



उत्तर प्रदेश UTTAR PRADESH NATIONAL INTERNET EXCHANGE OF INDIA [NIXI]

U 566261

ADMINISTRATIVE PANEL DECISION
SOLE ARBITRATOR: RODNEY D. RYDER

Luxottica Holdings Corp v. Lokesh Morade
Case No. INDRP/139

ARBITRATION AWARD

Disputed Domain Name: www.sunglasshut.in



The Parties

उत्तर प्रदेश **UTTAR PRADESH**
The Complainant in this arbitration proceeding is Luxottica U.S. Holdings Corp, incorporated 566262 under the laws of United States, with office at 4000 Luxottica Place, Mason, Ohio, United States; represented by Ms Madhu Rewari, Anand & Anand, India.

The Respondent in this arbitration proceeding is Mr. Lokesh Morade, [email ID - lmorade@hotmail.com.] as per the details given by the Whois database maintained by the National Internet Exchange of India [NIXI].

The Domain Name and Registrar

The disputed domain name is www.sunglasshut.in. The said domain name is registered with Name.com LLC.

Procedural History [Arbitration Proceedings]

This arbitration proceeding is in accordance with the .IN Domain Name Dispute Resolution Policy [INDRP], adopted by the National Internet Exchange of India ["NIXI"]. The INDRP Rules of Procedure [the Rules] were approved by NIXI on 28th June, 2005 in accordance with the Indian Arbitration and Conciliation Act, 1996. By registering the disputed domain name with the NIXI accredited Registrar, the Respondent agreed to the resolution of the disputes pursuant to the IN Dispute Resolution Policy and Rules framed thereunder.

According to the information provided by the National Internet Exchange of India ["NIXI"], the history of this proceeding is as follows:

In accordance with the Rules, 2(a) and 4(a), NIXI formally notified the Respondent of the Complaint, and appointed Rodney D. Ryder as the Sole Arbitrator for adjudicating upon the dispute in accordance with the Arbitration and Conciliation Act, 1996, and the Rules framed thereunder, .IN Domain Name Dispute Resolution Policy and the Rules framed thereunder.

The Arbitrator submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the NIXI.

The arbitration proceedings commenced on April 5, 2010.
The Respondent did not reply to the notice dated April 7, 2010.

Grounds for the administrative proceedings

The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has statutory/common law rights.

The Respondent has no rights or legitimate interests in respect of the disputed domain name.

The disputed domain name has been registered or is/are being used in bad faith.

Parties Contentions

Complainant

The Complainant in his complaint, inter alia, contended as follows:

The Respondent's domain name is identical and confusingly similar to a name, trademark or service in which the Complainant has rights.

The Complainant, based on the trademark registrations in various countries of the said trademark ['Sunglass Hut'] and based on the use of the said trademarks] in India and various abroad countries for many years, submitted that it is the sole proprietor of and has sole and exclusive rights to use, the said trademarks, which includes the trademark 'SUNGLASS HUT'.

The Complainant is the registered proprietor of the mark ['SUNGLASS HUT] in India under the Trade Marks Act, 1999. The Complainant submits that as the disputed domain name is 'www.sunglasshut.in', the disputed domain name is clearly identical/confusingly similar to the Complainant's trademark in which the Complainant has exclusive rights and legitimate interest.

Background of the Complainant and its statutory and common law rights

Adoption:

The Complainant is recognised as a leader in speciality sunglass retailing with over 2,300 Sunglass Hut locations around the world. Sunglass Hut stores are located throughout the United States, Canada, the Caribbean, Europe, Australia, New Zealand, Hong Kong, Singapore, Middle East, Philippines, Thailand, South Africa and India.

The Complainant adopted the word 'SUNGLASS HUT' as its trading name and trademark for its goods.

Statutory rights:

The Complainant is the owner of numerous word and figurative trademarks] "Sunglass Hut" throughout the world. In India, the Complainant has filed the following trademark applications:

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- Trademark application number 1638108 for the mark 'Sunglass Hut' [with device] in class 9 advertised in the Trade Marks Journal Number 1403;
- Trademark application number 1640226 for the mark 'Sunglass Hut' in class 35 advertised in the Trade Marks Journal Number 1409;
- Trademark application number 1640225 for the mark 'Sunglass Hut' in class 9 which is pending at the Registry;
- Trademark application number 1638107 for the mark 'Sunglass Hut' [with device] in class 9 which is pending at the Registry.

Domain name registrations:

The Complainant and its subsidiaries worldwide have registered and operate globally a number of websites using its trademark 'Sunglass Hut' in Generic and Country Code Top Level domain names such as: -

- www.sunlasshut.com
- www.sunlasshut.co.za [Sunglass Hut South Africa];
- www.sunlasshut.co.nz [Sunglass Hut, New Zealand];
- www.sunlasshut.com.au [Sunglass Hut Australia];
- www.sunlasshut.co.uk [Sunglass Hut, United Kingdom]

Respondent

The Respondent failed to reply to the notice regarding the complaint.

Discussion and Findings

The Respondent does not have any relationship with the business of the Complainant or any legitimate interest in the mark/brand ['Sunglass Hut']. Moreover, the Complainant has neither given any license nor authorized the Respondent to use the Complainant's mark. The Respondent has nothing to do even remotely with the business of the Complainant. The Respondent has never been commonly known by the domain name in question.

Once a complainant makes a prima facie case showing that a respondent lacks rights to the domain name at issue, the respondent must come forward with the proof that it has some legitimate interest in the domain name to rebut this presumption.

[a] The Respondent's Default

The INDRP Rules of Procedure require under Rule 8(b) that the arbitrator must ensure that each party is given a fair opportunity to present its case. Rule 8(b) reads as follows

"In all cases, the Arbitrator shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case."

Rule 11(a) empowers the arbitrator to move on with an ex parte decision in case any party does not comply with the time limits or fails to reply against the complaint. Rule 11(a) reads as follows:

" In the event that a Party, in the absence of exceptional circumstances as determined by the Arbitrator in its sole discretion, does not comply with any of the time periods established by these Rules of Procedure or the Arbitrator, the Arbitrator shall proceed to decide the Complaint in accordance with law."



The Respondent was given notice of this administrative proceeding in accordance with the Rules. The .IN Registry discharged its responsibility under Rules paragraph 2(a) to employ reasonably available means calculated to achieve actual notice to the Respondent of the Complaint.

As previously indicated; the Respondent failed to file any reply to the Complaint and has not sought to answer the Complainant's assertions, evidence or contentions in any manner. The Arbitrator finds that the Respondent has been given a fair opportunity to present his case.

The Rules paragraph 12(a) provides that the Arbitrator shall decide the Complaint on the basis of the statements and documents submitted in accordance with the INDRP and any law that the Arbitrator deems fit to be applicable. In accordance with Rules paragraph 12, the Arbitrator may draw such inferences as are appropriate from the Respondent's failure to reply to the Complainant's assertions and evidence or to otherwise contest the Complaint. In the circumstances, the Arbitrator's decision is based upon the Complainant's assertions and evidence and inferences drawn from the Respondent's failure to reply.

The issues involved in the dispute

The Complainant in its complaint has invoked paragraph 4 of the INDRP which reads

"Types of Disputes

Any Person who considers that a registered domain name conflicts with his legitimate rights or interests may file a Complaint to the .IN Registry on the following premises:

- (i) the Respondent's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;*
- (ii) the Respondent has no rights or legitimate interests in respect of the domain name; and*
- (iii) the Respondent's domain name has been registered or is being used in badfaith.*

The Respondent is required to submit to a mandatory Arbitration proceeding in the event that a Complainant files a complaint to the .IN Registry, in compliance with this Policy and Rules thereunder."

According to paragraph 4 of the INDRP, there are 3 essential elements of a domain name dispute which are being discussed hereunder in the light of the facts and circumstances of this case.

The Respondent's domain name is identical and confusingly similar to a name, trademark or service in which the Complainant has rights.

It has been proved by the Complainant that it has intellectual property, particularly trademark rights, and other rights in the mark "SUNGLASS HUT" by submitting substantial documents. The mark is being used by the Complainant worldwide and also in India in relation to its business. The mark has been highly publicized and advertised by the Complainant in both the electronic and print media; both in India and globally. According to the INDRP paragraph 3 it is the responsibility of the Respondent to find out before registration that the domain name he is going to register does not violate the rights of any proprietor/brand owner.

Paragraph 3 of the INDRP is reproduced below:

"The Respondent's Representations

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By applying to register a domain name, or by asking a Registrar to maintain or renew a domain name registration, the Respondent represents and warrants that: the statements that the Respondent made in the Respondent's Application Form for Registration of Domain Name are complete and accurate; to the Respondent's knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party; the Respondent is not registering the domain name for an unlawful purpose; and the Respondent will not knowingly use the domain name in violation of any applicable laws or regulations. It is the Respondent's responsibility to determine whether the Respondent's domain name registration infringes or violates someone else's rights."

The Respondent has failed in his responsibility discussed above and in the light of the pleadings and documents filed by the Complainant, I have come to the conclusion that the disputed domain name is identical with or deceptively similar to the Complainant's "SUNGLASS HUT" marks[s]. Accordingly, I conclude that the Complainant has satisfied the first element required by Paragraph 4 of the INDRP.

The Respondent has no rights or legitimate interests in respect of the disputed domain name
The second element that the Complainant needs to prove and as is required by paragraph 4(ii) of the INDRP is that the Respondent has no legitimate right or interests in the disputed domain name.

The Respondent has never used the disputed domain name or any trademark similar to the disputed domain name prior to the registration of the disputed domain name in its favour. The Respondent has also not used the disputed domain name as a trademark or a service mark in connection with any goods or services after the registration of the disputed domain name in its favour. The Respondent has also not registered the trademark 'SUNGLASS HUT' in its favour in India.

Moreover, the burden of proof on a Complainant regarding this element in the domain name lies most directly within the Respondent's knowledge. Once the Complainant makes a prima facie case showing that the Respondent does not have any rights or legitimate interest in the domain name, the evidentiary burden shifts to the Respondent to rebut the contention by providing evidence of its rights or interests in the domain name.

The Respondent has not rebutted the contentions of the Complainant and has not produced any documents or submissions to show his interest in protecting his own right and interest in the domain name. Further, the Respondent has not used the domain name or a name corresponding to the disputed domain name in connection with a bonfide offer of goods or services. Further, the Respondent is not commonly known by the disputed domain name and has not made any legitimate non-commercial or fair use of the disputed domain name. Thus, it is clear that the Respondent has no right or legitimate interest in respect of the disputed domain name www.sunglasshut.in

For these reasons, the Arbitrator finds that the Respondent has no rights or legitimate interests in the disputed domain name.



The disputed domain name has been registered or is being used in bad faith.

It has been contended by the Complainant that the Respondent has registered and has used the disputed domain name in bad faith. The language of the INDRP paragraph 4(iii) is clear enough, and requires that either bad faith registration or bad faith use be proved.

Paragraph 6 of the INDRP provides that the following circumstances are deemed to be evidence that a Respondent has registered and used a domain name in bad faith:

"Circumstances indicating that the Respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or

the Respondent 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 Respondent has engaged in a pattern of such conduct; or

by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its Website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation or endorsement of its Website or location or of a product or service on its Website or location."

From the circumstances of the case and from the evidences put before me by the Complainant, I am of the opinion that the Respondent had no previous connection with the disputed domain name and has clearly registered the disputed domain name in order to prevent the Complainant who is the owner of the said trademark from using the said trademark in the domain name. Moreover, any use of the disputed domain name by the Respondent, would result in confusion and deception of the trade, consumers and public, who would assume a connection or association between the Complainant and the Respondent's website or other online locations of the Respondents or product/services on the Respondent's website, due to the use by Respondent of the Complainant's said trademark in the disputed domain name, which trademarks have been widely used and advertised in India and all over the world by the Complainant and which trademarks are associated exclusively with the complainant, by the trade and public in India and all over the world.

The domain name is deceptively similar to the trademark of the Complainant and will lead to confusion with the Complainant's mark "SUNGLASS HUT" as to the source, sponsorship, affiliation or endorsement of the Respondent's website or service.

Thus, all the three conditions given in paragraph 6 of the Rules are proved in the circumstances of this case and thus the registration of the impugned domain name by the Respondent / Respondent is a registration in bad faith.

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Decision

The Respondent failed to comply with Para 3 of the INDRP which requires that it is the responsibility of the Respondent to ensure before the registration of the impugned domain name by him that the domain name registration does not infringe or violate someone else's rights

The Complainant has given sufficient evidence to prove trademark rights on the disputed domain name. Further; the Respondent's adoption and registration of the disputed domain name is dishonest and malafide. The Respondent had no previous connection with the disputed domain name and has clearly registered the disputed domain name in order to prevent the Complainant who is the owner of the said trademark from using and exercising proprietary rights in the said trademark in a corresponding domain name. The Respondent has not given any reason to register the domain name rightfully owned by the Complainant and therefore it can be presumed that the Respondent had registered the domain name only to make monetary benefit by selling the domain name to the rightful owner or his competitor.

[Relevant WIPO decisions: Uniroyal Engineered Products, Inc. v. Nauga Network Services D2000-0503; Thaigem Global Marketing Limited v. Sanchai Aree D2002-0358; Consorzio del Formaggio Parmigiano Reggiano v. La casa del Latte di Bibulic Adriano D2003-06611

While the overall burden of proof rests with the Complainant, panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is often primarily within the knowledge of the Respondent. Therefore a complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests. Once such *prima facie* case is made, Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. Thus it is clear that the Respondent is using the disputed domain name in bad faith and 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. *[Relevant WIPO decisions: Croatia Airlines d.d. v. Modern Empire Internet Ltd. D2003-0455; Belupo d.d. v. WACHEM d.o.o. D2004-01101*

The Respondent's registration and use of the Domain Name is abusive and in bad faith. The Respondent has no rights or legitimate interests in respect of the domain name. In accordance with Policy and Rules, the arbitrator directs that the disputed domain name be transferred from the Respondent to the Complainant; with a request to NIXI to monitor the transfer.



Rodney D. Ryder
Sole Arbitrator

Date: April 28, 2010