

2 Procedural History

- 2.1 A Complaint dated July 31, 2020 has been filed with the National Internet Exchange of India (hereinafter referred to as the "Exchange"). The Complainant has made the registrar verification in connection with the domain name at issue. It is confirmed that presently the Respondent is listed as the registrant and provided the contact details for the administrative, billing and technical contact. The Exchange verified that the Complaint satisfied the formal requirements of the Indian Domain Name Dispute Resolution Policy (hereinafter referred to as the "INDRP") and the Rules framed thereunder.
- 2.2 The Exchange appointed Dipak G. Parmar, Advocate as the sole arbitrator in this matter. The Arbitrator finds that he was properly appointed. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Exchange.
- 2.3 The Arbitrator had directed the Respondent to file his reply to the Complaint on or before August 25, 2020. On August 27, 2020, the Arbitrator had extended the deadline for submission of reply to September 2, 2020. The Respondent had submitted an interim reply on August 29, 2020 and also requested for additional time, which was granted. The Respondent had submitted his reply on September 10, 2020 and also requested for additional time, which was denied. The Complainant was directed to file its response to reply of the Respondent on or before September 16, 2020. On September 11, 2020, the Complainant submitted its response to reply of the Respondent (re-joinder). On September 14, 2020, the Respondent submitted his response to the re-joinder.
- 2.4 Email is the mode of communication of this arbitration and each email is copied to the Complainant, the Respondent and the Exchange.

3 Factual Background

From the pleadings and documents submitted by the parties, the Arbitrator has found the following facts:

- 3.1 The Complainant, which was founded in 1871, is a French industrial business trading internationally. It manufactures and offers products for power management, automation, and related solutions. The Complainant's corporate website can be found at www.schneiderelectric.com. The Complainant is featured on the NYSE Euronext and the French CAC 40 stock market index. In 2018, the Complainant revenues amounted to 25.7 billion euros.
- 3.2 APC by Schneider Electric (formerly American Power Conversion Corporation) of the Complainant, is a manufacturer of uninterruptible power supplies, electronics peripherals, and data center products.
- 3.3 The main website of APC by Schneider Electric is www.apc.com. The Complainant owns a large portfolio of trademarks including the wording "APC" in several countries, including in India.

Dipak G. Parmar

- 3.4 It is pertinent to note the Respondent having business relationship with the Complainant. The Respondent had produced various communications exchanged between the Complainant and him, which, inter alia, includes the Authorised Dealer Certificate recognizing the Respondent as APC authorised dealer and dealership is valid till December 2008; recent email interaction between the Complainant and its customer dated May 18-22, 2020 and the same were marked to sales@apcindia.co.in. It is clear from these communications that the Respondent was one of the distributor of the Complainant for more a decade.
- 3.5 But in the Complaint, the Complainant contends the Respondent is not related in any way with the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither license nor authorization has been granted to the Respondent to make any use of the trademark APC, or apply for registration of the disputed domain name by the Complainant. Moreover, the disputed domain name redirects to a reproduction of the Complainant's website (www.apc.com). The logo "APC" is reproduced without authorization.
- 3.6 The Disputed Domain Name <apcindia.co.in> was registered by the Respondent on July 19, 2009, without express approval of the Complainant. The Complainant raised a concerned about the Disputed Domain Name, vide its email dated January 24, 2013 and letter dated April 18, 2013. But no action was taken by the Complainant against the Respondent till date except the present Complaint. The Respondent continue to work as one of their distributor in India and was using the Disputed Domain Name for selling the Complainant's products and services thereof with the following so called disclaimer as part of its privacy policy, which is available at <https://apcindia.co.in/privacy-policy/>¹

APC India>Privacy Policy

Who we are

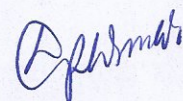
All other trademarks and logo used here are the property of their respective owners. All rights reserved. - PROMOTIONAL ONLINE SITE IS OWNED & OPERATED BY BIC. Bangalore. India

4 Parties' Contentions

4.1 Complainant

The Complainant contends that the Disputed Domain Name is identical to its trademark "APC";

¹ The Arbitrator had accessed <https://apcindia.co.in/> and <https://apcindia.co.in/privacy-policy/> on September 17, 2020.



the Respondent has no rights or legitimate interests in the Disputed Domain Name; and the Disputed Domain Name has been registered and is being used in bad faith.

4.2 Respondent

The Respondent denied all claims of the Complainant and relied on defense of acquiescence.

5. Discussion and Findings

- 5.1 The Arbitrator has decided the Complaint on the basis of the statements and documents submitted by parties in accordance with the INDRP, the Arbitration and Conciliation Act, 1996, the Rules and other applicable rules and principles of law.
- 5.2 According to the INDRP, the Complainant must prove that:
- (i) the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which complainant has rights;
 - (ii) the Respondent has no rights or legitimate interests in the Disputed Domain Name; and
 - (iii) the Disputed Domain Name has been registered or is being used in bad faith.

5.3 Identical or Confusingly Similar

The Complainant's trademark "APC" is a registered trademark in India and other countries. The Complainant has provided evidence of its registered trademarks, based on which, it is found that the Complainant has established its rights in the trademark. It is well accepted that submitting proof of trademark registration is considered *prima facie* evidence of enforceable rights in a mark.² The Disputed Domain Name consists of "APC", the Complainant's trademark, and merely addition of "India" and the generic top-level domain, "co.in". Prior panels³ deciding under the Uniform Domain Name Dispute Resolution Policy (UDRP) and Delhi High Court⁴ have held that mere addition of country name to domain name, "India" in the present complaint, adjacent to the complainant's trademark <trademark+country name> would not prevent a finding of confusing similarity under the first element. It is well-established in various decisions⁵ under the UDRP and the INDRP that the presence or absence of spaces, punctuation marks between words or indicators for top-level domains, such as .com, .us, .in, co.in etc., are irrelevant to the consideration of identity or confusing similarity between a trademark and a disputed domain name. Thus, "India" and ".co.in" should not be taken into account while comparing the Complainant's trademark and the Disputed Domain Name. Therefore, the

² In the matter of Perfetti Van Melle Benelux BV v. Lopuhin Ivan, IPHOSTER WIPO Case No. D2010-0858 it was held that trademark registration constitutes *prima facie* evidence of the validity of trademark rights. See Backstreet Productions, Inc. v. John Zuccarini, CupcakeParty, Cupcake Real Video, Cupcake-Show and Cupcakes-First Patrol, WIPO Case no. D2001-0654.

³ See Cellular One Group v. Paul Brien WIPO case no. D2000-0028 Domain name <cellularonechina.com> was found identical or confusingly similar to trademark "CELLULARONE". Also see Wal-Mart Stores Inc. v. Walmarket Canadian WIPO case no. D2000-0150 Domain name <walmartcanada.com> was found confusingly similar to trademark "WAL-MART".

⁴ See Yahoo! Inc. vs Akash Arora & Anr. 1999 IAD Delhi 229, 78 (1999) DLT 285 Domain name <yahooindia.com> was found identical or confusingly similar to trademark "Yahoo!".

⁵ See AB Electrolux v. GaoGou of YERECT, INDRP case no. 630 <Zanussi.in>: "The expressions .in and .com need to be discarded while comparing the marks with the domain names".

Arbitrator finds that the Disputed Domain Name <apcindia.in> is confusingly similar to the Complainant's trademark "APC".

5.4. Rights or Legitimate Interests

Paragraph 7 of the INDRP contains a non-exhaustive list of circumstances that may demonstrate when a respondent has rights or legitimate interests in the use of a domain name. The list includes:

- (1) 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 and services;
- (2) 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
- (3) 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 tarnish the trademark or service mark at issue.

A complainant must show a prima facie case that a respondent lacks rights or legitimate interests. Once the complainant has made a prima facie showing, the burden to come forward with evidence establishing rights or legitimate interests shifts to the respondent. The Complainant alleges initially that the Respondent is not related in any way with the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither license nor authorization has been granted to the Respondent to make any use of the trademark APC, or apply for registration of the Disputed Domain Name by the Complainant. However, the Complainant concede, by not giving any specific response to the reply of the Respondent, that:

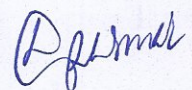
- (i) the Respondent was one of the distributor of the Complainant for more a decade;
- (ii) although the Complainant had raised concerned in 2003 about the Disputed Domain Name. But the Complainant had not taken any action against the Respondent till date except the present Complaint; and
- (iii) the Respondent continue to work as one of their distributor and was using the Disputed Domain Name for selling the Complainant's products and services thereof.

The Respondent also concede that:

- (i) he is not commonly known by the Disputed Domain Name;
- (ii) the Disputed Domain Name was registered without express approval of the Complainant; and
- (iii) he uses the Disputed Domain Name commercially for selling the Complainant's products and services thereof.

UDRP Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a bona fide offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the "Oki Data test", the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark



holder; and

(iv) the respondent must not try to "corner the market" in domain names that reflect the trademark.⁶

In absence of the specific allegations, the Arbitrator presume that no third party products or services were provided through the Disputed Domain Name nor the Respondent had registered any other domain names containing the Complainant's trademark "APC". However, the so called disclaimer used by the Respondent on the Disputed Domain Names does not satisfy the above mentioned (iii) condition. Thus, the Respondent failed to satisfy the Oki Data test.

However, the Oki Data test does not apply where any prior agreement, express or otherwise, between the parties expressly prohibits (or allows) the registration or use of domain names incorporating the complainant's trademark.⁷ The Respondent raised the defense of acquiescence by the Complainant to the Respondent's use of the Disputed Domain Name. It was not clear whether the Respondent was expressly allowed to use the Disputed Domain Name incorporating the complainant's trademark "APC". But it was established, from various communications exchange between the Complainant and the Respondent that in 2013 and thereafter, that the Complainant was aware of registration and use of the Disputed Domain Name by the Respondent. However, the Complainant preferred to continue its relationship with the Respondent and no action was taken against the Respondent for period of 7 years. Thus, defense of acquiescence was not thwarted by continuous business relationship of the Complainant with the Respondent⁸ and the Complainant's inaction, which does not expressly prohibits use of the Disputed Domain Name for selling the Complainant's products and services thereof. Consequently, the Arbitrator concludes that the Respondent has rights or legitimate interests in the Disputed Domain Name <apcindia.co.in>.

5.5 Registered and Used in Bad Faith

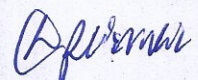
In view of the above finding regarding the Respondent's legitimate interest in respect of the Disputed Domain Name, the resolution of this case does not require reaching the third element of the Complainant's case, namely proof of bad faith on the part of the Respondent. Still, the Arbitrator examine the third element of bad-faith. At the time of registration of the Disputed Domain Name, the Complainant was using the registered trademark "APC" and the Respondent, being the distributor of the Complainant, knew of the existence of the Complainant's trademark "APC". The Respondent has incorporated "APC", the Complainant's trade mark, and merely addition of "India" in the Disputed Domain Name to attract Internet users to the Disputed Domain Name by creating a likelihood of confusion with the Complainant's trademark with an intent of trading on the goodwill and reputation associated with the Complainant's trademark "APC" for illegal profits.⁹ These facts supports the

⁶ See Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, section 2.8.1

⁷ Ibid.

⁸ See Assembled Products Corporation v. Uppgroup Inc., WIPO Case No. D2009-1223, a case in which the complaint failed to establish the absence of legitimate interest in a respondent that for several years sold genuine products of the complainant in association with authorized distributors.

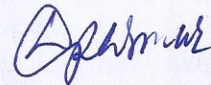
⁹ See Weny's LLC v. Apex Limited, INDRP Case no. 737. In this case the domain name <wendys.co.in> was found to be registered with the intention of trading on the goodwill and reputation associated with Wendy's trademark and was held to be registered and use of domain name in bad faith. Also see BASF SE v. Zhang Xiao, WIPO Case No. D2017-2200 <basf.sale>, at Annex 18: "Given the widespread reputation of the BASF marks and the identical domain name, the Panel finds that the public is likely to be confused into thinking that the disputed domain name has a connection with Complainant, contrary to fact. Through either displaying a PPC parking page or using a dynamic redirection scheme on the website at the disputed domain name, Respondent is likely to have made substantive commercial gain by 'freeriding' on the reputation of Complainant and its trademarks, which is indicative of Respondent's bad faith use of the disputed domain name."



inference that the Respondent deliberately registered the Disputed Domain Name using the Complainant's trademark with the intention to exploit it. This proves his malafide intent behind registration of the Disputed Domain Name. Considering the Complainant's continuous relationship with the Respondent, its inaction and acquiescence of the use of the Disputed Domain Name, the question of the Disputed Domain Name is being used in bad faith does not arise. In the UDRP, the Complainant has to prove that the Disputed Domain Name has been registered and is being used in bad faith. But in the INDRP, the Complainant has to prove that the Disputed Domain Name has been registered or is being used in bad faith. Accordingly, the Arbitrator finds on balance that the Disputed Domain Name has been registered in bad faith.

6. **Decision**

In sum, the Arbitrator concludes that even if the Complainant has satisfied the first and the third elements of its case but has not satisfied the second element. Hence, the Complaint is denied.



Dipak G. Parmar
Sole Arbitrator

Date: September 19, 2020