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INDRP ARBITRATION

THE NATIONAL INTERNET EXCHANGE OF INDIA (NIXI)

ADMINISTRATIVE PANEL DECISION

Sole Arbitrator: Neeraj Aarora

NIKE INNOVATE C.V. Vs Amy Hill

Arbitration Award

Disputed Domain Name: 'nikestore.in'

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INDRP ARBITRATION

THE NATIONAL INTERNET EXCHANGE OF INDIA [NIXI]

ADMINISTRATIVE PANEL DECISION

SOLE ARBITRATOR: Neeraj Aarora

Arbitration Award

Disputed Domain Name: **NIKESTORE.IN**

In the matter of:

NIKE INNOVATE C.V.

One Bowerman Drive

Beaverton, Oregon

97005 6453

United States of America

.....**Complainant**

Versus

Amy Hill

77 Massachusetts Avenue

Cambridge

Massachusetts 02139

US.

.....**Respondent**



I. The parties

a. Complainant

NIKE INNOVATE C.V.
One Bowerman Drive
Beaverton, Oregon
97005 6453
United States of America

Represented by:

Joel McDonald
Stobbs, Building 1000
Cambridge Research Park Cambridge
CB25 9PD United Kingdom
Email: joel.mcdonald@iamstobbs.com
Tel: +44(0) 1223 435240
Fax: +44(0) 1223 425258

b. Respondent

Amy Hill
77 Massachusetts Avenue
Cambridge
Massachusetts 02139 US
E-mail: darkbluebruce@gmail.com
Telephone: (+1) 617-253-1000

II. Disputed Domain Name & Registrar

a. Disputed domain name

'nikestore.in'

Date of Registration of Domain name: 20/01/2020

b. Registrar of the domain name:

Endurance Domains Technology LLP

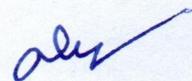


Registrar abuse contact email: abuse-contact@publicdomainregistry.com

- c. The registry is the National Internet Exchange of India (hereinafter referred to as NIXI).

III. Procedural History

- a. That the Complainant, through his authorized representative, has submitted the Complaint dated 23/10/2020 to the INDRP for arbitration of domain name dispute.
- b. Shri Neeraj Aarora was appointed as Sole Arbitrator by NIXI vide email dated 02/11/2020 & Shri Neeraj Aarora has accepted the assignment and also given his statement of acceptance and declaration of impartiality and independence. The NIXI vide email dated 14/12/2020 forwarded the documents/ case to the Arbitrator.
- c. That the notice was issued to the respondent on 14/12/2020, directing respondent to submit his reply to complaint by 03/01/2021. The arbitration proceedings are deemed to have been commenced on 14/12/2020.
- d. That, no reply to the notice was received from the Respondent till 03/01/2021. However, keeping in view the interest of justice, a further opportunity was provided to the Respondent to submit reply by 12/01/2021. It was specifically mentioned that in the event of failure of the Respondent to submit the reply, the matter will be proceeded ex-parte.



- e. That, despite various communication/ opportunities, no reply was received from the Respondent, hence, the proceedings was closed and vide email dated 13/01/2021, it was informed to the parties including the Respondent, that the matter would be decided on the basis of documents and ex-parte against the Respondent.

IV. Parties Contention

A. Complainant

- a. That the companies, NIKE INNOVATE C.V, a subsidiary of Nike, Inc., Nike Inc., its associated companies and subsidiaries are collectively referred herein as the Complainant.
- b. That the 'NIKE' brand was adopted by the Complainant in 1971 and it has been registered and used in many countries of the world by the Complainant and its associated entities. The Complainant has provided the list of applications/ registrations of trademark/ design with the 'NIKE' going on into more than 500 pages. Some of prominents are as follows:

Indian Registrations

S.No	Mark/Name	Reg. No./ App. No.	Class	Filing/ Registration Date
1	NIKE	RN: 201708 AN: 526647	25	22/03/1990

2	NIKE	RN: 597228 AN: 1058162	09	09/11/2001
3	NIKE	RN: 478222 AN: 1058161	14	09/11/2001
4	NIKE	RN: 396428 AN: 1058160	28	09/11/2001
5	NIKE	RN: 495800 AN: 1240800	35	01/10/2003
6	NIKE and Design	RN: 520834 AN: 1211922	28	07/07/2003
7	NIKE and Design	RN: 239123 AN: 566685	28	31/01/1992

International Registrations

S.No	Mark/Name	Reg. No./ App. No.	Class	Filing/ Registration Date
1	NIKE	RN: 6711 AN: 1995/356	(Int'l Class: 18) (Int'l Class: 25)	13/06/1997
2	NIKE and Design	RN: 6498 AN: 1995/378	(Int'l Class: 18) (Int'l Class: 25)	13/06/1997
3	NIKE and Design	RN: 33762	(Int'l Class: 25)	23/12/1996
4	NIKE and Design	RN: 33768	(Int'l Class: 09)	05/12/1997
5	NIKE	RN: 33770	(Int'l Class: 09)	05/12/1997
6	NIKE and Design	RN: 122728 AN: AM02621/1988	(Int'l Class: 25)	10/06/2015
7	NIKE and Design	RN: 4-1988-415624 AN: 4-1988-415624	(Int'l Class: 35)	14/06/2016

- c. The Complainant is the world's leading manufacturer of sports shoes/ sports apparels and also carries on an established business in respect of a large variety of goods. The Complainant, including through its authorized partners, operates retail stores and sells products under the 'NIKE' brand in many cities around the world.

- d. That the Complainant's total sales for sale of products under 'NIKE' brands including affiliates throughout the world during the period 1979 - 2018 in U.S dollars is \$485,490 million.
- e. That the Complainant advertising expenditures on its product bearing brand name 'NIKE' including expenditure of its affiliates throughout the world during the period 1979 – 2018 in U.S dollars is \$52,061 million.
- f. That the Complainant had been successful in a number of domain cases in its favour which relates to brand name 'NIKE' and also for the domain names which include the word 'NIKE', the domain name of the Complainant.

S.No	Particulars
1	INDRP/804 (NIKE.CO.IN)
2	D2013-1298 (NIKEIRAN.COM)
3	D2002-0543 (NIKESHOES.COM)
4	D2001-1115 (WWWNIKE.COM) DMX2017-0017 (NIKEGOLF.COM.MX and NIKEGOLF.MX.com)
5	DMX2016-0002 (NIKE.MX)
6	D2017-2357(NIKEMEETSWORLD.COM,NIKE-SG.COM, NIKEUKSHOPS.COM,NKFRSHOP.COM, SHOPNIKE99.COM)

- g. The Complainant has also sponsored various deals with globally well known elite athletes such as Cristiano Ronaldo, Neymar Jr., Wayne Rooney, Eden Hazard, Abby Wambach, Alex Morgan, Robert Lewandowski, Andres Iniesta, Serena Williams, Rafael Nadal etc, which have appeared in high profile sporting event prominently displaying the 'NIKE' brand.

B. Respondent

- a. The Respondent despite giving sufficient opportunities did not submitted any reply.

V. Findings

A. Applicable Law and Rules

- a. The present dispute is being decided as per .IN Dispute Resolution Policy (INDRP) comprising of **The .IN Domain Name Dispute Resolution Policy (INDRP)** and **INDRP Rules of Procedure**. It is mentioned in **Para 5 of The .IN Domain Name Dispute Resolution Policy (INDRP)** that *“The Arbitrator shall conduct the Arbitration Proceedings in accordance with the Arbitration & Conciliation Act, 1996 amended as per the Arbitration & Conciliation (Amendment) Act, 2015 read with the Arbitration & Conciliation Rules as well as the INDRP Policy and Rules, as amended from time to time.”*

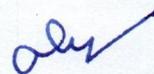
- b. In terms of Para 4 of **The .IN Domain Name Dispute Resolution Policy (INDRP)**, three premises are to be taken into consideration for deciding the dispute:
 - “(a) the Registrant's domain name is identical and/or confusingly similar to a name, trademark or service mark in which the Complainant has rights; and*
 - (b) the Registrant has no rights or legitimate interests in respect of the domain name; and*
 - (c) the Registrant's domain name has been registered or is being used in bad faith.”*

B. The Respondent's Default

- a. That the Respondent was served notices twice on his registered email id but consciously chosen not to reply despite being given various opportunities.
- b. The Rule 12 of INDRP Rules of Procedure provides as follows:
*"12. Default by Parties
In event any party breaches the provisions of INDRP rules and/or directions of the Arbitrator, the matter can be decided ex-parte by the Arbitrator and such arbitral award shall be binding in accordance to law."*
- c. In view of the intentional conduct of the Respondent in not filing the reply to the complaint, Respondent is proceeded '**ex-parte**'.

C. Identical/ Confusingly Similar

- a. The domain name used by the Respondent is '**www.nikestore.in**' while the Complainant has registered trade name/ trademark '**NIKE**' in India and also in various countries.
- b. The plain test to identify whether the domain name is identical or confusingly similar is the side by side comparison of the domain name. As also referred in the **WIPO Jurisprudential Review 3.0:**
"The standing or threshold test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name."



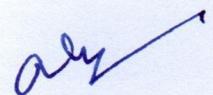
While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.”

- c. The domain name NIKESTORE.IN substantially incorporates the Complainant’s brand ‘NIKE’ and couples it with the generic word STORE which clearly refers to a key element of the Complainant business, namely a retail store. Therefore, this domain is identical / confusingly similar to the Complainant’s NIKE brand. In the similar scenario it was observed by the Hon’ble High Court of Delhi in the matter of **Thoughtworks Inc. Vs Super Software Pvt Ltd &Ors (MANU/DE/0064/2017)**

“With the domain name taking up the entire name of the Petitioner, there could be no doubt that the use of such domain name by the Respondent would be deceptively confusing and erroneously indicate a connection of Respondent No 1 with the Petitioner where there is none”.

- d. The registration and use of a identical/ confusingly similar domain name as that of trademark of the Complainant is a direct infringement and it was also observed in the matter of **F Hoffman-La Roche AG vs Relish Enterprises (WIPO) D2007-1629:**

“If the Complainant owns a registered trademark, then it satisfies the threshold requirement of having the trademark rights and the domain name is confusingly similar to Complainant’s trademark because the disputed domain name looks and reads like Complainant’s trademark.



- e. In case of trademarks with well-built goodwill, reputation & wide spread presence on internet, any re-arrangement with substantial similarity was to encash the goodwill of the reputed trademarks by creating closer imitation. It was observed in the matter of **Forest Laboratories Inc Vs Natural Products Solutions LLC Case No. D2011-1032.; Forest Laboratories Inc. Vs Clark Grace Case No. D2011-1006 (WIPO):**

“Typosquatting involves the intentional rearrangement or change of a few letters in the mark to make a nonsensical but close imitation deliberately intended to catch a tired or careless typist’s search for the mark wonder’s website. Usually, the added or substituted letter or addition involves a character immediately adjacent to the replaced one” - [Eg. Amazon.com Vs Steven Newman Aka Jill Waserstein AKA Pluto Newman (WIPO)]”

- f. In terms of **Para 3 of INDRP Rules of Procedure**, it is the obligation of the Respondent to ensure that the domain name registered by him does not violate upon the Right of any other person. **Para 3** provides as follows:

“3. Registrant's Representations

By applying to register a domain name, or by asking a Registrar to maintain or renew a domain name registration, the Registrant hereby represents and warrants that:

(a) the credentials furnished by the Registrant for registration of Domain Name are complete and accurate;

(b) to the knowledge of registrant, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party;

(c) the Registrant is not registering the domain name for an unlawful and malafide purpose; and

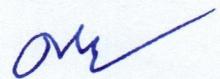
only

(d) the Registrant will not knowingly use the domain name in violation or abuse of any applicable laws or regulations.”

- g. In the facts and circumstances of the present case, where the trademark/ trade name ‘NIKE’ of the Complainant is registered across the world and enjoy a wide reputation and goodwill & as such, the Respondent fails to discharge its obligation in terms of **Para 3(b)** referred above and hence this tribunal is of the view that the disputed domain name is confusingly similar to Complainant’s Mark.

D. Rights and Legitimate Interest

- a. The Respondent is required to prove any of the circumstances provided under **Clause 6 of INDRP (Policy)** in order to prove legitimate interests:
- 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.



- b. That this requirement to be proved by the Complainant is the negative one and as such the Complainant is required to establish a prima facie case in respect of lack of right or legitimate interest of the Respondent in the disputed domain name and thereafter the burden of proof will shift to the Respondent.
- c. The Complainant is able to prove its rights and legitimate interest in the trademark 'NIKE' and has also produced the evidence of its registration across the world and amount spent by it as advertising and sponsorship expenses for generating goodwill and reputation, while the Respondent choose not to reply despite giving various opportunities.
- d. The Respondent does not come forward to show that the Respondent has any right or legitimate interest in the disputed domain name which incorporates the 'NIKE' mark. A mark in which the Complainant has the substantial and exclusive right and that is well known to the world, owing to the Complainant efforts.
- e. There is no material to show that the Respondent is using the disputed domain name in relation to bona fide offering of goods and services. Further, the fact that the Respondent on its website has not disclosed the Respondent relationship with the Complainant and therefore, such suppression of relationship may falsely mislead general Internet user to believe that the Complainant owns the domain name.



- f. That registration of domain name by Respondent similar to or resembling worldwide popular brand 'NIKE' of Complainant shows the intention of taking advantage of Complainant's rights, reputation and goodwill by Respondent.
- g. In the facts and circumstances of the case, when the trademark of the Complainant is well known, enjoys international reputation and trade name is known across the globe and the Respondent creates a deceptive domain name incorporating the entire trademark with a change by adding a generic word store, the Respondent cannot be said to have a right or legitimate interest. It was also observed in the matter of **Wockhardt Ltd vs Kishore Tarachandani:(INDRP Dispute Case no: INDRP/382)**

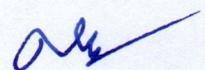
"The Respondent cannot have a right or legitimate interest in the disputed domain name when it incorporates the entire mark of the Complainant - Clear case of abusive registration of a well-known mark."

- h. That in the fact and circumstances, this Tribunal is of the view that Respondent does not have legitimate rights and interest in the domain name.

E. Registered or Use in Bad Faith

- a. That in order to prove that the Respondent has 'Registered or used in bad faith' the impugned domain name, Complainant has to prove one of the conditions provided under clause 7 of INDRP which are as follows:

"7. Evidence of Registration and use of Domain Name in Bad Faith



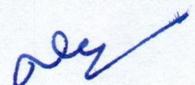
For the purposes of Clause 4(c), the following circumstances, in particular but without limitation, if found by the Arbitrator to be present, shall be evidence of the registration and use of a domain name in bad faith:

(a) circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant, who bears the name or is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented out-of-pocket costs directly related to the domain name; or

(b) the Registrant has 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, provided that the Registrant has engaged in a pattern of such conduct; or

(c) by using the domain name, the Registrant has intentionally attempted to attract Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location."

- b. That as the trademarks/ trade names of the Complainant is so famous & also distinctive that the Respondent must have had actual knowledge of the trademark prior to registering the disputed domain name. There cannot be any doubt from the evidence put before this Arbitral Tribunal that the Complainant's marks are well known and that the Respondent intended to capitalize on this confusion. By registering the disputed domain name with actual knowledge of the Complainant's trademark, the Respondent acted in bad faith by breaching its service agreement with the Registrar because the Respondent registered a



domain name that infringes upon the intellectual property rights of another entity.

- c. That the combination of the Complainant's NIKE brand with the generic term STORE will cause a false association between the Respondent's domain name and the Complainant's 'NIKE' brand and will lead the average Internet user to believe that the disputed domain name is owned by the Complainant and could relate to the sale of genuine 'NIKE' goods. This lead to the attributable conclusion that respondent was aware about the complainant trademark and has registered the disputed domain name in bad faith.
- d. That it was held in the matter of **Viacom International Inc & MTV Networks Europe vs Web Master (Case No. D2005-0321-WIPO)**

“Given long and widespread reputation of the Complainant's mark, the compelling conclusion is that the Respondent, by choosing to register and use a domain name which is not only confusingly similar to the Complainant's widely known and distinctive mark but identical thereto, intended to ride on the goodwill of the Complainant's trademark in an attempt to exploit, for commercial gain, Internet traffic destined for the complainant. Potential partners and end users are led to believe that the website is either the Complainant's site, especially made up for bearings, or the site of the official authorized partners of the Complainant, while, in fact, it is neither of these.”

- e. That the Hon'ble High Court in the matter of **ITC Ltd vs Travel India(Case No, L-2/5/R4 OF 2008 - NIXI):**

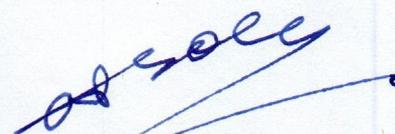
“Registration of domain name which is identical to trademark, with actual knowledge of the trademark holder's rights is strong evidence that the domain name was registered in bad faith. “



f. Therefore the entire facts and circumstances lead to irrefutable conclusion that the disputed domain name has been registered by the Respondent in bad faith.

I. Decision

In view of the aforesaid facts and reasons, the Complainant has proved its case and therefore this Arbitral Tribunal directs that the disputed domain name 'nikestore.in' is to be transferred to the Complainant.



Neeraj Aarora

Sole Arbitrator

Date: 15/01/2021