



उत्तर प्रदेश UTTAR PRADESH

BL 178558

INARA ARBITRATION  
KNITMESH LIMITED

V.

SHRI VIKAS AAREKH  
RISHIKESH ELECTRONICS  
PVT. LTD.

DOMAIN NAME : KNITMESH.CO.IN

*[Handwritten signature]*

**INDRP ARBITRATION  
THE NATIONAL INTERNET EXCHANGE OF INDIA [NIXI]**

**ADMINISTRATIVE PANEL DECISION  
SOLE ARBITRATOR: RODNEY D. RYDER**

**Knitmesh Limited**

**v.**

**Shri Vijay Parekh [Respondent 1]  
&  
Rishikesh Electromatics Pvt. Ltd [Respondent 2]**

**ARBITRATION AWARD**

**Disputed Domain Name: [www.knitmesh.co.in](http://www.knitmesh.co.in)**



### **The Parties**

The Complainant in this arbitration proceeding is Knitmesh Limited, a wholly owned subsidiary of the Greenfield Group Limited, both incorporated in the United Kingdom. The Greenfield Group Limited was incorporated in the United Kingdom on August 20, 1936. The Complainant was incorporated in the United Kingdom on June 17, 1957

The Respondents in these arbitration proceedings are:

Respondent No. 1: Shri Vijay Parekh, M/s M.V. International, 1303 Kent Garden, TPS III Road, Borivali [West], Mumbai, 400092, Maharashtra, India.

Respondent No. 2: Rishikesh Electromatic Pvt. Ltd., 301 Blue Rose Industrial Estate, Western Express Highway, Borivali East, Mumbai 400066, Maharashtra, India.

### **The Domain Name and Registrar**

The disputed domain name is www.knitmesh.co.in. The Registrar with which the disputed domain name is registered is India Links Web Hosting Pvt. Ltd [R51-AFIN] located at 105, Super Shopping Complex, Bajaj Cross Road, Kandivali West, Mumbai - 400067. India.

### **Procedural History [Arbitration Proceedings]**

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

According to the information provided by the National Internet Exchange of India ["NIXI"], the history of this proceeding is as follows:

In accordance with the Rules, 2(a) and 4(a), NIXI formally notified the Respondent of the Complaint, and appointed Rodney D. Ryder 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 Name Dispute Resolution Policy and the Rules framed thereunder. The Arbitrator submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by NIXI.

The reminder was sent on February 28, 2013 by the arbitrator. The Respondent acknowledged the communication on March 9, 2013. In a message on March 10, 2013, Mr Vijay Parekh [Respondent No 1] stated that he would be responding soon. On March 29, 2013, the Respondent requested for a one-month extension, to file his reply. The extension was granted in the interest of justice.

On April 30, 2013, the Respondent submitted his response. On May 10, 2013, the Complainant, through Counsel, Mr. Jitendra Kumar Jain, requested for time to file a rejoinder. The request was granted. The Complainant filed the rejoinder on May 16, 2013. On May 21, 2013, legal counsel for the Respondent, Ms Urvashi Nayak requested for time to file a reply to the rejoinder. The panel reiterated that there was no provision in the INDRP





rules of procedure for such reply to rejoinders. Nevertheless, the Panel allowed the Respondent to file such rejoinder no later than May 31<sup>st</sup> 2013. The Respondent through legal counsel Urvashi Nayak filed the reply to the rejoinders.

During the proceedings, both parties were advised that there are no provisions in the INDRP Rules or Procedure for the time extensions and the additional filings that were requested. The INDRP is structured on the need for procedural efficiency, and the obligation to treat each party with equality and ensure that each party has a fair opportunity to present its case. Both parties and NIXI were made aware that this proceeding had by that time, far exceeded the time provided under the INDRP Rules and Procedure; due to requests with regard to submissions made, in writing, by both the Complainant and the Respondent.

Parties to the INDRP are expected to adequately show the relevance of the filing[s] to the case and why they were unable to provide that information in the complaint or response. The Panel advised the Parties that no reiterations would be allowed. Written submissions as rejoinders or additional submissions must demonstrate "exceptional" circumstances.

#### **Grounds for the administrative proceedings**

1. The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has statutory/common law rights.
2. The Respondent has no rights or legitimate interests in respect of the disputed domain name.
3. The disputed domain name has been registered or is/are being used in bad faith.

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

The Complainant in this arbitration proceeding is Knitmesh Limited a wholly owned subsidiary of the Greenfield Group Limited, both incorporated in the United Kingdom. The Greenfield Group Limited was incorporated in the United Kingdom on August 20, 1936. The Complainant was incorporated in the United Kingdom on June 17, 1957.

#### **Statutory rights:**

The Complainant contends that it is the owner, designer, proprietor of the "Knitmesh" and has been using this brand for more than 55 [Fifty Five] years. The Complainant started using "Knitmesh" in the United Kingdom as early as in 1957 [the year of its incorporation]. The word "Knitmesh" was thereafter continuously used in commerce in the United Kingdom and other countries in connection with the design and manufacture of innovative knitted wire mesh solutions, serving automotive, industrial, electronic and domestic markets. "Knitmesh" is a reputed brand in many countries across the globe including the United Kingdom and India. The Complainant and its parent Company have registered "Knitmesh" as a trademark via the Madrid Protocol and others in over 50 countries including the United States of America, The European Community, Mexico, China and its trademark applications are pending in several countries including India.

The Complainant holds several domain name registrations incorporating the "Knitmesh" trademark, including knitmesh.com and www.knitmesh.in



## Discussion and Findings

The Respondent does not have any relationship with the business of the Complainant or any legitimate interest in the mark/brand "Knitmesh". Moreover, the Complainant has neither given any license nor authorized the Respondent to use the Complainant's mark. It is a well-established principle that once a Complainant makes a prima facie case showing that the Respondent lacks rights to the domain name at issue, the Respondent must come forward with the proof that it has legitimate interest in the domain name to rebut this presumption.

The Respondent in its reply contends that it is using the disputed domain name in good faith and that the trademark "Knitmesh" filed by the Complainant in India is a generic term and therefore does not have trademark rights.

## The issues involved in the dispute

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

*"Types of Disputes -*

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

*(i) the Respondent's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;*

*(ii) the Respondent has no rights or legitimate interests in respect of the domain name; and*

*(iii) the Respondent's domain name has been registered or is being used in bad faith.*

*The Respondent is required to submit to a mandatory Arbitration proceeding in the event that a Complainant files a complaint to the .IN Registry, in compliance with this Policy and Rules thereunder."*

According to paragraph 4 of the INDRP, there are 3 essential elements of a domain name dispute, which are being discussed hereunder in the light of the facts and circumstances of this case.

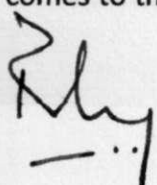
## Parties Contentions

### Complainant's Contention

**The Respondent's domain name is identical and confusingly similar to a name, trademark or service in which the Complainant has rights.**

It has been proved by the Complainant, to the satisfaction of this Panel, that it has 'legitimate interest' and in particular, trademark rights, and other rights in the mark "Knitmesh" by submitting substantial documents.

The disputed domain name contains the entirety of the Complainant's trademark. This panel comes to the conclusion that when a domain name contains a trademark in its entirety, the



domain name is identical or at least confusingly similar to the trademark. [Relevant Decisions: Case No. INDRP/125, February 14, 2010, *Lego Juris A/S v. Robert Martin*; Case No. INDRP/286, February 20, 2009, *G.A. Modefine S.A. v. Naveen Tiwari*]

The Respondent has thereafter made a calculated approach wherein the Respondents have not created any content on his website, except the fact that the content has been copied from one of the websites [www.knitmesh.com](http://www.knitmesh.com) of the Complainant.

The Complainant submits that the corporate name, trademark although the trademark Knitmesh in pending approval in India are distinctive on account of their extensive use and that mere pendency of the trademark will not deprive the common law rights of the Complainant and that the Complainant has registered Knitmesh as a trademark via the Madrid Protocol and others in over 50 countries including the United States, China, Mexico, Italy, The United Kingdom among many others.

According to the INDRP paragraph 3 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.

Paragraph 3 of the INDRP is reproduced below:

*"The Respondent's Representations -*

*By applying to register a domain name, or by asking a Registrar to maintain or renew a domain name registration, the Respondent represents and warrants that:*

- the statements that the Respondent made in the Respondent's Application Form for Registration of Domain Name are complete and accurate;*
- to the Respondent's knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party;*
- the Respondent is not registering the domain name for an unlawful purpose; and*
- the Respondent will not knowingly use the domain name in violation of any applicable laws or regulations.*

*It is the Respondent's responsibility to determine whether the Respondent's domain name registration infringes or violates someone else's rights."*

### **Respondents Contention**

The Respondent contends that the use of the word "Knitmesh" in the disputed domain name [www.knitmesh.co.in](http://www.knitmesh.co.in) is honest and concurrent. The Respondent contends that it never intended to damage the goodwill of any third party. The Respondent further contends that the term "Knitmesh" is very generic and descriptive word.

The Respondent states that the term "Knitmesh" is not registered as a trademark in India and that the application for registration by the Complainant is still pending in the Trademark Registry in India. The Respondent contends that according to **para. 3.4.7** of the Policy framework and Implementation of the .IN Dispute Resolution Policy, the first preference for registration is given to Indian Entities and that the registration is open on a first come first served basis.





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

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

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 evidentiary burden shifts to the Respondent to rebut the contention by providing evidence of its rights or interests in the domain name.

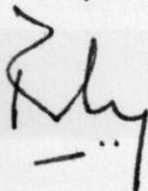
The Respondent has not rebutted the contentions of the Complainant and has not produced any documents or submissions to show his interest in protecting his own right and interest in the domain name.

The Respondent is not authorized by the Complainant to use the domain name. In the absence of any license or permission from the Complainant to use any of its trademarks or to apply for or use any domain name incorporating those trademarks, it is clear that no actual or contemplated bonafide or legitimate use of the domain name could be claimed by the Respondent [Relevant Decisions: *Guerlain S.A. v. Peikang*, D2000-0055 (WIPO March 21, 2000)]

Moreover, the disputed domain name was registered by the Respondent on September 24, 2007, which is more than a decade after the registration of the domain name - www.knitmesh.com by the Complainant on October 19, 1997. By this time, the Complainant had built considerable reputation in the mark "Knitmesh" and has been actively using the website www.knitmesh.com. The Complainant's rights in the trademark "Knitmesh" predates Respondent's registration of the disputed domain name incorporating that trademark, therefore the Respondent does not have rights or legitimate interests in the disputed domain name [Relevant Decisions: Case No: INDRP/096, June 27, 2009, *Compagnie Gervais Danone v. Digitech Software Solutions*]

The Respondent is in no way affiliated with the Complainant. The Complainant has not authorized or licensed Respondent to use and register the "Knitmesh" trademark, nor requested their assistance in the registration of any domain name incorporating this trademark.

Further, the Respondent has registered and used the domain name to infringe Complainant's rights in the trademark and to trade off Complainant's goodwill. The disputed domain name has been used to redirect users to a website, which has the same textual content as that of the Complainant, in order to confuse the user. [Relevant Decision: Case No. INDRP/286 [INDRP December 16, 2011] *Intesa Sanpaola S.p.A v. Amar Bose*; Case No. INDRP/180 [INDRP January 16, 2011] *Dart Industries Inc. v. Morada*]



The Respondent is not and has not in the past commonly used the disputed domain Name. Respondent does not use the Trademarks to identify itself on its website or for any other legitimate purpose. Even if the Respondent has used the trade name, such an unauthorised use does not establish legitimate interest in the disputed domain name. [Relevant Decision: Case No. INDRP/082, INDRP February 20, 2009 G.A. Modefine S.A. v. Naveen Tiwari].

### **Respondent's Contention**

The Respondent contends that since 2007, it is using the domain name and that since it is an Indian entity; it has the right to register the domain name www.knitmesh.co.in as per the para. 3.4.7 of the Policy framework and Implementation of the .IN Dispute Resolution Policy, which states that the first preference for registration is given to Indian Entities and that the registration is open on a first come first served basis.

The Respondent contends that since the mark "Knitmesh" is still pending and the fact that the objections are pending in the trademarks means that the Complainant does not have any rights in the disputed domain.

The Respondent also contends that they were not aware of the Complainant's other domain name i.e. www.knitmesh.com and that the Respondent had registered the disputed domain name www.knitmesh.co.in prior to the registration of the Complainant in India.

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

It has been contended by the Complainant that the Respondent has registered and has used the disputed domain name in bad faith. The language of the INDRP paragraph 4(iii) is clear enough, and requires that either bad faith registration or bad faith use be proved.

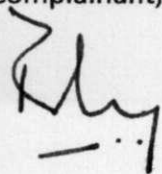
Paragraph 6 of the INDRP provides that the following circumstances are deemed to be evidence that a Respondent has registered and used a domain name in bad faith:

*"Circumstances indicating that the Respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or*

*the Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or*

*by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its Website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of its Website or location or of a product or service on its Website or location."*

From the circumstances of the case and from the evidences put before the Panel by the Complainant, the Panel is of the opinion that the Respondent had no previous connection





with the disputed domain name and any use of the disputed domain name by the Respondent, would result in confusion and deception of the trade, consumers and public, who would assume a connection or association between the Complainant and the Respondent.

The Respondent's registration and use of the domain name meets the bad faith elements set forth in the INDRP. Since the trademarks of the Complainant are so distinctive and famous that the Respondent must have had actual knowledge of the trademarks prior to registering the disputed domain name. According to the evidence put forth by the Complainant, it is evident that the Respondent was aware of the Complainant and its trademark.

Further, copying the text from the Complainant's website at [www.knitmesh.com](http://www.knitmesh.com) and using it on the disputed domain name's website to show that the Respondents are the owners of the trademark "Knitmesh" and to fake the corporate identity of the Complainant also amounts to evidence of bad faith

Bad faith is also evidenced by the Respondent's attempts to sell the domain name to the Complainant in explicit violation of Section 6 (i) of INDRP. [**Relevant Decisions:** *IndyMac Bank FSB v. Ebeyer*, FA 175292, Nat. Arb. Forum September 19<sup>th</sup>, 2003; *America Online v. QTR Corporation*, FA 92016, Nat. Arb. Forum February 4, 2000]

#### **Respondent's Contention**

The Respondent contends that it did not register the domain name in bad faith. The Respondent contends that it did not offer to sell the domain name in the first place and that the Complainant first offered to buy the domain name.

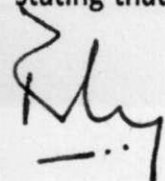
The Respondent also contends that the allegations put forth by the Complainant that the Respondent is a cybersquatter are completely false as the Respondent owns 16 domain names and each domain name represents a product that the Respondent is dealing or trading into.

#### **Decision**

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

- (i) the Complainants' trademark has a strong reputation and is widely known on a global basis;
- (ii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the disputed Domain Name;
- (iii) taking into account the nature of the disputed domain name and in particular the .in extension alongside the Complainant's mark, 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 the disputed Domain Name by the Respondent is and would be illegitimate. Use by the Respondent as such would amount to passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law.

At the outset, the panel would like to focus one of the submissions filed by the Respondent stating that contentions put forth by the Complainant after the initial complaint cannot be



decided by the Arbitration Panel and that the appropriate forum for the same would be the Honourable High Court at Mumbai. This panel rejects this contention of the Respondent and draws attention of the Respondent to the .IN Dispute Resolution Policy para. 2, which states that

"This .IN Domain Name Dispute Resolution Policy (the "Policy") sets out the terms and conditions to resolve a dispute between the Registrant and the Complainant, arising out of the registration and use of the .in Internet Domain Name."

And that under para. 4 of the .IN Dispute Resolution Policy

"Any Person who considers that a registered domain name conflicts with his legitimate rights or interests may file a Complaint to the .IN Registry"

Therefore the Complainant has a right to file a complaint and other subsequent submissions and prove to the panel that the registrant/Respondent's dispute domain name:

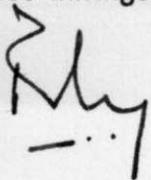
- (i) is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;
- (ii) the Registrant/Respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the Registrant's/Respondent's domain name has been registered or is being used in bad faith.

And that it is Registrant's/Respondent's duty under para. 3 of the .IN Dispute Resolution Policy to warrant and prove to the contrary that:

- (a) the Registrant/Respondent has accurately and completely made the Application Form for registration of the domain name;
- (b) to the Registrant's knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party;
- (c) the Registrant is not registering the domain name for an unlawful purpose; and
- (d) the Registrant will not knowingly use the domain name in violation of any applicable laws or regulations.

"It is the Registrant's responsibility to determine whether the Registrant's domain name registration infringes or violates someone else's rights."

The Panel comes to conclusion that the Respondent 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. **[Relevant Decisions:** *Salmi Oy v. PACWEBS* WIPO Case No. D2009-0040; *Graco Children's Products Inc. v. Oakwood Services Inc.* WIPO Case No. D2009-0813; *Artemides Holdings Pty Ltd v. Gregory Ricks*, WIPO Case No. D2008-1254; *Ville de Paris v. Jeff Walter*, WIPO Case No. D2009-1278].

The Complainant has given sufficient evidence to prove extensive global trademark rights on the disputed domain name. Further, the Respondent's adoption and registration of the disputed domain name is dishonest and malafide.

The Respondent contends that since the trademark "Knitmesh" is still pending in the trademark registry, therefore the Complainant does not have rights on the same. This argument is completely wrong. According to Trans Border Reputation concept, which was recognised and discussed by the Supreme court of India in the landmark case of **N. R. Dongre v. Whirlpool (1996) 5 SCC 714**. The Trademark "WHIRLPOOL" was held to have acquired reputation and goodwill in India. The Mark "WHIRLPOOL" was also held to have become associated in the minds of the public with Whirlpool Corporation on account of circulation of the advertisements in the magazines despite no evidence of actual sale. Hence, the trademark WHIRLPOOL was held to have acquired trans-border reputation which enjoys protection in India, irrespective of its actual user or registration in India.

The panel finds that the Respondent was clearly aware of the Complainant as they were both in constant touch over email and telephone according to the evidence shown by both the parties, and that it is clear that the aim of the registration of the disputed domain name was to take advantage of the confusion between the domain name and any potential Complainant rights, which clearly amounts to bad faith. **[Relevant Decisions:** *Kangwon Land, Inc. v. Bong Woo Chun (K.W.L. Inc)* D2003-0320; *Madrid 2012, S.A. v. Scott Martin-MadridMan Websites* D2003-0598; *General Growth Properties, Inc., Provo Mall L.L.C. v. Steven Rasmussen/Provo Towne Center Online* D2003-0845]

The panel finds that the Respondent did not stop using the disputed domain name when contacted by the Complainant, which is a clear indication of Bad Faith on the part of the Respondent.

The panel also finds that the Respondent ought to have known about the brand "Knitmesh" of the Complainant as the Complainant has been using this brand for more than fifty five [55] years. This constitutes Bad faith in the eyes of this panel **[Relevant Decisions:** *SembCorp Industries Limited v. Hu Huan Xin*, D2001-1092; *The Nasdaq Stock Market, Inc. v. H. Pouran*, D2002-0770; *Caesars World, Inc. v. Forum LLC.*, D2005-0517; *Maori Television Service v. Damien Sampat*, D2005-0524]

The Panel finds that Respondent has, used the disputed domain Name in a manner that constitutes bad faith. In particular, using Complainant's copyrighted content on the disputed domain name's website as provided by the Complainant as evidence and generating confusion in the eyes of the public. **[SelectHealth, Inc. v. James E Risinger II WIPO D2012-2275]**



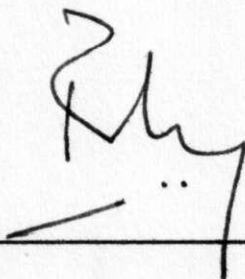


While the overall burden of proof rests with the Complainant, panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is often primarily within the knowledge of the Respondent. Therefore a Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests. Once such *prima facie* case is made, Respondent carries the burden of demonstrating rights or legitimate interests in the domain name.

Thus it is clear that the Respondent is using the disputed domain name in bad faith and has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name.

**[Relevant decisions:** *Lego Juris AS v. Robert Martin* INDRP/125; *Societe Air France v. DNS Admin* INDRP/075; *Kelemata SPA v. Mr Bassarab Dungaciu* WIPO D2003-0849; *Croatia Airlines d.d. v. Modern Empire Internet Ltd.* WIPO D2003-0455; *Uniroyal Engineered Products, Inc. v. Nauga Network Services* WIPO D2000-0503; *Microsoft Corporation v. Chun Man Kam* INDRP/119; D2012-0466 WIPO *Luigi Lavazza S.p.A. v. Noori net*; D2008-1474 WIPO *Serta Inc. v. Charles Dawson*; *Netflix, Inc. v. Sharma*, INDRP/216 (INDRP July 1, 2011); *Guerlain S.A. v. Peikang*, D2000-0055 (WIPO March 21, 2000); *Univ of Houston Sys. v. Salvia Corp.*, FA 637920 (Nat. Arb. Forum March 21, 2006); *Red Hat, Inc. v. Haecke*, FA 726010 (Nat. Arb. Forum July 24, 2006; *Lockheed Martin Corporation v. Steely Black*, INDRP/183 (January 5, 2011); *Equifax Inc. v. The Admin*, INDRP/163 (November 23, 2010);, *Revlon Consumer Products Corporation of New York v. Ye Genrong, et al*, D2010-1586 WIPO November 22, 2010]

The Respondent's registration and use of the domain name [www.knitmesh.co.in] is abusive and in bad faith. The Respondent has no rights or legitimate interests in respect of the domain name. In accordance with Policy and Rules, the Panel directs that the disputed domain name [www.knitmesh.co.in] be transferred from the Respondent to the Complainant; with a request to NIXI to monitor the transfer.

A handwritten signature in black ink, appearing to read 'Rodney D. Ryder', is written over a horizontal line.

**Rodney D. Ryder**  
**Sole Arbitrator**

**Date: June 3, 2013**