

मध्य प्रदेश MADHYA PRADESH

BN 840497

BEFORE THE ARBITRATOR RAJESH BISARIA
UNDER THE
.IN DOMAIN NAME DISPUTE RESOLUTION POLICY (INDRP)
[NATIONAL INTERNET EXCHANGE OF INDIA (NIXI)]

ARBITRAL AWARD

Date-18.04.2022

Disputed Domain Name: www. peterbilt.in
INDRP Case no -1507

THE PARTIES

(1)

The **Complainant** is PACCAR Inc. 777 106th Avenue, N.E. Bellevue, WA98004, USA

The **Respondent** is Alice Collier 4682 Haven Lane Lansing, MI 48933, United State of America.

THE DOMAIN NAME AND REGISTRAR

(2)

- (a) This dispute concerns the domain name bearing DOMAIN ID -. D223FE62A201F4CF0B4BDB489FD1B6B5B-IN is identified as **www. peterbilt.in**
- (b) The disputed domain name: **www. peterbilt.in** is registered with Registrar Dynadot LLC.

PROCEDURAL HISTORY

(3)

The NIXI appointed RAJESH BISARIA as Arbitrator from its panel as per paragraph 5(b) of INDRP Rules of procedure	25.02.2022
Arbitral proceedings were commenced by sending notice to Respondent through e-mail as per paragraph 4(c) of INDRP Rules of Procedure, marking a copy of the same to Complainant's authorized representative and NIXI .	26.02.2022
Due date of submission of Statement of Claim by Complainant (instructed by mail dated 26.02.2022)	05.03.2022
Complainant's response by submitting their Statement of Claim. Soft copy Hard copy	05.03.2022 07.03.2022
Due date of submission of Statement of Defense by Respondent (instructed by mail dated 26.02.2022)	12.03.2022
Further due date of submission of Statement of Defense by Respondent (instructed by mail dated 13.03.2022)	19.03.2022
Respondent's response by submitting their Statement of Defense against the due date of submission as 12.03.2022 & 19.03.2022	Not submitted
Complainant's response by submitting their Rejoinder. (Statement of Defense not submitted by Respondent)	Not required
Complainant's response by submitting proof of delivery of complaint along with all annexures to Respondent . Complainant Intimated vide their mail dated 17.03.2022 that-	17.03.2022

<i>Insofar as service of the hard copy of the Complaint as well as documents to the Respondent is concerned, we have been informed by the Courier agency that on account of incomplete address details, they are unable to deliver the same. Re service via email is concerned, please note that our email dated March 05, 2022 has returned undelivered and attached email.</i>	
Communicated by AT mail dated 30.03.2022 that the 'Respondent failed to submit the required documents within the time limit mentioned in mail ie 26.02.2022 and 13.03.2022 ie 12.03.2022 & 19.03.2022 respectively and even upto 30.03.2022 , therefore the Respondent lost their right to entertain it. The proceeding of this case was kept closed for award and the matter would be decided ex-parte on the basis of the material on record with this tribunal as per INDRP policy'.	30.03.2022
The language of the proceedings.	English

FACTUAL BACKGROUND

(4) The Complainant :

The **Complainant** is PACCAR Inc. 777106th Avenue, N.E.
Bellevue, WA98004 , USA

Authorized Representative of the Complainant:

Remfry & Sagar
Remfry House at the Millennium Plaza
Sector-27, Gurgaon-122009
Email: remfry-sagar@remfry.com; ca.brijesh@remfry.com;
dhruv.grover@remfry.com
Fax: 0124-2806101; 2572123
Phone: 0124-2806100; 4656100

Preferred Mode of Communication

To the Complainant's attorneys by e-mail and/or post

(5) **The Respondent:**

The **Respondent** is Alice Collier 4682 Haven Lane Lansing, MI 48933,
United State of America

(6) **Complainant's Activities:**

(a) PACCAR Inc. (hereinafter referred to as “**Complainant**”) is a global technology leader in the design, manufacture and customer support of premium light, medium and heavy-duty trucks under the *Kenworth*, *Peterbilt* and *DAF* nameplates. The Complainant also designs and manufactures advanced diesel engines, provides financial services, information technology, and distributes truck parts related to its principal business.

(b) In the year 1905, William Pigott, Sr. founded *Seattle Car Mfg. Co.* to produce railway and logging equipment at its plant in West Seattle. The Company later merged with Twohy Brothers of Portland to become ‘Pacific Car and Foundry Company’ (PACCAR), a name it retained for the next 55 years. The Complainant entered the heavy-duty truck market in 1945 with its first major acquisition, *Kenworth Motor Truck Company* of Seattle. Pacific Car and Foundry greatly expanded its heavy-duty truck capability with the purchase of *Peterbilt Motors Company* in 1958. That same year, the acquisition of *Dart Truck Company* permitted its entry into the entirely new market of mining vehicles. Later, it played a major part in the construction of the *Grand Coulee Dam*’s third powerhouse as well as New York City’s World Trade Center. In the year 1960, the Complainant became an international truck manufacturer. In 1973, *PACCAR International Inc.*, with headquarters in Bellevue, Washington, was formed to consolidate the sales and service of company products abroad, and *PACCAR Parts Division* was established in Renton to supply aftermarket parts sales.

(c) In the year 1986, the Complainant signed a merger agreement

- with *Trico Industries, Inc.*, and became a recognized world leader in manufacturing oil field pumps and accessories.
- (d) The acquisition of *DAF Trucks N.V.* in 1996 and *Leyland Trucks* in 1998 established the Complainant as one of the major truck manufacturers in the world. In the year 2010, the Complainant unveiled its *PACCAR MX engine line* for North America. The Complainant invested \$400 million in the PACCAR Engine factory and technology center in Columbus, Mississippi, to assemble the proprietary engines.
 - (e) The Complainant at present delivers its products and services to customers worldwide through an extensive dealer network of 2,200 locations, including in India. PACCAR Global sells its products in more than 100 countries and is expanding its dealer network in Asia and throughout the world. Approximately half of the Complainant's revenues and profits are generated outside the United States. *PACCAR Parts* operates a network of parts distribution centers offering aftermarket support to Kenworth, Peterbilt and DAF dealers and customers around the world. Aftermarket support includes customer call centers operating 24 hours a day throughout the year and technologically advanced systems to enhance inventory control and expedite order processing.
 - (f) *PACCAR Financial Services* provides finance, lease and insurance services to dealers and customers in 24 countries including a portfolio of more than 180,000 trucks and trailers and total assets in excess of \$13 billion. The group includes PACCAR Leasing, a major full-service truck leasing company in North America, with a fleet of 38,000 vehicles. Environmental responsibility is one of the Complainant's core values. The company regularly develops new programs to help protect and preserve the environment and the Complainant has established ambitious goals to further reduce emissions and enhance fuel efficiency in its truck models. The *PACCAR Foundation* grants millions of dollars each year for education,

social services and the arts. The Complainant and its employees' charitable contributions demonstrate a strong commitment to the communities in which they work and live.

(7) Complainant's Trade Marks And Domain Names :

- (a) PETERBILT was founded in 1939 and has been the Class of the trucking industry ever since. For past 80 years, PETERBILT has been creating purpose-built vehicles crafted to stand the test of time. PETERBILT trucks have been innovative from the beginning, with the dual- drive, lightweight Model 334 with its all- steel cab, as well as the chain- drive Model 260. From the year 1939- 1945, PETERBILT put its growing expertise at the service of the country. PETERBILT introduced the Model 350 in the late 1940s, later updated to feature the unique bubble-nose, cab-over-engine design. Meanwhile, the Model 351 was introduced in 1954, beginning the longest production run in the company history.
- (b) In the year 1958, the Complainant acquired PETERBILT, beginning a relationship that has lasted for over 60 years and counting. In the year 2019, Peterbilt celebrated 80 years of purposeful innovation, enduring craftsmanship, individualized solutions and pride and class. Even after 80 years, PETERBILT remains the industry's truck of choice. Few extracts evidencing the recognition and goodwill associated with Complainant's PETERBILT brand are marked and submitted as Annexure-B.
- (c) In addition to the aforesaid, the company's website, www.peterbilt.com is its primary presence on the Internet for global promotion. Additionally, the website www.paccar.com clearly shows references to the Complainant's brand 'PETERBILT'. The website is accessible worldwide, including in India and the public can gather extensive information about the Complainant, and its PETERBILT brand. Further, the Complainant's recognition and appreciation can be evidenced

from social networking sites, for instance, its followers on Facebook and Twitter. Screenshots of the said social media sites are marked and submitted as Annexure-C.

- (d) The Complainant has taken utmost care to secure statutory rights in the mark 'PETERBILT'. The mark PETERBILT stands registered across the globe for varied goods and services with the earliest registration dating back to the year 1963 in the USA. An illustrative list comprising some of the Complainant's registrations in respect of the mark PETERBILT were also submitted along with Registration number/Country, date of application and their class. Annexed herewith and submitted as Annexure-D are the copies of few such trade mark registrations. As is thus evident, the trade mark PETERBILT forms an integral part of the Complainant's business/activities and serves as its principal trade mark and domain name/website.
- (e) Further, the Complainant owns several domain names comprising the PETERBILT trademarks under different Top-level domains (TLDs) and county code top-level domains (ccTLD). Complainant's domain name 'peterbilt.com' stands registered since June 12, 1996. As evident from the aforesaid, the Complainant is the sole registered proprietor of several domain names containing 'PETERBILT'. It is pertinent to note that the Complainant's website is very popular amongst Internet users, disseminates valuable information and is a source of knowledge of its activities under the PETERBILT marks. Extracts from the WHOIS database are marked and submitted as Annexure-E.
- (f) In view of the foregoing, it is evident that the mark PETERBILT has on account of extensive and continuous use and trade mark registrations, become exclusively identified with the Complainant and its business. Therefore, the Complainant's trade mark/name PETERBILT has all the characteristics of 'well-known' mark and with Complainant's global presence, has acquired goodwill and reputation in the aforesaid mark.

(g) The Complainant not only possesses statutory rights by virtue of its registrations for the mark, but also acquired significant common law rights. The said marks are representative of the Complainant's brand identity, business reputation and public identification throughout the globe, including India. The Complainant has invested years of time, capital, efforts and resources and attained immense goodwill and reputation in the trade mark PETERBILT. The said marks have acquired a secondary meaning and are exclusively identified with the Complainant. In fact, Complainant has been extremely vigilant in protecting its intellectual property rights in the trade mark PETERBILT and has taken stringent legal actions against third party infringers across the globe. In this regard, complainant has secured successful orders from WIPO Arbitration and Mediation Center. Copies of the said orders are annexed and submitted as Annexure-F.

(8) Respondent's Identity and activities :

- (a) Recently, the Complainant became aware of a domain name viz. 'peterbilt.in' registered in the name of 'Alice Collier 4682 Haven Lane Lansing, MI 48933, United State of America (hereinafter referred to as the "Registrant"). The impugned domain name 'peterbilt.in' was registered on May 21, 2021, many years after the Complainant's first adoption and use of the trade mark/domain name registration. The Registrar of the domain is Dynadot LLC, and the impugned domain expires on May 21, 2022. The WHOIS records in respect of the domain name in question is attached herewith, marked and submitted as Annexure-G.
- (b) Upon visiting the website of the Registrant, it is clearly visible that www.peterbilt.in is a parked page containing ads/links to car insurance related content. A perusal of the aforesaid website

has revealed that the webpage was generated by the owner using 'Sedo Domain Parking', a website that facilitates generation of 'parked domains' for the sole purpose of selling the same. Annexed hereto and submitted as Annexure-H is a printout of the impugned website www.peterbilt.in.

- (c) It is evident that the Registrant is using the objectionable domain name illegally and dishonestly, only to derive unjust pecuniary gains. There is no iota of doubt that the impugned domain name is identical to the Complainant's trade mark PETERBILT and domain name peterbilt.com. The Complainant submits that the Registrant's impugned domain name 'peterbilt.in' may be transferred to the Complainant or the same may be cancelled forthwith on the following, amongst other grounds, which are exclusive and without prejudice to each other.

SUBMISSIONS BY COMPLAINANT

- (9) Complainant submitted Domain name complaint with pages 1 to 32 and annexure from A to J (Pages from 33 to 130)

As per the INDRP Rules of Procedure, Clause 4(a) –

The (maximum) word limit shall be 5000 words for all pleadings individually (excluding annexure). Annexure shall not be more than 100 pages in total. Parties shall observe this rule strictly subject to Arbitrator's discretion.

The Complainant submitted Pleadings of more or less 5000 words and annexure within 100 pages. The application is submitted as per the INDRP Rules and Procedures.

- (10) Complainant was directed to submit proof of delivery of complaint along with all annexure (to Respondent) to the AT.
- (a) In this regard, it is observed that Complainant had sent to Respondent, the soft copy of their complaint along with all

annexures & other documents , vide their mail dated Soft copy sent vide mail dated 05.03.2022 .Apart from this NIXI had also sent complaint along with all annexure to all concerning including Respondent vide their mail dated 25.02.2022.

(b) Hard copy of the same was sent by Complainant to Respondent's address via DHL courier and shipped on 04.03.2022. The DHL Waybill number is 7338794153,

(c) Complainant Intimated vide their mail dated 17.03.2022 that-

Insofar as service of the hard copy of the Complaint as well as documents to the Respondent is concerned, we have been informed by the Courier agency that on account of incomplete address details, they are unable to deliver the same. Re service via email is concerned, please note that our email dated March 05, 2022 has returned undelivered and attached email..

THE CONTENTIONS OF THE COMPLAINANT

(11) **The domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights:**

(a) The Registrant's impugned domain name 'peterbilt.in' is identical to and comprises in its entirety the Complainant's trade/service mark/name PETERBILT, which is a registered trade mark of Complainant. It is submitted that the Registrant has registered the impugned domain name 'peterbilt.in' with the *mala fide* intent to gain undue leverage from it by barring the Complainant from using the impugned domain. It is evident that the objectionable domain name registered by the Registrant, has no meaning or significance independent of the Complainant's trade/service mark/name PETERBILT. The well-known nature of the Complainant's trade mark PETERBILT and the Registrant's use of the same clearly establishes that the Registrant registered the impugned domain name with full knowledge of the Complainant, its business activities and

intellectual property rights. The unmistakable identity/deceptive similarity between the Complainant's corporate name and mark on one hand and Registrant's choice of its domain name on the other hand, is patently misleading to the consuming public.

- (b) The Complainant states that the impugned domain name 'peterbilt.in' is identical/similar to complainant's domain name 'peterbilt.com'.
- (c) It is further submitted that as per the WHOIS record, the impugned domain name 'peterbilt.in' was registered on May 21, 2021 whereas the Complainant's domain 'peterbilt.com' was created/registered many years before the impugned domain name, on June 12, 1996. The trade mark 'PETERBILT' stands registered in Complainant's name globally since 1962. The said mark also stands registered in India since 2011. Thus, the Complainant's adoption and use of the trade/service mark/domain name comprising PETERBILT is much prior to the Registrant's registration of the impugned domain name 'peterbilt.in'. In view of the same, it is apparent that the Complainant has prior rights in the trade/service mark/domain name comprising PETERBILT *vis – a – vis* the Registrant.

(12) **The Respondent has no rights or legitimate interests in Respect of the domain name:**

- (a) As regards Paragraph 6(a), it is submitted that the Registrant's adoption and use of a dishonestly adopted and confusingly similar domain name does not amount to a '*bona fide*' offering of goods and services. Given the Complainant's mark's well-known nature, its widespread use and repute in the world, including in India, and the factum of Registrant acquiring the impugned domain for the sole purpose of being able to sell it to the rightful owners, the Registrant's such adoption thereof to provide services under the impugned domain name is not *bona fide*. Intentional ignorance of the Registrant in disregarding the Complainant's pre-existing trade mark and domain name, and commencing use of a domain name comprising PETERBILT evidences its *mala fide*. It is trite law in respect of domain name proceedings that use which dishonestly and intentionally

rides on the reputation of another mark cannot constitute '*bona fide*' offering of goods and services. The mere fact that the Registrant has used the impugned domain name to conduct business (by hoarding the said domain name for the purpose of selling it for a price) is not sufficient to show that it has a right/legitimate interest or is *bona fide* offering goods or services. This *mala fide* intent is further evidenced by the use of the domain name openly as a Sedo Domain for the mere purposing of acquiring pecuniary gains. Therefore, by no stretch of the imagination, can the Registrant demonstrate any use relating to the *bona fide* offering of goods or services before any notice of this dispute or at any point in time whatsoever.

(b) Regarding paragraph 6(b), it is submitted that the Registrant is not commonly known by the domain name 'peterbilt.in' (in fact, it has completely redacted its identity from relevant records), and is not authorized or licensed by the Complainant to use its mark/name PETERBILT. Further, the Complainant has first used the mark PETERBILT in the year 1963 and registered the domain and trade/service mark comprising PETERBILT since the year 1962. Due to the extensive and continuous use of the PETERBILT trademarks, the same have become well-known and come to be exclusively associated with the Complainant and no one else. Hence, the Registrant cannot establish any association with the domain name in question for any reason/s whatsoever. When typing "Peterbilt" into the Google search engine, the Complainant's PETERBILT is the first and second result on the page.

(c) With respect to paragraph 6(c), it is submitted that the Registrant is not making any legitimate non-commercial or legitimate fair use of the domain name. In fact, the conduct of the Registrant as highlighted above cannot come under the definition of *bona fide* use. Registration of the impugned domain is aimed to benefit from the immense goodwill and reputation of the Complainant's trade mark PETERBILT, divert visitors/customers by creating initial Internet confusion and thereby commercially profit from use of the Complainant's trade/service mark/name PETERBILT. Thus, the

Registrant is indulging in (i) unfair use of the domain name with an intention to reap profits there from, (ii) tarnishing the goodwill and reputation enjoyed by the Complainant's well – known trade/service mark/name PETERBILT. The Registrant, therefore, cannot justify any legitimate interest in the domain name 'peterbilt.in'.

(13) **The domain name was registered and is being used in bad faith:**

- (a) Insofar as Paragraph 7(b), it is certain that the Registrant was aware of the Complainant's prior rights in its registered marks, as well as of Complainant's business, and yet chose to adopt the suspiciously similar domain name 'peterbilt.in' which leads to a website depicting links and ads of car insurance related content, which is nowhere close to what the Complainant undertakes on its website. Registration of the impugned domain name 'peterbilt.in' is detrimental to the Complainant's statutory right in the registered trade mark PETERBILT. Further, unlike most of the domain names comprising PETERBILT, which are registered in the name of the Complainant, the impugned domain name comprising PETERBILT is being unnecessarily held by the Registrant, thereby preventing a rightful holder to register and use the same in relation to the Complainant's business/ services/products.
- (b) As regards Paragraph 7(c), the conduct of the Registrant amply proves its *mala fide* to attract Internet users to its website by using the mark/name of the Complainant and consequently creating a likelihood of confusion as to the source, sponsorship, affiliation of the Registrant's website and/or of a product on the Registrant's website. Further, Internet users desirous of accessing the Complainant's website will inevitably get confused and therefore may be led to the impugned website. Thus, the Registrant's website may be accessed believing it to still be affiliated with the Complainant and users may access and use Registrant's services believing them to still originate from the Complainant.

- (c) Bad faith, on account of the Registrant is further evidenced by the fact the Registrant purposely registered the impugned domain name, solely looking for a payday from the Complainant in an untoward manner. The Registrant's possession of the domain name in question is therefore an act of bad faith.

(14) **Remedy Sought:**

The Complainant most humbly prayed that:

- (a) In accordance with Paragraph 14 of INDRP Policy and subject to all provisions thereof, order the Registrant not to transfer the domain name 'peterbilt.in' until conclusion of the arbitration proceedings;
- (b) The impugned domain name 'peterbilt.in' presently in the name of the Registrant be transferred in favour of the Complainant; and
- (c) An order for costs of the proceedings as may be deemed fit be passed in accordance with Paragraph 10 of the INDRP Policy

(15) **Other Legal Proceedings:**

The Complainant has not submitted any information regarding commencement or termination of any other legal proceeding related to this disputed domain name that is the subject of the Amended Complaint.

RESPONSE BY THE RESPONDENT

- (16) Respondent failed to submit the required documents within the time limit mentioned in mail ie 26.02.2022 and 13.03.2022 ie 12.03.2022 & 19.03.2022 respectively and even upto 30.03.2022. Communicated by AT vide mail dated 30.03.2022 that the Respondent lost their right to entertain it. The proceeding of this case was kept closed for award and the matter would be decided ex-parte on the basis of the material on record with this tribunal as per INDRP policy.

REJOINDER BY THE COMPLAINANT

- (17) Since Respondent failed to file the Statement of Defense , so there is no question of submitting the Rejoinder by the Complainant.

DISCUSSION AND FINDINGS

- (18) After going through the correspondence, this AT comes to the conclusion that the Arbitral Tribunal was properly constituted and appointed as per Clause 5 of the INDRP Rules of Procedure by NIXI and Respondent has been notified of the complaint of the Complainant.
- (19) Respondent was given enough opportunity to submit Reply of Complaint (Statement of Defense) from by 12.03.2022 and 19.03.2022. But Respondent failed to submit the same within said time limit and even upto 30.03.2022, therefore the Respondent had lost their right to entertain it. The proceeding of this case was kept closed for award on 30.03.2022 and now the matter is be decided ex-parte on the basis of the material on record with this tribunal as per INDRP policy.
- (20) Under Clause 4, of the .IN Domain Name Dispute Resolutions policy (INDRP), the Complainant must prove each of the following three elements of its case:
- (a) The Respondent's domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
 - (b) The Respondent has no rights or legitimate interest in respect of the domain name; and
 - (c) The Respondent's domain name has been registered or is being used in bad faith.

- (21) **The Respondent's domain name is identical or confusingly Similar to a trademark or service mark in which the Complainant has rights:**

Facts & Findings

- (i) On the basis of the submitted facts by Complainant and due to non submission of Statement of Defense by Respondent, the Arbitral Tribunal concludes that the Complainant has established 4(a) of the .IN Domain Name Dispute Resolution Policy (INDRP) and accordingly satisfies the said Clause of policy.

- (22) **The Respondent has no rights or legitimate interest in respect of the domain name:**

Facts & Findings

- (i) On the basis of submitted facts by Complainant and due to non submission of Statement of Defense by Respondent , the Arbitral Tribunal concludes that the Complainant has established Clause 4(b) of the .IN Domain Name Dispute Resolution Policy (INDRP) and accordingly satisfies the said Clause of policy.

- (23) **The Respondent's domain name has been registered or is being used in bad faith:**

Facts & Findings

- (i) On the basis of submitted facts by Complainant and due to non submission of Statement of Defense by Respondent, the Arbitral Tribunal concludes that the Complainant has established Clause 4(c) of the .IN Domain Name Dispute Resolution Policy (INDRP) and accordingly satisfies the said Clause of policy.

(24) **ARBITRAL AWARD**

I, Rajesh Bisaria , Arbitrator, after examining and considering the pleadings and documentary evidence produced before and having applied mind and considering the facts, documents and other evidence with care, do hereby publish award in accordance with Clause 12 & 13 of the INDRP Rules of Procedure and Clause 10 of .IN Domain Name Dispute Resolution Policy (INDRP), as follows:

Arbitral Tribunal orders that the disputed domain name

WWW. PRIDESTAFF.IN

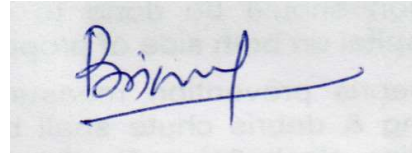
be forthwith TRANSFERRED from Respondent to Complainant.

Further AT takes an adverse view on the bad faith registration of impugned domain by the Respondent and to restrict the act for future misuse, fine of Rs 10000/- (Rs Ten thousand only) is being imposed on the Respondent, as per the provision in clause 10 of .IN Domain Name Dispute Resolution Policy (INDRP) to be paid to .IN Registry for putting the administration unnecessary work.

AT has made and signed this Award at Bhopal (India) on 18.04.2022
(Eighteenth Day of April, Two Thousand Twenty Two).

Place: Bhopal (India)

Date: 18.04.2022



(RAJESH BISARIA)

Arbitrator