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

ARBITRATION AWARD

DATED: 11th October 2016

BearingPoint IP Holdings B.V.
The Netherlands

...
Versus

Complainant

GaoGou of YERECT
Canada

...

Respondent

1. The Parties

- 1.1 The Complainant, BearingPoint IP Holdings B.V., is a company organized and existing under the laws of the Netherlands, having its place of business at De Entree 89, 1101 BH Amsterdam Z.O, The Netherlands. The Complainant is represented by Ms Tia Malik and Karan Bajaj, advocates of Singh & Singh Lall & Sethi at D-17, South Extension – II, New Delhi – 110 049.
- 1.2 Respondent is GaoGou of the organization YERECT at Suite 1100 South Tower, 175 Bloor Street, East, Ontario M4W 3R8, Toronto, Canada.

The Domain Name and Registrar

- 1.3 The disputed domain name < www.bearingpoint.co.in > created on 09.07.2012 is registered with the registrar, Business Solutions (R54-AFIN).

2. Procedural History

- 2.1 On 19th September 2016, NIXI asked me about my availability and consent to take up the Complaint for arbitration. On the same day, 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.
- 2.2 On 22nd September 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.
- 2.3 On 24th September 2016, I received hard copy of the Complaint from NIXI.
- 2.4 On 25th September 2016, 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 I have not received any response on merits from the Respondent till date of award.
- 2.6 Email is the medium of communication of this arbitration and each email is copied to all, Complainant, Respondent and NIXI.
- 2.7 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 The Complainant is a multinational management and technology consulting firm operating in over 20 countries around world with headquarters in Europe. The Complainant's origin lies in the consulting services of KPMG since 1997 and after a demerger with KPMG in the year 2000 and an IPO in 2001, the company was renamed to BearingPoint Inc.
- 3.2 In October 2002, the Complainant, under the well-known trade mark/trade name/company name BEARINGPOINT became the world's largest management and technology consulting services Company.
- 3.3 The Complainant is the owner of the earlier well-known trade mark BEARINGPOINT since August 23, 2008 in India. The Complainant's Indian registrations for the mark BEARINGPOINT are as below:
- (a) Application No.1238001 dated September 18, 2003 in classes 35 & 42
- (b) Application No.1128181 dated August 23, 2002 in class 9
- 3.4 The Complainant's International Application No.2687021 dated 13th September 2013 in classes 9, 35 and 42 based on its registration in France is pending for registration.
- 3.5 In addition to the above, the Complainant has registrations for its well-known mark BEARINGPOINT in several countries around the world including but not limited to Australia, the United States of America, and the United Kingdom.
- 3.6 By virtue of the excellent quality of services provided by the Complainant under the earlier well-known trade mark/ trade name/ corporate name BEARINGPOINT, the said trademark/trade name has become an instant success in the international market. The said trade mark/ trade name/ corporate name have become synonymous with the services of the Complainant.
- 3.7 The Complainant's services under the earlier well-known trade mark/ brand name BEARINGPOINT have been used and advertised extensively and provided in various countries of the world including but not limited to Argentina, Brazil, Canada, Chile, Columbia, China, Indonesia, Japan, Korea, Malaysia, Taiwan, Austria, Belgium, Denmark, Finland, Switzerland, France, Germany, United States of America, etc. It is clear that through long established and widespread use in many countries of the world, the aforesaid trade mark/ trade name/ corporate name of the Complainant enjoys immense worldwide reputation.

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- 3.8 In addition to above the earlier well-known trade mark BEARINGPOINT also forms part of the Complainant's domain name BEARINGPOINT.COM. Therefore, BEARINGPOINT forms a significant and integral part of the Complainant's company/trading name/corporate name/ domain name. The consumers at large associate the trade mark/ trade name/ domain name BEARINGPOINT with the Complainant alone. In light of the foregoing, it is evident that the Complainant has strong rights in its trade mark/trade name/ corporate name BEARINGPOINT and domain name BEARINGPOINT.COM.
- 3.9 It is well-established that the original role of a domain name is to provide an address for computers on the internet. However, in the present day world, with an increase of commercial activity on the internet, a domain name is used as a business identifier as well as a brand name. In the case of an e-commerce business, the domain name is the only business identifier to the public and members of trade. In the commercial field, each domain name owner provides information/goods/services which become exclusively associated with such domain names. Thus, a domain name pertains to the provision of goods and services.
- 3.10 In an UDRP proceedings (claim no. FA1101001368692) between Dallas Project Holdings Limited (the predecessor of the Complainant) & Alexander Halim Putra for the domain name BEARINGPOINT.ASIA, the National Arbitration Forum vide decision dated March 09, 2011 acknowledged the rights of the Complainant in the trade mark BEARINGPOINT and ordered the said domain to be transferred to the Complainant.
- 3.11 In light of the foregoing, it is evident that only the Complainant has strong rights in its earlier well-known trade mark BEARINGPOINT and domain name BEARINGPOINT.COM, or any other domain name containing the earlier well-known trade mark BEARINGPOINT. The Complainant's earlier well-known trade mark merits protection from a third party's act of cyber piracy and/or cybersquatting including that of the Respondent.
- 3.12 The Complainant has filed Annexure A to K in support of its Complaint.

B Respondent

- 3.13 The Respondent has not filed any response to the complaint till date of this award.

4. Parties Contentions

A Complainant

- 4.1 The Disputed Domain Name is identical to the Complainant's trade mark and domain name. The Opponent's earlier well-known trade mark BEARINGPOINT is contained in its entirety in the Disputed Domain Name with the addition of only the top-level country code domain for India, .CO.IN.
- 4.2 At the time the Respondent registered the Disputed Domain Name, the Complainant had already been using its earlier well-known mark as a trademark/trade name and as part of its domain name and had firmly established rights in the said trade mark. Furthermore, at the time the Respondent registered the Disputed Domain Name, the Complainant's earlier trademark had acquired the status of a well-known mark. The Respondent cannot claim or show any rights to the Disputed Domain Name that are superior to Complainant's rights as

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evidenced by Complainant's prior and well-known use of the trade mark and registration thereof. Since the Complainant's mark is well-known and the Respondent has no rights in this mark, the only reason the Respondent could have wanted to register a domain name which so prominently features the Complainant's earlier well-known trade mark was with the intention to trade upon the fame of the Complainant's mark by using the Disputed Domain Name for substantial commercial gain, in violation of the Policy. Therefore, the Respondent does not also have any legitimate interest in the disputed domain name except to make unlawful monetary gains.

- 4.3 Therefore, the Respondent has no rights in the Disputed Domain Name which contains the Complainant's well-known and registered trade mark BEARINGPOINT.
- 4.4 The bad faith of the Respondent in registering the Disputed Domain Name can be established from the fact that the Respondent has registered the domain name BEARINGPOINT.CO.IN which is identical to the Complainant's trade mark/trade name/corporate name BEARINGPOINT and domain name BEARINGPOINT.COM inasmuch as the Complainant's well-known and registered trade mark BEARINGPOINT is contained in its entirety in the disputed domain name. Furthermore, the Complainant's well-known and registered trade mark BEARINGPOINT is contained in its entirety in the Disputed Domain Name. There can be no plausible justification for such illegal and unwarranted adoption except to make unlawful monetary gain. In any case, it is most humbly submitted that it is well settled principle of law that in cases of an illegal adoption of an identical mark and/or the prominent features of the mark, any justification thereafter is nothing more than an afterthought.
- 4.5 The bad faith on the part of the Respondent can also be noted from the fact that when approached by the Complainant for the illegal adoption of the Disputed Domain Name, an email was received from the Respondent informing the Complainant that domain name is up for sale by way of bidding.
- 4.6 Further, as is apparent from accessing the website bearing the Disputed Domain Name at www.bearingpoint.co.in respondent prominently advertises the sale of the Disputed Domain Name. Therefore, the Disputed Domain Name has been acquired only with the malafide intention and bad faith to make undue profit from the intellectual property of the Complainant. Therefore, such acts come under the purview of cyber squatting. Therefore, the Disputed Domain Name ought to be transferred to the Complainant on this ground alone.
- 4.7 Given the fame of the Complainant's marks as a trademark and domain name, it is not possible to conceive of a use by Respondent of the Disputed Domain Name that would not constitute an infringement of Complainant's rights in its Trade Marks. Mere registration by Respondent of the Disputed Domain Name is thus further evidence of Respondent's bad faith.
- 4.8 The bad faith use of the Disputed Domain Name is quite clear in this case, given the content on the Respondent's website and his intent to sell the Disputed Domain Name to the highest bidder.
- 4.9 The activities of Respondent rise to the level of a bad faith usurpation of the recognition and fame of Complainant's Mark to improperly benefit the Respondent financially, in

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violation of applicable trademark and unfair competition laws. Moreover, these activities demonstrate bad faith registration and use of the Disputed Domain Name in violation of the Policy under paragraph 6.

B Respondent

4.10 The Respondent has not filed any 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 Complainant is the proprietor of the BearingPoint Marks. Complainant has been using BearingPoint Marks continuously since 2002. Complainant owns registrations in various countries including India for BearingPoint Marks. In India, the registration of the Complainant under Application No.1128181 dates back to 23.08.2002. The Complainant's domain name www.bearingpoint.com was created on 18.12.2000. The disputed domain name <www.bearingpoint.co.in> was created on 09.07.2012. Obviously, the Complainant is the prior adopter of the BearingPoint Marks. The above facts have established that the Complainant has statutory and common law rights in respect of their BearingPoint Marks.

5.4 The Complainant's BearingPoint Marks are famous and well known in India. It is obvious that the disputed domain name <www.bearingpoint.co.in> wholly incorporates the prior trade mark BearingPoint of the Complainant. The expressions, ".co" and ".in" need to be discarded while comparing the marks with the domain names. Further, the disputed domain name <bearingpoint.co.in> is similar to the domain name www.bearingpoint.com of the Complainant.

5.5 I, therefore, find that:

- (a) The Complaint has common law and statutory rights in respect of their BearingPoint Marks.
- (b) The disputed domain name <bearingpoint.co.in> is similar to the Complainant's prior registered BearingPoint Marks, and the domain name www.bearingpoint.com.



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

5.6 It is already seen that:

- (a) The Complainant is the prior adopter and user of the BearingPoint Marks. The Complainant's BearingPoint marks are well known in many countries across the globe including India.
 - (b) The Complainant's BearingPoint Mark was adopted in 2002. The Indian registration for the mark BearingPoint was obtained on 23.08.2002. The Complainant's domain name www.bearingpoint.com was created on 18.12.2000. The disputed domain name bearingpoint.co.in was created on 09.07.2012.
- 5.7 Respondent did not register the disputed domain name until 09.07.2012. Complainant has adopted and used the BearingPoint Marks before Respondent registered the disputed domain name bearingpoint.co.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 bearingpoint.co.in.
- 5.8 I visited the web site of the Respondent under the disputed domain name bearingpoint.co.in on 11th October 2016 using Edge Browser. It resolved into a web page informing me that the domain name was for sale. A notice appearing prominently at the top read as below:

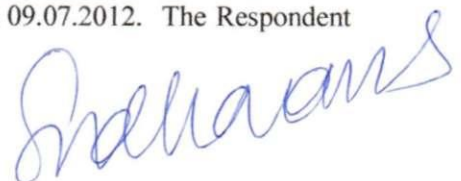
"The domain bearingpoint.co.in may be for sale. Click here to inquire about this domain."

In addition to the above sale offer, the web site has many links to various job portals. I understand that the Respondent has registered the disputed domain name solely for the purpose of selling it to others and not for any other purpose.

- 5.9 In the absence of any response from the Respondent, I agree with the contentions of the Complainant that Since the Complainant's mark is well-known and the Respondent has no rights in this mark, the only reason the Respondent could have wanted to register a domain name which so prominently features the Complainant's earlier well-known trade mark was with the intention to trade upon the fame of the Complainant's mark by using the Disputed Domain Name for substantial commercial gain, in violation of the Policy. Therefore, the Respondent does not have any legitimate interest in the disputed domain name except to make unlawful monetary gains.
- 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 bearingpoint.co.in.

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

- 5.11 The Complainant is the proprietor of the BearingPoint Marks. Complainant has been using BearingPoint Marks as trademarks continuously since 2002. Complainant owns registrations in various countries including India for BearingPoint Marks. In India, the registration of the Complainant under Application No.1128181 dates back to 23.08.2002. The Complainant's domain name www.bearingpoint.com was created on 18.12.2000. The disputed domain name bearingpoint.co.in was created on 09.07.2012. The Respondent



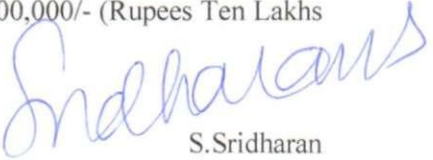
could not have ignored, rather actually influenced by, the well-known BearingPoint Marks of the Complainant at the time he acquired the disputed domain name <bearingpoint.co.in>.

- 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 Complainant as below:
- (a) The bad faith on the part of the Respondent can also be noted from the fact that when approached by the Complainant for the illegal adoption of the Disputed Domain Name, an email was received from the Respondent informing the Complainant that domain name is up for sale by way of bidding.
 - (b) As is apparent from accessing the website bearing the Disputed Domain Name <bearingpoint.co.in> respondent prominently advertises the sale of the Disputed Domain Name. Therefore, the Disputed Domain Name has been acquired only with the malafide intention and bad faith to make undue profit from the intellectual property of the Complainant. Therefore, such acts come under the purview of cybersquatting. Therefore, the Disputed Domain Name ought to be transferred to the Complainant on this ground alone.
 - (c) Given the fame of the Complainant's Marks as a trademark and domain name, it is not possible to conceive of a use by Respondent of the Disputed Domain Name that would not constitute an infringement of Complainant's rights in its Trade Marks.
 - (d) The activities of Respondent rise to the level of a bad faith usurpation of the recognition and fame of Complainant's Mark to improperly benefit the Respondent financially, in violation of applicable trademark and unfair competition laws. Moreover, these activities demonstrate bad faith registration and use of the Disputed Domain Name in violation of the Policy under paragraph 6.
- 5.14 Thus it is clearly established that Respondent registered the disputed the disputed domain name <bearingpoint.co.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 Complainant. 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 <bearingpoint.co.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.


S.Sridharan
Arbitrator