

தமிழ்நாடு தமில்நாடு TAMILNADU
23508
15 MAY 2012

AG 891911
P.S. SHANMUGA SUNDARAM,
STAMP VENDOR,
L No B4 / 109 / 88
HIGH COURT CAMPUS,
CHENNAI-600 104 (TAMIL NADU)

BEFORE THE SOLE ARBITRATOR MR.D.SARAVANAN
.IN REGISTRY
(C/o. NATIONAL INTERNET EXCHANGE OF INDIA)

Disputed Domain Name: <firestone.in>

Bridgestone Licensing Services, Inc.
535 Marriott Drive, Nashville,
Tennessee 37214,
United States of America
Punita@knspartners.com

Complainant


Vs.

Simon Ting
8F, No.199 Shifu Road,
Zhejiang 318000
China.
juc@qq.com

Respondent

..2.




 तमिलनाडु TAMILNADU
 23619
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 P.S. SIVANANDA SWAMY MURTHY,
 STATE JUDICARY,
 U. N. ROAD, CHENNAI 600 008,
 HIGH COURT CAMPUS,
 CHENNAI 600 094 (TAMIL NADU)

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1. The Parties:

The complainant is Bridgestone Licensing Services, Inc. having its registered office at 535, Marriott Drive, Nashville, Tennessee 37214, United States of America.

The respondent is Simon Ting, 8F, No.199 Shifu Road, Taizhou, Zhejiang 318000, China.

2. The Domain Name and Registrar:

The disputed domain name:

<firestone.in>

The domain name registered with .IN REGISTRY

3. Procedural History:

- May 11, 2012 : The .IN REGISTRY appointed D.SARAVANAN as Sole Arbitrator from its panel as per paragraph 5(b) of INDRP Rules of Procedure.
- May 24, 2012 : Arbitral proceedings were commenced by sending notice to Respondent through e-mail as per Paragraph 4(c) of INDRP Rules of Procedure, marking a copy of the same to Complainant, Complainant's authorized representative and .IN REGISTRY.
- June 04, 2012 : Due date for filing Response by Respondent.
- June 07, 2012 : Arbitrator sent an e-mail to Respondent notifying their default, a copy of which was marked to Complainant's authorised representative and the .IN REGISTRY.
- : The language of the proceedings in English.

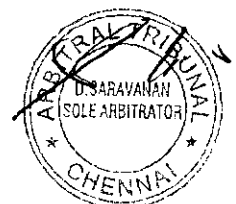
4. Factual Background:

4.1 The Complainant:

The complainant is Bridgestone Licensing Services, Inc. having its registered office at 535, Marriott Drive, Nashville, Tennessee 37214, United States of America, Rep. by its Authorised Representative Punita Bhargava, K & S Partners.

4.2 Complainant's Activities:

The Complainant is a Corporation duly formed and existing under the laws of the State of Delaware, United States of America. Certificate of Legal Existence of the Complainant is filed under Annexure 3. The Complainant is the wholly subsidiary of Bridgestone Corporation of 10-1, Kyobashi 1-chome, Chou-ku, Tokyo,



104 8340, Japan. Bridgestone Corporation is a multinational rubber conglomerate which was founded in 1931. Apart from its core business of manufacturing and marketing tyres, Bridgestone Corporation's products include automotive components, industrial products, construction materials, bicycles and sporting goods etc. It has manufacturing plants in many countries of the world including, but not limited to, India, China, France, United States of America, Mexico and throughout South America. FIRESTONE has been used by the Complainant and its group companies as a trade name and trademark since the early 1900s in relation to tyres and thereafter for other automotive goods in class 12. Harvey S. Firestone (1868-1938) founded The Firestone Tire & marketing solid rubber tyres for carriage wheels. The company was a pioneer in the mass production of tyres. By the 1920s, FIRESTONE had become a world leader in tyres and the company included its own retail store chain. Bridgestone Corporation purchased The Firestone Tire & Rubber Company in 1988. The group companies of and subsidiaries of Bridgestone Corporation develop, manufacture and market, inter alia, FIRESTONE tyres for consumers, automotive and commercial vehicle original equipment manufacturers, and those in the agricultural, forestry and mining industries. The companies also produce air springs, roofing materials, synthetic rubber and industrial fibres and textiles and operate the world's largest chain of automotive tyre and service centres under the FIRESTONE brand. Extracts from a book titled "The FIRESTONE - A Legend. A Century. A Celebration" published in the year 2000 for FIRESTONE centennial celebrations is filed under Annexure 4. In India, goods under the FIRESTONE marks have been available since January 1960 through the representatives of the Complainant's group, since the 1980s, the Complainant's group has been selling its air spring products under the FIRESTONE marks through its exclusive authorized. Copies of invoices evidencing sale of FIRESTONE products in India; certificate for participation in trade shows and auto expos under the FIRESTONE brand; invitations to Tender from ISRO Satellite Centre, Bangalore under the FIRESTONE brand are filed under Annexure 5. One of the Complainant's group companies entered into a joint venture with an Indian company in 2007 to manufacture, sell and distribute products under the FIRESTONE marks. The joint venture company is called Firestone TVS Private Limited and the Complainant has granted a non-exclusive license to it to use the trade name and trademark FIRESTONE and all such use inures to the benefit of the Complainant. A



copy of the license agreement between the Complainant and Firestone TVS Private Limited is filed under Annexure 6. The Complainant's group has also made substantial investment in advertising and promoting the FIRESTONE products on a worldwide basis. Expenses (world-wide) incurred by the Complainant in advertising and promotion of the FIRESTONE brand worldwide from 1995 to September 2011 are in excess of US Dollars 9.6 Million. Advertising and promotional expenditure in India relating to products under the Complainant's FIRESTONE mark have exceeded Rs.83,00,000/- between 2007 to 2011. Copies of a few advertisements issued internationally as well as in India are filed under Annexure 7. Owing primarily to the high quality of goods offered under the FIRESTONE mark, it has achieved enviable reputation and goodwill worldwide. In part, this is reflected by the annual revenues earned by the Complainant's group on account of sales of the FIRESTONE products which runs into billions of dollars. Specifically, from 1994 to September 2011, more than US \$ 3.6 billion dollars have been generated through sale of products under the FIRESTONE marks internationally. In India, revenue attributable to the sale of products under the FIRESTONE marks from 1994 to 2009 have been in excess of US Dollars 4.5 Million.

4.3 Complainant's Trading Name:

The Complainant states that one of the first registrations for the FIRESTONE mark dates back to 1921. Since then, the Complainant has obtained numerous other registrations for the FIRESTONE marks and variants in several classes in multiple jurisdictions including United Kingdom, European Community, Australia, Germany, France, Italy, UAE, Spain, Brazil, Japan, Canada, Singapore, South Africa, Switzerland etc. A list of countries where the FIRESTONE marks are registered is filed under Annexure 8. Copies of a few Registration Certificates for FIRESTONE marks in some of these countries are filed under Annexure 9. In India, the registrations for the FIRESTONE marks go back to December 1942. Details of the various FIRESTONE registrations are set out below:



TM No. and Date	Mark	Class	Status
9921 December 22, 1942	Firestone	12	Registered and renewed till December 22, 2016.
9922 December 22, 1942.	Firestone	17	Registered and renewed till December 22, 2016.
9924 December 22, 1942	FIRESTONE (Stylized)	12	Registered and renewed till December 22, 2016.
9925 December 22, 1942	FIRESTONE	17	Registered and renewed till December 22, 2016.
189898 April 9, 1959	FIRESTONE	12	Registered and renewed till April 9, 2018.
644491 October 31, 1994	FIRESTONE	19	Registered and renewed till January 31, 2014.
1237359 September 16, 2003	FIRESTONE	37	Registered and valid till September 16, 2013.

The trademark registrations listed above are valid and subsisting. Copies of Certificates for use in legal proceedings in respect of registration nos. 9921, 9922, 9924, 189898 and 1237359 issued by the Trade Marks Registry are filed under Annexure 10. The Complainant and its group companies own over 900 domain names which incorporate FIRESTONE and its formatives, including several country specific and top level domains such as <firestone.cn>, <firestone.jp>, <firestone.ca>, <firestone.info>, <firestone.biz>. The registration for the domain <firestone.com> was obtained on January 19, 1996 and the others were subsequently registered over the past few years. An illustrative list of the FIRESTONE formative domains is attached hereto as Annexure 11. 'Whois' extracts for some of these domain name registrations are attached hereto as Annexure 12. The Complainant has also hosted several websites corresponding to the aforesaid domain names. In pursuance of its worldwide rights and goodwill in the FIRESTONE marks, the Complainant actively pursues acts of infringement or misuse which comes to its notice. It has sent out many cease and desist letters to parties observed to be infringing its rights in the FIRESTONE mark. More often than not, the offending parties have complied with



the Complainant's demands and respects its rights in the FIRESTONE mark. Copies of a few letters in this behalf are marked under as Annexure 13.

4.4 Respondent's Identity and activities:

In January 2012, the Complainant discovered that the domain name <firestone.in> was registered in the name of one Simon Ting (hereinafter, Respondent). The true and correct print out of the .IN WHOIS detail for the disputed domain name as obtained on January 30, 2012 is filed under Annexure 14. The Registrant Organization is mentioned as Nelton Brands, Inc. in the print out but has since changed to Taizhou Netlon Investment Consulting Co. Ltd. The Complainant through its attorney addressed letter dated February 6, 2012 to the Respondent apprising it of its rights in the FIRESTONE name and mark and asking the Respondent to transfer the disputed domain name <firestone.in> to the Complainant. The said letter was sent by email to the email address mentioned in the WHOIS report as well as by courier to the postal address mentioned in the WHOIS report. The Respondent did not respond to the email and reminder of the Complainant's attorney and the courier sent to him returned on April 16, 2012 due to the postal address bring 'incomplete'. Copies of the email and reminder are filed under Annexure 15. The DHL courier report is attached under Annexure 16. On visiting the website www.firestone.in on April 17, 2012, the Complainant discovered that the domain name <firestone.in> had been put for sale by the Respondent on www.4.cn through an entity called Sedo. True and correct copies of print out from the websites www.firestone.in and www.4.cn are filed under Annexure 17.

5. Parties contentions:

A. Complainant:

(a) The Domain Name registered by Respondent is identical to the trademark of Complainant

The Complainant states that it is abundantly self-evident that they have statutory and common law rights in the trademark and trade name FIRESTONE including variants thereof. The Complainant has exclusive rights in the FIRESTONE mark by



virtue of prior adoption and use thereof as a trade name, trademark and domain name; (b) pursuant to the long, continuous and extensive international use of the FIRESTONE mark as aforesaid, and the substantial expenditure incurred in its promotion and advertising worldwide, the said mark is exclusively associated with the business of the Complainant; and (c) as a 'well-known mark', the FIRESTONE mark it is entitled to be protected against any misuse whatsoever including that by the Respondent. The Complainant submits that the disputed domain name <firestone.in> is identical in full to its trademark FIRESTONE and confusingly similar thereto as also the corporate and trade name of the Complainant's various group companies. The Complainant further submits that the "overall impression" left by the domain name suggests that this domain name belongs to the Complainant and consumer confusion will inevitably result. The disputed domain name is meant to suggest a ownership by the Complainant and anyone coming across the disputed domain name or any website corresponding thereto will naturally assume that this name is owned or affiliated with the Complainant and is a reflection of its Indian business. The Complainant further submits that being the registered proprietor of the trademark FIRESTONE, the Complainant has statutory rights in the same as also common law rights by virtue of long and continuous use and the disputed domain names violates the said statutory and common law rights of the Complainant.

(b) Respondent has no rights or legitimate interests in the domain name:

The Complainant states that the Respondent is not connected with the Complainant in any manner and neither the Complainant has any knowledge of the Respondent. The Complainant has not authorized or licensed the Respondent to apply for, register, use or offer for sale the disputed domain name or any trademarks forming part thereof. The Respondent has put up the disputed domain name <firestone.in> on sale in www.4.cn and the true and correct copy of the print out from the website www.4.cn is attached to the Complaint; There is no evidence that the Respondent is conducting any business under the name and mark FIRESTONE to warrant registration of the domain name in dispute in his name; To the best of the Complainant's knowledge, the Respondent is not known by the domain name and



there is no evidence that the Respondent has any trademark or service mark rights in the name and mark FIRESTONE; The Respondent has not made any demonstrable preparations to use the disputed domain name in connection with a bona fide offering of goods or services; The Respondent is not making any legitimate non-commercial or fair use of the domain name; In support of above, a true and correct copy of the print out of a search conducted through the Google search engine on April 17, 2012 is filed under Annexure 18.

(c) Respondent has registered and is using the domain name in bad faith:

The Complainant states that the Respondent had constructive notice of the registered trademark and trade name FIRESTONE. The FIRESTONE mark is a well known trade mark and trade name around the world and it is inconceivable that any person would not be aware of the same. The very act of registration of the disputed domain name by the Respondent is an instance of bad faith. The Respondent had actual notice of the Complainant's rights in and to the disputed domain name when it received the email communications from the Complainant's attorney. However, he deliberately chose to ignore these communications and instead put the disputed domain name on sale. The Respondent offered the domain name for sale with an aim to sell the same to third parties including competitors of the Complainant and thereby preventing the Complainant from registering the domain name <firestone.in>. The Complainant submits that offering to sell a domain name by advertising to the public at large that the domain name is for sale is evidence of bad faith and is properly regarded as an offer to sell the domain name to the Complainant or a competitor. By registering the disputed domain name, the Respondent has intentionally attempted to disrupt the Indian business of the Complainant as any person looking for information of Firestone products would necessarily look for the website corresponding to the domain name <firestone.in>. Anyone accessing the Internet is likely to associate the disputed domain name with the Complainant and, hence, realistic use of the disputed domain name will automatically misrepresent an association between the Respondent and the Complainant leading the members of the public to believe that the Complainant has licensed the use of the domain name to the Respondent or has authorized the



Respondent to register the same, resulting in unfair trade competition/ passing off and trademark infringement, at a minimum, under Indian law. It is also an instance of bad faith that the Respondent has provided an incomplete/incorrect postal address while registering the disputed domain name. This is against the Domain Registration Agreement it has with the Registrar, Directi Web Services Pvt. Ltd., In view of the aforesaid, the registration of the domain name <firestone.in> in the name of the Respondent is contrary to and in violation of paragraph 4 of the INDRP Policy. In view of the above submissions, it is prayed that the Administrative Panel appointed in this proceeding issue a decision that the disputed domain name <firestone.in> be transferred to the Complainant.

B. Respondent:

The Respondent did not submit any response.

6. Discussion and Findings:

It has to be asserted as to whether the Constitution of Arbitral Tribunal was proper? And Whether the Respondent has received the notice of this Arbitral Tribunal?

Having gone through the procedural history, this Tribunal comes to the irresistible conclusion that the Arbitral Tribunal was properly constituted and Respondent has been notified of the complaint of the Complainant. However, the Respondent did not choose to submit any response on merits of the complaint and that non-submission of the Response by the Respondent had also been notified to the Respondent.

Under paragraph 4 of the IN Domain Name Dispute Resolution Policy (INDRP), the Complainant must prove each of the following three elements of its case:

- (i) The Respondent's domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;



- (ii) The Respondent has no rights or legitimate interest in respect of the domain name; and
- (iii) The Respondent's domain name has been registered or is being used in bad faith.

(a) Identical or confusing similarity:

i) The Arbitral Tribunal finds that the Complainant has provided evidences that it possesses registered Trade / Service Marks "FIRESTONE" in various countries including India under Annexure 9 and also possesses registered domain names consisting <firestone.in>, <firestone.cn>, <firestone.jp>, <firestone.ca>, <firestone.info>, <firestone.biz> etc. throughout the world under Annexure 11 & 12. The Respondent's domain name, <firestone.in>, consists of entirely Complainant's registered trademark, domain name. Thus, this Arbitral Tribunal comes to the irresistible conclusion that the disputed domain name <firestone.in> is confusingly similar or identical to the Complainant's marks.

ii) The Arbitral Tribunal concludes that the Complainant has established paragraph 4(i) of the IN Domain Name Dispute Resolution Policy.

(b) Respondent's Rights or Legitimate Interests:

i) The Complainant contends that the Respondent has no legitimate interest in the disputed domain name. Paragraph 7 of the IN Dispute Resolution Policy sets out three elements, any of which shall demonstrate the Respondent's rights or legitimate interests in the disputed domain name for the purposes of paragraph 4(ii) of the Policy. The Respondent had been given the opportunity to respond and to present evidence in support of the elements in paragraph 7 of the INDRP. The Respondent has not chosen to do so and has not filed any response on merits of the complaint to establish any circumstances that could assist it in demonstrating, any rights or legitimate interests in the disputed domain name.



Although, the Complainant is not entitled to relief simply by default of the Respondent to submit a Response, the Arbitral Tribunal can however and does draw evidentiary inferences from the failure of the Respondent to respond. The Complainant has established a prima facie case of lack of rights and legitimate interest and the Respondent has failed to rebut the presumption of absence of rights or legitimate interests.

ii) Considering the above, and based on the record, the Respondent does not have rights or legitimate interests in the disputed domain name as the Respondent's current use is neither an example of a bona fide offering of goods or services as required under paragraph 7(i) of the Policy nor is there any legitimate non-commercial or fair use of the disputed domain name and as such there is no evidence that paragraphs 7(ii) or 7(iii) of the Policy apply. The Complainant asserts that they have not licensed or otherwise authorized the Respondent to use their trademark.

iii) The Arbitral Tribunal is satisfied that the Respondent has no rights or legitimate interests in respect of the disputed domain name and, accordingly paragraph 4(ii) of the Policy is satisfied.

(c) Registration and Use in Bad faith:

i) Paragraph 6 of the Policy provides the circumstances evidencing registration and use of a domain name in bad faith are that, by using the same, the Respondent has intentionally attempted to attract, for commercial gain, internet users to the Respondent's web site or other online locations, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's web site or location.

ii) On perusal of Annexure 18, it is seen that the respondent has put up the disputed domain name on sale in www.4.cn which itself exposes the bad and commercial intention of the respondent. The Respondent has registered the domain



name which appears to have been selected precisely for the reason that it is identical or confusingly similar to registered trademarks and trade names of the Complainant. The Respondent has no affiliation with the Complainant. Registration of a domain name that is confusingly similar or identical to a famous trademark by any entity, which has no relationship to that mark, is itself sufficient evidence of bad faith registration and use.

iii) In view of the submitted evidence and in the specific circumstances of this case, this Arbitral Tribunal draws the inference that Respondent's purpose of registering the domain name was in bad faith within the meaning of the Policy. The Respondent has no legitimate rights or interests in the disputed domain name and there was no real purpose for registering the disputed domain name other than for commercial gains, and that the intention of the Respondent was simply to reap unfair rewards through the sale of the disputed domain name to a competitor or any other person that has the potential to cause damage to the ability of the Complainant to have peaceful usage of the Complainant's legitimate interest in using their own trade names.

In the light of the above, this Arbitral Tribunal finds that the Complainant has established that the disputed domain name was registered and is being used in bad faith.

7. Decision:

For all the foregoing reasons, in accordance with paragraph 10 of the Policy, the Arbitral Tribunal orders that the disputed domain name <firestone.in> be transferred to the Complainant.

Dated at Chennai (India) on this 19th day of June, 2012.


(D.SARAVANAN)
Sole Arbitrator