  
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



**BEFORE THE NATIONAL INTERNET EXCHANGE OF INDIA  
ARBITRATION AWARD**

**In The Matter Between**

Yves Saint Laurent

Complainant

Versus.

S.Kambatta

Respondent

**1. The Parties**

The Complainant is Yves Saint Laurent, of 7, Avenue George V, 75008 Paris France represented in these proceedings by Remfry and Sagar, Gurgaon India.

The Respondent is S. Kambatta of 11-6-840 Jyoti Residency , 601 Red Hills Hyderabad 500004, India .



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## **2. The Domain Name, Registrar and Policy**

The present Arbitration pertains to the domain name <ysl.in> registered by the Respondent. The sponsoring registrar for the disputed domain name is Dynadot LLC.

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 August 8, 2012 and on August 10, 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 sent an email dated August 12, 2012 as a response in these proceedings. The Arbitrator now proceeds to determine the case on its merits.

## **Factual Background**

The unchallenged factual assertions are that the Complainant is a leading fashion house creating clothing and fashion accessories. The Complainant is the registered proprietor of the trademark YSL in numerous countries including India and has submitted copies of its trademark registrations for the mark.

The Complainant has submitted the copies of documents pertaining to its registered trademarks under numerous classes for the YSL marks in India, these are:

A handwritten signature in black ink, reading "Harini Narayanswamy". The signature is written in a cursive style with a horizontal line underneath the name.

S No.	TM Number	Trademark	Class	Date of Application	Status
1.	1397889	YSL	14, 18	November 10, 2005	Registered Renewed till 25/11/15
2.	1379351	YSL	25	August 24, 2005	Registered Renewed till 24/08/15
3.	649140	YSL (Monogram)	34	December 19, 1994	Registered Renewed till 19/12/14
4.	681457	YSL YVES SAINT LAURENT (Stylized)	18	September 25, 1995	Registered Renewed till 25/09/15
5.	681455	YSL YVES SAINT LAURENT (Stylized)	14	September 25, 1995	Registered Renewed till 25/09/15
6.	681456	YSL YVES SAINT LAURENT (Stylized)	16	September 25, 1995	Registered Renewed till 25/09/15
7.	1404376	YSL (monogram)	14, 18	December 6, 2005	Registered Renewed till 06/12/15
8.	1636942	YSL	9	January 1, 2008	Registered Renewed till 06/12/15
9.	560468	YSL	25	October 17, 1991	Registered Renewed till 17/10/15

*Hani Narayana*

The Respondent registered the disputed domain name <ysl.in> on April 3, 2005.

#### **4. Parties contentions**

##### **A. Complainant's Submissions**

The Complainant states that it is a simplified Joint Stock Company under the French laws. The Complainant's founder is a famous designer called Mr. Yves Mathieu Saint Laurent, popularly known as Yves Saint Laurent who was born on August 1, 1936 in Oran Algeria. In 1954 he joined the well-known designer Christian Dior and after the death of Christian Dior, Yves Saint Laurent became the Head Designer at the House of Dior. He started his own *couture* house under the company name Yves Saint Laurent in the year 1962.

The Complainant submits that it is an *haute couture* fashion house and is the first designer to launch women's luxury *prêt-à-porter*, ready to wear clothing. During the 1960s and the 1970s the Complainant states it popularized several modern concepts in women's luxury wear such as the beatnik look, safari jackets for men and women, tight pants, tall thigh high boots and the famous *Le Smoking* tailored tuxedo for women. The Complainant states that the designer Yves Saint Laurent was inspired by works of several painters including Van Gogh and Monet. He has designed clothing for many famous women due to which the Complainant states its style has become iconic. The Complainant claims it has more than one hundred stores in various countries all over the world and it is an industry leader that has received numerous awards and recognitions for its collections.

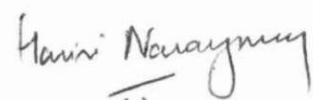
The Complainant states that it has invested time, capital, effort and resources in advertising and promoting its company and its collection under the trademark YSL through print and digital media around the world including India. In 1989, the Complainant states it held a series of fashion shows in India during the festival of France and has attached a newspaper report from the year 1989 referring to the said events. The Complainant has provided documents that show its products are available in India.



The Complainant states that since 1962 its trademark YSL is its most valued intellectual property and it is the registered proprietor of the mark in several countries covering a wide range of classes. The Complainant submits that the earliest trademark registration date for the YSL is April 10, 1962 under number 254533 in France and it also has registrations in UK and USA for the same year. The Complainant has filed the registration details of many of its registered marks for YSL and claims it is a globally recognized mark. In India the Complainant states its trademark YSL is registered in the year 1991 and that it has been recognized as a well-known mark by the Chinese trademark office in a decision published in 2005 and by a Chinese directory of well-known trademarks in China and has submitted corresponding translated documents as evidence. The Complainant has also provided a list of several top-level domain names it owns using its YSL mark. The Complainant claims that its web site ysl.com is popular in India.

The Complainant argues that the disputed domain name is identical to its YSL mark, which is recognized as a well-known mark and in which the Complainant has prior rights. The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name as the Respondent has not used the disputed domain name for a *bona fide* offering of goods or services and the Respondent is not known by the domain name in question and due to the fame of the Complainant's YSL mark that it is only associated with the Complainant, further the Respondent has been given no license to use its marks, and there is no evidence that the Respondent is making legitimate non-commercial fair use of the domain name.

The Complainant states the Respondent's bad faith acts include registration of the disputed domain name for the purpose of deriving commercial gain from the sale of the disputed domain name. The disputed domain name is offered for sale and is parked at Sedo.com, a well known website for selling domain names. The Complainant argues that the Respondent registered the disputed domain name knowing that it is identical to the Complainant's well-known trademark and for the goodwill attached to the mark. Thereby creating a likelihood of confusion with the Complainant's mark to attract unsuspecting users to the Respondent's website and misleading users that it may be sponsored, endorsed or affiliated with the



Complainant. The Complainant therefore request for transfer of the disputed domain name along with costs of the proceedings.

### **Respondent's Submissions**

The Respondent sent an email to the Arbitrator dated August 12, 2012 stating that the disputed domain name was not registered in bad faith as the domain names consists of a random combination of the three letters "L", "S" and "Y". The Respondent further argues that the complete three letter random combinations of all the three letters of the alphabet are registered in most domain extensions.

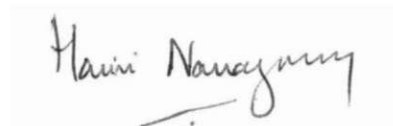
The Respondent goes on to state that other parties have register other extensions of "ysl", however the domain name ysl.com is not. The Respondent questions the Complainant's delay in bringing the proceedings after seven years of registration of the disputed domain name. Finally the Respondent argues that the registration of a domain without further development does not constitute trademark infringement.

### **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 YSL in these proceedings. Trademark registration is recognized as *prima facie* evidence of rights in a mark. Given the Complainant's prior registered rights in YSL the Arbitrator accepts the Complainant's rights in the three-letter mark YSL. Further, given the extensive media publicity in India regarding the Complainant's YSL mark and its products, the Complainant is found to have established the fame and reputation of its YSL mark in India and around the world.

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 YSL is found in its entirety in the disputed domain name. The country code top-level domain (cc TLD) “.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.





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 Complainant's submissions regarding the Respondent's lack of rights or legitimate interests in the disputed domain name are: (a) The Respondent has not used the disputed domain name for a *bona fide* offering of goods or services (b) The Respondent is not commonly known by the disputed domain name and the YSL marks are used and associated with the Complainant and the Complainant has not given any permission to the Respondent to use its trademark (c) The evidence of use of the disputed domain name shows that it is not being used for any non commercial or fair use purposes.

The Respondent has argued that the disputed domain name is just three letters and that the domain name is being held passively. However 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. Further if the domain name is found to be identical or confusingly similar to a well-known trademark, even if the trademark consists of merely three letters, the use of the trademark in the disputed domain name is likely to create confusion in the mind of the public. Furthermore if the Respondent has clearly not used the disputed domain name for any legitimate or *bona fide* purposes it shows lack of rights or legitimate interests 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. Laches and delay are generally not a valid defense in domain name proceedings as these proceedings are considered akin to trademark infringement proceedings.

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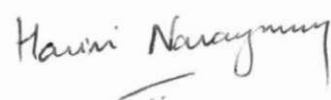
The Arbitrator finds the Complainant has made a *prima facie* case that the Respondent lacks rights and legitimate interests in the disputed domain name and has satisfied the second element under paragraph 4 of the Policy.

### **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 YSL and that the Respondent has intentionally registered an identical name and attempted to gain by advertising its sale on the SEDO website. The Complainant has clearly established its prior trademark rights in these proceedings and its use of the mark YSL for a number of years. The evidence on record shows the Complainant has used the trademark YSL for about fifty years whereas the disputed domain name was registered in the year 2005. It can therefore be reasonably inferred, based on the documents and evidence submitted by the Complainant, that the Respondent was aware of the Complainant's prior rights in the mark at the time the disputed domain name was registered.

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 explanation 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 Complainant's prior rights in the YSL mark. 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>.

The Respondent has not been able to show any *bona fide* use of the dispute domain name. 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>).

Accordingly the Complainant is found to have satisfied the third element under paragraph 4 of the Policy.

#### **Decision**

The Complainant has therefore 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 all the three grounds required under the Policy to succeed in these proceedings.

For the reasons discussed, it is ordered that the disputed domain name: <ysl.in> be transferred to the Complainant.



**Harini Narayanswamy**  
**(Arbitrator)**

**Date: September 15, 2012**