



BE 996701
P.S. SHANMUGA SUNDARAM
STAMP VENDOR
L. No: B4 / 109 / 88
HIGH COURT CAMPUS,
CHENNAI-600104. (TAMILNADU)

BEFORE THE SOLE ARBITRATOR MR.D.SARAVANAN
.IN REGISTRY
(C/o. NATIONAL INTERNET EXCHANGE OF INDIA)

Disputed Domain Name: www.potterybarn.in
in
INDRP Case No.773

WILLIAMS-SONOMA, INC
3250 Van Ness Avenue
San Francisco
CA 94109, USA.

.. Complainant

Versus

Jiaai (EAC International)
Of Ground Floor
26 lee street
Sydney, NSW 2000
AUSTRALIA

.. Respondent

...2/





தமிழ்நாடு தமில்நாடு TAMILNADU

6001.

10 FEB 2016

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1. The Parties:

The Complainant is WILLIAMS-SONOMA, INC, having address at 3250 Van Ness Avenue San Francisco, CA 94109, USA.

The respondent is Jiaai (EAC International) having office at Ground Floor, 26 lee street, Sydney, NSW 2000, AUSTRALIA.

2. The Domain Name and Registrar:

The disputed domain name is: <potterybarn.in>

The disputed domain name is registered with d.b.a. inregistrat.com (R123-AFIN).

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3. Procedural History:

18.01.2016	The .IN REGISTRY appointed D.SARAVANAN as Sole Arbitrator from its panel as per paragraph 5(b) of INDRP Rules of Procedure.
18.01.2016	Consent of the Arbitrator was given to the .IN REGISTRY according to the INDRP Rules of Procedure.
23.01.2016	The Complaint and annexures were received from the .IN Registry.
25.01.2016	The arbitral tribunal sent a notice through email to all the concerned including the respondent directing them to file their written response together with supporting documents, if any, within ten days.
04.02.2016	Due date for filing response.
05.02.2016	Notice of default was sent to the respondent notifying his failure in filing the response, a copy of which was marked to the Complainant's representative and .IN Registry.

4. Factual Background

4.1 The Complainant:

The Complainant is WILLIAMS-SONOMA, INC, having address at 3250 Van Ness Avenue, San Francisco, CA 94109, USA.

4.2 Complainants' Activities:

The Complainant states that Pottery Barn was founded in 1949 and is now one of the largest manufacturers and retailers in the field of home furnishing. It was acquired by the present complainant in the year 1985. It has stores around the world extending to almost all countries of the world. Pottery Barn ships its products to over 90 countries around the world. Pottery Barn has retail catalogues, the traditional Pottery Barn catalogue and Pottery Barn Bed and Bath. Due to the substantial significance and notoriety of the store and its trademarks and domain names, Pottery



Barn is used and employed and referred to by authors, politicians and precedence in various different contexts.

4.3 Complainant's Trading Name:

The Complainant is the registered proprietor of trademark POTTERY BARN in various countries and has been using it in connection with its ongoing business. The details of the Complainant's trademark registrations, marked as Annexure C, in India are as under:

A. REGISTRATIONS IN INDIA

Sr.No.	Trade Mark	Application/ Registration No.	Date of Application/ Registration	Country	Class
1	POTTERY BARN	1472090	21/07/2006	India	16, 20, 21, 35
2	POTTERY BARN KIDS	1472091	21/07/2006	India	16, 20, 35

B. REGISTRATIONS IN OTHER COUNTRIES:

The Complainant is also the registered proprietor of the trademark "POTTERY BARN", marked as Annexure D, in the following countries:

Sr.No.	Trade Mark	Registration No.	Country	Class
1	2021077	POTTERY BRN	US	42
2	0976344	POTTERY BARN	US	8
3	0959383	POTTERY BARN	US	21

C. DOMAIN NAME REGISTRATIONS:

The Complainant has the following domain names registered, marked as Annexure E, in its favour:-



DOMAIN NAME	REGISTRATION DATE
www.potterybarn.org	29/4/2001
www.potterybarn.co	29/6/2010
www.potterybarn.com	08/10/1995
www.potterybarn.net	04/12/2001

5. Respondent's Identity:

The Respondent is the registrant of the Domain Name **<potterybarn.in>** which is registered with .IN REGISTRY, National Internet Exchange of India, New Delhi. The name of the registrant is referred to as Jiaai (EAC International), Ground Floor, 26 lee street, Sydney, NSW 2000, AUSTRALIA.

6. Dispute:

The dispute arose when the respondent registered and used the domain name **<potterybarn.in>**. According to the WHOIS database, the disputed domain name was registered on August 13, 2013.

7. Parties contentions:

A. Complainant:

i. The domain name **<potterybarn.in>** is identical/ confusingly similar to complainant's trade mark **POTTERY BARN/POTTER BARN KIDS**:

i. The Complainant submits that the disputed domain name **www.potterybarn.in** contains the Complainant's complete trademark and trade name registered in India and other countries. The disputed domain name is visually and phonetically identical and/or confusingly similar to the trademark and trademark and trade name and further several domain names of the Complainant. Such registration by the respondent amounts to violation of Para 3 and attracts para 4 and 6 of the INDRP.



ii. The Complainant also reiterates as stated above that it is also the owner of domain names and websites which are accessible world over and are available for use by users globally including those in India. The said websites contain extensive information about the Complainant and its products marked and sold under the trademark and corporate name "**POTTERY BARN**". Products of Complainants are skid extensively through their e-commerce websites and direct mail catalogs. The e-commerce channel compliments the retail Channel by building brand awareness and acting as an effective advertising vehicle I addition a sales medium. A Significant portion of the Complainants customer orders are placed through e-commerce websites. The Complainant enclose as **Annexure F**, the latest public filing outlining its sales volume and marketing and advertisement expenses. It is evident from such documents as to the extent of use and sales and notirety of the Complainant, its trademarks and domain name. It is evident from such documents as to the extent of use and Sales and notirety of the Complainant, its trademarks and domain name.

iii. The Complainant submits that it has painstakingly built up a good reputation worldwide and has invested substantial amounts of resources in advertising its products under the trademark "**POTTERY BARN**" in various international magazines, brochures, catalogues, internet, other print and visual media and also through fairs, exhibitions and events. The trademark **POTTERY BARN** is a well known trademark in favour of the Complainant.

iv. Further, the Complainant submits that upon perusal of the Respondent's website <www.potterybarn.in>, it seems that the Respondent is a cyber squatter/cyber pirate and has registered the disputed domain name merely due to the fact that the Complainants' trademark and domain names are well known and reputed. Such a fact will make customers/prospective customers and general public to believe that the respondent domain name and activities is that of the Complainants.

v. The Complainant refers to and rely on the cases annexed as **Annexure G**, two decisions (1) IINDRP/016 siemens.in (2) INDRP/014 pepsico.in wherein it has been held that when a disputed domain name contains the trademark in its entirety, the



domain name is identical and confusingly similar. Further the Complainants refer to and rely on the numerous decisions wherein a domain name is registered by an entity unlawfully which corresponds to the registered trademark of a bonafide owner, your offices have in such an instance protected the rights of the bonafide owner.

ii. **Respondent has no rights or legitimate interests in respect of the domain name <potterybarn.in> :**

i. The Complainant submits that it has legitimate interest in the **"POTTERY BARN"** trademark in India as it had registered the said mark on (21/7/2006) and has been openly, continuously and extensively using it since 1/2/2005. Further **POTTERY BARN** is used and registered extensively throughout the world by the Complainant. By virtue of long and extensive use worldwide registration, extensive advertising, the **"Pottery Barn"** trademark has become well known mark around the world and such reputation and notoriety of the Complainants has extended into India as well. Further the Complainant has registered domain names in its favour comprising **POTTERY BARN**.

ii. The Complainant submits that the Respondent is neither commonly/popularly known in the public nor has applied for any registration of the mark **"POTTERY BARN"** or any similar mark or has registered his business under the said name with the Ministry of Corporate Affairs, India and therefore has no legitimate rights and interest in the said domain name.

iii. The Complainant submits that the disputed domain name was intentionally adopted by the Respondent for commercial gain to misleadingly divert the consumers or traders of the Complainant to the disputed domain name thereby causing irreparable loss, harm and damage to the goodwill and business of the Complainant. The adoption of the disputed domain name by the Respondent is dishonest and is in bad faith. The trading name of the Complainant has been derived from the Combination of founders name and the location of his first store and the Respondent has no justification whatsoever to adopt the identical domain name **www.potterybarn.in** other than to mislead the customers of the Complainant and



the general public at large to believe that the Respondent is the same entity as the Complainant. The Respondent registration of **POTTERY BARN** is dishonest and willful and merely to redirect the customers of the Complainant and internet users at large to its website and cause damage to the Complainant, its customers and repute.

iv. Further, the Complainant submits that it has registered the domain name www.potterybarn.org on (29/4/2001), www.potterybarn.co on (29/6/2010), www.potterybarn.com on (8/10/1995) and www.potterybarn.net on (4/12/2001) whereas the disputed domain name **www.potterybarn.in** was registered by the Respondent on (13/8/2013). Hence, such subsequent adoption and registration of the disputed domain name shows that the Respondent has no light or legitimate interest in the domain name <**www.potterybarn.in**>

iii. The domain name <**potterybarn.in**> was registered and is being used in bad faith:

i) The Complainant's predecessor adopted the trademark **POTTERY BARN** several decades ago. The Complainant and its predecessors has extensively used the trademark all over the world extensively. As already stated and submitted in preceding paras, the Complainant is one of the leading Companies in the field of kitchenware, home furnishings and related and associated goods. The trademark **POTTERY BARN** has also been extensively registered in numerous countries of the world including india. The Complainant has stores around the world and also relies on internet sales and ships products to over 90 countries. Due to extensive use worldwide excellence in quality of products and substantial advertisement, promotion throughout the world by the Complainant, the trademark has acquired tremendous goodwill and reputation in favour of the complainants and is infact a reputed and well known trademark. Further the Complainant has registered numerous domain names in its favor comprising **Pottery Barn**.

ii) The Complainant submits that by registering the disputed domain name the Respondent has intentionally attempted to attract internet users to its website by creating a likelihood of confusion with the Complainant's name and mark as to the



source or sponsorship or affiliation or endorsement of the Respondent's website or the products or services offered/available on the Respondent's website thereby violating Para 6 of INDRP. Further, the Complainant submits that the Respondent has deliberately registered the disputed domain name with the intention of preventing the Complainant who is the owner of the trademark "**POTTERY BARN**" from reflecting the said trademark in its domain name in India. The respondent has no justification in registering the disputed domain name and the same is in bad faith.

iii) The respondent had registered other domain name that incorporates registered trademarks owned by third parties which is an indication of bad faith. The respondent was involved in UDRP cases in which domain names it registered were transferred to the rightful owners such as in 1. BOEHRINGER INGLHEIN INTERNATIONAL GMBH vs. JIAAI (EAC INTERNATIONAL COMPANY LIMITED) case No. D2014-0372, 2. MICHELIN RECHERCHE ET TICHNOQUE SA vs (EAC INTERNATIONAL COMPANY LIMITED) WIPO case No. D2013-1210.3. BARILLA G.E.R FRATELLUI SPA vs. (EAC INTERNATIONAL COMPANY LIMITED) WIPO case No. D2013-1902. Copies of decisions in the aforesaid cases are annexed as **Annexure H**. Such facts and conduct further establishes that the registration of the disputed domain name is in bad faith and attracts the provisions of para 3, 4 and 6 of the INDRP.

B. Respondent:

In spite of notice, notice of default and emails, the respondent did not submit any response.

8. Discussion and Findings:

It has to be asserted as to whether the Constitution of Arbitral Tribunal was proper? Whether the Respondent has received the notice of this Arbitral Tribunal?

Having gone through the procedural history, this Tribunal comes to the irresistible conclusion that the Arbitral Tribunal was properly constituted and



Respondent has been notified of the complaint of the Complainants. However, the Respondent did not choose to submit any response and that non-submission of the Response by the Respondent had also been notified to the Respondent on 05.02.2016.

Under paragraph 4 of the IN Domain Name Dispute Resolution Policy (INDRP), the Complainants must prove each of the following three elements of its case:

- (i) The respondent's domain name <potterybarn.in> is identical to the Complainant's trademark **POTTERY BARN/POTTER BARN KIDS**;
- (ii) Respondent has no rights or legitimate interests in respect of the domain name <potterybarn.in>; and
- (iii) The registration and usage of domain name <potterybarn.in> by the respondent is in bad faith.

(a) Identical or confusing similarity:

i. The Arbitral Tribunal finds that the disputed domain name <potterybarn.in> is identical to complainant's trademarks **POTTERY BARN/POTTERY BARN KIDS** and domain names <potterybarn.co>, <potterybarn.org>, <potterybarn.com> and <potterybarn.net>.

ii. The complainant has established that their trademarks 'POTTERY BARN' and 'POTTERY BARN KIDS' were registered in India in the year 2006 and registered the domain names <potterybarn.com>, <potterybarn.org>, <potterybarn.net> and <potterybarn.co> in the years 1995; 2001 and 2010 respectively. It is clear that the disputed domain name incorporates the complainant's well-known, prior used trade mark 'POTTERY BARN' in its entirety. The Tribunal also finds that by merely affixing a ccTLD (i.e., .in) as a suffix will not remove the distinctiveness of the trade mark.

Thus, the Arbitral Tribunal concludes that the Complainants have established paragraph 4(i) of the IN Domain Name Dispute Resolution Policy.



(b) Respondent's Rights or Legitimate Interests:

i. The Complainant contends that the Respondent has no legitimate interest in the disputed domain name. Paragraph 7 of the IN Dispute Resolution Policy sets out three elements, any of which shall demonstrate the Respondent's rights or legitimate interests in the disputed domain name for the purposes of paragraph 4(ii) of the Policy. The Respondent had been given the opportunity to respond and to present evidence in support of the elements in paragraph 7 of the INDRP. The Respondent has not chosen to do so and has not filed any response in these proceedings to establish any circumstances that could assist it in demonstrating, any rights or legitimate interests in the disputed domain name. Although, the Complainant is not entitled to relief simply by default of the Respondent to submit a Response, the Arbitral Tribunal can however and does draw evidentiary inferences from the failure of the Respondent to respond. The Complainant has established a prima facie case of lack of rights and legitimate interest and the Respondent has failed to rebut the presumption of absence of rights or legitimate interests.

ii. Based on the record, the Respondent does not have rights or legitimate interests in the disputed domain name as the Respondent's current use is neither an example of a bona fide offering of goods or services as required under paragraph 7(i) of the Policy nor is there any legitimate non-commercial or fair use of the disputed domain name and as such there is no evidence that paragraphs 7(ii) or 7(iii) of the Policy apply. The Complainant asserts that they have not licensed or otherwise authorized the Respondent to use their trademark.

iii. The Arbitral Tribunal find that there is no evidence on record to show that Respondent is known by the disputed domain name or that he has used the disputed domain name in connection with a bona fide offering of goods or has any rights in the disputed domain name.



iv. The respondent has failed to show any justification for the adoption, usage or registration of disputed domain name.

v. The Arbitral Tribunal thus holds that the circumstances listed above demonstrate rights or legitimate rights of the Complainant in the domain name and holds that the respondent has infringed the rights of the Complainant by registering the trademark of the complainant.

vi. The Arbitral Tribunal is satisfied that the Respondent has no rights or legitimate interests in respect of the disputed domain name and, accordingly paragraph 4(ii) of the Policy is satisfied.

(c) Registration and Use in Bad faith:

(i) Paragraph 6 of the Policy provides the circumstances evidencing registration and use of a domain name in bad faith are that, by using the same, the Respondent has engaged in a pattern of such conduct and the Respondent has intentionally attempted to attract, for commercial gain, internet users to the Respondent's web site or other online locations, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's web site or location. It is the specific case of the Complainant that the respondent's modus operandi is by creation of the website <potterybarn.in> mark with generic/descriptive suffix, is seeking illegal commercial gain through its opportunistic bad faith registration of the disputed domain name.

(ii) The Arbitral Tribunal observes that the Respondent has registered the domain name which appears to have been selected precisely for the reason that it is identical to registered trademark of the Complainant. The Respondent has no affiliation or connection or any kind of relationship with the Complainant. Registration of a domain name that is identical to a famous trademark by any entity,



which has no relationship to that mark, is itself sufficient evidence of bad faith registration and use.

(iii) In view of the submitted evidence and in the specific circumstances of this case, this Arbitral Tribunal draws the legal inference that Respondent's purpose of registering the domain name was in bad faith within the meaning of the Policy. The Respondent has no legitimate rights or interests in the disputed domain name and there was a malafide intent for registering the disputed domain name for commercial gains as the disputed domain name resolves to parked website offering sale of the same and that the intention of the Respondent was simply to generate revenue, either by using the domain name for its own commercial purpose or through the sale of the disputed domain name to a competitor or any other person that has the potential to cause damage to the ability of the Complainant to have peaceful usage of the Complainant's legitimate interest in using their own trade names.

In the light of the above, this Arbitral Tribunal finds that the Complainant has established that the disputed domain name was registered and is being used in bad faith.

9. Decision:

For all the foregoing reasons, in accordance with paragraph 10 of the Policy, the Arbitral Tribunal orders that the disputed domain name <potterybarn.in> be transferred to the Complainant.

Dated at Chennai (India) on this February 09, 2016.


(D.SARAVANAN)
Sole Arbitrator