



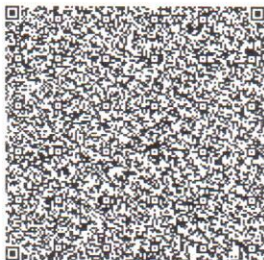
सत्यमेव जयते

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Certificate Issued Date : 22-Jun-2015 02:51 PM
Account Reference : IMPACC (IV)/ dI921303/ DELHI/ DL-DLH
Unique Doc. Reference : SUBIN-DL92130334465213292610N
Purchased by : ASHOK KUMAR SINGH
Description of Document : Article 12 Award
Property Description : Not Applicable
Consideration Price (Rs.) : 0
(Zero)
First Party : ASHOK KUMAR SINGH
Second Party : Not Applicable
Stamp Duty Paid By : ASHOK KUMAR SINGH
Stamp Duty Amount(Rs.) : 100
(One Hundred only)



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BEFORE THE SOLE ARBITRATOR UNDER THE .In DOMAIN NAME DISPUTE RESOLUTION POLICY

IN THE MATTER OF:

FORD MOTOR COMPANY
One American Road
Dearborn, Michigan 48126
United States of America

...(Complainant)

v.

YITAO APEX LABORATORIES LTD.
76, C.P. Rama Road, Hong Kong
Hong Kong 999077

...(Respondent)

Statutory Alert:

1. The authenticity of this Stamp Certificate should be verified at "www.shcilestamp.com". Any discrepancy in the details on this Certificate and as available on the website renders it invalid.
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The Parties

The Complainant in this proceeding is: Ford Motor Company ("Ford"), a publicly-traded corporation, organized under the laws of the State of Delaware, United States of America. Its principal place of business is located at One American Road, Dearborn, Michigan 48126. Ford India Private Limited ("Ford India") is a wholly-owned subsidiary of Ford Motor Company.

Respondent in this proceeding is Yitao , Apex Laboratories Limited, 76, C.P. Rama Road , Hong Kong 999077, telephone number + 852.23838380 and email id: sunong@live.com(available through WhoIS.com)

The Domain Name & Registrant

The disputed domain name is **FORD.CO.IN**. The name of the Registrant has not been provided in the Complaint.

Procedural History

I have been appointed as the Arbitrator by .IN Registry , to adjudicate upon the complaint of the Complainant, regarding the dispute over the domain name FORD.CO.IN.

.IN registry has supplied the copy of the Complaint and Annexures to me.

On 29.04.2015, I sent an email to the parties informing them about my appointment as an Arbitrator.

In the abovementioned mail itself, I requested the Complainant to supply the copy of the complaint with annexure to the Respondent and to provide me with the details of the service record.

In accordance with INDRP read with INDRP Rules of Procedure, notice of arbitration was sent to the Respondent on 29.04.2015 with the instructions to file his say within 15 days from the receipt of the stated email or the receipt of the copy of Complaint, whichever is later.

On 29.04.2015, Counsels/Representative of the Complainant sent the soft copy of the Complaint to the Tribunal.



NIXI through an email dated 01.05.2015 provided the proof of sending the copy of the complaint to the Respondent by blue dart courier and also stated in the same email that the Tribunal will be informed about the status of the courier once they receive it from the courier agency.

On 05.05.2015, NIXI informed the tribunal that the courier was lying undelivered at the destination due to the incorrect/incomplete address of the respondent.

On 12.05.2015 the Claimant was asked to send another hard copy of the Complaint along with all the annexures as the offices of the Arbitrator had caught fire and majority of the files had been badly damaged.

On 12.05.2015 the representatives/counsels of the Claimant sent electronic copy of the Complaint and the annexures to the Arbitrator.

On 18.05.2015, as the courier could not be delivered to the respondent because of the consignee address being incomplete/incorrect , the complainant was directed by the Arbitrator to send a soft copy of the complaint to the respondent. Even though the Respondent was copied on all correspondences and was deemed to be aware of the proceedings, in the interest of justice, 10 days time was further given to the Respondent, to file its Reply, failing which, the parties were informed that the Arbitrator will proceed with the matter on the basis of the pleadings and documents available on record.

On 19.05.2015 the Complainant sent a soft copy to the respondent on the email address listed for the Respondent in the WhoIs database of the .IN Registry.

On 04.06.2015, the Arbitrator informed the parties that the time allotted to the Respondent to file its reply has expired as on 29.05.2015 and as such, the Tribunal shall proceed and pass the award on the basis of the Complaint and documents on record.

The Respondent failed / neglected to file his say / reply to the Complaint of the Complainant within the stipulated time. Similarly he has not communicated anything on the Complaint till the date of this award and as such the proceedings were conducted.

I feel that enough opportunities have been given to the Respondent and genuine efforts have been made to make him a part of the proceedings. Since he has failed to join the proceedings, or to file any response the present ex-parte award is passed.

I have perused the entire record and all the annexures / documents.

Factual Background

The following information is derived from the Complaint and supporting evidence submitted by the Complainant.

COMPLAINANT:

The case of the Complainant is that :

1. The Complainant Ford is a global automotive industry leader, based in Dearborn, Michigan. Ford manufactures or distributes automobiles in 200 markets across six continents, with approximately 260,000 employees and 100 plants worldwide. Ford owns trademark registrations for FORD worldwide, including in India. Ford operates a website at *ford.com*.
2. FORD falls within a select class of internationally famous trademarks and is one of the most recognized trademarks in the entire world. FORD was listed in Business Week's annual survey of the "100 Most Valuable Global Brands" as the 45th most valuable brand in the world in 2012 and has consistently been in the top 50. In 2015, Brand Finance ranked FORD as the 44th most valuable brand in the world.
3. Ford has spent many millions of dollars and has expended significant effort in advertising, promoting, and developing the Ford Marks throughout the world, including in India. As a result of such advertising and expenditures, Ford has established immense goodwill in the marks.
4. Ford first sold vehicles in India in 1907 and first manufactured vehicles in India in 1926. In 1995, Ford Motor Company established Ford India as a wholly-owned subsidiary and has since invested over Rs. 8,000 crore (approximately \$2 billion USD) to expand its manufacturing facilities in India.

RESPONDENT

The Respondent in the present proceeding is: Yitao, Apex Laboratories Limited, 76, C.P. Rama Road, Hong Kong 999077, Telephone no. + 852.23838380 and email id: sunong@live.com



Parties Contentions

i) Complainant

The Complainant contends as follows:

- a. The Respondent's domain name is identical and / or confusingly similar to the Complainant's Trade Mark(s).
- b. The Respondent has no rights or legitimate interest in respect of the domain name.
- c. The Domain Name was registered and used in bad faith.

ii) Respondent

The Respondent has not filed any response and submissions to the complaint despite being given adequate notification and several opportunities by the Arbitrator.

Discussions and Findings:

As previously indicated the Respondent has failed to file any reply to the Complaint and has not rebutted the submission put forth by the Complainant, and the evidence filed by him.

Rule 8 (b) of the INDRP Rules of Procedure provides that *"In all cases, the Arbitrator shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case"*.

As mentioned above enough chances have been provided to Respondent to file the reply but no response was received. Therefore, the proceedings have been proceeded on the basis of the documents on record and hence conducted in his absence.

Rule 12 (a) of the INDRP Rules of Procedure provided that *"An Arbitrator shall decide a Complaint on the basis of the statements and documents submitted to it and in accordance with the Arbitration and Conciliation Act, 1996, Dispute Resolution Policy, the Rules of Procedure and any bye-laws, rules and guidelines framed thereunder and any law that the Arbitrator deems to be applicable"*



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In these circumstances, the decision of the Arbitrator is based upon the Complainant's assertions, and evidence and inference drawn from the Respondent's failure to reply.

Having perused the submissions and documentary evidence placed on record, the Complainant has proved that it has statutory and common law rights in the mark "FORD".

Further, the Arbitrator is of the view that the Complainant has satisfied all the three conditions outlined in the paragraph 4 of .IN Domain Name Dispute Resolution Policy, viz.

- (i) the Registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;
- (ii) the Registrant has no rights or legitimate interests in respect of the domain name; and
- (iii) the Registrant's domain name has been registered or is being used in bad faith.

i. The Domain name is identical or confusingly similar to a name, trade mark or service mark in which Complainant has rights.

The Complainant has stated in its complaint that domain name of Respondent *ford.co.in* is identical to his famous trademark FORD.

This fact has not been disputed by the Respondent and as such requires no further proof from the complainant and as such stands proved.

ii. The Registrant has no rights or legitimate interests in respect of the domain name.

According to the paragraph 7 of the .IN Dispute Resolution Policy, the following circumstances show Registrants rights or legitimate interest in the domain name for the purpose of paragraph 4(ii)

- i. before any notice to the Registrant of the dispute, the Registrant's use of, or demonstrable preparations to use, the domain name or a name*



- corresponding to the domain name in connection with a bona fide offering of goods or services;
- ii. the Registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or
 - iii. the Registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Complainant alleges that the Respondent should be considered as having no rights or legitimate interests in respect of *ford.co.in* because Respondent is not known as "*ford.co.in*," and has not been authorized by Complainant to use the Ford Marks in any connection, and has never made a bona fide use of *ford.co.in*.

It is further submitted that as far as Complainant has been able to determine, Respondent has not used *ford.co.in* in connection with any website that references FORD in any manner. Since Ford learned of *ford.co.in*, the domain name has resolved to different websites that make no mention of "Ford" and have no apparent connection to *ford.co.in* of any kind. For example, on February 13, 2015, the domain name resolved to a website featuring the "Family duo Hermanos Inglesos' music video for 'Wanderland'" and, at another time on that same day, to a website advertising tax software.

It is further submitted that on March 10, 2015, *ford.co.in* resolved to *mazdausa.com*, the website of an auto manufacturer that competes with Ford, and on March 16, 2015, the domain name resolved to *mapsgalaxy.com*, which provides maps and traffic reports.

It is submitted that none of these uses show that Respondent has any right or legitimate interest in *ford.co.in* under INDRP, Para. 7. None of these uses constitutes use in connection with a bona fide offering of goods or services under Para. 7(i), none shows that Respondent is commonly known as *ford.co.in* under Para. 7(ii), and none shows that Respondent is



making a legitimate non-commercial use of the domain name under Para. 7(iii).

It is further submitted that use of the domain name to resolve to the U.S. website of a competing auto manufacture (Exhibit N) precludes Respondent from claiming any right or legitimate interest in *ford.co.in*, as such a clearly infringing use of Complainant's trademark could never give rise to a legitimate right or interest on the part of Respondent in the domain name. Use of *ford.co.in* in this manner also prevents Respondent from claiming that Respondent is known as *ford.co.in*. As Ford has long used FORD in connection with autos and auto parts and accessories, any such use by Respondent directly violates the exclusive trademark rights now residing in Ford. Thus, Respondent could not legally acquire any public association between Respondent and a domain name referring to Ford, and hence could never be commonly known or recognized by that name and thus fall within INDRP, Para. 7(ii).

The above submission of the Complainant has not been rebutted by Respondent, as such they are deemed to be admitted by him. Even otherwise the above facts and annexures establish that the Respondent has no right or legitimate interest in the disputed domain name under INDRP paragraph 4(ii).

iii. The Registrant domain name has been registered or is being used in bad faith

It is alleged by the Complainant that the Complainant's rights in FORD were well established in India long before Respondent registered *ford.co.in*, and Respondent cannot claim that he registered the domain name unaware of its trademark significance. FORD falls within a select class of internationally strong marks that have become so famous that it is impossible for any respondent to claim that he was unaware of Ford's prior rights or has a legitimate interest in domain names that incorporate the mark. The same has also been illustrated by means of the case, *Ford Motor Co. v. Cox*, Case No. 1437143 (NAF May 10, 2012) (transferring *newfordvans.com*) where it was held that the contention that respondent registered *newfordvans.com* without awareness of FORD was inconceivable "in light of the fame and notoriety of Complainant's FORD mark".



It is further submitted that the Respondent registered *ford.co.in* primarily for the purpose of selling the domain name registration to Complainant, which bears the name "Ford" and is the owner of the trademark FORD, for valuable consideration in excess of Respondent's documented out-of-pocket costs directly related to the domain name that is also proven by Respondent's conduct in sending an unsolicited offer to Ford to buy the domain name and in demanding payment of an amount in gross excess of Respondent's out-of-pocket registration costs, namely, \$1890 USD. Furthermore, Respondent admitted that Respondent registered the domain name for the sole purpose of selling the domain name when Respondent responded to Ford's refusal to pay for the domain name by stating in an email to Ford's counsel: "I am a domain investor. If it could be free, no need to register this domain name before." *Id.* Thus, Respondent's bad faith is established pursuant to INDRP, Para. 6(i).

It is further submitted that Respondent's bad faith registration and use is also established under INDRP, Para. 6(ii) inasmuch as Respondent has registered other domain names incorporating Ford's famous trademarks and attempted to sell them to Ford, as well as many other domain names incorporating the famous trademarks of others.

It is submitted emphasized by the Complainant that the Respondent previously registered the domain name *fordcredit.in* for the purpose of selling the domain name to Ford. On August 15, 2013, a number of Ford departments and individual employees received an unsolicited offer to buy *forcredit.in* that was sent from an email address used by Respondent namely, nameescrow@outlook.com and is identical to the unsolicited offer Respondent sent regarding *ford.co.in*. That email stated:

www.fordcredit.in

This Indian domain is for sale.

Contact us via nameescrow@outlook.com

Manager

Thereafter when Ford objected, Respondent sent an email demanding payment of \$1890 US that is nearly identical to the email Respondent sent to Ford's counsel in this matter. That email stated:

Thanks for your email.

I understand that you said, so this domain could be sold to your company at a low price.

Only 1890 USD.

We could do the transaction via sedo.com(Germany) or escrow.com(USA), and the transfer will be finished in one week.

Best regards,

Song

It is submitted that the Respondent has been the losing party in prior UDRP and INDRP cases in which Respondent was found to have registered famous trademarks in domain names primarily for the purpose of selling them to the trademark owner for valuable consideration and, indeed, has been characterized as a "habitual offender and a cybersquatter."

Reference has been made to the case of **Jaguar Land Rover Ltd. v. Yitao**, Case No. INDRP/641 (INDRP Jan. 5, 2015) (transferring *jaguarlandrover.co.in*), at pages 32-34, where the Respondent responded to the complainant's demand letter by demanding \$1990 USD.

Another case cited by the Complainant is **Giorgio Armani S.p.A. v. Yitao/Apex Labs. Ltd.**, Case No. D2013-2060 (WIPO Jan. 29, 2014) (transferring *armanijeans.com* and holding, where the Panel determined from the evidence of the settlement discussions that they represented a bad faith effort to extort by the Respondent. Similarly case of **Booz Allen Hamilton Inc. v. Yitao**, Case No. D2013-0738 (WIPO June 17, 2013) (transferring *boozallenhamilton.biz* where bad faith based was found based on factors including Respondent's offer "to sell the disputed domain name for a sum in



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excess of its out-of-pocket costs directly related to the domain name have been cited by the Complainant.

It is submitted that the fact that Respondent has deliberately provided false WhoIs information serves as another basis for finding that Respondent registered and used the domain name in bad faith. The complainant has relied on the case of *Jaguar Land Rover Ltd. v. Yitao*, to show that the Arbitrator found that Respondent "deliberately provided" false WhoIs information in order to "save from any legal action/proceedings, which is a total violation of clause 2 of terms and conditions for Registrants and Paragraph 3 of the .IN Domain Dispute Policy as to Registrant's Representations"

It is submitted that the WhoIs information that Respondent used in registering *jaguarlandrover.co.in* is exactly the same as the WhoIs information Respondent used in registering *ford.co.in*.

It is further submitted that the Respondent's use of *ford.co.in* to operate an infringing website constitutes further evidence of bad faith under INDRP, Para. 6(iii). Use of a domain name that is confusingly similar to the complainant's mark to host a website offering competing goods and services for sale is classic cyberpiracy and constitutes compelling evidence of bad faith in the registration and use of the disputed domain name.


The Tribunal is of the view that the Respondent has neither responded nor has put forth or provided any evidence to show that the Respondent is engaged in or demonstrably prepared to engage in offering any bonafide goods or services in the name of the disputed domain name.

The above submission of the Complainant has not been rebutted by Respondent, as such they are deemed to be admitted by him. Even otherwise, the above facts and annexures establish that the Respondent has no right or legitimate interest in the disputed domain name under INDRP paragraph 4(ii).

DECISION

In view of the above facts and circumstances, it is clear that the Complainant has succeeded in its complaint.

The Respondent has registered and used the disputed domain name in bad faith. NIXI is hereby directed to transfer the domain name of the Respondent i.e. <FORD.CO.IN> to the Complainant. In the facts and circumstances of the case no cost or penalty is imposed upon the Respondent. The Award is accordingly passed on this 29th day of June 2015.



A.K. Singh

Sole Arbitrator

Date: 29th June, 2015