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**INDRP ARBITRATION
THE NATIONAL INTERNET EXCHANGE OF INDIA [NIXI]**

**ADMINISTRATIVE PANEL DECISION
SOLE ARBITRATOR: RODNEY D. RYDER**

**WARNER BROS. ENTERTAINMENT INC.
V.
YE GENRONG c/o OVERSEA DOMAIN MANAGEMENT**

ARBITRATION AWARD

Disputed Domain Name: www.warnerbros.co.in

Ryder

The Parties

The Complainant in this arbitration proceeding is Warner Bros. Entertainment Inc. with registered address as Warner Bros. Entertainment Inc, 4000 Warner Blvd. Burbank, CA 91522, United States of America.

The Respondent in this arbitration proceeding is Shri Ye Genrong, C/O Oversea Domain Management, located at Chaoyaomen Street 1080 KM, Beijing 100008, CN, 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.warnerbros.co.in. The Registrar with which the disputed domain name is registered is Directi Internet Solutions Pvt Ltd, DirectiPlex, Next to Andheri Subway, Old Nagardas Road, Andheri [East], Mumbai, Maharashtra 400069 India.

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 NIXI.

The request for submission with a complete set of documents was dispatched to the Respondent by the National Internet Exchange of India [NIXI]. A reminder was sent on May 16, 2012 by the Arbitrator. The Respondent did not reply.

Grounds for the administrative proceedings

1. The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has statutory/common law rights.
2. The Respondent has no rights or legitimate interests in respect of the disputed domain name.
3. The disputed domain name has been registered or is/are being used in bad faith.

Parties Contentions

Complainant

The Complainant in his complaint, interalia, 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 various Indian and international trademark registrations across various classes owns the trademark "Warner Bros". Based on the use of the said trademark in India and other countries including China submitted that it is the sole proprietor of and has sole and exclusive rights to use the said trademark "Warner Bros".

The Complainant is the registered proprietor of the mark "Warner Bros" in India and several countries across the world including China. The Complainant submits that as the disputed domain name is 'www.warnerbros.co.in', it is clearly identical/confusingly similar to the Complainant's trademark - "Warner Bros" in which the Complainant has exclusive rights and legitimate interest.

Background of the Complainant and its statutory and common law rights Adoption:

The Complainant Warner Bros. Entertainment Inc. is a fully integrated, broad based entertainment company and a global leader in the creation, production, distribution, licensing and marketing of all forms of entertainment and their related businesses. Complainant stands at the forefront of every aspect of the entertainment industry from feature films to television, home entertainment/DVD, animation, product and brand licensing and interactive entertainment. The company's vast library, considered one of the best and the largest in the world, consists of more than 600 feature films, 50,000 television titles and 14,000 animated titles (including 15,00 classic animated shorts). Complainant's employee population ranges from 5,000 to 15,000 on any given day in North America (depending on the level of television and movie production) and some 2,000 employees overseas.

Statutory rights:

The Complainant contends that the trademark "Warner Bros" and other related formative marks have acquired global reputation and goodwill and are well known marks. The complainant holds several domain name registrations incorporating the Warner Bros trademark.

Respondent

The Respondent failed to reply to the notice regarding the complaint and did not file submissions in this matter.

Discussion and Findings

The Respondent does not have any relationship with the business of the Complainant or any legitimate interest in the mark/brand "Warner Bros". Moreover, the Complainant has neither given any license nor authorized the Respondent to use the Complainant's mark. It is a well established principle that that 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.

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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 proceed 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 bad faith.*

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."

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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 "Warner Bros" by submitting substantial documents. The mark has been highly publicized and advertised by the Complainant in both the electronic and print media; both in India and globally and the disputed domain name is similar to that of the complainant's mark, services and domain names.

The disputed domain name contains the entirety of the Complainant's trademark. Previous panels have found that when a domain name contains a trademark in its entirety, the domain name is identical or at least confusingly similar to the trademark. [Relevant Decisions: Case No. INDRP/125, February 14, 2010, *Lego Juris A/S v. Robert Martin*; Case No. INDRP/286, February 20, 2009, *G.A. Modelfine S.A. v. Naveen Tiwari*]

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 -

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; The Panel comes to the conclusion that the disputed domain name is identical with or deceptively similar to the Complainants' marks and its business. Accordingly, the Panel concludes 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

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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.

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.

The Respondent is not authorized by the Complainant to use the domain name. In the absence of any license or permission from the Complainant to use any of its trademarks or to apply for or use any domain name incorporating those trademarks, it is clear that no actual or contemplated bonafide or legitimate use of the domain name could be claimed by the Respondent [Relevant Decisions: *Guerlain S.A. v. Peikang*, D2000-0055 (WIPO March 21, 2000)]

The Complainant's rights in the trademark "Warner Bros" predates Respondent's registration of the disputed domain name incorporating that trademark, therefore the Respondent does not have rights or legitimate interests in the disputed domain name [Relevant Decisions: Case No: INDRP/096, June 27, 2009, *Compagnie Gervais Danone v. Digitech Software Solutions*]

Respondent is in no way affiliated with the Complainant. The Complainant has not authorized or licensed Respondent to use and register the Warner Bros trademark, nor sought registration of any domain name incorporating this trademark.

Further, the Respondent has registered and used the domain name to infringe Complainant's rights in the trademark and to trade off Complainant's goodwill. The disputed domain name has been used to redirect users to a landing page, which has links to sites related to complainant's products or services, although not limited to Complainant's own goods and services. [Relevant Decision: Case No. INDRP/286 (INDRP December 16, 2011) *Intesa Sanpaola S.p.A v. Amar Bose*; Case No. INDRP/180 (INDRP January 16, 2011) *Dart Industries Inc. v. Morada*]

The Respondent's use of the disputed domain name does not constitute a bonafide offering of goods or services, as there is no evidence to prove that there was legitimate interest to offer any bonafide goods or services through the disputed domain name. [Relevant Decision: Case No. INDRP/215 (INDRP July 9th 2011) *Ray Marks Co. LLC v. Rachel Ray Techniques Pvt. Ltd.*; *Chanel, Inc. v. Cologne Zone*, D2000-1809 (WIPO March 6th 2001)]

The Respondent is not and has not in the past commonly used the disputed domain Name. Respondent does not use the Trademarks to identify itself on its website or for any other legitimate purpose. Even if the Respondent has used the tradename, such an unauthorised use does not establish legitimate interest in the disputed domain

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name. [Relevant Decision: Case No. INDRP/082 (INDRP February 20, 2009 G.A. Modefine S.A. v. Naveen Tiwari)]

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:

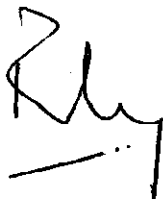
"Circumstances indicating that the Respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of the complainant, 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 the Panel by the Complainant, the Panel is of the opinion that the Respondent had no previous connection with the disputed domain name and 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.

The Respondent's registration and use of the domain name meets the bad faith elements set forth in the INDRP. Since the trademarks of the Complainant are so distinctive and famous that the Respondent must have had actual knowledge of the trademarks prior to registering the disputed domain name. Therefore the panel comes to the conclusion that the registration is in bad faith. By registering the disputed domain name with actual knowledge of the Complainant's trademark, the Respondent acted in bad faith by breaching its service agreement with the registrar because the Respondent registered a domain name that infringes upon the Intellectual Property rights of another entity, which in the present scenario is the

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Complainant. [Relevant Decision: Case No. INDRP/215 (INDRP July 9th 2011) Ray Marks Co. LLC v. Rachel Ray Techniques Pvt. Ltd.]

Further, the failure to make active use of the disputed domain name is evidence of bad faith registration and use of the domain name. [Relevant Decision: Case No. INDRP/216 (INDRP July 1, 2011) Netflix, Inc. v. Sharma]

The disputed domain name incorporates the world famous Trademarks with no addition, making it identical to the name widely used by the Complainant on a variety of goods and services, thereby increasing the confusion in the minds of users who may be falsely led to believe that the disputed domain name, the page to which it directs and the links contained thereon are sponsored by the Complainant, which is clear evidence of bad faith pursuant to Section 4(iii) of the INDRP [Relevant Decisions: *Univ of Houston Sys, v. Salvia Corp.*, FA 637920(Nat. Arb. Forum March 21st 2006); *Red Hat, Inc. v. Haecke*, FA 726010 (Nat. Arb. Forum July 24th 2006)]

Bad faith is also evidenced by the Respondent's attempts to sell the domain name in explicit violation of Section 6 (i) of INDRP. [Relevant Decisions: *IndyMac Bank FSB v. Ebeyer*, FA 175292 (Nat. Arb. Forum September 19th, 2003; *America Online v. QTR Corporation*, FA 92016 (Nat. Arb. Forum February 4th 2000)]

It has been further established that the Respondent has been engaged in a practise of registering domain names reproducing well-known trademarks, which further deprives the Respondent from having any right or legitimate interest in the disputed domain name. The panel. [Case No. INDRP/183 INDRP January 5, 2011 *Lockheed Martin Corporation v. Steely Black*; Case No. INDRP/163 (INDRP November 23, 2010) *Equifax Inc. v. The Admin*; D2010-1586 WIPO November 22, 2010, *Revlon Consumer Products Corporation of New York v. Ye Genrong, et al*].

Consequently it is established that the disputed domain name was registered in bad faith as well as used in bad faith

Decision

The following circumstances are material to the issue in the present case:

- (i) the Complainants' trademark has a strong reputation and is widely known on a global basis;**
- (ii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the disputed Domain Name;**
- (iii) taking into account the nature of the disputed domain name and in particular the .in extension alongside the Complainant's mark, which would inevitably associate the disputed domain name closely with the Complainant's group of domains in the minds of consumers, all plausible actual or contemplated active use of the disputed Domain Name by the Respondent is and would be illegitimate. Use by the Respondent as such would amount to passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law.**

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 Respondent should have exercised reasonable efforts to

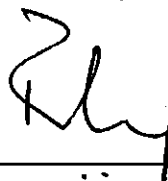
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ensure there was no encroachment on any third party rights. [Relevant Decisions: *Salmi Oy v. PACWEBS* WIPO Case No. D2009-0040; *Graco Children's Products Inc. v. Oakwood Services Inc.* WIPO Case No. D2009-0813; *Artemides Holdings Pty Ltd v. Gregory Ricks* WIPO Case No. D2008-1254; *Ville de Paris v. Jeff Walter* WIPO Case No. D2009-1278].

The Complainant has given sufficient evidence to prove extensive global trademark rights on the disputed domain name. Further, the Respondent's adoption and registration of the disputed domain name is dishonest and mala fide.

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 decisions: *Lego Juris AS v. Robert Martin* INDRP/125; *Societe Air France v. DNS Admin* INDRP/075; *Kelemata SPA v. Mr. Bassarab Dungaciu* WIPO D2003-0849; *Croatia Airlines d.d. v. Modern Empire Internet Ltd.* WIPO D2003-0455; *Uniroyal Engineered Products, Inc. v. Nauga Network Services* WIPO D2000-0503; *Microsoft Corporation v. Chun Man Kam* INDRP/119; D2012-0466 WIPO *Luigi Lavazza S.p.A. v. Noori net*; D2008-1474 WIPO *Serta Inc. v. Charles Dawson*]

The Respondent's registration and use of the domain name [www.warnerbros.co.in] 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 Panel directs that the disputed domain name [www.warnerbros.co.in] be transferred from the Respondent to the Complainant; with a request to NIXI to monitor the transfer.



Rodney D. Ryder
Sole Arbitrator

Date: June 12, 2012