

भारतीय गैर न्यायिक



INDIA NON JUDICIAL

उत्तर प्रदेश UTTAR PRADESH

AP 028312

Dr. Bodhisatva Acharya

ARBITRATOR

(Appointed by .IN Registry-National Internet Exchange of India)

ARBITRATION AWARD

DISPUTED DOMAIN NAME :< www.americaneagle.in >

In the matter of:

Retail Royalty Company

101 Convention Center Drive

Las Vegas

Nevada 89109

United States of America

Filed by its authorized representative attorney -

IP Gurus

Attention: Sujata Chaudhari and Sahil Yadav

A-45, Sector 63

NOIDA,

Uttar Pradesh 201307

... ..Complainant.

PS



उत्तर प्रदेश UTTAR PRADESH

Vs.

AP 028313

Claudio Russo
C/o N/A
Wexford Road
Purmerend
North Holland 0299
Netherlands

.....Respondent.

A W A R D

1. The Parties:

The complainant in this arbitration proceeding is Retail Royalty Company, 101 Convention Center Drive, Las Vegas, Nevada 89109, United States of America filed by its authorized representative attorney IP Gurus, Attention: Sujata Chaudhari and Sahil Yadav, A-45, Sector 63, NOIDA, Uttar Pradesh 201307

Respondent Claudio Russo, C/o N/A, Wexford Road, Purmerend, North Holland 0299, Netherlands

BC

2. The Domain Name, Registrar & Registrant:

The disputed domain name is **www.americaneagle.in**

3. Procedural History:

The Complainant, through its authorized representative, filed this complainant to NIXI regarding the disputed domain name **www.americaneagle.in** following the clause 4 of the policy of .IN Registry and .IN Registry appointed **Dr. Bodhisatva Acharya** (The Arbitrator) as Sole Arbitrator under clause 5 of the policy. The Arbitrator submitted his statement of acceptance and declaration of Impartiality and the Independence and the complaint was produced before the Arbitrator on October 17th, 2013 and the Arbitrator sent a notice, to the Respondent through his email for the Arbitration Proceeding on October 24th, 2013, to submit his reply but nothing was submitted to Arbitrator till the date of award hence the AWARD is being declared on the December 18th, 2013 as Ex-parte.

4. Factual Background:

- (a) Retail Royalty Company, together with its parent, American Eagle Outfitters, Inc., and affiliated entities (collectively "the Complainant") founded in 1977 is a leading retailer that designs, markets, and sells a variety of goods including readymade clothing and fashion accessories such as leather goods, jewelry, sunglasses and cosmetics. Since its founding in 1977, the Complainant has been consistently listed among the top clothing and accessory retailers in the United States in 2006; the Complainant was listed first in the Forbes Platinum list, an exclusive list of best companies in the United States. The Complainant has also been ranked in fortune 500's list of America's 1000 largest corporations. Women's wear daily, a leading source of news in the fashion industry, ran a consumer brand awareness survey in which the Complainant was listed in the top 100 brands in the United States ahead of brands such as ROLEX, CALVIN KLEIN and RAY-BAN.
- (b) The Complainant has consistently used the AMERICAN EAGLE Marks since it was founded more than thirty-five (35) years ago. The AMERICAN EAGLE Marks displayed on clothing, cosmetics, fragrances, eyewear, purses, wallets, jewelry, fashion accessories and a range of services, including retail store services, online retail store services and advertising and entertainment services. Today goods bearing the AMERICAN EAGLE Marks are sold through approximately one thousand (1000) stores operated by the Complainant and/or by its franchisee partners around the world. The stores are located in numerous countries around the world, including the United

States, Poland, Canada, Hong Kong, Israel, Japan, People's Republic of China, Russia and several Middle Eastern countries.

- (c) The Complainant's sales of products, including those products bearing the AMERICAN EAGLE Marks, reached approximately US\$ 7 billion during the years 2004-2006. During the period 2006-2012, these sales were approximately US\$ 15.2 billion. The Complainant has spent enormous amounts of money on advertising reached nearly USD\$ 550 million. In the year 2004 alone, the complainant spent more than US\$ 43.2 million in advertising its products and services around the world. In 2005 and 2006, these figures were approximately US\$ 53.3 million and US\$64.4 million, respectively. During the years 2007-2012, the Complainant's advertising dollars have shown a significant increase from US \$ 74.9 million to US \$ 90 million.
- (d) The Complainant has had, and continues to have, significant commercial ties with India. Since the year 1995 the Complainant has engaged Indian Manufacturers to manufacture clothing and fashion accessories such as clothing, jewelry and shoes in India. Today the Complainant engages numerous manufacturers located in Bangalore, Chennai, Delhi and the National Capital Region, and Mumbai. Since manufacture first began in India, the total dollar value of products manufactured has exceeded several billion dollars. For many years, the Complainant has used the Internet as a significant business medium. In fact, the Complainant's primary web site located at www.ae.com (on which the AMERICAN EAGLE Marks are featured prominently) has received wide acclaim as an advertising and sales tool. In 2012, Internet Retailer, considered the world's leading authority on Internet retailing, ranked the Complainant among the top 100 Internet retailers in the united States. During the year 2012 and 2013, the Complainant was listed at numbers 5 and 2, respectively, in the L2 Digital IQ Index: Specialty Retail. This index ranks the digital IQ of prestige specialty retail brands on the basis of site and e-commerce strength, digital marketing.
- (e) The Complainant has registered the AMERICAN EAGLE Marks in numerous countries/jurisdictions around the world, including the United States, the European Union (of which the Netherlands is a member state), Australia and Singapore. Copies of a representative sampling of certificates of Registration and/or printouts from the websites of the respective. Insofar as the registration position in India is concerned, the Complainant is the owner of valid and subsisting registrations for AMERICAN EAGLE Marks. These registrations include, but are not limited to registration No. 905098 for the mark AMERICAN EAGLE OUTFITTERS dated 22 February, 2000 and Registration No. 1648222 for the mark AMERICAN EAGLE (label) dated 30 January, 2008.
- (f) The Registrant or Respondent in this case who is from Netherlands and registered the disputed domain name on 27 April, 2013. On 1 October, 2013, the Complainant's legal department received an email from a GMAIL account

that the disputed domain name, AMERICANEAGLE>IN, is for sale. The email touted the advantages of registering the domain name. The Complainant notes that the registrant is a habitual cyber-squatter who has registered numerous domain names that incorporate third-party marks. These domain names include, but are not limited to, J-SAINBURY.NET, HHONORS.INFO, MACYS.INFO, ANHEUSER.NET, and CVSCAREMARK.NET. These domain names incorporate third-party marks, some of which are known for all over the world. The Complainant found that the Registrant has been the respondent in prior UDRP proceedings at the WIPO. In each of these proceedings the WIPO ordered the transfer of domain names to the Complainants.

- (g) Lastly the complainant filed this complaint for Arbitration proceeding and the Arbitrator submitted his statement of acceptance and declaration of Impartiality and the Independence and the complaint was produced before the Arbitrator on October 17th, 2013 and the Arbitrator sent a notice, to the Respondent through his email for the Arbitration Proceeding on October 24th, 2013, to submit his reply but nothing was submitted to Arbitrator till the date of award hence the AWARD is being declared on the December 18th, 2013 as Ex-parte.

5. Parties Contentions:

- (a) Complainant contends 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; and
 - (iii) The Registrant's domain name has been registered or is being used in bad faith, and the domain name be transferred to the Complainant.

- (b) Respondent contends that

The respondent gave no response.

6. Discussion & Findings:

- A. The Complainant has demonstrated statutory and common law rights in the AMERICAN LEGAL Marks. The Complainant owns registrations for the AMERICAN EAGLE Marks in various countries and jurisdictions around the world, including in India. Furthermore, the Complainant has used the AMERICAN EAGLE Marks extensively and continuously since 1977 and

continues to do so. The disputed domain name AMERICANEAGLE>IN consists of the Complainant's AMERICAN EAGLE mark and the country code IN. .IN is non-distinctive and an essential part of every domain name pertaining to India. Permira IP Limited v. Paperboy & Co., INDRP/092 (April 24, 2009). The disputed domain name is identical to the Complainant's AMERICAN EAGLE mark. First, the domain name incorporates the Complainant's AMERICAN EAGLE mark in its entirety. Second, .IN, the non-distinctive element of the domain name, does nothing to distinguish the domain name from AMERICAN EAGLE Mark. In Walmart stores, Inc. v. AmbraBerthiaume, INDRP/491 (June 11, 2013) the arbitrator held that the domain name WALMART.IN is identical to the WALMART Mark under the Policy because the domain name incorporates the WALMART mark in its entirety.

- B. The Registrant cannot have any right or legitimate interest in the disputed domain name because the disputed domain name incorporates the AMERICAN EAGLE mark, a mark in which the Complainant has sole and exclusive prior rights and that has become known owing to the Complainant's effort.
- (i) Registrant is a cyber squatter and has contacted the Complainant with an offer to sell the disputed domain name; there is no question that the Registrant registered the domain name for the purpose of exploiting the domain for commercial gain. This is clear evidence of the Registrant's lack of rights and legitimate interest in the domain name. Georgia Armani S.P.A., Milan, Swiss Branch, Mendisio v. Xu Tao, INDRP/351 (June 10, 2012).
- (ii) As discussed above, the disputed domain name resolves to third-party web sites that feature businesses not related to the Registrant in any way. Each time the domain name is accessed, the user is redirected to a different website. The Registrant's selection of a domain name that incorporates the Complainant's AMERICAN EAGLE mark in its entirety and use of the domain name to redirect consumers to other sites is not bona fide use and does not confer any rights or legitimate interests on the Registrant. BASF SE v. Gao Gou/Yerect International Limited, INDRP/520 (August 16, 2013).
- C. It is clearly more than a coincidence that the Registrant chose and registered a domain name that is confusingly similar to the Complainant's AMERICAN EAGLE Marks. The Complainant has a long and well established reputation in the AMERICAN EAGLE Marks through its exclusive use through out the world, including in India. There can be no doubt that the Registrant was aware of the AMERICAN EAGLE Marks when he chose and registered the disputed domain name, and in fact chose the domain name because it was confusingly similar to the Complainant's AMERICAN EAGLE Marks and intended to capitalize on that confusion. This constitutes evidence of bad faith. Kenneth Cole Productions Inc. v. Viswasinfomedia. INDRP/93.

- (i) Furthermore, the conduct of the Registrant speaks to the Registrant's bad faith. As described above, the Registrant registered the domain name in April 2013. Less than six months later, the Registrant contacted the Complainant's legal department in an attempt to sell the domain name. Clearly, the Registrant registered the domain name for the sole purpose of selling the domain name to the Complainant for a consideration. This is clear evidence of bad faith under the Policy.
- (ii) Lastly, the Registrant has registered the domain name in bad faith because it has provided false contact information to the domain name registrar. As discussed above, the WHOIS information indicates that the Registrant is based in the Netherlands but the phone number is a Greenland number. Clearly, the Registrant is trying to conceal its identity by supplying false contact information. This is evidence of bad faith. Chung, Mong Koo and Hyundai Motor Company v. Individual, WIPO Case No. D2005-1068 (December 21, 2005).
- D. The Complainant thus has satisfied the Arbitrator on all the parameters as mentioned in the Paragraph 4 of the Policy (INDRP).

7. Decision:

Hence the Arbitrator decides the Disputed Domain Name www.americaneagle.in is identical or confusingly similar to registered trademark of the Complainant and Respondent has no right to use the disputed domain name and the Respondent domain name has been registered in bad faith.

The Arbitrator further decides and orders that the domain name www.americaneagle.in shall be transferred to the Complainant with immediate effect.


Dr. BODHISATVA ACHARYA
SOLE ARBITRATOR
NIXI

DATED: December 18th, 2013,
PLACE: NEW DELHI,
INDIA