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NATIONAL INTERNET EXCHANGE OF INDIA
B Wing, 9th Floor, Statesman House Building
148, Barakhamba Road,
New Delhi-110001

FILA LUXEMBOURG SÁRL.

V/s

Phillip Kaestner

Phillip Kaestner
26/2/2022

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AWARD

1. THE PARTIES

The Complainant is FILA LUXEMBOURG SÁRL, E-mail: mimafidon@fila.com
Address: Boulevard Royal 26, L-2449, Luxembourg Telephone: +39 335 574 22
61, Mobile: +352621531610, by its authorized representative Red Points Solutions,
S.L. (Mrs. Marta Carrera) E-mail: enforcement-ps@redpoints.com Address:
C/Berlin 38-48, 1, 08029 Barcelona, Spain Telephone: +34 93 418 94 33, Fax: +34
93 418 89 35

The Respondent is Phillip Kaestner, Germany, E-mail: -zhuichun7116@sina.com,
Phone +49.0351144741

2. THE DOMAIN NAME AND REGISTRAR:

This Arbitration pertains to a dispute regarding the Domain name
flashoesindia.co.in

The disputed Domain name is flashoesindia.co.in

The abovesaid domain registered particulars in detail is provided and
available in **Annexure-1**.

Registrar Name: Endurance Digital Domain Technology LLP

IANA ID : 801217

Date of creation: 21.06.2019

Date of Expiry : 21.06.2022

Registrant Client ID : EDTRP-10960807

Registrant ROID: C68BCB32A1CFE4FB4892DCBD49E2B698C.IN

Email: zhuichun7116@sina.com

Phone: +49.0351144741

For detail information please refer annexure-1

3. PROCEDURAL HISTORY

- (a) The Complainant has filed a complaint on 19.01.2022 with the
NATIONAL INTERNET EXCHANGE OF INDIA. The Complainant
made the registrar verification in connection with the Domain name at

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issue. The annexures received with the complaint are **Annexure-1 to 6**. The exchange verified the complaint, satisfied the formal requirements of the Indian Domain Name Dispute Resolution Policy (INDRP) (the 'Policy') and the Rules framed thereunder.

- (b) The NIXI has appointed Sh. R.K. Kashyap, Advocate as the Sole Arbitrator in this matter vide letter dated 18.01.2022. The Arbitrator finds that he has been properly appointed. The Arbitrator has submitted his Statement of acceptance and Declaration of Impartiality and Independence on 20.01.2022, as required by the Exchange.
- (c) The Arbitrator, as per the INDRP Policy and the Rules, has duly issued the notice on 20.01.2022 and directed the complainant to serve the Respondent with a copy of the Complaint alongwith annexures on the given e-mail as well as on physical address. In the Notice, it has also been mentioned that the respondent to file the reply/response within 10 days from the receipt of notice. The direction of the arbitrator to serve the respondent has duly been complied with and the complainant sent the notice through mail as well as through courier dated 21.01.2022, the tracking details has also been sent vide No.0816/X12840888, at the address provided in the complaint and the complainant sent the mail in this regard on 24.01.2022. The authorized representative of the complainant also sent the affidavit of service dated 24.01.2022. The respondent is duly served through electronic mode and having complete knowledge about the proceedings before the arbitrator, as such the respondent is deemed served. Despite knowledge, the respondent has not filed any response till date. Hence, the respondent proceeded ex-parte.

4. **Factual Background:**

The following information has been derived from the Complaint and the various supporting annexure to it, the Arbitrator has found the following facts:

Complainant's Activities

- a) The Complainant filashoesindia.co.in, is the registered trademark of FILA in various countries and using it in connection with its ongoing business. The detail of complainant registration are available in **annexure-1**.
- b) The Complainant is the owner of the FILA trademarks, the company was founded in Biella (Piamonte, Italy) by the Fila family in 1911. The brand



has developed different products from cloth to underwear designs and finally sportswear, and has expanded its areas of business and markets from then until now.

- c) One of its big changes was in 1973 when a diversification process was carried out, the first change came with the underwear to knitwear manufacture, and secondly manufacturing sportswear with a revolutionary concept based on innovation and design. This was the year of the change and FILA SPORT was born as a new concept of modern sportswear. It was at that time when the FILA brand became famous all over the world. Their first case of success was the creation of their first ribbed cotton T-shirt for tennis players with the distinctive red-and-blue "F-Box" logo. After this first success, FILA SPORT kept expanding out of Italy giving rise to the new headquarters of FILA France, Fila Deutschland and FILA USA.
- d) In 1976, the company started with the swimming sports world, creating lines for men and women; the development of these new markets led them to patent a special extra thin, highly resistant material for swimsuits capable of lowering water friction.
- e) FILA also has conquered the highly competitive world of athletic footwear in the United States. This brand achieved the second position as a basketball brand in the US in the mid-nineties and number three in terms of overall athletic footwear revenue, in that time, their revenues increased from approx. US\$ 140 million in 1990 to over US\$ 1,424 million in 1997. Moreover, in 1993, shares in FILA Holding SpA were listed on the New York Stock Exchange.
- f) In the eighties, FILA became the sponsor of some of the best racing car drivers back then, but their biggest achievement in this field was signing a partnership agreement with Ferrari to become the official supplier of sportswear, footwear and accessories for the racing teams. This was the same year they signed an agreement with Ducati to design a collection of shoes and apparel with the inspiration of the motorcycle racing world.
- g) Many more sports came later as a FILA's expansion plans developed such as:
 - Golf, with the creation of apparel for Tom Watson, Lee Janzen and Nancy Lopez. The brand became famous in this field due to the collaboration with Massimo Mannelli and the Italian Golf Federation.

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- Ski, with their collaboration with the Italian national ski team. They made a number of high-tech cutting-edge products for the Italian Winter Sports Federation and became the official sportswear supplier for ski champions such as Alberto Tomba, Deborah Compagnoni, Stefania Belmondo, Manuela Di Centa, etc.
- Sailing, FILA supported the Atlantic crossing record of Giovanni Soldini's during the Atlantic Alone race.
- Running, FILA started a research project for footwear; the result of this was race shoes for the FILA marathon team which includes great champions like Moses Tanui, Paul Tergat, German Silva and Gelindo Bordin.
- Football, in 1998 the use of FILA football shoes started to spread because of the sponsorship of some major football clubs such as Fiorentina, West Ham, Hamburg and the outfit of some key football players: Jugovic, Veron, Di Biagio, Mihajlovic, Candela, Nakata and Buffon. FILA is a brand that not only conquered lots of sports disciplines but played a big role in sports worldwide, supplying outfits for individual athletes, being the official supplier of CONI (Italian National Olympic Committee) for the 1984 Olympic Games in Los Angeles, the 1994 Winter Olympics in Lillehammer and the 1998 Winter Olympics in Nagano, as well as of several Federations taking part in the Olympic Games held in Atlanta 1996, Sydney 2000 and Turin 2006. Finally, in 2012 and 2014 FILA was the official apparel supplier of the Korean team in the London and Sochi Olympic Games.

FILA has been the fastest growing brand this year, with a 68% brand value increase to USD\$2.7 billion. The following examples serve to illustrate the importance that the exploitation of the "FILA" brand has achieved internationally:

- FILA performance its very first fashion show during the Milan Fashion week New Yorker article: <https://www.newyorker.com/culture/on-and-off-the-avenue/how-fila-snuck-back-into-favor>.
- h). In India, FILA has achieved great success and popularity in the last few years. There has been an ambitious investment in the Indian market, with

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sales projected to grow over 50% in 2019 and opening 100 stores that year. There are exclusive stores where products bearing the well-known trademark are sold to the Indian public at large, located in Mumbai, Thane and Hyderabad.

- i). In India, FILA has presence through Cravatex Limited, which is licensed to solely design, manufacture and distribute FILA merchandise across India, Sri Lanka, Nepal, Bhutan, Bangladesh and Pakistan. Cravatex also serves as an exclusive licensee for FILA in the Middle East and North Africa.
- j). Additionally, FILA products are available online through the official FILA website and through well-known ecommerce sites such as MYNTRA (<https://www.myntra.com/fila>) and AMAZON (https://www.amazon.in/s?k=Fila&ref=bl_sl_s_sh_web_3930598031).
- k). There is no doubt that the FILA brand is recognised all over the world; one of the reasons why is because of its endorsements and sponsorships by well-known athletes like Björn Borg, Michael Schumacher, Ashleigh Barty, the Italian National Swimming Team or even Virender Sehwang who was the first ever Brand Ambassador in India.
- l). As the brand has expanded its aims to a lifestyle clothing and sneakers line with great success, other sponsors such as BTS, Wang Yuan and Ranvijay Singh Sangha have joined the FILA ranks. In September 2021 FILA announced the incorporation of Diljit Dosanjh, famous singer and actor with 12.3m followers on Instagram, as new Brand Ambassador with the aim of attracting the youth of India, setting trends and catering to the lifestyle of young Indian consumers.
- m). The domains owned by the Complainant are available in Annex 4.
- n). In India, the Complainant is the owner of the registered trademarks under the provisions of The Trade Marks Act 1999, the details are provided in Annexure 2:
- o). Respondent registered without authorization the Domain Name on 21.06.2019, well after Complainant's registration of the FILA.

5. **DISCUSSION AND FINDINGS:**

The Rules instructs 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:-

- a) The Registrant's Domain name is identical or confusingly similar to a name, Trademark or Service mark in which the Complainant has rights;
- b) The Registrant's has no rights or legitimate interests in respect of the Domain name that is the subject of Complaint; and
- c) The Registrant's Domain name has been Registered or is being used in bad faith.

(A). Identical or Confusingly Similar:

- i) The disputed Domain name “**filashoesindia.co.in**” was Registered by the Respondent on 21.06.2019.
- ii) The Complainant is the owner of the FILA trademarks registered in India before the disputed domain name registration date 2019-06-21 (refer Annexure 1 and 2). The Complainant has grown an International business under the FILA trademark. Additionally, by virtue of their longstanding use and the investments made by the Complainant, the FILA trademarks have acquired a great reputation and are well known worldwide, including India.
- iii) The disputed domain name is confusingly similar to the FILA Trademark, as it's demonstrated below in the following comparison: the terms to be compared are the disputed domain name, **filashoesindia.co.in** and the registered trademarks “FILA”.
- iv) The disputed domain name includes the entirety of the Complainant's trademark within their domain name, with an addition of a descriptive term indicating one of the core products sold by the Complainant (shoes) and the targeted market (India).
- v) Previous WIPO UDRP panels have established that the use of the entirety of a registered trademark in a domain is sufficient to fulfill the confusing similarity test, and especially so when the trademark is nationally and internationally reputed and well known, as is the case with FILA as provided above. In *Playboy Enterprises International, Inc. v. Zeynel Demirtas* (WIPO Case No. D2007-0768) the Panel held that “when a domain name wholly incorporates a complainant's registered mark, that may be sufficient to establish confusing similarity for purposes of the Policy. [...] That is particularly true where the trademark is highly recognizable and famous.”

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- vi) Furthermore, the addition of generic descriptive suffixes to the trademark is not sufficient to distinguish or differentiate the disputed domain from the Complainant's trademark. The term "shoes" has the purpose to attract customers looking for FILA shoes, while the term "India" clearly focuses the target audience on the Indian market. In fact, the combination of these terms with the FILA trademark increases the likelihood of consumers to believe there is a commercial relationship between the Complainant and the Respondent's domain.
- vii) Undoubtedly, a consumer accessing the Respondent's domain is expecting FILA shoes to be available in the website's content, not just any brand of shoe. As established by previous Panel's decisions, and exemplified in the decision on Dr. Martens v. Maria Elma states (INDRP CASE No. 1242), "the mere presence of the suffix "shoes" will not distinguish the respondent's disputed domain name, only reinforces the confusion as it relates to the subject matter of the Complainants trademark."
- viii) Contention of Complainant is also squarely covered in Case of *Walmart Stores, Inc. v. Richard MacLead*, (WIPO Case No. D2000-0662) wherein 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. The reliance can be placed on the following cases of NIXI in this regards :-
- NIXI case number INDRP/956,
 - NIXI case number INDRP/997,
 - NIXI case number INDRP/1038,
 - NIXI case number INDRP/992,

Therefore, I hold that the Domain name "filashoesindia.co.in" is phonetically, visually and conceptually identical or confusingly/deceptively similar to the Trademark of the Complainant "FILA".

(B). Rights or Legitimate Interests :

- i) The Respondent has been identified as Phillip Kaetner, the complainant has never authorized the Respondent (whether directly or through an agent or representative) to use or register the domain name filashoesindia.co.in. Furthermore, the Respondent's name and other contact information obtained by the Complainant have no relation to the Complainant's trademark and is highly unlikely to be commonly known by the name FILA.

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- ii) In light of the information available and without any evidence to the contrary from the Respondent. The respondent has no legitimate interest therein. Below is a non-exhaustive list of contents featuring the unlawful uses of the Complainant's exclusive Trademarks and distinctive signs:
- The unauthorised use of the FILA figurative trademark (refer screenshot of Web Archive from 24 November 2021, Annex 3.a). The Respondent incorporated in its website the well-known FILA figurative trademark in the upper and main parts of their website. The FILA trademarks appear in the main part of the website layout design, capturing the attention of the consumer and causing an appearance of the website that causes the impression of being an official Fila website.
 - The use of the FILA figurative trademark in the main part of the website is combined with pictures owned by the Complainant and used by their authorized licensees as exemplified in Annex 5. Additionally, in the upper horizontal menu above the FILA logo and pictures, there are different category options for consumers, the categories are the following: mens, womens, boys, girls (see screenshot of Web Archive from 24 November 2021 in Annex 3. c) where alleged FILA products are categorized and offered by clothing, shoes, underwear and bags. This party declares the Respondent has never been authorised or licensed by the Complainant to sell products using the FILA trademarks.
 - The use of social media links directly to share the website in the consumer's own social media profiles in order to gain further publicity and traffic towards the Respondent's website and stating the owner of the website as "Fila India Online Store" (see screenshot of Web Archive from 24 November 2021 in Annex 3. b).
- iii) Moreover, WhoIs information attached in Annex 1 shows the creation of the disputed domain name to be on June 21st 2019, not only after the registration of Fila trademarks in India and their establishment as a well known brand, but even after the creation and registration of the official website for Fila in India, fila.co.in created on April 2nd 2011 and owned by the Complainant.
- iv) From June 2021, the domain filashoesindia.co.in has been hosting a website to distribute Fila products, including clothing such as hoodies, pants and sweatshirts among others, shoes such as sneakers or flip flops, bags and accessories, using distinctive signs and Trademarks of the Complainant on the website with commercial purposes.

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v) In conclusion of all of the foregoing, the Respondent does not have legitimate rights due to the following:

- a). The Respondent has never been authorised by the Complainant to register the disputed domain name, which clearly exploits the latter's registered trademarks, name and identity.
- b). The Respondent has never been authorised or licensed by the Complainant to sell products under the FILA trademarks.
- c). Consumers were given the impression of navigating on an official FILA website dedicated to the distribution of products produced by the Complainant by using the FILA trademark in the domain name and the website. There is a clear commercial interest of the Respondent to use the FILA Trademark and associate its image with the FILA reputation to attract consumers to mislead consumers into believing it to be an official FILA website and consequently, achieve commercial gain.
- d). Accordingly, it is sufficient that Complainant shows a *prima facie* evidence in order to shift the burden of production on Respondent (see *i.a.*, Bulgari S.p.A. v DomainBook [INDRP/1002], Croatia Airlines d.d. v. Modern Empire Internet Ltd. WIPO Case No. D2003-0455, Belupo d.d. v. WACHEM d.o.o. WIPO Case No. D2004-0110, Sampo plc v. Tom Staver WIPO Case No. D2006-1135, Audi AG v. Dr. Alireza Fahimipour WIPO Case No. DIR2006-0003).

Therefore, concludes that Respondent has no rights or legitimate interests in respect of the Domain Name "Versace.in" as per INDRP policy.

(C). **Registered and Used in Bad Faith:**

- i) There is little doubt that Respondent was not aware of the trademark's worldwide recognition and popularity, seeing as the trademark "FILA" is an established and well known brand worldwide, including India, and it being a registered trademark as shown in Annex 2. The only conclusion that can be drawn is that the registration of the domain name in question has been done in bad faith.
- ii) The Respondent is using the FILA figurative Trademarks in the website layout design and is identifying itself as an official FILA website. The use of the FILA trademark in the domain name in connection with the use of the FILA figurative Trademark in the website to distribute Fila



products and the use of pictures from previous FILA campaigns gives an impression to be an official and authorized FILA website.

- iii) Reference can be pleased to (INDRP CASE No. 1242), the Panel concluded that “the combination of the Complainant’s trademark with the word “shoes” indicates that the respondent was fully cognizant of the Complainants trademark and the commercial standing at the time of registration of the domain name”.
- iv) Refer INDRP CASE No. 1206; “the ICANNs Policy “use in bad faith” requirement is met by registering a domain that will ultimately result in customer confusion.” The above presents evidence of a high likelihood of confusion for consumers to believe that they are on the official FILA website for the Indian market: the addition of “shoes” and “india” to the Complainants’s trademark in the domain name does not provide the customers with a different expectation than accessing the localized website for the indian market with a special focus on the shoe product line of the brand, an aspect which proves again that the Respondent had full knowledge about the existence of the Complainant’s trademark and demonstrates once more the bad faith of the Respondent. There are sufficient indications to affirm that the Respondent intended to impersonate FILA.
- v) It should be kept in mind that the Respondent was using the disputed domain with a clear intention to attract consumers to achieve commercial gain, using its trademarks without prior authorisation and exploiting this to increase their sales of alleged FILA products, actions that divert customers from the official website belonging to the Complainant and lead to a disruption of the Complainant’s business. In this regard, refer WIPO Case No. D2003-0031 “Said use of the contested domain names shows the intention of disrupting the Complainant’s business and/or for the purpose of intentionally attempting to attract, for commercial gain, internet users to its websites, by creating a likelihood of confusion with the Complainant’s trademarks as to the source, sponsorship, affiliation or endorsement of its websites.” Another fact that demonstrates the bad faith of the Respondent is the issue of the additional registrations of domain names the Respondent has made using the FILA trademark. The same IP is shared with 7 other domains as shown in Annexure 6, of which only 1 is currently active, that use the Complainant’s trademark.

Therefore, Respondent could not have possibly ignored the existence of Complainant’s well-known trademark when it registered the identical

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Domain Name < **filashoesindia.co.in**>. Several INDRP and UDRP decisions confirmed that the well-known character of a trademark incorporated in a disputed domain name is a relevant circumstance in the assessment of bad faith registration. See *i.a. Accor v. Jiangdeyun*, WIPO Case No. D2011-2277. See also, along the same lines Perfetti Van Melle Benelux BV v. Jing Zi Xin [INDRP/665] ; Bulgari S.p.A. v DomainBook [INDRP/1002](*supra*) and Amazon Technologies Inc. v. Surya Pratap [INDRP/835].

Complainant submits that, by using the Domain Name, Respondent has intentionally attempted to attract Internet users to its website, by creating a likelihood of confusion with Complainant's trademark as to the source, sponsorship, affiliation or endorsement of Respondent's website or the products or services promoted through the Respondent's website, according to Rule 7 (c) of INDRP Policy.

In view of the above, it is clear that the Domain Name was registered and is being used by Respondent in bad faith according to Paragraph 4(c) of the INDRP.

6. **DECISION**

In light of the foregoing findings, namely, that the Domain name is confusingly/deceptively similar to Complainant's well-known brand "FILA", a mark in which the Complainant has rights, that the Respondent has no claims, rights or legitimate interests in respect of the disputed Domain name, and that the disputed Domain name was Registered in bad faith and is being used in bad faith, in accordance with the policy and the rules, the Arbitrator orders that the Domain name "**filashoesindia.co.in**" be transferred to the Complainant.

This award is passed at New Delhi on this 24th day of February, 2022.

Devi Singh
24/2/2022

R. K. KASHYAP
SOLE ARBITRATOR