



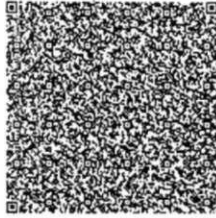
सत्यमेव जयते

## INDIA NON JUDICIAL

Government of National Capital Territory of Delhi

### e-Stamp

Certificate No.	: IN-DL00751247515387L
Certificate Issued Date	: 23-Dec-2013 10:37 AM
Account Reference	: IMPACC (IV)/ dl775503/ DELHI/ DL-DLH
Unique Doc. Reference	: SUBIN-DL77550399296696691781L
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)



.....Please write or type below this line.....

**NATIONAL INTERNET EXCHANGE OF INDIA**  
**Flat No. 6 B, 6<sup>th</sup> Floor, Uppals M 6 Plaza,**  
**6, Jasola District Centre,**  
**NEW DELHI – 110 025**

3M Company v. Mr. Gopinath Goswami

### AWARD

**Statutory Alert:**

1. The authenticity of this Stamp Certificate should be verified at "www.sholestamp.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.
3. In case of any discrepancy please inform the Competent Authority.

*Wagawal*

### 1. The Parties

The Complainant is 3M Company, 220-9E-01 3M Center, 2501 Hudson Road, Saint Paul, MN 55144.

The Respondent is Mr. Gopinath Goswami, LeBon Impex Private Limited, 401, Deepa Block, Chitra Avenue, 9, Choolaimedu High Road, Chennai – 600 094, Tamil Nadu.

### 2. The Domain Name and Registrar

The disputed domain name is <www.steridraper.in>.

The particulars of registration of the disputed domain name are as follows:

- |                            |                                  |
|----------------------------|----------------------------------|
| (a) Name of the Registrant | : Mr. Gopinath Goswami           |
| (b) Domain ID              | : D5849188-AFIN                  |
| (c) Created on             | : 14 <sup>th</sup> February 2012 |
| (d) Expiration date        | : 14 <sup>th</sup> February 2014 |
| (e) Registrar              | : GoDaddy.com, LLC (R101-AFIN)   |

### 3. Procedural History

- (a) A Complaint dated 4<sup>th</sup> December 2013 has been filed with the National Internet Exchange of India, New Delhi. The Complainant has made the registrar verification in connection with the domain name at issue. The print outs so received are annexed as Annexure 9 with the Complaint. It is confirmed that the Respondent is listed as the Registrant of the disputed domain name and provided the contact details for the administrative, billing, and technical contact. The National Internet Exchange of India 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 National Internet Exchange of India 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 was properly appointed. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Exchange.

*V. K. Agarwal*

- (c) In accordance with the Rules, the Sole Arbitrator formally notified the Registrant/Respondent of the Complaint through a registered letter dated 23<sup>rd</sup> December 2013. The Registrant/Respondent was required to submit his defence within 15 days. The Respondent was informed that if his response was not received by that date, he would be considered in default and the matter will be proceeded ex-parte.
- (d) In response to the aforesaid communication, the Respondent has duly submitted his response dated 30<sup>th</sup> December 2013 in hard copy through post, to the Complaint.

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

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

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

The Complainant M/s 3M Company, 220-9E-01 3M Center, 2501 Hudson Road, Saint Paul, MN 55144, United States of America was founded in 1902. Its principal place of business is St. Paul, Minnesota.

The Complainant's products include adhesives, abrasives, laminates, passive fire protection, dental products, electronic materials, medical products, car-care products, electronic circuits, optical films, etc. The SRERI-DRAPE brand incise drape is a clear, adhesive surgical drape that provides a sterile surface all of the way to the wound edge. A detailed list of various kinds of STERI-DRAPES is given in annexures 6 and 7 to the Complaint.

According to the complaint, 3M operates in more than 70 countries, sells products in nearly 200 countries and employs 88,000 employees globally. The Complainant is the owner of the trademark "STERI-DRAPE" in the United States of America and India.

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

According to the Complainant, the disputed domain name is owned by the Respondent Mr. Gopinath Goswami.

The Respondent Mr. Gopinath Goswami has submitted his response dated 30<sup>th</sup> December 2013. According to the response, the Respondent is carrying on business of surgical and medical devices in India under the name and style of OnlineSurgicals.com for the last more than 20 years.

*Kagarnal*

## 5. Parties Contentions

### A. Complainant

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

In relation to element (i), the Complainant contends that it is the owner of the trademark "STERI-DRAPE" for the last more than 50 years. The Complainant has spent substantial sums or money in developing and marketing its products and services under its mark STERI-DRAPE.

The complainant is a registered owner of the trademark "STERI-DRAPE" in various countries including United States of America. The said trademark "STERI-DRAPE" is also registered in India in Class 5.

The Complainant also owns a number of domain names with the combination of word "STERI-DRAPE"

The Complainant has stated that the Respondent/Registrant has registered the disputed domain name <www.steridrape.in> with an intention to trade upon the immense goodwill and reputation enjoyed by the Complainant in the famous trademark "STERI-DRAPE".

The complainant has further contended that it is the owner of trademarks "TEGADERM" and "IOBAN". The Respondent has registered the domain names with these trademarks also.

Thus, the disputed domain name <www.steridrape.in> is identical or confusingly similar to the trademark "STERI-DRAPE" of the Complainant.

In relation to element (ii), the Complainant contends that the Registrant/Respondent (as an individual, business, or other organization) has not been commonly known by the mark or name "STERI-DRAPE". Further, the Registrant/Respondent is not making a legitimate non-commercial or fair use of the said domain name for offering goods and services. The Respondent registered the domain name for the sole purpose of creating confusion, indicating sponsorship or affiliation and misleading the general public.

Further that the Respondent's registration of the domain name <www.steridrape.in> infringes on 3M's trademark rights. The Respondent has no statutory or other right in the mark "STERI-DRAPE".

Regarding the element at (iii), the Complainant contends that the main object of registering the domain name <www.steridrape.in> by the Respondent/Registrant is to mislead the general public and the customers

*Kagamel*

of the Complainant. There is no evidence that the domain name was registered by the Respondent for a legitimate reason. Additionally, Respondent prominently displayed images of 3M's STERI-DRAPE brand product on its website. The use of the image creates the impression that the disputed website <www.steridrape.in> is affiliated with 3M.

The Complainant has stated that the use of a domain name that appropriates a well known name to promote competing or infringing products or for making profit by offering to sell it cannot be considered a "*bona fide offering of goods and services*".

The Complainant has further contended that a visit to the site indicates that the disputed domain indicates that it is being used divert traffic away from 3M's own website to third party websites selling competitive products. Thus, the registrant/Respondent registered the disputed domain name in bad faith and for making profit out of the same.

The Respondent directs the domain name to commercial website that displays various commercial products that are linked to website that sells those and other products. Respondent, in turn, profits off of that advertising when consumers click links that go to another website that sells products that compete against 3M's products.

In support of its contentions, the Complainant has relied on a number of decisions in other cases.

#### **B. Registrant/Respondent**

The Respondent has been generous enough to submit in his response as follows:

"I further respectfully state that being a successful businessman in this industry, I would always like to be in good books of the great companies like 3M. I regret that my **INADVERTENT** act of registering these domain names has attracted unwarranted notoriety from a big corporate like 3M Company. I was indeed shocked to learn that a 30 Billion Dollar American Fortune 500 company has initiated legal action against me .... an ordinary individual running a small time business. Being an ordinary individual how can I take head-on with the mighty Corporation with extensive and abundant resources? At the same time, if I were to lose the ownership of the said domains, it will be a big BODY-BLOW for my business. Because I have invested a lot of time, money and energy around these domains to build up my business over a long period of time, I shudder to even think of the future of my business, if I were to lose the ownership of the said domain names."

*Kagansal*

The Respondent has further contended that, "The brand names Viz. Tegaderm, Steridrape, Ioban are no longer considered as brand names in India by medical fraternity, but as generic names only. When a surgeon orders for Steridrape, it is most likely that he may receive the incise drape of some other brand only. These terms are used in India so widely that in practice, these terms have become known as generic names."

## 6. Discussion and Findings

The Rules instruct 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 in accordance with the IN Domain Name Dispute Resolution Policy (INDRP), the Arbitration and Conciliation Act, 1996, the Rules and any rules and principles of law that it deems applicable".

According to paragraph 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 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 and is being used in bad faith;

### A. Identical or Confusingly Similar

The disputed domain name is <www.steridrape.in>. The Complainant is the registered owner of the trademark "STERI-DRAPE" in many countries including India. The domain name contains the entire trademark of the Complainant. The addition of the word "in" is insignificant. The said trademark is associated with well respected brand medical dressings. Further, the Complainant also owns domain names with the words "steridrape". The Registrant/Respondent has also used the same words. Thus, the Respondent's domain name is phonetically, visually and conceptually identical to the trademark of the Complainant.

In the case of *Farouk Systems Inc., v. Yishi*, WIPO Case No. D2010-0006 it has been held that the domain name wholly incorporating a complainant's registered mark may be sufficient to establish identity or confusing similarity, despite the addition or deletion of other words to such

*Kagarnal*

marks.

Therefore, I hold that the domain name <www.steridrape.in> is confusingly similar to the Complainant's marks.

#### **B. Rights or Legitimate Interests**

According to paragraph 7 of the INDRP, the Registrant/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 Respondent'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;
- (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.

In this case there is no evidence to suggest that the Registrant/Respondent has become known by the disputed domain name anywhere in the world. The Respondent is known by the name of Mr. Gopinath Goswami. There does not exist any relationship between the Registrant/Respondent and the words "steri-drape" used in the disputed domain name. Further that, the Respondent is not operating any activity on the website under the impugned domain "steridrape.in".

Further, the Complainant has not licensed or otherwise permitted the Registrant/Respondent to use its name or to apply for or use the domain name incorporating the said name. The Registrant/Respondent is not offering any goods or services under the disputed domain name.

It has been held in the cases of *American Home Products Corporation v. Ben Malgioglio*, WIPO Case No. D2000-1602 and *Vestel Elektronik Sanayi Ve Ticaret As v. Mehmet Kahvect*, WIPO Case No. D2000-1244 that a passive holding of a domain name is an evidence of a lack of legitimate rights and interests in that name.

*Kagame*



The submission of the Registrant/Respondent that he is using the domain name for the legitimate purpose of Search Engine Optimization is legally not sustainable.

Based on the evidence adduced by the Complainant, it is concluded that the above circumstances do not exist in this case. I, therefore, find that the Registrant/Respondent has no rights or legitimate interests in the disputed domain name.

### **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 is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of documented out of pocket costs directly related to the domain name; or
- (ii) The Registrant 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 it has engaged in a pattern of such conduct; or
- (iii) The Registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) By using the domain name, the Registrant 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 the Respondent's website or location or of a product or service on its website or location.

The contention of the Complainant is that the present case is covered by the above circumstances. There are circumstances indicating that the Registrant/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 name. Further that, The Registrant's/Respondent's registration of the domain name "<www.steridrape.in >" is likely to cause immense confusion and deception

*Megamul*



and lead the general public into believing that the said domain name enjoys endorsement and/or originates from the Complainant.

The Registrant/Respondent has submitted in his response that he has not registered the disputed domain name <www.steridrape.in> in bad faith. However, the use of registered trademark of the Complainant as a part of the domain name is sufficient to negate the said submission of the Registrant/Respondent.

The foregoing circumstances lead to the presumption that the domain name in dispute was registered and used by the Registrant/Respondent in bad faith. Therefore, I conclude that the domain name was registered and used by the Registrant/Respondent in bad faith.

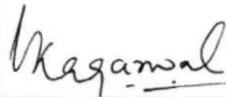
It will not be out of place to reproduce the last submission of the Registrant/Respondent which is as follows:

“Yet, I am of the considered opinion that 3M Company is the Brand Owner and they are entitled for the ownership of these domains. I wouldn't like to contest the case on mere technicalities and drag the issues. I am of the view that any attempt to contest would only smack of the intentions that lack bona fide. Therefore, I respectfully state that I agree for transfer of ownership of the said domains to the Complainant unconditionally.”

#### 7. Decision

In light of the foregoing findings, namely, that the domain name is confusingly similar to the name in which the Complainant has rights, that the Registrant/Respondent has no rights or legitimate interests in respect of the disputed 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, as prayed by the Complainant, the disputed domain name <www.steridrape.in> may be transferred to the Complainant.

The Registrant/Respondent has also consented for the transfer of ownership of the disputed domain name to the Complainant.



---

Vinod K. Agarwal,  
Date: February 14, 2014