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Government of Karnataka

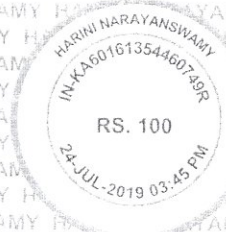


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सत्यमेव जयते



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BEFORE THE NATIONAL INTERNET EXCHANGE OF INDIA
ARBITRATION AWARD
INDRP CASE NO. 1089

BLUE STAR LIMITED

Vs.

SRINIVAS B

Complainant

Respondent

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Harini Narayanswamy

BEFORE THE NATIONAL INTERNET EXCHANGE OF INDIA

ARBITRATION AWARD

INDRP CASE NO. 1089

BLUE STAR LIMITED
Kasturi Buildings,
Mohan T. Advani Chowk
Jamshedji Tata Road
Mumbai 400020
India

Complainant

Versus.

SRINIVAS B
Nagole
Hyderabad 500035
India

Respondent

1. The Parties

The Complainant is Blue Star Limited of Mumbai India represented in these proceedings by Krishna & Saurastri Associates LLP of Mumbai, India. The Respondent is Srinivas B of Hyderabad, India.

2. The Domain name, Registrar and Policy

The present arbitration proceeding pertains to a dispute regarding the domain name <bluestar-service-center.in> (hereinafter referred to as disputed domain name). The registrar for the disputed domain name is Godaddy.com LLC, Scottsdale, AZ United States of America. The disputed domain name was registered on April 6, 2018. The Arbitration proceedings are conducted in accordance with the Arbitration and Conciliation Act of 1996 (India), the .IN Domain Name Dispute Resolution Policy (the "INDRP Policy" or "Policy"), and the INDRP Rules of Procedure (the "Rules").

Haini Narayana

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 and the electronic copy of the case documents from the .IN registry on May 24, 2019 and on May 26, 2019 the Arbitrator 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.

4. Factual Background

The Complainant is a leading manufacturer of electronic devices such as air conditioners, refrigerators, air purifiers, air coolers, water coolers, water purifiers, commercial refrigerators and cold storage equipment. The Complainant owns the trademark BLUE STAR which it has used for several decades in relation with its goods and related services such as installations and after sales services. The Complainant is the registered owner of the BLUE STAR trademark for both word and device marks in several classes across many jurisdictions including India, European Union, Canada, United States of America, Bhutan and Egypt. The first trade mark registration in India for the BLUE STAR mark was obtained by the Complainant on July 11, 1972 under number 281416 in class 11.

The Respondent Srinivas B, is located in Hyderabad, India, as per the registration record of the disputed domain name. Not much else is known about the Respondent, as he has not responded in these proceedings. The Respondent registered the disputed domain name on April 6, 2018 and has been using it to host a website offering door-step service for home appliances such as air conditioners. The Respondent has displayed the Complainant's BLUE STAR device mark on the web pages to which the disputed domain name resolves.

Harini Narayanswamy

The Parties Contentions

A. Complainant

The Complainant states that it was incorporated 70 years ago in the year 1949 and adopted BLUE STAR as its distinctive corporate name and its trademark. The Complainant states its business has grown substantially over the years and that currently its revenues exceed INR 4600 crores, it has a network of 32 offices with 5 modern manufacturing facilities, 2800 employees and 2900 channel partners. With a presence in several countries, the Complainant states its products are also offered through e-commerce platforms such as Amazon.in, Flipkart.com, Croma.com, and Pepperfry.com.

The Complainant owns the domain name <bluestarindia.com>, which was registered on February 3, 1999. Its shares are listed in the two Indian stock exchanges, National Stock Exchange (NSE) and Bombay Stock Exchange (BSE). The Complainant alluding to its popularity, states a search conducted on Google for the term "Blue Star" returns 2,76,00,000 results, most of which are associated with the Complainant. The Complainant asserts that its mark is distinctive and has acquired secondary meaning due to its extensive use, advertisement and publicity. Further, as the mark has gained tremendous reputation and goodwill in the Indian markets, the Complainant claims it has acquired the status of a well-known mark.

The Complainant requests for the transfer of the disputed domain name on the grounds that: (i) that the disputed domain name is identical or confusingly similar to the trademark in which the Complainant has rights (ii) The Respondent has no rights or legitimate interests in respect of the disputed domain name and (ii) The disputed domain name has been registered or is being used in bad faith by the Respondent.

B. Respondent

The Respondent did not respond in these proceedings.

Hanvi Narayana

Discussion and Findings

Under the INDRP Policy, the Complainant has to establish the following three elements to obtain the remedy of transfer of the disputed domain name:

- (i) The disputed domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights, and
- (ii) The Respondent lacks rights or legitimate interests in respect of the disputed domain name; and
- (iii) The disputed 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 disputed domain name is identical or confusingly similar to a mark in which the Complainant has rights.

The Complainant has established its rights in the BLUE STAR mark in these proceeding by filing evidence of ownership of its registered trademarks. The Complainant has submitted, among others, evidence of trademark registration for the word mark BLUE STAR bearing number 1281292 class 37, dated April 28, 2004, and BLUE STAR bearing number 1281293 class 42, dated April 28, 2004. The Complainant has also provided evidence of use of its mark in connection with services related to its products.

The disputed domain name contains the BLUESTAR mark with the terms "service" and "center", separated by hyphens. It is well established that the addition of generic words to a trademark and use of hyphens do not distract from finding confusing similarity. The dominant part of the disputed domain name is the BLUE STAR trademark. The terms "service" and "center" with the BLUE STAR mark does little to dispel the confusing similarity with the mark. It is likely that unwary Internet user, who comes across the disputed domain name could be misled or confused that the disputed domain name is connected to the Complainant. Accordingly, it is found that the disputed domain name is confusingly similar to the Complainant's BLUE STAR mark.

Hanini Narayana

Rights and Legitimate Interests

The second element requires the Complainant to put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The onus of proving rights or legitimate interest in the disputed domain name lies on the Respondent. However, it is for the Complainant to put forward a *prima facie* case, to prevail under the second element.

The Complainant has argued that the Respondent has no rights or legitimate interests in the disputed domain name and has stated that the Respondent has no authorization to use its mark. Under the INDRP Policy, a respondent can demonstrate legitimate interests in the disputed domain name if there are circumstances that show (i) that before notice of the dispute, the respondent 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 respondent (as an individual, business organization) has been commonly known by the domain name, or (iii) The respondent is making legitimate, non-commercial or fair use of the domain name without intent for commercial gain.

The Respondent here is not commonly known by the disputed domain name and is not an authorized reseller of the Complainant's services. Referential use of a mark by an unauthorized service provider could be a basis for legitimate use. However, there are explicit guidelines for such referential use of a mark by a service provider or reseller. The basic prerequisite of such legitimate referential use of a trademark is that the mark should not be used in a manner to falsely mislead Internet users to obtain unjust commercial gain.¹

¹ See *Okidata Americas v ASD, Inc.* WIPO Case No 2001-0903 where the following cumulative requirements or guidelines were mentioned for finding legitimate use by a reseller:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark.

Havini Narayana

The Respondent in the present case has not placed a disclaimer and there is no evidence to indicate that the Respondent has used or uses the mark to provide service for only the Complainant's product. However, from the screenshots of the webpages, it appears that the Respondent offers services to other home appliance brands. Under these circumstances, the Respondent's use of the mark appears to be a clear case of "bait-and-switch" rather than referential use of the BLUE STAR mark. Namely, using the Complainant's mark to bait customers and then offering services competing with the Complainant. Use of the mark to "bait-and-switch" is not considered legitimate use of the domain name.

The Respondent furthermore, does not clearly disclose on the website that he is not the owner of the mark but simply uses the mark to derive mileage from the fame and goodwill associated with the mark. Such "bait-and switch" use to mislead and attract customers for providing competing services is typically recognized as infringing use. Under the circumstance discussed, the use of the Complainant's mark by the Respondent does not qualify as legitimate use by a reseller or service provider.

The Complainant is found to have successfully made a *prima facie* case that the Respondent lacks rights and legitimate interests in the disputed domain name. The second requirement under paragraph 4 of the Policy has been met.

Bad Faith

The third element of Policy requires the Complainant to establish the disputed domain name was registered in bad faith or is being used in bad faith.

The material and evidence on record clearly establish the Complainant's prior adoption and use of the BLUE STAR mark. The Respondent therefore ought to have been aware of the Complainant's mark at the time of registration of the disputed domain name. This fact is further reinforced by the fact that the webpages display the Complainant's device mark, which the Respondent ought to have known is a device mark belonging to the Complainant.

It is well established under the Policy, that the registration of a domain name with the intention of creating confusion in the mind of Internet users and thereby attracting Internet

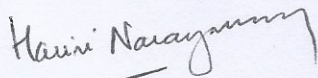
Hani Narayana

traffic based on the reputation associated with a trademark is considered bad faith registration and use under the Policy. See *Dell Inc, v. Jitendra Diwakar* (<delllaptopservicecenter.in>) INDRP Case No.1096 (June 14, 2019) where the respondent in that case admitted to running a business of repairing out-of-warranty laptops for several brands such as DELL, LENOVO and HP and it was found that the use of the DELL mark was misleading use of another's trademark in the disputed domain name, which is considered bad faith under the Policy.

In the present case, the circumstances and evidence show the Respondent has used the BLUE STAR mark in the disputed domain name to mislead and attract users. The Arbitrator finds based on the evidence and the circumstances discussed, that the Respondent has registered and used the disputed domain name in bad faith as understood under the INDRP Policy.

Decision

It is ordered that the disputed domain name <bluestar-service-center.in> be transferred to the Complainant.



Harini Narayanswamy

Arbitrator

Date: July 19, 2019