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NATIONAL INTERNET EXCHANGE OF INDIA
Incube Business Centre, 5th Floor,
18, Nehru Place,
NEW DELHI – 110 019

Western Digital Technologies Inc.,, v. Mr. Xingming

AWARD

1. The Parties

The Complainant is Western Digital Technologies Inc., 3355, Michelson Drive, Suite No. 100, Irvine, CA 92612

The Respondent is Mr. Xingming, Room No. 501, No. 71 HongKou, Hong Kong 999077.

2. The Domain Name and Registrar

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The disputed domain name is <www.westerndigital.co.in>. The said domain name is registered with Directi Web Services Pvt. Limited d/b/a PublicDomainRegistry.com.

3. Procedural History

(a) A Complaint dated February 17, 2012 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 B 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 on February 22, 2012. The arbitrator received the Complaint on February 28, 2012. 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.

(c) In accordance with the Rules, on March 07, 2012 the Sole Arbitrator through registered letter formally notified the Registrant/Respondent of the Complaint. The Registrant/Respondent was required to submit his defence within 15 days from the date of receipt of the letter, that is, by March 31, 2012 (including 10 days for postal requirements). The Respondent was informed that if his response was not received by that date, he would be considered in default and the matter will proceed ex-parte.

(d) The said registered letter has however been returned as unserved by the postal authorities to the sole arbitrator on March 26, 2012. Thus, no reply has been received from the Respondent. Accordingly, the Respondent's default has been notified.

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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 Western Digital Technologies Inc., 3355, Michelson Drive, Suite No. 100, Irvine, CA 92612 is a limited company incorporated in 1970 according to the corporate laws of the United States of America. According to the Complainant, it manufactures hard drives and solid state drives for internal, external, portable and shared storage applications. The Complainant's hard drives are used in desktop and notebook computers, mobile and handheld devices, corporate networks and home entertainment equipment. The solid state storage is used in netcom, industrial, embedded computing, medical, military and aerospace markets.

Respondent's Identity and Activities

According to the Complainant, the disputed domain name is owned by Mr. Xingming, trading as Je J'Taime Productions Limited. The administrative contact address provided is Room 501, No. 71 Hongkou, Hong Kong. However, the Respondent did not file any reply. Hence, the Respondent's activities are not known.

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 its name is Western Digital Technologies, Inc. The disputed domain name is <www.westerndigital.co.in>. Thus, the disputed domain name contains the complete name of the Complainant. The deletion of the words "Technologies" or addition of the words "co" and "in" is insignificant.

It is further contended that the Complainant is the registered proprietor of the trademark WESTERN DIGITAL. The Complainant also owns various

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domain names with the combination of words "western" and "digital". Some such domain names are "western-digital.com"; "westerndigital.com.cn"; "westerndigital.jp"; "westerndigital.com.es"; "westerndigital.me"; "westerndigital.ae"; "westerndigital.com.hk"; "westerndigital.com.mobi"; "westerndigital.com.mx"; "westerndigital.co.uk"; "westerndigital.co.nl"; "westerndigital.co.nz"; "westerndigital.com.au"; "westerndigital.it"; "westerndigital.us"; "westerndigital.us.com"; "westerndigitaltech.com"; etc. The said websites were used and applied for registration long before the Respondent's registration of the disputed domain name.

The Complainant is also a registered proprietor of the trademark "WESTERN DIGITAL" in various countries. An illustrative list of such countries is Australia, Canada, Chile, China, Egypt, Hong Kong, Israel, Japan, Malaysia, Mexico, New Zealand, Paraguay, Russia, Saudi Arabia, Singapore, Switzerland, Taiwan, Thailand, Turkey, United Arab Emirates, United States of America, etc. In most of these countries, the said trademark "WESTERN DIGIYAL" is registered in Class 9. At the time Respondent registered the disputed domain name, the words "WESTERN DIGITAL" were well known as trademark and as part of the domain names of the Complainant.

The trademark "WESTERN DIGITAL" is also registered in India since March 18, 2005. The said registration is also in Class 9 for the following goods; "computer products namely disk drive". A copy of the registration certificate is available at Annexure E.

In support of its contention, the Complainant has relied on the decision of Yahoo! Inc., v. Akash Arora & Anr., (1999 PTC (19) Delhi) of the Delhi High Court.

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 "Western Digital". Further, the Registrant/Respondent is not making a legitimate 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 and misleading the general public.

In support of its contentions, the Complainant has relied on the cases of Guerlain S. A. v. PeiKang, WIPO Case No. D2000-0055; Veuve Cliequot Ponsardin v. The Polygenix Group Co., WIPO Case No. D2000-0163; Charles Jourdan Holding AG v. AAIM, WIPO Case No. D2000-0403; caravan Club v. Mrgsale, NAF Claim No. FA0007000095314; CBS broadcasting Inc., v. Worldwide Webs Inc., WIPO Case No. D2000-0834..

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

The Complainant has further contended that on March 28, 2011 the Complainant received an e mail from the email ID-sale@189.cn offering the impugned domain name for sale. Thus, the registrant/Respondent registered the disputed domain name in bad faith and for making profit out of the same by selling it to the Complainant or his competitors.

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*".

In support of its contentions, the Complainant has relied on the cases of Playboy Enterprises International Inc., v. Hector Rodriguez, WIPO Case No. D2000-1016; Veuve Cliequot Ponsardin v. The Polygenix Group Co., WIPO Case No. D2000-0163; Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003. Bennet Coleman & Co., Ltd., v. Steven S Lalwani, WIPO Case No. D2000-0014;

B. Registrant/Respondent

The Registrant/Respondent did not submit any evidence or argument indicating his relation with the disputed domain name <www.westerndigital.co.in> or any trademark right, domain name right or contractual right. Therefore, the Respondent has no legal right or interest in the disputed domain name.

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:

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(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

As per the whois information, the Registrant/Respondent has created the disputed domain name <www.westerndigital.co.in> on March 28, 2011. The expiration date is March 28, 2012. In other words, the said registration of the disputed domain name already ceased to exist.

The disputed domain name <www.westerndigital.co.in> contains the entire name of the Complainant, which is Western Digital Technologies, Inc. Merely by deleting the words "Technologies" or by creating a domain name with "co" and "in" is not sufficient to make the domain name distinct.

The Complainant is the registered owner of the trademark "WESTERN DIGITAL" in many countries, as indicated above. Further, the Complainant also owns a large number of domain names with the words "westerndigital". The Registrant/Respondent has also used the same words. Thus, the Respondent's domain name is phonetically, visually and conceptually identical as that 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 marks.

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

B. Rights or Legitimate Interests

According to paragraph 7 of the INDRP, the Registrant may demonstrate its rights to or legitimate interest in the domain name by proving any of the following circumstances:

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(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.

The Registrant's response is not available 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. There does not exist any relationship between the Respondent and the words "western digital" used in the disputed domain name. Based on the evidence adduced by the Complainant, it is concluded that the above circumstances do not exist in this case and that the Registrant/Respondent has no rights or legitimate interests in the disputed domain name.

The arbitrator is of the vies that the Registrant/Respondent registered the disputed domain name mainly for the purpose of misusing it, or transferring it to the Complainant or selling it in the market at a high price or for providing it to the competitor of the Complainant for valuable consideration.

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.

Therefore, the Registrant is not using the disputed domain name for bona fide offering of goods or services.

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.

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I, therefore, find that the Registrant/Respondent has no rights or legitimate interests in the 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. The Registrant's/Respondent's registration of the domain name <www.westerndigital.co.in> is likely to cause immense confusion and deception and lead the general public into believing that the said domain name enjoys endorsement and/or originates from the Complainant.

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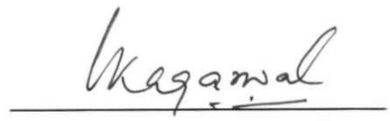
There is evidence that the Registrant/Respondent offered the disputed domain name for sale to the Complainant on March 28, 2011 through an email ID-sale@189.cn. Thus, the registrant/Respondent registered the disputed domain name in bad faith and for making profit out of the same by selling it to the Complainant or his competitors.

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.

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 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, as prayed by the Complainant, the disputed domain name <www.westerndigital.co.in> be transferred to the Complainant.



Vinod K. Agarwal
Sole Arbitrator
Date: April 4, 2012