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Unique Doc. Reference : SUBIN-CHCHIMPSP0762089689522186T
Purchased by : RAJESH KUMAR
Description of Document : Article 12 Award
Property Description : Not Applicable
Consideration Price (Rs.) : 0
(Zero)
First Party : SAJAL KOSER
Second Party : Not Applicable
Stamp Duty Paid By : SAJAL KOSER
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ARBITRATION AWARD

BEFORE SH. SAJAL KOSER, SOLE ARBITRATOR, CHANDIGARH

INDRP CASE NO. 1427 OF 2021

DISPUTED DOMAIN NAME: JIMMYJOHNS.IN

KC 0005209057

Statutory Alert:

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Jimmy John's Enterprises, LLC, 2212 Fox Drive, Champaign, Illinois 61820,
United States of America.

...Complainant

Versus

Dingcorp, DingDing, A3, JiaZhao Ye, JiangBei, Huicheng District, HuiZhou,
GuangDong, China.

...Respondent

1. INTRODUCTION

The above titled complaint was submitted to the undersigned for Arbitration in accordance with the INDRP Policy and rules of procedure.

2. THE PARTIES

A. The Complainant

As per the complaint, the Complainant in this dispute is Jimmy John's Enterprises, LLC, a limited liability company organized and existing under the laws of the State of Delaware, of the address 2202 Fox Drive, Champaign, Illinois 61820, United States of America.

The Complainant's authorized representative in this administrative proceeding is:

Vikrant Rana,

S.S. Rana & Co., Advocates

Email: inf@ssrana.com

B. The Respondent

The details of the Respondent mentioned in the Complaint is that according to the .IN Registry WHOIS database, the contact details of the registrant are privacy protected/hidden. Upon

filing this domain complaint, it was revealed by NIXI that the said domain name is registered in the name of Dingcorp, DingDing at the address, A3, JiaZhao Ye, JiangBei, Huicheng District, HuiZhou, GuangDong, China. Copy of the complete WHOIS details as received from NIXI is annexed and marked as Annexure C-2 with the Complaint. The said Registrant is hereinafter referred to as the "Respondent".

The available data mentioned on the WHOIS database with respect to the disputed domain name is as below:

Domain ID: DB5AEC4E14CAC4B4E925FF93030C45A21-IN
Creation Date: December 31, 2020
Expiration Date: December 31, 2022
Registrant Organization: Dingcorp, DingDing
Registrant Address: A3, JiaZhao Ye, JiangBei,
Huicheng District, HuiZhou,
GuangDong, China.

3. **THE REGISTRAR WITH WHICH THE DOMAIN NAME IS REGISTERED AS:**

Registrar: Dynadot LLC

Address: 210 S Ellsworth Ave #345 San mateo, CA 94401 US

4. **PROCEDURAL HISTORY**

- i) Vide mail dated 24.08.2021, the undersigned was appointed as an Arbitrator by National Internet Exchange of India (NIXI) to adjudicate and decide upon the dispute relating to the Domain name JIMMYJOHN'S.IN.



- ii) Along with the mandate, undersigned also received copy of the Complaint with Annexures.
- iii) As required, the undersigned vide mail dated 27.08.2021, sent Statement of Acceptance and Declaration of impartiality and independence as an Arbitrator in the present Dispute.
- iv) Simultaneously, Notice to the Respondent as prescribed in the INDRP Rules of Procedure was issued vide mail dated 27.08.2021.
- v) Further, vide mail dated 08.09.2021 received from the Complainant, the service of Complaint upon the Respondent via Courier on 06.09.2021 and via email on 01.09.2021 was confirmed.
- vi) The Respondent did not file any response or reply to the complaint within the stipulated period of 15 days from the date of receipt of notice as well as even after the receipt of the copies of Complaint and Annexures from the Complainant.
- vii) In the interest of justice vide mail dated 23.09.2021, 3 more days as last opportunity, was given to the Respondent to file reply, if any, failing which the case will be decided ex-parte on the basis of pleadings and documents on record.
- viii) Since, the Respondent did not file any reply or response to the complaint, therefore, vide mail dated 02.10.2021, the right of the Respondent to file reply was closed by order and the matter was reserved for passing an award.



5. CASE OF THE COMPLAINANT, BRIEF HISTORY AND DISPUTE

Complainant has stated that:

- i) Complainant Jimmy John's Enterprises, LLC is a Limited Liability Company incorporated under the Laws of Delaware, USA and is an American sandwich restaurant chain/franchise operating under the name JIMMY JOHN'S and its variations and the Complainant herein includes its parent company Inspire Brands, Inc., subsidiary companies, licensees, franchisees, sub-franchisees, distributors, associates and affiliates.
- ii) The Complainant Company was founded by Jimmy John Liautaud in 1983 and headquartered in Illinois, USA. The Complainant under the name Jimmy John's Enterprises, LLC was incorporated in Delaware on November 29, 2006 and the mark Jimmy John's was adopted by it as a company name, trade name as well as a trade mark for its goods/services at least as early as the year 1983. Copy of the Incorporation Certificate of the Complainant is annexed and marked as Annexure C-3 with the Complaint. As per the Complainant, presently, it has over 2700 locations operating in the United States of America.
- iii) The Complainant has registered the top-level domain name www.jimmyjohns.com from where it is operating an interactive e-commerce website. The said website show cases information about Jimmy John's history and achievements as well as its goods/services under the trademark Jimmy John's and variations thereof. The said website is accessible globally

and can be viewed by persons all over the world. Snapshots of the website pages of the Complainant prominently displaying the name/mark Jimmy John's have been pasted as part of the complaint.

- iv) The complainant further states that the domain Jimmy John.com was registered on August 14, 1997 and in support of this contention placed on record the Snapshot of the WHOIS results of Jimmy John.com annexed and marked as Annexure C-4.
- v) The Complainant further pleaded in the Complaint that it has also applied for and obtained registration for the trademark Jimmy John's vide US Registration No. 1702263 dated March 18, 1991 for class 42. And that the said registration was filed claiming use since January 13, 1983. Copy of the relevant extract from the United States Patent and Trademark Office is also placed on record as Annexure C-5. Thereafter, the complainant obtained registrations over its trade mark Jimmy John's and variations thereof in other jurisdictions of the world such as Australia, Canada, the European Union, Mexico, Israel, Malaysia, New Zealand, Singapore, Philippines, India, etc. By virtue of such registrations the Complainant has the exclusive statutory right to the use of the trade mark Jimmy John's and variants thereof in the countries where they are registered. A list of the Complainant's world-wide registrations for the marks Jimmy John's and variants thereof has been mentioned in tabular form by the complainant in Para 4 of the complaint and

copies of the relevant Registration Certificates have been annexed as Annexure C-6 (colly).

- vi) It is also the Case of the Complainant that with specific reference to India, Jimmy John's owns several registrations for the mark Jimmy John's and variation thereof and the details of the same are mentioned in para 5 and copies of corresponding registration certificates have been annexed as C-7. It is also stated by the complainant that aforesaid trade mark registrations are valid and subsisting as on date and because of the said registration, Complainant has the exclusive statutory right to use the said trade mark in India in request of the goods/services for which it has been registered.
- vii) According to the complainant, the first restaurant was opened in a garage in Charleston, Illinois, USA on January 13, 1983 and subsequently, with the increase of business more restaurants were opened and presently there are now over 2700 physical Jimmy John's restaurants operating in the United States.
- viii) As per the Complaint, the complainant owns and operates restaurants under the JIMMY JOHN'S brand (Jimmy John's Restaurants) and grants franchises to restaurants to operate under same brand (also Jimmy John's Restaurants). The complainant has vendors who produce food products branded with packaging exclusively for their franchisees under the Jimmy John's brand and provide catering and food delivery services through their franchises and company owned stores under the Jimmy John's brand. Jimmy John's Restaurants are

generally located in strip shopping centers, shopping malls and free-standing units, selling prepared food and meals, gourmet deli sandwiches, fresh-baked breads and other food and beverage products. In addition, Jimmy John's Restaurants provide carry-out, delivery and on-premises dining services.

- ix) The Complainant has further stated that it maintains quality control over the goods and services being produced and provided by Jimmy John's Restaurants including franchised Jimmy John's Restaurants. The Complainant has plans to expand and develop the Jimmy John's brand, restaurants and franchises internationally.
- x) It is also case of the Complainant that Jimmy John's is the key and prominent portion of the Complainant's trading name/corporate name and is also the key brand. Since 1980s, the Complainant has build the reputation of Jimmy John's brand as manufacturer and supplier of world's greatest gourmet sandwich by offering fresh, good quality, low cost, sandwiches in the restaurant and initially taking to the streets with armfuls of free sandwiches for college students. The Jimmy John's brand was first used in conjunction with restaurant services and food and beverages when the first Jimmy John's restaurant opened on January 13, 1983 in Charleston, Illinois, United States.
- xi) It is also mentioned in the Complaint that Complainant's worldwide annual sales figures in respect of its various products sold under the trade mark Jimmy John's have been

increasing each year. For example, in 2010 Jimmy John's total annual turnover was more than USD 700,000,000.00. In recent year, annual revenues exceed 1 billion USD.

- xii) It is further case of the Complainant that the Complainant's goodwill and reputation in the trade mark Jimmy John's and variations thereof have not come from sales alone. Tens of millions of US dollars are spent each year promoting its trade marks by means of national and trans-national advertizing. In support of these above contention, the complainant has placed on record documents annexed as Annexure C-8 (colly).
- xiii) Complainant has also mentioned that Jimmy John's has also been part of various promotional and sponsorship activities relating to international events including NASCAR (since 2009) and various race car drivers like Dustin Whal Racing, Kevin Weaver Racing, Nick Mancuso Racing, Brock Lesner (mixed material arts fighter and former champion of the UFC's Heavyweight Division), and other events such as Snowmobile racing, Freaky Fast 500, Freaky Fast Flash, POP Kits as well as a sandwich auction. Complainant also mentioned about launching of Jimmy John's Sandwiches App in year 2015 and the print out of Complainant's Restaurants, Website, Mobile App showing complainant's goods/services bearing the mark Jimmy John's have been placed on record as Annexure C-9.
- xiv) It is also the case of the Complainant that over the years, the Complainant and its trade marks Jimmy John's have been advertised in wide variety of print and electronic media for

promotion throughout the world. Wide publicity has also been done through magazines, catalogues, brochures and other promotional material. Many Articles have been written and the details of some of the news articles published in Newspaper, Magazines etc. have been mentioned in para 2 and the copies are annexed as Annexure C-10 respectively.

- xv) The Complainant further stated that its products/services under the mark Jimmy John's have gained immense popularity among consumers around the world. The Complainant is also present on and connects with its customers worldwide through various popular social networking websites such as Facebook, Instagram and Twitter. Details of the Complainant's social media accounts under the name Jimmy John's are as under:

Complainant's Social Media Likes/Followers as on June 15, 2021	
Facebook	Over 33,67,561 likes
Instagram	Over 143 k followers
Twitter	Over 1452.4 k followers

The likes and followers on the Complainant's said social media accounts increase daily. In modern times, the number of likes and followers of an entity on social media websites have become the benchmarks to ascertain its popularity among with the masses. Copies of pages from the social media websites have been annexed as Annexure C-11 (colly) with the Complaint.



- xvi) It is further case of the Complainant that it strives for efficiencies along with their suppliers in food packaging transportation and material. Each year, the industry publication Nation's Restaurant News issues a ranking of the largest restaurant chains and companies. As per this ranking, Jimmy John's is one of the fastest growing chains in the world. The Complainant along with their suppliers, have been bestowed by various awards and certificates since 1999, which have been mentioned in para 16 of the Complaint. The Complainant has also mentioned qua various philanthropic and charitable activities.
- xvii) It is also the case of the Complainant that it considers its name and trade mark Jimmy John's and its variations as its valuable intellectual property and makes every effort to protect the same. Protection of Jimmy John's trademarks extends beyond registration activities to enforcement actions, which range from opposing trade mark applications for the same or similar trademarks, filing domain name complaints and commencement of legal action in a court of law, if necessary.
- xviii) Complainant further states that Jimmy John's is not only the trade mark and trade name of the Complainant, but it is its trading style as well as its House Mark. By virtue of the prior adoption, long standing and uninterrupted use, extensive publicity and Complainant's proprietary rights in its trade mark and name Jimmy John's and variations thereof, both under common law and statutory protection, the said trade mark has

acquired a high degree of distinctiveness and are identified by the market and general trade and public as exclusively belonging to the Complainant and its goods/services and have acquired a significant reputation amongst the trade and public.

- xix) Finally, in its brief history, achievements and exclusive ownership as well as use of mark Jimmy John's, Complainant submitted that as a result of the above described extensive use and promotion, the Complainant's marks Jimmy John's and variations thereof have become distinctive and well known and have enjoyed distinctiveness, goodwill and reputation long prior to the date on which the Respondent registered the disputed domain name.

6. DISPUTE AND GRIEVANCE OF THE COMPLAINANT

- i) The dispute arose when it was recently brought to the Complainant's notice that a domain name, namely <JIMMYJOHNS.IN> was registered on December 31, 2020 by the Respondent, located in California, USA. An internet search revealed a parked page at the domain <JIMMYJOHNS.IN> hosting pay-per click advertisements displaying links to restaurant/online food delivery services belonging to the Complainant's direct competitors. Relevant snapshot of the impugned webpage has been pasted in para 21 of the Complaint.
- ii) As the said domain name is phonetically, visually, conceptually identical to the Complainant's trade mark Jimmy John's, domain name www.jimmyjohns.com and also its corporate

names Jimmy John's Enterprises, LLC, Jimmy John's Franchise, LLC, the Complainant is constrained to file the present complaint, in order to safeguard its valuable Intellectual Property rights.

7. LEGAL GROUNDS AND CONTENTIONS OF THE COMPLAINANT

i) The domain <JIMMYJOHNS.IN> is identical and/or confusingly similar to the complainant's trade mark Jimmy John's in which the Complainant has rights.

a) According to the Complainant, the Complainant is the proprietor of the trademark Jimmy John's in the United States (where the Respondent is situated) and in numerous countries in the world and has been continuously and exclusively using the same in relation to its business since at least as early as 1983 i.e. almost 40 years prior to the date on which the Respondent registered the domain <JIMMYJOHNS.IN>. By virtue of its long-standing use and registrations, the complainant's trademarks Jimmy John's qualifies to be a well known mark.

b) The impugned domain name <JIMMYJOHNS.IN> is comprised of the Complainant's trade mark JIMMY JOHN'S in toto. Therefore, the domain name <JIMMYJOHNS.IN> is visually, phonetically, conceptually, deceptively and confusingly identical/similar to complainant's corporate and trade names Jimmy John's Enterprises, LLC, Jimmy John's Franchise, LLC, trade mark

JIMMY JOHN'S and the complainant's domain <JIMMYJOHNS.COM>.

- c) Given the identity of the impugned domain name <JIMMYJOHNS.IN> with the complainant's name and mark JIMMY JOHN'S, the same is bound to cause confusion and deception in the minds of the public that Respondent has some connection, association or affiliation with Complainant, when it is not so. It has been held by prior panels deciding under the INDRP that there is confusing similarity where the disputed domain name wholly incorporates the complainant's trade mark such as *Kenneth Cole Productions Vs Viswas Infomedia INDRP/093*. Further, a TLD/ccTLD such as ".IN" is an essential part of domain name. Therefore, it cannot be said to distinguish the Respondent's domain name <JIMMYJOHHNS.IN> from the Complainant's trademark JIMMY JOHN'S. This has been held by prior panels in numerous cases, for instance in *Dell Inc. Vs Mani, Soniya INDRP/753*.
- d) The Complainant also placed Reliance on an earlier decision in *INDRP case no. 705 titled M/s Retail Royalty Company Vs Mr. Folk Brook* wherein on the basis of the Complainant's registered trademark and domain names for "AMERICAN EAGLE", having been created by the complainant much before the date of the disputed

domain name <AMERICANEAGLE.CO.IN> by the Respondent, it was held that,

"The disputed domain name is very much similar to the name and trademark of the Complainant. The Hon'ble Supreme Court of India has recently held that the domain name has become a business identifier. A domain name helps identify the subject of trade or service that an entity seeks to provide to its potential customers. Further that there is a strong likelihood that a web browser looking for AMERICAL EAGLE products in India or elsewhere would mistake the disputed domain name as of the Complainant."

According to the Complainant, in the present dispute as well, the Complainant has acquired rights in the trade mark JIMMY JOHN'S by way of trademark registrations and by virtue of use as part of its company and domain names since much prior to the date on which the Respondent created the impugned domain <JIMMYJOHNS.IN> incorporating the Complainant's identical company name, trade mark and trade name Jimmy John's in toto.

- e) Complainant further contents that this evident identify between the Respondent's domain name and the Complainant's marks, domain names and company name incorporating JIMMY JOHN'S is likely to mislead, confuse

and deceive the Complainant's customers as well as the general lay public as to the source, sponsorship, affiliation or endorsement of the Respondent's domain name. As evidenced in the preceding paragraphs, Complainant's rights over the marks JIMMY JOHN'S predate the Respondent's registration of the impugned domain <JIMMYJOHNS.IN> by almost 40 years, which as per the WHOIS records, was only registered/created on December 31, 2020.

- f) Complainant also submits in the Complaint that the identity between the Complainant's mark JIMMY JOHN'S and the domain <JIMMYJOHNS.IN> is grossly exacerbated by the fact that the Respondent is using the domain for a parked page displaying links to competing restaurants/online food delivery services, which are the primary products in relation to which the complainant uses the mark JIMMY JOHN'S and variants thereof.

And therefore, the conditions under the INDRP Paragraph 4(a) stand suitable established.

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

- a) For the facts stated hereinabove, the Respondent has no right or legitimate interest in the domain name <JIMMYJOHNS.IN>. Complainant has not authorized the Respondent at any point of time to register the impugned domain name. Further, the Respondent

cannot assert that it is using the domain name in connection with a bonafide offering of goods and services in accordance with paragraphs 6(a) of the .IN Policy, as it is not operating any website from the impugned domain and is instead using the domain in connection with a parked page hosting commercial/sponsored links to restaurants/online food delivery services belonging to the Complainant's direct competitors. Such links cannot constitute a bonafide offering of goods and services. Reliance is placed on *case No. INDRP/481 L.Oreal Vs Yerect International Limited*.

- b) Complainant further submits that Respondent is not commonly known by the name JIMMY JOHN'S within the meaning of paragraph 6(b) of the Policy nor does it appear to have been known as much prior to the date on which Respondent registered the impugned domain name. Accordingly, Respondent is not making a legitimate, non-commercial fair use of the domain name. As per the relevant WHOIS records, Respondent in the present matter is known by the name **Dingcorp**. Therefore, it appears that Respondent has deliberately chosen to use the domain name <JIMMYJOHNS.IN>, which is phonetically, visually, conceptually, deceptively and confusingly identical to complainant's trademark, so as to suggest a direct connection or affiliation with Complainant's trade mark JIMMY JOHN'S and to create a

direct affiliation with Complainant and its business when in fact there is none.

c) The Complainant further mentions that the Respondent does not have any right or legitimate interest in the name JIMMY JOHN'S within the meaning of Paragraph 6(c) of the Policy. The Respondent is not making a legitimate, non-commercial or fair use of the domain name. It appears that the Respondent has deliberately chosen to use the domain name <JIMMYJOHNS.IN>, which is phonetically, visually, conceptually, deceptively and confusingly identical/similar to the Complainant's trademarks, prior domain names and corporate name, so as to suggest a direct connection or affiliation with the Complainant's trademark JIMMY JOHN'S and to create a direct affiliation with Complainant and its business when in fact there is none.

d) Further, as per the contents of complaint, such confusion is greatly aggravated by the fact that the Respondent is using the domain <JIMMYJOHNS.IN> in connection with a parked page displaying links to competing restaurants/online food delivery services which is identical/overlapping to the Complainant's area of business under the name/mark JIMMY JOHN'S accordingly. The Respondent cannot assert that they are currently making a legitimate, non-commercial or fair use of the domain name, in accordance with paragraph 6(c)

of the Policy. In fact, any use of the domain name <JIMMYJOHNS.IN> by the Respondent in relation to any goods and/or services is likely to create a false association and affiliation with the complainant, Jimmy John's and its well known trade mark JIMMY JOHN'S as well as its official website at JIMMYJOHNS.COM. Therefore, it is submitted that Respondent has no rights or legitimate interests in respect of the impugned domain name and is incapable of making a legitimate, non commercial or fair use of the domain name in accordance with Paragraph 6(c) of the Policy.

- e) It is also the contention of the Complainant that Respondent cannot assert that they are currently making a legitimate, non commercial or fair use of the domain name, in accordance with Paragraph 6(c) of the Policy. In fact, the Respondent is not making any use of the impugned domain at all; instead, it has kept it blocked for use by legitimate users by placing a parked page and hosting commercial/sponsored links therein which redirect to restaurants/online food delivery services of the Complainant's direct competitors. In view thereof, it is clear that the Respondent is not making any legitimate or fair use of the impugned domain name so as to fall within the ambit of paragraph 6(c) of the INDRP. Further, any use of the domain name < JIMMYJOHNS.IN> in the future by the Respondent is likely to create a false

association and affiliation with the Complainant and its well known trade mark JIMMY JOHN'S. Therefore, it is submitted that Respondent has no rights or legitimate interests in respect of the impugned domain name and is incapable of making a legitimate, non commercial or fair use of the domain name in accordance with paragraph 6(c) of the Policy.

- f) Complainant further submits that the Respondent herein registered the impugned domain <JIMMYJOHNS.IN> almost 40 years after the Complainant adopted the trade mark JIMMY JOHN'S in relation to its business. Further, Respondent is presently not making any use of the domain with a bonafide offering of goods or services and in fact, it is not currently making any use of the domain at all. In the circumstances of this case, the Respondent's use of the disputed domain name is not "bona fide" within the meaning of Paragraph 6(c) of the Policy since there is no apparent legitimate justification for the Respondent's registration of the <JIMMYJOHNS.IN> domain name that is visually, phonetically, conceptually, deceptively and confusingly identical/similar to the complainant's trade name/mark.

Complainant also asserts that the continued ownership of the disputed domain <JIMMYJOHNS.IN> by the Respondent, despite not having any legitimate or fair reason to do so, prevents the Complainant from

reflecting its trademark in the subject domain name. Complainant relied upon *Motorola, Inc. Vs NewGate Internet, Inc. (WIPO Case D2000-0079)*, wherein, it was held that use of the trademarks cannot only create a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation or endorsement of its website, but also creates dilution of the marks.

- g) It is not possible to conceive of any plausible use of the domain name <JIMMYJOHNS.IN> by Respondent that would not be illegitimate, as it would inevitably create a false association and affiliation with Complainant and its well known trade mark Jimmy John's. Therefore, it is submitted that Respondent has no rights or legitimate interests in respect of the impugned domain name.

iii) **The domain name was registered or is being use in bad faith.**

- a) The Complainant contents that as per paragraph 7(c) of the Policy, it is stipulated that a "bad faith" registration and use of a domain name can be established inter alia by showing circumstances indicating that the Respondent has registered and was previously using the domain name to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation or endorsement of Respondent's website or location, or of a product or service on Respondent's website or location.

- b) According to the complainant, the fact that the mark Jimmy John's derives its name from the Complainant's founder further aggravates the Respondent's bad faith, in as much as, the Respondent is using the identical name with respondent to the impugned domain name <JIMMYJOHNS.IN>. There can be no other plausible explanation as to how the Respondent arrived at the impugned domain name <JIMMYJOHNS.IN> which incorporates the Complainant's mark JIMMY JOHN'S in toto and displays links to competing restaurants/online food delivery services which are the primary products of the Complainant sold and marketed under the mark JIMMY JOHN'S. In light of the continuous and exclusive use of the mark JIMMY JOHN'S by the Complainant including as part of its trade/corporate name over many years, this mark has no meaning other than as an identified of the Complainant. Reliance is placed on a prior decision in *INDRP Case No. 323* titled *M/s Merck G GaA Vs Zeng Wei* and contended that the Respondent had no reason to adopt an identical name/mark with respect to the impugned 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, with the sole intention to ride on the massive goodwill and reputation

associated with the Complainant and to unjustly gain enrichment from the same.

- c) The Complainant further brought to the notice of the Tribunal that the Respondent is a habitual cyber-squatter and is in the business of registering domain names containing well known trademarks and making illegal profits by either offering them for sale or hosting pay-per click advertisements (as in the present case). Reliance is placed on *Glen Raven, Inc. Vs Ding Ding, Dingcorp INDRP/989* wherein it was held that the Respondent (Dingcorp) is in the habit of being involved in cyber-squatting by registering domain names containing well known trademarks for illegal profits. The Respondent was also implicated in *Le Creuset Vs Ding Ding INDRP/961* wherein it was held that the Respondent had knowingly registered the impugned domain incorporating the Complainant's trademark to attract internet users with the intent of commercial gain. Accordingly, given the Respondent's track record, it is apparent that the registration of the impugned domain by the Respondent is not bonafide and is in bad faith.
- d) Lastly, the Complainant contended that the fact that the Respondent is currently using the domain in relation to a parked page displaying advertisements/links which redirect to restaurants/online food delivery services of the Complainant's direct competitors, gives the

impression that it is a case of passive holding and the same is tantamount to the fact that the Respondent does not hold any legitimate interest in the domain name. Complainant placed Reliance on *Flipkart online services Private Limited Vs Azeem Ahmed Khan* wherein it was held that, "parking of domain names incorporating someone else's trademark constitutes bad faith."

Reliance is also placed on *Instagram, LLC Vs Contact Privacy Inc./Sercan Lider (WIPO Case No. D2019-0419)* wherein it was held that "passive holding can be sufficient to find bad faith use." In another decision in *Johnson & Johnson Vs Daniel Wistbacka (WIPO Case No. D2017-0709)* while discussing the elements constituting bad faith with respect to passive holding of respondent's domain name as noted in the landmark case of *Telstra Corporation Limited VS Nuclear Marshmallows (WIPO Case No. D2000-0003)*, it was held that,

...In particular it seems that the fifth element (i.e. impossibility to conceive of any plausible active use) is actually a conclusion which was made on the base of the preceding four elements and that this fifth element plays a decisive role in determining whether any particular passive holding can be regarded as "bad faith" use of a domain name in dispute.



In the present case like in the above cited case, the Panel cannot conceive of any plausible use of the disputed domain name that would be legitimate, absent an authorization from the Complainant. As the disputed domain name is strictly identical to the Complainant's distinctive mark, consumers would certainly mistakenly assume that an active website connected to the disputed domain name is operated or endorsed by the Complainant, when such is not the case.

The Panel accordingly reaches the conclusion that the passive holding of the disputed domain name amounts to use in bad faith given the circumstances of the case.

- e) In consideration of the complainant's longstanding reputation, and the ubiquitous presence of the Complainant's mark JIMMY JOHN'S on the Internet, Respondent was, or should have been, aware of the Complainant's trademarks long prior to registering the domain name. In view of the aforesaid, it is submitted that the Respondent had constructive notice of the Complainant's mark Jimmy John's which is registered and used in the United States of America (where the Respondent is situated) and many other jurisdictions around the world. Reliance has been placed upon *Caesars World, Inc. Vs Forum LLC (WIPO Case No. D2005-*



0517). HUGO Boss Trade Mark Management GmbH & Co.
KG HUGO Boss Ag Vs Dzianis Zakharenka (WIPO Case No.
D2015-0640).

- f) The Complainant in the Complaint ended with contentions that Respondent's knowledge of the Complainant's mark JIMMY JOHN'S is further evidenced by their current use of the disputed domain <JIMMYJOHNS.IN> on a parked page showing advertisements/links which redirect to restaurants/online food delivery services of the complainant's direct competitors. The Respondent's intent appears reflective of a blatant attempt to ride on the association and goodwill of the Complainant's brand as acquired among the consuming public and thereby drive traffic towards the Respondent's domain and website by misleading, confusing and deceiving Complainant's customers and the general lay public as to the source, sponsorship, affiliation or endorsement of the Respondent's domain name and website as hosted thereon

8. RESPONDENT'S CONTENTION

As the Respondent did not file any reply, therefore, the contentions of the complainant have gone un rebutted, however, since, it is a settled dictum of law that the Party has to stand on his own legs and cannot be allowed to take benefit of other party's weakness or no

action, therefore, the present dispute is decided on the basis of the pleadings and documents on record.

9. TRIBUNAL'S FINDING AND DECISION

As per the .IN Domain name dispute Resolution Policy Rule No. 4, any person who considers that a registered domain name conflicts with his/her legitimate rights or interests may file a Complaint to the .IN Registry on the following premises:

- 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.

Further, for the purposes of Clause 4(c) supra, rule 7 provides that 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.*

10. That the Tribunal has to see that as to whether Complainant is the owner of Trademark JIMMYJOHN's and is an exclusive use of the same since long which is also corporate name and trading style of Complainant worldwide. As per the pleadings of the complainant in the complaint supported by Annexure C-3 to C-5, Complainant is the Registered Owner of Trademark JIMMYJOHN'S and as evident from Annexure C-6 & C-7, Complainant has obtained registrations over the Trademark JIMMYJOHN'S and variations thereof in other jurisdiction of the World including India and by virtue of said registrations, the complainant has the exclusive statutory right to use the trademark JIMMYJOHN'S Variants thereof in the countries where they are registered as fully described in the para 4 and 5 of the complaint. The



Complainant has also placed on record various photographs showing publicity and promotional activities of the disputed domain JIMMYJOHN'S by way of Annexure C-8, Annexure C-9 are the photographs of some Restaurants of the Complainant and Annexure C-10 is few news clippings. Though, the Complainant in the Complaint as alleged that they have about 2700 restaurants in America but no documents in support of said contentions has been placed on record and though the same has gone un rebutted and even also not very relevant for the purpose of deciding the present dispute.

11. Now, further to be discussed that as to whether complainant has been able to prove the 3 ingredients of Clause 4 of the INDRP. A perusal of Annexure C-2 which is the contact details of Registrant Respondent from WHOIS database which is also the domain name information containing impugned domain name JIMMYJOHNS.IN and the Complainant's and the documents annexed by the Complainant regarding trademark JIMMYJOHN'S, it is evident that the disputed domain name JIMMYJOHNS.IN is identical and also confusingly similar to the Complainant's trademark JIMMYJOHN'S qua which the Complainant has exclusive and absolute rights. Therefore, the Complainant has met with the requirement of clause 4 (a) of the INDRP.
12. It is also evident from the pleadings and the documents annexed with the Complaint that the Respondent has no rights or legitimate interest in respect of the Domain name JIMMYJOHNS.IN. According to the complainant, it has not authorized the Respondent to register

the impugned domain name and also the Respondent cannot assert that it is using the domain name in connection with bonafide offering of goods and services in terms of clause 6(a) of INDRP as it not operating any website from the impugned domain and instead using the domain in connection with a parked page hosting commercial/sponsored links to Restaurants/online food delivery services belonging to complainant's direct competitors. The Complainant has further contended in the Complaint that Respondent is not commonly known by the name JIMMY JOHNS within the meaning of Clause 6 (b) of INDRP and is known by the name DingCorp thereby Respondent has deliberately chosen to use the disputed domain name to suggest a direct connection or affiliation with the Complainant's trademark and its business when in fact there is none. As the contentions have gone un rebutted, therefore, it can be very well said that the Respondent has no rights or legitimate interest in respect of the impugned domain name and as such the ingredient of clause 4(b) has also been proved by the Complainant.

13. That as per the facts on record in the shape of contents of the Complaint and the documents annexed, there can be no hesitation in saying that the Respondent has no reason to adopt an identical name/mark with respect to the impugned domain name except to create a deliberate and false impression in the mind of the consumers that the Respondent is somehow associated with or endorsed by the Complainant with the sole intention to right on the massive goodwill and reputation built, enjoyed and associated with



the Complainant and to unjustly gain enrichment from the same. An ulterior motive of the Respondent to register disputed domain name which is strictly identical to the complainant's distinctive mark can be seen from the contention of the Complainant that the Respondent is a habitual cyber squatter and is in the business of registering domain names containing well known trademarks and making illegal profits by either offering them for sale or hosting paper click advertisements etc. The Tribunal has perused two decisions in INDRP/989 and INDRP/961. In these two disputes, the name of the Respondent is similar to the name of the Respondent in the present case, however, the address seems to be different but since, Respondent failed to file response, the Tribunal has no other alternative but to accept the contentions of the Complainant which are also supported by various decisions which are applicable to the facts of the present dispute. In view of above discussions, the Tribunal has no hesitation in arriving at a conclusion that the Registrant's Domain name has been registered and is being used in bad faith, thus, the Complainant has fulfilled the requirement of clause 4(c) of INDRP also.

From above discussions and findings, the Tribunal has come to the conclusion that the Complainant has been able to prove its case in terms of INDRP, provisions of Arbitrations and Conciliation Act, 1996, as amended up to date, and also settled dictum of law and therefore, the prayer of the Complainant is allowed and the following decision is given in the Award.



14. DECISION

Though, this is a fit case where Respondent/Registrant's disputed Domain name JIMMYJOHNS.IN is liable to be cancelled, however, taking overall view of the matter, this Tribunal orders that Respondent is barred from using the mark JIMMYJOHNS.IN and therefore shall immediately cease to use the said domain name. It is further ordered that the disputed domain name JIMMYJOHNS.IN be transferred to the complainant.

15. AWARD

It is awarded that the Respondent is barred from using the mark JIMMYJOHNS.IN and therefore shall immediately cease to use the said domain name. It is further ordered that the disputed domain name JIMMYJOHNS.IN be transferred to the complainant.

16. COST

In view of the facts and circumstances of the case as the Complainant has been uncalled for an unnecessarily dragged into the present dispute, therefore, the costs of the proceedings as provided in INDRP Rules of Procedure is also awarded in favour of the Complainant and against the Respondent.

Signed on this 22nd October 2021.



(Sajal Koser)
Sole Arbitrator