states that it extended the offer for two people, however both the offers were refused



by the Respondent. In November 2011 the Respondent was again contacted by the Complainant and was asked what he wanted to receive in order to agree to transfer all of the domain names to the Complainant, but no reply was received. The Complainant submits that in December 2011 the Respondent accepted to transfer the domain names for USD 3500 per domain name and the Complainant made a counter offer of USD 10,000 for all six-domain names, which the Respondent accepted but had failed to co-operate in finalizing the formal written documentation. On March 22, 2012 the Complainant states that prior to commencing these proceedings against the Respondent, it made a lower offer for USD 4000 for the domain names as a final offer to the Respondent.

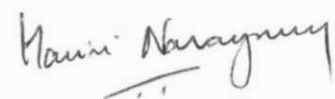
The Complainant states that the email exchanges between the parties shows the Respondent has registered the disputed domain name for the purpose of selling or otherwise transferring it to the Complainant for valuable consideration in excess of the Respondents out of pocket costs directly related to the domain name and requests for transfer of the disputed domain name.

Respondent's Submissions

The Respondent states that he is based in the city of Hyderabad in India and has been a motor sports enthusiast since 1996. He states he is involved in the business of running driving schools under the name "Hind Motor Training School" and uses the domain name <hindmotortraining.com> as the website for his business.

The Respondent claims he has won national and regional events including the first Regional National Champion, the JK Tyres National Go Karting Championship in 2001. The Respondent submits he started the Andhra Pradesh Motorsports Club and has organized six national level drag races and two TDS rallies in Hyderabad among others. The Respondent states he has also entered the LIMCA BOOK OF RECORDS for conducting the maximum number of drag races in India in a year with an average participation of more than two hundred racers.

The Respondent states he started "Speedway Motorsports" with five partners in order to provide a platform for racing enthusiasts and professionals. The Respondent has



also created a fan page on the social networking site Face Book in November 2008 and the page has about 1000 fans. The Respondent has submitted as evidence the documents of Registration of the partnership firm “Speedway Motorsports”, screen shots of the website at www.speedwaymotorsports.in, the entire face book fan page of the Respondent and copies of articles, photographs news clippings about the Respondent and his activities.

The Respondent argues that the Complainant has no rights in the mark SAHARA FORCE INDIA as the Complainant has not filed any documents that show it is known by the name Sahara Force Indian, and the incorporation certificate has not been filed by the Complainant. The Respondent further argues that no documents such as advertisements, brochures invoices etc have been filed to show its common law rights in the composite term “Sahara Force India”. The Respondent further argues that the trademark documents filed by the Complainant does not show since when the trademark has been put to use. Further, no evidence has been provided by the Complainant to show that the trademark application has been filed in India or that the said expression has been used in India.

The Respondent further submits that even in its email communications the Complainant has not used the term SAHARA FORCE INDIA and therefore argues that as the Complainant does not use the term SAHARA FORCE INDIA it is not known by the name. Further the Respondent argues that the Complainant has not given evidence of use of its mark FORCE INDIA from 2008 or evidence of use of SAHARA FORCE INDIA from October 2011 and the Complainant’s trademark application for SAHARA FORCE INDIA was filed on April 23, 2012. As these trademark applications was filed after the registration of the disputed domain name, it does not prove rights in favor of the Complainant as unregistered rights are not sufficient without showing documents of use for common law rights to establish rights. The Respondent cites several WIPO cases to support its contentions.

The Respondent submits that it has lawful intentions to use the disputed domain name to operate a fan site for the Indian Formula One team and has taken steps to start operating such a website, but since its registration the Respondent has been approached by many entities requesting for transfer and intends to use it as a non

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commercial website for Formula One racing fans for the Indian audience as an interactive website. The Respondent contends that he has demonstrated his interests by submitting various documents showing his interest in motor sports and his online fan pages. The Respondent argues that there was no bad faith in registration of the disputed domain name as the brand SAHARA FORCE INDIA did not exist at the time of registration of disputed domain name. The Respondent states that although he has shown “demonstrable intentions” to put the subject domain name to use he has not yet hosted the website due to threats made by the Complainant. Further, the Respondent states that the communications from the Complainant were from Kingfisher and the Complainant did not used the term SAHARA FORCE INDIA in its communications with the Respondent and argues that the Complainant’s trade mark application has been as recently as April 23, 2012 and that the Complainant has not filed any documents to show that the mark has been used prior to April 23, 2012. The trademark applications according to the Respondent do not show the date of use of the mark and additionally the Complainant has not filed an Indian trademark registration. The Respondent further argues that the Respondent could not have predicted the Complainant’s brand could be named SAHARA FORCE INDIA even prior to the founding of the brand.

The Respondent submits that he is a motor sports enthusiast and has genuine interest in the achievement of TEAM FORCE INDIA and has no commercial interest in the domain name but wishes to open an unofficial fan club about its activities and achievements. The Respondent had opened such online forums in the past out of sheer interest and has founded such groups in “Face book” with 1000 members. The Respondent states that as he was continuously contacted by companies claiming interest in the domain name that were threatening legal action he chose not to develop the website as he could not afford to develop a fan page and finally incur loss over the dispute.

The Respondent states he has not commercially gained from the registration of the domain name and does not seek any profit from such registration, as there are no advertisements on the page of the domain name. Had the Respondent sought to profit from the registration, he argues he would have contacted the Complainant and offered to sell the domain name or accepted the good offers made by the Complainant, but

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has not yielded to the offers as he has stuck to his objective to make a fan site. The Respondent states that there shall be no confusion between the disputed domain name and the Complainant website as the Respondent would make legitimate non-commercial fair use of the disputed domain name, and adds that his interest in motor sport is being throttled by all the might of the Complainant. The Respondent further submits that it would be adding the appropriate “disclaimer clauses” to distinguish itself from the WebPages of the Complainant and claims that he has not put to use the Intellectual Property belonging to the Complainant in any of the contents in the unofficial fan club.

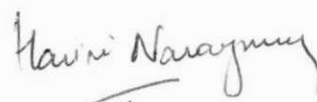
The Respondent further states there is no competitor in the same business and that the Respondents activities of a fan club will only prove beneficial to the Complainant. The Respondent reiterates that as the expression SAHARA FORCE INDIA was not in existence at the time of registration of disputed domain name the Complainant is acting against a true motor sport enthusiast.

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.

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.

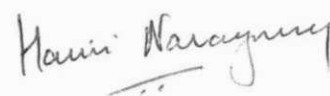


Identical or Confusingly Similar

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.

The Complainant has furnished documents that demonstrate that it has registered rights in the trademark FORCE INDIA in these proceedings. Trademark registration is recognized as *prima facie* evidence of rights in a mark. The Arbitrator notes the Respondent's arguments that the Complainant has neglected to provide its incorporation certificate or other documents to prove that it is known by the name. The Policy does not require the Complainant to establish that it is known by the disputed domain name and it is sufficient for the Complainant to establish it has rights in the mark in these proceedings. The Complainant has established its rights in the mark FORCE INDIA in these proceedings and the trademark registration certificates for FORCE INDIA show use since 2008 giving credence to the Complainant's averments. Further, online archived material from leading Indian daily newspaper reports corroborate the Complainant's submissions that the Sahara Group took over as the Complainant's new management on or about the date the Respondent registered the disputed domain name. Given the extensive media reports, and the Complainant's prior registered rights in FORCE INDIA the Arbitrator accepts the Complainant's rights in the term "Sahara Force India". Further, given the extensive media publicity in India regarding the Complainant's ownership of the team, the Respondent's arguments that the Complainant was not the owner of the mark on the date of registration of the domain name or that the Complainant has not used or registered the mark in India does not help the Respondent's case.

If a trademark is found in its entirety in a disputed domain name, it is sufficient to establish that the disputed domain name is identical or confusingly similar to the mark. See for instance *G.A Modelfine S.A v. Naveen Tiwari* , INDRP / 286 (February 20, 2009) and *L'Oreal v. Zeng Wei* <loreal-paris.in>, INDRP/342 (May 3, 2012) . In the present case, the mark FORCE INDIA is found in its entirety in the disputed domain name. Media reports in well-known daily newspapers in India such as Times



of India mention the Sahara Group is the owner of the Indian F1 team Force India. Therefore the entire term “Saharaforceindiaf1” is found to be confusingly similar to the Complainant’s registered mark FORCE INDIA. The country code top-level domain (cc TLD) “.in” or the “.co.in” suffix does not lessen the confusing similarity. See *Morgan Stanley v. Bharat Jain*, INDRP Case No. 156 dated October 27, 2010.

For the reasons discussed, the Complainant is found to have satisfied the first element under paragraph 4 of the Policy, that the disputed domain name is confusingly similar to a trademark in which the Complainant has established rights.

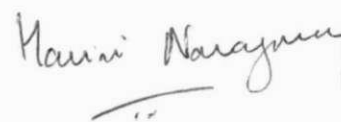
Rights and Legitimate Interests

The second element requires the Complainant to show that the Respondent has no rights and legitimate interests in the disputed domain name and it is sufficient if the Complainant can make a *prima facie* case of the Respondent’s lack of rights.

The Complainant’s submissions regarding the Respondent’s lack of rights or legitimate interests in the disputed domain name are: (a) The FORCE INDIA marks are used and associated with the Complainant (b) The Respondent is not commonly known by the disputed domain name and has not acquired any trademark rights in the term (c) The Respondent has not used the disputed domain name for a *bona fide* offering of goods or services and there is no evidence that the disputed domain name is being used for non commercial fair use purposes.

Under Paragraph 7 of the Policy, a Respondent or a registrant 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 fair use of the domain name without any commercial gain.

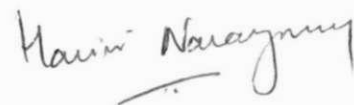
The Respondent has sought protection under Paragraph 7(iii) of the Policy and has submitted that he proposes to use the disputed domain name in connection with a fan



site for Formula One Racing Team for the Indian audience. However such an argument does not sufficiently explain why the Respondent has opted to merely use the Complainant's trademark without using term "fan club". Further, the Respondent has stated that the disputed domain name is being held passively till the present dispute is resolved. The Respondent's arguments that he has not developed the fan site till the outcome of the legal proceedings does not detract from the fact that the domain name is being held passively at present. Mere passive holding of the domain name in contemplation of a proposed site does not establish rights, and this has been recognized in numerous previous domain name cases.

The Respondent has submitted that he has lawful intentions to use the disputed domain name to operate a fan site for the Indian Formula One team and has taken steps to start operating such a website. Proposed contemplated future use is not a defense under the Policy. The Respondent has not shown demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services under paragraph 7 (i) or filed any evidence filed that shows he is making legitimate, non commercial fair use of the domain name without any intention of commercial gain under paragraph 7 (iii) of the Policy. There is little merit in the Respondent's submissions that by placing a disclaimer on the proposed web site there shall be no confusion between the disputed domain name and the Complainant's website. In the absence of a distinguishing term such as "fan club" or "fan site" along with the Complainant's mark, the Arbitrator is not convinced that use of the Complainant's trademark in the disputed domain name is not likely to create confusion in the mind of the public. Further if the domain name is found to be identical or confusingly similar to a known trademark and the respondent has clearly not used it for any legitimate or *bona fide* purposes it shows lack of rights or legitimate interests of the respondent, See for instance *Mobile Communication Service Inc. v. WebRegRN*, WIPO Case NoD2005-1304, or *Gerber Products Co. v. La Porte Holdings*, WIPO Case No. D2005-1277.

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 argued that the Respondent has registered and used the disputed domain name in bad faith for the reason that the Complainant has well-established rights in the trademark FORCE INDIA and the Respondent has intentionally attempted to gain from registration of the disputed domain name by trying to sell it to the Complainant, who is the owner of the mark.

The Complainant has clearly established its prior trademark rights and that it has used the mark FORCE INDIA from the year 2008. The evidence on record shows the Complainant and its predecessor in interest had adopted and used the trademark FORCE INDIA for about three years prior to the registration of the disputed domain name. It can therefore be reasonably inferred that the Respondent who is a car racing enthusiast was aware of the Complainant's prior rights in the mark at the time the disputed domain name was registered. Taking into account these facts and circumstances, the registration of the disputed domain name appears to be a deliberate use of the Complainant's mark to derive some gain by the Respondent. Registration of a domain name, based on awareness of a complainant's trademark rights is indicative of bad faith registration under the Policy. See *Worckhardt Limited v. Kishore Tarachandani* INDRP Case No. 382, August 14, 2012 (<wockhardt.in>).

If there are circumstances that indicate the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name to the Complainant, the owner of the mark for valuable consideration in excess of documented out of pocket costs directly related to the domain name, it is considered evidence of bad faith registration under Paragraph 6 (i) of the Policy. The facts presented here suggest there is no reasonable explanations for the registration of the disputed domain name except that the Respondent seeks to exploit the reputation and goodwill associated with the Complainant's mark in the manner mentioned under Paragraph 6 (i) of the Policy and by registering and using the disputed domain name the Respondent has acted in disregard of the

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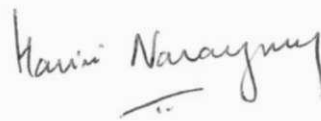
Complainant's prior rights in the FORCE INDIA mark. The Arbitrator finds that it has been held in the WIPO case filed against the Respondent regarding the domain name <saharaforceindia.com>, that the timing of the registration of the domain names by the Respondent indicates opportunistic registration in bad faith. See *Force India Formula One Team v. Mandeep Singh Dhingra*, WIPO Case No D2012-1102.

The facts in the present case also show the Respondent has registered the disputed domain name on the same day that press and media announcements were made that the Sahara Group had acquired the Force India F1 team. Given the evidence on record in the present case and the timing the Respondent has registered the disputed domain, it is reasonable to infer that the Respondent had registered the disputed domain name with opportunistic intentions of obtaining some undue advantage associated with the goodwill of the Complainant's trademarks. The registration and use of a domain name that exploits the goodwill and fame of another's trademark is an indication of bad faith registration and use. See *Bloomberg Finance L.P v. Domain Admin / Bharat DNS Pvt Ltd.*, INDRP / 365 August 13, 2012 <bloombergnews.in>.

Accordingly the Complainant has satisfied the third element under paragraph 4 of 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 lacks 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:
<saharaforceindiafl.co.in> be transferred to the Complainant.



Harini Narayanswamy
(Arbitrator)

Date: September 7, 2012