



सत्यमेव जयते

INDIA NON JUDICIAL

Government of National Capital Territory of Delhi

e-Stamp

Certificate No. : IN-DL97486520009688U
Certificate Issued Date : 06-Oct-2022 10:49 AM
Account Reference : IMPACC (IV)/ dl815803/ DELHI/ DL-DLH
Unique Doc. Reference : SUBIN-DL81580374007083862086U
Purchased by : AJAY GUPTA
Description of Document : Article 12 Award
Property Description : Not Applicable
Consideration Price (Rs.) : 0
(Zero)
First Party : AJAY GUPTA
Second Party : Not Applicable
Stamp Duty Paid By : AJAY GUPTA
Stamp Duty Amount(Rs.) : 10
(Ten only)



Please write or type below this line

INDRP ARBITRATION CASE NO.1615
THE NATIONAL INTERNET EXCHANGE OF INDIA (NIXI)

ADMINISTRATIVE PANEL DECISION
SOLE ARBITRATOR: AJAY GUPTA

HERO MOTOCORP LIMITED
The Grand Plaza, Plot No.2, Nelson Mandela Road
Vasant Kunj - Phase -II, New Delhi-10070.

... Complainant

VERSUS

NONE
2, Shenzhen, Guangdong-518000 (CHINA).
Telephone (+86)17722606611
E Mail: wandou2022@protonmail.com

... Respondent

Disputed Domain Name: "HERO-INDIA.IN"

Statutory Alert:

1. The authenticity of this Stamp certificate should be verified at 'www.shcilestamp.com' or using e-Stamp Mobile App of Stock Holding. Any discrepancy in the details on this Certificate and as available on the website / Mobile App renders it invalid.
2. The onus of checking the legitimacy is on the users of the certificate.
3. In case of any discrepancy please inform the Competent Authority.

Ajay

INDRP ARBITRATION CASE NO.1615
THE NATIONAL INTERNET EXCHANGE OF INDIA (NIXI)

ADMINISTRATIVE PANEL DECISION
SOLE ARBITRATOR: AJAY GUPTA

HERO MOTOCORP LIMITED

VERSUS

NONE

DISPUTED DOMAIN NAME: **"HERO-INDIA.IN"**

A handwritten signature in black ink, appearing to read 'Ajay', with a long horizontal line extending from the end of the signature.

INDRP ARBITRATION CASE NO.1615
THE NATIONAL INTERNET EXCHANGE OF INDIA (NIXI)

ADMINISTRATIVE PANEL DECISION
SOLE ARBITRATOR: AJAY GUPTA

HERO MOTOCORP LIMITED
The Grand Plaza, Plot No.2,
Nelson Mandela Road, Vasant Kunj - Phase -II,
New Delhi-10070. ... Complainant

VERSUS

NONE
2,Shenzhen,
Guangdong-518000,
China.
Telephone (+86)17722606611
E Mail: wandou2022@protonmail.com ... Respondent

Disputed Domain Name: "**HERO-INDIA.IN**"



1. THE PARTIES

1.1 The **Complainant** HERO MOTOCORP LIMITED in this arbitration proceedings is a company organized and existing under the Companies Act, 1956 in India, and its contact address is: The Grand Plaza, Plot No.2, Nelson Mandela Road, Vasant Kunj Phase-II, New Delhi-110070.

1.2 The Complainant's authorized representative in this administrative proceeding is Ms. Purnima Dogra
Address: The Grand Plaza, Plot No.2, Nelson Mandela Road, Vasant Kunj - Phase -II, New Delhi - 110070
Telephone: +91-11-49414504 Fax: +91-11-26143321
E-mail: purnima.dogra@heromotocorp.com

In this arbitration proceeding, the Respondent is :
NONE,
2, Shenzhen, Guangdong-518000 (CHINA).
Telephone (+86)17722606611
E-Mail: wandou2022@protonmail.com

as per the details given by the WHOIS database maintained by the National Internet Exchange of India (NIXI).

2. The Domain Name and Registrar

2.1 The disputed domain name is "HERO-INDIA.IN" and the Registrar with which the disputed domain name is registered is Dynadot LLC, Address: 210 S Ellsworth Ave #345 San Mateo, CA 94401 US.

3. PROCEDURAL HISTORY [ARBITRATION PROCEEDINGS]

3.1 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 under the .IN Dispute Resolution Policy and Rules framed thereunder.

3.2 The history of this proceeding is as follows:

3.2.1 In accordance with Rules 2(a) and 4(a), NIXI on 28.09.2022 formally notified the Respondent of the complaint along with a copy of the complaint & annexures/documents, 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 thereunder, IN Domain Resolution Policy and the Rules framed thereunder. That the Arbitrator submitted the Statement of Acceptance and Declaration of Impartiality and Independence Dated 28.09.2022 to NIXI.

3.2.2 That commencing the arbitration proceedings an Arbitration Notice Dated 30.09.2022 was emailed to the Respondent on 30.09.2022 by this panel under Rule 5(c) of INDRP Rules of Procedure with direction to file a reply of the complaint, if any, within 10 days.

3.2.3 This panel vide its mail dated 29.09.2022 had directed the Complainant to update the domain

complaint with the registrant's missing details and send the same to all including the respondent. The Complainant in compliance with this panel's directions vide its mail dated 29.09.2022 filed the amended complaint before this panel and also emailed the same to the Respondent. The Complainant through its mail dated 03.10.2022 to this panel also furnished /submitted a receipt of courier as proof of dispatch of a physical copy of the amended complaint to the Respondent.

3.2.4 This panel vide its Arbitration Notice dated 30.09.2022 had directed the Respondent to file the reply of complaint, if any, within 10 days of the notice and therefore respondent was supposed to file the reply of the complaint by 09.10.2022.

3.2.5 However, since the Respondent failed to file the reply of Complaint, if any, within time i.e. by 09.10.2022 as directed by this panel, this panel again in the interest of justice vide its mail dated 10.10.2022 granted a further period of 05 days i.e. by 14.10.2022 to the respondent to file the reply of the complaint. The Respondent, despite the receipt of Notice Dated 30.09.2022 and reminder dated 10.10.2022 neither replied to the Arbitration notice nor filed a reply of complaint; hence, on 15.10.2022 the respondent proceeded ex-parte.

4. THE RESPONDENT'S DEFAULT

4.1 The Respondent failed to reply to the notice regarding the complaint. It is a well-established

principle 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 proof that it has some legitimate interest in the domain name to rebut this presumption. The disputed domain name in question is "hero-india.in".

- 4.2 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."

- 4.3 The Respondent was notified of this administrative proceeding per the Rules. The .IN discharged its responsibility under Rules paragraph 2(a) to employ reasonably available means calculated to achieve actual notice to the Respondent of the complaint.
- 4.4 The panel finds that the Respondent has been given a fair opportunity to present his case. The Respondent was given direction to file a reply of the Complaint if any, but the Respondent neither gave any reply to notice nor to the complaint despite repeated opportunities. The 'Rules' paragraph 12 states, "In the 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 the law." In the circumstances, the panel's decision



is based upon the Complainant's assertions, evidence, inferences, and merits only as the Respondent has not replied despite repeated opportunities given in this regard and is proceeded ex parte.

5. BACKGROUND OF THE COMPLAINANT & ITS SUBMISSIONS ABOUT THE TRADEMARK "HERO", ITS STATUTORY AND COMMON LAW RIGHTS ADOPTION :

- 5.1 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 :
- 5.2 The Complainant submits that the Complainant is a company organized and existing under the Companies Act, 1956, and is a part of the HERO Group of Companies, including inter-alia Hero Invest Corp Private Limited, other affiliates, predecessors-in-interest, title, and rights.
- 5.3 The Complainant submits that it is a part of the reputed HERO group of companies, the earliest of which was established in the 1950s for the manufacture and sale of bicycles and parts thereof. As of date the HERO group companies are engaged in diverse business activities including but not limited to the manufacture and sale of automobiles (two-wheelers) and their parts and fittings, financial solutions, insurance, investments, planning, advisory execution, and monitoring of investments.
- 5.4 The Complainant submits that one of the Complainant's Group's companies Hero Invest Corp

Private Limited was incorporated on December 4, 1981, inter alia with the objective to apply for, register, own, develop, create, purchase or by other means acquire and protect, prolong and renew any IPR, goodwill, licenses, secret processes or let on lease or otherwise mortgage, charge, or encumber the same.

5.5 The Complainant submits that the word HERO forms the forepart and most distinguishing feature of the Complainant's corporate name and trading style and the name of some of the Complainant's other group companies, all of whom are using the name HERO with the permission/authority/license from one of the Hero group company, namely, Hero Invest Corp Private Limited since Hero Invest Corp is the owner of the reputed trademarks HERO and composite marks with the brand HERO used in conjunctions with other words/devices/logos including the trademarks Hero MotoCorp and H device and the Complainant is authorized/permitted user of these trademarks.

5.6 The Complainant submits that the Complainant was incorporated on January 19, 1984, and is the largest manufacturer of motorcycles and scooters having cumulative sales of 100+ million two-wheelers since its inception. It is the No.1 two-wheeler manufacturer company in the world for the last 21 consecutive years having a market share of 34.6% in the domestic two-wheeler market and a market share of 48.3% in the domestic motorcycles market with a global presence in about 43 countries. The Complainant has an extensive sales and service



network which spans over 9000 customer touchpoints. The Complainant markets sell and advertise its products under the distinctive marks HERO and Hero MotoCorp which is also a part of its trade name. The Complainant also owns the popular website www.heromotocorp.com which consumers, members of trade, and public at large associate solely with the Complainant.

- 5.7 The Complainant submits that the trademark HERO was adopted as a trademark in the year 1950 by Hero Group Companies. The Complainant has been using the brand name "Hero" since 1984. The mark Hero is registered globally in around 122 countries.
- 5.8 The Complainant submits that in India, the Complainant is authorized to use the trademarks/ name HERO, Hero Moto Corp and H Device by Hero Invest Corp for Complainant's businesses and the same are valid, subsisting, and exclusively used only by the owner and are licensed to Complainant. The Complainant submits that several applications are pending in various classes for the trademark HERO, Hero MotoCorp, H Device, and HERO formative marks.
- 5.9 The Complainant submits that the trademark HERO, Hero MotoCorp and H Device have been used continuously, uninterruptedly, and unopposed by the Complainant over the past several years. The trademarks HERO, Hero MotoCorp, and H device forms the most distinguishing feature of Complainant located in different jurisdictions of the world and is

exclusively associated with Complainant and to HERO Group companies by the relevant members of the industry and trade as well as the general public.

5.10 The Complainant submits that the trademark HERO is well-known on a global footing and enjoys goodwill and a reputation of international character through publicity and dissemination of knowledge/information about the mark and products and services. The Complainant has, since its incorporation, spent a worldwide huge amount of money on the publicity, advertisements, and promotions of their goods and services with aforesaid trademarks. As a result of such expenditure in terms of time, money, and effort, the mark HERO and Hero MotoCorp today has become synonymous with the products and services of the Complainant and is also a market leader in its field.

5.11 The Complainant further submits that by several registrations, continuous and extensive usage, vast publicity, and the excellent and unmatched quality of the goods and services, the trademark HERO, Hero MotoCorp, and H devices have acquired enormous reputation and goodwill for themselves, which has become a household word associated with the HERO group companies.

5.12 The Complainant submits that it has received various awards/recognitions/accolades for the goods sold by it under the marks HERO and Hero MotoCorp. The Complainant has also brought on record the revenue and advertising figures related to the sale of



products under the trademarks HERO and Hero Moto Corp in India.

5.13 The Complainant submits that it is the exclusive owner of the domain www.heromotocorp.com, used to give the greater public access, and showcase information about the products and services, advertising, and promotion of the Complainant. The website is accessible all over the world (including India). This domain name/website is a very famous and frequently visited website in India for two wheeler and their parts. This domain/website is partly interactive in nature and inter alia provides for an online platform for the prospective dealers for applying for dealership of the Complainant.

5.14 The Complainant submits that it is selling, marketing, and advertising its products, services, and dealerships, etc. by adopting the aforementioned domain name and trademark for decades. Due to the enormous goodwill of the brand and the popularity of the website the trade channels and public associate and identify this domain or any other domain with the words Hero MotoCorp or Hero with the Complainant or its group companies. The Complainant submits that the Complainant has created a niche for itself in the domestic and international markets and any domain created with registered trademarks mentioned above shall create confusion and shall lead to deception amongst the public at large that the same is originating from the Complainant or in some way associated with the Complainant.



6. SUBMISSIONS OF COMPLAINANT ABOUT THE RESPONDENT AND ITS USE OF THE DOMAIN NAME

6.1 The Complainant submits that the Respondent has dishonestly malafidely, and unauthorizedly registered a domain name www.hero-india.in by adding the word "-india" after the well-known mark HERO trademark of the Complainant and has used "Hero" as the most distinguishing and major feature of the said domain name. Except for the addition of words "-india" and ccTILD ".in", the entire domain name www.hero-india.in is identical to our domain www.heromotocorp.com and substantially contains the words "Hero" which constitutes an infringement of our registered and well-known trademark "Hero".

6.2 The Complainant further submits that besides modifying the domain name by adding "-india" to the well-known mark Hero of the Complainant, the Respondent has created a confusingly similar website leading to a severe violation of a trademark and copyright infringement along with severe penal consequences. The Respondent is using the said domain on various unscrupulous Telegram channels in order to accept the money from the public. The Respondent has registered the impugned domain names with the intention of ranging a cyber-attack on the Complainant Group in a bid to extort monetary benefit from its illegal and unethical activities.

6.3 The Complainant submits that it believes that the Respondent is making an illegitimate, commercial, unfair use of the impugned domain name, with the

intent to reap commercial benefits and to cheat, defraud mislead and divert consumers, trade channels, and the public at large.

7. THE ISSUES INVOLVED IN THE DISPUTE

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

Types of Disputes -

7.2 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.

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

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

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

8. PARTIES CONTENTIONS

8.1 **The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights and has identical domain/website content which infringes the copyrighted work of the Complainant**



8.2 Complainant

8.2.1 The Complainant submits that the Respondent's domain name – www.hero-india.in encompasses the whole of the Complainant's registered and well-known trademark HERO and forms the most distinguishing and major feature of the said domain name. The Respondent's domain content is a slavish copy of the Complainant's website www.heromotocorp.com. The Respondent is using the said domain on various unscrupulous Telegram channels to accept the money from the public and to confuse and deceive the public to believe that the Respondent's domain originates/belongs to Complainant or is associated with the Complainant. The trademarks HERO has been blatantly copied in the domain name and domain content without any authorization from Complainant.

8.2.2 The Complainant submits that as numerous courts and prior WIPO UDRP panels have recognized, the incorporation of a trademark in its entirety may be sufficient to establish that a domain name is identical or confusingly similar to Complainant's registered marks.

8.2.3 The Complainant submits that infringing domain /website is registered to accept the money from the public and to confuse and deceive the public to believe that the Respondent's domain is originating/belongs to Complainant or is associated with the Complainant.



8.2.4 The Complainant submits that the Respondent by using the infringing website, using the complete well-known trademark HERO, and just adding the word "-India" against the Hero trademark of the Complainant, is trying to cheat the public at large. The complainant also relies on the judgment of PRL USA Holdings, Inc. v. Spiral Matrix (Case No. D 2009-0009) wherein the panel observed that "It is a well-established principle that the addition of descriptive or non-distinctive terms to a complainant's trademark in a domain name does not dispel confusing similarity." The Complainant also relied on Motion Limited v. Nicholas Stewart, WIPO Case No. D2008-0262 and in Research in Motion Limited v. Blackberry World, WIPO Case No. D2006-1099, the panels held that the domain names were confusingly similar to the BLACKBERRY trademark.

8.2.5 The Complainant submits that the Complainant has filed a few domain name infringement complaints with WIPO bearing number (LBA) D2018-1480 dated July 09, 2018, (TLE) D2018-1744 dated 1st August 2018 and D2018-2903 dated Dec 20, 2018, vide which the Complainant reported trademark and copyright infringement by a domain www.heromotocorps.com, www.herodelearship.com, and wwwhmcld dealership.com respectively. WIPO after following the due process decided the Complaint D2018-1480 and D2018- 1744 in favor of the Complainant and the said domain names were transferred in the name of the Complainant.



8.2.6 The Complainant submits that it also filed a copyright and trademark complaint(s) with GoDaddy who is the Registrar, for the following fake domain names: A. Domain Name: www.heromotocorps.com Incident ID: 36400734 and 36400953 dated July 02, 2018, B. Domain Name: www.herodealership.com Incident ID: 36574632 and 36574402 dated July 30, 2018, C. Domain Name: www.heromotocorps.in Incident ID: 36996969 and 36997357 dated Sept 06, 2018, D. Domain Name: www.hmclddealership.com Incident ID: 37832425 and 37832288 dated Dec 17, 2018, E. Domain Name: www.heromotor.in Incident ID: 37991553 and 37991587 dated Jan 8, 2018, After investigation, GoDaddy after asking the Respondent to pull down the infringing content, suspended the said website www.heromotocorps.com, www.herodealership.com, www.heromotocorps.in, www.hmclddealership.com and www.heromotor.in (impugned website).

8.2.7 The Complainant relied on the case of 3M Company v. Machang INDRP/856 (decided on 06.02.2017) wherein it was held that "the disputed domain name www.futuro.co.in of the Respondent bears the Complainant's registered trade mark FUTURO as its essential and memorable feature. It is the word/trademark FUTURO that the disputed domain name would be remembered by the general internet users who would access the internet services being offered by the Respondent....Having regard to the complete similarity/Identity between the

Complainant's trademark domain name FUTURO and the disputed domain name www.futuro.co.in of the Respondent I am of the considered view that an average consumer with imperfect memory would be led to the belief of a possible nexus between the Complainant and the Respondent or of the disputed domain name."

8.2.8 The Complainant also relied on Charmin Charlie LLC v. Normand Clavet INDRP/859 (decided on 17.03.2017) wherein it was held that "the disputed domain name incorporates the mark CHARMING CHARLIE in its entirety. It has been held in Inter-Continental Hotels Corporation vs. Abdul Hameed (INDRP/278) as well as Indian Hotels Company Limited v. Mr. Sanjay Jha (INDRP/148) that when a disputed domain name incorporates a mark in entirety, it is adequate to prove that the disputed domain name is either identical or confusingly similar to the mark. Similarly, in the case of Farouk Systems Inc. v. Yishi, WIPO Case No. D2010-006, it has been held that the domain name wholly incorporating a complainant's registered mark may be sufficient to establish identity or confusing similarity, despite the additions or deletions of the other words to such marks. The domain name in question is phonetically as well as visually identical to the Complainant's prior registered t 14 CHARMING CHARLIE and that the ccTLD ".in" does nothing materially to distinguish the same from Complainant's mark CHARMING CHARLIE. It is well recognized that incorporating a trade mark in its entirety, particularly if the mark is a well-known mark, is sufficient to establish that the



domain name is identical or confusingly similar to the Complainant's registered mark. (Ingersol-Rand Co. Frankly Gully d/b/a Advcomren, WIPO Case No. D2000- 0021). Reliance is also placed on Boehringer Ingelheim Pharma GmbH & Co. KG v. Philana Dhimkana WIPO Case No. D2006-1594, where it was held that, if a well-known trade mark was incorporated in its entirety into a domain name - that is sufficient to establish that a domain name is identical or confusingly similar to the Complainant's registered trade mark."

- 8.2.9 The Complainant has also relied on Ducati Motor Holding S.p.A. v. Abhishek Chordia INDRP/ 834 (decided on 20.02.2017) wherein it was held that "The disputed domain name registered by the Respondent is identical/confusingly similar to the well-known trademark DUCATI which has been owned and used by Complainant No 1 continuously and openly since 1926. With such extensive, continuous, open and uninterrupted use of the DUCATI trademark and trade name by the Complainants, throughout the world the DUCATI trademark has become distinctive and indicative of the goods of the Complainants alone and none else. Hence, any individual coming across the disputed domain name will assume it to be the Complainant's website for India and instantly associate the same with the Complainants. That is, the domain name of the Respondent, is identical / confusingly similar to the registered trademark of the Complainant - DUCATI, which incorporates the same in it's entirety. In a number of past domain dispute decisions, it has been confirmed that incorporating a

trademark in its entirety can be sufficient to establish that a domain name is identical or confusingly similar to a registered trademark (Toyota France and Toyota Motor Corporation v. Computer-Brain, WIPO Case No. D2002-0002 and Toyota Jidosha Kabushiki Kaisha d/b/a Toyota Motor Corporation v. S&S Enterprises Ltd., WIPO Case No. D2000-0802). In addition, the disputed domain name almost entirely copies the Complainant's registered domain name www.ducati.com..... Honorable Delhi High Court in the matter of Yahoo!, Inc. vs Akash Arora & Anr. [78 (1999) DLT 285] referred to Card service 15 International Inc. Vs. McGee; reported in 42 USPQ 2d 1850, where it was held that the domain name serve same function as the trademark and is not a mere address or like finding number on the Internet and, therefore, it is entitled to equal protection as trademark."

8.2.10 The Complainant also relied on the case of Bharti Airtel Limited v. Sunita Bhardwaj INDRP/837 (decided on 03.02.2017) wherein it was held that "the respondent has registered the disputed domain name www.airtelservices.in using the mark of the complainant in toto which creates confusion with the Complainant's trademarks as to the source, sponsorship, affiliation or endorsement in relation to the impugned domain name."

8.2.11 The Complainant has also put Reliance on Zippo Manufacturing Company v. Zhaxia INDRP/840 (decided on 27.01.2017) wherein it was held that "the disputed domain name www.zippo.co.in of the

Respondent is identical to the complainant's well known trademark ZIPPO. There is nothing in the Respondent's domain name to distinguish it from the Complainant's well known trademark or its domain name. The complainant has overwhelming common law as well as statutory rights in its trade mark ZIPPO. Therefore the Complainant is the sole legitimate owner of the trade mark ZIPPO.... Reliance is also placed on KFC Corporation v. Webmaster Casinos Ltd. (L-2/6/R4) by the complainant wherein it was held that when a domain name wholly incorporates a complainant's registered mark that is sufficient to establish identity or confusing similarity for purpose of the policy."

8.3 Respondent

8.3.1 The Respondent has not replied to Complainant's contentions.

9. PANEL OBSERVATIONS

9.1 This Panel on pursuing the pleadings, documents and records submitted by Complainant observes that the Complainant is a part of the reputed HERO group of companies, which are engaged in diverse business activities such as manufacture and sale of automobiles and its parts and fittings, financial solutions, insurance, investments, planning, advisory execution and monitoring of investments etc.

9.2 This panel observes that the Complainant has common law as well as statutory rights in its trade/service mark "HERO". It is also observed by this panel that the Complainant has successfully secured registration for



the HERO marks. The Complainant has proved that it has trademark rights and other rights in the mark "HERO" by submitting substantial information and documents in support of it.

9.3 It is further observed by this panel that the trademark "HERO" is included, without any addition or deletion, and the fact that the Disputed domain "hero-india.in" comprises the Complainant's trademarks "HERO" in their entirety has the potential to cause consumer confusion and will cause the user to 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.

9.4 This panel, therefore, is of opinion that the disputed domain name "hero-india.in" being identical/ confusingly similar to the trademark of Complainant will mislead the public and will cause an unfair advantage to Respondent. The Panel is of the view that there is a 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 "HERO" of the Complainant.

9.5 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 and the respondent has miserably failed in following this condition.

9.6 This Panel, therefore, in light of the contentions raised by the Complainant concludes 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(a) of the INDR Policy.

10. THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DOMAIN NAME.

10.1 Complainant

10.1.1 The Complainant submits that the Respondent neither has any legitimate interest in the trademark HERO nor is the lawful owner or licensee of any right relating to the Complainant's Group's marks. The Respondent has fraudulently registered the impugned domain name in order to disrupt the Complainant's business and take undue advantage of the Complainant's goodwill and reputation by misrepresenting itself as the Complainant.

10.1.2 The Complainant submits that the Respondent registered the impugned domain name on July 25, 2022 which is long after Complainant started using the mark HERO in the 1950s. The Complainant also created its website www.heromotocorp.com on May 17, 2011. Given that the Complainant's adoption and extensive use of the HERO the domain name and the



corporate name of its company HERO MOTOCORP LIMITED predates the Respondent's registration of the impugned domain name, the burden is on Respondent to establish its rights or legitimate interests in the infringing domain name.

10.1.3 The Complainant submits that the content of the impugned website has been blatantly copied from the Complainant's domain name to deceive the customers/dealers into believing that it originates from the Complainant or has been licensed/ authorized for the same. Reference is made to the case of Croatia Airlines d.d. v. Modern Empire Internet Ltd. WIPO Case No. D2003- 0455 whereby it was observed that the "Use of a domain name that is identical or confusingly similar to a trademark that applies to goods sold by a Respondent is not a bona fide use, if the Domain Name serves as a "bait" to attract customers to Respondent's website, rather than merely as a descriptor of the Respondent's products".

10.1.4 The Complainant further submits that it has been held by the Hon'ble Tribunal in the case of eBay Inc. v. Akram Mehmood, WIPO Case No. DAE2007-0001 that "rights or legitimate interests cannot be created where the user of the Domain Name at issue would not choose such a name unless he was seeking to create an impression of association with the Complainant".



- 10.1.5 The Complainant submits that the Respondent has registered the infringing domain name and created an identical website to trade on Complainant's goodwill and to divert traffic to its website as well as to harass and tarnish the goodwill of the Complainant by impersonating the Complainant for illegal acts.
- 10.1.6 The Complainant submits that at no time did the Complainant ever authorize or permit Respondent's registration of the infringing domain name incorporating the Complainant's Group's HERO and its corporate name HERO MOTOCORP LIMITED and its website content.
- 10.1.7 The Complainant submits that by registering the impugned domain name and copying the copyrighted content of the Complainant's website in entirety, thereby constituting a violation of the Complainant's copyright in its website, the Respondent is clearly attempting to trade on the fame/reputation of the Complainant and its HERO trademarks and as such cannot constitute a bona fide use. Philip Morris Inc. v. Alex Tsytkin, WIPO Case No. D2002-0946 ("use which intentionally trades on the fame of another cannot constitute a bona fide offering of goods or services"); Bumble & Bumble LLC v. Gladyshev, WIPO Case No. D2008-1956 ("The Respondent's use of a domain name incorporating the Complainant's distinctive BUMBLE AND BUMBLE mark in its entirety, and the further use of the Complainant's mark on



the website, improperly suggest that the site is affiliated with the Complainant and that the Respondent is authorized to sell the Complainant's line of hair care and beauty products"); Toyota Jidosha Kabushiki Kaisha t/a Toyota Motor Corporation v. Double Time Jazz a/k/a Jamey Aebersold, NAF Claim Number: FA0205000113316 (2002) ("A Respondent cannot use Complainant's trademark in a domain name when the Respondent, even though selling Complainant's goods, has no permission to use the trademark as the domain name" (citing Avon Prods., Inc. v. Lee, WIPO Case No. D2001-0272)).

10.1.8 The Complainant submits that it has also been established in the case of Owens Corning v. NA, (WIPO Case No. D2007-1143), that where the Respondent wants to argue that it has a legitimate interest in a domain name in relation to genuine products, it is incumbent upon that entity to bring evidence before the panel to the effect that the domain name has been, or will be, used in a manner that satisfies the conditions of use as upheld in several cases.

10.1.9 The Complainant submits that it is apparent from a bare perusal of the infringing domain name that the Respondent has no legitimate interests in the said mark/domain name. In Dell Inc. v. Mani, Soniya INDRP/ 765 (decided on 05.04.2016) it was held that "the respondents websites are not bona fide since the respondent

is using the disputed domain name to divert/ redirect internet users and consumers seeking the complainant's goods and services to its own websites, which offers the complainant's 18 products and services and also of those in direct competition with the complainant.

10.2 Respondent

The Respondent has not replied to Complainant's contentions.

10.3 Panel Observations

10.3.1 This Panel holds that the second element that the Complainant needs to prove and as is required by paragraph 4(b) of the INDRP is that the Respondent has no legitimate right or interests in the disputed domain name.

10.3.2 This panel observes that the Complainant by placing documents/records and evidence along with the complaint has been able to prove that the Complainant is trading and doing its business under the mark 'HERO'. The Complainant by virtue of its priority in adoption, goodwill, and long, continuous and extensive use of the mark, the Complainant has acquired the exclusive right to the use of the 'HERO' mark in respect of its goods and services.

10.3.3 Whereas, it is observed by this panel that the Respondent has failed to rebut the allegations of the complainant that the Respondent neither has any legitimate interest in the trademark HERO nor is the lawful owner or licensee of any right relating to the

Complainant's Group's marks. The Respondent has also failed to rebut the contentions of the Complainant, that the Respondent has fraudulently registered the impugned domain name in order to disrupt the Complainant's business and take undue advantage of the Complainant's goodwill and reputation by misrepresenting itself as the Complainant.

10.3.4 It is also observed by this panel that given the fact that the Domain name and the corporate name of its company HERO MOTOCORP LIMITED predates the Respondent's registration of the impugned domain name and the burden is on Respondent to establish its rights or legitimate interests in the infringing domain name. However, the respondent has failed to establish it.

10.3.5 It is observed by this panel that the Respondent has failed to rebut the contention of the complainant that the that the content of the impugned website has been blatantly copied from the Complainant's domain name to deceive the customers/dealers into believing that it originates from the Complainant or has been licensed/ authorized for the same.

10.3.6 The Respondent has also failed to rebut the contentions of the Complainant that at no time did the Complainant ever authorize or permit Respondent's registration of the infringing domain name incorporating the Complainant's Group's HERO and its corporate name HERO MOTOCORP LIMITED and its website content.



10.3.7 Once the Complainant makes a prima 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 place any evidence to rebut the allegations of the Complainant.

10.3.8 It is further observed by this panel that para 6 of the .IN Domain Name Dispute Resolution Policy (INDRP) states :

Any of the following circumstances, in particular but without limitation, if found by the Arbitrator to be proved based on its evaluation of all evidence presented, shall demonstrate the Registrant's rights to or legitimate interests in the domain name for Clause 4 (b) :

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

This panel observe that the respondent also failed to full fill any of the requirements as mentioned in para 6 of INDRP Policy which demonstrates the Registrant's rights to or legitimate interests in the domain name for Clause 4 (b) :

10.3.9 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 "HERO-INDIA.IN".

11. THE DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH.

11.1 Complainant

11.1.1 The Complainant submits that circumstances evidences that the Respondent has registered and/or acquired the impugned domain name in bad faith as well as has created an identical website with identical layout and appearance of official website of Complainant with a dishonest intention to: (a) defraud and cheat the customers, dealer and other relevant stakeholders of the Complainant. (b) mislead and/or divert the consumers/trade channels and the public at large or to sell the said domain name to the Complainant for profit. (c) range a cyber-attack on the Complainant in a bid to extort monetary benefit from its illegal and unethical activities. (d) disrupt the business of the Complainant by misrepresenting that the domain belongs to Complainant. (e) gain commercial benefit illegally.

11.1.2 The Complainant submits that the domain www.hero-india.in raises serious concerns and the Complainant is afraid that the series of infringement will continue as different permutation and combination with slight variation is used by the Respondent to illegally operate and to encash and siphon off the goodwill of Complainant.

11.1.3 The Complainant submits that it is crystal clear that the Respondent is trying to exploit the goodwill, reputation and fame of Complainant by unauthorisingly, dishonestly and malafidely using identical/confusingly similar domain name with identical copyrighted 19 content and HERO trade marks in bad faith in order to improperly cheat and deceive internet users, potential consumers, trade partners and for benefit of the Respondent financially by illegitimate and fraudulent means. These activities demonstrate bad faith registration and use of the domain name in violation of the Policy as set forth in paragraphs 4(b)(i) and 4(b)(ii).

11.1.4 The Complaint has relied to the Judgment of this panel in the case of Identigene, Inc. v. Genetest Laboratories (WIPO Case No. D2000-1100) in which it was decided that "Panelist finds that Respondent's use of the domain name at issue to resolve to a website where services are offered to Internet users is likely to confuse the user into believing that Complainant is the

source of or is sponsoring the services offered at the site. This constitutes evidence of bad faith registration and use under the Policy Paragraph 4(b)(iv). InfoSpace.com, Inc. v. Hari Prakash, (WIPO Case No. D2000-0076); America Online Inc. v. Cyber Network LLP, (WIPO Case No. D2000-0977)."

11.1.5 The Complainant submits that a Consumer searching for information concerning the Complainant or any of its group companies is likely to be confused as to whether the impugned domain name is connected, affiliated or associated with or sponsored or endorsed by the Complainant or any of its group companies.

11.1.6 The Complainant submits that it has also been observed in the case of America Online, Inc. v. Cyber Network LLP (Case No. D2000-0977) that if "Panel finds that Respondent's use of the domain name at issue to resolve to a web site where services are offered to internet users is likely to confuse the user into believing that Complainant is the source of or is sponsoring the services offered at the site. This constitutes evidence of bad faith registration and use under the Policy. Policy, Paragraph 4(b)(iv). 20

11.1.7 The Complainant submits that it has met the requirements of the Policy by demonstrating not only its own legitimate interest in the HERO, Hero Moto Corp trademarks as well as corporate name HERO MOTOCORP LIMITED, and also that

Respondent's sole interest in the infringing domain name is to unlawfully profit from it.

11.2 Respondent

The Respondent has not replied to Complainant's contentions.

11.3 Panel Observation

11.3.1 This panel while going through the complaint and documents which are placed in the form of exhibits has observed that the Respondent registered the disputed domain name in July 2022, by which time the Complainant has been using the mark HERO mark for many years. It is observed by this panel that the Complainant has statutory and common law rights in the mark HERO and is also using the HERO mark on the internet, in other domain names, and as a trading name prior to registration of disputed domain name. It is observed by this panel that in view of the above-mentioned facts and circumstances, it is impossible to conceive that the Respondent could have registered the disputed domain name in good faith or without knowledge of the Complainant's rights in the mark HERO.

11.3.2 This panel observe that the Respondent has failed to rebut the contentions of the Complainant that the circumstances evidences that the Respondent has registered and/or acquired the impugned domain name in bad faith as well as has created an identical website with identical layout and appearance of official website of Complainant with a dishonest intention to: (a) defraud and cheat the

customers, dealer and other relevant stakeholders of the Complainant. (b) mislead and/or divert the consumers/trade channels and the public at large or to sell the said domain name to the Complainant for profit. (c) range a cyber-attack on the Complainant in a bid to extort monetary benefit from its illegal and unethical activities. (d) disrupt the business of the Complainant by misrepresenting that the domain belongs to Complainant. (e) gain commercial benefit illegally.

11.3.3 It is further observed by this panel that that the Complainant has rightly submitted that a Consumer searching for information concerning the Complainant or any of its group companies is likely to be confused as to whether the impugned domain name is connected, affiliated or associated with or sponsored or endorsed by the Complainant or any of its group companies. And also that Respondent's sole interest in the infringing domain name is to unlawfully profit from it.

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

(a) Circumstances indicating that the Respondent has registered or has acquired the domain name primarily for 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 over the Registrar's documented out of pocket costs directly related to the domain name; or

- (b) the Respondent has registered the domain name 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
- (c) by using the domain name, the Respondent has intentionally attempted to attract internet users to its website or other online 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 a product or services on its website or location."

11.3.5 The complainant rightly established that the respondent has registered the disputed domain name in bad faith, and there is evidence that points to the existence of circumstances as mentioned in clause 7(c) of the INDRP Policy. The Respondent's domain name registration meets the bad faith elements outlined in para 4 (c) of the INDRP Policy. Therefore the Panel concludes 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 and the Respondent has wrongfully acquired/registered the domain name www.hero-india.in in its favor in bad faith.

12. REMEDIES REQUESTED

12.1 The Complainant has prayed to this Administrative Panel :

- To immediately transfer the domain name www.hero-india.in to the Complainant and direct the Respondent to take all necessary steps with the domain name registering authority to transfer the impugned domain name to the Complainant.
- To order payment of costs related to the present proceedings, including fee paid for initiating the administrative process.
- Any further order(s) which this panel may find fit and proper given the facts and circumstances of the present complaint.

13. DECISION

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

Through its contentions based on documents/ records and evidence, the Complainant has been able to establish that the mark "HERO" is a well-established name in India and other countries. The complainant has established that the hero, is popularly known exclusively concerning the Complainant. The Complainant has also established that the trademark HERO is inherently distinctive of the products, services, and business of the Complainant and has secured trademark protection for HERO by registering trademarks.



13.2 The Respondent despite repeated opportunities given, however, has failed to provide any evidence that it has any rights or legitimate interests in respect of the domain name, and the Respondent is related in any way to the Complainant. The Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the Disputed Domain Name.

13.3 The Complainant has rather has been able to establish by its contentions and records in the form of Exhibits, that the Respondent has attempted to attract Internet users for gain which is evidence of bad faith. It is therefore established by the complainant that the domain name by itself is being used for attracting internet users rather than any bona fide offering of goods/services thereunder. This panel while considering the complaint and records in the form of Annexures submitted by the complainant, has concluded that there exist circumstances as stated in para 7(C) of INDRP Policy.

13.4 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.

13.5 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.

13.6 This panel is of the view that it is for the Complainant to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such a prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name but the Respondent has miserably failed to do that. The Respondent's registration and use of the domain name [hero-india.in] are 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.

14. RELIEF

Following INDRP Policy and Rules, this Panel directs that the disputed domain name [hero-india.in] be transferred from the Respondent to the Complainant; with a request to NIXI to monitor the transfer.

New Delhi, India
Dated : 17th October, 2022


AJAY GUPTA
Sole Arbitrator