



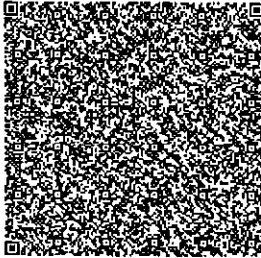
सत्यमेव जयते

## INDIA NON JUDICIAL

Government of National Capital Territory of Delhi

### e-Stamp

Certificate No. : IN-DL40495325607707P  
Certificate Issued Date : 21-Jan-2017 01:27 PM  
Account Reference : IMPACC (IV)/ dl889403/ DELHI/ DL-DLH  
Unique Doc. Reference : SUBIN-DL DL88940381479394107830P  
Purchased by : V K AGARWAL  
Description of Document : Article 12 Award  
Property Description : Not Applicable  
Consideration Price (Rs.) : 0  
(Zero)  
First Party : V K AGARWAL  
Second Party : Not Applicable  
Stamp Duty Paid By : V K AGARWAL  
Stamp Duty Amount(Rs.) : 10  
(Ten only)



Please write or type below this line.

**NATIONAL INTERNET EXCHANGE OF INDIA**  
Flat No. 6B, 6<sup>th</sup> Floor, Uppals M6 Plaza,  
Jasola District Centre,  
New Delhi – 110 025

M/s Marks & Spencer PLC, v. Deborah R. Heacock

*V K Agarwal*

## AWARD

### 1. The Parties

The Complainant is M/s Marks & Spencer PLC, Waterside House, 35, North Wharf Road, London W2 1NW, United Kingdom.

The Respondent is Deborah R. Heacock , 1256 Horizon Circle, Seattle, WA 98119, United States of America.

### 2. The Domain Name and Registrar

The disputed domain name is <www.MarksandSpencer.co .in>. The said domain name is registered with Dynadot, P. O. Box 345, San Mateo CA 94401, United States of America. (info@dynadot.com)

The details of the disputed domain name, as mentioned in Exhibit B – 1 to the Complaint, are as follows:

|                      |                                  |
|----------------------|----------------------------------|
| (a) Domain ID        | : D5440851-AFIN                  |
| (b) Date of creation | : 01 <sup>st</sup> November 2011 |
| (c) Expiry date      | : 01 <sup>st</sup> November 2017 |

### 3. Procedural History

(a) A Complaint dated November 23, 2016 has been filed with the National Internet Exchange of India. The Complainant has made the registrar verification in connection with the domain name at issue. The print outs so received are attached with the Complaint. It is confirmed that the Respondent is listed as the registrant and provided the contact details for the administrative, billing, and technical contact. The Exchange verified that the Complaint satisfied the formal requirements of the Indian Domain Name Dispute Resolution Policy (INDRP) (the “Policy”) and the Rules framed thereunder.

(b) The Exchange appointed Dr. Vinod K. Agarwal, Advocate and former Law Secretary to the Government of India as the sole arbitrator in this matter and the Complaint was received by the Sole Arbitrator on December 29, 2016. The arbitrator finds that he was properly appointed. The Arbitrator has

*Vinod K. Agarwal*

submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Exchange.

- (c) In accordance with the Indian Domain Name Dispute Resolution Rules, National Internet Exchange of India notified the Respondent along with a copy of the Complaint through post (courier) on the address mentioned in the Complaint and the WHOIS record. The Respondent was required to convey his response to the Complaint within 15 days from the date of receipt of the said letter. The Respondent was informed that if his response was not received by that date, the Respondent would be considered in default and the Arbitrator would still proceed to decide the dispute.
- (d) However, the postal authorities (courier service provider) returned the letter with the observation that the address is incomplete and the addressee was not found on the given address. Hence, no response was received from the Respondents and the case has to proceed ex-parte.

#### **4. Factual Background**


From the Complaint and the various annexure to it, the Arbitrator has found the following facts:

##### **Complainant's activities**

The Complainant is a company existing under the corporate laws of the United Kingdom.

The Complainant contends that, since its foundation in the year 1884, the Complainant is managing and running retail stores offering various products, such as, men's and women's apparel, cosmetics, perfumes, coffee, tea, sugar, flour, rice, spices, food and wine, furniture and home goods, computers, telephones and accessories, and many other products.

According to the Complaint, the Complainant now has more than 1380 locations in over 59 countries in the world operating under the MARKS AND SPENCE trademarks, including 58 outlets across 27 different cities in India.



## **Respondent's Identity and Activities**

The Respondent has not submitted any response to the Complaint. Hence, the Respondent's activities are not known.

### **5. Parties Contentions**

#### **A. Complainant**

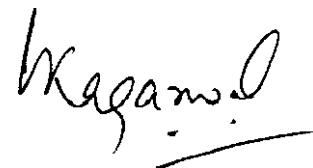
The Complainant contends that each of the elements specified in the Policy are applicable to this dispute.

In relation to element (i), the Complainant has adopted MARKS AND SPENCER as trade name as well as trademark long time back. Further that, the Complainant has been continuously and extensively using the "MARKS AND SPENCER" as trade name, trademark, corporate name, business name, trading style, etc. The Complainant has registered the trademark "MARKS AND SPENCER" long prior to the creation date of the disputed domain name "MarksandSpencer.co.in" by the Respondent.

The trademark "MARKS AND SPENCER" of the Complainant is registered in many countries such as Albania, Azerbaijan, Bosnia and Herzegovina, Egypt, Georgia, Islamic Republic of Iran, Japan, Kyrgyzstan, Liechtenstein, Monaco, Oman, Republic of Moldova, Serbia, Tajikistan, Turkmenistan, United Kingdom, and United States of America in various classes. In India, the said trademark was initially registered on 27<sup>th</sup> March 1996 vide Registration No. 703488 in Classes 25 and 35.

The Respondent has registered the disputed domain name <MarksandSpencer.co.in> purposely with the motive or intention of obstructing the business of the Complainant, to obfuscate clients, prospective clients and other internet users and to cause negative impact on the reputation of the Complainant.

It is further contended that in recent times, the domain name has become a business identifier. A domain name helps identify the subject of trade or service that an entity seeks to provide to its potential customers. Further that, there is a strong likelihood that a web browser looking for Marks and Spencer products in India or elsewhere would mistake the





*Xiantao*, Case No. INDRP/796 dated 06<sup>th</sup> June 2016; *DD IP Holder LLC v. Manpreet Badhwar*, Claim No. FA 1562029 (FOURM 2015) and *TV Sundaram Iyengar and Sons Private Limited v. Rohit Kumar*, INDRP/792 dated 19<sup>th</sup> July 2016.

Regarding the element at (iii), the Complainant contends that the Respondent made an attempt to sell the <MarksandSpencer.co.in> domain to the Complainant. Various pages of the domain (Exhibit F) contain the message “marksandspencer.co.in” is for sale. It is expressly set out in the Policy that offering to sell an infringing domain to a brand owner for a price in far excess of the registration cost displays Respondent’s bad faith. The Complainant has also indicated a number of cases of a similar nature involving different domain names against the Respondents.

Further that the main object of registering the domain name <MarksandSpencer.co.in> by the Respondent/Registrant is to mislead the general public and the customers of the Complainant. The Complainant has stated that the use of a domain name that appropriates a well-known trademark to promote competing or infringing products cannot be considered a “*bona fide offering of goods and services*”.

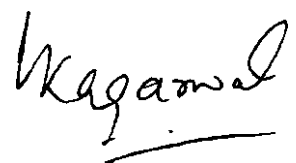
In support of its contentions, the Complainant has relied on the decisions in the cases of *General Motors India Private limited and General Motors LLC v. Anish Sharma*, Case No. INDRP/799 dated 02<sup>nd</sup> June 2016; *Vedant Fashions Pct. Ltd. v. Ravi*; *Bearing Point IP Holdings B.V. v. GaoGou of TERECT*, Case No. INDRP/823 dated 11<sup>th</sup> October 2016 wherein it has been held that it is a bad faith where the respondent informed the Complainant that the “domain name is up for sale by way of bidding”.

## **B. Respondent**

The Respondent has not submitted any response. Hence, the Respondent’s contentions are not known.

## **6. Discussion and Findings**

The Rules instructs this arbitrator as to the principles to be used or adopted



in rendering its decision. It says that, “a panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, the Arbitration and Conciliation Act, 1996, the Rules and any rules and principles of law that it deems applicable”.

According to the Policy, the Complainant must prove that:

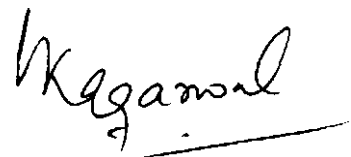
- (i) The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) The Respondent has no rights or legitimate interests in respect of the domain name that is the subject of Complaint; and
- (iii) The domain name in question has been registered and is being used in bad faith and for the purposes of trafficking;

***A. Identical or Confusingly Similar***

As per the whois information, the Respondent has created the disputed domain name <MarksandSpencer.co.in> on November 01, 2011. It will expire on November 01, 2017 unless permitted to extend it further. The present Complaint has been filed after almost 5 years from the date of creation of the disputed domain name. It is not known as to why the Complaint was not filed earlier by the Complainant.

According to the information submitted by the Complainant, the Complainant is the owner of trademark MARKS AND SPENCER. The trademark MARKS AND SPENCER is registered in many countries.

The present dispute pertains to the domain name <MarksandSpencer.co.in>. The Complainant possesses a number of other domain names with the word “Marks and Spencer”. The Complainant is also the owner of trademark “MARKS AND SPENCER” in many countries of the world. Most of these domain names and the trademarks have been created by the Complainant much before the date of creation of the disputed domain name by the Registrant/Respondent. The disputed domain name is very much similar or identical to other domain names and the trademark of the Complainant.

  
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Therefore, I hold that the domain name <MarksandSpencer.co.in> is confusingly similar or identical to the Complainant's trademarks.

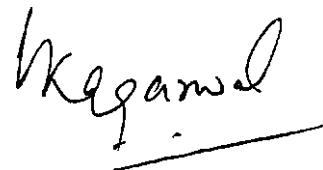
***B. Rights or Legitimate Interests***

The Respondent may demonstrate its rights to or legitimate interest in the domain name by proving any of the following circumstances:

- (i) before any notice to the Respondent of the dispute, the Respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the Respondent (as an individual, business or other organization) has been commonly known by the domain name, even if the Respondent has acquired no trademark or service mark rights; or
- (iii) The Respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent's response is not available in this case. There is no evidence to suggest that the Respondent has become known by the disputed domain name anywhere in the world. The name of the Complainant is Marks And Spencer PLC. The Respondent is known by the name of Deborah R. Heacock. It is evident that the Respondent can have no legitimate interest in the aforesaid disputed domain name. Further, the Complainant has not assigned, licensed, sold, transferred or in any way authorized or otherwise permitted the Respondent to use its name or trademark or to apply for or use the domain name incorporating said name and/or mark. Further, the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name.

Based on the evidence adduced by the Complainant, it is concluded that the above circumstances do not exist in this case and that the Respondent has no rights or legitimate interests in the disputed domain name.

  
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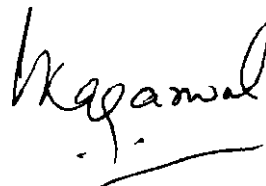
### ***C. Registered and Used in Bad Faith***

Any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration or use of the domain name in bad faith:

- (i) Circumstances indicating that the Respondent has registered or 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 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 it 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 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 the Respondent's website or location or of a product or service on its website or location.

The contention of the Complainant is that the present case is covered by the above circumstances. The Respondent has intentionally attempted to attract, for commercial gain, internet users to the disputed website by creating a likelihood of confusion with the Complainant's mark. The Respondent was aware of the Complainant's registration of the trademark "Marks and Spencer"

Further that the Respondent registered or acquired the disputed domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the owner of the trademark or service mark (normally the Complainant or other interested buyers) for valuable

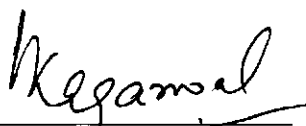
A handwritten signature in black ink, appearing to read "K. K. K. K. K." with a horizontal line underneath.

consideration in excess of the Respondent's out-of-pocket costs directly related to the domain name. Exhibit F attached to the Complaint indicates that the disputed domain name [MarksandSpencer.co.in] is available for sale.

The complete address of the Registrant/Respondent could not be found. Further, there is no response on the e-mail address mentioned in the WHOIS record. The foregoing circumstances lead to the conclusion that the domain name in dispute was registered and used by the Respondent in bad faith.

## 7. Decision

In light of the foregoing findings, namely, that the domain name is confusingly similar to the mark in which the Complainant has rights, that the Respondent has no rights or legitimate interests in respect of the domain name, and that the domain name was registered in bad faith and is being used in bad faith in accordance with the Policy and the Rules, the Arbitrator orders that the domain name <www.MarksandSpencer.co.in> be transferred to the Complainant.



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Vinod K. Agarwal

Sole Arbitrator

**Date:** 25<sup>th</sup> January 2017