



महाराष्ट्र MAHARASHTRA

सदरचा मुद्रांक लिहू अंगड जायरोन्वराठी नाही

HM 276580

अनुक्रमांक... ५९८९... दिनांक... १२/८/१३... रुपये... २०००००
 मुद्रांक कोषागार कारणासाठी वापरावयाचा आहे... डावीकडे अंगड
 मुद्रांक मुद्रांक अधिनियम १९५८ चे अनुक्रमित आहे...
 मुद्रांक वापरणाराचे संपूर्ण नाव... विश्वजीप प्रिन्सिपल ज्योतिराम
 संपूर्ण पत्ता... २४०४, शनिवार पेठ, पुणे-४११००४
 हस्त लेखणीचे संपूर्ण नाव... नरेश ग्राहारे
 पत्ता... ६००३, विठ्ठलवाडी, पुणे-४११००३

नरेश ग्राहारे

स्वाक्षरी (मुद्रांक विक्रेता)
 (सी. जयश्री नि. बेलखले)
 परवाना क्र. २२०५०९९/१९९५
 परवान्याची मुदत ३१/३/२०१४
 पत्ता: ४२५ व, शनिवार पेठ, पुणे-४११००४

मुद्रांक धारकाची/हस्त लेखणीची सही



AWARD
 IN ARBITRATION
 'CLUBPENGU.IN'

Disney Canada Inc.
 181, Bay Street Suite 4400
 Toronto ON M5J 2T3, CANADA

THE COMPLAINANT

AND

Jishi Samuel
 GuildSoft Private Limited, T.C.27/1767, 1st Floor,
 Sri C.C Bldg, Manchiyoor, Trivandrum. 695035, Kerala

THE RESPONDENT /
 THE REGISTRANT

**IN THE MATTER OF DISPUTED DOMAIN NAME: - 'CLUBPENGU.IN'
BEFORE MR.S.C.INAMDAR, B.COM. LL.B., F.C.S.**

SOLE ARBITRATOR

**DELIVERED ON THIS 17TH DAY OF AUGUST TWO THOUSAND THIRTEEN AT PUNE,
INDIA.**

SUMMARISED INFORMATION ABOUT THE DISPUTE: -

**01. Names and addresses
Of the Complainant: -**

**Disney Canada Inc.
181, Bay Street Suite 4400
Toronto ON M5J 2T3
Canada**

**Through its authorized
representative**

**Mr. Sahil Sethi
C/o Saikrishna & Associates.
A-2E, CMA Towers
Second Floor, Sector 24
NOIDA201301.U.P. INDIA**

**02. Name and address of
The Respondent: -**

**Jishi Samuel
GuildSoft Private Limited
T.C. 27/1767, 1st Floor,
Sri C.G. Bldg, Vanchiyoor, Trivandrum.
Kerala. 695035. India**

03. Registrar

Directi Internet Solutions Pvt. Ltd.

04. Calendar of Major events:

Sr. No.	Particulars	Date (Communications in electronic mode)
01	Arbitration case referred to me & acceptance given by me	05/07/2013
02	Hard copy of complaint received	12/07/2013
03	Reply by the Registrant before issue of notice	12/07/2013
04	Notice of Arbitration issued (with the instructions to file say / reply latest by 05.08.2013)	26/07/2013
05	Second reply by the Registrant	10/08/2013
06	Rejoinder notice sent (with instruction to file say latest by 14/08/2013)	11/08/2013
07	Notice of closure of arbitration	16/08/2013
08	Award passed	06/04/2013

I] PRELIMINARY: -

- 1) Disney Canada Inc., a company incorporated under the provisions of the laws of Canada., having its principal office at 181, Bay Street Suite 4400, Toronto ON M5J 2T3, Canada, (**The Complainant**) has filed complaint with National Internet Exchange of India (NIXI) disputing the registration of domain name '**CLUBPENGU.IN**' (the disputed domain name / domain name), through its authorised representative **Mr.Sahil Sethi of Saikrisna & Associates, NOIDA, U.P., India.**
- 2) The Complainant has disputed registration of domain name '**CLUBPENGU.IN**' in the name of **Mr.Jishi Samuel, GuildSoft Private Limited, T.C. 27/1767, 1st Floor, Sri Chitirathirunal Grandhashala Bldg., Vanchiyoor, Trivandrum 695035, Kerala, India (The Respondent / Registrant).**
- 3) Major events took place as enumerated in the above table.

II] PROCEDURE FOLLOWED IN ARBITRAION PROCEEDINGS: -

01. In accordance with INDRP read with INDRP Rules of Procedure, notice of arbitration was sent to the Respondent on 26th July 2013 with the instructions to file his reply / say latest by 5th August 2013.
02. The Registrant / Respondent sent email on 12th July 2013, even before issue of Notice of Arbitration stating that he is the owner of the disputed domain name and that he has been using it for his business purposes. He had no disputes of any nature with anybody.
03. However after receipt of the hard copy of the Complaint, this Arbitration Panel issued Notice of Arbitration on 26th July 2013 with the instructions to the Registrant to file say/ reply, if any, latest by 5th August, 2013.
04. The Registrant replied to the Notice on 12th August 2013 stating that he had already replied to the Complaint on 12th July 2013 and reiterated the same stand.
05. In view of above reply by the Respondent, rejoinder was called for from the Complainant. However no rejoinder was filed by the Complainant.
06. Copies of notices were marked to the Complainant's authorised representative, Respondent and NIXI every time.
07. No personal hearing was requested / granted / held.

III] SUMMARY OF THE COMPLAINT OF THE COMPLAINANT: -

The Complaint is based on the following points / issues in brief: - -

(A) OWNER OF REGISTERED TRADEMARKS AND DOMAIN NAMES:

1. The Complainant is the owner of following registered trademarks: -

Sr. No.	COUNTRY	REG. NO.	CLASS
01	Australia	1151975	16,25,28,41
02	Australia	1151977	--DO--
03	Australia	1303546	09,14,18,20
04	Australia	1368268	24
05	European Community	009066796	41
06	Singapore	T0905269E	41
07	United Kingdom	2439356	16,28,41
08	United Kingdom	2439354	--DO--
09	United Kingdom	2481871	9
10	United Kingdom	009066796	41
11	United Kingdom	2550808	18,20
12	United States of America	4150662	16,28

Apart from above registered trademarks, the Complainant has several websites including www.clubpenguin.com since last many years.

(B) IDENTITY OR CONFUSING SIMILARITY OF THE DOMAIN NAME WITH THE TRADEMARKS OF THE COMPLAINANT: -

1. The Registrant's domain name www.clubpengu.in directly uses the trademark / trade name CLUB PENGUIN as one of the operative words and this name is identical to that of the registered trademark of the Complainant. The impugned domain name is also extremely similar to the Complainant's international website www.clubpenguin.com. Therefore ordinary internet users are likely to be confused by the presence of the impugned domain name on the internet, ostensibly offering goods and services similar / identical to those of the Complainant and thus cause loss of business and reputation to the Complainant.
2. The Registrant has no affiliation, past or present, nor the Complainant has authorised the Registrant to register the disputed domain name and hence the Registrant has no rights or legitimate interests in respect of the domain name. By registering the impugned domain name the Registrant is blatantly seeking to cash in on the brand value and reputation of the Complainant's trademark CLUB PENGUIN for his personal gain.

3. The Registrant has cleverly adopted part of the Complainant's mark 'clubpengu' and has severed only characters 'i' & 'n' from it. However India Specific Top Level Domain name is 'in' and hence it creates an overall impression of the domain address as 'clubpenguin'.
4. The impugned domain name is virtually identical to the trademark of the Complainant causing confusion among internet users. The impugned domain name 'clubpengu.in' redirects an internet users to a website <http://codenamecp.wordpress.com> which offers cheat codes, hints and tips for the Complainant's online gaming portal accessible on www.clubpenguin.com.
5. The Registrant has no rights or legitimate interests in respect of the impugned domain name. The Respondent has never been known by the name 'Club Penguin' or conducted any bona fide business under the impugned name.
6. The disputed domain name was created on 6th May, 2009 as against the Complainant being in this business since 2005. This has been done for the Registrant's own business which causes loss of business and reputation to the Complainant.
7. The registration of the impugned domain name by the Registrant is in bad faith. The registration of disputed domain name was made primarily to usurp illegitimate consideration from the Consideration. The registration was done primarily to dilute the distinctiveness of the Complainant's domain name clubpenguin.com and gain unlawful internet traffic for the impugned domain name 'clubpengu.in'.

(C) REMEDIES SOUGHT BY THE COMPLAINANT: -

On the background of the Complaint and reasons described therein the Complainant has requested for transfer of domain name to it. The Complainant has also requested for costs of the present proceedings to be granted to it.

VI] REPLY TO THE COMPLAINT / STATEMENT OF DEFENSE: -

As stated earlier the Respondent / Registrant has filed say / reply, by simply stating that the disputed domain name is registered and owned by him and that he has been actively using it. He has added further that he has no disputes with anybody over this.

VII] REJOINDERS OF THE PARTIES: -

In view of the reply by the Registrant it was felt necessary to call for rejoinders from the Complainant. However no rejoinder has been filed by the Complainant.

VIII] ISSUES & FINDINGS: -

On the basis of policies and rules framed by NIXI in respect of dispute resolution as also on the basis of submissions of both the parties I have framed following issues. My finding on each issue is also mentioned against it respectively.

SR. NO.	ISSUE	FINDING
01	Does the Complainant have trade mark or service mark directly related to the disputed domain name?	Yes
02	Whether the Registrant's domain name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights?	Yes
03	Whether the Registrant is owner of trade mark or service mark corresponding to the disputed domain name?	No
04	Whether the Registrant has commonly been known by the domain name?	No
05	Whether the Registrant has any legitimate interests in the disputed domain name?	No
06	Whether the Registrant's domain name has been registered or is being used in bad faith?	Yes
07	Has the Registrant registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name?	Yes
08	Whether the Registrant has intentionally attempted to attract internet users to the Registrant's website or other online location by creating likelihood of confusion with the Complainant's name or mark?	Yes

VIII] BASIS OF FINDINGS: -

1. Does the Complainant have trade mark or service mark directly related to the disputed domain name?

The Complainant is the owner of various trademarks as stated in the table above. The Complainant also owns various domain names which include the words 'Club Penguin'. The said trademarks have been registered since 2005 and have been renewed from time to time.

Therefore my finding on this issue is in affirmative.

2. Whether the Registrant's domain name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights?

The word 'CLUB PENGUIN' is an integral / prominent component of subject domain name and also is an integral / prominent component of the registered Trademarks of the Complainant. It is well established beyond doubt by several arbitral decisions in India as also WIPO cases that mere addition of suffix like .in / .org does not differentiate the domain name from the marks. Looking at the stature of the

Complainant, its global presence, as also its strong presence on the internet, it is very hard to believe that the Registrant was not aware of the same.

The disputed domain name has severed two characters i and e from the registered trademarks and website of the Complainant. India TLD is in and hence if uttered uninterrupted the disputed domain name resembles with the registered trademarks of the Complainant. I have searched dictionary as well as thesaurus, research books and reference sites on internet. However there is no word as 'clubpenguin' in any language. The Registrant has not furnished any meaning of the said word nor has he furnished any explanation as to how the word was coined. It leads to only conclusion that the same has been borrowed from the Complainant's trademarks and website 'http://www.clubpengu.com'.

The Complainant has been using this word, trademarks and website since 2005. It is a web place where children all over the world including India, have interactive and other types of virtual games.

Importantly the disputed domain leads to another word press type site and the same has not been developed independently. The material on the disputed domain site is exactly similar to that of the Complainant's website.

The Respondent has not claimed having any registered trade mark or service mark consisting of the word 'CLUB PENGUIN'.

Though the disputed domain name is not fully identical to that of registered trademarks, material portion of the same has been stolen and if adjoined with Indian CCTLD '.in' it represents exactly the same name as is in registered trademarks.

Therefore my finding on the first issue is affirmative.

3. Whether the Registrant is owner of trade mark or service mark corresponding to the disputed domain name?

The Registrant has not filed any say or reply to the complaint and hence it is presumed that he does not have / he has not claimed nor mentioned of being owner or applicant of any trade mark or service mark corresponding to the disputed domain name.

Therefore my finding on this issue is in negative.

4. Whether the Registrant has commonly been known by the domain name?

The name of the Registrant, as on the Whois records is Jishi Samuel. As such he is not commonly been known by the domain name or any variation thereof.

Therefore my finding on this issue is in negative.

5. Whether the Registrant has any legitimate interest in the disputed domain name?

The Registrant has no registered trademark or service mark which includes the words 'CLUB PENGUIN'. He is not commonly been known by that name or any variation or

combination thereof. He has not shown any other nexus of his business with the disputed domain name or any authority by the Complainant to use the word 'Club Penguin' in this behalf.

Therefore my finding on this issue is negative.

6. Whether the Registrant's domain name has been registered or is being used in bad faith?

The website is designed in such a manner that it deceitfully appears to be authentic website of the Complainant. Obviously the Registrant is therefore using it in bad faith for attracting internet users and obtaining illegal monetary gains.

Therefore my finding on this issue is affirmative.

7. Has the Registrant registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name?

The Registrant has failed to establish his bona fides and nexus with the disputed domain name. The Complainant has brought out various aspects of malafide registration of the disputed domain name, registration of domain name without any authority and for any bona fide business on the part of the Respondent. Therefore it is squarely established that such registration by the Registrant has resulted into denying the Complainant his lawful right to register and use the disputed domain name for his business purposes.

Therefore my finding on this issue is in affirmative.

8. Whether the Registrant has intentionally attempted to attract internet users to the Registrant's website or other online location by creating likelihood of confusion with the Complainant's name or mark?

The name of the website is appearing to be authentic website of the Complainant and hence internet users are being attracted to the website as if it is of the Complainant. Finally it is resolving into a blog like webpage but till then the damage is done to the Complainant's business and reputation. It is beyond doubt that the website is creating confusion with the Complainant's identity, name or mark.

Therefore my finding on this issue is affirmative.

IX] CONCLUSION AND BASIS OF AWARD: -

From above discussion this panel has reached the conclusion that: -

1. Since the Registrant's reply to complaint or Notice of Arbitration is very short and merely stating that he is the owner of the domain name, without any justification in respect of how the name has been coined, how it is different than that of the Complainant etc., it leads to only one conclusion that registration has been done with criminal and deceitful intentions and for the purposes of gaining illegally and immorally.

2. The disputed domain name includes the material portion of the registered marks and registered domain names of the Complainant. It means the Complainant's rights, interests and reputation are at stake in the disputed domain name.
3. The Registrant / Respondent does not have any registered trade mark / service mark in his name containing the words 'CLUB PENGUIN' and hence does not have any legitimate interest in the disputed domain name. He has not been authorised by the Complainant to register the said domain name at any time.
4. The Registrant has **not** been commonly known by the disputed domain name.
5. The Respondent / Registrant has completely failed to establish his nexus, rights or interests in or with the disputed domain name in any way.

From all findings on the issues framed, it can be concluded that the Registrant has registered domain name in bad faith, without any legitimate interests in it, and with the purpose of making illegal profits by selling or transferring it for valuable consideration.

On the basis of my findings on issues and foregoing discussion I pass the following award: -

01. The Complainant is entitled to the disputed domain name - 'CLUBPENGU.IN' and hence the same be transferred to the Complainant.
02. The Registrant shall pay to the Complainant all the documented costs of these proceedings.

Dated: - 17.08.2013

Place: - Pune


(S.C. INAMDAR)
SOLE ARBITRATOR