



தமிழ்நாடு தமில்நாடு TAMILNADU

K 035940

UMA MAHESWAR
Stamp Vendor
L.No. A6/10535/76
HIGH COURT CAMPUS
CHENNAI - 600 004

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

Disputed Domain Name: www.wills.in

ITC Limited
Virginia House
37, J.L.Nehru Road
Kolkata- 700 071
INDIA.
Arup.ghosh@itc.in

Complainant

Vs.

Mr.Mark Segal
Namegiant.com
17, Black Friars Lane
London
EC4.V, Great Britain
info@namegiant.com

Respondent





தமிழ்நாடு தமில்நாடு TAMILNADU

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1. **The Parties:**

The Complainant is ITC Limited, Virginia House, 37, J.L.Nehru Road, Kolkata - 700 071, INDIA, represented by its Authorised Representative Rodney D.Ryder (email:Rodney.ryder@kochhar.com), Kochhar & Co., Advocates and Legal Consultants, 3rd Floor, Tower-B, Technopolis Building, Sector-54, DLF GolfCourse Road, Gurgaon-122 002, INDIA.

The Respondent is Mr.Mark Segal, Namegiant.com, 17, Black Friars Lane, London, EC4V, Great Britain. Neither the Respondent represented himself nor represented by any one.

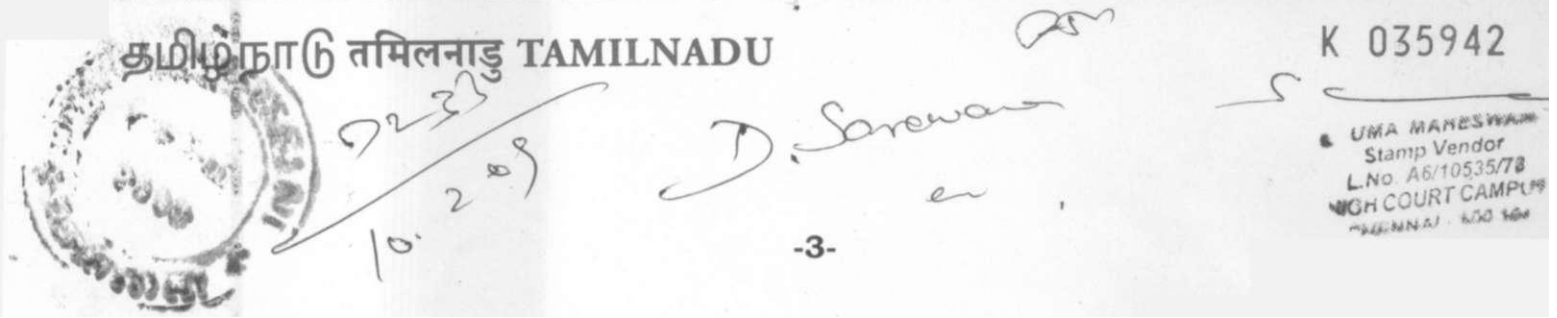
2. **The Domain Name and Registrar:**

The disputed domain name :

<www.wills.in>

The domain name registered with .IN REGISTRY





3. Procedural History:

- January 5, 2009 : Date of Complaint.
- January 6, 2009 : The .IN REGISTRY appointed D.SARAVANAN as Sole Arbitrator from its panel as per paragraph 5(b) of INDRP Rules of Procedure.
- January 6, 2009 : The Arbitrator has submitted Statement of Acceptance and Declaration of Impartiality And Independence to the .IN REGISTRY.
- January 8, 2009 : The .IN REGISTRY has forwarded the hard copy of the complaint and annexures to the Arbitrator.
- January 9, 2009 : 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 authorised representative and .IN REGISTRY.



January 19, 2009 : Due date for filing Response by Respondent.

January 22, 2009 : Arbitrator sent an e-mail to Respondent notifying his default, a copy of which marked to Complainant, 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 ITC Limited, Virginia House, 37, J.L.Nehru Road, Kolkata - 700 071, INDIA.

4.2 Complainant's Activities:

The Complainant states that they are one of India's foremost Private Sector Companies; rated among the World's best big companies; they are ranked among India's Top Ten 'Most valuable Brands' in a study conducted by Brand Finance and published by the Economic Times who won the 'Inaugural World Business Award' for its significant efforts to create sustainable livelihood opportunities and enduring wealth in developing countries. The complainant further states that it was incorporated in the year 1910 under the name of 'Imperial Tobacco Company of India Ltd.,' later the name was changed to 'Indian Tobacco Company Ltd.,' on 20th May, 1970; thereafter the said name was also changed to "I.T.C. Limited" on 14th March, 1974; and finally the said name was also changed to the present name, viz., "ITC Limited" on 18th September, 2001. The complainant further states that they employ over 21,000 people at more than 60 locations across India and it has a diversified presence in Cigarettes, Hotels, Paper Boards and Speciality papers, Packaging, Agri-business, Packaged foods and Confectionary, Information Technology, Branded Apparel, Greeting cards, Safety matches, Personal care products and other FMCG products.



4.3 Complainant's Trading Name:

The complainant states that in the year, 2000 they entered the Lifestyle Retailing Business with the Wills Sport range of International quality relaxed wear for men and women and has established a nation wide retailing presence through its Wills Lifestyle chain of exclusive speciality stores expanding its range such as Wills Classic Formal Wear and Wills Clublife evening wear periodically and that Wills Lifestyle became title partner of the country's most premier fashion event being Wills Lifestyle India Fashion Week which has gained recognition as the single largest B-2-B Platform for Fashion Design Industry. The complainant further states that in December, 2005 they introduced an exclusive line of fragrance and other personal care products under the brand names Essenza Di Wills, Superia, Fiama di Wills, Vivel and Vivel di Wills. According to the complaint, the name Wills originate from the extremely popular and well known range of Wills Cigarettes manufactured and marketed by the complainant under the brand names WILLS CLASSIC, WILLS NAVI CUT, WILLS SILK CUT and such mark/name has acquired a secondary meaning and is synonymously associated with the complainant. According to the complainant Wills Lifestyle Stores are preferred shopping destinations for customers looking for quality products including its World class ambience, customer facilitation and presentation of products with clear differentiation which is evident from the facts that the complainant was awarded prestigious superbrand award for the year 2006 by the Super Brands Council of India. The complainant states that they have spent a huge amount of money on the promotion and advertisement of its products under the brand/mark Wills since its adoption and use through several mediums such as TV advertisements, Newspaper advertisements, Brouchers, Fliers, Hoardings, etc. According to the complainant, the Wills brand/mark is a name to reckon with and has acquired an enormous goodwill not only in India but in many countries across the globe and due to its extensive use, advertisements, publicity and awareness throughout the World, has acquired the status of a well known trade mark under Section 2(1)(zg) of the Trade Marks Act, 1999 which qualifies all tests for the well known status of



a mark under Section 11(6) of the Act including considerations like knowledge or recognition among relevant section of public, duration, extend and geographical area of use, promotion and publicity of mark etc., and that their Wills mark/brand falls within the category of a famous mark as set out under Article 6bis of the Paris Convention. The complainant further states that its trade/service name/marks is an important and an extremely valuable asset and in order to protect the same it has obtained several trade mark registrations for the mark Wills and its many variations in India as per their Annexure B. According to the complainant, their brand/mark WILLS is completely distinctive and unique and by a mere mention of the said mark establishes its identity with the complainant and none else. The complainant further states that they have all the rights in its trade mark and use of the said trade mark by any third party including the respondent without the authorization of the complainant, either as a mark, name, domain name, or in any other form whatsoever constitutes infringement and passing off violating complainant's right and that the use of disputed domain name by the respondent amounts to mis-representation indulging in unfair competition. The complainant further states that since the Internet has become an essential medium to conduct business registered domain names in which WILLS forms an inseparable and their distinctive part thereof, viz., www.wills.com, www.essenzadiwills.com for which the complainant has spent considerable amount of money and skill for the development of the said websites which not only provides comprehensive details of their range of products but also provide the customers with the facility of buying the said products on the Internet as per their Annexure C. The complainant further states that, recently, to their utter surprise and shock came to know that somebody has obtained a domain name registration for www.wills.in and on their immediate search of the WHOIS database it was found that the impugned domain name was registered in the name of the respondent through the registrar Enom Inc. According to the complainant the registration of disputed domain name is the verbatim duplication of the complainant's registered and well known mark WILLS by



which act itself is evident on the respondent's malafide and devious intention.

4.4 Respondent's Identity and activities:

The Respondent is the registrant of the Domain Name <www.wills.in> which is registered with .IN REGISTRY, National Internet Exchange of India, New Delhi. The name of the registrant is referred to as Mr. Mark Segal, Namegiant.com, 17, Black Friars Lane, London, EC4V, Great Britain, as per complainant's Annexure A.

5. Parties contentions:

A. Complainant:

(a) The Domain Name is identical or confusingly similar to a Trademark or service mark of the Complainant has rights:

According to the complainant, a mere glance at the disputed domain name gives rise to enormous confusion as to its origin as the domain name used by the respondent is identical to the corporate name of the complainant and that not even a single letter differs between the disputed domain name and the registered mark of the complainant and that the respondent has picked up the complainant's WILLS mark verbatim without even changing a single letter resulting in the use of the disputed domain name by the respondent is a prima facie case of cyber squatting and trade mark/name infringement. According to the complainant, their WILLS brand/mark is a distinctive and unique mark and by mere mention of the said name/mark establishes an identity and connection with the complainant and none else in which the complainant owns all the rights including statutory and common law rights in the said name/mark and is entitled to protection under the Indian Trade Marks Act, 1999 and use of the said name either as a mark, name, domain name or in any other form whatsoever constitutes violation of the complainant's rights. The complainant further states that the specific top level of a domain name such



as ".com", ".org" has to be dis-regarded whether it is identical or confusingly similar to the trade mark in which the complainant has rights.

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

According to the Complainant, the respondent is in the business of holding domain names and selling them. Whereas the complainant is an established business entity since atleast 1910 and in fact the respondent has put up the disputed domain name for sale which is evident from the home page on the disputed domain name as marked under Annexure I which itself is adequate evidence to show that the respondent has no legitimate interest in the disputed domain name and is merely hoarding the same without doing any business. According to the complainant, the respondent has no proprietary or contractual rights in any registered or common law trade mark corresponding in whole or in part to the disputed domain name and in any event the complainant has not authorized or licensed the respondent to use its trade mark/name or to use the disputed domain name. According to the complainant, the respondent has merely provided links to various other websites, by which conclusion that can be drawn from such an act of the respondent is that he has neither any bonafide interest in respect of offering goods and services nor it has any legitimate non-commercial or fair use of the disputed domain name.

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

The complainant states that the respondent registered the disputed domain name five years after the first use of the name/mark WILLS by the complainant is a prima facie evidence of mala fide intentions and bad faith with the motive either to extract huge sums of money from the complainant as per the exhibited fact that the respondent has put up the domain name for sale or the respondent may be able to represent itself as the complainant or its authorized representative and cause damage to some third party by entering into transactions or contracts with them under the garb of being



associated with the complainant or transfer or sell the domain name to some competing interest of the complainant who may damage the goodwill and reputation of the complainant by inserting pre-judicial material in relation to the complainant or all of the above motives.

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 and that non-submission of the Response by the Respondent had also been notified to the Respondent on January 22, 2009.

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 trade mark 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 and/or being used in bad faith.



ii) 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 trade mark.

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 engaged in a pattern of such conduct and 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) 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 trade marks 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 trade mark by any entity, which has no relationship to that mark, is itself sufficient evidence of bad faith registration and use.



ii) 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 trade mark.

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:

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ii) 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 trade marks 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 trade mark 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 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 generate revenue, either by using the domain name for its own commercial purpose or 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 <wills.in> be transferred to the Complainant. There is no order as to costs.

Dated at Chennai (India) on this 10th February, 2009.


(D.SARAVANAN)
Sole Arbitrator