

ఆంధ్రప్రదేశ్ ఆంధ్ర ప్రదేశ్ ANDHRA PRADESH

K.Rama Chandravathi
R 664240

Sl. No.: 23208 Date.12/05/2011.
Sold To : Harini Narayanswamy
S/o. : B. Narayanaswamy
To Whom : Self R/o Flat No.545/A, Road No.86, J Hills, Hyd.

K.RAMA CHANDRAVATHI
Licenced Stamp Vendor
LIC No.16-11-27/1999
REN. No.16-11-5/2011
H.No.6-3-387, Near Himalaya Book World
Beside Petrol Pump Punjagutta
HYDERABAD (SOUTH) DISTRICT
PHONE NO.23351799, 9392490025

BEFORE THE NATIONAL INTERNET EXCHANGE OF INDIA
ARBITRATION AWARD

In The Matter Between

Consorzio del Prosciutto di Parma

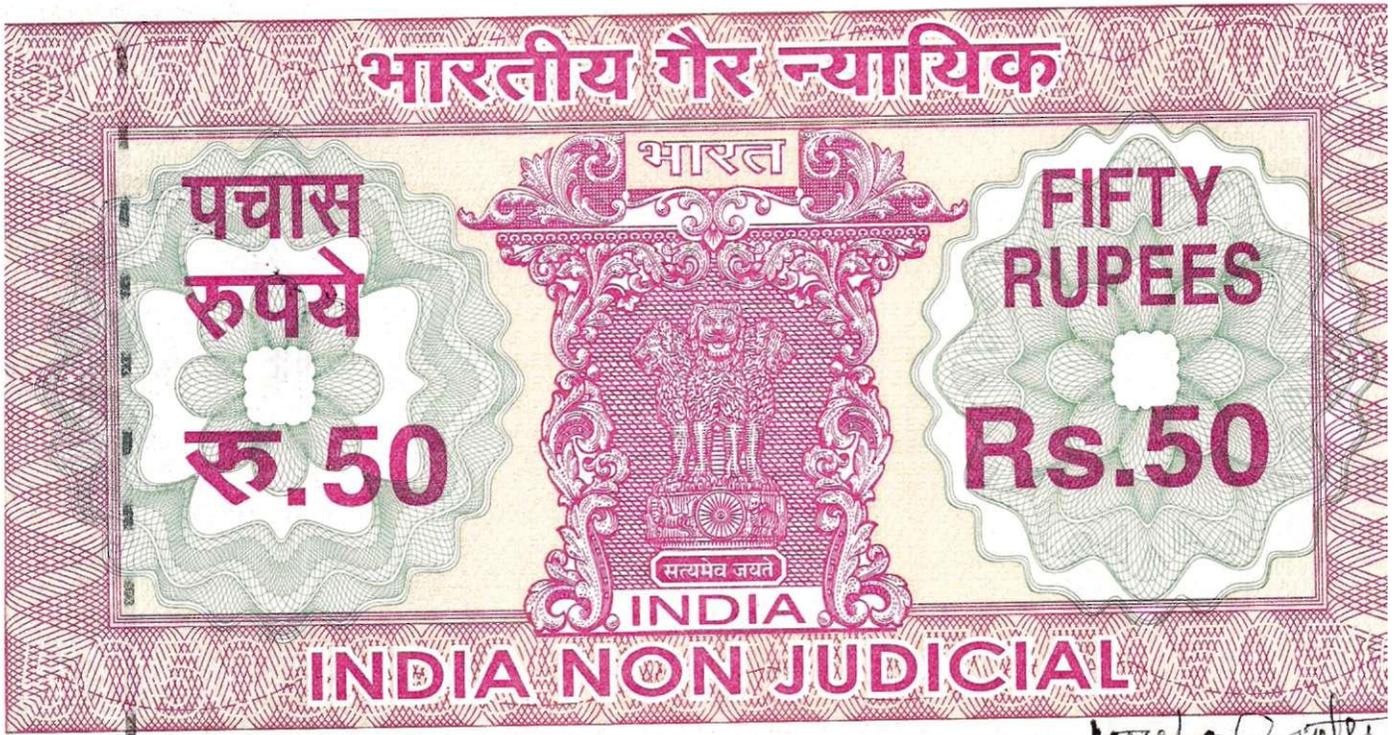
Complainant

Versus.

Jim Muller

Respondent

Harini Narayanswamy



ఆంధ్రప్రదేశ్ ఆంధ్ర ప్రదేశ్ ANDHRA PRADESH

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R 66423

Sl. No.: 23905 Date: 12/05/2011.
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1. The Parties

The Complainant is Consorzio del Prosciutto di Parma of Via Marco dell' Arpa 8/b43100 Parma Italy represented in these proceedings by Sudhir D.Ahuja of D.P Ahuja and Co.of Kolkata, india.

The Respondent is Jim Muller, of Domain Solutions. 1658 Kanchipuram, Tamil Nadu 603109. India.

2. The Domain name, Registrar and Policy

This Arbitration pertains to a dispute regarding the domain name <parmaham.co.in>. The registrar for the disputed domain name is Directi Internet Solutions Pvt. Ltd.

The Arbitration Proceeding is conducted in accordance with the Arbitration and Conciliation Act of 1996 (India), the current .IN Domain Name Dispute Resolution Policy (the "INDRP Policy"), and the INDRP Rules of Procedure (the "Rules").

3. Procedural History

The sole arbitrator appointed in the case is Mrs. Harini Narayanswamy. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, in compliance with the Rules.

The Arbitrator received the Complaint from the .IN registry on May 5, 2011 and on May 6, 2011 transmitted by email a notification of commencement of the arbitration proceedings to the Respondent. Under the INDRP Rules, copies of the said notification were sent to other interested parties to the dispute. The Respondent was given twenty-one days time from the date of the notification to file a response. The Respondent did not reply to the notification or file any response in these proceedings. Based on the material on record the Arbitrator now proceeds to determine the case on its merits.

Factual Background

The Complainant Consorzio del di Parma, is a voluntary consortium of Parma 1 lam producers and was set up in 1963 on the initiative of 23 producers of Parma region in Italy, with the objectives of safe guarding the genuine products of Parma. The Complainant states the consortium presently has 189 members. The Complainant and its members use the trademark P A R M A H A M for their ham products. On November 4, 2010 the Respondent registered the disputed domain name <parmaham.co.in>.

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4. Parties contentions

A. Complainant's Submissions

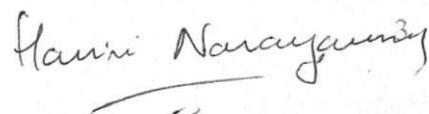
The Complainant states that since roman times the unique dry conditions of the clearly defined region of Parma made it possible to produce the highest quality hams that have been appreciated by gourmet for centuries. The tradition and practice of preparing specially cured ham dates back to 100 BC. The word "Prosciutto" is derived from the Latin *perexsuctwn* meaning "dried", which is an indication of the purity of Parma ham production and its roots in Italy.

Only hams produced and cured in the hills around Parma may use the term Parma Hams. The Consortium's quest for perfection was acknowledged by the European Union in 1996 when Parma Ham became one of the first meat products to be awarded the Designation of Protected Origin status. The designated status of the product entails that all Parma Ham producers must be located within the geographical boundaries of the Parma production area. 5 km south of the via Emilia, limited to the east by the river Enza and on the west by the river Stirone. and up to the altitude of 900 m.

Complainant states it owns several domain names, several Geographical Indication (GI) registrations, trademarks and certification marks containing and pertain to PROSCIUTTO DI PARMA. PARMA. PARMA HAM and their variants. The complainant has furnished a list of its registered marks along with copies some trademark and GI registrations. Copies of news articles and news items about the Complainant and its activities, published in Indian and International media and prior cases recognizing its ownership rights in the mark including WIPO Case D2010-1561 and INDRP case / 198 are filed.

The Complainant bases the present complaint on the grounds that the disputed domain name is identical or confusingly similar to the name, trademark or service mark in which the Complainant has rights. In reply to a cease and desist letter sent by the Complainant to the Respondent, the Respondent allegedly requested for EUR 3000 to transfer disputed domain name and later reduced the sum to EUR 1000.

The Complainant argues the Respondent has no rights or legitimate interest in the disputed domain name as the Respondent has not been given any license to use the trademark, Geographic Indication or service mark and is not authorized to use the Complainant's mark. Further, the Respondent is not known by the disputed domain name and the disputed domain name is not used in a *bona fide* manner but is used to suggest a false affiliation with the Complainant. Such use does not constitute legitimate use or non-commercial fair use, as it misleads customers by creating a likelihood of confusion. The disputed domain name resolves to a dummy website parked with SEDO that has displayed the domain name is for sale. Complainant's marks and GI are particularly strong and have gained absolute exclusivity in respect to its unique products and it is not likely that the Respondent could conceivably use it for a business with the same name.


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The Complainant asserts the disputed domain name was registered and is used in bad faith, as there is no active website linked to the domain name. Further, passive use is also recognized as bad faith registration and use in such circumstances. The Respondent has intentionally attempted to attract users by creating a likelihood of confusion with the Complainant's mark that deceives the public. The Respondent ought to have known of the Complainant's internationally recognized rights that predate the domain name registration by several years. The Respondent's offer to transfer the domain name for a hefty sum and the Respondent advertising its sale indicates bad faith registration and use of the disputed domain name. For all these reasons the Complainant requests for transfer of the disputed domain name.

B. Respondent's Submissions

Discussion and Findings

Under the .IN Policy, the registrant of the domain name is required to submit to a mandatory arbitration proceeding in the event that a complaint is filed in the .IN Registry, in compliance with the .IN Policy and the INDRP Rules.

The .IN Policy, Paragraph 4 requires the Complainant, to establish the following three elements:

- (i) The domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights, and
- (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.

Identical or Confusingly Similar

The first element requires the Complainant to prove that the domain name registered by the Respondent is identical or confusingly similar to a mark in which the Complainant has rights.

The Arbitrator finds that the Complainant has submitted documents showing registered rights in the trademark P A R M A H A M and related marks, in particular, the Complainant has submitted the documents of its US trademark registration for PROSCJUTTO DI P A R M A bearing number 2,914,629, for ham products, its US trademark registration renewal 2014629. registration date 11/12/ 1996, trademark registration for Britain and Northern Ior PROSCIUTTO DI P A R M A Ireland bearing No 1457951 underclass 29 dated September 12. 1997 and its European Community trademark under class 29, its India GI registration G.I 164 dated 27.01.2011 in class 29. These documents establish the Complainant's statutory rights in the trademark P A R M A H A M establish that the Complainant has adopted and used the mark extensively for a considerable period and show the mark is distinctive of the Complainant and its services.

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The disputed domain name entirely incorporates the Complainant's trademark P A R M A H A M . As argued by the Complainant it is a deliberate attempt to make the disputed domain name confusingly similar to the mark. The deliberate inclusion of a well-known trademark by a third party in a domain name is recognized as cyber squatting as it results in confusing similarity of disputed domain name with the mark. See *Grundfos A/S v. Telecom Tech Corp./Private Registration*, WIPO Case No. D2010-0735.

The Complainant in the present case has established that it has extensive worldwide business for its products. Further, the Arbitrator notes that the Complainant's adoption and use of the mark has been for a considerable length of time and has used it widely in numerous jurisdictions. Based on these undisputed submissions by the Complainant, the Panel finds the disputed domain name is confusingly similar to the Complainant's mark. The country code top level domain (cc TLD) suffix does not lessen the confusing similarity of the domain name with the trademark. See for instance *Morgan Stanley v. Bharat Jain*, 1NDRP Case No. 156 dated October 27, 2010.

For the reasons discussed, the Arbitrator finds that the Complainant has satisfied the first element under paragraph 4 of the Policy.

Rights and Legitimate Interests

The second element requires the Complainant to show that the Respondent has no rights and legitimate interests in the disputed domain name.

The Complainant has asserted that the Respondent has no rights or legitimate interests in the disputed domain name, as the Respondent has not been given any authorization to use the Complainant's mark. Paragraph 7 of the Policy states a Respondent or a registrant can establish rights in the domain name, if (i) before notice of the dispute, the registrant had used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services or (ii) the registrant (as an individual, business organization) has been commonly known by the domain name, or (iii) The registrant is making legitimate, non commercial or fair use of the domain name without intent for commercial gain.

The Respondent has not responded in these proceedings and has not provided any material to show rights in the disputed domain name, The material on record does not show that the Respondent is commonly known by the disputed domain name or is making any legitimate noncommercial fair use of the disputed domain name.

In the Arbitrator's view, the use of the Complainant's mark in the disputed domain name is likely to mislead the public and internet users that the disputed domain name may refer to the Complainant and its products. Internet users may falsely believe that the Respondent's domain name and website are being operated or endorsed by the Complainant.

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Misleading users by incorporating others trademarks in a domain name gives a false impression to users and does not constitute a *bona fide* offering of goods and services under the Policy. This view has been upheld in several prior decisions including UDRP cases. See for instance, *Zurich American Insurance Company v. Administrator. Domain*. WIPO Case No.D2007-0481 (Use of a confusingly similar or identical domain name to divert internet users is not use that can be termed a *bona fide* offering of goods and services).

The Arbitrator finds the Complainant has made a *prima facie* case that the Respondent has no rights and legitimate interests in the disputed domain name and has satisfied the second element under paragraph 4 of the Policy.

Bad Faith

Under the INDRP Policy the Complainant is required to establish that the domain name was registered or is being used in bad faith.

The Complainant has put forward the following submissions that the Respondent has registered the disputed domain name in bad faith and uses it in bad faith. First, the Complainant has prior rights in the well-known trademark PARMA MAM. Second, the Respondent has intentionally attempted to attract users by creating a likelihood of confusion with the Complainant's mark as to source of endorsement and affiliation: Third, the Complainant's prior adoption of the mark that predates the Respondent's domain name registration by several decades. Four, the Respondent's passive holding of the disputed domain name without an active website indicates bad faith registration use and Five, the disputed domain name being advertised for sale shows bad faith registration and use.

Based on the documents on record and the facts and circumstance in the present case, the Arbitrator finds the arguments of the Complainant are persuasive. The Complainant has filed documents that establish its prior adoption and use of the PARMA HAM mark. The Complainant's trademark applications were made much before the disputed domain name registration. The Complainant's trademark is undoubtedly well known and it is unlikely that the Respondent did not know of the Complainant's prior rights in the mark when he registered the disputed domain name. The very choice of the domain name is not a mere coincidence but is a deliberate use of a well-recognized mark to attract unsuspecting users to the Respondent's site. Registration of a domain name, based on awareness of a complainant's trademark rights is recognized as bad faith registration under the Policy, *Lego Juris v. Robert Martin*, INDRP / 125. February 14, 2010.

Under Paragraph 6 (iii) of the Policy, if the registrant of the domain name in dispute, has used the domain name to intentionally attract Internet users to the Registrant's website or other online location by creating a likelihood of confusion with the trademark of another, it is considered evidence of bad faith.

The Panel finds the circumstances here suggest that there is no reasonable explanation for the registration and use of the disputed domain name except that the Respondent seeks to

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exploit the reputation and goodwill associated with the Complainant's mark to attract Internet traffic to the Respondent's website and to mislead customers to believe that the Complainant is in some way associated with the Respondent's website. The registration and use of a domain name that exploits the goodwill of another's trademark is considered bad faith under the INDRP Policy, See *Eli Lilly and Company v Andrew Yan*, INDRP Case 195, dated February 16, 2011. The registration of a well-known mark itself is evidence of bad faith registration. See *Genpact Limited v. Manish Gupta*. INDRP/056. or *Advance Magazines Publishers Inc. v. JF Limited. England. (<vogue.co.in>)*, INDRP Case 184, January 27, 2011.

For the reasons discussed, the Arbitrator finds the disputed domain name has been registered and used in bad faith under the Policy.

Decision

For all the reasons discussed, the Arbitrator orders that the disputed domain name <parmaham.co.in> be transferred to the Complainant.

A handwritten signature in blue ink that reads "Harini Narayanswamy". The signature is written in a cursive style with a long, sweeping underline.

Harini Narayanswamy (Arbitrator)

Date: June 16, 2011