

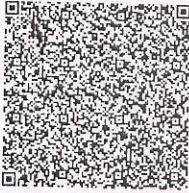


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INDIA NON JUDICIAL Chandigarh Administration

e-Stamp

Certificate No.	: IN-CH19271097281194R
Certificate Issued Date	: 09-Aug-2019 01:37 PM
Certificate Issued By	: chvandani
Account Reference	: IMPACC (GV)/ chimpsp07/ E-SMP MANIMAJRA/ CH-CH
Unique Doc. Reference	: SUBIN-CHCHIMPSP0738503190565973R
Purchased by	: ASHWINIE KUMAR BANSAL
Description of Document	: Article 12 Award
Property Description	: KOTHI NO 6 SHIVALIK ENCLAVE NAC MANIMAJRA CHANDIGARH
Consideration Price (Rs.)	: 0 (Zero)
First Party	: ASHWINIE KUMAR BANSAL
Second Party	: Not Applicable
Stamp Duty Paid By	: ASHWINIE KUMAR BANSAL
Stamp Duty Amount(Rs.)	: 100 (One Hundred only)



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ARBITRATION AWARD
(On Stamp Paper)

SR 0003204298

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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.
3. In case of any discrepancy please inform the Competent Authority.

**INDRP ARBITRATION
THE NATIONAL INTERNET EXCHANGE OF INDIA
[NIXI]**

**ARBITRAL TRIBUNAL CONSISTING OF
SOLE ARBITRATOR:
DR. ASHWINIE KUMAR BANSAL, L.L.B; Ph.D.
Advocate, Punjab & Haryana High Court,
Chandigarh**

In the matter of:

SUCCESS Partners Holding Co.,
5800 Democracy Drive,
Plano, TX 75024.

Email: docket@grspc.cpm; rschultz@grspc.com;
kneedham@grspc.com; jvincent@grspc.com

(Complainant)

Vs.

Success Partners LP. USA
Malad Mumbai, Mumbai, Maharashtra, IN 400097
+91.2239465670

E-Mail: editor@thesuccessmagazine.co.in;
editor.heer@thesuccessmagazine.co.in;
advertise@thesuccessmagazine.co.in;
laren.lawley@thesuccessmagazine.co.in;
postmaster@thesuccessmagazine.co.in

(Respondent)

COMPLAINT REGARDING: DISPUTED DOMAIN NAME:
<THESUCCESSMAGAZINE.CO.IN>

1. The Parties:

Complainant: SUCCESS Partners Holding Co., 5800 Democracy Drive, Plano, TX 75024.

Respondent: Success Partners LP. USA, Malad Mumbai, Mumbai, Maharashtra, IN 400097. Phone no. +91.2239465670

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2. **The Domain Name and the Registrar:** The disputed domain name <thesuccessmagazine.co.in> is registered with GoDaddy.com of the address 14455 North Hayden Road, Suite 219 Scottsdale, AZ 85260-6993, United States of America. (the "Registrar").

3. **Procedural History [Arbitration Proceedings]**

NIXI appointed Dr. Ashwinie Kumar Bansal, Advocate, as the sole Arbitrator in this matter. The Arbitrator has submitted his Statement of Acceptance and Declaration of Impartiality and Independence, as required by NIXI.

A Complaint has been filed with the National Internet Exchange of India (NIXI). NIXI has informed vide its E-mail dated 16.07.2019 as under:

"This is to inform you that we dispatched the physical copies of the captioned complaint on 5th July 2019 at the given address of the Respondent/Registrant provided in the WHOIS details as well as Complaint. The same has returned to our office as we believe that the address of the Respondent provided in the complaint as well as WHOIS details was incorrect/incomplete.

However, the soft copy of the complaint has been duly delivered to the Respondent vide email dated 5th July, 2019 as the same has not bounced back."

Notice of arbitration proceedings under rule 5(c) of INDRP Rules of Procedure of NIXI (the Rules) was sent to the Respondent vide e-mail dated 09.07.2019 on the e-mail addresses provided in the complaint.

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The address given per WhoIs Information is incomplete. Office of arbitrator had tried to communicate on the phone number given in the complaint, but it was an invalid number. NIXI as well as arbitrator had made efforts to serve the Respondent at his last known address/email ids , hence there is deemed service of the soft copy as per the provisions of Section 3 of the Arbitration and Conciliation Act, 1996 which provides as under:

*"3. Receipt of written communications.- (1) Unless otherwise agreed by the parties,-
(a) any written communication is deemed to have been received if it is delivered to the addressee personally or at his place of business, habitual residence or mailing address, and
(b) if none of the places referred to in clause (a) can be found after making a reasonable inquiry, a written communication is deemed to have been received if it is sent to the addressee's last known place of business, habitual residence or mailing address by registered letter or by any other means which provides a record of the attempt to deliver it.
(2) The communication is deemed to have been received on the day it is so delivered.
(3) This section does not apply to written communications in respect of proceedings of any judicial authority."*

In view of provisions of section 3 of the Arbitration and Conciliation Act, 1996 regarding receipt of communications, he is deemed to have been duly served.

The notice from the arbitrator has been duly delivered to the Respondent vide Email dated 09.07.2019 as the same has not bounced back from email addresses given in the complaint i.e.

.editor@thesuccessmagazine.co.in;

editor.heer@thesuccessmagazine.co.in;

and

postmaster@thesuccessmagazine.co.in. Hence, service of the

Respondent is complete.

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The Respondent was directed to file the response to the Complaint within 10 days vide notice dated 09.07.2019 through e-mail. The Respondent has failed to file any response to the Complaint till date although period for filing of response has already been expired.

As per section 25 of the Act the arbitrator is competent to make the award if Respondent fails to file the reply before him. Section 25 is reproduced below for ready reference:

25. Default of a party.- Unless otherwise agreed by the parties, where, without showing sufficient cause,----
(a) the claimant fails to communicate his statement of claim in accordance with sub-section (1) of section 23, the arbitral tribunal shall terminate the proceedings;
(b) the respondent fails to communicate his statement of defence in accordance with sub-section (1) of section 23, the arbitral tribunal shall continue the proceedings without treating that failure in itself as an admission of the allegations by the claimant.
(c) a party fails to appear at an oral hearing or to produce documentary evidence, the arbitral tribunal may continue the proceedings and make the arbitral award on the evidence before it.

In view of above, arbitrator proceeds to make the award in accordance with provisions of the Rules read with section 25 of the Arbitration and Conciliation Act, 1996.

4. Factual Background

Complainant has published magazines under the SUCCESS Mark since at least as early as 1977. The Complainant has secured 32 Trademark registrations that incorporate the term "SUCCESS", including both standard character registrations and design.

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The Respondent has registered the disputed domain name <thesuccessmagazine.co.in> incorporating Trademark of the Complainant. Hence, present Complaint has been filed by the Complainant against the Respondent.

5. Parties Contentions

A. Complainant

Complainant provides magazines, printed materials and publications, electronic materials and publications, and audio and video publications in the field of personal and professional development. Complainant has also long engaged in direct advertising of its goods and services through its website, social media, and printed materials. Use and registration of Complainant's trademarks in domain names is strictly prohibited. Complainant has very well established trademark rights in the SUCCESS family of marks. At least 32 registrations have been secured, seventeen (17) with the USPTO, for goods and services including magazines and online publication of magazines. These valid and subsisting registrations are sufficient to establish Complainant's rights under INDRP.

Furthermore, Complainant has developed substantial common law rights in the marks. SUCCESS magazine was first established in 1897. Complainant has regularly published magazines for personal and professional development since at least 1977, and has established widespread international recognition and consumer goodwill. Complainant's goods and services are available worldwide. Complainant has conducted substantial advertising, both through traditional media, as well as internet

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advertising and social media. Complainant hosts annual conferences that are attended by hundreds of people. Complainant also maintains several domains which are used in the ordinary course of Complainant's business, including www.success.com, www.store.success.com, www.successpartners.com, www.successpartnersuniversity.com, and www.successacademy.com. Complainant's long standing use and widespread recognition of its marks, along with its U.S. Federal and other international registrations, firmly establish its trademark rights since long before the registration of the domain in January 2018.

In this case, the fact that the domain wholly incorporates Complainant's SUCCESS trademarks strongly indicates that there is confusing similarity. The addition of the ccTLD ".co.in" as well as the generic and descriptive terms "the" and "magazine" do not distinguish the domain from Complainant's trademarks. Thus, <thesuccessmagazine.co.in> is identical or confusingly similar to Complainant's well established trademark rights in the SUCCESS Family of Marks.

Respondent has registered the domain under a false business name to advertise an unauthorized offering of Complainant's services. Respondent's use of the domain indicates a lack of rights or legitimate interests in several ways. First, Respondent has registered the domain under a fake business entity and has otherwise provided incomplete contact information, so Respondent cannot be commonly known by the domain, nor have gained any rights or public association.

Furthermore, Respondent is not authorized by Complainant to use Complainant's trademark in its domain name. Respondent's anonymity does not cast any doubt on this assertion, because

Complainant does not have any association with or license to any entities in India. In fact, Complainant does not have any "Indian" issue of its magazine, or any other country specific issue. Therefore, Complainant still would not have authorized the registration of the domain at issue.

Similarly, Respondent is using the domain to advertise Complainant's services as if Respondent were an authorized representative of Complainant. Respondent's use of the domain to re-publish articles, embed videos, and otherwise distribute Complainant's genuine materials strongly indicates that Respondent is attempting to appear as an authorized representative of Complainant. But Respondent is not an authorized representative of Complainant.

Complainant's personal and professional development magazine is universally applicable and available to all audiences. It is not specialized for individual countries. Hence, there is no possibility whatsoever that Respondent is an authorized representation of Complainant in India. Simply put, Respondent's registration and use of the domain falsely leads consumers to believe that Respondent is an authorized representative of Complainant – when it is not– such activity is textbook 'passing off.' Respondent's unauthorized use of Complainant's trademarks, including in the registration of the domain, precludes Respondent from having any rights or legitimate interests in the domain.

Bad faith can be shown, after considering the totality of the evidence, by conduct fitting the generally accepted meaning of the term. Bad faith registration and use can also be shown by evidence that Respondent intentionally attempted to attract, for commercial gain, Internet users to Respondent's web site 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 Respondent's business. Knowledge of a trademark – such as would show bad faith registration – can be shown by the registration of a domain containing the trademark plus generic or descriptive matter. Bad faith can also be shown when a well-known trademark is registered by a party with no connection with or authorization from the owner of the trademark.

In this case, Respondent clearly had knowledge of Complainant when registering the domain. For instance, Respondent registered the domain under the fake business entity "Success Partners LP. USA". Though it is similar to Complainant's name and trademarks, the company listed as Registrant does not exist. For instance, "Success Partners LP. USA" is not one of Complainant's companies. Furthermore, the entity is not a company name registered with the Ministry of Corporate Affairs in India. Not only is the domain registrant's name false, but the registrant information is incomplete and the address used is incorrect/non-deliverable. Complainant's trademarks are well known, Respondent blatantly copied them, and has used them to masquerade as an authorized representative of Complainant. These actions strongly indicate that Respondent is aware of Complainant and Complainant's trademark rights, and has registered and used the domain in bad faith.

Moreover, Respondent's agents have has posed as officers of Complainant. Respondent has held itself out as an authorized publication related to Complainant. Respondent has also gone so

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far as to re-publish Complainant's articles, and reuse Complainant's genuine promotional materials on its offending website to exacerbate the likelihood of confusion. For example, Respondent's website embeds multiple articles taken from Complainant's websites. Respondent also distributes a promotional media kit advertising the sale of banner ad space on the offending website, which is a nearly identical copy of Complainant's 2018 media kit. Similarly, Respondent distributes a "bidder form" used in the sale of advertising space which is also nearly an identical copy of a form used and created by the State of Illinois Education Department. Respondent's unauthorized taking of Complainant's genuine articles and promotional materials, and those of others, especially for the purpose of passing itself off as an authorized agent of Complainant, is textbook bad faith.

Moreover, Respondent has fraudulently represented itself to consumers. For instance, Respondent has endeavored to sell advertising space on the domain. During the course of dealings with potential consumers a representative of Respondent has held himself out as Complainant's Senior Vice President, Lauren Lawley. Furthermore, Respondent has used its altered bidder form and promotional media kit to advertise and sell ad space on the offending website to consumers. Similarly, Respondent has represented to the general public that it is associated with Complainant. For example, Respondent has posted job advertisements that state "Success Magazine India is the Indian Issue/Edition of Success, The Renowned business magazine in the United States" (emphasis added). The offending website also has multiple embedded links that forward users to Complainant's

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actual websites www.success.com, and www.store.success.com. These actions indicate a specific intention to benefit from Complainant's trademark SUCCESS and its reputation by registering and using the domain in bad faith.

On February 21, 2019, Complainant sent a cease and desist letter to Respondent using the three email addresses used by responded on promotional materials (editor.heer@thesuccessmagazine.co.in; advertise@thesuccessmagazine.co.in; and lauren.lawley@thesuccessmagazine.co.in). Complainant received a confirmation of delivery to the email address editor.heer@thesuccessmagazine.co.in. Respondent was afforded a deadline of March 3, 2019 in which to respond. At the submission of this complaint no response has been received. Respondent's failure to respond to the cease and desist letter sent by Complainant also indicates bad faith. The domain has remained up and the offending website is still actively being updated indicating Respondent's continued use is in bad faith.

Furthermore, Respondent's competing use of the domain also indicates bad faith. Respondent has taken careful steps to avoid detection, including providing incomplete and incorrect contact information and providing no contact information on the offending website. Purposefully withholding information raises a presumption of bad faith when done in a commercial context of direct competition or passing off, such as here.

Hence, Respondent clearly had knowledge of Complainant and its trademarks, used the offending domain in concert with claims of

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association, verbatim copies of Complainant's articles and promotional materials, posed as a representative of Complainant, and provided incomplete registrant information to prevent the discovery of its identity. Hence, Respondent has registered and used the domain in bad faith.

Respondent

The Respondent has not filed the Response to the Complaint in spite of opportunity given to him.

6. Discussion and Findings:-

As per Paragraph 11 of the INDRP Rules of Procedure where a Respondent does not submit a response, in the absence of exceptional circumstances, the Arbitrator may decide the Complaint in accordance with law. The Arbitrator does not find any exceptional circumstances in this case preventing him from determining the dispute based upon the Complaint, notwithstanding the failure of the Respondent to file a response.

It remains incumbent on the Complainant to make out its case in all respects under Paragraph 4 of the Policy, which sets out the three elements that must be present for the proceeding to be brought against the Respondent, which the Complainant must prove to obtain a requested remedy. It provides as follows:

"4. 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 Registrant's domain name is identical or confusingly similar to a name, Trademark or service*

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mark in which the Complainant has rights;

(ii) the Registrant has no rights or legitimate interests in respect of the domain name; and

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

The Registrant 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."

The Arbitrator has examined the Complaint and documents filed by the Complainant and he will address the three aspects of the Policy listed above.

A. Identical or Confusingly Similar

The Complainant owns the intellectual property rights in the Trademark SUCCESS and he has secured trademark registrations from the authorities. The Complainant has produced copy of a few Certificates of Registration regarding Trademark SUCCESS. The Trademark of the Complainant has become associated by the general public exclusively with the Complainant. The Complainant also has domain name registration of domain name <www.SUCCESS.com > which leads to an active website containing various articles published by the complainant and information on the various products available with the Complainant.

The disputed domain name as registered by the Respondent wholly incorporates Trademark SUCCESS of the Complainant. The Respondent has registered the disputed domain name, which is a combination of the Complainant's Trademark SUCCESS and a suffix magazine. The relevant Trademark "SUCCESS" is recognizable in

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the disputed domain name. While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant Trademark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that Trademark for purposes of UDRP standing¹.

The Arbitrator finds that the registration of the Trademark is *prima facie* evidence of the Complainant's Trademark rights for the purposes of the Policy². Internet users who enter the disputed domain name <thesuccessmagazine.co.in> being aware of the reputation of the Complainant may be confused about its association or affiliation with the Complainant.

The Respondent has registered the disputed domain name <thesuccessmagazine.co.in> incorporating the Trademark SUCCESS of the Complainant, which the Arbitrator finds is sufficient to establish confusing similarity for the purpose of the Policy.

The Arbitrator finds that the disputed domain name <thesuccessmagazine.co.in> is confusingly similar to the Trademark SUCCESS of the Complainant.

¹ The WIPO Overview 3.0 section 1.7 provides the consensus view of panelists.

² See *State Farm Mutual Automobile Insurance Company v. Periasami Malain*, NAF Claim No. 0705262 ("Complainant's registrations with the United States Patent and Trademark Office of the trademark STATE FARM establishes its rights in the STATE FARM mark pursuant to Policy, paragraph 4(a)(i)."); see also *Mothers Against Drunk Driving v. phix*, NAF Claim No. 0174052 (finding that the Complainant's registration of the MADD mark with the United States Patent and Trademark Office establishes the Complainant's rights in the mark for purposes of Policy, paragraph 4(a)(i)).

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B. Rights or Legitimate Interests

The Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in the disputed domain name. Nevertheless, it is well settled that the Complainant needs only to make out a *prima facie* case, after which the burden of proof shifts to the Respondent to rebut such *prima facie* case by demonstrating rights or legitimate interests in the domain name³. The Respondent has registered the disputed domain name wholly incorporating the Trademark SUCCESS owned by the Complainant. The Complainant has been using the Trademark SUCCESS since very long. The Complainant has not authorized or permitted the Respondent to use the Trademark SUCCESS.

The Respondent has not filed a Response to rebut the Complainant's *prima facie* case and the Respondent has thus failed to demonstrate any rights or legitimate interests in the disputed domain name <thesuccessmagazine.co.in> as per Paragraph 7 of the Policy.

The Respondent has no right to and legitimate interest in the disputed domain name. The Respondent illegally and wrongfully adopted the Trademark SUCCESS of the Complainant with the intention to create an impression of an association with the Complainant. The Arbitrator finds that the Complainant has made out a *prima facie* case. Based on the facts as stated above, the Arbitrator finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name <thesuccessmagazine.co.in>.

³ See *Hanna-Barbera Productions, Inc. v. Entertainment Commentaries*, NAF Claim No. 0741828; *AOL LLC v. Jordan Gerberg*, NAF Claim No. 0780200.

C. Registered and Used in Bad Faith

Paragraph 6 of the Policy identifies, in particular but without limitation, three circumstances which, if found by the Arbitrator to be present, shall be evidence of the registration and use of the Domain Name in bad faith. Paragraph 6 of the Policy is reproduced below:

"6. Evidence of Registration and use of Domain Name in Bad Faith

For the purposes of Paragraph 4(iii), the following circumstances, in particular but without limitation, if found by the Arbitrator to be present, shall be evidence of the registration and use of a 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 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 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."

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Each of the three circumstances in Paragraph 6 of the Policy (which are non-exclusive), if found, is evidence of "registration and use of a domain name in bad faith". Circumstances (i) and (ii) are concerned with the intention or purpose of the registration of the domain name, and circumstance (iii) is concerned with an act of use of the domain name. The Complainant is required to prove that the registration was undertaken in bad faith and that the circumstances of the case are such that the Respondent is continuing to act in bad faith.

The respondent's website embeds few articles taken from complainant's website. Respondent also distributes a promotional media kit advertising the sale of banner ad space on the offending website, which is a copy of complainant's media kit.

The Respondent has registered disputed domain name <thesuccessmagazine.co.in> with the .IN Registry wholly incorporating the Complainant's well-known, prior used and registered Trademark SUCCESS. The Complainant has not licensed or otherwise authorized or given consent to the Respondent to use/utilize or commercially exploit the Complainant's registered and well known Trademark SUCCESS in any manner. The disputed domain name clearly incorporates the Complainant's Trademark SUCCESS in its entirety. Such unauthorized registration of the domain name by the Respondent incorporating the Trademark of the Complainant suggests opportunistic bad faith. The Respondent's true intention and purpose of the registration of the disputed domain name <thesuccessmagazine.co.in> which incorporates the Trademark SUCCESS of the Complainant is, in this Arbitrator's view, to capitalize on the reputation of the Trademark of the Complainant.

The Arbitrator therefore finds that the disputed domain name <thesuccessmagazine.co.in> has been registered by the Respondent in bad faith.

The Trademark SUCCESS has been a well-known name. The disputed domain name <thesuccessmagazine.co.in> is confusingly similar to the Complainant's Trademark SUCCESS, and the Respondent has no rights or legitimate interests in respect of the domain name, and he has registered and used the domain name <thesuccessmagazine.co.in> in bad faith. These facts entitle the Complainant to an award transferring the domain name thesuccessmagazine.co.in to him from the Respondent.

The Arbitrator allows the Complaint and directs that the Respondent's domain name <thesuccessmagazine.co.in> be transferred in favour of the Complainant.

7. Decision

Keeping in view all the facts and circumstances of the matter this Complaint is allowed. The disputed domain name <thesuccessmagazine.co.in> is similar to the Trademark SUCCESS in which the Complainant has rights. The Arbitrator orders in accordance with the Policy and the Rules, that the domain name <thesuccessmagazine.co.in> be transferred to the Complainant.

The award has been made and signed at Chandigarh on the date given below.

Place: Chandigarh

ABJ
09/08/2019