

Bond



**Indian-Non Judicial Stamp  
Haryana Government**



Date :29/08/2018

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Penalty : ₹ 0  
(Rs. Zero Only)

**Deponent**

Name: Rna Ip Attorneys

H.No/Floor : Na

Sector/Ward : Na

Landmark : Na

City/Village : Gurugram

District : Gurugram

State : Haryana

Phone : 0

Purpose : ALL PURPOSE to be submitted at Other



**RANJAN NARULA**

**ARBITRATOR**

Appointed by the .In Registry – National Internet Exchange of India

In the matter of:

**PRET A MANGER (EUROPE)**

75 B Verde, 10 Bressenden Place, London,  
SW1E 5DH, United kingdom

....Complainant

**Sudeep Gupta**

A-23, Sector 83, Noida,  
Gautam Buddha Nagar,  
Uttar Pradesh-201305,  
India.

..... Respondent

Disputed Domain Name: <PRETAMANGER.IN>

## **AWARD**

### **1) The Parties:**

The Complainant in this arbitration proceeding is **PRET A MANGER (EUROPE)** 75 B Verde, 10 Bressenden Place, London, SW1E 5DH, United Kingdom. The Complainant is represented by its authorized representative Mr. Srijoy Das & Mr. Bidyut Tamuly, Archer & Angel, K-4, South Extension -II, New Delhi-110049, India.

The Respondent in this arbitration proceeding is **Sudeep Gupta** A-23, Sector 83, Noida, Gautam Buddha Nagar, Uttar Pradesh-201305, India as per the details available in the whois database maintained by National Internet Exchange of India (NIXI).

### **2) The Domain Name, Registrar & Registrant:**

The disputed domain name is **Pretamanger.in** The Registrar is GODaddy.com, LLC, 14455 North Hayden Rd, Suite 226, Scottsdale AZ 85260-6993, United States.

The Registrant is Mr. Sudeep Gupta A-23, Sector 83, Noida, Gautam Buddha Nagar, Uttar Pradesh-201305, India

### **3) Procedural History: :**

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 28<sup>th</sup> 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.

As per the information received from NIXI, the history of the proceedings is as follows:

In accordance with the Rules 2(a) and 4(a), NIXI formally notified the Respondent of the Complaint and appointed Ranjan Narula as the Sole Arbitrator (hereinafter Arbitrator) for adjudicating upon the dispute in accordance with the Arbitration and Conciliation Act, 1996, and the Rules framed thereunder, .IN Domain 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 Complaint is dated September 04, 2018. The Arbitrator's consent was sought on 11<sup>th</sup> September, 2018 and complaint with Annexures was provided on 24<sup>th</sup> September, 2018. The parties were notified of complaint on 25<sup>th</sup> September, 2018 providing Respondent 10 days time until 5<sup>th</sup> October, 2018 to file its response. On 3<sup>rd</sup> October, 2018 an email was received from Ms Priyadarshini Verma, Advocate of KPS Associates representing the Respondent seeking 10 days extension to file its response. The Arbitrator granted Respondent time until 10<sup>th</sup> October, 2018 to file their response. Response was filed by the Respondent on 10<sup>th</sup> October. On 11<sup>th</sup> October, the Complainant sought time to file its rejoinder which was permitted and time granted until 16<sup>th</sup> October, 2018. The Complainant submitted its rejoinder on 15<sup>th</sup> October. The Arbitrator notified the party that pleadings are completed and the order will be pronounced in due course.

Since, both the parties have filed their respective submissions/ contentions; the Arbitrator is proceeding to decide the present dispute based on submissions and documents filed by the parties.

#### **4). Summary Of The Complainant's Contentions In The Complaint**

1. That the Complainant is an international chain of restaurants offering natural food common to so much of the prepared and fast food on the market since 1986, started its journey from London and since the opening of that store the Complainant gained immense goodwill across the world. The word **PRET A MANGER** forms an integral part of the company name of the Complainant i.e., **PRET A MANGER (EUROPE) LTD.**
2. The Complainant has secured statutory rights in its trademark **PRET A MANGER** around the world including classes 16, 29,30,32,35,39,43 details of which are:
  - a) PRET A MANGER on bar logo (Indian Registration- 824778) in class 30
  - b) PRET A MANGER on bar logo (Indian Registration – 844536) in class 16
  - c) PRET A MANGER on bar logo (Australian Registration- 1408237) in classes 29,30,32,39,43
  - d) PRET A MANGER (China Registration – 957858) in class 43 and many more.

The **PRET A MANGER** Trademarks have been registered and associated with the Complainant and its predecessors since 1986 and in India the earliest of such registrations is of the year 1998. A list of Trademark **PRET A MANGER** claimed to be owned by Complainant have been attached with the Complaint marked as ANNEXURE-6.

3. That in addition to the trademark registrations for the mark **PRET A MANGER**, the Complainant own several Top level generic domain names <pretamanger.com> and <pret-a-manger.com> since 1996. Moreover, in



addition to these domain names the Complainant also owns other top level and country specific domain names, namely :

Applytopret.com,  
prêt.cn,  
prêt.co.uk,  
pre.la,  
pretamanger.cl,  
pretamanger.com,  
pretamanger.it,  
pretamanger.co.in  
and many more.

A list of domain names claimed to be owned by Complainant have been attached to the Complaint marked as ANNEXURE-8.

4. That the Complainant is also operating its website [www.pret.com](http://www.pret.com) which is accessible throughout the world. It is pertinent to take a note here that Complainant's websites prominently displays the trademark PRET, in a stylized manner thereby leading its display and presence to all the consumers accessing and visiting the said website from across the world.
5. That the mark **PRET A MANGER enjoys** presence over Youtube, Facebook, Twitter, LinkedIn and Pinterest. And the recognition of the Complainant augments even by the fact that that a general search of the word **PRET A MANGER** on the Google leads to the Complainant websites.
6. That the Complainant has extensively promoted and advertised its name **PRET A MANGER** and has incurred the expenditure in millions every year. And due to worldwide advertisement and promotions, Complainant has managed to gather trans- border reputation over the mark **PRET A MANGER.**
7. In addition to trans-border reputation, Complainant is also vigilant in enforcing its intellectual property rights in the trademark **PRET A MANGER** by taking enforcement actions in several countries and has cited the following actions:
  - Successful appeal in relation to opposition to EUTM application No. 13013506
  - Successful opposition to EUTM application No. 001576332
  - Successful opposition to EUTM application No. 004366316

And many more.

##### **5). Summary Of The Registrant's/Respondent's Response**

The Respondent filed its response to the Complaint filed by the Complainant. The Respondent's allegations are summarized as below:



1. That the website is only restricted to India, whereas Complainant website is restricted to UK and other countries only and does not own or operate any business in India and there is no brand visibility in India.
2. That the Respondent is a Director of M/s Café Buddy's Foods Pvt. Ltd which is based on ready to eat "on the go" concept and have vast presence in India with unmatched services.
3. That the company Café Buddy's was accredited with the award for the fastest growing Food Retail chain in India by The Big Brands Research in the year 2011.
4. That the the word " Pret E Manger" means ready to eat in French Language and is a dictionary and generic term therefore, Respondent being in Food Chain Industry in India got the domain name registered. That the Respondent has been in the food industry for the past 13 years, and had registered the domain name in good faith and since Complainant does not operate in India, there is no basis for the Complaint and Complaint being baseless and devoid of any merit is liable to dismissed.

#### 6). Rejoinder filed by the Complainant

The Complainant filed the Rejoinder to the Respondent's reply on October 15, 2018. The key contentions raised by the Complainant in the Rejoinder are:

1. That the complainant's websites/blog, social media accounts and online news articles are accessible throughout the world where there is access to internet, including in India.
2. That the Complainant's mark **PRET A MANGER** is registered in various jurisdictions across the world without facing any major objections in relation to their alleged descriptive nature thus **PRET A MANGER** cannot be considered as a generic word.
3. That the evidences adduced by the Respondent were in relation to the company "CAFÉ BUDDY FOODS PRIVATE LIMITED" thus the documents does not support the reason behind the adoption of the Disputed Domain name <Pretamanger.in>.
4. That due to immense trademark registrations and domain names worldwide for **PRET A MANGER**, the said mark has obtained well known mark status and relevant Indian laws precludes the proprietors of well known marks from initiating action against those violating its rights, regardless of "actual/ physical usage. In furtherance, Complainant placed reliance on Indian trademark registration of **PRET A MANGER**, and social media accounts and online news articles, for proving accessibility in India.
5. That using the registered well known mark as a domain name by the Respondent shows bad faith and intention of the Respondent to ride upon the goodwill created by the Complainant. Furthermore, Complainant has neither granted license nor assigned or in any way authorized them to register or



make use of its registered trademarks PRET and PRET A MANGER and yet the disputed domain name was maliciously registered.

## **7). DISCUSSIONS AND FINDINGS**

Paragraphs 12(a) of the rules provide that the Arbitrator shall decide the Complaint on the basis of the statements and documents submitted in accordance with the Arbitration and Conciliation Act, 1996 and .in Dispute Resolution Policy.

Having perused the submissions and documentary evidence placed on the record, the arbitrator is inclined to agree that the Complainant has established better and prior rights in the mark **PRET A MANGER**. Further the arbitrator is of the view that Complainant has satisfied all the three conditions outlined in the paragraph 4 of the policy as detailed below

- a. The domain name is identical or confusingly similar to the trade mark **PRET A MANGER** in which the Complainant has the rights:
- b. The Registrant has no rights or legitimate interest in the domain name;
- c. The Registrant's domain name is registered or used in bad faith ;

The Arbitrator holds the view for the reasons discussed below:

### **A. The Domain Is Identical/Confusingly Similar To The Trademark Pret A Manger In Which The Complainant Has The Rights**

The Complainant is prior in adoption and in use of the trade mark **PRET A MANGER**. The Complainant for more than 30 years has been engaged in the food service using the mark **PRET A MANGER**. The aforesaid also forms an integral part of the websites which are in operation since the inception of the business of the Complainant . The Complainant's website can be accessed all over the world including by consumers based in India. The mark **PRET A MANGER** and website forming integral part of the name **PRET A MANGER has been in use** all over the world since 1986. Even in India, the Complainant has registered the mark PRET A MANGER on bar logo (Indian Registration- 824778) in class 30, PRET A MANGER on bar logo (Indian Registration - 844536) in class 16 since 1998. Thus the Complainant has successfully demonstrated its rights in the mark **PRET A MANGER**.

On the other hand documents and evidence on record shows that the Respondent had adopted the domain name not earlier than May, 2018. Further a bare perusal of the evidence adduced the Respondent it is clear that all the documents and evidence are in relation to the company "CAFÉ BUDDY FOODS PRIVATE LIMITED". Thus the documents does not support the reason behind the adoption of the Disputed Domain name < Pretamanger.in>. The arbitrator is of the view that Respondent has failed to provide any plausible

reason for adoption of the domain name PRET A MANGER which is identical/similar to the Complainant's registered trade mark PRET A MANGER. The only reason given by the Respondent is that he is of Indian origin and he wishes to promote the Indian food which is not a sufficient reason in my view to explain bona fide adoption of the disputed domain name. It may also be mentioned that the Respondent in its response has mentioned the Complainant name and mark as PRET E MANGER and in some places as PRET A MANGER which further signifies the mark being of foreign origin and not of common usage, the Respondent is himself not clear about the exact brand name or its use as domain name.

The Respondent has also challenged the Complainant's right in the domain name with .in extension by contending that their business does not have operation in India. The arbitrator does not find merit in this argument and hold that there is no bar against a third party from registering a ".in" domain name on the ground that the party is not of Indian origin or because their business is based out of India.

Further, the Respondent has also made the claim that the word "Pret E Manger" means ready to eat in French Language and is a dictionary and generic term. The Arbitrator does not agree with this reasoning, as there is no material on record to show the term has become generic and commonly used to indicate 'ready to eat' food. Further the word "Pret A Manger" is a registered mark in India.

In view, of forgoing arguments and documents placed on record, it can be concluded that the domain name is identical / confusingly similar to the Complainant's registered mark 'Pret A Manger' and the Complainant has better rights in the domain name.

**B. The Registrant has no rights or legitimate interests in respect of the domain name**

According to the policy, the following circumstances , in particular but without limitation, shall demonstrate the Registrant's right to or legitimate interests in the domain name for the purpose of para 5(ii):

- I. *"before any notice to you of the dispute, your 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"*

In this case the Respondent has registered the disputed domain name in the month of May, 2018 which is much later to when the Complainant had adopted and used the mark **PRET A MANGER** in respect of similar services since the year 1986. There is no evidence to

suggest that the Complainant has authorized the Respondent to use the disputed domain name. For the reasons already mentioned in preceding paragraphs, the Arbitrator holds that the Respondent has not offered any plausible reason or justification for the registration of the domain name. In fact being in the food industry it can be presumed that the Respondent must have known about use and reputation of the mark PRET A MANGER at the time of registration of the domain name.

- II. *Registrant (as an individual, business, or other organization) have been commonly known by the domain name, even if Registrant have acquired no trademark or service mark rights; or*

The Respondent's name is Sudeep Gupta . There is no evidence to suggest that the Respondent at any time has been commonly known by the name PRET A MANGER. Further there is no evidence to show that the term is commonly used by other traders in India or elsewhere.

- III. *Registrant 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.*

For the reasons mentioned in the preceding paragraphs, the Arbitrator is of the view that the Respondent is not making a legitimate non-commercial or fair use of the domain name. The said domain name currently resolves to a parked page with links to third party's business. This cannot be termed as noncommercial or fair use of the domain name

Based on the submissions/ evidence the Arbitrator finds that the Respondent has not satisfied any of the condition laid down by the policy to establish their rights or legitimate interest in the domain name.

C. **The registrant's domain name has registered or used in bad faith**

According to the policy, the following circumstances , in particular but without limitation, shall demonstrate the registration and use of the domain name in the bad faith:

*" by using the domain name, Registrant has intentionally attempted to attract, for commercial gain, Internet users to Registrant's web site 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 Registrant's web site or location or of a product or service on your web site or location."*



As mentioned earlier, the Registrant's domain name is currently parked with links to third party websites. By registration and attempted use of the Complainant's mark PRET A MANGER, the Respondent has tried to attract the internet users to its website. Given the identity of the marks/domain name, the Arbitrator finds that there is likelihood that the internet users will get confused as to the source. The Complainant being prior user and adopter of the domain name, the use of an identical domain name in the food business by the Respondent will cause confusion.

The aforesaid circumstances, suggests bad faith registration and use of the domain name by the Registrant.

**8). Decision:**

For all the reasons discussed above, the arbitrator orders that the domain name <PRETAMANGER.IN> be transferred to the Complainant.



**RANJAN NARULA**  
**SOLE ARBITRATOR**  
**NIXI**  
**INDIA**

**October 24, 2018**