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ARBITRATION AWARD

**.IN REGISTRY – NATIONAL INTERNET EXCHANGE OF
INDIA**

.IN domain Name Dispute Resolution Policy

INDRP Rules of Procedure

IN THE MATTER OF:

Stanley Black & Decker, Inc,
1000, Stanley Drive,
New Britain, CT 06053

..... Complainant

VERSUS

Mr. Andrew Yan,
Domain Broker Inc.,
No.800, Dongchuan Road,
Shanghai,
Shanghai 200240, China

... Respondent No.1

Mr. Andrew Sullivan,
Domain Broker Inc.,
Pinelake, Raleigh,
North Carolina,
U.S.A.

.... Respondent No.2

1. **THE PARTIES:**

The Complainant in this administrative proceeding is Stanley Black & Decker, Inc, 1000, Stanley Drive, New Britain, CT 06053 represented through Lall and Sethi Advocates, D-17, South Extension-II, New Delhi -110 049, National Capital Region, India.

The Respondent No. 1 is Mr. Andrew Yan of the address Domain Broker Inc., No.800, Dongchuan Road, Shanghai, Shanghai 200240, China.

The Respondent No. 2 is Mr. Andrew Sullivan of the address Domain Broker Inc., Pinelake, Raleigh, North Carolina, U.S.A who is the current Registrant of the Domain Name

2. **THE DOMAIN NAME AND REGISTRAR**

The disputed domain name **<WWW.STANLEYBLACKANDDECKER.CO.IN>** has been registered by the Respondent(s). The Registrar with whom the disputed domain is registered is Directi Web Services Pvt. Ltd. (R118-AFIN)

3. **PROCEDURAL HISTORY**

The Complaint was filed with the .In Registry, National Internet Exchange of India (NIXI), against Mr. Andrew Yan, Domain Broker Inc., No.800, Dongchuan Road, Shanghai, Shanghai 200240, China (Respondent No.1) & Mr. Andrew Sullivan, Domain Broker Inc., Pinelake, Raleigh, North Carolina, U.S.A. (Respondent



- 3.5 The Panel considers that according to Paragraph-9 of the Rules, the language of the proceedings should be in English. In the facts and circumstances, in-person hearing was not considered necessary for deciding the Complaint and consequently, on the basis of the statements and documents submitted on record, the present award is passed.

4. **FACTUAL BACKGROUND**

- 4.1 The Complainant in these administrative proceedings is Stanley Black & Decker, Inc, 1000, Stanley Drive, New Britain, CT 06053.
- 4.2 The complainant claims to be the proprietor of the trade mark STANLEY and BLACK & DECKER. The Complainant submits that it has an exclusive right to use the aforesaid trade mark in respect of the goods for which the said marks are registered.

The respondent has registered impugned domain name <www.stanleyblackanddecker.co.in> without any right or legitimate interest therein and in bad faith.

- 4.3 The Complainant submits that the present dispute is properly within the scope of INDRP and the Constituted Panel appointed by INDRP has the jurisdiction to decide the suit. The Registrar of the disputed Domain Name has adopted the INDRP Rules as per its Registrar Accreditation Agreement.

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5. PARTIES CONTENTIONS

5A COMPLAINANT

5A(1)The Complainant Stanley Black & Decker, Inc, submits that he is the owner of trade marks STANLEY and BLACK & DECKER and other trade marks in which STANLEY and BLACK & DECKER marks appear as Complainant thereof.

5A(2)The Complainant submits that the Complainant has registration of trade mark STANLEY and BLACK & DECKER in India and various other countries and also enclosed list of countries in which the trade mark STANLEY and BLACK & DECKER are registered or are pending registration.

5A(3)The Complainant submits that the Complainant's Domain Name and Trade Marks were registered much prior to Respondents registration of the impugned Domain Name.

5A(4)The Complainant provides sales figures of its brand STANLEY and BLACK & DECKER worldwide for the years 2008 to 2011 as under:-

STANLEY in \$'000

Year	Sales figures
2008	1656
2009	2068
2010	3088
2011	3342



BLACK & DECKER in \$'000

Year	Sales figures
2008	3815
2009	5181
2010	6941
2011	8371

5A(5) The Complainant submits various articles published by leading Newspapers and Publishers acknowledging the Trade Mark right of the Complainant under the marks STANLEY and BLACK & DECKER.

B. RESPONDENT

5B(1) The Respondent has twice been given opportunities to file his/her response to the Complaint by the panel by its notice dated March 7, 2012 and notice dated March 26, 2012. However, the respondent has failed to file any response within the prescribed time or to seek any extension of time. The case of the complainant, therefore, remain un rebutted.

6. DISCUSSIONS AND FINDINGS

6.1 The Complainant, while filing the Complaint, submitted to arbitration proceedings in accordance with the .In Dispute Resolution Policy and the Rules framed thereunder in terms of paragraph (3b) of the Rules and Procedure. The Respondent also submitted to the mandatory arbitration proceedings in terms of paragraph 4 of the policy, while seeking registration of the disputed domain name.



- 6.2 Paragraph 12 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted and that there shall be no in-person hearing (including hearing by teleconference video conference, and web conference) unless, the Arbitrator, in his sole discretion and as an exceptional circumstance, otherwise determines that such a hearing is necessary for deciding the Complaint. I do not think that the present case is of exceptional nature where the determination cannot be made on the basis of material on record and without in-person hearing. Sub-Section 3 of Section 19 of The Arbitration & Conciliation Act also empowers the Arbitral Tribunal to conduct the proceedings in the manner it considers appropriate including the power to determine the admissibility, relevance, materiality and weight of any evidence.
- 6.3 It is therefore, appropriate to examine the issues in the light of statements and documents submitted as evidence as per Policy, Rules and the provisions of the Act.
- 6.4 In accordance with the principles laid down under order 8 Rule 10 of the Code of Civil Procedure, the arbitrator is empowered to pronounce judgment against the Respondent or to make such order in relation to the Complaint as it think fit in the event, the Respondent fails to file its reply to the Complaint in the prescribed period of time as fixed by the panel.
- 6.5 The award can be pronounced on account of default of Respondent without considering statements or averments made by the Complainant on merit. However, in view of the fact that preliminary onus is on the Complainant to satisfy the existence of all conditions under the policy to

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obtain the relief's claimed, the panel feels it appropriate to deal with the averments made by the Complainant in its Complaint in detail and to satisfy itself if the conditions under the policy stand satisfied.

- 6.6 The Respondent has not filed its reply or any documentary evidence in response to the averments made in the complaint. The averments made in the complaint remain unrebutted and unchallenged. There is no dispute raised to the authenticity of the documents filed by the Complainant.
- 6.7 The onus of proof is on the Complainant. As the proceedings are of a civil nature, the standard of proof is on the balance of probabilities. The material facts pleaded in the Complaint concerning the Complainant's legitimate right, interest and title in the trade mark, trade name and domain name **<WWW.STANLEYBLACKANDDECKER.CO.IN>** and the reputation accrued thereto have neither been dealt with nor disputed or specifically denied by the Respondent. The Respondent has not also denied the correctness and genuineness of any of the Annexures/Exhibits filed by the Complainant along with the Complaint.
- 6.8 Under the provisions of Order 8 Rule 5 of the Code of Civil Procedure, 1908 the material facts as are not specifically denied are deemed to be admitted.
- 6.9 The decision of Hon'ble Supreme Court of India in the matter of **Jahuri Sah Vs. Dwarika Prasad** – AIR 1967 SC 109, be referred to. The facts as are admitted expressly or by legal fiction require no formal proof. (See Section 58 of the Indian Evidence Act, 1872).



6.10 The Panel therefore accepts the case set up and the evidence filed by the Complainant and concludes that the same stand deemed admitted and proved in accordance with law.

6.11 Paragraph 10 of the Policy provides that the remedies available to the Complainant pursuant to any proceedings before an arbitration panel shall be limited to the cancellation or transfer of domain name registration to the Complainant.

6.12 Paragraph 4 of the Policy lists three elements that the Complainant must prove to merit a finding that the domain name of the Respondent to be transferred to the Complainant or cancelled:

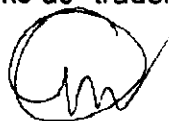
A. IDENTICAL OR CONFUSINGLY SIMILAR

6A.1 The Complainant contends that the Registrant's Domain Name is identical or confusingly similar to a trade mark in which the Complainant has rights.

6A.2 The Respondent registered the Disputed Domain Name on March 17, 2010.

6A.3 The dominant and distinctive feature of the Disputed Domain Name is the incorporation of the Complainant's trade marks, as it is.

6A.4 At the time Respondent registered the Disputed Domain Name STANLEY and BLACK & DECKER, the Complainant had already been using its STANLEY and BLACK & DECKER marks as trademarks and domain

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name and had firmly established rights in the said mark. Furthermore, at the time the Respondent registered the Disputed Domain name, the Complainant's STANLEY and BLACK & DECKER trade marks had acquired the status of well-known marks. The Respondents have not claimed or shown any right to the Disputed Domain Name that are superior to Complainant's rights in its STANLEY and BLACK & DECKER marks, as evidenced by Complainant's prior and well-known use of the marks and registrations thereof. Nor can the Respondents demonstrate that it was unaware of Complainant's Marks at the time the Disputed Domain Name was registered.

6A.5 The Complainant is the registered proprietor of the trade marks STANLEY and BLACK & DECKER, in India and various other countries. The Complainant's trade marks and domain name were used and applied for registration long before the Respondents No.1 & 2's registration of the Disputed Domain Name.

6A.6 The Complainant's use of their well-known and prior trade marks has been extensive, exclusive and continuous all across the world. Given the nature of the Complainant's use of its trade marks, anyone with access to a computer and the Internet, has access to the Complainant's web site wherein the Complainant's trademarks are featured throughout this web site.

6A.7 The Complainant maintains a website at the domain www.stanleyblackanddecker.com.

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6A.8 In India, the trademarks have been in use since the year 1920. Not only have the trade marks STANLEY and BLACK & DECKER been widely used in India, it has also been widely advertised and publicized in India. By virtue of such extensive sales and sales promotion activities in India as well as worldwide, the earlier trade marks of the Complainant have a very high recall value and are extremely well-known to Indian consumers and are famous brands in India. The Complainant has a chain of company owned stores in various cities in India and its products are sold through these stores, not only this the Complainant also has an extensive network of service and support centers in India that provides host of facilities to its retail and corporate customers in India.

6A.9 The trade marks STANLEY and BLACK & DECKER have been extensively advertised and promoted on the internet *inter alia* through the Complainant's website www.stanleyblackanddecker.com. The said website contains extensive information about the Complainant and the products marketed and sold under the trade marks STANLEY and BLACK & DECKER. This information is accessible by any person from anywhere in the world.

6A.10 The Respondent has not disputed any contentions raised by the Complainant in the Complaint. The Panel also finds and holds that the disputed Domain Name <WWW.STANLEYBLACKANDDECKER.CO.IN> is identical and/or deceptively similar to the earlier registered trade marks and Domain names of the Complainant. The whole of Complainant's trade mark /domain name has been incorporated in the disputed



domain name and there is bound to be confusion and deception in the course of trade by the use of disputed domain name. Therefore, the Complainant has been successful in proving that the domain name <WWW.STANLEYBLACKANDDECKER.CO.IN> is identical and/or confusingly similar to the trademarks STANLEY and BLACK & DECKER of the Complainant.

B Registered and used in Bad Faith

6B. The Respondents have no interest or legitimate right with respect to the Disputed Domain Name.

6B.1 The Complainant through its counsel in India, M/s. Lall & Sethi Advocates served a Cease and Desist notice on the Respondent No.1 through email at admin@domainbroker.tw. The Respondent No.1 replied to it stating that they will transfer the domain and will not be registering the domain containing trade marks STANLEY and BLACK & DECKER in future only if they get a 'reasonable compensation'. However the Complainant refused to pay any illegal compensation to the Respondent No.1 instead offered to pay only towards the cost of registration of the domain. Since the Respondent No.1 didn't accept the offer of the Complainant and demanded a compensation of USD 1500, the Complainant decided to proceed with present INDRP complaint. While preparing for the INDRP complaint this came to attention of Complainant's counsel that the registrant details of the domain in question has been changed and now the same is owned by Respondent No.2. As the cease and desist notice was served on the Respondent No.1 this sudden



change of name in the registrant including change of country from China to United States of America was seen by the Complainant as an effort to nullify the effect of the cease and desist notice.

6B.2 Since the Complainant's Marks are well-known and Respondents No.1 and No.2 have no rights in these marks, the only reason Respondents could have wanted to register a domain name that so prominently features the Complainant's STANLEY and BLACK & DECKER marks was with the intention to trade upon the fame of the Complainant's marks by selling the Disputed Domain Name for substantial commercial gain, in violation of Section 4(b) of the Policy.

6B.3 In light of the foregoing, Internet users are likely to believe that the Disputed Domain Name is related to, associated with, or authorized by the Complainant. Considering the Complainant already uses sites such as www.stanleyblackanddecker.com, the internet users would be confused into thinking that the Respondents No.1 and/or No.2 enjoy authorization of the Complainant to do business in India or is in fact their Indian website considering that the country code top-level domain name in the disputed domain name is "CO.IN"

6B.4 The Respondent did not dispute any of the contentions raised by the Complainant in its Complaint. The case set up by the Complainant is deemed to be admitted as not disputed by the Respondent. The Panel also finds, on the basis of



the material available on record, that the respondent has no legitimate right or interest in the disputed domain name. The respondent has failed to show any justification for the adoption, use or registration of disputed domain name.

6B.5 The Panel, therefore holds that the circumstances listed above demonstrate rights or legitimate interests of the Complainant in the domain name **<WWW.STANLEYBLACKANDDECKER.CO.IN>** and holds that Respondent has infringed the rights of the Complainant by registering the Domain Name and has no legitimate right or interest therein.

C Registered and used in Bad Faith

6C.1 For a Complainant to succeed, the Panel must be satisfied that a domain name has been registered and is being used in bad faith.

6C.2 Paragraph 6 of the Policy states circumstances which, if found shall be evidence of the registration and use of a domain name in bad faith:

6C.3 The bad faith in registering the impugned domain is apparent from the fact that Respondent No.1 in reply to the notice sent to them demanded compensation to the tune of USD 1500 for the transfer of domain which was of course refused by the Complainant for obvious reasons. The intention of the Respondents in registering the Disputed Domain was to make monetary gain out of it by selling it to the Complainant or to a third party for an exorbitant sum thus prejudicing the rights of the Complainant.



6C.4 Given the fame of the Complainant's Marks as a trademark and domain name, it is not possible to conceive of a use by Respondents No.1 and/or No.2 of the Disputed Domain Name that would not constitute an infringement of Complainant's rights in its Trade Marks.

6C.5 The Complainant relies upon the decision of WIPO Case No. D2000-1016 titled Playboy Enterprises International, Inc. Vs. Hector Rodriguez. "People, who manifest an intent to traffic in domain names that incorporate well-known or famous trademarks, as the Respondents do here, simply do not expand their efforts with the sole intention of relinquishing those domain names for just their out-of-pocket registration costs. The goal of their efforts, simply put, is an expectation of receiving an adequate reward, i.e. sufficient profit, from this trafficking." transfer awarded. The Complainant submits that bad faith use of the Disputed Domain Name is quite clear in this case, given the content on the Respondent's web site and his intent to sell the Disputed Domain Name to the highest bidder.

6C.6 The Respondents do not dispute any of the contentions raised by the Complainant. The facts and circumstances explained in the complaint coupled with the material on record clearly demonstrate that the domain name <WWW.STANLEYBLACKANDDECKER.CO.IN> was registered by the respondents in bad faith and to attract the internet users, through disputed domain, to the website of the competitor.

6C.7 The panel accepts the contentions of the Complainant as have been raised by them and holds that the registration




of the domain name on part of the Respondent is in bad faith.

7. **DECISION**

In view of the fact that all the elements of Paragraphs 6 and 7 of the policy have been satisfied and in the facts and circumstances of the case, the panel directs the

A. Transfer of the domain name **WWW.STANLEYBLACKANDDECKER.CO.IN** to the Complainant.

B. Respondent to pay to the Complainant cost of Rs.25,000/- in the above proceedings.


AMARJIT SINGH
Sole Arbitrator

Dated: June 1, 2012