



उत्तर प्रदेश UTTAR PRADESH

BF 707618

BODHISATVA ACHARYA
ARBITRATOR

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

Case No. Of 2012

ARBITRATION AWARD: DISPUTED DOMAIN NAME :< starbuck.in >

In the matter of:

Starbucks Corporation doing business as
Starbucks Coffee Company
2401 Utah Avenue South,
Seattle, Washington 98134,
U.S.A

Filed by its authorized representative attorney -

S.S. Rana & Co.
Advocate for Complainant
317, Lawyers Chambers,
Delhi High Court,
New Delhi-110003
Tel No: - 23384491

.....Complainant.

Vs.

Mr. M.C. Nolten
Letitring ! gmbh Von Basse Str.1,
Bolken-Nordhein-Westfalen,
Germany

.....**Respondent.**

A W A R D

1. The Parties:

The complainant in this arbitration proceeding is Starbucks Corporation doing business as Starbucks Coffee Company, 2401 Utah Avenue South, Seattle, Washington 98134, U.S.A filed by its authorized **representative attorney** S.S. Rana & Co., Advocate for Complainant, 317, Lawyers Chambers, Delhi High Court, New Delhi-110003

Respondent in this arbitration proceeding is Mr. M.C. Nolten, Letitring ! gmbh Von Basse Str.1, Bolken-Nordhein-Westfalen, Germany.

2. The Domain Name, Registrar & Registrant:

The disputed domain name is www.starbuck.in



3. Procedural History:

The complainant, through its authorized representative, filed this complainant to NIXI regarding the disputed domain name www.starbuck.in following the clause 4 of the policy of .IN Registry and .IN Registry appointed **Mr. 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 and the complaint was produced before the Arbitrator on December 11th, 2012 and the Arbitrator sent a notice, to the Respondent through his email for the Arbitration Proceeding on December 16th, 2012, to submit his reply but nothing was submitted to Arbitrator till the date of award hence the AWARD is being declared on the January 17th, 2013 as Ex-parte.

4. Factual Background:

- (a) The Complainant is the world's largest multi-national chain of specialty coffee shops with corporate headquarters in Seattle, Washington, USA. The complainant is a leading retailer, roaster and brand of specialty coffee. In 1971, Complainant opened its first retail store offering a variety of coffee, tea and other beverages in Seattle's Pike Place market, USA after that number of starbucks retail locations has grown to more than 17,000 in 55 countries and territories around the world with over 130,000 partners, serving millions of customers worldwide each week, in connection with its international business. The Complainant owns and uses, the trade marks **STARBUCKS** and **STARBUCKS COFFEE WITH DESIGN**, which are associated with it and its goods, business, including coffee shops, cafes etc. The said trade marks are registered in various classes in United States and several countries of the world including India. The Complainant has used the trade marks **STARBUCKS** and **STARBUCKS COFFEE WITH DESIGN** for over for forty years as the principal identifier of its business and the products it sells. Through its substantial efforts and investment, consumers have come to associate the said trade marks with the premium quality in both products and services of the Complainant, which has made the Complainant the industry leader.



- (b) By virtue of long standing use, extensive publicity and worldwide registrations, the trade name and trade mark **STARBUCKS** and **STARBUCKS COFFEE WITH DESIGN** are identified worldwide exclusively with the Complainant and its business and enjoys wide reputation, support and trust amongst the trade and public. The first starbucks location outside of North America opened in Tokyo in 1996. Starbucks entered the U.K. market in 1998. **STARBUCKS** is associated with the highest standard of quality control. As such, products and services of the Complainant enjoy worldwide reputation and support amongst the trade and public in general. Because of the extent and the length of time the Complainant has carried on business, its name and trade mark **STARBUCKS** has become famous in this line of business and associated and related by the public at large with it alone. Due to extensive use, advertisement and promotion, the trade mark **STARBUCKS** commands much valuable reputation and goodwill and is distinctive of and identified worldwide. Exclusively with products and services of the Complainant.
- (c) The Complainant's trade marks **STARBUCKS**, **STARBUCKS COFFEE**, **STARBUCKS COFFEE WITH DESIGN** as well as other variations of **STARBUCKS** marks are registered in over 154 countries. The Complainant is the registered proprietor of the trade marks **STARBUCKS**, **STARBUCKS COFFEE** and **STARBUCKS COFFEE WITH DESIGN** as well as other variations of **STARBUCKS** marks in various classes in India. By virtue of such registrations, the Complainant has the exclusive statutory right to use the trade marks for the goods and services for which they are registered.
- (d) The Complainant registered the domain name www.starbucks.com in the year 1993, in addition to country specific domain names including www.starbucks.com as under:

Domain name	Registration Date
starbuck.co.in	7/10/2009
Starbucks.in	2/16/2005
Starbuckscoffee.co.in	6/3/2009
Starbuckscoffee.in	2/16/2005
starbucksindia.co.in	6/3/2009
Starbucksindia.in	2/16/2005

The Complainant has an interactive website <http://www.starbucks.com>. In addition to other country websites, which are accessible to persons from any part of the world including in India . The trademark **STARBUCKS** has become one of the best-known trademarks in the world today, and certainly one of the best-known marks used by any coffee based business in the world.

- (e) In order to promote a global reputation, the Complainant has taken numerous steps through the years. Millions of US dollars are spent each year for promoting the Complainant's trade marks in countries around the world by means of national and transnational advertising. The name and trademark **STARBUCKS** has been advertised in a wide variety of print and electronic media, including newspapers, magazines, satellite TV channels as well as on the Internet. Interbrand, a leading international branding consultancy company in its Annual survey for several consecutive years (2000-2011) ranked **STARBUCKS** amongst the top 100 Brands of the world and according to Millward Brown Optimor Brandz, **SRATBUCKS** is among the top 100 Most Powerful Brands. **STARBUCKS** is also listed in America's Greatest Brands. The Complainant has been conferred with many awards and recognition for its business ethics and social causes.
- (e) Further, the Complainant's name and mark **STARBUCKS** has been immortalized by Mr. Howard Schultz and Ms. Dori Jones Yang in their book *Pour Your Heart Into It- How Starbucks Built a Company One At A Time*, which has been printed and distributed world wide in several languages including Japanese, Mandarin, Portuguese, Thai, Korean. The Complainant's name and trademarks have been advertised and featured in international and Indian magazines and newspapers having circulation in many countries through out the world including India. The Complainnat's products with the name **STARBUCKS** or starbucks Retail stores have been featured (without any solicitation) in various pictures including Indian Movies and some of these movies are listed below:

LIST OF INDIAN MOVIES		
S. No.	Movies Name	Year
1	Chalte-Chalte	2003
2	Kal Ho Na Ho	2003
3	Hum-Tum	2004

4	Kabhi Alvida Na Kehna	2006
5	Partner	2007
6	Dostana	2008
7	Love Aaj Kal	2009

The Complainant supports social development projects that help the communities that produce our coffee, tea and cocoa. Projects include improving access to education and agricultural training, microfinance and micro credit services, improving biodiversity conservation, and increasing levels of health, nutrition and water sanitation. The Complainant has been actively associated with Collaboration for Hope and Advancement in India (CHAI), which was launched in October 2002, to help improve living conditions and create opportunities for those living and working in the villages of the tea producing regions of west Bengal, Darjeeling India.

- (f) The Complainant's name and trademark **STARBUCKS** is well known and famous, not only in the USA but also in many countries of the world. By virtue of such continuous and extensive use and the high quality of goods and services provided under the marks **STARBUCKS** and variations, the same have become distinctive and are associated by the public and the trade with the Complainant's goods and services alone. **STARBUCKS** and variations thereof have acquired substantial reputation and goodwill and are well known and famous in India within the meaning of Section 2(zg) of the Act. The trademarks Act of 1999 provides for protection of well-known marks in India.
- (g) It has been brought to the notice of the Complainant that the Respondent/Registrant has registered the top level Indian domain name starbuck.in and after that the Complainant was filed for Arbitration proceedings.
- (e) Lastly the complainant filed this complaint for Arbitration proceeding and the complaint was produced before the Arbitrator on December 11th, 2012 and the Arbitrator sent a notice, to the Respondent through his email for the Arbitration Proceeding on December 16th, 2012, to submit his reply but nothing was submitted to Arbitrator till the date of award hence the AWARD is being declared on the January 17th, 2013 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 and produced no reply.

6. Discussion & Findings:

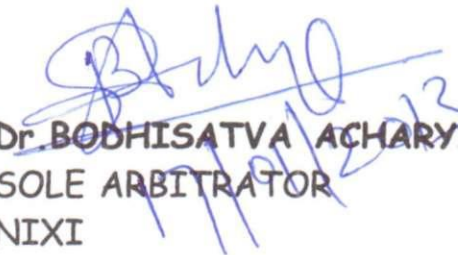
- (i) The domain name **starbuck.in** registered by the Respondent/Registrant is identical with and confusingly similar to the name, trade mark and service mark **STARBUCKS**, in which the Complainant has statutory and common law rights in India and Abroad. The Respondent's domain name is bound to cause confusion and deception as it is identical to the name and trademark of the Complainant. The links provided on the landing page of the website www.starbuck.in refers to and has links to separate pages titled **STARBUCK**, **STARBUCKS COFFEE**, **STARBUCKS FRANCHISE**, **STARBUCK COFFEE** etc. The Respondent has used the said key words and links without the Complainant's permission or

authorization with the sole intention to have web users land on their website. The Respondent by doing this act, generates revenue through-click scheme which is evident from the "sponsored Search Results" tag displayed on each page. Copy of another webpage from the said website with the tag "Sponsored Search Result for STARBUCK".

- (ii) The Respondent/ Registrant has no right or legitimate interest in the impugned domain name. The Respondent is not making a legitimate or fair use of the said domain name for offering goods and services. The Respondent (as an individual, business or other organization) has not been commonly known by the name or mark **STARBUCKS**. It is submitted that **STARBUCKS** is the name and registered trade mark of the Complainant. Therefore the Respondent / Registrant can have no legitimate interest in the said domain name. The Complainant has not licensed or otherwise permitted the Respondent/Registrant to use its name or trade mark or to apply for or use the domain name incorporating the said name. The adoption and/ or use of the domain name that appropriates a well known trade mark cannot be considered a bona fide offering of goods and services. The Respondent /Registrant has registered or acquired the name prominently for the purpose of misleading and creating confusion in the minds of general public so that the impugned domain name comes to be associated with that of Complainant.
- (iii) The Respondent/Registrant's domain name has been registered is being used in bad faith. The main object of registering the domain name **starbuck.in** by the Respondent/Registrant is to mislead the general public and trade, as well as prevent the Complainant from using it or reflecting the mark in a corresponding domain name. The registration of the domain name **starbucks.co.in** incorporating the name and registered trade mark of the Complainant is malafide.
- (iv) 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.starbuck.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.starbuck.in shall be transferred to the Complainant with immediate effect.


Dr. BODHISATVA ACHARYA
SOLE ARBITRATOR
NIXI

DATED: January 17TH, 2012,
PLACE: NEW DELHI,
INDIA.