



उत्तर प्रदेश UTTAR PRADESH

BL 220313



Dr. Bodhisatva Acharya
ARBITRATOR

(Appointed by .IN Registry-National Internet Exchange of India)

ARBITRATION AWARD

Case No. INDRP/452

DISPUTED DOMAIN NAME : < www.pizzaexpress.co.in >

In the matter of:
PizzaExpress Limited
Hunton House,
Highbridge Estate Oxford Road,
Uxbridge, Middlesex UB8 1LX
United Kingdom

Filed by its authorized representative attorney -
Anand & Anand
Attn: Revanta Mathur/Twinky Rampal
First Channel, Plot No.17A
Sector 16A, Film City, Noida
Email-revanta@anandandanand.com
twinky@anandandanand.com

..... .Complainant.

Vs.

**Machang, Hua An Holdings (H.K.) Limited
Room 14-050301, West Block, North, Hong Kong
Postal code: 999077, HK
E-mail- domainbook@hotmail.com**

.....Respondent.

A W A R D

1. The Parties:

The complainant in this arbitration proceeding is PizzaExpress Limited, Hunton House, Highbridge Estate Oxford Road, Uxbridge Middlesex UB8 1LX, United Kingdom filed by its authorized representative attorney Anand & Anand, Attn: Revanta Mathur/Twinky Rampal, First Channel, Plot No.17A Sector 16A, Film City, Noida with Email- revanta@anandandanand.com & twinky@anandandanand.com

Respondent Machang, Hua An Holdings (H.K.) Limited, Room 14-050301, West Block, North, Hong Kong, Postal code: 999077, HK with E-mail- domainbook@hotmail.com

2. The Domain Name, Registrar & Registrant:

The disputed domain name is www.pizzaexpress.co.in

3. Procedural History:

The complainant, through its authorized representative, filed this complainant to NIXI regarding the disputed domain name www.pizzaexpress.co.in following the clause 4 of the policy of .IN Registry and .IN Registry appointed Dr. Bodhisatva Acharya (The Arbitrator) as Sole Arbitrator under clause 5 of the policy. The Arbitrator submitted his statement of acceptance and declaration of Impartiality and the Independence on January 9th, 2013 and the complaint was produced before the Arbitrator on January 21st, 2013 and the Arbitrator sent a notice, to the Respondent through his email for the Arbitration Proceeding on January 22nd, 2013, to submit his reply in 14 days but



Respondent gave no response till the date of award and hence on February 23rd, 2013 the Award has been declared as Ex-parte.

4. Factual Background:

- (a) The Trademark PIZZA EXPRESS is used worldwide by the Complainant, in respect of providing food products that includes pizzas and pizza products, preparations for making pizzas, toppings, sources, spices and flavorings, pizza dough and pizza flour, pasta and pasta based meals, prepared meals and snacks, desserts and pudding, ice cream, cakes, tea, sugar, beverages with chocolate or coffee base, bread, garlic bread, spaghetti and related restaurant, catering and bar services.
- (b) Complainant, PizzaExpress Limited, is an extremely well known and reputed company and is the proprietor of the trademark and trade name **PIZZA EXPRESS** having adopted and used the same since the year 1965 internationally at a time when no other party was using the same. The Complainant was established in the year 1965 by Peter Boizot in London when he started the first **PIZZA EXPRESS**. Over the years the **PIZZA EXPRESS** location spread across United Kingdom and thereafter the Complainant operates or has operated restaurants in several other countries worldwide including India since 1st December 1997.
- (c) The complainant has won several awards and accolades for the goods and services under the trademark name **PIZZA EXPRESS**. Presently the Complainant directly or through its related companies or its franchisees operates more than 300 **PIZZA EXPRESS** restaurants worldwide including in UK, Ireland, Jersey, Hong Kong, United Arab Emirates, Oman, Qatar, Kuwait, Gibraltar, Cyprus with several new stores scheduled to open in the coming years. In the past the Complainant has also operated restaurants in at least Russia, Saudi Arabia, Poland, France and India. The Petitioner has established a good market in UK and Ireland. In some countries the Complainant also operates as Milano, Pizza Milano and Pizza Marzano.
- (d) In India, the Complainant entered into a master franchise agreement with The Modi group company, Lombard Street (Estates) Pvt. Ltd (LSEPL) and has set up restaurants under the trademark **PIZZA EXPRESS** in New Delhi in the past.
- (e) It is pertinent to note that the Complainant operates restaurants under the trademark **PIZZA EXPRESS** across the United Kingdom and its related companies or franchisees operate under the mark **PIZZA EXPRESS** in several countries worldwide including in India. In such a case, the members of trade and consuming public would believe that any party using a mark which is identical to the Complainant's trademark **PIZZA EXPRESS** could have some nexus, affiliation with the Complainant/its related company or is a franchisee of the complainant. All the goodwill and reputation accrued



through use of PIZZA EXPRESS by its related companies or its franchisees belongs to the Complainant.

- (f) The Complainant has expended a great amount of time, money and effort to promote and advertise the trademark **PIZZA EXPRESS** in all and every manner possible. As a result the complainant has been established an impeccable reputation and goodwill under its trademark **PIZZA EXPRESS** worldwide including in India.
- (g) In India, a huge awareness for such products have also stemmed from widespread exposure and publicity of the PIZZA EXPRESS products and services, in magazines and newspapers having a widespread reach and circulation in India, exposure via the internet, exposure of consumers to PIZZA EXPRESS products and services overseas, word of mouth publicity and review articles appearing in various trade publications etc.
- (h) The Complainant is the owner of the top level domain name PIZZAEXPRESS.COM well as several other country code top level domain names. The domain name www.pizzaexpress.com leads to an active website.
- (i) The Complainant or its related companies are also the owner of several other country code top level domain name registrations that incorporate its reputed mark PIZZA EXPRESS such as www.pizzaexpress.com.hk, www.pizzaexpressuae.com, www.pizzaexpress.com.om, www.pizzaexpressgib.com, www.pizzaexpress.com.cy etc.
- (j) Lastly the complainant filed this complaint for Arbitration proceeding and the complaint was produced before the Arbitrator on January 21st, 2013 and the Arbitrator sent a notice, to the Respondent through his email for the Arbitration Proceeding on January 22nd, 2013, to submit his reply in 14 days but Respondent gave no response till the date of award but the learned counselor of complainant informed through email to Arbitrator with a request that the Hon'ble Arbitrator passed an award to the same Complainant therefore it is a covered matter and pass an award accordingly. Hence on February 23rd, 2013 the Award has been declared as Ex-parte.

5. Parties Contentions:

- (a) Complainant contends that
 - (i) The Registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;
 - (ii) The Registrant has no rights or legitimate interests in respect of the domain name; and





- (iii) The Registrant's domain name has been registered or is being used in bad faith, and the domain name be transferred to the Complainant.

- (b) Respondent contends that

The respondent gave no response.

6. Discussion & Findings:

- (i) The Complainant's reputed trademark PIZZA EXPRESS is a registered trademark in various countries around the world. These registrations or pending applications are either in its name or they have consented to applications/registrations being in the name of its related companies. With specific reference to India, it is submitted that the Complainant has registrations and pending applications for the mark PIZZA EXPRESS in class 30 and 43. The details of the same are as given below:-

Trademark	Registration/ Application No.	Class	Status
	781833	30	Registered Renewed up to 11/12/2017
PIZZA EXPRESS	2040035	30,43	Pending Registration
	2163974	43	Pending Registration

The Respondent in the present instance has registered the disputed domain name PIZZAEXPRESS.IN on June 27, 2011 which incorporates in it's entirely the Complainant's reputed mark PIZZA EXPRESS. The Respondent's domain name is identical to the trading style and trademark in which the Complainant has prior rights. The Respondent domain name incorporates in it's entirely the reputed mark PIZZA EXPRESS of the Complainant in which the complainant has statutory rights.

The malicious intention of the Respondent is evident from the blatant misappropriation of the Complainant's trademark PIZZA EXPRESS. It is submitted that in the present instance, any Indian user searching for the Complainant's business online as PIZZA EXPRESS will be taken to the Respondent's domain name, which enhances the possibility of confusion and/or deception. The addition of the country code ".co. in" (INDIA) to the Complainant's trademark PIZZA EXPRESS makes the resulting domain

name PIZZAEXPRESS.CO.IN confusingly similar to the Complainant's trademark.

In case **SAS Institute Inc. v. Farzad Bahreini, FA0207000115038 (Nat. Arb. Forum, August 26, 2001)** (domain name < sasinstitute.us> held confusingly similar to mark SAS INSTITUTE; panel held that the addition of a top level country-code such as ".us" does not create a distinct mark capable of overcoming a claim of identical or confusing similarity). Hence, it is apparent that the Respondent's domain name wholly contains the Complainant's trademark PIZZA EXPRESS and is identical to the trademark in which the Complainant has statutory rights. Such unauthorized use of Complainant's domain name by the Respondent amounts to fraud that is done to the faithful customers of the Complainant.

- (ii) Since the disputed domain name comprises the reputed trademark PIZZA EXPRESS in which the Complainant has sole and exclusive interests, it is evident that the Respondent cannot have any rights or legitimate interest in domain name.

The Respondent's choice of the Complainant's reputed trademark PIZZA EXPRESS as part of its domain name is totally unnecessary. PIZZA EXPRESS is not the Respondent's personal name, neither is the Respondent commonly known by the domain name and Respondent is not known to the public under the name PIZZA EXPRESS. Respondent has not been engaged in any such activity to show that it has legitimate rights or interest in the impugned domain name. Given that the disputed domain name was only registered on June 27th, 2011 it is inconceivable that the Respondent was unaware of the existence of the complainant at the time of registration. Hence the Respondent has no rights or legitimate interest in the domain name.

- (iii) The disputed domain name **PIZZAEXPRESS.CO.IN** incorporates the Complainant's reputed mark PIZZA EXPRESS it is evident that the Respondent have no rights or legitimate interest in the domain name.

Complainant's PIZZA EXPRESS mark is reputed and the Respondent is presumed to have knowledge of the Complainant's mark at the time it registered the confusingly similar domain name. This knowledge indicates Respondent's bad faith use and registration. Therefore, the Respondent is bound to have had prior knowledge of the fame and reputation of the Complainant's reputed trademark PIZZA EXPRESS. The disputed domain name has been registered and is being used in bad faith.

- (iv) Learned counselor of complainant informed through email to Arbitrator and made a request that the Hon'ble Arbitrator passed an award to the same Complainant on August 22nd, 2012 in Case No. INDRP/366 "PIZZA EXPRESS LIMITED Vs. Mr. M.C.Nolte" therefore it is a covered matter and passed an award accordingly.



The Complainant thus has satisfied the Arbitrator on all the parameters as mentioned in the Paragraph 4 of the Policy (INDRP).

7. Decision:

Hence the Arbitrator decides, the Disputed Domain Name www.pizzaexpress.co.in is identical or confusingly similar to registered trademark of the Complainant and Respondent has no right to use the disputed domain name and the Respondent domain name has been registered in bad faith.

The Arbitrator further decides and orders that the domain name www.pizzaexpress.co.in shall be transferred to the Complainant with immediate effect.


Dr. BODHISATVA ACHARYA
SOLE ARBITRATOR
NIXI
23/02/2013

DATED: February 23rd, 2013,
PLACE: NEW DELHI,
INDIA.