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INDRP ARBITRATION CASE NO.1482
THE NATIONAL INTERNET EXCHANGE OF INDIA
(NIXI)

ADMINISTRATIVE PANEL DECISION
SOLE ARBITRATOR: AJAY GUPTA

ULTA SALON, COSMETICS & FRAGRANCE, Inc.

Vs.

CHANDAN MA

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INDRP ARBITRATION CASE NO.1482
THE NATIONAL INTERNET EXCHANGE OF INDIA (NIXI)

ADMINISTRATIVE PANEL DECISION
SOLE ARBITRATOR: AJAY GUPTA

Ulta Salon, Cosmetics & Fragrance, Inc.
1000 Remington Boulevard, Suite 120,
Bolingbrook, Illinois 60440,
United States of America

...Complainant

VERSUS

Chandan M A
82 Anjaneya House Building Society, Chikkakallasandra,
Bangalore, Karnataka - 560061, India

...Respondent

Disputed Domain Name: ULTA.IN

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The Parties

The **Complainant** in this arbitration proceedings is ULTA Salon, Cosmetic & Fragrance, Inc who is beauty retailer and beauty destination for cosmetics, fragrance, skin, hair care products, and salon services, among others under mark ULTA, which is the Complainant's very trade name is and its contact address is Ulta Salon, Cosmetics & Fragrance, Inc. 1000 Remington Boulevard, Suite 120, Bolingbrook, Illinois 60440, United States of America. The Complainant in this administrative proceeding is represented by its counsel Raja Pannir Selvam Selvam and Selvam Old No. 9, Valliammal Street, First Floor, Kilpauk, Chennai 600 010 Tamil Nadu, India.

The **Respondent**, in this arbitration proceeding, is, Chandan M A Address: 82 Anjaneya House Building Society, Chikkakallasandra, Bangalore, Karnataka - 560061, India as per the details given by the WHOIS database maintained by the National Internet Exchange of India (NIXI).

The Domain Name and Registrar

The disputed domain name is ulta.in. The Registrar with which the disputed domain name is registered is NameSilo LLC.

Procedural History [Arbitration Proceedings]

This arbitration proceeding is in accordance with the .IN Domain Name Dispute Resolution Policy [INDRP], adopted by the National Internet Exchange of India(NIXI). The INDRP Rules of Procedure [the Rules] were approved by NIXI on 28th June 2005 in accordance with the Indian Arbitration and Conciliation Act,1996. By registering the disputed domain name with the NIXI accredited Registrar, the Respondent agreed to the resolution of the disputes pursuant to the IN Dispute Resolution Policy and Rules framed there under.

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The history of this proceeding is as follows :

In accordance with the Rules 2(a) and 4(a), NIXI on 27.12.2021 formally notified the Respondent of the complaint, and appointed Ajay Gupta as the Sole Arbitrator for adjudicating upon the dispute in accordance with the Arbitration and Conciliation Act, 1996, and the Rules framed there under, .IN Domain Resolution Policy and the Rules framed there under . That the Arbitrator submitted the Statement of Acceptance and Declaration of Impartiality and Independence Dated 27.12.2021 vide mail Dated 28.12.2021 , as required by NIXI.

That commencing the arbitration proceedings an Arbitration Notice Dated 28.12.2021 was sent to the Respondent by this panel under Rule 5(c) of INDRP Rules of Procedure with direction to file reply of the complaint if any within 10 days. The copy of complaint was also mailed to Respondent by Complainant on the directions of this panel on 30.12.2021. That the Complainant also sent the hard copy of complaint to the Respondent on address as mentioned in WHOIS Domain Name Information through Speed Post on 30.12.2021 and postal receipt of the speed post was supplied to this panel by Complainant vide their mail dated 30.12.2021. That the Respondent vide its mail dated 05.01.2022 requested this panel to give more time to file the reply stating that he just came from his native village. This panel vide its mail dated 30.01.2022 granted further opportunity to file the reply of complaint and directed Respondent to file the reply by 15.01.2022. The Respondent was further directed that in future all communications shall also be copied to NIXI.

That on 15.01.2022 this panel received a mail from the Respondent through which he expressed his consent to transfer the disputed domain name to Complainant. In view of Respondent's mail dated 15.01.2022 this panel vide its mail dated 15.01.2022 gave instructions to the Complainant to explore the

possibility of settlement , if any, by contacting each other. Both the parties were directed that if any, settlement is reached between them , it should be by way of settlement agreement and that was to be duly signed by both the parties. It was also directed by this panel to both the parties to copy all the communication/ mail to this panel as well as NIXI. They were further directed to mail the said settlement to this panel on or before 25.01.2022.

That complying with the instructions of this panel, Complainant through its counsel vide mail dated 17.01.2022 contacted the Respondent. That in furtherance to its earlier mail dated 17.01.2022 the counsel of the Complainant again contacted the Respondent through its mail dated 19.01.2022. On observing that the Respondent neither responded to the mails of the counsel of Complainant nor made any communication with this panel , this panel vide its mail Dated 21.01.2022 directed the Respondent to act expeditiously as INDRP proceedings are to be held in time bound manner. The Respondent was further directed to file the formal reply of complaint, if any, before 25.01.2022 in case he is not interested in settlement. It was further made clear to the Respondent by this panel that no further opportunity to file the formal reply shall be given after 25.01.2022 as enough opportunity for same was already granted to him on his request.

The Respondent despite repeated mails by Complainant and this panel neither contacted the Complainant nor filed his reply by 25.01.2022, however Respondent vide his mail dated 25.01.2022 which was received in evening by this panel submitted that due to health issues he could not reply to mails. The Respondent further submitted that he has already accepted to transfer the disputed domain name but could not change as same was locked by technical team. This panel in view of Respondent's mail vide mail dated 25.01.2022 granted one more opportunity to contact the Complainant and settle the matter by executing the settlement agreement by 29.01.2022. The Complaint through its counsel also

sent mail to Respondent on 25.01.2022 in furtherance of mail of this panel. The Complainant vide his mail dated 25.01.2022 explained the whole procedure of settlement to the Respondent and also offer to answer any questions raised by him. That Complainant in furtherance of his mail dated 25.01.2022 once again vide mail dated 29.01.2022 sent the settlement agreement executed by the Complainant but there was no response from the Respondent. This panel vide its mail dated 29.01.2022 also asked the Respondent to expedited the process of execution of settlement agreement, if he is agreed for the same. The Respondent was also given opportunity by this panel for clarification of any doubt or questions in this regard. The Respondent till date despite repeated mails by this panel and Complainant has neither responded to the same nor filed the formal reply of complaint. The Respondent despite repeated efforts of the Complainant for execution of settlement has not responded for the same and also not followed the instructions of this panel. However, in the interest of justice one last and final opportunity was given to the Respondent to either execute the settlement agreement with Complainant or file the reply of compliant if any by 05.02.2022 and the Respondent was also informed about this decision vide mail dated 02.02.2022 of this panel. The Respondent was further informed through mail that no further opportunity would be given after 05.02.2022 and the case shall be decided on merits of the complaint.

That thereafter, despite mail dated 02.02.2022 of this panel and earlier repeated opportunities given to him, the Respondent neither made any effort for settlement with Complainant by contacting its counsel nor filed the formal reply of the Complaint as directed by this panel. Further, no communication or mail was received by this panel from the Respondent in this regard.

This panel from the conduct of the Respondent has come to the conclusion, that Respondent despite having repeated opportunities

is neither interested in any settlement nor ready to file the formal reply of the complaint. The Respondent has repeatedly not followed the instructions of this panel hence, the Respondent was proceeded ex-parte on 07.02.2022 of in accordance with INDRP Rules and the present complaint is being decided on its merits.

The Respondent's Default

The Respondent failed to reply the complaint despite being given repeated opportunities. It is a well established principal that once a Complainant makes a prima-facie case showing that a Respondent lacks rights to the domain name at issue; the Respondent must come forward with the proof that it has some legitimate interest in the domain name to rebut this presumption. The disputed domain name in question is "ulta.in"

The INDRP Rules of Procedure require under Rule 8(b) that the arbitrator must ensure that each party is given a fair opportunity to present its case. Rule 8(b) reads as follows:

"In all cases, the Arbitrator shall ensure that the parties are treated with equality and that each party is given a fair opportunity to present its case."

The Respondent was given notice of this administrative proceeding in accordance with the Rules. The .IN discharged its responsibility under Rules paragraph 2(a) to employ reasonable available means calculated to achieve actual notice to the Respondent of the complaint.

The panel finds that the Respondent has been given fair opportunities to present his case. The Respondent was given direction to file the reply of the Complaint if any or settle the matter by signing the settlement agreement but Respondent neither gave any reply to the complaint nor signed the settlement agreement. The 'Rules' paragraph 12 provides that "In event any

party breaches the provisions of INDRP rules and / or directions of the Arbitrator, the matter can be decided ex parte by the Arbitrator and such arbitral award shall be binding in accordance to law." In the circumstances, the panel's decision is based upon the Complainant's assertions, evidences, inferences and merits only as the Respondent has not replied and is proceeded ex parte.

Background of the Complainant and its statutory and common law rights Adoption :

The Complainant, in the present arbitration proceedings to support their case, has relied and placed on records documents as Annexures and made the following submissions:

The Complainant submits that the Complainant is a well-renowned beauty retailer founded in 1990 and has over 1,200 brick and mortar locations across the USA, as well as a significant online presence via its website www.ulta.com. The Complainant is the premier beauty destination for cosmetics, fragrance, skin, hair care products, and salon services, among others. The mark ULTA, which is the Complainant's very trade name, is popularly known exclusively in relation to the Complainant.

The Complainant submits that it has been profusely associated with the ULTA marks and the same has been used in relation to cosmetics, fragrance, skin care products, hair care products and salon services for over 25 years. Since its establishment, the Complainant has become the largest beauty retailer in the United States of America and is a premier beauty destination under the ULTA marks. Through its online and brick and mortar stores, the Complainant offers more than 25,000 SKUs from over 500 well established and emerging beauty brands across all categories and price points. The Complainant invests large sums of money to promote the ULTA marks through television (advertisements), print media and the Internet. The Complainant

further owns and operates the domain name www.ulta.com, which incorporates the registered ULTA marks and prominently feature the same. Moreover, the website hosted on the domain is accessible all over the world, including India.

The Complainant submits that the Complainant's ULTA website is critical to the Complainant's business as an online retail website and a forum to advertise and promote the Complainant and their goods and services under the subject mark. The profile and popularity of the Complainant's services has been continuously increasing since the date of adoption and use of the Complainant's ULTA marks. Further, the Complainant maintains an active and prominent social media presence on multiple popular platforms such as Facebook, Instagram, Twitter, Pinterest, SnapChat and YouTube among others. These pages are constantly updated with the latest information about the ULTA marks along with its products and services and have millions (6.7 million to be precise) of loyal followers.

It is further submitted by the Complainant that with specific reference to India, it is pertinent to note that the Complainant has successfully registered the marks ULTA, ULTA BEAUTY and in India and the same was done with an intention to strengthen their position in the Indian beauty industry to successfully secure their rights to prevent third parties from infringing their marks, such as this case. Moreover, the Complainant is widely recognized amongst the Indian public as a reputable and reliable beauty retailer and several Indian YouTubers and other online influencers have posted positive reviews and video content of the Complainant's products and services on the said platform.

The Complainant further submitted that due to the impeccable reputation and goodwill earned by the Complainant across the world (including in India), the word 'ULTA' has come to be exclusively associated with the Complainant's products and

services and any unauthorized use of the ULTA mark by any third parties would cause the public to believe that such use has been authorized or is associated with the Complainant in some manner. Hence, the Complainant is vigilant in protecting its intellectual property against unauthorized use by third parties, such as the Respondents.

Complainant Submissions about the trademark ULTA:

The Complainant submits that Complainant has been trading under the trademarks 'ULTA' and 'ULTA BEAUTY' (hereinafter referred to as the "ULTA marks") for nearly 25 years. The Complainant's rights in the mark are further evidenced by its numerous registered trademarks in many countries including Indian registrations, that wholly incorporate the ULTA mark.

Submissions of Complainant about the Respondent and its use of the domain name

The Complainant submits that Complainant came to notice that the disputed domain name www.ulta.in was registered without any authorization whatsoever by one Harmony Infotech (hereinafter referred to as 'the prior registrant'). Therefore, on November 24, 2020, the Complainant had reached out to the other party and also sent cease and desist notice to the effect. Subsequently, during negotiations, the prior registrant over phone, had demanded for payment in order to transfer the disputed domain in favour of the Complainant and when the Complainant failed to heed to this demand, the prior registrant put up the disputed domain for sale.

The Complainant has submitted that finally, when the Complainant decided to initiate INDRP proceedings against the disputed domain, the Complainant now notes that the Respondent herein is one Chandan M A. In light of the same, it is further submitted that the prior registrant has, with mala fide intention,



either transferred the domain to the current Respondent or merely updated the name to reflect the current Respondent, the specific details of which is left to the privy of the Registrar and the Learned Arbitrator.

The Complainant further submitted that the current Respondent too does not have any legitimate rights in the disputed domain as evidently so, the disputed domain name wholly incorporates the ULTA mark and is identical to the Complainant's domain except for the country code Top Level Domain ("ccTLD"). It is submitted by the Complainant that, it is not certain that whether the prior registrant has merely transferred the domain to another third-party 9 namely the current Respondent, or has merely updated the Registrant details, to mislead the Complaint, the details of which as mentioned above, is left to the privy of the Registrar and the Learned Arbitrator.

The Complainant submits that neither the prior registrant nor the current Respondent, holds the disputed domain name, which is identical to that of the Complainant, with mala fide intention to confuse the customers, without any legitimate rights and is ultimately registered in bad faith.

The Complainant submits that, it is pertinent to note that the Complainant is vigilant in protecting its intellectual property especially against third parties such as the prior registrant and the Respondent who have blatantly and deliberately infringed the Complainant's rights in the ULTA mark by way of unlawfully registering the domain name www.ulta.in. Therefore, it is reiterated that the disputed domain is identical to the well₁ recognized ULTA trademark, and the only exception is the ccTLD and as inferred from the preceding paragraphs, the Respondent has no interest in the domain name or the mark and has registered the disputed domain name which is deceptively similar to the Complainant's domain name without any

authorization whatsoever, with the sole intent to gain unlawful monetary benefits. Therefore, the Respondent's registration of the disputed domain name violates the Complainant's hard-earned rights in the ULTA mark. The Complainant, being the true and rightful owner of the ULTA marks and domain names, had not and has not authorized the Respondent's use of the ULTA mark or the registration of the disputed domain name. Evidently so, the Respondent has no legitimate rights in the disputed domain name.

The Complainant further submits, that based on the Respondent's adoption and registration of a domain name that wholly incorporates the ULTA mark in its entirety with only a change in the ccTLD, the Complaint believes that the Respondent is squatting on the domain, as established in the preceding paragraphs, with an ill-intent to commercially gain from the same, thereby infringing the Complainant's ULTA marks. Indeed, there is no evidence that Respondent has any legitimate claims to the disputed domain name and any current or conceivable future use of the disputed domain name violates the Policy. The unauthorized use of the disputed domain name by Respondent severely harms the Complainant by tarnishing and infringing its trademarks, hard earned reputation and goodwill.

Panel Observation- This panel with reference to submissions of Complainant regarding earlier registrant, hold that since the Complainant has not made earlier registrant party to the present complaint no purpose would serve in adjudicating for past conduct and that is also not relevant because present Respondent has not formally replied in this regard despite repeated opportunities.

The issues involved in the dispute

The Complainant in its complaint has invoked paragraph 4 of the INDRP, which reads:

"Types of Disputes

Any person who considers that a registered domain name conflicts with his legitimate rights or interests may file a Complaint to the .IN Registry on the following premises :-

The disputed domain name is identical or confusing similar to a trademark in which the Complainant has statutory /common law rights.

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

The disputed domain name has been registered or is/are being used in bad faith.

The above mentioned 3 essential elements of a domain name dispute are being discussed hereunder in the light of the facts and circumstances of this case.

Parties Contentions

- 1. The disputed domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights.**

Complainant

The Complainant submits that the Complainant is the registered proprietor of the ULTA mark, and its variants as elucidated by means of relevant evidence submitted in the form of annexures. The Complainant's ULTA mark and its variants are distinctive and well recognized solely in relation to the Complainant. The Complainant owns the ULTA mark and has used its registered ULTA mark on its own domain www.ulta.com (which was registered in 1998) and is very relevant to the current proceeding. Moreover, the Complainant has successfully secured registrations



for the ULTA marks in India. Therefore, the disputed domain name is undeniably confusing and identical to the Complainant's prior ULTA mark which has been extensively and continually used for decades.

The Complainant submits that the Respondent has registered the domain name which comprises, apparently, in entirety, the Complainant's trademark ULTA. The minor of altering the ccLTD does not alleviate the fact that the domain name is deceptively identical to the registered mark ULTA of the Complainant. A person with 11 average intelligence and imperfect recollection would obviously not realize the minor change and be misled into thinking that the said domain belongs to the Complainant. The disputed domain name is identical to the Complainant's domain name and the change in ccTLD could easily be overlooked by a person of average intelligence and imperfect recollection, or even more likely, that such a person would assume that the same is associated to or affiliated with the Complainant.

The Complainant in support of his contentions has relied upon the following cases :

"In M/s Satyam Infoway Ltd. Vs. M/s Sifynet Solution (P) Ltd. JT. (2004 (5) SC 541), it was held that, "Domain name has all characteristics of trademark. As such principles applicable to trademark are applicable to domain name also. In modern times domain name is accessible by all internet users and thus there is need to maintain it as an exclusive symbol."

"In LEGO Juris A/S Vs. Robert Martin, INDRP/125 (2010), it was further held that "It is well recognized that incorporating a trademark in its entirety, particularly if the mark is an internationally well-known mark, is sufficient to establish that the domain name is identical or confusingly similar to the Complainant's registered mark."

In Starbucks Corporation vs. Mohanraj, INDRP/118 (2009):

"Domain name wholly incorporating a Complainant's registered trademark may be sufficient to establish

identity or confusing similarity, despite addition of other words to such marks." It is reiterated that a minor change such as altering the ccLTD would not alleviate the fact that the disputed domain name is deceptively similar to the Complainant's domain name."

In Google, Inc. vs. Mr. Gulshan Khatri INDRP/189 (2011), it was held :

"The act of registering a domain name similar to or identical to a famous trademark is an act of unfair competition whereby the domain name registrant takes unfair advantage of the fame of the Complainant's trademark to either increase traffic to the disputed domain, or to seize a potential asset of the trademark owner in the hope that the trademark owner will pay the requirement to relinquish the domain name."

The Complainant in view of the above contentions, submits that the disputed domain name is deceptively similar to the ULTA marks as per INDRP, para 6 (i); INDRP Rules, para 4 (b) (vi) (1).and the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Respondent

The Respondent has not replied to the Complainant's contentions despite repeated opportunities given to him.

Panel Observations

This Panel on pursuing the documents and records submitted by Complainant observe that the Complainant is the premier beauty destination for cosmetics, fragrance, skin, hair care products, and salon services, among others. The mark ULTA, which is the Complainant's very trade name, is popularly known exclusively in relation to the Complainant. It is further observed by this panel that Complainant is the registered proprietor of the ULTA mark and the Complainant's ULTA mark and its variants are distinctive and well recognized solely in relation to the Complainant. It is also observed by this panel that the Complainant has successfully

secured registrations for the ULTA marks in many countries including India .

This panel observe the fact that Disputed domain "www.ulta.in" comprises the Complainant's trademarks "ULTA" in their entirety and has the potential to cause consumer confusion and will cause the user into mistakenly believe that it originates from, is associated with or is sponsored by the Complainant and further suffix "in" is not sufficient to escape the finding that the domain is confusingly similar to Complainant's trademark.

Therefore, the panel is of opinion that disputed domain name "ulta.in" being identical/confusingly similar to the trade mark of Complainant will mislead the public and will cause unfair advantage to Respondent. The Panel is of the view that there is likelihood of confusion between the disputed domain name and the Complainant, its trademark and the domain names associated. The disputed domain name registered by the Respondent is confusingly similar to the trademark "ULTA" of the Complainant.

It has to be noted that the paragraph No.4 of the INDRP policy starts with following words :

"Any person who considers that a registered domain name conflicts with his legitimate rights or interest may file complaint to the registry on the following premises." This is a positive assertion and sentence. Further paragraph 4(i) also constitutes a positive assertion and sentence. The above clearly indicates that the onus of proving the contents of para 4(i) is upon Complainant. To succeed he must prove them."

It has been proved by the Complainant that it has trademark rights and other rights in the mark "ULTA" by submitting substantial documents in support of it. This panel while following the rule of law is of the opinion that while considering the trademark "ULTA" in its entirety, the disputed domain name "ulta.in" is confusingly similar to the trade mark of Complainant.



Paragraph 3 of the INDRP states that, it is the responsibility of the Respondent to find out before registration that the domain name he is going to register does not violate the rights of any proprietor/brand owner.

This Panel therefore, in light of the contentions raised by the Complainant comes to the conclusion that the disputed domain name is confusingly similar to the Complainant marks. Accordingly, the Panel concludes that the Complainant has satisfied the first element required by Paragraph 4(i) of the INDR Policy.

2. The Respondent has no rights or legitimate interests in respect of the disputed domain name.

Complainant

The Complainant submits that Complainant is the sole registered proprietor of the ULTA marks and provides services under the mark ULTA and has garnered immense goodwill and reputation under the ULTA mark. The Complainant further submits that the disputed domain name is deceptively similar to the ULTA mark in which the Complainant enjoys substantial reputation, goodwill and a trademark registration in India. Thus, the Respondent can have no legitimate interest in the impugned domain name which is deceptively similar to the Complainant's prior, registered and well-recognized ULTA mark and domain name www.ulta.com.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name, more so owing to the fact that the mark ULTA per se is known and associated with the Complainant and Complainant only. The Respondent thus, holds no legitimate rights or interest in the disputed domain name pursuant to ICANN Policy 4(c).



The Complainant submits that the Complainant has registered the domain name www.ulta.com which features the ULTA mark much prior to the Respondent. Hence, it is evident that the Respondent was interested in obtaining the disputed domain name only because it is deceptively similar to the mark in which the Complainant has rights and interest. It is therefore evident that the Respondent has no legitimate rights in the Complainant's ULTA mark, and such use of a domain name does not imply a legitimate interest under the Policy. The Respondent cannot also seek refuge under the purview of nominative fair use of the Complainant's ULTA trademarks, considering that the registration of the impugned domain would cause the general public to believe that the same is associated or connected with the Complainant in some manner. The Respondent thus, holds no legitimate rights or interest in the disputed domain name.

The Complainant has relied on the decision in L'OREAL vs Jack Sun INDRP/343 (2012), where the learned Arbitrator observed that although the disputed domain name belonged to the Respondent, the simple use of the L'OREAL trademark in the disputed name did not confer rights or legitimate interest to the Respondent in the same.

The Complainant in view of the above submits that the Respondent has no rights or legitimate interest in the disputed domain name as per INDRP Policy, para 6 (ii); INDRP Rules, para 4 (b) (vi) (2).

Respondent

The Respondent has not replied to the Complainant's contentions despite repeated opportunities given to him.

Panel Observations

This Panel holds that the second element that the Complainant needs to prove and as is required by paragraph 4(ii) of the INDRP

is that the Respondent has no legitimate right or interests in the disputed domain name.

This panel observes that the Complainant by placing documents/ records along with complaint has been able to prove that Complainant is the sole proprietor of the ULTA marks and provides services under the mark ULTA and has garnered immense goodwill and reputation under the ULTA mark.

Once the Complainant makes a prime facie case showing that the Respondent does not have any rights or legitimate interest in the domain name, the burden to give evidence shifts to the Respondent to rebut the contention by providing evidence of its rights or interests in the domain name. The Respondent has failed to rebut the allegations of the Complainant that the Respondent can have no legitimate interest in the impugned domain name which is deceptively similar to the Complainant's prior, registered and well-recognized ULTA mark and domain name www.ulta.com.

For these reasons, the Panel holds that the Complainant has proved that the Respondent does not have any rights or legitimate interests in the disputed domain name.

3. The disputed domain name has been registered or is being used in bad faith.

Complainant

The Complainant submits that Complainant's ULTA marks is well-recognized, and the Complainant has gained immense reputation and goodwill, not to mention popularity, thriving in the industry for decades. The Complainant and the ULTA marks are known synonymously for their laudable products and services. The Complainant has expended substantial resources on promoting and advertising its products and services and continues to maintain on-going business operations. The Complainant further

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submits that the Complainant has successfully secured trademark registrations for the ULTA marks in India and by using the disputed domain name, the Respondent has intentionally attempted to attract, internet users to the disputed domain's website by creating a likelihood of confusion with the Complainant's ULTA marks.

The Complainant submits that the fact that the ULTA mark was adopted and applied to the Complaint's popular goods and services many decades prior to the registration of the disputed domain name and that makes it extremely unlikely that the Respondent created the said domain independently without any knowledge of the Complainant's popular ULTA marks or website. The fact that the Complainant's ULTA mark is fanciful further irrefutably proves that the disputed domain name was adopted and registered in bad faith by the Respondent.

The Complainant has in support of his contentions has relied on the following cases:

In Google Inc. Sunil K. Support Solution Aditi Sawant, Support Solution Rohit Sharma/ Vineet Sharma Deep Sunil K, FA1501001599162 (National Arbitration Forum, February 19, 2015) the Panel held that, "Respondent's use of the contested domain name is an attempt to capitalize on the likelihood that Internet users will be confused as to the possibility of Complainant's association with the contested domain name and its website. Under Policy 4 (b) (iv), this stands as evidence of Respondent's bad faith in the registration and use of the domain name.

"In LEGO Juris A/S Vs. Martin, INDRP/125 (2008): "Where a domain name is found to have been registered with an intention to attract Internet users by exploiting the fame of a well-known trademark, it constitutes bad faith registration." The impugned



domain name is deceptively similar to the Complainant's domain names and prior trademark www.ulta.com and ULTA respectively; it is conclusively proved that the said domain has been registered only to misrepresent itself under the guise of the Complainant. This irrefutably establishes that the said domain has been registered in bad faith by the Respondent.

In Satyam Infoway Ltd. Vs. Sifynet Solutions Pvt. Ltd [AIR 2004 SC 3540], the Respondent had registered domain names www.siffynet.com and www.siffynet.net which were similar to the Plaintiff's domain name www.sifynet.com. The Plaintiff was reputed and Sify was a coined mark comprising of Satyam and Infoway. The Supreme Court of India held that "domain names are business identifiers, serving to identify and distinguish the business itself or its goods and services and to specify its corresponding online location." The decision was in favour of the plaintiff.

In Aqua Minerals Limited Vs. Mr. Pramod Borse & Anr [AIR 2001 Delhi 467], the Delhi High Court observed that "Unless and until a person has a credible explanation as to why did he choose a particular name for registration as a domain name or for that purpose as a trade name which was already in long and prior existence and had established its goodwill and reputation there is no other inference to be drawn than that the said person wanted to trade in the name of the trade name he had picked up for registration or as a domain name because of its being an established name with widespread reputation and goodwill achieved at huge cost and expenses involved in the advertisement."

In the case of Microsoft Corporation Vs. Montrose Corporation, (WIPO Case No. D2000-1568), it was held: "The incorporation of a well-known trademark into a domain name by a registrant having no plausible explanation for doing so may be, in and of

itself, an indication of bad faith.” More importantly, the nature of Respondent’s fraudulent activity in registering a domain name incorporating the ULTA mark not only showcases the full extent of knowledge that the Respondent has of the Complainant, but also the extreme bad faith and mala fide intent of the Respondent, while simultaneously causing damages and prejudice to the business of the Complainant, by unlawfully using the prior and registered ULTA mark of the latter.

The Complainant further submits that the Respondent has failed to comply with Para 3 of the INDRP which requires that it is the responsibility of the Respondent to ensure before the registration of the impugned domain name by him, that the domain name registration does not infringe or violate someone else’s rights. (AB Electrolux vs. Liheng INDRP/700) (August 03, 2015)

That in view of the above arguments the Complainant submits that the Respondent has registered and is using the disputed domain name in bad faith.

Respondent

The Respondent has not replied to the Complainant’s contentions despite repeated opportunities given to him.

Panel Observation

Paragraph 7 of the INDRP provides that the following circumstances are deemed to be evidence that Respondent has registered and used a domain name in bad faith :

“Circumstances indicating that the Respondent has registered or has 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 Registrar’s documented out of pocket costs directly related to the domain name; or

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the Respondent 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 Respondent has engaged in a pattern of such conduct; or

by using the domain name, the Respondent has intentionally attempted to attract internet user to its website or other on -line location, by creating a likelihood of confusion with the Complainant's mark as to the source , sponsorship, affiliation or endorsement of its Website or location or of a product or services on its website or location."

The panel is of the view that from the documents/records and evidence put before it by Complainant has establish that Respondent has no previous connection with the disputed domain name and has made no *bonafide* use of the Disputed domain name .

It is very unlikely that Respondent before registering the domain name ulta.in had no knowledge of Complainant's rights in the trade mark ULTA, which evidences bad faith. It is also a well settled principle that the 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.

This panel observe that the Complainant has successfully secured trademark registrations for the ULTA marks not only in many other countries but also in India and by using the disputed domain name, the Respondent has intentionally attempted to attract, internet users to the disputed domain's website by creating a likelihood of confusion with the Complainant's ULTA marks.

By registering the disputed domain name with actual knowledge of the Complainant's trademark "ULTA", the Respondent acted in bad faith by breaching its service agreement with the registrar because the Respondent registered a domain name that infringes

upon the intellectual Property rights of another entity, which in the present case is the Complainant ULTA Salon, Cosmetic & Fragrance .Inc.

The Respondent's registration of the domain name meets the bad faith elements set forth in the INDRP. Therefore the panel comes to the conclusion that the registration by Respondent is in bad faith. Consequently it is established that the disputed domain name was registered in bad faith or used in bad faith.

Remedies Requested

The Complainant has prayed to this Administrative Panel that the disputed domain <www.ulta.in> be transferred to the Complainant.

Decision

The following circumstances are material to the issue in the present case :

The Complainant through its contentions based on documents/ records and evidence has been able to establish that the Complainant is the premier beauty destination for cosmetics, fragrance, skin, hair care products, and salon services, among others. The mark ULTA, which is the Complainant's very trade name, is popularly known exclusively in relation to the Complainant. It is observed by this panel that the Complainant owns and operates the domain name www.ulta.com, which incorporates the registered ULTA marks and prominently feature the same and the website hosted on the domain is accessible all over the world, including India. The Complainant has also been able to establish that, the Complainant has statutory rights in the Mark ULTA through registration in many countries including India. The Respondent however, has failed to provide any evidence that it has any rights or legitimate interests in respect of the domain name and Respondent is related in any way with the

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Complainant. The Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the disputed Domain Name.

Taking into account the nature of the disputed domain name and in particular the ".in" extension alongside the Complainant's mark which is confusingly similar, which would inevitably associate the disputed domain name closely with the Complainant's group of domains in the minds of consumers, all plausible actual or contemplated active use of disputed Domain Name by the Respondent is and would be illegitimate.

The Respondent also failed to comply with Para 3 of the INDRP, which requires that it is the responsibility of the Respondent to ensure before the registration of the impugned domain name by him that the domain name registration does not infringe or violate someone else's rights. The Respondent should have exercised reasonable efforts to ensure there was no encroachment on any third party rights.

The Complainant has given sufficient evidence to prove extensive trademark rights on the disputed domain name. Whereas, the Respondent's adoption and registration of the disputed domain name is dishonest and done in bad faith.

This panel is of the view that it is for the Complainant to make out a prime facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, Respondent carries the burden of demonstrating rights or legitimate interests in the domain name but the Respondent has miserably failed to do that despite repeated opportunities given to him. Thus it is clear that the Respondent's registration and use of the domain name [ulta.in] is in bad faith. The Respondent has no rights or legitimate interests in respect of the domain name and also the domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

RELIEF

In accordance with Policy and Rules, the Panel directs that the disputed domain name [ulta.in] be transferred from the Respondent to the Complainant; with a request to NIXI to monitor the transfer.

New Delhi, India
Dated : 16th February, 2022


AJAY GUPTA
Sole Arbitrator