



தமிழ்நாடு தமில்நாடு TAMILNADU

1005  
23.4.2012

Sridharan  
Chennai

V 473145  
S. Mangalam  
S. MANGALAM  
STAMP VENDOR,  
66, MURTHY STREET,  
CHENNAI-600 033.  
LICENCE No : 9942/89  
PHONE No: 2371 0754

BEFORE THE INTERNET EXCHANGE OF INDIA  
ARBITRATION AWARD

ARBITRATOR: S. SRIDHARAN  
DATED: 22nd APRIL 2012

Zeno David SA

--- Complainant

-VS-

Mahendra Kumar

--- Respondent

Sridharan





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Zino Davidoff SA	...	Complainant
<b>Versus</b>		
Mahendra Kumar	...	Respondents

1. The Parties

- 1.1 The complainant is Zino Davidoff SA, an entity organized and existing under the laws of Switzerland having its principal place of business at Rue Faucigny 5, 1700 Fribourg, Switzerland represented by Mr.Ranjan Narula, Advocate of Ranjan Narula Associates at Vatika Towers 10<sup>th</sup> Floor, Block B, Sector 54,Gurgaon -122002.
- 1.2 Respondent is Mr.Mahendra Kumar at 29/1, 72<sup>nd</sup> Cross, 17<sup>th</sup> E Main Road, Rajaji Nagar 5<sup>th</sup> Block, Bangalore-560010.

The Domain Name and Registrar

- 1.3 The disputed domain name <davidoffindia.in> is registered with Transecute Solutions Pvt Ltd.

2. Procedural History

- 2.1 On 28<sup>th</sup> December 2011, NIXI asked me about my availability and consent to take up the Complaint for arbitration. On 3<sup>rd</sup> January 2012, I informed my

*Sridharan*



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.

- 2.2 On 19<sup>th</sup> January 2012, I received hardcopy of the Complaint along with Annexures.
- 2.3 On 21<sup>st</sup> January 2012, 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.
- 2.4 On 25<sup>th</sup> January 2012, the Respondent informed me that the web site under the disputed domain name <davidoffindia.in> was already stopped. He directed his service provider to stop the disputed domain name <davidoffindia.in> long back. But because of his mistake the disputed domain name <davidoffindia.in> appeared and as on date, the web site under the disputed domain name <davidoffindia.in> was stopped and would not appear again.
- 2.5 I perused the Complaint. Para 20 of the Complaint mentioned that the Complainant had obtained some injunction against the Respondent. The order restrained the Respondent from using DAVIDOFF mark. The order attached at Exhibit 9 of the Complainant was a dismissal order dated 4<sup>th</sup> October 2010 passed by the XVIII Additional City Civil Judge, Bangalore City and was against the Complainant. I therefore asked the Complainant

*Induvarans*

by mail dated 30<sup>th</sup> January 2012 to the Complainant to send me a copy of the order passed by the High Court.

- 2.6 On 31<sup>st</sup> January 2012, the Complainant sent me a copy of the order passed by the Karnataka High Court. High Court in its order dated 21<sup>st</sup> April 2011 in MFA No.475 & 474 of 2011 against the dismissal of IA No.1 & II in OS No.6487 of 2010 granted an injunction restraining the Respondent from using the mark DAVIDOFF. The suit was originally filed in Delhi High Court in the year 2008 under CS(OS)No.548 of 2008. The Delhi High Court passed an ex-parte interim injunction against the Respondent by an order dated 26.03.2008. Thereafter on 20.07.2010 the plaint was returned by the Delhi High Court for want of territorial jurisdiction. Thereafter the Complainant presented the suit to the city civil court at Bangalore and the same was numbered as OS No.6487 of 2010.
- 2.7 On 21<sup>st</sup> March 2012, the Respondent sent me a copy of the order dated 9<sup>th</sup> March 2012 passed by IPAB removing the registration no.454875 for the mark DAVIDOFF in class 25 of the complainant for non-renewal of the same within the statutory period.
- 2.8 The disputed domain name <davidoffindia.in> was registered by the Respondent on 10th February 2011.
- 2.9 Email is the medium of communication of this arbitration and each email is copied to all, Complainant, Respondent and NIXI.

*Indu Harans*

### 3. Discussion and Decision

- 3.1 It is obvious from the chronological events mentioned above that the Respondent registered the disputed domain name <davidoffindia.in> after the dismissal of the injunction applications by the Bangalore City Civil Court and before the High Court allowed the appeal of the Complainant and granted the injunction against the Respondent. Immediately on receipt of the notice from me, the Respondent called me over phone and explained that he stopped using the web site under the disputed domain name <davidoffindia.in> and the appearance of the domain name <davidoffindia.in> was despite his instructions to his service provider. He further assured me that the disputed domain name <davidoffindia.in> would not appear again.
- 3.2 The removal of the complainant's trade mark registration does not answer his entitlement to the adoption and use of the disputed domain name <davidoffindia.in> containing wholly the DAVIDOFF mark of the Complainant. In the disputed domain name <davidoffindia.in>, Davidoff is the predominant and distinctive part and the expression "India" is not distinctive one.
- 3.3 The Complaint is allowed as prayed for in the Complaint on the basis of the voluntary agreement to stop using the disputed domain name <davidoffindia.in> by the Respondent and by the reason of the operation of the injunction order passed by the Karnataka High Court against the Respondent.

*Indhira*

3.4 It is hereby ordered that the disputed domain name <davidoffindia.in> be transferred to the Complainant.

3.5 There will be no order as to costs.



S.Sridharan

Arbitrator