

उत्तर प्रदेश UTTAR PRADESH

FD 172824

INDRP ARBITRATION

THE NATIONAL INTERNET EXCHANGE OF INDIA [NIXI]

ADMINISTRATIVE PANEL DECISION

OSRAM GmbH V OSRAM India Pvt Ltd <www.OSRAM.in>

SOLE ARBITRATOR: ANKUR RAHEJA, FCS LLB MCA

In the matter of:

OSRAM GmbH

...Complainant

Marcel-Breuer-Straße 6,
80807 Munich, Germany

Versus

OSRAM India Pvt Ltd

...Respondent

Rohini, Delhi - 110085, Delhi, India

A. Rahaj
25-AUG-2019

ARBITRATION AWARD

Disputed Domain Name: OSRAM.in

1. The Parties:

1.1. The Complainant in this arbitration proceedings is: **OSRAM GmbH, Marcel-Breuer-Straße 6, 80807 Munich, Germany**, represented by Mr Shailendra Bhandare of Khaitan & Co, Mumbai, India.

1.2. The Respondent in this arbitration proceeding is **OSRAM India Pvt Ltd, Rohini, Delhi - 110085 Delhi, India.**

2. The Domain Name and the Registrar:

2.1. The Disputed Domain Name is **<osram.in>**, created on 25th September 2018.

2.2. Domain Registrar is Endurance Domains Technology Pvt Ltd.

3. Procedural History:

3.1. Arbitrator received an email, inquiring if Nixi can avail of its services as an arbitrator for the dispute pertaining to the domain name **<osram.in>**. Arbitrator confirmed availability and sent the signed



Statement of Acceptance and Declaration of Impartiality and independence as required by rules.

3.2. NIXI appointed Mr Ankur Raheja as the sole Arbitrator on 04th July 2019 and Arbitrator received the hard copy of the Complaint along with Annexures on 08 July, 2019.

3.3. Arbitral Proceedings commenced on 06th July 2019 by issue of a notice by the Arbitrator by email to the Respondent, directing Respondent to file his response to the Complaint by 21 July 2019, which was successfully delivered on the WHOIS Email ID.

3.4. In the meantime, Nixi served soft copy of the Complaint with Annexure, while the hard copy of the same was dispatched through courier to the WHOIS address of the Respondent.

3.5. Relevant Dates are as follows:

Sr No	Particulars	Date
1	Date of Handover of Complaint by NIXI and service of soft copy of Complaint upon Respondent by Nixi	4 July 2019
2	Hard copy of the Complaint received by the Arbitrator	8 July 2019
3	Notice of Arbitration issued to the parties, also referred as date of commencement of Proceedings	6 July 2019

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4	Second Notice to the Respondent	22 July 2019
5	Award Passed	25 August 2019

- 3.6. In accordance with INDRP read with INDRP Rules of procedure, notice of Arbitration was sent to the Respondent on 6th July 2019, with the instructions to file his reply / response by 21st July 2019.
- 3.7. That on failure of the Respondent to file any response to the first notice, another opportunity was provided to the Respondent on 22 July 2019 but he failed to comply with the same as well.
- 3.8. The communication at various stages of proceedings through emails at the ID provided in the WHOIS information of the Disputed Domain was delivered successfully. NIXI had already delivered Soft Copy of the Complaint upon Respondent on 04th July 2019. Though, the hard Copy of the Complaint remained undelivered due to incomplete address, but INDRP Rules of procedure are deemed to be complied with.
- 3.9. In the facts and circumstances of the case, an order for ex-parte proceedings were issued on 30 July 2019, as no response was received from the Respondent. In any case, the WHOIS info was the only contact information available for the Domain name owner as per the WHOIS records and which is assumed to be provided correctly and on which various notices were otherwise attempted to be served. Therefore, service of notice has deemed to have been complied with in accordance with Rule 2 of the INDRP Rules of Procedure.



3.10. No personal hearing was requested / granted / held.

3.11. The language of these proceedings is in English.

4. Factual Background:

4.1. The Complainant is a private company operating under the OSRAM Group, headquartered in Germany. The Complainant was established centuries ago and comes as a German light bulb manufacturer, which has now successfully converted itself into an internationally recognized and renowned company in various sectors including automotive, LEDs, emotters, lasers, sensors, light engines and modules, light management systems, electronic gear, flexible lighting solutions, lamps and special lamps, luminaires, etc.

4.2. The Complainant carries out the aforesaid business under its well-known mark OSRAM across continents in various countries. In India, the complainant carries on its business through its subsidiary. Products and services emanating from the Complainant under its well-known marks have acquired substantial goodwill and reputation.

4.3. The Complainant is based upon Complainant's well known trademark OSRAM and marks consisting of OSRAM. The Complainant's mark was adopted by the Complainant over a century ago.

4.4. The Complainant's mark OSRAM was adopted by the Complainant over a hundred years ago and the business thereunder is conducted in over 100 countries. The complainant's marks are extensively used internationally as part of the Complainant's corporate name, trading



style, domain names in addition to the same being used as a product / service identification mark.

- 4.5. In India, the Complainant is the proprietor of valid and subsisting registrations for the Complainant's Marks, including the mark "OSRAM" (word per se) vide Trademark Registration no 1250222 dated 18 November 2003 in classes 35, 37 and 42; Registration no 1756422 dated 21 November 2008 under class 11; Registration no 2533494 under class 10 dated 17/05/2013; Registration no 580830 dated 10 September 1992 under class 9 and registration number 612620 dated 25/11/1993 under class 11. Moreover, the Complainant is the owner of many domain names consisting of the word OSRAM, in addition to one of its official websites - www.osram.com.
- 4.6. The products / services provided by the Complainant under the Complainant's Marks since the last century enjoy worldwide reputation and goodwill (including trans-border reputation penetrating into India) and the same vests exclusively in the Complainant. The members of the trade and the public at large associate the Complainant's marks with the Complainant exclusively. The aforesaid is inter alia evinced by the facts stated herein below.
- 4.7. The total revenue of the Complainant under the Complainant's marks over decades exceeds millions of Euros. The Complainant has incurred substantial promotional / marketing expenditure in advertising / promoting their business under the Complainant's Marks internationally over decades. Over the years, the products / services by the Complainant have been cited and discussed in numerous leading

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publications, which have circulation and readership all around the world including India.

- 4.8. The Complainant has been regarded as one of the top 12 Companies in the global general lighting market and in the subsequent year received a spot in one of the top 10 companies in the category of largest LED light manufacturers in the world.
- 4.9. A search through various search engines from India such as Google and Yahoo reveals the Complainant's Marks in several listings clearly establishing enormous goodwill and reputation, the Complainant's mark enjoys all over the world. including in India. The aforesaid clearly indicates that the Complainant's marks have acquired tremendous goodwill and reputation across the globe and sufficient trans-border reputation, which has not merely percolated or penetrated into India but has poured into and continues to pour into India.
- 4.10. The Complainant has promptly, effectively, actively and regularly defended its domain names as mentioned herein above and protected it against cyber-squatters and infringers over a period of time vide UDRP Case No DRO2005-0004, UDRP Case no Case No. D2008-0083, UDRP Case No. D2008-1032, UDRP Case No D2008-1045 and more. These decisions were decided in favour of the Complainant, including OSRAM.com. The decisions also state that the Complainant's marks are distinctive identifiers of the Complainant and its products / services. More specifically, the domain name rights were recognized under INDRP as well in 2012. In the aforesaid arbitration, the appointed learned arbitrator transferred the disputed domain name - www.osram.co.in to the Complainant.

- 4.11. The Complainant recently discovered that the Respondent has registered the disputed domain name OSRAM.IN with the above Registrar, without the Complainant's permission or authorization. At the time of filing of this Complaint, the disputed domain name does not resolve to an active website. The disputed domain name is likely to create a likelihood of confusion of the Respondent with the Complainant to the source, association, affiliation or endorsement of the impugned website. The disputed domain name is likely to misdirect traffic to the disputed domain name.

5. Complainant's Contentions under Para 4 of the INDRP Policy:

5.1. The Disputed Domain Name is identical or confusingly similar to the trademark of the Complainant in which the Complainant has statutory and/or common law rights

- 5.1.1. The Complainant has statutory as well as common law rights in the well-known Complainant's marks in several countries of the world including in India and also by virtue of its extensive use. Further, the Complainant is the prior adopter and prior user of the Complainant's Marks [Dell India v. Raj Kumar, INDRP/249].

- 5.1.2. The disputed domain name effectively incorporates the Complainant's well-known mark OSRAM in its entirety. Further, the disputed domain name is identical or confusingly similar to the Complainant's Marks [Lego Juris A/S v. Robert Martin, INDRP/125].



5.1.3. The Domain Name at issue is in it relevant, dominant and distinguishing part almost identical to Complainant's Marks. The only difference between the disputed domain name and the Complainant's trademark resides in the replacement of the alphabet "O" with the numerical "0", placed at the beginning of the domain name. Thus it is evident from this malicious act that there is clearly a mala fide intent on the part of the Respondent to represent the said alphabet as the said numerical, owing to their close visual similarity - typically referred to as typo-squatting. A user / visitor of common prudence with average intelligence and imperfect recollection may not be able to differentiate between "O" and "0". Moreover, the domain name www.osram.in is owned and operated by the Complainant's subsidiary having presence in India.

5.1.4. Further, considering that the disputed domain name is likely to be referred to / pronounced as that of the Complainant, it is submitted that the rival domain names are phonetically similar as well. The changes element is not sufficient to avoid the likelihood of confusion.

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

5.2.1. The Respondent does not have any rights or legitimate interest in the disputed domain name because the Respondent has only demonstrated the use of the disputed domain name for misrepresenting the public and trade and not in connection with



a bona fide offering of goods or services. Such passive holding of a domain name evinces the lack of rights and legitimate interests in the domain name as settled in *Compagnie Gervais Danone v. Digitech Software Solutions*, INDRP/96 (27 June 2009).

- 5.2.2. Further, the Respondent is not commonly known by the disputed domain name. The Respondent has deliberately registered the domain name in the name of OSRAM India Pvt Ltd, when there is no connection of Respondent with the Complainant. Here the name of the Respondent is not Osram - this is apparent from the Respondent's email ID which shows a Gmail ID and the user name is MDSHAKEELDL. In any event, the Respondent is not in a position to make such claims, as the Complainant's marks are exclusively associated with the Complainant. Moreover, upon information and belief, the Respondent does not actually engage in any business or commerce under the disputed domain name for the same to be associated with the Respondent.
- 5.2.3. The Complainant is the prior adopter and prior user of the Complainant's marks and extensive use of the same. Further, the Complainant is the prior adopter and prior user of the Complainant's marks. Accordingly, the Respondent cannot establish any right or legitimate interest in the disputed domain name.
- 5.2.4. The Complainant has not authorized the Respondent to use the Complainant's marks in any way or manner whatsoever. The

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Complainant submits that the disputed domain name is unauthorizedly and wrongfully registered by the Respondent for commercial purposes to misleadingly divert consumers or to tarnish the Complainant's marks.

5.2.5. In any event, the Respondent cannot have any right or legitimate interest in the disputed domain name when the disputed domain incorporates the entire mark of the Complainant [Wockhardt Limited v Kishore Tarachandani, INDRP 382/2012 [14 August 2012].

5.3. The disputed Domain Name has been registered or is being used in Bad Faith

5.3.1. The Complainant's marks have acquired tremendous goodwill and reputation across the globe and are well-known marks. Furthermore, products bearing the said marks have come to be associated by the public at large exclusively with the Complainant. It is inconceivable that the Respondent was not aware of the Complainant's marks and / or exclusive rights of the Complainant over those marks. It is inconceivable that the Respondent has any other purpose in registering and using the disputed domain name (containing a visually identical trademark), but to trade-off on the reputation of the Complainant's marks. As held in Wockhardt Limited v Kishore Tarachandani, INDRP 382/2012 (14 August 2012), when the entire mark is copied in the disputed domain name, it is a clear case of abusive registration of a well-known mark.



- 5.3.2. Even otherwise, in terms of Paragraph 3 of the Policy, it is the Respondent's responsibility to determine whether the Respondent's domain name registration infringes or violates someone else's rights. The Complainant submits that the Respondent should have conducted a prior availability search before registering the domain name. In fact, whilst registering the disputed domain name, the Respondent must have realized that the Complainant had registered their domain names consisting of the Complainant's marks.
- 5.3.3. The Complainant submits that the Respondent has registered the domain name in order to prevent Complainant from reflecting the Complainant's marks in a corresponding domain name. Even if the disputed domain name is not used, the members of the public and trade are likely to access the details of the disputed domain name and assume that the disputed domain name belongs to the Respondent or that the Respondent is connected, associated or affiliated with the Complainant when such is not the case.
- 5.3.4. The Respondent has malafidely adopted the disputed domain name with an ulterior motive of usurping the Complainant's Marks in which Complainant has acquired immense and unparalleled goodwill and reputation. The fact that the Respondent has resorted to typo squatting and also registered the domain name in the name of OSRAM India Pvt Ltd is a clear indication of the Complainant's malafide intent. The Complainant submits that the disputed domain name is registered in an attempt to attract, for commercial gain, internet



users to the proposed website (if so) bearing the disputed domain name or other on-line location, by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation or endorsement of the proposed website (if so) or location or of a product or service on the proposed website (if so) or location. The disputed domain name is likely to misdirect traffic from the Complainant's websites.

5.3.5. The registration and use of the disputed domain name also constitutes trademark infringement and is resulting in the dilution of the Complainant's well known and reputed marks. The registration and use of the disputed domain name also amount to the tort of passing off. The Respondent has therefore made false representations whilst registering the disputed domain name and have breached the service agreement with the Registrar.

6. Respondent's Contentions

- 6.1. Respondent did not file any formal Response.
- 6.2. As per WHOIS information the Whois name has been provided as OSRAM India Pvt Ltd. with incomplete address and even the company name provided is similar to Complainant's subsidiary in India.
- 6.3. Though the name of the Complainant's subsidiary has not been made available but as per the Complainant's official website, the Indian Subsidiary name is OSRAM Lighting Pvt Ltd.

6.4. Further, as per Ministry of Company Affairs (MCA) records - "OSRAM India Pvt Ltd" (as used by the Respondent in its WHOIS information) has current status as 'Struck Off' in terms of Section 248 of the Companies Act, 2013, while the Respondent registered the disputed domain name on 25 September 2018 only.

6.5. That is, the WHOIS information has been provided wrongly and as a result hard copy of the Complaint could not be delivered to the Respondent.

7. Discussions and Findings

7.1. The Arbitrator has reviewed all the documents placed before it by the Complainant and the Respondent respectively.

7.2. The Complainant in its complaint has invoked Para 4 of the INDRP, wherein the Complainant is supposed to satisfy all three conditions provided under Para 4 of the INDRP Policy.

7.3. The Complainant, headquartered in Germany, was established in the early twentieth century and comes as a German light bulb manufacturer, which has now successfully converted itself into an internationally recognized and renowned company, operating in varied sectors.

7.4. The Complainant adopted mark OSRAM over a century ago and holds valid registration across several jurisdictions in the world including India. The business under the said mark is being conducted in over 100 countries.

- 7.5. The details of registration of trade marks secured and for **OSRAM** marks in various classes have been produced along with the complaint. The Indian Trademark Registry website also evidences that Complainant had applied for some of its first Trademark applications under class 9, way back in 1992.
- 7.6. The Complainant is the owner of numerous domain names consisting of the word **OSRAM**. In addition has an official website at www.osram.com, whose registration date appears as 25 March 1999. Further Complainant over time, has also obtained registration for several country and region specific domain names or ccTLDs bearing the word **OSRAM** and/or its derivatives such as OSRAM.de, OSRAM.com.au, OSRAM.co.uk, OSRAM.fr, OSRAM.asia, OSRAM.in and so on.
- 7.7. The products / services provided by the Complainant under the Complainant's Marks since the last century enjoy worldwide reputation and goodwill. The disputed domain name registered by the Respondent is identical / confusingly similar to the well-known trademark **OSRAM** which has been owned and used by Complainant continuously and openly since early twentieth century.
- 7.8. With such extensive, continuous, open and uninterrupted use of the **OSRAM** trademark and trade name by the Complainants, throughout the world the **OSRAM** trademark has become distinctive and indicative of the goods of the Complainants alone and none else. Hence, any individual coming across the disputed domain name **<Osram.in>** will assume it to be the Complainant's website for the India and instantly

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associate the same with the Complainants. That is, the disputed domain name <0sram.in> wherein the first letter 'O' has been replaced by numeric '0' is still confusingly similar to the registered trademark of the Complainant - **OSRAM**, which incorporates the same almost in its entirety.

- 7.9. In the UDRP matter of **mtdpr0ducts.com** (Complainant: MTD Products Inc; NAF Case No FA1803598), it was held that Previous panels have found confusing similarity when a respondent merely adds generic terms to a complainant's mark. See PG&E Corp. v Anderson, D2000-1264 (WIPO Nov. 22, 2000) (finding that respondent does not by adding common descriptive or generic terms create new or different marks nor does it alter the underling mark held by the Complainant). The Panel agrees that the addition of the generic term 'pr0ducts', even when misspelled, to Complainant's MTD mark does not distinguish the Domain Name from Complainant's registered trade mark pursuant to the Policy; especially as Complainant's corporate name is MTD Products. Similarly, disputed domains were ordered to be transferred in the matter la-z-b0y.com (Complainant: La-Z-Boy Incorporated).
- 7.10. The Hon'ble Supreme Court in the matter of Cadila HealthCare Ltd. vs. Cadila Pharmaceuticals Ltd. (2001) 5 SCC 573, inter alia, observed that its decisions in the last four decades had clearly laid down that what had to be seen in the case of a passing off action was the similarity between the competing marks and to determine whether there was a likelihood of deception or causing confusion.



- 7.11. Honorable Delhi High Court in the matter of Yahoo!, Inc. vs Akash Arora & Anr. [78 (1999) DLT 285] referred to Card service International Inc. Vs. McGee; reported in 42 USPQ 2d 1850, where it was held that the domain name serves the same function as the trademark and is not a mere address or like finding number on the Internet and, therefore, it is entitled to equal protection as a trademark.
- 7.12. The Complainants have brought conclusive evidence that it owns trademark rights in the name **OSRAM** on a worldwide scale, including India. The registration and the use of the identical/confusingly similar disputed domain is a direct infringement of the legitimate rights held by the Complainant of the mark **OSRAM**. In the matter of F. Hoffmann-La Roche AG v. Relish Enterprises, [WIPO Case No D2007-1629], where it was held - "if the Complainant owns a registered Trademark then it satisfies the threshold requirement of having the Trademark rights and the Domain name is confusingly similar to Complainant's Trademark because disputed Domain Name looks and reads like Complainant's Trademark".
- 7.13. In the matter of Nikon, Inc. v. Technilab, Inc, [WIPO Case No D2000-1774] and Magnum Piering, Inc. v. Mudjackers & Wilson, [WIPO Case No D2000-1525], it was held that holding that confusing similarity under the Policy is decided upon the inclusion of a trademark in the domain name. That is, The registration and the use of the confusingly similar impugned domain is a direct infringement of the legitimate rights held by the Complainant of the mark **OSRAM**.
- 7.14. Further, the Complainant has promptly and regularly defended its marks against cybersquatters and infringers over a period of time both



under UDRP and INDRP policy. These decisions were decided in favour of the Complainant, including OSRAM.com, OSRAM.co.in. It was held that the Complainant's marks are distinctive identifiers of the Complainant and its products / services.

- 7.15. For the second condition as to legitimate interests, Para 7 of the INDRP policy provides for the 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 purposes of Paragraph 4.
- 7.16. Complaint submits that the Respondent is neither known by the name **OSRAM** nor carries any trade or business under the said trademark. Further, the Complainants have not authorized the Respondent to secure and continue to hold such domain name registration.
- 7.17. Moreover, there is no website on the disputed domain name. The Respondent has simply registered the disputed domain name in order to benefit from the Complainant's goodwill and deceive the visitors by registering a domain name that entirely incorporates the Complainant's trademark without including any distinguishing features.
- 7.18. Given the long and widespread reputation of the Complainant's mark, the compelling conclusion is that the Respondent, by choosing to register and use a domain name which is not only confusingly similar to the Complainant's widely known and distinctive mark but identical, intended to ride on the goodwill of the Complainant's trademark in an attempt to exploit, for commercial gain, Internet traffic destined for the



Complainant. Potential partners and end users are led to believe that the website is either the Complainant's site, especially made up for the bearings, or the site of official authorized partners of the Complainant, while in fact it is neither of these [Viacom International Inc., and MTV Networks Europe v. Web Master, WIPO Case No. D2005-0321 – mtvbase.com].

7.19. That online search reveals that Respondent registered two domain names on the same date - 25 September 2018, both starting with numeric zero and providing WHOIS name as OSRAM India Pvt Ltd.

7.19.1. Osram.in (*Disputed Domain Name*)

7.19.2. Orientelectric.com (*while OrientElectric.com is a famous CK Birla Company website*)

7.20. That on searching for Respondent's WHOIS name - 'OSRAM India Pvt Ltd' in Ministry of Company Affairs (MCA) database at www.mca.gov.in, it has come forward that a company that was registered by this name in 1993 has a status as 'Strike Off'. Therefore, it can be concluded that the Respondent has no relation with the said company name, so as to provide any relief under the second clause of Para 4 of the INDRP Policy.

7.21. Under the second clause, 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, the burden of proof shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. But the Respondent has not filed any response to the said INDRP complaint.

- 7.22. The disputed domain <Osram.in> does not have a proper website website on the date of filing of the complaint, though it has been hosted. Moreover, the WHOIS information provided is incorrect. The case made out by the Complainant, given the strong trademark, prima-facie proves that Respondent has no legitimate rights or interest in the Domain Name.
- 7.23. In the WIPO matter of American Home Products Corporation vs. Ben Malgiogli - "it was held that the Respondent's website is not operational and the Panel infers that it never has been. The Panel simply does not see such passive use to constitute a legitimate non-commercial or fair use without any intent to misleadingly divert consumers or tarnish the trademark or service mark at issue" [WIPO Case No. D2000-1602]. Further in the WIPO matter of Paris Hilton v. Deepak Kumar, if the owner of the domain name is using it in order "...to unfairly capitalise upon or otherwise take advantage of a similarity with another's mark then such use would not provide the registrant with a right or legitimate interest in the domain name. The Respondent's choice of the Domain Name here seems to be a clear attempt to unfairly capitalise on or otherwise take advantage of the Complainants' trademarks and resulting goodwill" [WIPO Case No. D2010-1364].
- 7.24. Further, there is no indication that Respondent is commonly known by that name or carrying on business under the name, corresponding to the disputed domain name or has any intellectual property rights over the term **OSRAM**. Further, obviously neither Complainant has assigned, granted, licensed, sold, transferred or in any way authorized

the Respondent to use the distinctive mark **OSRAM** or to register the disputed domain name.

- 7.25. Respondent's domain name contains the Complainant's mark in its entirety, and the domain is not resolving to any website. Therefore, cannot be said to be making a bonafide or fair use of the domain name. Rather by holding such a Domain Name, Respondent is trying to capitalize on the goodwill and reputation of the Complainant's mark **OSRAM**. The use of the disputed domain name <Osram.in> by the Respondent will most likely deceive the general public into believing that the disputed domain name, registered by the Respondent, is associated with or endorsed by the Complainants in some way. But the Complainants have not authorized the Respondent to register or continue to hold such domain name registration. Such registration and ownership of the disputed domain name by the Respondent restricts the Complainant's rights to use the said domain to its benefit and advantage. Also in January 2017, Hon'ble Delhi High Court held: "With the domain name taking up the entire name of the Petitioner, there could be no doubt that the use of such domain name by the Respondent would be deceptively confusing and erroneously indicate a connection of Respondent No. 1 with the Petitioner when there is none." [Thoughtworks Inc vs Super Software Pvt Ltd. & Anr on 12 January, 2017 - O.M.P. 530/2015]
- 7.26. In the INDRP matter of BASF V GaoGou, it was held that the registration of a domain name that is confusingly similar or identical to a famous trademark by an entity that has no relationship to the mark is sufficient evidence of bad faith registration and use. Internet users may

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believe that the Respondent's domain name is being operated or endorsed by the Complainants [INDRP/752 - basf.co.in].

- 7.27. Lastly, it is quite evident from the parked webpage at the disputed domain name that neither any legitimate, noncommercial or fair use of the disputed domain name being made, but the Respondent seems to have intentionally registered the disputed domain name, which reproduces Complainant's well-known trademark **OSRAM**, in order to capitalize / profit from the goodwill associated with the famous mark.
- 7.28. For the purposes of Paragraph 4(iii), the circumstances provided therein, 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.
- 7.29. INDRP casts a duty upon the Domain Registrant/Respondent in terms of clause 3(b) of the INDRP Policy as well, to do a research before registering a domain name so that it does not infringe upon or otherwise violate the rights of any third party.
- 7.30. The complainant contends that the Complainants use of mark goes back to early twentieth century and has acquired immense goodwill and popularity over the last century. A simple google search can reveal that the **OSRAM** brand is associated with the Complainants and is being used by them in their trade and business. In the matter of The Caravan Club v. Mrgsale, FA 95314 it was held that registration of a well-known trademark by a party with no connection to the owner of the trademark and no authorization or legitimate purpose to utilize the mark reveals bad faith.

- 7.31. The Respondent registered the Domain Name on 25 September 2018, with WHOIS name as OSRAM India Pvt Ltd. It has been laid down in the INDRP matter of ITC Limited v Travel India that registration of Domain Name which is identical to a trademark, with actual knowledge of the trademark holder's rights, is strong evidence that the domain name was registered in bad faith [INDRP Case No 065].
- 7.32. That the Respondent's ownership of the disputed domain name <Osram.in> shows the malafide intent on its part to earn undue advantage by capitalizing on the goodwill and reputation of the Complainant's well-known mark **OSRAM**. Clearly, the disputed domain name <Osram.in> incorporates the said Complainant's mark in its entirety, except with the use of numeric '0' as against alphabet 'O' and is very similar to existing Complainant's website OSRAM.in. Hon'ble Delhi High Court in 2017, held: "With the domain name taking up the entire name of the Petitioner, there could be no doubt that the use of such domain name by the Respondent would be deceptively confusing and erroneously indicate a connection of Respondent No. 1 with the Petitioner, when there is none." [Thoughtworks Inc vs Super Software Pvt Ltd. & Anr on 12 January, 2017 - O.M.P. 530/2015]
- 7.33. The Complainant has registered and used many country specific ccTLDs like OSRAM.co.uk for United Kingdom, OSRAM.fr for France, OSRAM.de for Germany and most importantly **OSRAM.in** for India to provide information as to their products and services. Under the Policy, it is evidence of bad faith registration and use that by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a

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likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement or your web site or location of a product or service on your web-site or location.

7.34. Further, given the Complainant's mark / brand popularity, the use of substantially similar or identical mark, the Respondent has intentionally attempted to attract Internet users to the said website, by creating a likelihood of confusion with the Complainant's Trademark as to the source, sponsorship, affiliation, or endorsement of the said domain name. In the INDRP matter of Lego Juris V Robert Martin, it has been held that "where a domain name is found to have been registered with an intention to attract Internet users by exploiting the fame of a well-known trademark, it constitutes bad faith registration" [INDRP/125 - lego.co.in].

7.35. Therefore, given the immense goodwill and popularity acquired by the Complainants even in India, the act of acquisition of the Domain Name indicates Bad Faith on behalf of the Respondent and it is safe to assume that Respondent already possessed the knowledge of **OSRAM** Trademark. This action of the Respondent clearly constitutes an attempt to free-ride on the Complainant's goodwill and reputation. The Respondent has sought to squat/hoard the said domain with mala fide intent and to the Complainant's detriment and prejudice. In the INDRP matter of QRG Enterprises Limited and Havells India Limited V Zhang Mi - "The Complainant's prior adoption of the mark predates the Respondent's domain name registration of a name that is so obviously connected with the Complainants is suggestive of the Respondent's Bad Faith" [INDRP/852 - QRG.co.in].



7.36. In the matter of Telstra Corporation Limited v. Nuclear Marshmallows [WIPO Case No D2000-0003] the question was considered as to what circumstances of inaction (passive holding) other than those identified in paragraphs 4(b)(i), (ii) and (iii) can constitute a domain name being used in bad faith. It concludes that it does. The particular circumstances of this case which lead to this conclusion are:

- 7.36.1. (i) the Complainant's trademark has a strong reputation and is widely known, as evidenced by its substantial use in Australia and in other countries,
- 7.36.2. (ii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the domain name,
- 7.36.3. (iii) the Respondent has taken active steps to conceal its true identity, by operating under a name that is not a registered business name,
- 7.36.4. (iv) the Respondent has actively provided, and failed to correct, false contact details, in breach of its registration agreement, and

Taking into account all of the above, it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would be legitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law.

7.37. Clearly, the above factors are proved in the current matter of <Osram.in> as well, as the Complainant has a strong reputation due to well known mark globally. And given the distinctiveness of the Complainant's mark it is reasonable to infer that the Respondent has

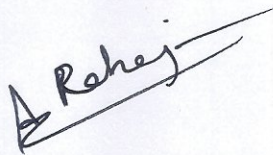
registered the domain name with full knowledge of Complainant's marks and uses it for the purpose of misleading and diverting Internet traffic.

- 7.38. In the UDRP matter of PepsiCo, Inc. v. "null", aka Alexander Zhavoronkov, it has been held that registration of a well-known trademark as a domain name may be an indication of bad faith in itself, even without considering other elements of the Policy [WIPO Case No. D2002-0562]. And given the popularity of the Complainant's www.OSRAM.com website, the Complainant's mark **OSRAM** is acknowledged as a "well-known" mark, and is as such exclusively associated with Complainant's products/services.
- 7.39. In the WIPO matter of Ga Modelfine, Giorgio Armani S.p.A. v. Kim Hontage - the Panel accepts the Complainant's arguments that the worldwide fame of the trademarks leaves no question of the Respondent's awareness of those at the time of the registration of the disputed domain names which wholly incorporates the Complainant's trademarks, as even recognized by numerous previous UDRP panels, [WIPO Case No. D2007-0851].
- 7.40. Even where the domain name has not been used to identify a web site, Panels have held that the ICANN Policy 'use in bad faith' requirement is met by registering a domain name that will ultimately result in consumer confusion. In the matter of CBS Broadcasting, Inc. v. LA-Twilight-Zone, [WIPO Case no D2000-0397] - finding bad faith where Respondent failed to provide any evidence to controvert Complainant's allegation that it registered the domain name in bad faith and where any future use of the domain name would do nothing but

cause confusion with the Complainant's mark, except in a few limited noncommercial or fair use situations, which were not present.

8. Decision:

- 8.1. Therefore, the Arbitrator concludes that the Complainant has established all the three essential elements to maintain its complaint being that the disputed domain name is identical or confusingly similar to its Trademark **OSRAM**; the Respondent has no rights or legitimate interests in respect of the disputed domain name; the Disputed Domain Name was registered or is being used in bad faith.
- 8.2. Consequently the Arbitrator orders that in accordance with INDRP policy that the disputed domain name **<osram.in>** be transferred to the Complainant.



Ankur Raheja, MCA FCS LLB

Sole Arbitrator, NIXI, India

Date: 25th August 2019

Place: New Delhi