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R. Ragupathi

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Sridharan

BEFORE S SRIDHARAN, SOLE ARBITRATOR
OF NATIONAL INTERNET EXCHANGE OF INDIA

STAMP VENDOR, L/No. C3/4839/83
No. 37, VILLAGE ROAD, NOW KNOWN AS
VALLUVARKOTTAM HIGH ROAD
NUNGAMBAKKAM, CHENNAI-600 034
PHONE: 9445114347

ARBITRATION AWARD

DATED: 26th June 2016

Axalta Coating Systems, USA &
Coatings Foreign IP Co LLC, USA

Versus

Complainants

M. Om Narayan, Bangalore

Respondent

Sridharan

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Mr. Om Narayan, Bangalore

Respondent

1. The Parties

- 1.1 First Complainant, Axalta Coating Systems, is an entity organized and existing under the laws of USA, having its registered office at Suite 3600, 2001 Market Street, Philadelphia, PA 19103, USA. The First Complainant has also office in India at 16th Floor, A-1601, Lotus Corporate Park, Gram Path, Jay Coach Junction, off. Western Express Highway, Jogeshwari East Mumbai, Maharashtra - 400 063.
- 1.2 The Second Complainant, Coatings Foreign IP Co, LLC is an entity organized and existing under the laws of USA, having its registered office at C/o The Corporation Trust Company, Corporation Trust Center, 1209 Orange Street, Wilmington, Delaware 1980, USA. Second Complainant owns First Complainant's Intellectual Property in India and other countries outside of the United States.
- 1.3 The Complainant 1 and Complainant 2 are represented by their counsel, Ms Archana Sahadeva of Singh & Singh Lall & Sethi at D - 17, South Extension Part II, New Delhi - 110 049.
- 1.4 Respondent is Mr. Om Narayan at Ittina Mahavir, Bangalore- 560035, Karnataka, India.

The Domain Name and Registrar

- 1.5 The disputed domain name <axaltacoatingsystems.in> created on 01.02.2013 is registered with the registrar, GoDaddy.com, LLC (R101-AFIN).

2. Procedural History

- 2.1 On 10th June 2016, NIXI asked me about my availability and consent to take up the Complaint for arbitration.
- 2.2 On 11th June 2016, I informed my availability and consent. I also informed NIXI that I had no conflict of interest with either of the parties and could act independently and impartially. I sent signed declaration of independency and impartiality to NIXI.
- 2.3 On 17th June 2016, NIXI by email informed the parties about the appointment of me as the arbitrator in the above dispute. In the same email, NIXI has also provided the contact details of the arbitrator.
- 2.4 On 23rd May 2016, I received hard copy of the Complaint from NIXI. On the same day, I issued by email a Notice to the Respondent setting forth the relief claimed in the Complaint and directing him to file his reply to the Complaint within 15 days. I also sent an email about my appointment to arbitrate the complaint to the Complainant and asked the Complainant to send a soft copy of the complaint to me.



- 2.5 On 24th May 2016, I received soft copy of the Complaint from the Complainants.
- 2.6 On 30th May 2016, I received a mail from the Respondent stating that he was willing to close this matter by establishing direct contact with the representatives of the Complainant and sought two weeks' time. On the same day, I granted 10 days' time to the Respondent.
- 2.7 On 30th June 2016, the Complainants informed me by mail that they were awaiting settlement terms from the Respondent.
- 2.9 On 8th June 2016, the Complainants by email informed me that both the parties attempted to amicably settle the matter, however no settlement could be arrived between the parties. There was no scope for any settlement, in view of malafide and bad faith of the Respondent. The Complainants requested me to decide the matter on merits.
- 2.11 I have not received any update or response on merits from the Respondent till date of award.
- 2.12 Email is the medium of communication of this arbitration and each email is copied to all, Complainant, Respondent and NIXI.
- 2.13 I have returned to NIXI by courier all pleadings / documents that I received from it. I have not received any pleadings / documents by courier/post from the Parties.

3. Factual Background

A Complainant

- 3.1 Complainant no. 1 is a leading global coatings company dedicated to the development, manufacture and sale of liquid and powder coatings. Axalta (through its predecessor), in 2016 celebrates 150 years in the paint and coatings industry, as the original producer of Axalta's well-known STANDOX paints founded in 1866. The said Complainant's products increase durability, enhance productivity and add beauty. A range of performance and transportation coatings for manufacturers of light and commercial vehicles, the refinish aftermarket and for many industrial applications is also provided. Innovative products and services include paint and coatings, color matching tools, application technologies and customer training, support and business management systems.
- 3.2 Axalta Coating Systems became an independent company, with a new name and identity, on February 01, 2013. As on date, the Complainant is currently doing business in more than 130 countries with over 100,000 customers and 4000 distributors. The Complainant employs more than 12,000 people at its 36 manufacturing centers, 30 country technology laboratories and 47 customer training centers worldwide. It is pertinent to note that in the year 2015 alone, the net sales of the Complainants were to the tune of \$4.1 Billion. The Complainant attached Original internet printouts from the Complainants' website.
- 3.3 AXALTA COATING SYSTEMS / AXALTA is the corporate name/ trade name of the Complainants as well their registered trademark which has been continuously and uninterruptedly used across several countries.
- 3.4 Complainants own the trademarks AXALTA COATING SYSTEMS / AXALTA / A AXALTA (collectively referred to as the 'AXALTA Marks') in India as well as in many other jurisdictions. In India, the Complainants have trade mark registrations / pending applications for the AXALTA Marks in Classes 2, 35, 37, 41 and 42. The particulars of the trade mark registered in favour of the Complainants in India are summarized herein under:

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Trade Mark	Registration Number	Date	Class	Goods
Axalta (Word Mark)	2465345	23.01.2013	2	House mark for full line of Base Coats, Colorants, Coatings, Enamels, Finishes, Lacquers, Paints, Powders and Primers used in the Automotive, Aviation, constructions, Equipment, Marine, Rail, Tool and Trailer Industries.

The Complainant attached copy of the trade mark registration obtained for the AXALTA Mark in India.

- 3.5 Apart from the aforesaid, trade mark applications, in classes 35, 37, 41 and 42, seeking registration of trade mark AXALTA COATING SYSTEMS in favour of the Complainants are also pending before the Trade Marks Registry.
- 3.6 By virtue of these registrations and by virtue of the provisions of Trade Marks Act, 1999, Complainants have the exclusive right to use the aforesaid trademarks inter-alia in respect of the goods and / or services for which the said trademarks are registered. Additionally, by virtue of the registrations and by virtue of the provisions of Section 31 of The Trade Marks Act, 1999, the above mentioned original registration(s) are prima facie evidence of their validity. Further, owing to the prior, continuous and uninterrupted use of the AXALTA Marks, Complainants claims Common Law Rights in the said trademarks as well. Needless to add, the trade mark AXALTA COATING SYSTEMS, apart from being the Complainants' trade mark, features prominently as the trade name / corporate name.
- 3.7 In addition to the aforesaid, Complainants also claim Statutory Rights in the AXALTA Marks in the United States, Canada, European Union, Turkey, Australia, China, Japan, Russia, Brazil, and many others jurisdictions. Complaints attached copies of the trade mark registrations obtained for the AXALTA Marks in various jurisdictions.
- 3.8 Complainants also have to their credit, domain name registrations for various domain names that include the AXALTA Marks. The following is an illustrative list of such domain name registrations:
- www.axaltaacs.com
 - www.axaltacoatingsystems.com
 - www.axalta.in
 - www.axalta-coating-systems.in
 - www.axaltaacs.in
 - www.axalta-cs.in
- Complainants attached copy of the detailed list of the domain names registered in their favour featuring the AXALTA Marks.
- 3.9 Considering the extensive use and registrations of the AXALTA Marks and domain names throughout the world, including in India, the public at large associates the AXALTA Marks with the Complainants alone. Complainants attached copies of print coverage in various magazines throughout the country, featuring the Complainants' AXALTA Marks.
- 3.10 The Complainants have, over the past three years, invested huge time and resources to ensure that the AXALTA Marks are associated solely with them and by virtue of the same the AXALTA Marks have attained the status of being well known marks. The following table evinces the expenditure incurred by the Complainants over the past three years in order to promote the AXALTA Marks in India:

Year	Expenditure Incurred (in USD)
2013	Approx. \$7,000
2014	Approx. \$11,000
2015	Approx. \$6,000

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- 3.11 Further, the net sales of the Complainants in respect to the products sold / services offered under the AXALTA Marks in India, for the past three years illustratively, are as under:

Year	Net Sales (in USD)
2013	Approx. \$26,000,000
2014	Approx. \$41,000,000
2015	Approx. \$44,000,000

- 3.12 In the year 2015 alone, the global net sales of the Complainants was to the tune of \$4.1 Billion.
- 3.13 That by virtue of regular, continuous and extensive use of the AXALTA Marks by the Complainants, efforts taken by the Complainants in popularizing its brand/ mark and services, and by reason of superior quality and efficacy of the services provided by the Complainants, the AXALTA Marks enjoy an extremely high level of goodwill and reputation across the globe. Consequently, the AXALTA Marks have become distinctive of the Complainants and the services offered by them.
- 3.14 The Complainants also enjoy Common Law Rights in the AXALTA Marks. Therefore, the Complainants' AXALTA Marks are well known marks and have tremendous trans-border reputation and goodwill in India and is known to a substantial segment of society in India.
- 3.15 On August 31, 2015 the Complainants received an e-mail sent by Respondent, with the email id vasuaxalta@gmail.com, wherein the Respondent offered to sell the impugned domain name viz. axaltacoatingsystems.in which has been registered by the Respondent which contains Complainants' trademarks AXALTA COATING SYSTEMS and AXALTA in toto. The Complainant attached the said e-mail dated August 31, 2015.
- 3.16 In the said letter the Respondent proposes to the Complainants to consider buying the domain name for the sake of Complainants' organization, while also attempting to threaten that the Respondent is on his way to commence related services as that of the Complainants and put in use the impugned domain name as registered by him. The fact that the Respondent was fully aware of the superior rights of the Complainants in the mark/domain name is evident from his statement in the letter that the domain name would be more useful to the Complainants 'considering the brand related awareness which has been created so far with the launch and future perspective'. Therefore, it may be safely inferred that the Respondent had sufficient knowledge that the mark was not only the corporate name but also extensively used and highly reputed by the Complainants.
- 3.17 A similar message was also posted by the said Respondent on Complainants' Facebook on September 09, 2015.
- 3.18 The impugned domain name axaltacoatingsystems.in is registered in favour of Respondent. Upon visiting the impugned domain name, it becomes amply clear that the same has been registered by the Respondent with ulterior motives and being fully aware of the rights of the Complainants in the AXALTA Marks and further with an intent to capitalize on the same.
<http://www.axaltacoatingsystems.in>:
- Complainants have given a screen shot of the web page that opens when the impugned domain name is accessed is extracted.
 - A bare perusal of the screen shot amply demonstrates that the said web page contains misleading information.
 - The web page displays the Complainants' trade mark AXALTA COATING prominently. Further, the information provided on the web page viz. 'Lets color your dream. Axalta Coating is the easiest way to get your home or office expertly painted' is blatantly misleading and to any unsuspecting consumer, would appear to be that of the Complainants, since the same is directed at consumers in the paints/coatings industry

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- (d) The mala fides of the Respondent are further exemplified from the fact that the said Respondent is well aware of the services being offered by the Complainants and in fact it was with such an intention that the Respondent solicited the Complainants, offering to sell the impugned domain name to the Complainants.
- 3.19 Further on a bare perusal of the impugned domain name, confusion is inevitable as to the source of origin of the website. The trade mark AXALTA COATING SYSTEMS and/or AXALTA is being used without authorization and with the intent to confuse consumers. Complainants attached original Internet printouts from the corresponding webpages of the impugned domain name.
- 3.20 Complainants had issued a Cease and Desist Notice dated November 03, 2015 calling upon the Respondent to cease and desist from using the impugned domain name as the right over the AXALTA Marks vests with the Complainants. The same was sent via e-mail as well as registered post. Complainants attached copy of the Cease and Desist Notice dated November 03, 2015.
- 3.21 The Cease and Desist Notice was resent again via registered post to the Respondent and was returned un-served owing to the address being incomplete. While in the meantime efforts were taken to identify the correct address, it is pertinent to mention that Complainants did not receive any response from the Respondent to the e-mail sent. That in complete disregard to the Legal Notice, Respondents continues to misuse the dishonestly registered domain name.
- 3.22 While Complainants, through their agents attempted to call the Respondent, it was only after several attempts they were able to establish contact with the Respondent. However, to the Complainant's dismay Respondent refused to provide any details in the said call.
- 3.23 Subsequently, Counsel for the Complainants, in an earnest attempt to resolve the disputes, tried and explained the rights of the Complainants to the Respondent, while also informing about the Cease and Desist Notice. While the Respondent admitted to having received the Cease & Desist Notice by email, to the surprise of the Complainants, maintained his stand that he is the registered owner of the domain name and the idea was to connect to the Complainants on the issue.
- 3.24 The Respondent, in January, 2016, contacted the Counsel for the Complainants with his proposal and demanded USD 3 Million for the transfer of the disputed domain name <axaltacoatingsystems.in> in favour of the Complainants.
- 3.25 And now, despite receiving the Notice letter from Complainants, and being fully aware of Complainants' prior rights in the AXALTA Marks, the Respondent has commenced using the axaltacoatingsystems.in domain name for a blatantly misleading web page in connection with paints/coatings products and services. Respondent is, beyond a doubt, intentionally and methodically attempting to confuse and deceive consumers at the expense of the Complainants.
- 3.26 In light of the aforesaid, it is submitted that the adoption of the mark AXALTA COATING SYSTEMS and/or AXALTA by the Respondent for the impugned domain name is dishonest and has been done with *mala fide* intentions solely to unfairly enrich from the hard earned reputation and goodwill associated with the Complainants' marks. In respect of the said violation, the present Complaint is being filed for transfer of the domain name <axaltacoatingsystems.in> in its favour.

B Respondent

- 3.27 Though the Complainant sought time to engage the Complainant to amicably settle the dispute, he has neither shown any interest in settling the dispute nor has come up with any response on merits.

4. Parties Contentions

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A Complainant

- 4.1 The disputed domain name in issue <axaltacoatingsystems.in>
- (a) Wholly incorporates the Complainants' trade name / corporate name **AXALTA COATING SYSTEMS and/or AXALTA** and;
 - (b) Is identical to the Complainants' registered AXALTA Marks.
 - (c) The impugned domain name is identical to the trade mark/trading style of the Complainants, thereby making confusion and deception inevitable.
 - (d) The impugned domain name is identical to the various registered domain names registered in favour of the Complainants and as such the chances of confusion are enhanced.
- 4.2 The impugned domain name, as registered by the Respondent, is identical and confusingly similar to the AXALTA Marks of the Complainants. An Internet user who wishes to visit the Complainants' site for information regarding the Complainants' services, but not being completely familiar with the exact web address of the Complainants' site, might be taken to the website of the Respondent instead, which barely contains any information or has misleading information.
- 4.3 Further, any Internet user who carries out a WHOIS search for <axaltacoatingsystems.in> will find that the said domain name stands registered in the name of the Respondent and this would further result in considerable confusion in the mind of such user that the Respondent is in some way connected to or affiliated with the Complainants or that the Respondent is being endorsed/promoted by the Complainants, which clearly is not the case.
- 4.4 Domain names and URLs form part and parcel of the 'online' identity of an entity and serve the function of its trade/service mark upon the Internet. In view of this, the act of the Respondent in registering the impugned domain name, which is identical to that of the Complainants' domain names and URLs, severely impinges upon the Statutory and Common Law Rights of the Complainants and is, thus, in contravention of the Intellectual Property Rights vesting in the Complainants in respect of its AXALTA marks.
- 4.5 It is pertinent to note that the Complainants' domain name, located at the URL www.axaltaacs.com functions as a trade mark in the Internet world, as the Complainants provide exhaustive information, advertisements of its services through the said website. No entity other than the Complainants, therefore, has any right or justification to use the words 'AXALTA COATING SYSTEMS and/or AXALTA' or a deceptively similar mark, either on the internet or in a regular book and mortar store.
- 4.6 The Respondent cannot demonstrate any legitimate interest in the impugned domain name. The Respondent registered the impugned domain name after the Complainants have acquired and established rights in the trade marks/trade name AXALTA COATING SYSTEMS and/or AXALTA through prior use and registrations.
- 4.7 Furthermore, there exists no relationship between Complainants and Respondent that would give rise to any license, permission, or authorization by which Respondent could own or use the impugned domain name, which is identical to Complainants' AXALTA Marks.
- 4.8 In addition, the Respondent registered the impugned domain name at or around the time that the Respondents' business was spun-off from predecessor company DuPont and changed its name to AXALTA COATING SYSTEMS. This is not a coincidence; Respondent intentionally squatted on Complainants' trade name and marks to extract unlawful financial gain from Complainants. This was confirmed by Respondent's bad faith offer to sell the impugned domain name to Complainants for millions of dollars, and now it's bad faith website content relating to the paint industry to pose as Complainants and deceive consumers. In addition, the Respondent registered the impugned domain

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name after the Respondents filed their Indian trade mark no. 2465345 for the AXALTA mark and no. 2465346 for the AXALTA COATING SYSTEMS mark.

- 4.9 Further, the mala fide intention of the Respondent is amply demonstrated in its attempt to offer to sell the impugned domain name to the Complainants for commercial gain, knowing fully well of the Statutory and Common Law rights of the Complainants in the AXALTA Marks. The Respondent has no legitimate justification for having registered the impugned domain name incorporating the word AXALTA COATING SYSTEMS and/or AXALTA.
- 4.10 The Complainants issued a Legal Notice dated November 03, 2015 calling upon the Respondent to cease and desist from using the name AXALTA COATING SYSTEMS and/or AXALTA or any variation thereof as the right over the said trade mark vests with the Complainants, however no response has been served by the Respondent till date and on the contrary earnest attempts of the Complainants to settle the issue was reverted with unreasonable and arbitrary demands. Since the matter could not be resolved amicably between the parties, the Complainants are left with no choice but to approach this Hon'ble Forum seeking transfer of the impugned domain name.
- 4.11 The activities of Respondent rise to the level of a bad faith usurpation of the recognition and fame of Complainants' trade marks in violation of applicable trademarks and unfair competition laws.
- 4.12 Moreover, these activities demonstrate bad faith registration and use of the impugned domain name in violation of the Policy under Paragraph 6 which promulgates that bad faith can be found where there is evidence of circumstances indicating that Respondent has registered or Respondent has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainants who is the owner of the trade mark or to a competitor of the Complainants, for valuable consideration in excess of Respondent's documented out-of-pocket costs directly related to the domain name; or Respondent has registered the domain name in order to prevent the owner of the trade mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or by using (if any, though denied) the domain name, by creating a likelihood of confusion with the Complainants' name or mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Registrant's website or location.
- 4.13 The registration of the impugned domain name www.axaltacoatingsystems.in and thereafter offering to sell the same to the Complainants herein is clearly in bad faith and *mala fide* intent. Bad faith registration is evident from the fact that the Respondent could have no justification for seeking registration of a domain name of which the word AXALTA COATING SYSTEMS and/or AXALTA is a part. The domain name www.axaltacoatingsystems.in, registered in the name of the Respondent is an instrument of fraud and deception, which is causing considerable damage to the Complainants' business interests, apart from prejudicing substantial public interest. The fact that the Respondent solicited the Complainants and attempted to sell the impugned domain name to the Complainants amplifies the bad faith conduct in the instant case. And now the content on the impugned website shows a clear attempt to deceive Respondents' customers by posing as a paint industry website.
- 4.14 The Complainants submit that the unlawful registration of the impugned domain name by the Respondent is resulting in the dilution of the Complainants' trade mark/trading style AXALTA COATING SYSTEMS and/or AXALTA. The illegal registration of the said domain name is causing irreparable damage and injury to the Complainants' reputation and goodwill, which is unascertainable due to the intangible nature of the goodwill.
- 4.15 The Complainants have amply demonstrated that the Respondent has registered / acquired the impugned domain name primarily for the purpose of selling the impugned domain name to the Complainants, who are the registered proprietors and owners of the AXALTA Marks as well as the prior users of the same.

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- 4.16 Further, by registering the impugned domain name, the Respondent is intentionally attempting to attract the internet users to the impugned domain name and is creating confusion with the Complainants' trademarks as to the source, sponsorship, affiliation, or endorsement in relation to the impugned domain name.
- 4.17 Based upon all of the forgoing considerations, it is evident that the Complainants have met the requirements of the Policy, by demonstrating not only its own legitimate interest in its trademarks being part of the trade name/ corporate name and domain name as evidenced by its use of such marks and the fame associated therewith, but also that Respondent's sole interest in the impugned domain name is to unlawfully profit from it. Accordingly, the Complainants believe that it is entitled to the remedy requested below.

B. Respondent

- 4.18 The Respondent has not filed reply.

5. Discussion and Findings

- 5.1 The Complainant in order to succeed in the Complaint must establish under Paragraph 4 of .IN Domain Name Dispute Resolution Policy (INDRP) the following elements:
- (I) Respondent's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;
 - (II) Respondent has no rights or legitimate interests in respect of the domain name; and
 - (III) Respondent's domain name has been registered or is being used in bad faith.
- 5.2 Each of the aforesaid three elements must be proved by a Complainant to warrant relief.

Disputed domain name is identical or confusingly similar to a trade mark of the Complainant.

- 5.3 The Complainants are the proprietors of the Axalta Marks (AXALTA COATING SYSTEMS / AXALTA / A AXALTA). Complainants have been using Axalta Marks as trademarks continuously ever since its adoption in 2013. Complainant and its group companies own registrations in various countries including United States, Canada, European Union, Turkey, Australia, China, Japan, Russia, Brazil, and many others jurisdictions worldwide for Axalta Marks. In India, the registration of the Complainant under Application No. 2465345 dates back to 23.01.2013. The Complainants domain name www.axaltacoatingsystems.com was created on 24.01.2013. The disputed domain name axaltacoatingsystems.in was created on 01.02.2013. Obviously, the Complainant is the prior adopter of the Axalta Marks. The above facts have established that the Complainants have statutory and common law rights in respect of their Axalta Marks.
- 5.4 The Complainants' Axalta Marks are famous and well known throughout India. The Complainants have registration for Axalta and application for the mark AXALTA COATING SYSTEMS. The expression .in needs to be discarded while comparing the marks with the domain names. It is obvious that the disputed domain name wholly incorporates the prior trade mark Axalta Coating Systems of the Complainants. Further, the distinctive feature of the disputed domain name is Axalta. The expression "coating systems" is common and generic in nature and anybody dealing with coating systems may tend to use the expression "coating systems" in their domain name or trade mark. Therefore, it is obvious that the disputed domain name incorporates wholly the prior registered trade mark "Axalta" of the Complainants.

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5.5 I, therefore, find that:

- (a) The Complaints have common law and statutory rights in respect of their Axalta Marks.
- (b) The disputed domain name axaltacoatingsystems.in is similar to the Complainants' prior Axalta Marks, and the domain name www.axaltacoatingsystems.com.

Respondent has no rights or legitimate interests in respect of the disputed domain name

5.6 It is already seen that:

- (a) The Complainants are the prior adopter and user of the Axalta Marks. The Complainants' Axalta marks are well known in many countries across the globe including India.
- (b) The Complainants Axalta Mark was adopted in 2013. The Indian registration for the mark Axalta was obtained on 23.01.2013. The Complainants domain name www.axaltacoatingsystems.com was created on 24.01.2013. The disputed domain name axaltacoatingsystems.in was created on 01.02.2013.

5.7 Respondent did not register the disputed domain name until 01.02.2013. Complainants have adopted and used the Axalta Marks before Respondent registered the disputed domain name axaltacoatingsystems.in. It is unlikely that the Respondent was unaware of existence of Complainant's trademark rights and domain name rights before registering the disputed domain name axaltacoatingsystems.in.

5.8 I visited the web site of the Respondent under the disputed domain name axaltacoatingsystems.in on 26th June 2016. It led me to a static web site "Axalta Home Coating." The web site talks about home coating but its links are not working. I understand the Respondent is not currently making any fair use of the disputed domain name axaltacoatingsystems.in.

5.9 In the absence of any response from the Respondent, I agree with the contentions of the Complainants as below:

- a) Any Internet user who carries out a WHOIS search for disputed domain name axaltacoatingsystems.in will find that the said domain name stands registered in the name of the Respondent and this would further result in considerable confusion in the mind of such user that the Respondent is in some way connected to or affiliated with the Complainants or that the Respondent is being endorsed/promoted by the Complainants, which clearly is not the case.
- b) The Complainants' domain name, located at the URL www.axaltacs.com functions as a trade mark in the Internet world, as the Complainants provide exhaustive information, advertisements of its services through the said website. No entity other than the Complainants, therefore, has any right or justification to use the words 'AXALTA COATING SYSTEMS and/or AXALTA' or a deceptively similar mark, either on the internet or in a regular book and mortar store.
- c) There exists no relationship between Complainants and Respondent that would give rise to any license, permission, or authorization by which Respondent could own or use the impugned domain name.
- d) The Respondent registered the impugned domain name at or around the time that the Respondents' business was spun-off from predecessor company DuPont and changed its name to AXALTA COATING SYSTEMS. This is not a coincidence. Respondent intentionally squatted on Complainants' trade name and marks to extract unlawful financial gain from Complainants. This was confirmed by Respondent's bad faith offer to sell the impugned domain name to Complainants for millions of dollars, and now it's bad faith website content relating to the paint industry to pose as Complainants and deceive consumers.

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- e) The mala fide intention of the Respondent is amply demonstrated in its attempt to offer to sell the impugned domain name to the Complainants for commercial gain, knowing fully well of the Statutory and Common Law rights of the Complainants in the AXALTA Marks. The Respondent has no legitimate justification for having registered the impugned domain name incorporating the word AXALTA COATING SYSTEMS and/or AXALTA.
 - f) The Complainants issued a Legal Notice dated November 03, 2015 calling upon the Respondent to cease and desist from using the name AXALTA COATING SYSTEMS and/or AXALTA or any variation thereof as the right over the said trade mark vests with the Complainants, however no response has been served by the Respondent till date and on the contrary earnest attempts of the Complainants to settle the issue was reverted with unreasonable and arbitrary demands. Since the matter could not be resolved amicably between the parties, the Complainants are left with no choice but to approach this Hon'ble Forum seeking transfer of the impugned domain name.
- 5.10 Therefore, I have no hesitation to hold, for the above reason that the Respondent has no right or legitimate interest in respect of the disputed domain name <axaltacoatingsystems.in>.

Respondent's domain name has been registered or is being used in bad faith.

- 5.11 The Complainants are the proprietors of the Axalta Marks (AXALTA COATING SYSTEMS / AXALTA / A AXALTA). Complainants have been using Axalta Marks as trademarks continuously ever since its adoption in 2013. Complainant and its group companies own registrations in various countries including United States, Canada, European Union, Turkey, Australia, China, Japan, Russia, Brazil, and many others jurisdictions worldwide for Axalta Marks. In India, the registration of the Complainant under Application No. 2465345 dates back to 23.01.2013. The Complainants domain name www.axaltacoatingsystems.com was created on 24.01.2013. The disputed domain name <axaltacoatingsystems.in> was created on 01.02.2013. The Respondent could not have ignored, rather actually influenced by, the well-known Axalta Marks of the Complainant at the time he acquired the disputed domain name <axaltacoatingsystems.in>.
- 5.12 The Respondent has not filed any response. He has not come up with any response or justification for the adoption of the disputed domain name.
- 5.13 In the absence of any response from the Respondent, I agree with the contentions of the Complainants as below:
- (a) The activities of Respondent rise to the level of a bad faith usurpation of the recognition and fame of Complainants' trade marks in violation of applicable trademarks and unfair competition laws.
 - (b) Moreover, these activities demonstrate bad faith registration and use of the impugned domain name in violation of the Policy under Paragraph 6 which promulgates that bad faith can be found where there is evidence of circumstances indicating that Respondent has registered or Respondent has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainants who is the owner of the trade mark or to a competitor of the Complainants, for valuable consideration in excess of Respondent's documented out-of-pocket costs directly related to the domain name; or Respondent has registered the domain name in order to prevent the owner of the trade mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or by using (if any, though denied) the domain name, by creating a likelihood of confusion with the Complainants' name or mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Registrant's website or location.
 - (c) The registration of the impugned domain name <axaltacoatingsystems.in> and thereafter offering to sell the same to the Complainants herein is clearly in bad faith and mala fide intent. Bad faith registration is evident from the fact that the Respondent could have no justification for seeking

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registration of a domain name of which the word AXALTA COATING SYSTEMS and/or AXALTA is a part. The domain name <axaltacoatingsystems.in>, registered in the name of the Respondent is an instrument of fraud and deception, which is causing considerable damage to the Complainants' business interests, apart from prejudicing substantial public interest. The fact that the Respondent solicited the Complainants and attempted to sell the impugned domain name to the Complainants amplifies the bad faith conduct in the instant case. And now the content on the impugned website shows a clear attempt to deceive Respondents' customers by posing as a paint industry website.

- (d) The unlawful registration of the impugned domain name by the Respondent is resulting in the dilution of the Complainants' trade mark/trading style AXALTA COATING SYSTEMS and/or AXALTA. The illegal registration of the said domain name is causing irreparable damage and injury to the Complainants' reputation and goodwill, which is unascertainable due to the intangible nature of the goodwill.
 - (e) The Respondent has registered / acquired the impugned domain name primarily for the purpose of selling the impugned domain name to the Complainants, who are the registered proprietors and owners of the AXALTA Marks as well as the prior users of the same.
 - (f) Further, by registering the impugned domain name, the Respondent is intentionally attempting to attract the internet users to the impugned domain name and is creating confusion with the Complainants' trademarks as to the source, sponsorship, affiliation, or endorsement in relation to the impugned domain name.
- 5.14 Thus it is clearly established that Respondent registered the disputed domain name <axaltacoatingsystems.in> in bad faith.
- 5.15 The actions of the Respondent should not be encouraged and should not be allowed to continue. The Respondent has not even chosen to respond to the Complaint. His offer for discussion is misleading. It is without any truthful intent. The conduct of the Respondent has necessitated me to award costs of the Complaint to and in favour of the Complainant.

6. **Decision**

- 6.1 For all the foregoing reasons, the Complaint is allowed as below.
- 6.2 It is hereby ordered that the disputed domain name <axaltacoatingsystems.in> be transferred to the Complainant.
- 6.3 Respondent is ordered to pay the Complainant a sum of Rs.10,00,000/- (Rupees Ten Lakhs Only) towards costs of the proceedings. If the Respondent fails to pay, the Complainant may recover this amount by initiating execution proceedings in the Civil Court having jurisdiction over the Respondent in India.



S.Sridharan
Arbitrator