



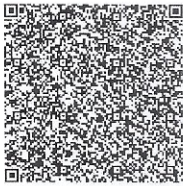
सत्यमेव जयते

## INDIA NON JUDICIAL

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### e-Stamp

Certificate No.	: IN-DL28331902818248T
Certificate Issued Date	: 08-Jan-2021 05:35 PM
Account Reference	: SELFPRINT (PU)/ dl-self/ NEHRU/ DL-DLH
Unique Doc. Reference	: SUBIN-DLDL-SELF60113944308858T
Purchased by	: IRA LAW PREETIKA KASHYAP
Description of Document	: Article 12 Award
Property Description	: ARBITRATION AWARD
Consideration Price (Rs.)	: 0 (Zero)
First Party	: BINNY KALRA
Second Party	: NONE
Stamp Duty Paid By	: BINNY KALRA
Stamp Duty Amount(Rs.)	: 150 (One Hundred And Fifty only)



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**SELF PRINTED CERTIFICATE  
TO BE VERIFIED BY THE RECIPIENT**

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ARBITRATION AWARD  
IN REGISTRY

NIKE INNOVATE C.V. — COMPLAINANT

✓

CHRISTINA MUELLER — RESPONDENT

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*Binny Kalra*

**ARBITRATION AWARD  
.IN REGISTRY**

(C/O NATIONAL INTERNET EXCHANGE OF India)

Before the Sole Arbitrator, Binny Kalra

Disputed domain name <www.nike-india.in>

In the matter of:

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

**Complainant**

vs

Christina Mueller  
Alter Wall 24  
Miltenberg 63886  
Germany

**Respondent**

INDRP Case No: 1289

**1. The Parties:**

The Complainant is NIKE INNOVATE C.V. who claims to be the brand owner and a subsidiary of Nike, Inc., a US corporation. The Complainant is represented in these proceedings by its authorized representative Joel McDonald, c/o Stobbs, Building 1000, Cambridge Research Park, Cambridge 4 CB25 9PD, United Kingdom. The Respondent is Christina Mueller, who has not made any representations either herself or through counsel during these proceedings.

**2. The domain name, Registrar, and Policy:**

The present proceedings pertain to a dispute regarding the domain name www.nike-india.in (hereinafter referred to as the "**Disputed Domain Name**"). The Registrar for the Disputed Domain Name is Endurance Domains Technology LLP. The present arbitration is being conducted in accordance with the Arbitration and Conciliation

*Binny Kalra*



Act, 1996, the .IN Domain Name Dispute Resolution Policy ("**Policy**") and the INDRP Rules of Procedure ("**Rules**").

### **3. Procedural history:**

- 10 November 2020: Consent of the arbitrator along with a declaration of impartiality and independence was given to the .IN Registry
- 16 November 2020: A notice from the .IN Registry to the parties informing them of the appointment of Ms. Binny Kalra as the arbitrator was sent along with the complete set of papers comprising the Complaint and its annexures
- 1 December 2020: The .IN Registry provided the complaint and all relevant documents to the arbitrator as the email address was inadvertently misspelt in the email notice dated 16 November 2020
- 1 December 2020: Notice of commencement of arbitration proceedings was sent to all parties by the arbitrator and a period of 30 days, until 30 December 2020, was given to the Respondent to submit a statement of defence
- 30 December 2020: No communication had been received from the Respondent by the stipulated date and even until 31 December 2020. A notice of forfeiture of the right to file a statement of defence by the Respondent was sent by email by the arbitrator to all concerned parties and the matter was reserved for passing an ex parte award

### **4. The Complainant's case:**

The expression "Complainant", as per the submission in para 3 of the complaint, would include Nike, Inc. and associated companies and subsidiaries of Nike, Inc. The Complainant claims to be carrying on an established business in respect of a large variety of goods, including footwear, clothing, headgear, bags, eyewear, watches

*Binny Kalra*

and other electronic products and sports equipment. The mark NIKE is claimed to be known exclusively in relation to the Complainant, and it is further claimed that the Complainant has a significant reputation and has built up a vast amount of goodwill in the NIKE brand worldwide.

The Complainant has further made the following relevant factual claims, *inter alia*:

- The NIKE brand was adopted by the Complainant in 1971 and has been registered and used in many countries of the world.
- The Complainant is the registered proprietor of the mark NIKE including registrations in India and has placed on record a database of its trademark registrations worldwide as **Annexure-4** to the complaint.
- The Complainant is the world's leading manufacturer of sports shoes and sports apparel and operates retail stores and sells products under the NIKE brand itself and through its authorised partners in many cities.
- The NIKE brand is amongst the most widely recognized brands in the world and finds place in the highest valued brands in the following rankings, *inter alia*:
  - *Interbrand's* annual publication for the 100 'Best Global Brands'
  - *BrandFinance's* annual report 'Global 500'.
  - *Fortune Magazine's* annual ranking of 'The World's Most Admired Companies'
  - *FastCompany's* annual ranking of 'The World's Most Innovative Companies'
- The Complainant's total sales figures for sale of products under NIKE brands by all NIKE companies, including affiliates throughout the world, from fiscal year 1979 through fiscal year 2018 total USD 485,490,000,000.
- The Complainant spends large sums of money annually in advertising the products sold under the NIKE brand. The total advertising expenditure of NIKE companies, including affiliates throughout the world, from fiscal year 1979 through fiscal year 2018 totals USD 52,061,000,000. This includes advertisements in magazines having international circulation such as Sports Illustrated, Time, Newsweek etc. The NIKE brand is displayed by NIKE-sponsored athletes and teams who compete in major sporting events

*Bhavya Kabe*



including the FIFA World Cup, the Copa America, the CONCACAF Gold Cup, the Olympics, The Wimbledon Tennis Championships, The French Open, The U.S. Open, The British Open, the MLB World Series, the NFL Super Bowl, the NHL Stanley Cup, the Tour de France, major golf championships, and major international basketball, baseball, hockey, and football tournaments. All of these events are watched by millions of viewers around the world on television. Products sold under the Complainant's NIKE brand are thus known to sports lovers around the world.

- The Complainant also has a long history of numerous sponsorship deals with globally well-known, elite athletes, who have participated in and appeared at high profile sporting events with clothing and/or footwear prominently displaying the NIKE brand.
- Based on the long use, significant sales and advertising, and worldwide fame of the Complainant's NIKE brand, the NIKE brand ought to be deemed famous and well known throughout the world.
- The Complainant has been successful in a number of other domain complaints which relate to domain names including the word NIKE.
- The disputed domain name is confusingly similar to the Complainant's NIKE brand. The domain name NIKE-INDIA.IN wholly incorporates the Complainant's NIKE brand and couples it with the word INDIA which is one of the Complainant's core markets. Therefore, this domain is identical / highly similar to the Complainant's NIKE brand.
- The details of the Disputed Domain Name registered by the Respondent have been placed on record as **Annexure-1** to the Complaint.
- The combination of the NIKE brand and the term 'INDIA' creates the false impression that the domain name is being used by the Respondent for the sale of genuine and authorized products bearing the Complainant's NIKE brand in India. Given the reputation and long use of the NIKE brand by the Complainant, there is no believable or realistic reason for registration or use of the Disputed Domain Name other than to take advantage of the Complainant's rights.

*Praveen Kumar*

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- The Complainant's in-house team has confirmed that the goods sold via this Disputed Domain Name are not genuinely sourced Nike product (*sic*). The Respondent's use of the disputed domain name to sell non-genuine goods is evidence that they are not using it in relation to a bona fide offering of goods and services.
  - The Disputed Domain Name was registered in bad faith, as the combination of the NIKE brand with the term INDIA will lead the average Internet user to believe that the Disputed Domain Name is owned by the Complainant. The registration of a domain name that is confusingly similar to a trade mark by an entity that has no relationship to that mark is sufficient in itself for a finding of bad faith.

## **5. Legal grounds:**

Under Paragraph 4 of the Policy, the Complainant must establish the following three elements to succeed:

- (a) the Disputed Domain Name is identical and/or confusingly similar to a name, trademark or service mark in which the Complainant has rights; and
- (b) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (c) the Disputed Domain Name has been registered or is being used in bad faith.

## **6. Discussion and findings:**

The Respondent has chosen not to participate in the present proceedings and has not filed any statement of defence. Therefore, the claims of fact made by the Complainant as summarized in paragraph 4 of this decision, shall be accepted by the Arbitrator if they are found to be *prima facie* valid. The discussion will therefore proceed on this basis.





**A. Whether the Disputed Domain Name is identical and/or confusingly similar to a name, trademark or service mark in which the Complainant has rights**

The Disputed Domain Name is <nike-india.in>. The Complainant has claimed rights in the mark NIKE. The evaluation of Issue A shall therefore be twofold:

**a. Whether the Complainant has rights in the mark NIKE**

The Complainant has attempted to establish its rights in the mark NIKE by making the following claims:

- It holds various trademark registrations for the mark NIKE and has submitted details of these registrations in a tabulated form in Annexure-4;
- It is a leading manufacturer of sports shoes and sports apparel and has been trading under the mark NIKE since 1971;
- The Complainant's NIKE brand is among the most widely recognized brands in the world. According to Interbrands's annual publication for the 100 'Best Global Brands', NIKE consistently ranks among the highest valued brands in the world. The Complainant's NIKE brand also consistently ranks among the most valuable brands in BrandFinance's annual report, 'Global 500'. The Complainant consistently appears in Fortune Magazine's annual ranking of "The World's Most Admired Companies". The Complainant continues to appear in FastCompany's annual ranking of "The World's Most Innovative Companies";
- There are several decisions in the Complainant's favour with regard to the NIKE formative domain names including:
  - i. INDRP/804 (NIKE.CO.IN)
  - ii. D2013-1298 (NIKEIRAN.COM)
  - iii. D2002-0543 (NIKESHOES.COM)
  - iv. D2001-1115 (WWWNIKE.COM)
  - v. DMX2017-0017 (NIKEGOLF.COM.MX and NIKEGOLF.MX.com)
  - vi. DMX2016-0002 (NIKE.MX)
  - vii. D2017-2357 (NIKEMEETSWORLD.COM, NIKE-SG.COM, NIKEUKSHOPS.COM, NKFRSHOP.COM, SHOPNIKE99.COM)

*Amey Kulkarni*

At the outset, it must be pointed out that the Complainant has placed no evidence in support of its claims other than the database of its worldwide trademark registrations/applications. As regards the trademark database, the Complainant has left it to the Panel to identify the relevant registrations in India from the 387-page record of its worldwide registrations/applications. The registration certificates, at least for India, ought to have been separately filed since presumably, these registrations are the Complainant's primary evidence of rights and title relevant for the purpose of these proceedings. Further, since INDRP/UDRP complaints are filed online the Complainant could have assisted the Panel better by providing the URL links, if not copies, for the most relevant domain name decisions on which it places reliance.

Be that as it may, the Panel has accepted the Complainant's claims to be *prima facie* valid based on the statements in the complaint and the trademark registration numbers for India in the trademark database forming Annexure 4, and the INDRP decision No. 804 dated 12 July 2016. The Panel also finds that the Complainant has goodwill and reputation in the mark NIKE in India, taking note of the high visibility of the NIKE brand in sporting events such as the FIFA World Cup, the Olympics, the Wimbledon Tennis Championships, the French Open, The U.S. Open, the Tour de France, and it also has statutory rights in the mark NIKE in India.

**b. Whether the Disputed Domain Name is identical and/or confusingly similar to the mark NIKE**

In agreement with the claims made by the Complainant and as the result of independent analysis, the Panel finds that the Disputed Domain Name is confusingly similar to the mark NIKE, for the following reasons:

- The Disputed Domain Name <[www.nike-india.in](http://www.nike-india.in)> wholly contains the Complainant's mark NIKE in which the Complainant has exclusive rights.
- The mark NIKE has been accepted by the Panel to be exclusively owned and associated with the Complainant. The mere addition of the non-distinctive term "India" to the word 'Nike' is not sufficient to distinguish

*Amey* *balve*



the Disputed Domain Name from the Complainant's mark NIKE and it is likely that consumers who access the website corresponding to the Disputed Domain Name will associate it with the Complainant, believing it to be that of or related to the Complainant. Similar reasoning has been upheld by several courts, as far back as the decision of the Delhi High Court in *Yahoo! Inc. v. Akash Arora*, (1999) PTC (19) 201 Del, where the Hon'ble High Court held that there was every possibility of an internet user being confused between the domain names/marks 'Yahoo' of the Plaintiff and 'Yahooindia' of the Defendant and believing that they belonged to a common source, and in the more recent case of *Citigroup Inc. v. Citicorp Business & Financial Pvt. Ltd.*, (2015) 216 DLT 359.

For the above reasons, the Panel holds in favour of the Complainant in respect of Issue A and finds that the Disputed Domain Name is confusingly similar to the mark NIKE in which the Complainant has rights.

**B. Whether the Respondent has any rights or legitimate interests in respect of the Disputed Domain Name**

The Complainant's statements in the complaint are accepted by the Panel taken together with the document placed on record at Annexure 4 to the complaint and absent any rebuttal thereof by the Respondent. *Prima facie*, it appears that the Respondent does not have any rights or legitimate interest in the Disputed Domain Name.

Therefore, the Panel holds in favour of the Complainant in respect of Issue B and finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name.

**C. Whether the Disputed Domain Name has been registered or is being used in bad faith**

Although the Complainant has averred that its in-house team has confirmed that the goods sold via this Disputed Domain Name are not genuinely sourced Nike product and the Respondent's use of the disputed domain name to sell non-

*Binary Labs*

genuine goods is evidence that they are not using it in relation to a bona fide offering of goods and services, the Complainant has not placed on record a screenshot of the website corresponding to the Disputed Domain Name as on the date of filing the complaint, which would have enabled the Panel to examine the same and determine whether this is/was being used in bad faith.

When checked by the Panel on January 8, 2021, the website corresponding to the Disputed Domain Name is unavailable and the web browser displays the message "*This site can't be reached. Check if there is a typo in nike-india.in. ...*". The Panel therefore cannot rely on the contents of the website corresponding to the Disputed Domain Name to evaluate the Complainant's contention and, in the absence of any evidence in this regard, the Panel is unable to reach a finding based on the said contention.

However, given the widespread use and statutory title of the Complainant in the mark NIKE and considering the confusing similarity between the Complainant's NIKE mark and the Disputed Domain Name, the Panel holds in favour of the Complainant in respect of Issue C and finds that the Disputed Domain Name has been registered in bad faith.

**7. Decision:** For the reasons described above, the Panel finds that the Complainant has satisfied all three elements required under Paragraph 4 of the Policy to obtain the remedy of transfer of the Disputed Domain Name.

Therefore, the Panel directs that the Disputed Domain Name <**www.nike-india.in**> be transferred to the Complainant.

Signed:



Ms. Binny Kalra

Arbitrator

Date: 9 January, 2021