



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

The Himalaya Drug Company v. Vikas Jandial

Case No. D2000-1822

1. The Parties

The Complainant in this proceeding is the Himalaya Drug Company, a partnership firm, having its office at Makali Bangalore-562123, India.

The Respondent in this proceeding is Mr. Vikas Jandial, D7-7180, Vasant Kunj, New Delhi-110070, India.

2. The Domain Name and Registrar

The domain name at issue is <liv52.com>, which is registered with Network Solutions, Inc.

3. Procedural History

The WIPO Arbitration and Mediation Center (the "Center") received the complaint of the Complainant, the Himalaya Drug Company, on December 27, 2000 in hard copy.

On January 9, 2001 the Center sent an acknowledgement of the receipt of the Complaint (hard copy) to the Complainant and requested him to send an electronic version of the complaint. Accordingly on January 10, 2001 the Complainant sent an electronic version of the complaint alongwith correspondence between the Complainant and the Respondent. On January 10, 2001 the Center sent to the Registrar Network Solutions, Inc., a request for verification of registration data. On

January 11, 2001 the Registrar confirmed, inter alia, that it is the Registrar of the domain name in dispute, and that the disputed domain name is registered in the name of the Respondent.

Having verified that the complaint satisfies the formal requirements of the ICANN Uniform Domain Name Dispute Resolution Policy ("the Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy ("the Rules") and the Supplemental Rules for Uniform Domain Name Dispute Resolution Policy ("the Supplemental Rules"), the Center on January 12, 2001, sent to the Respondent in accordance with paragraph 2(a) of the Rules a notification of the complaint and commencement of administrative proceeding together with copies of the complaint and correspondence. It has been stated in the notification dated January 12, 2001 that payment in the required amount to the Center has been made by the Complainant.

The Respondent was given an opportunity to submit his response. The last date for sending response by the Respondent was January 31, 2001. On January 23, 2001 the Center received an email in which the Respondent requested for extension of time for filing response. On January 24, 2001 the Center sent an email to Complainant's representative inviting him to address his views on the issue of extension of time. On January 25, 2001 the Center received an email from the Complainant regarding no objection for granting an extension of time requested by the Respondent. On

January 25, 2001 the Center granted the extension of 15 days as requested by the Respondent and fixed the new deadline for filing a response as February 15, 2001.

On February 15, 2001 the Respondent submitted a response stating that he had declined ownership of the domain name and that the Whois search shows erroneously him as the registrant.

On February 21, 2001 the Center sent an email suggesting to the Respondent to complete transfer forms, and suggested that the Complainant should request for suspension of Uniform Domain Name Dispute Resolution Policy proceedings initiated by Complainant in order to permit the parties sufficient time to complete the transfer forms and to provide Network Solutions, Inc., the registrar in this case, with an opportunity to process the transfer documents. In his e-mail dated February 28, 2001 the Complainant gave his consent subject to the consent of the Respondent to sign the transfer forms and at his cost. But all efforts failed to bring a final settlement between the parties. On March 29, 2001 the Center decided to proceed to appoint the Administrative Panel. More efforts were made for reaching a final settlement but to no use.

On April 30, 2001 the Center transmitted to the Complainant and the Respondent via email a notification of Appointment of Administrative Panel and Projected Decision Date. The notification advised that Mr. Bansal Ashwanie Kumar had been appointed as the single Panelist, and that the decision would be due on May 13, 2001. A copy of the notification was also sent to the Panelist.

The panel after consideration of the records of the case finds:

- that the complaint was filed in accordance with the Rules and Supplemental Rules, the payment for filing the complaint was made, and the complaint complies with the formal requirements,
- that the complaint was properly notified in accordance with the Rules, paragraph 2 (a),
- that the response to complaint was filed within the time extended by the Center,
- that the Administrative Panel was properly constituted.

4. Factual Background

The Complainant has been carrying on business of manufacturing and marketing of Ayurvedic medicines and health products. The trademark LIV.52 was registered on January 24, 1959 in favour of the Complainant in Class 5 as trademark No. 180564 as of the date July 10, 1957 as per certificate issued by the Registrar of Trade Marks, Government of India. The trademark registration was renewed as per certificate issued by the Registrar of Trade Marks for a period of seven years from July 10, 1999.

The trademark is registered in a few other countries namely Republic of Greece, Mexico, Romania, Switzerland, Costa Rica, Great Britain and Northern Ireland, and Germany. Photocopies of the certificates of registration of the trademark LIV.52 in India and other countries have been annexed as Annexure 'H collectively' with the complaint.

The Respondent is the current registrant of the domain name in issue as per Whois search. E-mail dated January 11, 2001 from Network Solutions, Inc. confirms to Center that the Respondent is the Registrant of the domain name in issue. The date of registration of the domain name is February 24, 2000 and registration is valid for a period of two years.

5. Parties' Contentions

A. Complainant

The Complainant's contentions in brief are as under-

(i) that the respondent registered the domain name <liv52.com> in its favour with the Network Solutions, Inc. on February 24, 2000. The domain name <liv52.com> is identical and confusing with the prior registered trademark of the Complainant which is distinctive and has acquired reputation and goodwill in several countries.

(ii) that the Respondent, seems to be in the habit of registering domain names consisting of words taken from reputed and popular Trade Marks. The Respondent has, apart from registering the domain name <liv52.com> so registered two other domain names being <laopala.com> and <boroline.com>. The trademark BOROLINE is again a very old trademark which is a household name being used for the last several decades. This trademark is registered and owned by G.D. Pharmaceuticals of Calcutta. The trademark Laopala is also reputed all over India and is used by R.G. Glass Limited, a Calcutta based company, dealing in international quality tablewares. The respondent has registered domain names of popular and reputed Trade Marks to clandestinely negotiate for transfer of the same for consideration.

(iii) that the impugned 'domain name <liv52.com>' is exactly similar and identical to the Complainant's registered trademark LIV.52.

(iv) that the Respondent has no right to and legitimate interest in the domain name <liv52.com>.

(v) that the Complainant has not licensed or otherwise permitted the respondent to use any of its trademarks, nor has he licensed or otherwise permitted the Respondent to apply for or use any 'domain name' incorporating the mark.

(vi) that the Respondent did not make any use of the impugned 'domain name'.

(vii) that the registration of the impugned domain name by the Respondent was bad faith registration and use.

B. Respondent

The Respondent's submissions in brief are as under-

(i) That he is not a registrant nor owner the domain name <liv52.com> because he had not paid for it.

(ii) That he had long ago decided that he would not be retaining this account or developing a website with this domain name, because of other official preoccupations and other priorities. That is the reason why he did not pay for it at all. Non deletion of the domain name is a technical error of the automated process of Network Solutions, Inc.

(iii) That the account, <liv52.com> is technically dead because as per the Network Solutions, Inc. rules one is required to make payment within one month of the date of the booking on receipt of the invoice, otherwise the account lapses and things come back in the general pool for anyone to register.

(iv) That the internet has been around for the last seven years, and if for seven years, nobody lays claim to this domain name, it can give general impression that no one is interested in a particular domain name, not even the organisation which owns a product with a similar name.

(v) That he had not demonstrated any such deed or act with the said domain name which conveys an impression that he had exploited his ownership in anyway. The registration was not done in bad faith.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panelist as to the principles the Panelist is to use in rendering its decision: "A panelist shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable." Applied to this case, Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

(i) that the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) that the Respondent has no rights or legitimate interests in respect of the domain name; and

(iii) that the domain name has been registered and used in bad faith.

A. Identical or Confusingly similar

The domain name <liv52.com> registered by the Respondent is confusingly similar to Complainant's registered trademark LIV.52, and is otherwise identical to the Complainant's mark LIV.52 except for the absence of a dot (.) between 'LIV' and '52', which does not change the likelihood for confusion. The Complainant has submitted certificates of registration and renewal of the trademark in India as well as a few other countries.

The Registrar, i. e. the Network Solutions, Inc., has already confirmed vide email dated January 11, 2001 that the Respondent is the current registrant of the domain name at issue.

The Administrative Panel finds that the domain name <liv52.com> is confusingly similar to the trademark LIV.52.

B. Rights or legitimate interests

The trademark LIV.52 has been registered in India and a few other countries like Republic of Greece, Mexico, Romania, Switzerland, Costa Rica, Great Britain and Northern Ireland, and Germany. True copies of the certificates of Registration of the trademark LIV.52 are annexed as Annexure 'H collectively' to the complaint.

The Respondent has failed to present any defense or evidence that would tend to establish that Respondent has any legitimate interest in respect of the domain name in issue.

The Respondent in his response dated February 15, 2001 has clearly stated that he is not the owner nor registrant of the domain name <liv52.com>, because he did not pay for it and that non deletion of the domain name is a technical error of the automated process of Network Solutions, Inc.

Accepting the assertions made in the complaint filed by the Complainant and the response filed by the Respondent to be correct, the Administrative Panel finds that the Respondent has no rights or legitimate interests in the domain name in issue.

C. Bad faith

The requirement in Paragraph 4(a)(iii) of the Policy is that the domain name "has been registered and is being used in bad faith" would be satisfied if the Complainant proves that the registration was undertaken in bad faith and the circumstances of the case are such that the Respondent is continuing to act in bad faith.

Paragraph 4(b) of the Policy provides that for the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the Respondent has registered or he 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 that Complainant, for valuable consideration in excess of his documented out-of-pocket costs directly related to the domain name; or

(ii) 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

(iii) the Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, internet users to his 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 his website or location or of a product or service on his website or location.

Network Solutions, Inc. Who is search enclosed as Annexure A with the complaint shows that the record in respect of the domain name was created on February 24, 2000.

The Center received a series of emails from the respondent and complainant's representative, indicating that parties intended to settle the matter and had reached near a point of final settlement. But finally the Complainant because of lack of support from the Respondent again approached the Center to proceed with the case.

The Respondent in his response dated February 15, 2001 has stated:

I would like to confirm to your esteemed organization that I have never been the "Owner", or the "Registrant" of the domain name, LIV52.com. In order to be the registrant/owner of the domain name, I should have paid the registration fees for it, only then, the registration process can be deemed to be complete, and consequently I can be termed as the Registrant/owner. As per my records, there has never been a payment transaction between me and Network Solutions, Inc. for the said domain name. Since I have never bought it, I am not the owner of the domain name.

Even in his email sent to Center on April 2, 2001, the Respondent had again stated that he is not the owner of the domain name nor does he desire its ownership. On one side the Respondent says that he has no interest in the domain in issue but on the other side he fails to take effective steps to transfer the domain name in favour of the Complainant inspite of repeated request. The Respondent was given sufficient time to transfer the domain name but he failed to do the needful on merely technical grounds.

The Respondent has admitted in his email dated June 20, 2000 Annexure 'L' to the complaint that he and his entire family has been the regular user of the product for the last 40 years and have benefited immensely from it. It implies that Respondent was well aware of the product LIV.52 manufactured by the Complainant. The Respondent has stated that he had booked the domain name because he liked the product. The Respondent has admitted in his email of January 03,2001 that he had temporarily parked the domain name LIV52.com on February 24, 2000, but eventually decided against acquiring it for his ownership and did not pay for it or purchase it.

Payment or non-payment for ownership of domain name is a matter between the Respondent and the Registrar, Network Solutions, Inc. The Complainant has nothing to do with the same. The Complainant has concern with the fact that the Respondent is the Registrant of the domain name <liv52.com> as per Whois search which is his registered trademark. The fact of registration of domain name in favour of the Respondent has also been verified by the Registrar Network Solutions, Inc.

Network Solutions, Inc. Who is search made on May 31, 2000 Annexure 'A' to the complaint shows that the record in respect of the domain name was created on February 24, 2000. There is no evidence that a web site or other online presence is in the process of being established which will use the domain name. There is no positive action being undertaken by the Respondent in relation to the domain name. But, inactivity by the Respondent may also amount to the domain name being used in bad faith. In the case No. D2000-0003 Telstra Corporation Limited v. Nuclear Marshmallows, the Administrative Panel laid down that a passive holding of a domain name by a Respondent may amount to the domain name being used in bad faith.

The Respondent has, apart from registering the domain name <liv52.com> also registered two other domain names being <laopala.com> and <boroline.com> as per Whois search report produced as 'Annexure K' collectively with the complaint. It is stated in the complaint that the trademark BOROLINE is an old trademark which is a household name being used for the last several decades. This trademark is registered and owned by G.D. Pharmaceuticals of Calcutta. The trademark Laopala is also reputed all over India and is used by R.G. Glass Limited, a Calcutta based company, dealing in international quality table wares. These facts have not been opposed by the Respondent in his response.

The conduct of the Respondent clearly implies that he has acted in bad faith and he has registered the domain name which is confusingly similar to the trade mark of the Complainant. The Complainant has substantially used the mark LIV.52 since long and he has got the trademark registered in his favour since long. The Respondent is not authorised to use the mark LIV.52 owned by the Complainant. The Respondent is not commonly known by the domain name registered by him. The domain name at issue is not a registered business name of the Respondent. The Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by him of the domain name. The Respondent has admitted the long use of the product known as LIV.52 manufactured by the Complainant for last 40 years by him as well as his family. On one side he has said that he has no interest in the domain name, but on the other hand he has failed to take effective steps to transfer the domain name. The Respondent is engaged in a pattern of conduct of registering popular and well known marks as domain names.

The panel finds that in the circumstances of this particular complaint, the passive holding of the domain name by the Respondent amounts to the Respondent acting in bad faith under paragraph 4 (a) (iii) of the policy. The Respondent has registered and used the domain name in bad faith. The panel further finds that the Complainant has proved each of the three elements of paragraph 4 (a) of the policy.

7. Decision

This Panel concludes that the Respondent owns a domain name <liv52.com> which is identical or confusingly similar to the Complainant's trademark (LIV.52), has no rights or legitimate interests in respect of the domain name, and he registered and used the domain name in bad faith. These three facts entitle the Complainant to an order which entitles transfer of the domain name from the Respondent. The Panel allows the complaint and directs that the Respondent's domain name <liv52.com> be transferred in favour of the Complainant.

Ashwanie Kumar Bansal
Sole Panelist

Dated: May 8, 2001