



தமிழ்நாடு தமில்நாடு TAMILNADU

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1002
23.4.2012

Sridharan
Chennai

BEFORE THE INTERNET EXCHANGE OF INDIA
ARBITRATION AWARD

ARBITRATOR: S. SRIDHARAN

Dated: 16th APRIL 2012

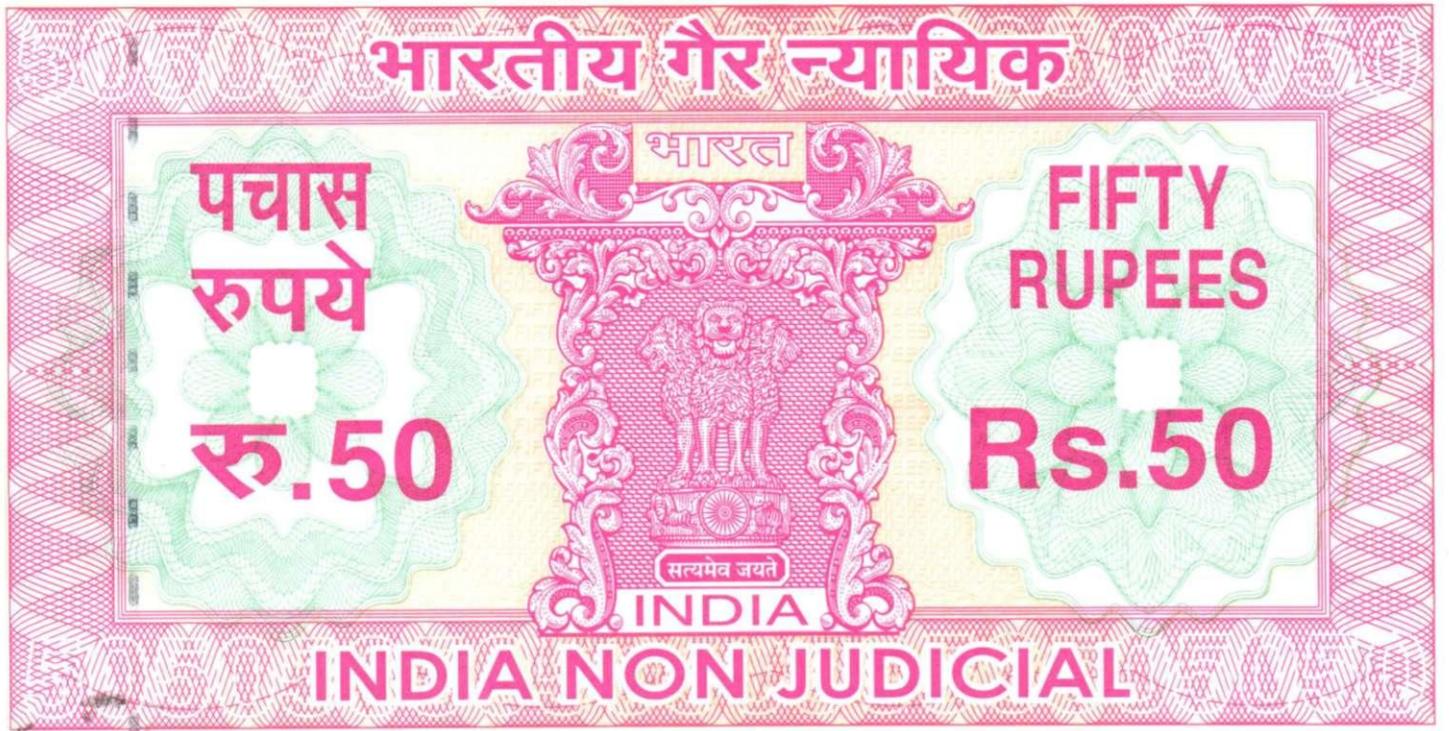
MISSONI SPA

--- Complainant

-VS-

Domain Investment Inc/CIYU --- Respondent

Sridharan



குழிநாடு தமிழ்நாடு TAMILNADU

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MISSONI S.p.A. ... Complainant

Versus

Domain Investment, Inc./Liyu ... Respondent

1. The Parties

- 1.1 The complainant is **Missoni S.p.A.**, an incorporated business forming a joint stock company of Italian nationality with principal place of business in Sumirago (Varese) - Italy represented by Dr. Fabrizio Bedarida of Dr. Modiano & Associati S.p.A. at Via Meravigli, 16 – 20123 Milan – Italy
- 1.2 Respondent is Liyu of Domain Investments Inc at weihai, weihai, Shandong, 223911 – China.

The Domain Name and Registrar

- 1.3 The disputed domain name **<missonihome.in>** is registered with A to Z Domains Solutions Pvt. Ltd (R124-AFIN).

2. Procedural History

- 2.1 On 9th February 2012, NIXI asked me about my availability and consent to take up the Complaint for arbitration. On 12th February 2012, I informed my

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availability and consent. I also informed NIXI that I had no conflict of interest with either of the parties and could act independently and impartially.

- 2.2 On 16th February 2012, I received hardcopy of the Complaint along with Annexures. Since I was away from my place, I could not issue notices immediately to the Respondent and Complainant
- 2.3 On 23rd February 2012, I issued by email a Notice to the Respondent setting forth the relief claimed in the Complaint and directing him to file his reply to the Complaint within 15 days. I also sent an email about my appointment to arbitrate the complaint to the Complainant and asked the Complainant to send a soft copy of the complaint to me.
- 2.4 On 23rd February 2012, I received a soft copy of the Complaint from the Complainant.
- 2.5 Respondent did not file any response to the Complaint.
- 2.6 Email is the medium of communication of this arbitration and each email is copied to all, Complainant, Respondent and NIXI.

3. Factual Background

A Complainant

- 3.1 The Complainant owns the trade marks MISSONI, MISSONI HOME and MISSONI HOME COLLECTION. Complainant is a leading company in the fashion field, and its goods are marketed and promoted in almost every country including India. As a consequence, the trademark, the trade name and the family name of the designer (Mr. Ottavio Missoni) are well known

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throughout the entire world. These have been extensively used by Missoni for many years. Due to this use, Missoni has continually developed the goodwill and repute of the trademark and this is the most valuable and important asset of the company. As to the trademarks of Complainant in Italy, the first filing for MISSONI dates back to September 2, 1969 while MISSONI HOME was filed for the first time on January 25, 2005.

- 3.2 In addition, Missoni is the owner of many national, international and community registered trademarks. A further description of the main goods and services for which the Complainant uses its trademark can be had from Complainant's official website www.missoni.com. In fact, Missoni has published company information via internet for years. Indeed, Complainant has registered quite a number of country and generic domain names corresponding to its trademarks and providing Company information, among them there are also the domain names www.missonihome.eu, www.missonihome.asia and www.missonihomecollection.com

B Respondent

- 3.3 The Respondent has not filed any reply to the Complainant's Compliant in this arbitration.

4. Parties Contentions

A Complainant

- 4.1 The disputed domain name <missonihome.in> can be considered confusingly similar to the renowned trademarks MISSONI, and MISSONI

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HOME COLLECTION and it is identical to the trademark MISSONI HOME all of them rightfully registered by Complainant. The disputed domain name <missonihome.in> is also confusingly similar to Complainant's company name MISSONI S.p.A. and to Complainant's domain names such as www.missoni.com, www.missoni.it, www.missoni.eu www.missonihome.eu, www.missonihome.asia www.missonihomecollection.it and www.missonihomecollection.eu. The only difference between the disputed domain name <missonihome.in> and Complainant's trademark MISSONI HOME consists in the addition of the ccTLD .in. In addition, the only difference between the disputed domain name and the main trademark MISSONI is given by the addition of the generic term "HOME".

- 4.2 Complainant asserts that: **(a)** no agreements, authorisations or licenses have been granted to the Respondent to use Complainant's trademarks, trade name and Company name; **(b)** The use of disputed domain name <missonihome.in> containing Complainant's entire mark, makes it difficult to infer a legitimate use of the disputed domain name <missonihome.in> by Respondent. **(c)** Upon information and belief, there is no evidence that the Respondent has trademarks or company activities registered under the names MISSONI, MISSONI HOME and/or any other name similar to them. **(d)** The disputed domain name <missonihome.in> for a certain period was parked free through the Sedo domain parking program. In addition, the disputed domain name <missonihome.in> was and still is for sale **(e)** Upon information and belief, since registration of the disputed domain name

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<missonihome.in> Respondent has never made any bona fide use of this domain name; (f) Upon information and belief, Respondent has never been known under the MISSONI or MISSONI HOME names.

4.3 All the above shows a lack of interest and of legitimate use of the disputed domain name <missonihome.in>. Complainant thus claims that: Respondent has no rights or legitimate interests in respect of the disputed domain name <missonihome.in>.

4.4 Respondent knew of Complainant's activity and trademarks when registering the disputed domain name. This is supported by the following facts:

(a) The MISSONI trademarks are WORLDWIDE renowned marks. This has been acknowledged by other WIPO Panels in many decisions some of them are here below reported: - Missoni S.p.A. v. Ahmed Salman Case No. D2007-1485; Missoni S.p.A. v. Caribbean Online International Ltd., Case No. D2007-0885; Missoni S.p.A. v. BigDoggie.com and Taeho Kim, Case No. D2002-0545; Missoni S.p.A. v. Nurinet Case No. D2010-1068; Missoni S.p.A. v. Liu Zhixian Case No. D2010-0371;

(b) Complainant started to publish company information via internet through its official Web site at the URL www.missoni.it in the year 2000;

End of answers

- (c) Complainant has registered numerous domain names corresponding to and or comprising its trademarks MISSONI, MISSONI HOME and MISSONI HOME COLLECTION;
- (d) As was stated by the Panelist in WIPO Case No. D2001-1375 domain gianfranco-ferre.com: *«Taking into consideration the fame of Complainant and Complainant's trademarks, it may reasonably be assumed that Respondent knew of Complainant and its trademarks when he registered the Domain Name».*
- (e) In addition, as affirmed by the Panel in the above quoted decision *Missoni S.p.A. v. Liu Zhixian* WIPO Case No. D2010-0371 *«Complainant's mark is distinctive and well known around the world. Without some colorable right to use that mark there are few if any plausible explanations for incorporating it into a disputed domain name other than the free ride identified in paragraph 4(b)(iv)»;*
- (f) In view of all the above, it is highly unlikely that Respondent registered the disputed domain name without knowledge of the MISSONI trademarks.

4.5 The fact that the Respondent, though having actual knowledge of Complainant and its trademarks, proceeded to register the disputed domain name <missonihome.in>, shows Respondent's bad faith in registering the disputed domain name <missonihome.in>. Actual knowledge of the Complainant's rights on the trademark is a factor that

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has been repeatedly considered in previous UDRP decisions as supporting bad faith.

- 4.6 Complainant is being hindered and penalised by the use of this disputed domain name <missonihome.in> which is misleading Internet users and creating a likelihood of confusion with Complainant's trademarks and domain names.
- 4.7 By registering the disputed domain name <missonihome.in> Respondent also prevents Complainant from activating its website under one of the .in extensions corresponding to India in which Complainant has trademark rights.
- 4.8 The fact that Respondent is also not using the disputed domain name <missonihome.in> that is merely placed on sale, demonstrates that Respondent is aware of the disputed domain name's value and planned to make a profit out of it by offering it for sale also through Sedo.
- 4.9 Respondent appears to have registered more than one hundred domain names among them there are also several corresponding to and therefore presumably infringing renowned third parties' trademarks such as: marksandspencer.co.in, clubmed.in, carlsonwagonlittravel.in, skoda-auto.in, yonex.in and footlocker.in.
- 4.10 The use of Complainant's mark in the disputed domain name <missonihome.in> makes it difficult to infer a legitimate use of the disputed domain name by Respondent. No plausible explanation exists as

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to why Respondent selected the disputed domain name <missonihome.in> other than to trade on the goodwill of Complainant's renowned trademarks <MISSONI> and <MISSONI HOME>.

- 4.11 Respondent is not using the disputed domain name <missonihome.in>. In fact, at the disputed domain name <missonihome.in> solely a page containing exclusively sponsored links and the offer of the domain name for sale is displayed. Complainant believes that this use of the disputed domain name <missonihome.in> made by the Respondent can also be considered as a passive holding.
- 4.12 Respondent's main purpose is to sell the disputed domain name <missonihome.in>. This is shown by the fact that the disputed domain name <missonihome.in> was listed for sale on the Sedo website for a certain period of time. Indeed, the following message, offering the domain for sale, was displayed on the website www.missonihome.in: «il dominio missonihome.in è in vendita» (The domain name missonihome.in is for sale). This is further inference of bad faith registration and use of the domain name.
- 4.13 It is very important to note that an entity named Domainjet/Jack Sun (with the very same email address domainjet@foxmail.com) appeared to be the previous owner of the disputed domain name <missonihome.in> as well as of the following domain names: hotelmissoni.in, hotelmissoni.co.in, missonihome.co.in and missonifragrance.com

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4.14 DomainJet/Jack Sun tried to sell the domain name missonifragrance.com for two hundred Euros to the Complainant. However, Complainant, having ascertained that Jack Sun was also the holder of the domain names: hotelmissoni.in, hotelmissoni.co.in, missonihome.co.in and missonihome.in, requested him to transfer all of them offering to reimburse the registration costs. This offer was refused by Jack Sun that wanted a higher price.

B. Respondent

4.15 Respondent has not filed any reply to the Complainant's Complaint in this arbitration.

5. Discussion and Findings

5.1 Respondent did not file his response within the stipulated time. I have not received any communication from him until the date of this award. Since the Respondent chose not to respond to this Complaint, I am proceeding to determine this Complaint on the basis of the materials available on record.

5.2 The Complainant in order to succeed in the Complaint must establish under Paragraph 4 of .IN Domain Name Dispute Resolution Policy (INDRP) the following elements:

- (I) Respondent's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;
- (II) Respondent has no rights or legitimate interests in respect of the domain name; and

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

5.3 Each of the aforesaid three elements must be proved by a Complainant to warrant relief.

Disputed domain name is identical or confusingly similar to a trade mark of the Complainant.

5.4 The Complainant is the proprietor of the marks MISSONI, MISSONI HOME and MISSONI HOME COLLECTION. The Complainant has been using the mark since 1969. In Italy, the first filing for MISSONI dates back to September 2, 1969 while MISSONI HOME was filed for the first time on January 25, 2005. The Complainant registered his domain name www.missoni.com in 1999, www.missonihome.eu in 2006, www.missonihome.asia in 2008 and www.missonihomecollection.com in 2005. The disputed domain name **<missonihome.in>** was registered on 27th September 2010. Obviously, the Complainant is the prior adopter and registrant of the MISSONI marks. The above facts have established that the Complainant has common law rights in India in respect of its MISSONI trade marks.

5.5 The Complainant's MISSONI marks are famous and well known throughout the world including India. It is clearly seen that the disputed domain name **<missonihome.in>** wholly incorporates MISSONI and MISSONIHOME marks of the Complainant. The disputed domain name **<missonihome.in>** is similar to the Complainant's domain names www.missoni.com,

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www.missonihome.eu, www.missonihome.asia, and www.missonihomecollection.com . In all these domain names, MISSONI is the distinctive part and the rest are non-distinctive.

5.6 I, therefore, find that:

- (a) The Complaint has common law rights in respect of its MISSONI marks in India.
- (b) The disputed domain name <www.missonihome.in> is:
 - (i) Identical to the Complainant's prior trade mark MISSONIHOME and similar to the complainant's prior trade marks MISSONI and MISSONI HOME COLLECTION and
 - (ii) Similar to the Complainant's prior domain names www.missoni.com, www.missonihome.eu, www.missonihome.asia and www.missonihomecollection.com .

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

5.7 It is already seen that:

- (a) The Complainant is the prior adopter and user of MISSONI marks. The Complainant's MISSONI marks are well known in many countries across the globe including India.

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(b) The Complainant's trade mark was first registered in Italy in 1969. The disputed domain name <missonihome.in> was registered by the Respondent on 27th September 2010.

5.8 Respondent did not register the disputed domain name <missonihome.in> until 2010. As such, chances are slim to none that Respondent was unaware of the famous MISSONI marks and Complainant's rights thereto prior to registering the disputed domain name in <missonihome.in> 2010.

5.9 I visited the web site of the Respondent under the disputed domain name <missonihome.in>. "This web site is for sale" appears prominently in the middle of the web page under the disputed domain name <metlife.in>. The disputed domain name also provided links to web sites of the Complainant's competitors. It is obvious that the Respondent never intended to use the disputed domain name <missonihome.in> in connection with a bona fide offering of goods or services.

5.10 In the absence of response from the Respondent, I accept the argument of the Complainant that:

(a) No agreements, authorisations or licenses have been granted to the Respondent to use Complainant's trademarks, trade name and Company name;

(b) The use of disputed domain name <missonihome.in> containing Complainant's entire mark, makes it difficult to infer a legitimate use of the disputed domain name <missonihome.in> by Respondent.

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- (c) There is no evidence that the Respondent has trademarks or company activities registered under the names MISSONI, MISSONI HOME and/or any other name similar to them.
- (d) The disputed domain name <missonihome.in> for a certain period was parked through the Sedo domain parking program. In addition, the disputed domain name <missonihome.in> was and still is for sale.
- (e) Since the registration of the disputed domain name <missonihome.in> Respondent has never made any bona fide use of this domain name;
- (f) Respondent has never been known under the MISSONI or MISSONI HOME names.

5.11 All the above shows a lack of interest and of legitimate use of the disputed domain name <missonihome.in>. Respondent has no rights or legitimate interests in respect of the disputed domain name <missonihome.in>.

5.12 Therefore, I have no hesitation to hold, for the above reasons that the Respondent has no right or legitimate interest in respect of the disputed domain name <missonihome.in>.

Respondent's domain name has been registered or is being used in bad faith.

5.13 The Complainant is the proprietor of the MISSONI marks. Complainant has been using the MISSONI marks continuously since 1969. The

Complainant has registrations for the MISSONI marks in Italy. In Italy, the first filing for MISSONI dates back to September 2, 1969 while MISSONI HOME was filed for the first time on January 25, 2005. The Complainant registered his domain name www.missoni.com in 1999, www.missonihome.eu in 2006, www.missonihome.asia in 2008 and www.missonihomecollection.com in 2005. The disputed domain name **<missonihome.in>** was registered on 27th September 2010. Obviously, Complainant's right in the MISSONI marks pre-dates Respondent's registration of the disputed domain name **<missonihome.in>**. The Respondent could not have ignored, rather actually influenced by, the well-known MISSONI marks of the Complainant at the time he acquired the disputed domain name **<missonihome.in>**.

5.14 As seen above, Respondent is currently placed the disputed domain name **<missonihome.in>** for sale. The disputed domain name **<missonihome.in>** merely gives links to web sites of the Complainant's competitors. The Respondent is no way connected with the Complainant. Respondent's adoption of the disputed domain name **<missonihome.in>** is nothing but an unjust exploitation of the well known reputation of the Complainant's prior MISSONI marks.

5.15 Respondent's lack of response to the Complaint indicates that the Respondent has no reason and/or justification for the adoption of the Complainant's MISSONI marks.

5.16 I agree with the Complainant's arguments that:

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- (a) Complainant is being hindered and penalised by the use of this disputed domain name <missonihome.in> which is misleading Internet users and creating a likelihood of confusion with Complainant's trademarks and domain names.
- (b) By registering the disputed domain name <missonihome.in> Respondent also prevents Complainant from activating its website under one of the .in extensions corresponding to India in which Complainant has trademark rights.
- (c) Respondent's main purpose is to sell the disputed domain name <missonihome.in>. This is shown by the fact that the disputed domain name <missonihome.in> was listed for sale on the Sedo website for a certain period of time. Indeed, the following message, offering the disputed domain name <missonihome.in> for sale, was displayed on the website: «il dominio missonihome.in è in vendita» (The domain name missonihome.in is for sale). This is further inference of bad faith registration and use of the domain name.
- (d) An entity named Domainjet/Jack Sun (with the very same email address domainjet@foxmail.com) appeared to be the previous owner of the disputed domain name <missonihome.in> as well as of the following domain names: hotelmissoni.in, hotelmissoni.co.in, missonihome.co.in and missonifragrance.com
- (e) DomainJet/Jack Sun tried to sell the domain name missonifragrance.com for two hundred Euros to the Complainant.

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However, Complainant, having ascertained that Jack Sun was also the holder of the domain names: hotelmissoni.in, hotelmissoni.co.in, missonihome.co.in and the disputed domain name <missonihome.in>, requested him to transfer all of them offering to reimburse the registration costs. This offer was refused by Jack Sun that wanted a higher price.

5.17 Thus it is clearly established that Respondent registered the disputed the disputed domain name <missonihome.in> in bad faith.

5.18 The actions of the Respondent should not be encouraged and should not be allowed to continue. Respondent never intended to put the disputed domain name <missonihome.in> into any fair/useful purpose. Respondent not even considered it worth responding the complaint of the Complainant. Respondent did not file any response. The conduct of the Respondent has necessitated me to award costs of the Complaint to and in favour of the Complainant.

6. **Decision**

6.1 For all the foregoing reasons, the Complaint is allowed as prayed for in the Complaint.

6.2 It is hereby ordered that the disputed domain name <missonihome.in> be transferred to the Complainant.

6.3 Respondent is ordered to pay the Complainant a sum of Rs.10,00,000/- (Rupees ten lakhs only) towards costs of the proceedings.

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