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All Star C.V. & Converse, Inc., USA vs. Hangzhou Gougou Internet Co., China
INDRP Case no. 1479
 Arbitrator : Mr. P.K.Agrawal

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AWARD

1. The Parties

The Complainant is M/s All Star C.V. One Bowerman Drive Beaverton Oregon 97005 6453 United States of America **AND** Converse, Inc. One High Street North Andover Massachusetts, 01845-2601 United States of America.

The Respondent is Hangzhou Gougou Internet Co., Ltd., No. 400 8th Floor, Shaoxing RD, Hangzhou, Zhejiang – 310005, China.

2. The Domain Name and Registrar

The disputed domain name is <www.converse.in>. The said domain name is registered with the Registrar – Online Nic (IANA ID: 82). The Registrar URL is [https:// onlinenic.com](https://onlinenic.com).

The details of registration of the disputed domain name (as per Annexure attached to the Complaint) are as follows:

- a. Domain ROID: D602119-IN
- b. Date of creation: Feb 19, 2005
- c. Expiry date: Feb 19, 2022

3. Procedural History

(a) A Complaint dated 3rd December, 2021 (amended complaint on 30.12.2021) has been filed with the National Internet Exchange of India (NIXI). The Complainant has made the registrar verification in connection with the domain name at issue. The print outs confirmed that the Respondent is listed as the registrant and provided the contact details for the administrative, billing, and technical contact. The Exchange verified that the Complaint satisfied the formal requirements of the Indian Domain Name Dispute Resolution Policy (INDRP) (the “Policy”) and the Rules framed thereunder.

(b) The Exchange appointed the undersigned Mr. P.K.Agrawal, Advocate and former ~~Addl.~~ Director General in the Government of India, as the sole Arbitrator in this matter. The Arbitrator finds that he has been properly appointed. The Arbitrator has submitted the Statement of

Acceptance and Declaration of Impartiality and Independence, as required by the Exchange.

- (c) In accordance with the Policy and the Rules, the copies of complaint with annexures were served by the National Internet Exchange of India on 27.12.2021 (amended complaint on 30.12.2021) by email. The Arbitrator served the Notice under Rule 5(C) of INDRP Rules of procedure along-with copies of complaint and annexures to the parties through email on 27.12.2021. The Respondent was given 14 days for reply to the complaint. The Complainant sent the physical copies of complaint & annexures by International Mail to the Respondent on 31.12.2021, after he was instructed to do so. In view of this, the Complaint and its annexures may be deemed to have been served to the Respondents as per Arbitration and Conciliation Act, 1996 and INDRP rules. Since, the Respondent has not responded to the repeated notices served through emails, the present proceedings have to be conducted ex-parte as per the Arbitration and Conciliation Act, 1996 and the .IN Domain Name Dispute Resolution Policy and the Rules of Procedures framed there under.

(d) Delay / laches in proceedings :

The Complainants have submitted that the Disputed Domain Name was registered in 2005, however the doctrine of 'laches' does not apply in domain disputes. This doctrine has been applied in other domain dispute policies, such as the UDRP process, where the WIPO Overview 3.0, section 4.17 states that panels: 'have widely recognized that mere delay between the registration of a domain name and the filing of a complaint neither bars a Complainant from filing such case, nor from potentially prevailing on the merits.'

The Complainants contend that the INDRP has also applied this principle in cases such as Subway Inc. v. Ramaswamy Nathan. INDRP Case No. 1151/2019, where panelist Mr. Vinod K. Agarwal applied the comments in National Association for Stock Car Auto Racing, Inc. v. Racing Connection / The Racin' Connection, Inc WIPO Case No. D2007-1524 that: '...the equitable defense of laches does not properly apply in this Policy proceeding. The remedies under the Policy are injunctive rather than compensatory in nature, and the concern is to avoid ongoing or future confusion as to the source of communications, goods, or services.' Consequently, the Complainants submit that the doctrine of laches should not apply in these proceedings.

I, the Arbitrator, fully agree with the submissions of the Complainants regarding delay in the proceedings. Therefore, I proceed to arbitrate on the issue of disputed domain name on merits.

4. Factual Background

The Complainants are the owners and controllers of the CONVERSE brand. The Complainants have, through own use and use by associate companies and licensees, built a significant reputation and have built up a vast amount of goodwill in the CONVERSE brand worldwide in relation to a range of goods and services including footwear, clothing, headgear and bags. The Complainants are a famous manufacturer of shoes, apparel and bags. The Complainants, including their authorised partners, sell products under the CONVERSE brand in many countries, including United States; Canada; Brazil; Mexico; Germany; England; France; Italy; Spain; Greece; Holland; Denmark; Sweden; Norway; Czech Republic; Russia; China; Hong Kong; Japan; Korea; Thailand; Malaysia; Indonesia; Australia.

According to the complaint, the Complainants have produced and sold shoes for over a century. The Complainants were founded in 1908 in Massachusetts, United States, as a rubber company, and began producing shoes in 1909. Since that time, the Complainants have developed the Converse brand into a worldwide famous brand selling footwear, apparel, and bags around the world. Every year large sums of money are spent in advertising the products sold under the CONVERSE brand. Such advertisements appear in magazines having international circulation such as Sports Illustrated, Newsweek and many others. The Complainants' CONVERSE brand is and has been seen being worn and/or promoted by a large number of culturally significant people including the former First Lady of the United States of America, Michelle Obama, movie star Kristen Stewart, the lead singer of world-renowned band Nirvana, Kurt Cobain, popular Netflix show, Stranger Things, Millie Bobby Brown, and international popstars Rihanna, Katy Perry, and Taylor Swift. Products sold under the Complainants' CONVERSE brand are thus known to consumers around the world. Thus, the Complainants have made extensive and continuous use of their CONVERSE brand around the world. In consequence of such use, the Complainants' CONVERSE brand has acquired and maintained a substantial reputation and significant goodwill. From the Complaint and the various annexures to it, the Arbitrator has found the following additional facts:

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Additional Facts:

- In addition to their established goodwill, the Complainants are the proprietor of numerous trade mark registrations for the CONVERSE brand since 1968 around the world and have registered trade mark rights in India since 1979.
- The Complainants are owner and registered proprietor of the word marks CONVERSE in India as follows:

353741 1979-09-21 **CONVERSE** 25 English socks (for wear).
353737 1979-09-21 **CONVERSE** 18 bags included in class-18.
396218 1982-10-08 **CONVERSE ALL STAR** 18 English bags
(Being all purpose or duffel).
485020 1988-02-01 **CONVERSE** 25 English footwear.
WIPO 924653 2007-05-16 **CONVERSE ALL STAR** 25 English
Athletic footwear and clothing, namely t-shirts, shorts, hats, jackets,
tank tops, sweatpants and sweatshirts.
1625259 2007-11-27 **CONVERSE, ALL STAR, OF STAR** 25
English footwear and apparel.

- Complainants are the registrant of the top-level domain (TLD) converse.com since long and host an interactive website accessible globally including in India.
- The disputed domain name <converse.in > was registered on Feb 19, 2005 and in the past resolved to numerous websites, some of which contain links to various websites which offer services in competition with that of the Complainants.

Respondent's Identity and Activities

The Respondent's activities are not known. The Respondent has not responded to the Notice and complaint.

5. Parties Contentions**A. Complainants**

The Complainants contend that each of the elements specified in the Policy are applicable to this dispute.



In relation to **element (i)**, the Complainants contend that the disputed domain name <converse.in> is confusingly similar to its trademark CONVERSE. The Complainants submit that they have registered trade mark rights in India from 1979 and goodwill in the CONVERSE brand since that date as outlined above. The Complainants submit that there have been recent decisions where the complaining party has relied on UK and EUTM rights, which were held to be sufficient for the purposes of establishing 'rights' in a INDRP dispute concerning the domain (What3Words Limited v. Vinit Saxena. INDRP Case No. 1229/2020).

The Complainants have a number of other domain dispute decisions that have been issued which relate to domain names including the word CONVERSE which act to support that the Complainants have a significant portfolio of trade mark rights, a reputation in the CONVERSE brand and that a likelihood of confusion does exist in relation to the Dispute Domain Name. Extracts from some of the decisions are as follows:

1. WIPO Case No. D2011-1405 - - 'The Complainant clearly has rights in the CONVERSE Marks'.
2. WIPO Case No. D2007-0926 - - 'The CONVERSE mark is notoriously associated with athletic footwear products....'
3. WIPO Case No. D2005-0350 - - 'Complainant has long-established and registered trademark rights in the MARK, which is well known and associated with basketball shoes'.
4. WIPO Case No. D2018-0414 - 'It is uncontroverted that the Complainant has established rights in the CONVERSE Trademark based on its numerous registrations for the CONVERSE Trademark and long-term use all over the world'.

Furthermore, the Complainants contend that the Disputed Domain Name is identical to the Complainants' CONVERSE brand as it incorporates the CONVERSE term verbatim. The Complainants request that the Panel omit the suffix extension 'in' as this is merely a technical requirement for domain names in India (Urban Outfitters, Inc. v. Machang - INDRP Case No. 601/2014).

Therefore, the Complainants contend that the disputed domain name <converse.in > is confusingly similar to its trademarks.

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In relation to **element (ii)**, the Complainants contend that the Respondent does not have any legitimate interest in using the disputed domain name. Based on the Complainants' reputation, there is no believable or realistic reason for registration or use of the Disputed Domain Name other than to take advantage of the Complainants' rights.

The Complainants contend that the Respondent has no rights or legitimate interests in respect of the domain name and he is not related in any way with the Complainant. To the best of their knowledge, the Respondent has never legitimately been known as 'CONVERSE' at any point in time. These facts lead the Complainants to conclude that the only reason why the Respondent registered the Disputed Domain Name was to take advantage of the Complainants' goodwill and valuable reputation and make a financial gain for themselves.

Finally, the complainants have contended that nothing about the Disputed Domain Name suggests that the Respondent is making a legitimate non-commercial or fair use. As mentioned above, the Disputed Domain Name has been set-up to resolve to various websites, some of which direct unsuspecting Internet users to competing goods, which shows that the Respondent is attempting to capitalize on the brand value of the Complainants' CONVERSE brand. Therefore, the Respondent cannot come within Policy, Paragraph 6(c) of the INDRP Policy.

Based on the above-mentioned arguments, the Complainants argue that the Respondent has no rights or legitimate interests in the disputed domain name.

Regarding the **element (iii)**, the Complainants contend that the bad faith is implicit in the registration of the Disputed Domain Name. The CONVERSE brand is established worldwide. Thus, given the distinctiveness of the Complainant's trademarks and reputation, it is inconceivable that the Respondent could have registered the disputed domain name <converse.in > without actual knowledge of Complainants' rights in the trademark, which evidences bad faith.

The Complainants submit that the Respondent has registered the Disputed Domain Name in bad faith by intentionally attempting to attract Internet users to their website or other online location, by creating a likelihood of confusion with the Complainants' name or mark as to the

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source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location.

Furthermore, the disputed domain name resolves to a parking page with commercial links. The Respondent's domain portfolio shows other registered domain names which relate to established brands such as (the established fashion brand <https://www.kenzo.com/uk/en/home>) and (owned by the established cereal brand <https://www.kelloggs.com>). The Complainants contend the Respondent has attempted to attract Internet users for commercial gain to his own website thanks to the Complainants' trademarks for its own commercial gain, which is evidence of bad faith. Evidently, the Respondent is not interested in carrying out any genuine trade or business through the disputed domain name.

The Complainants contend that the Respondent's malafide is further evident from the fact that the Respondent has been involved in another '.in' domain dispute which targeted an established Calvin Klein in Calvin Klein, Inc. v. Hangzhou Gougou Internet Co., Ltd. INDRP Case No. 704/2015: the domain name is registered without any authority, agreement or arrangement between the Complainant and the Registrant. The webpage included several links to the third parties in respect of various products including those of the Complainant. Thus, the Registrant has been making money illegally by using the name and fame, of the Complainant (Panelist S.C. Inadmar in INDRP Case No. 704/2015).

On these facts, the Complainant contends that the Respondent has registered the disputed domain name and is using it in bad faith.

B. Respondent

The Respondent did not submit any evidence or argument indicating his relation with the disputed domain name <converse.in> or any trademark right, domain name right or contractual right.

6. Discussion and Findings

The Rules instruct this arbitrator as to the principles to be used

in rendering its decision. It says that, "a panel shall decide a complaint on the basis of the statements and documents submitted by the parties in accordance with the Policy, the Arbitration and Conciliation Act, 1996, the Rules and any rules and principles of law that it deems applicable".

According to the Policy, the Complainant must prove that:

- (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's has no rights or legitimate interests in respect of the domain name that is the subject of Complaint; and
- (iii) The Registrant's domain name has been registered or is being used in bad faith.

Although Respondent has failed to respond to the complaint, the default does not automatically result in a decision in favour of the Complainant, nor is it an admission that Complainant's claims are true. The burden remains with Complainant to establish the three elements of the Policy by a preponderance of the evidence.

A. Identical or Confusingly Similar

The disputed domain name <converse.in > was registered by the Respondent on Feb 19, 2005.

The Complainant is an owner of the registered trademark "CONVERSE" for the last many years. The Complainant is also the owner of the domain as stated above and referred to in the Complaint. These domain name and the trademarks have been created by the Complainant much before the date of creation of the disputed domain name by the Respondent. In the present case the disputed domain name is <converse.in >. Thus, the disputed domain name is very much similar to the name, activities and the trademark of the Complainant.

The Hon'ble Supreme Court of India has 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 "CONVERSE" products would mistake the disputed domain name as of the Complainant.



In the case of *Wal Mart Stores, Inc. v. Richard MacLeod*, (WIPO Case No. D2000-0662) it has been held that "When the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name" it is identical or confusingly similar for purposes of the Policy.

Therefore, I hold that the domain name <www. converse.in > is phonetically, visually and conceptually identical or confusingly similar to the trademark of the Complainant.

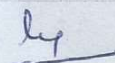
B. Rights or Legitimate Interests

The Respondent may demonstrate its rights to or legitimate interest in the domain name by proving any of the following circumstances:

- (i) before any notice to the Registrant of the dispute, the Registrant's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the Registrant (as an individual, business or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or
- (iii) The Registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

In Case No. INDRP/776, *Amundi v. GaoGou*, the arbitration panel found that the Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests. Once such *prima facie* case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4 (II) of the INDRP Policy.

The Respondent's response is not available in this case. There is no evidence to suggest that the Respondent has become known by the disputed domain name anywhere in the world. The name of the Registrant / Respondent is Hangzhou Gougou Internet Co., Ltd. as given in Whois details. Based on the evidence adduced by the Complainant, it is concluded that the above circumstances do not exist in this case and that



the Respondent has no rights or legitimate interests in the disputed domain name.

Further, the Complainant has not consented, licensed or otherwise permitted the Respondent to use its name or trademark "CONVERSE" or to apply for or use the domain name incorporating said trademark. The domain name bears no relationship with the Registrant. Further that, the Registrant has nothing to do remotely with the business of the Complainant.

As has been contended by the Complainant, the Respondent is not making a legitimate, fair or bona fide use of the said domain name for offering goods and services. The Respondent registered the domain name for the sole purpose of creating confusion and misleading the general public.

I, therefore, find that the Respondent has no rights or legitimate interests in the domain name <converse.in > under INDRP Policy, Paragraph 4(ii).

C. Registered and Used in Bad Faith

Any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration or use of the domain name in bad faith:

- (i) 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
- (ii) 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
- (iv) by using the domain name, the Registrant has intentionally



attempted to attract the 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.

The contention of the Complainant is that the present case is covered by the circumstances mentioned herein above. There are circumstances indicating that the Respondent has intentionally attempted to attract, for commercial gain, internet users to its web site, by creating a likelihood of confusion with the Complainant's mark. It may also lead to deceiving and confusing the trade and the public.

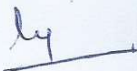
In WIPO Case No. D2007-1695, Mayflower Transit LLC v. Domains by Proxy Inc./Yariv Moshe - "Respondent's use of a domain name confusingly similar to Complainant's trademark for the purpose of offering sponsored links does not of itself qualify as a bona fide use."

The circumstances as evident from the foregoing paragraphs lead to the conclusion that the domain name in dispute was registered and used by the Respondent in bad faith.

7. Decision

In light of the foregoing findings, namely, that the domain name is confusingly similar to the trademark in which the Complainant has rights, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the domain name was registered in bad faith and is being used in bad faith, it is clear beyond doubt that the Respondent has violated the provisions of Rule-3 of the Policy. Therefore, in accordance with the Policy and the Rules, the Arbitrator orders that the domain name <converse.in> be transferred to the Complainant.

No order to the costs.



Prabodha K. Agrawal

Sole Arbitrator

Dated: 17th January, 2022