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BEFORE SHRI SANJAY KUMAR SINGH ARBITRATOR

IN DOMAIN NAME DISPUTE RESOLUTION POLICY (INDRP)

IN RE:

STARBUCKS CORPORATION
d.b.a STARBUCKS COFFEE COMPANY
2401, UTAH AVENUE SOUTH, SEATTLE,
WASHINGTON, 98134 USA.

Complainant

Versus

MOHANRAJ,
DTP INDIA
40/4, BALAJI NAGAR MAIN ROAD
SHAKTHIVEL NAGAR, KOLATHUR
CHENNAI, TAMIL NADU-600082
E-MAIL: MR@DTPINDIA.COM

..Respondent

1. THE PARTIES:

The complainant is Starbucks Corporation, d.b.a Starbucks Coffee Company, 2401, Utah Avenue South, Seattle, Washington, 98134 USA.

The Respondent is Mohanraj, DTP India 40/4, Balaji Nagar Main Road, Shakthivel Nagar, Kolathur Chennai, Tamil Nadu.

2. DOMAIN NAME AND TRADEMARK IN DISPUTE:

Domain name of the respondent is "**STARBUCKS.CO.IN**"

The trademark of the complainant is "**Starbucks**". The registry is National Internet Exchange of India (NIXI).

3. BRIEFBACKGROUND:

This arbitral proceeding commenced in accordance with IN Dispute Resolution Policy (INDRP) and rules framed thereunder.

The complainant submitted his complaint in the registry of NIXI. Shri Sanjay Kumar Singh was appointed as Sole Arbitrator in the matter by NIXI.

It is alleged by the complainant that it is the world's largest multinational chain of coffee shops with headquarter in Seattle, Washington, U S A . The complainant is a leading retailer, roaster and brand of specialty coffee. The term complainant includes its predecessor-in-interest, franchisees, licensees and affiliates. It is alleged by the complainant that it owns and uses, inter alia, 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 United States and several countries including India. The complainant has used the trade marks **STARBUCKS and STARBUCKS COFFEE WITH DESIGN** for over eight years as the principal identifier of its business and the products it sells. It is further alleged by the complainant that it owns the trademark "**Starbucks**" and **Starbucks coffee with design** and complainant's trade marks are registered in 138 countries. The lists of the countries are mentioned in para no.3 of the complaint. The details of the complainant's registration for the trade marks "**Starbucks**" in USA and some

of the major countries including INDIA are mentioned Para no.4 of the complaint. The complainant has submitted in Para no.4 of the complaint that it has registered the trade mark "**Starbucks**" in INDIA vide registration number 689218 in "class 30" on December 4, 2005. The complainant has further submitted in Para no.5 of the complaint that it is the registered proprietor of the trade mark **Starbucks** and **Starbucks coffee with design** in INDIA in various classes as mentioned in Para no.5 of the complaint. The complainant has also submitted that he has registered the domain name www.starbucks.com in the year 1993, in addition to country specific domain names including www.starbucks.in as mentioned in Para no.6 of the complaint. The complainant has further submitted that it has an interactive website <http://www.starbucks.com>. In addition to the country specific websites which are accessible to persons from any part of the world including India.

A copy of complaint has already been sent to the respondent by the .In Registry through e-mail. Upon receipt of the complaint, the Arbitrator sent a notice dated to the respondent to send his defence / counter to the complaint alongwith supportive documents / evidence at his e-mail address within seven days from receipt.

The respondent sent his defence / counter to the complaint. The respondent has submitted that at the time of booking /registering the domain name www.starbucks.co.in the .in registry or his registrar did not ask him to submit any supportive documents / evidence to register the Domain name. The respondent has further submitted that the complainant has neglected the Domain name www.starbucks.co.in for past 04 years at the time of registering www.starbucks.in even though the .co. in extension was available(fron year

2002) before .in extension released. He has prayed for cancellation of complaint and allow him to use the domain name for his own purpose of another business which will not be in complainant's industry.

The complainant has sent the rejoinder to the reply / defence / counter to the respondent stating that the averments made in the complaint by the complainant have not been denied and the same are therefore deemed to be admitted by the respondent. The complainant has further submitted that mere fact that at the time of booking/ registering the domain name www.starbucks.co.in the .in registry or his registrar did not ask respondent to submit any supportive documents / evidence to register the Domain, does not bestow upon him any absolute right in the said domain name. The complainant has further submitted that respondent has not given any explanation as to how he came about adopting or hit upon the domain name www.starbucks.co.in, when the complainant is the registered proprietor of the trade mark **Starbucks** in India since 1995. The complainant has further submitted that the respondent is neither commonly known as **Starbucks** nor making a legitimate or fair use of the said domain name. The complainant has further submitted that the domain name of respondent is identical to complainant's registered trade mark and service mark **Starbucks**. The complainant has further submitted that it has bonafide right in the registered trade mark **Starbucks** and the respondent has no right or legitimate interest in the domain name and he has got it registered for unjust enrichment. The domain name has been used in bad faith and therefore the respondent is not entitled to retain the said the domain name. The complainant has Draved for the transfer of the domain name www.starbucks.co.in to the complainant.

4.

Sanjay K. Singh

4. PARTIES' CONTENTIONS:

- (i) The complainant has alleged that domain name of the respondent is identical and confusingly similar to his trademark in which it has rights.
- (ii) The complainant has alleged that respondent does not have rights or legitimate interest in respect of domain name and also the respondent has no registered trademark rights of the said domain name.
- (iii) The complainant has further alleged that the domain name is registered by the respondent and is used by him in bad faith. **The complainant has submitted that its trade marks are well known in India.** The complainant has further alleged that the respondent's intention is not to act in good faith but has got registered the disputed Domain name in bad faith.

The complainant has sought the relief of transfer of domain name "STARBUCKS.CO.IN" to him.

5. OPINION/FINDING:

The Para no.4 of the IN Domain Dispute Resolution Policy (INDRP) is as follows:-

TYPES OF DISPUTES

Any person who considers that a domain name conflicts with his legitimate rights or interest may file complaint to .IN Registry on following premises:

- "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

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- iii) The Registrant's domain name has been registered or is being used in bad faith."

The para no.6 of the IN Domain Dispute Resolution Policy (INDRP) is follows:

6. EVIDENCE OF REGISTRATION AND USE OF DOMAIN NAME IN BAD FAITH

The following circumstances, in particular but without limitation, if found by the Arbitrator to be present, shall be evidence of the registration and use of a domain name in bad faith:

- "i) Circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant, who bears the name or is the owner of the trademark or service mark, or to a competitor of that complainant, for valuable consideration in excess of the Registrant's documented out of pocket costs directly related to the domain name; or
- ii) the Registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Registrant has engaged in a pattern of such conduct; or
- ii) by using the domain name, the Registrant has intentionally attempted to attract Internet users to the Registrant's website or other online location, by creating a likelihood of confusion with the complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's

website or location or of a product or service on the Registrant's website or location."

The para no.7 of the IN Domain Dispute Resolution Policy (INDRP) is as follows:-

7. REGISTRANT'S RIGHTS TO AND LEGITIMATE INTERESTS IN THE DOMAIN NAME

Any of the following circumstances, in particular but without limitation, if found by the Arbitrator to be proved based on its evaluation of all evidence presented, shall demonstrate the Registrant's rights to or legitimate interests in the domain name for the purpose of paragraph 4

(ii):

- "i) before any notice to the Registrant of the dispute, the Registrant's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bonafide offering of goods or services;
- ii) the Registrants (as an individual, business, or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or
- iii) the Registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

The other fact, which is to be dealt with before going into merit is, that, as to whether, the cases decided by WIPO- Administrative Panel could be considered, while deciding the present controversy. Moreover these cases throw light upon

various important aspects of controversy. As such they would be considered, while deciding the present controversy, in so far as they do not conflict with INDRP.

8. OPINION AND FINDINGS ON MERITS

A) Whether the domain name is identical or confusingly similar to a trademark in which complainant has right.

It has been held in Indian decision **M/s Satyam Infoway Ltd. Vs. M/s Sifynet Solution (P) Ltd. JT. 2004 (5) SC 541**, that Domain name has all characteristics of trademark. As such principles applicable to trademark are applicable to domain names also. In the said case the words, 'Sify' & 'Sify' were held to be phonetically similar and addition of work 'net' in one of them would not make them dissimilar.

It is held in Indian case **JT.2004 (5) SC 541**, that in modern times domain name is accessible by all internet users and thus there is need to maintain it as an exclusive symbol. It is also held that it can lead to confusion of source or it may lead a user to a service, which he is not searching.

The domain name and trademark, which may be used in different manner and different business or field, or sphere can still be confusingly similar or identical.

Thus the conclusion is that the domain name of respondent is identical and confusingly similar to the trademark of complainant.

Now the other important aspect that needs consideration is, as to whether the complainant has right in the trademark. It is important to mention here that as per the claim of the complainant the respondent has no trademark right on the said domain name.

This principle is settled in many above Indian cases and referred cases **JT 2004(5) SC 541 and 2004(5) SCC 287**. The complainant has made submission that he has legitimate trademark in India, he is using trademark for many years as stated above. Thus the conclusion is that the domain name **STARBUCKS.CO.IN**" is identical and confusingly similar to the trademark of complainant **'Starbucks'** and the complainant has established that he has right in the trademark.

B) Whether the respondent has no right or legitimate interest in the domain name got registered by him

It is pertinent to mention here that paragraph 4 (ii) of INDRP is to be read with paragraph no.7.

As already stated that paragraph 4 (ii) and 7 of INDRP are to be read together. Their combined effect is that, onus to prove the ingredients of these paras are prima facie on complainant. The onus is not very weak and prima facie, but it heavily shifts on respondent. Respondent can discharge the onus by direct cogent and positive evidence which are in his special knowledge and power. The complainant has made positive assertions that respondent has no legitimate right in domain name and the respondent has no trademark on the domain name. The complainant has made positive assertions regarding the fact that respondent has got registered the disputed domain name in the .IN Registry for which the respondent has no right or trademark. As such in above circumstance it is clear that the complainant has prima facie discharged the initial onus cast upon him by virtue of paragraph 4(ii) and 7 of INDRP.

The respondent on other hand has not provided any positive, cogent and specific evidence that it is known or recognized by domain name. The respondent has neither put forth and has nor provided such evidence.

Thus the conclusion is that respondent has no right or legitimate interest in the domain name.

Whether the respondent's domain name has been registered or is being used in bad faith

It is to be seen as to whether the domain name has been got registered in bad faith. The paragraph no.4 (iii) and 6 are relevant and as already stated; the onus is primarily upon complainant.

Keeping in view above facts and circumstances it is thus clear that the respondent has registered the disputed domain name and in spite of notice, he has not provided any substantial evidence in his support.

Thus the conclusion is that the respondent has got registered his domain name "**STARBUCKS.CO.IN**" in bad faith.

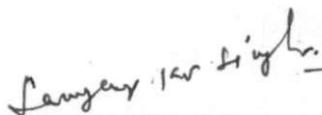
9. CONCLUSION:

The domain name of the respondent is identical and confusingly similar to trademark of complainant. The respondent also does not have right or legitimate interest in the domain name. He has got it registered in bad faith, as such he is not entitled to retain the domain name. The complainant is entitled to transfer of domain name "**STARBUCKS.CO.IN**" to him, as he has established his bonafide rights in trademark as per law discussed above. Hence I direct that the Domain name be transferred to the complainant by registry on payment of requisite fee to the registry.

No order as to costs.

Delhi

Date: 26-11-2009.


(Sanjay Kumar Singh)

Arbitrator