

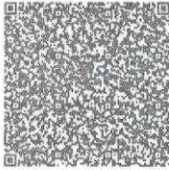


सत्यमेव जयते

INDIA NON JUDICIAL
Government of Uttar Pradesh

e-Stamp

Certificate No.	: IN-UP70362532862142T
Certificate Issued Date	: 28-Apr-2021 06:27 PM
Account Reference	: NEWIMPACC (SV)/ up14078504/ GHAZIABAD SADAR/ UP-GZB
Unique Doc. Reference	: SUBIN-UPUP1407850428343606431988T
Purchased by	: PUNITA BHARGAVA
Description of Document	: Article 12 Award
Property Description	: Not Applicable
Consideration Price (Rs.)	:
First Party	: PUNITA BHARGAVA
Second Party	: NA
Stamp Duty Paid By	: PUNITA BHARGAVA
Stamp Duty Amount(Rs.)	: 100 (One Hundred only)



-----Please write or type below this line-----

BEFORE THE NATIONAL INTERNET EXCHANGE OF INDIA
.IN REGISTRY

Arbitral Award in Case No. 1347
Ms. Punita Bhargava, Sole Arbitrator
Disputed domain name: <yonex.in>

4

Statutory Alert:

1. The authenticity of this Stamp certificate should be verified at www.shoulesstamp.com/ or using e-Stamp Mobile App of Stock Holding. Any discrepancy in the details on this Certificate and as available on the website / Mobile App renders it invalid.
2. The onus of checking the legitimacy is on the users of the certificate.
3. In case of any discrepancy please inform the Competent Authority.

In the matter of

YONEX KABUSHIKI KAISHA, trading as YONEX CO., LTD.

23-13, Yushima 3-Chome

Bunkyo-ku 113-0034, Tokyo

Japan

... Complainant

v.

Maria R. Dempsey

4056 Woodside Circle K7,

Fort Walton Beach 32547

USA

... Respondent

1. The Parties

The Complainant in this proceeding is YONEX KABUSHIKI KAISHA, a corporation duly organised and existing under the laws of Japan, trading as: YONEX CO., LTD.; incorporated on June 30, 1958 with its registered address at 23-13, Yushima 3-Chome Bunkyo-ku, 113-0034 Tokyo, Japan and is represented by Mr. Vikrant Rana of S.S. Rana & Co., Advocates of 317, Lawyers Chambers, High Court of Delhi, New Delhi 110003, India. The Respondent in this proceeding is Maria R. Dempsey of the address 4056 Woodside Circle K7, Fort Walton Beach 32547, United States of America.

2. Disputed Domain Name and Registrar

This dispute concerns the domain name <YONEX.IN> (the 'disputed domain name') registered on August 16, 2012. The Registrar with which the disputed domain name is registered is Endurance Domains Technology LLP (Registrar IANA ID: 801217)

3. Procedural History

The arbitration proceeding is in accordance with the .IN Domain Name Dispute Resolution Policy (Policy), adopted by the National Internet Exchange of India (NIXI).

NIXI vide its email dated March 1, 2021 requested availability of Ms. Punita Bhargava to act as the Sole Arbitrator in the matter. The Arbitrator indicated her availability and submitted the Statement of Acceptance and Declaration of Impartiality and Independence in compliance with the .INDRP Rules of Procedure (Rules) on the same date. In accordance with Rules, NIXI vide its email of March 2, 2021 appointed the Arbitrator and also notified the Respondent of the Complaint. The Arbitrator sent an email to the Respondent on March 3, 2021 informing it of the commencement of the proceeding and providing it time of two weeks to file its reply.

No reply was received from the Respondent within the time prescribed and so the Arbitrator sent an email to all concerned parties on March 23, 2021 that she would proceed to pass its award ex-parte taking into consideration all the material presented before it.

Further, the Arbitrator sought clarification from the Complainant's representative on April 13, 2021 with regard to the conversion figures stated in paragraph 10 of the Complaint and has taken the response received on April 14, 2021 in consideration while passing this Award.

The language of this proceeding is English.

4. Background of the Complainant and its rights in YONEX as submitted by it

The Complainant (reference to which includes its predecessors, predecessors in title, licensees, franchisees affiliates, associates, and subsidiary including Yonex India Private Limited) is a leading manufacturer, producer and supplier of sports equipment, apparel and gear with operations that extend across Asia, Europe and the Americas. As on March 2020, it had a net income of over USD 15 million.

The Complainant was founded by Mr. Minoru Yoneyama in the year 1946. A brief history of the Complainant since its inception is tabulated below:

YEAR	EVENT
1946	Mr. Minoru Yoneyama began manufacturing and selling wooden products in Niigata Prefecture, Nagaoka City, Japan.
1958	Mr. Yoneyama founded the YONEYAMA COMPANY LTD. (with a capital of 2 million yen) for production of badminton racquets.
1964	YONEYAMA COMPANY, LTD. made good progress and increasing sales led to its becoming the No. 1 sports brand in Japan.
1967	YONEYAMA COMPANY, LTD. changed its name to LIMITED COMPANY YONEYAMA RACQUETS and set-up its first distributor in Singapore.
1974	LIMITED COMPANY YONEYAMA RACQUETS changed its name to YONEX SPORTS CO., LTD. YONEX SPORTS CO., LTD. began production of wooden tennis racquets and signed up Mr. Tony Roche, the doubles title winner of four Grand Slam tournaments as its Opinion Leader.
1975	YONEX SPORTS CO., LTD. built its second factory in Niigata prefecture, Nagaoka City and commenced sale of YONEX GRAFLEX tennis racquet T-9000.

1977	YONEX SPORTS CO., LTD. built YONEX Gymnasium, equipped with two badminton courts and launched a YONEX Tennis Club in Niigata Prefecture, Nagaoka City.
1980	YONEX SPORTS CO., LTD. signed top tennis players Billie Jean King (USA), Martina Navratilova (USA) and Dianne Fromholtz (Australia) as its brand ambassadors.
1981	YONEX SPORTS CO., LTD. expanded its international presence by incorporating its German subsidiary YONEX SPORTS GmbH and by opening a branch office in Germany.
1982	YONEX SPORTS CO., LTD. changed its name to YONEX CO., LTD and diversified its business into golf and launched its very first carbon graphite and persimmon wooden golf club.
1983	YONEX CO., LTD. boosted its international presence in the United States by incorporating its subsidiary YONEX CORPORATION.
1987	YONEX CO., LTD. established branch offices in the United Kingdom and Taiwan by incorporating subsidiaries YONEX UK LTD. and YONEX TAIWAN CO., LTD., in the said countries respectively.
1989	YONEX CO., LTD. incorporated a dedicated research and development company for golf course construction, i.e. YONEX R&D CO., LTD.
1995	YONEX CO., LTD. marked its entry into the snowboarding industry and launched industry's first carbon-infused snowboard.
2009	YONEX CO., LTD. began sale of running shoes.

The Complainant states that the name and mark YONEX is derived, in large part, from the name of its founder YONEYAMA and its use of YONEX as its corporate name and trademark in respect of *inter alia* tennis racquets dates back 1974. The Complainant has since then been continuously, openly and extensively using the YONEX name and mark in respect of sports equipment and other goods which are available all over the world, including in India, through an elaborate chain of retail and distribution network including in India.

The Complainant has foreign subsidiaries/ affiliate under the YONEX name and mark across multiple jurisdictions, some of which are as under:



Company Name	Country
Yonex India Private Limited	India
Yonex Corporation	The united states
Yonex Canada	Canada
Yonex U.K. Limited	United Kingdom
Yonex GmbH	Germany
Yonex Taiwan Co., Ltd.	Taiwan
Yonex Sports (China) Co., Ltd.	China

Over the course of the last few decades, the Complainant's YONEX brand has become widely recognized in Japan and internationally including in India. Details of some of the year wise milestones of the Complainant since its founding is as under:

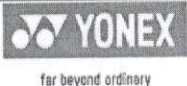
YEAR	EVENT
1960	The Complainant became the first company in the sports industry to receive the Japanese Prize of Smaller Enterprise Agency's Director.
1979	The Complainant's tennis racquets received official recognition from the USPTA.
1987	The Complainant's founder Minoru Yoneyama received Japanese Medal with Blue Ribbon.
1991	The Complainant's YONEX CARBONWOOD golf club achieved a 48.2% share of the carbon head club market in America, making it the No. 1 choice for the consuming public.
2001	The Complainant was honored with a "Certificate of Commendation" by the Council of the International Badminton Federation
2005	The YONEX brand was ranked at 270 in the list of "Asia's Top 1000 Brands" by Campaign Asia Pacific.
2006	The Complainant received quality management system ISO9001 qualification.

The Complainant's worldwide annual sales figures in respect of its YONEX branded products runs into millions of Yen. It's annual net sales between years 2008-2012 is as under:

Financial Year	Yen (in Millions)	USD (in millions)
2007-2008	36,761	352 million
2008-2009	37,381	358 million
2009-2010	36,870	353 million
2010-2011	36,687	351 million
2011-2012	37,512	359 million

The Complainant is the registered proprietor of the YONEX mark as well as variants of the same that incorporate YONEX including  and  in various jurisdictions; of the world in various classes. In India, the Complainant has the following registrations, which are valid and subsisting on the Register.

Trademark	Registration No.	Application Date	Class/es
YONEX	362564	June 5, 1980	18
YONEX	362563	June 5, 1980	25

YONEX	362562	June 5, 1980	28
YONEX	1492699	October 3, 2006	5, 7, 9, 14, 16, 21, 24, 26, 29, 30, 41
	3679748	July 27, 2017	28

The Complainant's YONEX mark has been declared as well-known in India by the Intellectual Property Appellate Board of India vide its Order dated June 18, 2020. It has also been recognized as a famous trademark in Japan. Further, the YONEX mark has been certified as a "Superbrand" in India by Superbrands India.

The Complainant registered the domains <yonex.com> and <yonex.co.jp> on September 25, 1995 and January 08, 1997 respectively. It also operates websites corresponding to the same which details its business, products and services under the YONEX brand. The Complainant has also registered domain names like <yonexusa.com>, <yonex.co.uk>, <yonex.cn>, <yonex.com.tw>, <yonex.de>, <www.yonex.fr> and operates websites corresponding to the same. Some of the other domains with the <yonex.____> designation owned by the Complainant are as under:

Domain	Valid Up To
yonex.xyz	02-06-2021
yonexbadminton.com	20-07-2021
yonextennis.com	20-07-2021
yonex.ae	10-09-2020
yonex.shop	26-09-2021
yonex-showroom.com	01-03-2021
yonex.jp	31-03-2021
yonex.co.jp	31-01-2021
yonexshop.jp	31-12-2021
yonex-cc.com	16-12-2020
yonex.com	24-09-2022
yonexusa.com	23-02-2023
yonex.cn	17-03-2030
yonex.com.cn	05-11-2023
yonex.at	
yonexshop.net	09-10-2021
yonex.eu	31-3-2021
yonex.co.uk	25-5-2021
yonex.tw	30-11-2026
yonex.com.tw	01-07-2023
yonexsports-f.or.jp	31-05-2018

The Complainant has spent millions of US dollars in promoting the YONEX brand via satellite television channels, subscription based online channels as well as in a wide variety of print and electronic media. It has sponsored marque international sporting events and actively promoted the YONEX brand in the sports industry, including in hoardings, player kits and merchandise, professional sports photography, post-match presentations, podium formalities, player interviews, media reporting, sports desk of notable news channels, newspapers, magazines, catalogues, brochures, and other promotional material.

A representative list of events sponsored/ partnered by the Complainant is as under:

Title/Event	Year
Yonex All England Open Badminton Championships	1984-2020
Yonex Open Hiroshima Golf Tournament (JPGA Tour)	1989
Yonex Open Hiroshima 1999	1999
Yonex Ladies Golf Tournament (annual event on the LPGA of Japan Tour, held at the YONEX COUNTRY CLUB)	1999-2019
Yonex Sunrise Hong Kong Super Series 2008	2008
Yonex-Sunrise Badminton Asia Championships 2010	2010
TOTAL BWF World Championships (5-year agreement from 2017-2022 as the Official Equipment Provider)	2017, 2019
TOTAL BWF Sudirman Cup (5-year agreement from 2017-2022 as the Official Equipment Provider)	2017, 2019
TOTAL BWF Thomas & Uber Cup Finals (5-year agreement from 2017-2022 as the Official Equipment Provider)	2018
Yonex Open Chinese Taipei 2017	2017
Yonex Chinese Taipei Open 2019	2019
Daihatsu Yonex Japan Open 2019	2019
Yonex US Open 2019	2019
Yonex Dutch Junior International	2020
Yonex Sunrise Open- Hong Kong	2020
12th Yonex Junior Golf Championship 2019	2019
Yonex German Open 2019	2019
Yonex French Open 2019	2019
Yonex Latvia U17 International 2020	2020

Apart from the above, the Complainant has signed up popular sporting personalities as brand ambassadors who use YONEX branded equipment's; some of these are detailed as under:

Player	Year of Signing	Achievements
---------------	------------------------	---------------------

Tony Roche (Australia Tennis Player)	1974	Mr. Roche won doubles title at the Wimbledon (1974), the Australian Open (1971, 1976 and 1977) and mixed doubles at Wimbledon (1976).
Ann Kiyomura (American Tennis player)	1976	Ms. Kiyomura won the 1975 Wimbledon Championship doubles.
Billie Jean King (American Tennis player)	1980	Ms. King won Singles championship at the US Open (1971, 1972, 1973, 1975), the French Open (1972) and Wimbledon (1972, 1973, 1975)
Martina Navratilova (American Tennis player)	1980	Ms. Navratilova won the Australian Open, Wimbledon, and US Open in 1983 (in both singles and doubles) with the best-selling YONEX R-22 racquet. In 1990, Ms. Navratilova claimed her 9th Wimbledon title with the YONEX widebody RQ-180.
Phil Mickelson (American Golf player)	1992	Mr. Mickelson won National University Golf Championship three times. His other PGA wins include Byron Nelson Golf Classic, the World Series of Golf in 1996, the AT&T Pebble Beach National Pro-Am in 1998, the Colonial National Invitation in 2000, the Greater Hartford Open in 2001 and 2002
Richard Krajicek (Dutch Tennis player)	1996	Mr. Krajicek won the 1996 singles Wimbledon title.
Lleyton Hewitt (Australian Tennis Player)	1999	Mr. Hewitt won the US Open (2000) and Wimbledon (2002).
Ryo Ishikawa (Japanese Golf Player)	2008	Mr. Ishikawa won Pro Tour Championship at the age of 15 and later recorded the world's lowest score.
Lee Chong Wei (Malaysian Badminton Player)	2007	Mr. Lee was the No. 1 ranked badminton player (as per BWF World Rankings) at the time and as on date, has held 69 title wins, including India Open, Hong Kong Open, All England Open and French Open.
Caroline Wozniacki (Danish tennis player)	2011	Ms. Wozniacki was ranked first in the women's tennis world (at that time) and she won the Canadian Open (2010), Pan Pacific Open (2010), China Open (2010), Dubai Championships (2011) and Indian Wells Open (2011).
Carolina Marin (Spanish Badminton Player)	2012	Ms. Marin won singles title at the All England Open (2015), Malaysia Open

		(2015), Australian Open (2015), French Open (2015) and Hong Kong Open (2015).
Eugene Bouchard (Canadian Tennis Player)	2018	Ms. Bouchard won Nuremberg Cup (2014).

Some other players who are YONEX brand ambassadors are as under:

TENNIS		
Sr. No.	Name	Nationality
1	Stan Wawrinka	Switzerland
2	Nick Kyrgios	Australia
3	Yoshihito Nishioka	Japan
4	Eugenie Bouchard	Canada
5	Caroline Garcia	French
6	Markéta Vondroušová	Czech
GOLF		
7	Suzuka Yamaguchi	Japan
8	Hyo-Joo Kim	South Korea
BADMINTON		
9	Lin Dan	China

Additionally, the Complainant has provided the official stringing teams ("The Yonex Stringing Team") to string at many notable international events. The Yonex Stringing Team supports top players in international tournaments in Tennis, Badminton and Soft Tennis. A list of events where the Complainant has been signed up as the official stringer is as under:

Sr. No.	Event
1	Grand Slam: Australian Open
2	Shanghai Rolex Masters (ATP 1000)
3	Rakuten Japan Open (ATP 500)
4	Chengdu Open (ATP 250)
5	Shenzhen Open (ATP 250)
6	WTA Elite Trophy (Tour Championships)
7	Toray Pan Pacific Open (Premier)
8	Wuhan Open (Premier)
9	Tianjin Open (International)
10	Hong Kong Open (International)
11	2008 Beijing Olympic & Paralympic Games
12	2012 London Olympic & Paralympic Games
13	2016 Rio de Janeiro Olympic & Paralympic Games

By virtue of its long-standing use and extensive promotion of the YONEX mark, the Complainant's YONEX branded sports equipment, apparel and gear command valuable respect in the Indian market as well and YONEX is amongst the leading sports brands here. For the purpose of facilitating its business in India, the Complainant has incorporated a subsidiary Yonex India Private Limited in 2016 and commenced manufacturing YONEX branded equipment by setting up a factory in Bengaluru. The Complainant further sells YONEX branded products in India through its authorized distributor SUNRISE SPORT (INDIA) PVT LTD through an extensive network of retailers as also e-commerce platforms/ online marketplaces like www.amazon.in, www.flipkart.com, www.snapdeal.com.

The Complainant has an active involvement in the Indian sports industry and has sponsored major sporting events here. In 2018 it signed a three-year sponsorship contract worth INR 750,000,000 (USD 10,250,004 approx.) with the Badminton Association of India. As part of the sponsorship agreement, the Complainant supplies equipment to the BAI for all its tournaments, camps and academies and acts as the title sponsor of all BAI administered badminton tournaments in India. A list of BAI administered tournaments sponsored by the Complainant is as under:

Dates	Tournament Title	Venue
23 Feb - 29 Feb 2020	Yonex Sunrise 44th Indian Masters (veteran) National Badminton Championships – 2019-20	Jaipur
18 Feb - 23 Feb 2020	Yonex-Sunrise All India Senior Ranking Badminton Tournament	Bareilly
21 Jan - 26 Jan 2020	Yonex-Sunrise All India Junior Ranking Badminton Tournament 2020	Bangalore
14 Jan - 19 Jan 2020	Yonex-Sunrise All India Senior Ranking Badminton Tournament	Mapusa, Goa
10 Jan - 15 Jan 2020	Yonex-Sunrise All India Junior Ranking Badminton Tournament	Chandigarh,
10 Jan - 15 Jan 2020	Chandigarh Junior National Ranking Tournament	Chandigarh
07 Jan - 12 Jan 2020	Yonex-Sunrise All India Senior Badminton Tournament 2020	Bengaluru

A representative list of sport events co-sponsored/ partnered by the Complainant in India is as under:

Title/ Event	Year
Yonex Sunrise India Open 2009	2009
Yonex Sunrise India Open 2010	2010
Yonex-Sunrise India Open 2011	2011
Yonex Sunrise India Open 2012	2012
Yonex Sunrise India Open 2013	2013
Yonex- Sunrise India Open 2014	2014
Yonex Sunrise India Open 2015	2015
Yonex Sunrise India Open 2016	2016
Yonex Sunrise India Open 2017	2017
Yonex-Sunrise Dr. Akhilesh Das Gupta India Open 2018	2018
Yonex Sunrise India Open 2019	2019

In addition to the above, the Complainant has signed up/sponsored the following Indian sports personalities

Player Name	Year of Signing	Achievement
Saina Nehwal	2013	Ms. Nehwal is the Bronze medalist of the 2012 London Olympics (Women's singles) and Gold medalist at the Commonwealth Games (2010 and 2018), women's single titles.
P.V. Sindhu	2016-2019	Ms. Sindhu is the silver medalist at the 2016 Olympic Games, Brazil (women's singles title) and at the 2018 Asian Games, Jakarta (women's singles title).
Ankita Raina	2014	Ms. Raina is the No. 1 ranked Indian female tennis player.
H. S. Prannoy	2017	World No. 27 ranked Badminton player (as per BWF world ranking men's singles on October 01, 2020).


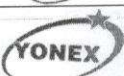

The Complainant's business under the YONEX brand have been the focus of media attention and have featured in news articles in popular sports magazines in various countries of the world. The Complainant also regularly issues press releases to keep its customers informed about the developments of its brand and business and about the existing and newly introduced products/ services under the YONEX brand. The Complainant and the YONEX brand have been bestowed with numerous awards and recognitions.

The Complainant submits that reputation of a mark is not limited by geographical boundaries and due to ease of communications and travel, reputation also travels

crossing such boundaries. Accordingly, Indians are not only aware of the YONEX brand, a large number of foreigners from U.S.A., UK, Germany, Japan, China and other countries of the world where the Complainant sponsored events are hosted visit India every year and bring to India its reputation and their familiarity of the YONEX brand. Further, a large number of Indians travel every year to U.S.A., UK, Germany, Japan, China and other countries where the Complainant has operations under YONEX brand and bring back the knowledge, reputation and goodwill attached to the same.

Accordingly, the Complainant submits that it has exclusive statutory and common law rights in its YONEX brand. By virtue of the said rights, long-standing use, the YONEX brand has gained recognition, valuable goodwill and reputation not only internationally but also in India and is distinctive of and exclusively identified with the Complainant. Accordingly, the YONEX brand is exclusively identified with the Complainant and is well-known.

The Complainant has also enforced rights in the YONEX brand diligently by filing oppositions, sending cease and desist notices and initiating legal actions in India. Some oppositions filed by the Complainant are as under:

Mark Opposed	Trademark No.	Class	Outcome
SATKAR YONEX	604243	6	Application abandoned
YONEX	682273	12	Application abandoned
Y O N E X	817204	14	Application abandoned
	1141625	6	Application abandoned
	1541350	6	Application abandoned
YONEX	1616025	11	Application withdrawn
DONEX	2989780	28	Application abandoned
YOVVEX/  BATHROOM FITTINGS	4413631	11	Opposed
TONEX	4431928	24	Opposed

5. The website corresponding to the disputed domain name

The Complainant submits that it recently became aware that the disputed domain name is registered by the Respondent. An Internet search reveals that a parking page is available on the web-link www.yonex.in and this contains URLs/ hyperlinks that redirect Internet traffic/users to third party websites, which have no relation/ connection with the Complainant and on which third-party branded badminton

equipment, rackets and related sports gear i.e. identical to the goods which are sold by the Complainant under its YONEX brand are being offered for sale.

6. Grounds for Complaint

The Complainant's contentions are as under:

- i. The Complainant states that it is the registered proprietor of the trademark YONEX and variations thereof in several jurisdictions across the world, including in India, and has been continuously and exclusively using its trademark/corporate name YONEX in relation to its business since at least 1974, i.e., nearly forty (40) years/ 4 decades prior to the date on which the Respondent registered the disputed domain name. By virtue of long-standing use, registrations, recognition and extensive promotion, the YONEX mark qualifies as a well-known mark and deserves protection as such.

The disputed domain name comprises of the Complainant's registered and well-known trade mark YONEX in toto and is therefore identical to the Complainant's trademark and corporate name as well as its domain names incorporating YONEX, including <yonex.com>, <yonex.co.jp> and <yonex.cn>, corresponding to which the Complainant hosts websites for many years. The Complainant submits that the fact that if the disputed domain name entirely incorporates the Complainant's trademark, this is sufficient to establish confusing similarity. This is well-settled and has been held and reiterated in various cases by the respective Panels including in Akshaya Pvt. Ltd. v. Mr. Prabhakar Jeyapathy, (INDRP/ 277), G.A. Modeline S.A. v. Naveen Tiwari, (INDRP/ 082) and L'Oreal v. Zeng Wei <loreal-paris.in>, (INDRP/ 342).

Further, the Complainant states that it has produced copies of trademark registrations for the mark YONEX and various formatives thereof, in various jurisdictions of the world, including in India. It is a well-settled principle, through various decisions under the INDRP, that submitting proof of trademark registrations is prima facie evidence of enforceable rights in a trademark. Reliance is placed on TransferWise Ltd. vs. Li, Chenggong INDRP/1122, Perfetti Van Melle Benelux BV vs. Lopuhin Ivan, IPHOSTER, WIPO Case No. D2010-0858, Backstreet Productions, Inc. vs. John Zuccarini, WIPO Case No. D2001-0654).

The Complainant further submits that the Indian country-specific generic top level domain ".in" is an essential part of the disputed domain name and cannot be said to distinguish the disputed domain name <yonex.in> from the

Complainant's prior registered and well-known trademark YONEX. Reliance is placed on LEGO Juris A/S vs. Robert Martin (INDRP/125); Starbucks Corporation d.b.a Starbucks Coffee Company vs. Mohanraj (INDRP/118); AB Electrolux v. GaoGou of Yerec, (INDRP/ 630); and Dell Inc. v. Mani Soniya (INDRP/753).

The Complainant states that as the disputed domain redirects to a parked page displaying advertisements/ links to badminton equipment, rackets and related sports gear, which are the primary products in relation to which the Complainant uses the mark YONEX and variants thereof, confusion is bound to happen.

Accordingly, the Complainant submits that the disputed domain name is identical and confusingly similar to the Complainant's trademark, corporate name and prior registered domain names incorporating YONEX.

- ii. The Complainant submits that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has not authorized, licensed or otherwise allowed the Respondent to make any use of its registered trademark, trade and corporate name YONEX, and the Respondent does not have any affiliation or connection with the Complainant nor to the Complainant's products/ services under the name/mark YONEX (including any variations thereof). This constitutes prima facie proof in favour of the Complainant under Paragraph 4(b) of the Policy – that the Respondent does not have any rights or legitimate interests in the disputed domain name. Further, the Respondent cannot assert that it is using the domain name in connection with any bona fide offering of goods and services in accordance with Paragraph 6(a) of the INDRP, as it is not operating any website corresponding to the disputed domain but rather is hosting a parked page reflecting URLs of third party website(s) which have no connection/ relation to the Complainant.

The Respondent is not commonly known by the name YONEX within the meaning of Paragraph 6(b) of the Policy, nor does it appear to have been known as such prior to the date on which the Respondent registered the disputed domain name. Accordingly, the Respondent is not making any legitimate, non-commercial, or fair use of the disputed domain name. As per the WHOIS records, the Respondent is known by the name Maria R. Dempsey (based in US) and does not appear to have any rights or legitimate rights interests in the disputed domain name. Therefore, it appears that the Respondent has deliberately chosen to use the disputed domain name which is identical to the Complainant's well-known trademark/ domain name YONEX, so as to suggest a direct connection or affiliation with the Complainant and to create a direct affiliation with the Complainant and its business, when in fact there is none. Hence, registration of

the disputed domain by the Respondent appears to be a blatant attempt to encash upon the Complainant's goodwill and reputation under the YONEX name and mark. Further, such confusion is greatly enhanced by the fact that the Respondent is using the disputed domain name in connection with a parked page displaying advertisements/ commercial links/ sponsored content for badminton equipment, rackets and related sports gear which is identical to the Complainant's goods sold/ marketed under the name/ mark YONEX. Accordingly, the Respondent cannot assert that she is making legitimate, non-commercial or fair use of the domain name, in accordance with Paragraph 6(c) of the INDRP. In fact, any use of the disputed domain name by the Respondent in relation to any goods and/ or services is likely to create a false association and affiliation with the Complainant, and its well-known YONEX mark. There is no plausible or legitimate justification for the Respondent's registration of the disputed domain name which is identical to the Complainant's YONEX name and mark.


Therefore, the Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed impugned domain name and is incapable of making a legitimate, non-commercial or fair use of the domain name in accordance with the Policy.

- iii. The Complainant submits that as per Paragraph 7 of the Policy, "bad faith" registration and use of a domain name can be established inter alia by showing circumstances indicating that the Respondent has intentionally attempted to attract Internet users to its 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.

The Respondent has is not hosting any website on the disputed domain name but hosts a parking page therein, which contains URLs that redirect Internet users to third party websites that have no connection to and are not affiliated with the Complainant. The Respondent therefore appears to be using the disputed domain name solely to redirect Internet traffic/ users to a different online location (being third party websites), inter alia by creating a likelihood of confusion with the Complainant's trademark YONEX.

The Complainant submits that that the URLs/ hyperlinks depicted/ embedded on the parked page at www.yonex.in redirect the Internet traffic/ users to direct competitors of the Complainant, which are engaged in the business of selling identical goods, i.e., sports equipment, inter alia, badminton rackets. This redirection of internet traffic is causing loss of business to the Complainant and

these are likely generating pay-per-click revenue for the Respondent. It is a well settled principal under the Policy that use of the disputed domain name "to redirect the internet users to a competitor's website" is a circumstance indicative of bad faith registration and use. Reliance is placed on B9 Beverages SPRL vs. Mr. Sandeep Kumar, INDRP/1136; Safelite Group, Inc. v. Will Reed (WIPO Case No. Case No. D2019-1081; WIPO Case No. D2005-0313; Lauderdale Graphics Corporation v. Jason Forth, WIPO Case No. D2008-0453).

It is further submitted that several other URLs/ hyperlinks embedded/ depicted on the web-page www.yonex.in incorporate the Complainant's mark YONEX in toto and redirect to another website that appears to be offering for sale/ selling products/ sports equipment under the Complainant's YONEX mark and is misusing the Complainant's mark and artistic work . The said website has not been authorized by the Complainant, their unauthorized/ unsolicited advertisement/ sale of products under the mark YONEX is bound to cause loss of business to the Complainant, and further the entity/ website could possibly be dealing in (or use their unauthorized channels of sale to deal in) counterfeit YONEX products which could further damage the goodwill and reputation vested in the Complainant's YONEX branded products. Further, the Respondent's aforesaid conduct indicates its opportunistic behavior and it cannot assert that the disputed domain name is being used with respect to any bona fide offering of goods or services. Such opportunistic conduct is indicative of bad faith under Paragraph 7(c) of the Policy.

In consideration of the fact that the Complainant operates its business globally and has been carrying out active commercial use of its trade mark YONEX (and variations thereof) inter alia through sale of its YONEX branded sports gear and merchandise via an extensive retail network globally as well as by hosting its ubiquitous and active websites, it submits that the Respondent had constructive notice of the Complainant's aforesaid trademarks/corporate name and domain names, as well as its reputation in the same.

Further, the Complainant's business in the United States, where the Respondent is based (as per the WHOIS information available), dates back to at least as early as 1983 and as on date, it has more than 900 authorized retailers of its YONEX branded products in the United States of America. The website www.yonexusa.com is operational and the corresponding domain name was registered on February 23, 2001, i.e., more than a decade prior to Respondent's registration of the disputed domain <yonex.in>. Therefore, the Respondent, also being based in the United States, cannot assert that she has no knowledge of the

Complainant's operations under the trademark/ corporate name YONEX. It is settled principle under the Policy that a deliberate use of a well-recognized mark to attract unsuspecting users to the Respondent's site, based on awareness of the trade mark, is indicative of bad faith registration. Reliance is placed on Lego Juris v. Robert Martin, INDRP/ 125; Caesars World, Inc. v. Forum LLC (WIPO Case No. D2005-0517); HUGO BOSS Trade Mark Management GmbH & Co. KG, HUGO BOSS AG v. Dzianis Zakharenka, (WIPO Case No. D2015-0640).

The Respondent has no reason to adopt the disputed domain name except to create a deliberate and false impression in the minds of consumers that the Respondent is somehow associated with or endorsed by the Complainant, and to thereby intentionally ride on the massive goodwill and reputation associated with the Complainant and to unjustly gain enrichment from the same.

The Complainant submits it is a well-settled principle under the Policy that registration of a domain name that incorporates a well-known mark by an entity that has no relationship to the mark is evidence of bad faith. Reliance is placed on The Ritz Carlton Hotel Company LLC vs. Nelton! Brands Inc., INDRP/ 250, Make-up Art Cosmetics Inc. vs. Doublefist Limited, INDRP/1094, Wells Fargo & Co. and Anr. vs. Krishnna Reddy, INDRP 5810060; QRG Enterprises Limited & Anr. vs. Zhang Mi, INDRP/852. As the YONEX name and mark is well-known in India, it is established that the Respondent's use of a domain name incorporating the mark YONEX in toto is in bad faith.

Lastly, the Complainant submits that based on a reverse WHOIS search, the Respondent appears to be a serial domain squatter and has a history of registering domain names similar to or comprising of various notable trademarks/ corporate names, including but not limited <netgear.in> and <standardbank.co.in>. In this regard, a reverse WHOIS search report for the Respondent, can be accessed at the URL <https://viewdns.info/reversewhois/?q=Maria+R.+Dempsey>. Multiple domains registered by the Respondent have been subject matter of prior domain dispute cases under the Policy and have accordingly been duly dealt with by prior Panels in favour of the Complainants including in INDRP/422 and INDRP/415.

In view of the above, the Complainant submits that it is evident that the Respondent is a serial infringer who is in a habit of registering domains incorporating third party trademarks in bad faith and with the intention of cashing upon their goodwill and reputation for illegal profit. The continued ownership of the disputed domain by the Respondent, despite not having any

legitimate or fair reason to do so, is preventing the Complainant from reflecting its trademark in the impugned domain name, in which the Complainant has rights. In view of the above, the element indicative of bad faith as stipulated under Paragraph 7(b) of the Policy has stands established and hence Respondent's registration of the disputed domain name is contrary to the provisions of Paragraph 4(c) of the Policy.

7. **Respondent's default**

Despite notice of the present proceeding in terms of the Rules and an opportunity to respond, no response has been received from the Respondent by the Arbitrator.

8. **Discussion and Findings**

The Arbitrator has reviewed the Complaint and the Annexures filed by the Complainant as well as the decisions cited by the Complainant. The Arbitral Tribunal has been properly constituted.

The Policy requires that the Complainant must establish three elements *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. These are discussed hereunder:

(i) **Identical or Confusingly Similar**

As regards this the first element, the Complainant has established that it has rights in the YONEX name and mark. The Complainant has been using YONEX as a trademark and trade/corporate name since 1974. Its products under the YONEX brand are sold/offered in several countries including in India. The Complainant has advertised and promoted the YONEX brand, has sponsored numerous sporting events under the YONEX brand and has signed up several sports personalities as brand ambassadors. The YONEX marks are registered in several countries including in India under nos. 362564, 362563, 362562, 1492699 and 3679748 in various classes. The Complainant has also enforced its rights in the YONEX brand by filing oppositions. It has also been held to be well-known by the IPAB and is recognized as a well-known brand in Japan.

There is no dispute as to the Complainant's ownership of its registered and well-known trademark YONEX.

The Arbitrator notes that the disputed domain name is YONEX.IN i.e., the disputed domain name wholly incorporates the Complainant's YONEX brand. It has been routinely held that when a domain name wholly incorporates a complainant's registered mark, this is sufficient to establish identity or confusing similarity. It is also settled that for the purpose of comparing a trademark with a disputed domain name, the country code top-level domain (ccTLD) can be excluded.

The Arbitrator accordingly finds that the first element is satisfied and that the disputed domain name is virtually identical and confusingly similar to the Complainant's registered trademark.

(ii) Rights or Legitimate Interests

As regards the second element, the Complainant must establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name. With respect to this requirement, a complainant is generally required to make a prima facie case that a respondent lacks rights or legitimate interests and once such prima facie case is made, the burden of proof shifts to the respondent to come forward with evidence demonstrating rights or legitimate interests in the disputed domain name. Paragraph 6 of the Policy contains a non-exhaustive list of the circumstances which, if found by the Panel to be proved, shall demonstrate the respondent's rights or legitimate interests to the disputed domain name.

Based on the undisputed contentions made by the Complainant as stated above, it has made a prima facie case that none of these circumstances are found in the case at hand and therefore, the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent is not commonly known by the disputed domain name, nor authorized by or connected with the Complainant. There is no relationship between the Complainant and the Respondent that would give rise to any license, permission, or authorization by which the Respondent could own or use the disputed domain name. There is no evidence that Respondent is using the disputed domain name for a *bona fide* offering of goods or services. Rather, the Respondent is trying to associate itself with the Complainant with the intent to ride upon the goodwill and reputation of the Complainant's YONEX brand and unduly gain therefrom. Such adoption and use of the disputed domain name is likely to confuse the trade and public that any services under the disputed domain name are being provided by the Complainant, which is not the case.

It is also been held that if the respondent fails to come forward with relevant evidence, the Complainant is deemed to have satisfied the second element. See Volkswagon AG v. Nowack Auto und Sport – Oliver Nowack WIPO Case No. D2015-0070 and OSRAM GmbH. v. Mohammed Rafi/Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org WIPO Case No. D2015-1149.

Since the Respondent in the present case has failed to come forward, the Arbitrator finds that the Respondent has no rights or legitimate interests in the disputed domain name.

(iii) Registered or Used in Bad Faith

As regards the third element of bad faith, based on the contentions of the Complainant describing its extensive registrations of the YONEX brand, long standing use thereof and associated business, the Arbitrator accepts that the YONEX brand is well-known and exclusively associated with the Complainant. Its rights significantly predate the registration of the disputed domain name by the Respondent. Therefore, it is the view of the Arbitrator that the Respondent was clearly aware of the Complainant's YONEX brand at the time of registration of the disputed domain name and has sought to create a misleading impression of association with the Complainant in its choice of the disputed domain name. This supports a finding of bad faith. See Starbucks Corporation v. Registration Private, Domains by Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico, WIPO Case No. D2019-1991. The Arbitrator accepts the Complainant's contention that an average Internet user will believe that the disputed domain name is owned by the Complainant and relates to sale of its goods in India; such users may end up looking for a website to which the disputed domain name resolves. The fact that other URLs/ hyperlinks embedded/ depicted on the web-page www.yonex.in incorporate the Complainant's YONEX mark and redirect to other sites that appear to be offering for sale/ selling products/ sports equipment under the Complainant's YONEX mark, which could be counterfeit YONEX products, is opportunistic bad faith on part of the Respondent. This cannot confer any legitimacy to the Respondent and is indicative of bad faith on part of the Respondent. By registering the disputed domain name, the Respondent has sought to create a misleading impression of association with the Complainant, to ride on the goodwill and reputation of the Complainant and to gain therefrom. Further, the Arbitrator accepts that the disputed domain name is not being used in relation to a bona fide offering

of goods or services and the Respondent is not making legitimate or fair use of the disputed domain name. The Arbitrator also accepts that the Respondent has registered the disputed domain name to prevent the Complainant from owning the same. Thus, the Arbitrator concludes that the Respondent's conduct constitutes bad faith registration or use of the disputed domain name within the meaning of the Policy.

The Arbitrator has reviewed the reverse WHOIS search at <https://viewdns.info/reversewhois/?q=Maria+R.+Dempsey> and the decisions in INDRP/422 and INDRP/415. It can be said that the Respondent is a habitual squatter engaged in a pattern and practise of registering and using/offering for sale domain names corresponding to well-known trade names or marks of third parties - which strengthens the inference of bad faith.

Thus, the Arbitrator concludes that the Respondent's conduct constitutes bad faith registration or use of the disputed domain name within the meaning of the Policy.

Accordingly, the Arbitrator finds that the Complainant has established all three elements as required by the Policy.

9. Decision

For all the foregoing reasons, the Complaint is allowed and it is hereby ordered in accordance with paragraph 10 of the Policy that the disputed domain name be transferred to the Complainant. There is no order as to costs.

This award has been passed within the statutory deadline of 60 days from the date of commencement of arbitration proceeding.



Punita Bhargava

Sole Arbitrator

Date: May 1, 2021