



தமிழ்நாடு தமில்நாடு TAMILNADU

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19 JUL 2016

Dr. SUDHIR RAJA RAVINDRAN
Chennai

BA 990740

S. AYATH BASHA
STAMP VENDOR

L.NO. 3 / 3 / 2000

No.43, SEETHAMMAL ROAD,
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Phone : 9841640694

BEFORE THE SOLE ARBITRATOR, DR. SUDHIR RAJA RAVINDRAN

.IN REGISTRY

(NATIONAL INTERNET EXCHANGE OF INDIA)

.IN DOMAIN NAME DISPUTE RESOLUTION POLICY (INDRP)

ARBITRATION AWARD

DATED: July 20, 2016

NAVISTAR, INC.

2701 Navistar Drive,

Lisle, IL 60532

United states of America

COMPLAINANT

VERSUS

Yazdi Tantra

Citi Services

Tamarind Lane Rajabhadur Mansion F,

Mumbai – 400 023

Maharashtra

RESPONDENT

DISPUTED DOMAIN NAME: "TRANSTAR.IN"

1. Parties

1.1. The Complainant in this arbitration proceeding is Navistar, Inc, represented by Mr. Vinod Khurana, Khurana & Khurana, Advocates and IP Attorneys, Noida.

1.2. The Respondent in this arbitration proceeding, according to the WHOIS database accessed via the .IN Registry's website, is Yazdi Tantra.

2. The Dispute: The domain name in dispute is TRANSTAR.IN. According to the WHOIS search utility of the .IN Registry, the Registrar of the disputed domain name is Net4India (R7-AFIN).

3. Calendar of Major Events:

S. No	PARTICULARS	DATE
1.	Date on which NIXI'S letter was received for appointment as Arbitrator	24.05.2016
2.	Date on which consent was given to act as an Arbitrator	24.05.2016
3.	Date of appointment of Arbitrator	27.05.2016
4.	Date on which the Hard copy of the complaint was received	01.06.2016
5.	Date on which notice was issued to the Respondent	04.06.2016
6.	Due date for filing of Counter Statement by the Respondent	11.06.2016



7.	NIXI email to Arbitrator regarding complaint un-served to Respondent due to "incomplete address"	07.06.2016
8.	Arbitrator instructed NIXI to comply under the Rule 2.(a).(ii) of INDRP Rules of Procedure	07.06.2016
9.	NIXI's compliance under the Rule 2.(a).(ii) of INDRP Rules of Procedure	07.06.2016
10.	Respondent telephoned the Arbitrator and sent an email.	08.06.2016
11.	Arbitrator instructing Respondent citing Rule 7 of INDRP Rules of Procedure and asked the respondent to comply with Rule 2(g)(iii)	09.06.2016
12.	Arbitrator had sought from the Complainant certain explanation along with additional documentation (if any).	02.07.2016
13.	Arbitrator had sought from the Respondent certain explanation along with additional documentation (if any)	02.07.2016
14.	Respondant had provided response along with additional documentation to the Arbitrator's email dated July 2, 2016	05.07.2016
15.	Complainant had provided response along with additional documentation to the Arbitrator's email dated July 2, 2016	09.07.2016

4. Procedural History

4.1. 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 ("Rules") were approved by NIXI on June 28, 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.

4.2. In accordance with the Rules 2(a) and 4(a), NIXI formally notified the Respondent of the complaint and appointed Dr. Sudhir Raja Ravindran as the sole arbitrator for adjudicating upon the dispute in accordance with the .IN Domain Name Dispute Resolution Policy and the Rules framed thereunder and the Arbitration and Conciliation Act, 1996 and the Rules

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

- 4.3. The Complaint was filed in accordance with the requirements of the .IN Domain Name Dispute Resolution Policy (INDRP).
- 4.4. On June 4, 2016, the Arbitrator issued a notice to the Respondent intimating the Respondent of the appointment of the Arbitrator and calling upon the Respondent to submit his response within 7 days, i.e. on or before June 11, 2016.
- 4.5. On June 7 20, 2016 NIXI requested the Arbitrator for advice and instructions on the issue that the Complaint was not served due to "Incomplete address".
- 4.6. On June 7, 2016, the Arbitrator advised NIXI to send the Complaint in electronic form by email to the email address shown in the domain name's registration data through the .IN Registry's WHOIS function at www.registry.in; and [postmaster@\[the contested domain name\]](mailto:postmaster@[the contested domain name]) in accordance with Rule 2 (a)(ii) of INDRP Rules of Procedure.
- 4.7. On June 7, 2016, NIXI complied with requirement of Rule 2.(a).(ii) of INDRP Rules of Procedure.
- 4.8. On June 8, 2016, a person claiming to represent a company Transtar Logistics Private Limited had telephoned the Arbitrator and sent an email. The Arbitrator had responded to the email and directed not to call the Arbitrator or have any unilateral communication with Arbitrator citing Rule 7 of INDRP Rules of Procedure and further advised that all communication be in compliance of Rule 2 (g)(iii) of INDRP Rules of Procedure.
- 4.9. On July 2, 2016 Arbitrator had sought from the Complainant explanation along with additional documentation (if any) stating that:

4.9.1. The Complainant in this case is Navistar, Inc. The details of the trademark registration and applications submitted by the Complainant show that the owner/applicant of the



trademarks are International Truck Intellectual Property Company, LLC and Transtar Industries, INC.

4.9.2. The Complainant has not filed evidence of any assignment or license provided to the Complainant by International Truck Intellectual Property Company, LLC and Transtar Industries, INC or affiliation to International Truck Intellectual Property Company, LLC and Transtar Industries, INC.

4.9.3. The Complainant has also not provided any evidence that it has been given the specific authority to pursue this matter by the relevant trademark owners.

4.9.4. The Complainant has provide whois results of the Complainant's domain name vide Annexure E which relates to the domain www.transtar.com. The whois results provided by the Complainant shows that Perfect Privacy, LLC as the owner and do not reflect the name of the Complainant. The website www.transtar.com also reflects the website of Transtar Real Estate Solutions and show no relation to the Complainant

4.10. On July 2, 2016, Arbitrator had sought from the Respondent explanation along with additional documentation (if any) stating that:

4.10.1. The whois records reflects the Registrant's Name as Yazdi Tantra and Registrant's Organisation name as Citi Services.

4.10.2. Vide email dated June 8, 2016 Transtar Logistics Private Limited claims to have incorporated Transtar Logistics Private Limited and registered the domain name www.transtar.in

4.10.3. No proof of the incorporation or date of incorporation of Transtar Logistics Private Limited or registration of the domain by Transtar Logistics Private Limited has been provided.

4.11. On July 5, 2016 Transtar Logistics Pvt Ltd responded by stating that it is a private limited company registered with Registrar of Companies and enclosed its incorporation certificate.

Again on July 5, 2016, the Registrant Yazdi Trantra had responded stating that it had registered the domain name "transtar.in" on behalf of its client Transtar Logistics Pvt Ltd and enclosed their bills for domain registration and renewal for 2 years, evidencing the same.

4.12. On July 9, 2016 the Complainant had provided response as below:

4.12.1. *INTERNATIONAL TRUCK INTELLECTUAL PROPERTY COMPANY, LLC, is a wholly owned affiliate of Navistar INC and is responsible for handling of intellectual Properties of NAVISTAR INC worldwide. Copy of official records available online substantiating that International Truck Intellectual Property Company, LLC is 100% owned affiliate entity of Navistar, Inc is attached for ready reference. With regards to Transtar Industries, INC, attached herewith is copy of Trademark Co-existence agreement entered into between NAVISTAR, INC and Transtar Industries, INC identifying goods under respective parties wherein clause 3 specifically provides that both companies shall co-exist and that Navistar, or its wholly owned intellectual property affiliate International Truck Intellectual Property Company, LLC is entitled to seek registration of trade mark TRANSTAR for NAVISTAR use in class 12 anywhere in the world.*

4.12.2. *As explained in previous paragraph, INTERNATIONAL TRUCK INTELLECTUAL PROPERTY COMPANY, LLC, is a wholly owned affiliate of Navistar INC and is responsible for handling of intellectual Properties of NAVISTAR INC worldwide. Copy of official records available online substantiating that International Truck Intellectual Property Company, LLC is 100% owned affiliate entity of Navistar, Inc and copy of Trademark Co-existence agreement entered into between NAVISTAR, INC and Transtar Industries, INC entitling NAVISTAR to seek registration of trade mark TRANSTAR for NAVISTAR use in class 12 anywhere in the world is attached for ready reference and records of Hon'ble Tribunal.*



4.12.3. Copy of letter dated July 07, 2016 authorising NAVISTAR INC for the present proceedings is attached for reference and records of Hon'ble Tribunal.

4.12.4. It is respectfully submitted that the complainant is and has claimed ownership of the trade mark TRANSTAR as registered in its affiliate company's name in various jurisdictions and no wherein the complaint it has claimed ownership of domain name TRANSTAR.COM. The attachment of who is result pertaining to domain name TRANSTAR.COM was only to endorse that the website belongs to Transtar Real Estate Solutions and not the respondent.

5. Factual Background:

5.1. The Complainant is a company incorporated under the laws of United States of America and is world's leading manufacturer and trader of Commercial vehicles and automobile engines. The Complainant is one of the most renowned names in the automotive industry across the world. The Complainant's inception dates back to 1831 which was started by McCormick and was subsequently named as McCormick Harvesting Machine Company. In the Year 1902, McCormick harvesting Machine Company was merged with Deering harvester Company and a new company was created known as International Harvester Company. In 1986 Navistar was incorporated with the primary objective of building trucks, buses and engines. The Complainant has adopted the trade name and trademark TRANSTAR since the late 1968 with respect to its goods and services and the Complainant use of the trademark is more than 47 years. The Complainant has registered trademarks for the mark TRANSTAR in USA, New Zealand, Brazil, Mexico and Turkey. The Complainant has filed application for registration of the mark TRANSTAR in India.

5.2. The Respondent registered the disputed name <TRANSTAR.IN> on April 25, 2015.

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6. Parties Contentions

6.1. Complainant's Submission:

6.1.1.The Complainant has registered its trademark TRANSTAR which is distinctive and has an established reputation in many countries in the world.

6.1.2.In India, the Complainant has applied for registration with the Indian Trademark Registry for its trademark "TRANSTAR" in Class 12 under trademark Application number 2988489 on June 17, 2015.

6.1.3.The Complainant has also won various awards, recognitions and milestones for its products and services.

6.1.4.The Complainant claims that the TRANSTAR product line of the Complainant are one of the world famous preferable vehicle across the Globe which has been introduced since the year 1968 and kept timely modified by the Complainant to meet the diverse needs of the ever developing market and thus is the first choice for the potentials across various countries making it one of the best selling and well known product line of the Complainant.

6.1.5.The Complainant claims that the adoption of the trade mark "TRANSTAR" by the Complainant dates back to 1968 and the mark since its adoption been developed, protected, nurtured and promoted an exclusively used by the Complainant for more than 47 years now in more than 90 countries. Owing to the use of the mark in respect of the Complainant's well established line of commercial vehicles, the Complainant's brand has gained phenomenal recognition and is one of the most valued brand internationally and has trans border and spill over reputation to India.

6.1.6.The Complainant claims that the proprietary rights in the mark "TRANSTAR" and that have been recognized all over the world by way of registrations in various jurisdictions



and are strong evidence of its perseverance in securing and protecting their intellectual property for its brand name.

6.1.7. The Complainant claims that the Complainant's Trade Mark "TRANSTAR" represents its invaluable proprietary rights and the Complainant vigorously enforces and vehemently defends such rights against any act of infringement and passing off. The Complainant also keeps a close watch on any activity resulting in transgression of its Intellectual Property Rights and is always prepared to take proactive measures against such acts.

6.1.8. International Truck Intellectual Property Company, LLC, is a wholly owned affiliate of Navistar INC and is responsible for handling of intellectual Properties of Navistar Inc worldwide and entitled to seek registration of trade mark TRANSTAR for Complainant's use in class 12 anywhere in the world. The Complainant also submitted the Trademark Co-existence agreement entered into between Complainant and Transtar Industries, INC entitling Complainant to seek registration of trade mark TRANSTAR for Complainant's use in class 12 anywhere in the world.

6.1.9. Complainant had also submitted copy of letter dated July 07, 2016 wherein Transtar Industries, Inc had authorised Complainant for the present proceedings.

6.1.10. Complaint claims ownership of the trade mark TRANSTAR as registered in its affiliate company's name in various jurisdictions.

6.1.11. In support of its contentions, the Complainant relied on the decisions in the cases of WIPO Decisions Osram Gmbh v. Yuri A Ivanov Case No. D2009-0692, INDRP Decisions Societe Des Prodi its Nestle Sa, Awitzerland v. Nescafe Limited, United Kingdom INDRP Case No. INDRP/100, Monster India Private Limited v. Domain Leasing Company INDRP Case No. AA 2006- 0012, Rediff.com India Limited v. Mr. Abhishek Verma and Iadvance Media case No. INDRP/001, Arcelor Mittal Legal Affair Corporate, France v. Simon Ting



Nelto Brand Inc, China Case No. INDRP/336 and Netgear Inc. V. Chen Shenglu Case No. INDRP/017.

6.1.12. The Complainant requests for the following relief: "requests that the domain name <TRANSTAR.IN> be transferred to the Complainant and costs as may be deemed fit may also be awarded by the Arbitrator".

6.2. Respondent's Submission:

6.2.1. Respondent submits that it had registered the domain name "transtar.in" on behalf of its client Transtar Logistics Pvt Ltd and enclosed their bills for domain registration and renewal for 2 years, evidencing the same.

6.2.2. Transtar Logistics Pvt Ltd states that it is a private limited company registered with Registrar of Companies and has provided its incorporation certificate.

6.2.3. Transtar Logistics Pvt Ltd state that the domain name "TRANSTAR" was obtained based on availability.

7. Discussion and Findings

7.1. Under the .IN Policy, the registrant of the domain name is required to submit to a mandatory arbitration proceeding in the event that a complaint is filed in the .IN Registry, in compliance with the .IN Policy and the INDRP Rules.

7.2. The .IN Policy, Paragraph 4 requires the Complainant, to establish the following three elements:

7.2.1. The domain name is identical or confusingly similar to the trademark or service mark in which the Complainant has rights, and

7.2.2. The Respondent has no rights or legitimate interests in respect of the domain name; and

7.2.3. The Respondent's domain name has been registered or is being used in bad faith.

7.3. Identical or Confusingly Similar

7.3.1.The first element requires the Complainant to prove that the domain name registered by the Respondent is identical or confusingly similar to a mark in which the Complainant has rights.

7.3.2.It is well established that trademark registration is recognized as prima facie evidence of rights in a mark. The Complainant had filed documents of certain registered trademarks in USA, New Zealand, Brazil, Mexico and Turkey. The Complaint had also filed documents of application for trademark registration in India.

7.3.3.The details of the trademark registration and applications submitted by the Complainant is tabled below:

Si.no	Trademark	Applicant/Owner	Registration/Appl ication Number	Date of Filing	Class	Country	Status
1.	TRANSTAR	International Truck Intellectual Property Company, LLC	78962884	29/08/2006	12	USA	Registered
2.	TRANSTAR	International Truck Intellectual Property Company, LLC	170304	10/02/1987	12	New Zealand	Registered
3.	TRANSTAR	International Truck Intellectual Property Company, LLC	830471685	12/03/2009	12	Brazil	Registered
4.	TRANSTAR	Transtar Industries, INC	915960	20/09/2005	12	Mexico	Registered
5	TRANSTAR	International Truck Intellectual Property Company, LLC	2011-90460	04/11/2011	12	Turkey	Registered

6	TRANSTAR	International Truck Intellectual Property Company, LLC	2988489	17/06/2015	12	India	Pending
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7.3.4. The Complainant in this case is Navistar, Inc. The details of the trademark registration and applications submitted by the Complainant show that the owner/applicant of the trademarks are International Truck Intellectual Property Company, LLC and Transtar Industries, INC.

7.3.5. The Complainant's trademarks TRANSTAR are registered by International Truck Intellectual Property Company, LLC, a wholly owned affiliate of the Complainant. The Complaint also claims ownership of the trade mark TRANSTAR as registered in its affiliate company Transtar Industries, Inc's name in various jurisdictions.

7.3.6. The Complainant has submitted the Trademark Co-existence agreement entered into between Complainant and Transtar Industries, INC entitling Complainant to seek registration of trade mark TRANSTAR for Complainant's use in class 12 anywhere in the world.

7.3.7. The Complainant had also submitted copy of letter dated July 07, 2016 wherein Transtar Industries, INC had authorised Complainant for the present proceedings.

7.3.8. The Complainant has established that it has rights in the trademark "TRANSTAR".

7.3.9. The disputed domain name incorporates the trademark "TRANSTAR" in its entirety and this is adequate to prove that the disputed domain name is either identical or confusingly similar to the mark. A domain name that entirely incorporates a Complainant's mark is sufficient to establish the confusing similarity of the disputed domain name with the mark.

7.3.10. The Arbitrator finds that the Complainant has satisfied the first element under Para 4 (i) of the Policy.



7.4. Rights and Legitimate Interests

7.4.1. The second element requires the Complainant to show that the Respondent has no rights and legitimate interests in the disputed domain name.

7.4.2. The Complainant has asserted that the Respondent has no rights or legitimate interests in the disputed domain name and that the Respondent has registered the domain name "transtar.in" mala fide with the sole motive to encash upon the goodwill and reputation of the Complainant.

7.4.3. The Complainant further states that the Respondent having no legitimate interest is corroborated by the fact that the domain in question was registered almost a year back on April 25 2015 and the website has not been activated and the domain name merely parked and is likely to be used for display of advertisement or for the purpose of selling, renting or otherwise transferring the domain to the Complainant or to a competitor of the Complainant.

7.4.4. Under Paragraph 7 of the Policy, a Respondent or a registrant can establish rights in the domain name, if (i) before notice of the dispute, the registrant had used or made demonstrable preparations to use the domain name in connection with a bonafide offering of goods or services or (ii) the registrant (as an individual, business organization) has been commonly known by the domain name, or (iii) The registrant is making legitimate, non commercial or fair use of the domain name without intent for commercial gain.

7.4.5. The Respondent has responded in these proceedings and submitted that it had registered the domain name "transtar.in" on behalf of its client Transtar Logistics Pvt Ltd and enclosed their bills for domain registration and renewal for 2 years, evidencing the same.



7.4.6. Transtar Logistics Pvt Ltd had also stated that it is a private limited company registered with Registrar of Companies and had provided its incorporation certificate. Transtar Logistics Pvt Ltd state that the domain name "TRANSTAR" was obtained based on availability.

7.4.7. The Arbitrator finds the material on record shows that Transtar Logistics Pvt Ltd on whose behalf the Respondent had registered the domain name "transtar.in" is commonly known by the disputed domain name.

7.4.8. There is no information to refute the Respondent's assertions. Further, the Arbitrator finds that there is no evidence showing that Respondent's conduct was aimed at creating confusion with Complainant's trademark at any point in time.

7.4.9. The Complainant does not provide any proof indicating that Respondent's aim in registering the disputed domain name was to profit from and exploit Complainant's trademark and the Complainant's position is based solely on inference.

7.4.10. The Arbitrator is not satisfied that the Complainant has met the requirements of the second element under Para 4 (ii) of the Policy and it is not possible to conclude that on the evidence before the Arbitrator, the Respondent has no rights or legitimate interests in the domain name.

7.5. Bad Faith

7.5.1. Under the INDRP Policy the Complainant is required to establish that the domain name was registered or is being used in bad faith. Proof of bad faith is a separate requirement. Information that is relevant to a consideration of the other ingredients of a claim can be relevant to bad faith inquiry, but it usually will not be sufficient to meet the Complainant's burden of proof.

7.5.2. The Complainant has asserted that the Respondent has registered and uses the disputed domain name in bad faith for the reasons that the Complainant has acquired

a formidable reputation and become a stalwart in the automobile industry and having regards to the fact that the Respondent has registered its domain name only since one year ago and that the Respondent seeks to exploit its famous mark to attract Internet users for commercial purpose. The Complainant further states that bad faith is corroborated by the fact that the domain in question was registered almost a year back on April 25 2015 and the website has not been activated and the domain name merely parked and is likely to be used for display of advertisement or for the purpose of selling, renting or otherwise transferring the domain to the Complainant or to a competitor of the Complainant.

7.5.3. In this case, the acquisition of the subject domain name by the Respondent does not lead to any inference adverse to it. There is no information to support the suggestion that Respondent intends to sell the subject domain name. There is no information that the Complainant asked the Respondent to cease using the subject domain name.

7.5.4. As a general rule bad faith registration cannot arise in circumstances where the registration predates any applicable trademark rights that the Complainant asserts – see *WIPO Overview 2.0*, at paragraph 3.1: *“Can bad faith be found if the disputed domain name was registered before the trademark was registered or before unregistered trademark rights were acquired? Consensus view: Generally speaking, although a trademark can form a basis for a UDRP action under the first element irrespective of its date [see further paragraph 1.4 above], when a domain name is registered by the respondent before the complainant’s relied-upon trademark right is shown to have been first established (whether on a registered or unregistered basis), the registration of the domain name would not have been in bad faith because the registrant could not have contemplated the complainant’s then non-existent right”*. That is exactly the position in the present case wherein the only Indian trademark that

the Complainant has relied on is Application number 2988489 which was made on June 17, 2015 in Class 12, the Respondent's registration of the domain name "transtar.in" was on April 25, 2015 which predates the date of application in India by the Complainant.

7.5.5. Transtar Logistics Pvt Ltd's response to this present proceedings was made using an email id "cs@transtar.in" which the Arbitrator treats as evidence that the disputed domain name "transtar.in" has been used as an email address. In fact the statement in the domain name *"We are in the process of development & will be online soon. Please visit again shortly"* is positive information of a legitimate, planned use.

7.5.6. The Arbitrator finds that the Complainant has not provided any evidence of registration and use of domain name in bad faith as provided for in Para 6 of the Policy and failed to demonstrate that the Respondent's conduct is in bad faith as set out in Para 4 (iii) of the Policy.

7.5.7. The Arbitrator finds that the Complainant has failed to prove that the Respondent registered the disputed domain name in bad faith and that the Complainant has not met the requirements of Para 4 (iii) of the Policy.

8. Decision

8.1. In the light of the findings in paragraph 7 above, the Arbitrator concludes that this dispute is not within Paragraph 4(ii) and 4(iii) of the Policy, the Complaint is denied and the domain name "transtar.in" shall remain registered to the Respondent.

8.2. The Award is accordingly passed on this day of July 20, 2016.

8.3. The Parties shall bear their own costs.

Place: Chennai


Dr. Sudhir Raja Ravindran
Sole Arbitrator