



सत्यमेव जयते

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Purchased by : RAJESH KUMAR
Description of Document : Article 12 Award
Property Description : Not Applicable
Consideration Price (Rs.) : 0
(Zero)
First Party : SAJAL KOSER
Second Party : Not Applicable
Stamp Duty Paid By : SAJAL KOSER
Stamp Duty Amount(Rs.) : 100
(One Hundred only)



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ARBITRATION AWARD

BEFORE SH. SAJAL KOSER, SOLE ARBITRATOR, CHANDIGARH

INDRP CASE NO. 1677 OF 2023

DISPUTED DOMAIN NAME: <WWW.CATERPILLARINDIA.NET.IN>

JD 0007004898

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Caterpillar Inc..

...Complainant

Versus

Laura Daecher, Street1: Knesebeckstrasse 55, Honerath, Postal Code 53518, DE. Phone: (49) 02691208036 Email: lou445teng@163.com

...Respondent

1. **INTRODUCTION:**

The present Complainant has been submitted by Complainant namely Caterpillar Inc. through its authorized representative for arbitration in accordance with INDRP Policy and Rules of Procedure, which is been entrusted to the undersigned. The Details of **Respondent** given in the Complaint is as under:-

- i) Registrant ID: EDT_99760195
- ii) Registrant Name: Laura Daecher
- iii) Registrant Street1: Knesebeckstrasse 55
- iv) Registrant City: Honerath
- v) Registrant Postal Code: 53518
- vi) Registrant Country: DE
- vii) Registrant Phone: (49) 02691208036
- viii) Registrant Email: lou445teng@163.com

3. **PROCEDURAL HISTORY:**

- I) Vide email dated 23.03.2023, the undersigned was appointed as an Arbitrator to adjudicate the above mentioned dispute. Vide email of the same date sent to all the concerned parties, the undersigned submitted statement of Acceptance and Declaration of Impartiality and Independence.

- II) As the undersigned received the complaint and all the documents as annexed with the complaint and being satisfied that the Respondent has also received the same, notice to the Respondent was issued on 28.03.2023 requiring the Respondent to file reply within 15 days as provided in INDRP Rules of Procedure.
- III) As within the stipulated period and thereafter also till 15.04.2023, since, the Respondent neither filed reply nor submitted any response to the complaint/notice, vide order dated 15.04.2023, the opportunity given to the Respondent to file reply/response to the Complaint was closed by order and the Complaint was fixed for passing award, ex-parte.

4. THE CASE OF THE COMPLAINANT:

- 4.1 As per the Complaint, the complainant is a technology leader and the world's leading manufacturer and licensor of a wide range of products and services. The trademarks CAT and Caterpillar have been used by the Complainant both worldwide and in India, in relation to its innumerable products including apparel, footwear, headwear and accessories thereof, gloves, bags, phones, leather and other material, sunglasses, sporting goods, outdoor wear earth moving equipment integrated tools, machine tools, agricultural tools and products, pumps, motors, carriers backhoe, wheel loaders, cold planer. Asphalt pavers, log loaders, electrical and electronic apparatus and instruments, engines, construction and road building equipment marine engines, track-type tractors, waste disposal arrangements, motor grades, excavators, mass excavators,

shovels, articulated trucks, wheel tractors, soil compactors, landfill, compactors, batteries, and related goods thereof etc.

- 4.2 It is further submitted by the Complainant that in relation to its products, services and business, the complainant is the proprietor of several well known marks, which inter alia including among others the marks, CAT, Caterpillar and Caterpillar.
- 4.3 According to the Complainant, starting out first in the year 1904 by its founders, the complainant adopted the trademark CATERPILLAR in the same year in relation to its heavy machinery and equipment and parts thereof. In support of above averments, the Complainant has annexed Annexure B with the complaint which are relevant extracts from the websites of the Complainant regarding the history of the Complainant company.
- 4.4 The Complainant further submits in the Complaint that the mark CATERPILLAR was first used in India in 1948 when caterpillar machinery was used in India for the construction of the Bhakra Nangal Dam in Punjab. A copy of a relevant extract from the website of the complainant evidencing its history and showing the first use of the mark CATERPILLAR in India is attached and marked as Annexure C with the Complaint.
- 4.5 According to the Complainant, over time, the level of familiarity with the mark CAT (word) and CAT logo, also referred as 'CAT' marks or 'CAT' made it possible to rely on it as a primary public-facing brand name. The Complainant's products, trade dress, dealer identity and web presence leverage the powerful CAT marks and almost exclusively associated with the Complainant brand CAT brand name representing the products

and services provided by the Complainant and its wholly owned subsidiaries. The mark CAT has been used by the Complainant as a trademark since as early as the year 1949. Today, the CAT marks are the Complainant's primary brand name, representing its equipment, related services and the incredible dealer network that supports customers all over the world including India. The Complainant has attached as Annexure D, the relevant extracts from the websites of the Complainant evidencing that the CAT marks are used across all the goods and services of the Complainant and are also affixed on all the goods manufactured by the Complainant.

4.6 The Complainant has further stated that it has manufacturing operations in several countries and manufactures more than 300 types of products under its CAT trademarks. Further, CATERPILLAR is the world's leading manufacturer of construction and mining equipment, diesel and natural gas engines, industrial gas turbines and diesel-electric locomotives. The complainant is also a leading services provider through CATERPILLAR Financial Services, CATERPILLAR Remanufacturing Services and Progress Rail Services. It is further stated in the Complaint that the Complainant provides more than 104,000 jobs worldwide and sells its products in over 190 countries through an extensive network of more than 155 dealers and 14000 retail outlets.

4.7 It is further case of the Complainant that the complainant's Caterpillar and CAT marks are registered in over 90 jurisdictions throughout the world including India. The Caterpillar and CAT marks were first registered in the United States of America in the Year 1912 and 1952, respectively.

Some of the jurisdictions where the Complainant's aforesaid marks stand registered include the USA. Albania, Algeria, African Intellectual Property, Argentina, Armenia and various other countries as mentioned in the Complaint. Further in particular the complainant has obtained registrations for its Caterpillar marked in several jurisdictions. In support thereof a list of such jurisdictions are attached with the complaint as Annexure E.

- 4.8 According to the Complainant, in India, the Complainant has numerous registrations for Caterpillar marks in various classes, with the oldest registration for the Caterpillar mark going back to 1943. A list of registrations along with some sample copies of registration and renewal certificates and Trade marks office online extracts have been attached with the Complaint as Annexure F.
- 4.9 It is also the case of the Complainant that the Complainant's trademark CATERPILLAR has been recognized as Well known in a decision of the Delhi High Court in Caterpillar Vs Mehtab Ahmed as reported in 2002 CTMR 345 and the copy of the decision is annexed as Annexure G with the complaint. Further, according to the Complainant, the India Trade Marks Registry has also notified the Complainant's CATERPILLAR mark as well known and in support of this Complainant has attached Annexure H as a list of marks notified as well known by the Trade Marks Registry. According to the Complainant, the mark CAT has been derived from the Complainant trademark trade name CATERPILLAR and the public at large even refers to the Complainant as CAT. The very fact that the Complainant is referred to by the term CAT, itself is a clear indicator of the well

known character of the mark CAT. The Complainant in the complaint has also submitted that the trademarks CAT and CATERPILLAR have also been recognized as well known in various pronouncements in different countries as mentioned in para 1.10 of the Complaint.

- 4.10 In addition to above, the Complainant has further submitted that it owns several domain name registrations including www.cat.com; www.caterpillar.com; www.catfootwear.com; www.shopcaterpillar.com etc. The said websites are interactive and information pertaining to the Complainant's goods and services under the trademark CATERPILLAR is available and displayed on several websites on the internet including the aforesaid websites and as the internet is well connected in India and thus comes as a ready source of exposure and knowledge to the public. Publicity of the Complainant's goods and services under the CAT marks through the medium of the internet has contributed considerably to enhancing the recognition and reputation of the CAT marks and the goods and services thereunder worldwide including India. In Addition to above, the Complainant submits that the CAT brand has achieved tremendous fame and notoriety worldwide as a result of the quality of products and services offered and marketing thereof. A table evidencing the worldwide runover under the CAT marks for the year 2005-2002 is mentioned in para 1.12 of the Complaint and a copy of the relevant pages from the complainant's annual report for the year 2021 is attached as Annexure I with the complaint. Further, in Para 1.13 of the Complaint, the Complainant has given details of various subsidiaries containing the name/ mark CATERPILLAR. In

addition to this, the complainant has also mentioned the names of the subsidiaries in India.

4.11 Now, so far as the Background of the present Complaint which gave a cause of action to the Complainant to file the present Complaint is that according to the Complainant, sometime in November 2022, the Complainant received complaints about this domain offering CATERPILLAR and CAT branded footwears for sale and advised that consumers were not receiving the products they had purchased relating to the impugned domain name WWW.CATERPILLARINDIA.NET.IN. Upon reviewing the impugned website, it revealed that Complainant was selling footwear bearing the marks caterpillar and Cat logo without authorization. Snapshots of the impugned domain's webpage have been annexed as Annexure J with the complaint. On further checking, it appeared that the impugned domain is registered in the name of Laura Daecher who is the Respondent and WHOIS particulars for the impugned domain name WWW.CATERPILLARINDIA.NET.IN are attached with the Complaint as Annexure K.

5. **GROUND:**

The Complainant has based its complaint on the following grounds:

- i) it is submitted that the impugned domain name **<WWW.CATERPILLARINDIA.NET.IN>** is identical to the name and trademark CATERPILLAR in which the Complainant has legitimate rights. Given the prior adoption, registrations, use and reputation of the Caterpillar name/mark as detailed hereinabove, the mark of CATERPILLAR is exclusively associated with the Complainant and no one else.

- ii) The Respondent has no legitimate rights to use the impugned domain **<WWW.CATERPILLARINDIA.NET.IN>** which is identical to the complainant's registered trademarks and sells complainant's products without authorization.
- iii) The registration of the impugned domain name **<WWW.CATERPILLARINDIA.NET.IN>** by the Respondent is evidently in bad faith and is actuated by a malafide intention to take undue advantage of the reputation and goodwill of the complainant in its well known caterpillar mark.

6. RELIEF SOUGHT:

On the basis of the averments made in the Complaint as well as documents annexed, the Complainant, in accordance with Paragraph 10 of the INDRP Policy, requested that the domain name **<WWW.CATERPILLARINDIA.NET.IN>** may kindly be transferred to the Complainant and also claimed further reliefs.

7. FINDINGS:

After going through un-rebutted and uncontroverted averments and submissions made in the Complaint as well as the documents annexed, the undersigned is of the view that the Complainant has absolute statutory rights over the trademark, "CATERPILLAR" as owner thereof. The said Mark is well recognized and well known in India and in various countries Abroad. It is also evident from the record that the Trademark "CATERPILLAR" forms part of Complainant's Company and its subsidiaries. As per the contents of the Complaint and documents annexed, the Complainant has been able to prove the ingredients of sub paras/sub clauses (a) to (c) of Clause 4 of the INDRP dispute Resolution Policy. From the contents

and grounds mentioned in the complaint, it has been proved on record that the Disputed Domain Name is identical to the Trademark in which the complainant has rights. It has also been proved that the Respondent Registrant has no rights or legitimate interest in respect of the Domain name and also that the Domain name has been registered by the Respondent and is being used in bad faith. The Complainant has been able to prove its case in terms of clause 4 of the INDRP Dispute Resolution Policy and it also falls within the ambit of Clause 7 of the said policy as and wherever applicable. Since, the Respondent has not chosen to contest the present case, therefore, this Tribunal has no other alternative but to consider and accept the unrebutted contentions of the Complainant as made out in the Complaint which, however, are supported by documents.

8. **CONCLUSION:**

As evident from the findings above, since, the Complainant has proven its case as required under the INDRP Dispute Resolution Policy, therefore, the Complaint is allowed with cost and the following award is being passed in favour of the complainant and against the Respondent.

9. **AWARD:**

In view of above, it is awarded that the disputed domain name **<WWW.CATERPILLARINDIA.NET.IN>** is transferred to the complainant Caterpillar Inc. Accordingly, the registry is directed to transfer the said domain name in favour of the Complainant. It is further ordered that the Respondent is barred from using the mark **<WWW.CATERPILLARINDIA.NET.IN>** and therefore, shall immediately be ceased to use the said domain name in any manner whatsoever.

10. COST:

As due to abovementioned wrongful acts of the Respondent, the complainant has been unnecessarily forced to initiate the present arbitral proceedings, therefore, the cost of the proceedings are also awarded in favour of the Complainant.



(Sajal Koser)
Arbitrator
24.05.2023