

ADMINISTRATIVE PANEL DECISION

Khadi & Village Industries Commission v. Om Soft Solution
Case No. D2021-1373

1. The Parties

The Complainant is Khadi & Village Industries Commission, India, represented by Fidus Law Chambers, India.

The Respondent is Om Soft Solution, India, represented by Arun Thapa, India.

2. The Domain Name and Registrar

The disputed domain name <urbankhadiclub.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 4, 2021. On May 4, 2021, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 5, 2021, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the disputed domain name. In response to a notification by the Center that the Complaint was administratively deficient, the Complainant filed an amended Complaint on May 11, 2021.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on May 14, 2021. In accordance with the Rules, paragraph 5, the due date for Response was June 3, 2021. The Response was filed with the Center on May 25, 2021.

The Center appointed Dr. Vinod K. Agarwal, Advocate as the sole panelist in this matter on June 10, 2021. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a statutory body formed in April 1957 by the Government of India under the Act of Parliament, namely, "Khadi and Village Industries Commission Act, 1956. The Head Office of the Complainant is in Mumbai and its six zonal offices in different parts of the country. The main function of the Complainant is to promote products under the trademark KHADI. The Complainant owns several KHADI trademarks, such as Indian trademark registration no. 2851524, registered on November 27, 2014. In addition, the Complainant plans, promotes, organizes, and implements programs for the development of KHADI and other village industries in rural areas nationwide.

The Complainant's products bearing the trademarks KHADI are sold and showcased through exhibitions in various parts of the world. The Complainant has participated in several exhibitions and fairs to promote products and services under the KHADI trademarks and to encourage artisans, spinners and weavers of India. Images from exhibitions, fairs, and other expos where the Complainant's KHADI trademarks have been prominently displayed and promoted are enclosed as Annexure K.

The only information available about the Respondent is that the Respondent is a website designing and software development company based in Delhi, India.

5. Parties' Contentions

A. Complainant

The Complainant contends that each of the three elements specified in paragraph 4(a) of the Policy are applicable to the present dispute.

In relation to element (i), the Complainant contends that the disputed domain name <urbankhadiclub.com> incorporates the Complainant's trademark KHADI, in which the Complainant has statutory as well as common law rights by virtue of long and continuous use. As per the Act of Parliament of India the word "khadi" is also a part of name of the Complainant.

The words "khadi" and "khadu india" are the registered trademarks of the Complainant. The said trademarks of the Complainant are registered in various jurisdictions for a very long time. A consolidated list of all registered trademarks along with copies of the registration certificates are attached with the Complaint as Annexure F. All of the registrations are currently valid and subsisting. The said trademarks are registered in different classes and the earliest valid registration dates back to the year 1975.

By virtue of prior adoption, long and continuous use and extensive publicity and promotion, the trade name and trademark KHADI have acquired tremendous goodwill and enviable reputation worldwide amongst the consumers and public in general. Thus, they are associated by the business houses and public exclusively with the Complainant and their businesses, services and products.

The registration of the disputed domain name <urbankhadiclub.com> by the Respondent is confusing inasmuch as it causes the public to believe that the Respondent is associated with the Complainant and also violates the Complainant's trademark rights in the KHADI trademark. Thus, the intention of the Respondent is to create confusion in the market and business circles.

In relation to element (ii), the Complainant contends that by virtue of continuous and exclusive use since September 25, 1956 as well as the promotion of the KHADI trademark by the Complainant, general public and members of trade now recognize and associate the goods and services under the KHADI trademarks with the Complainant. The Complainant's trademark KHADI has become highly distinctive of the goods and services of the Complainant on account of extensive use, viewership and promotion.

This disputed domain name has not been used in connection with *bona fide* offering of goods or services by the Respondent. The disputed domain name has instead been used to advertise goods and services in violation of the trademark rights of the Complainant. The Respondent is using the disputed domain name to advertise their products under the mark KHADI, misleading the consumers into believing that <urbankhadiclub.com> is in some manner affiliated to the Complainant by using the term KHADI in conjunction with the generic word as prefix and suffix “urban” and “club”. The addition of the terms “urban” and “club” only creates an impression that the fabric or clothing offered by the Respondent is a contemporary version/line of goods offered by the Complainant.

The Respondent registered the disputed domain name solely for misleading consumers. None of the exemptions provided under paragraph 4(c) of the Policy apply in the present circumstances. Further that, the Respondent is in no way related to the Complainant. The Complainant has not licensed or otherwise permitted or granted to the Respondent an authorization or a right to use their trademark or to apply for or use the disputed domain name incorporating the trademark and that nobody would use the word “khadi” unless seeking to create an impression of an association with the Complainant,

The Respondent registered the disputed domain name for the sole purpose of creating confusion and misleading the general public and the customers of the Complainant. Thus, it is contended that there were no legitimate rights or interests of the Respondent in the disputed domain name.

Regarding the element (iii), the Complainant contends that the disputed domain name was registered in bad faith and with a primary aim to disrupt the business of the Complainant as well as take advantage of goodwill and reputation associated with the Complainant’s trademarks.

The purpose and intent of the Respondent in adopting the disputed domain name <urbankhadiclub.com> is to cash in on the name, fame, reputation, and image and goodwill of the Complainant which has been built up assiduously over the years. In other words, the Respondent has registered and is using the disputed domain name in bad faith with the intention to dupe, and wrongly attract Internet users into believing that the Respondent is associated with the Complainant and creating a likelihood of confusion with the Complainant’s trademark as to the source, sponsorship, affiliation or endorsement of the website.

Therefore, the registration and use of the disputed domain name by the Respondent was in bad faith and the requirement of Paragraph 4(a)(iii), 4(b) of the Policy read along with the Rules, paragraph3(b)(ix)(3) has been established.

In support of its contentions, the Complainant has relied on a number of UDRP cases filed with WIPO involving the trademark KHADI and which have been decided in their favour. The said cases have been duly taken into consideration.

B. Respondent

In relation to element (i), the Respondent contends that the present Respondent is a website designing and software development company based in Delhi however, the disputed domain name <urbankhadiclub.com> is owned and operated by Mr. Harsh Gaba and he is proprietor of Urban Khadi club business. “In reality respondent is not the proprietor of ‘Urban Khadi Club’ business or disputed domain name but in reality only the disputed domain name website is designed and maintained by the present respondent [...] Mr. Harsh Gaba is the proprietor of the business as well as operate and run the dispute domain website WWW.URBANKHADICLUB.COM”.

The Respondent has further contended that, the Complainant’s trademark as well as domain name are completely different from that of Mr. Harsh Gaba’s Indian trademark URBAN KHADI CLUB with registration no. 3191111, registered on February 19, 2016, and the disputed domain name. The logo or label mark cannot have phonetic connotation and it cannot be pronounced, but only seen/perceived visually. Moreover it is entirely different with the Complainant’s mark both visually and phonetically as well as in terms of words,

fonts and logos.

Further that, "khadi" has been used in India to refer to hand-woven/ hand spun cloths. The word "khadi" can never enjoy any protection; it is very much a common word. No protection attaches to it, nobody can claim exclusive right to use any word, abbreviation, or acronym which has become public juris. The Complainant's so called trademark reputation has nothing to do with Mr. Harsh Gaba's trademark and disputed domain name as purpose and business idea behind both the marks is distinctive and different.

In relation to element (ii), the Respondent contends that Mr. Harsh Gaba's trademark URBAN KHADI CLUB was registered for the purpose of selling and manufacturing clothing, footwear, headgear, trousers, uniforms, etc. This can be inferred from his trademark registration certificate. Hence, Mr. Harsh Gaba is engaged in sales of all types of clothing products except KHADI products. Therefore, Mr. Harsh Gaba has rights or legitimate interests in respect of the disputed domain name.

In relation to element (iii), the Respondent contends that Mr. Harsh Gaba after proper due diligence bonafidely adopted the said trademark. It confers upon him the exclusive right to use the trademark in relation to the good or services in respect of which the trademark is registered. Therefore by virtue of trademark certificate and the abovementioned circumstances Mr. Harsh Gaba has lawfully created and have been granted the exclusive rights and protection over the use of his products and services. Mr. Harsh Gaba is not a cybersquatter but a genuine and authorized user of his mark as well as disputed domain name.

Further that the disputed domain name was not registered in order to prevent the Complainant from reflecting the mark in a corresponding domain name and, in connection therewith, Mr. Harsh Gaba has not engaged in a pattern of such conduct. It is further submitted that the Complainant and the Mr. Harsh Gaba are not competitors as their products are entirely distinctive and the disputed domain name was not registered primarily to disrupt the Complainant's business but it was adopted by Mr. Harsh Gaba to set up his business plan to earn his livelihood.

6. Discussion and Findings

According to paragraph 4(a) of the Policy, the Complainant must prove that:

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

The registration of the disputed domain name has expired on June 9, 2021. However, the PDR Ltd. d/b/a PublicDomainRegistry.com (the "Registrar") has stated that they will keep the disputed domain name under Registrar lock so that the administrative procedure can continue as required under the UDRP.

Another important issue raised by the Respondent is that the present Complaint is liable to be dismissed on the sole ground that the Complainant has not included the proper and necessary party to the present Complaint. According to paragraph [5](b) of the Response to the Complaint, the present Respondent is a website designing and software development Company based in Delhi however, the disputed domain name <urbankhadiclub.com> is owned and operated by Mr. Harsh Gaba and he is proprietor of Urban Khadi club business.

The Respondent has submitted a Certificate of Registration of Trade Mark (Annexure B). According to the said Certificate, the Registrar of Trade Marks, Mumbai, India has granted registration of the trademark URBAN KHADI CLUB on January 20, 2018, to Mr. Harsh Gaba, B-113, DDA Flats, Kalkaji, New Delhi, India.

The disputed domain name was registered on June 9, 2018. According to the Whois provided by the Registrar and attached with the Complaint, the name and details of the Registrant of the disputed domain name are as follows:

Registrant Name:	Om Soft Solution
Registrant Organization:	Om Soft Solution
Registrant Street:	2570, First Floor, Sector 7A
Registrant City:	Faridabad
Registrant State:	Haryana
Registrant Country:	India

From the aforesaid facts, it is clear that at the time of registration of the disputed domain name, the name or the registration of the trademark by Harsh Gaba was not disclosed to the Registrar of the disputed domain name. Hence, the name of Mr. Harsh Gaba does not appear anywhere in the Whois. Even the addresses of the Respondent, Om Soft Solutions, and Mr. Harsh Gaba are different. Therefore, the actions or inactions of Mr. Harsh Gaba are not relevant in the present case.

As has been indicated above, according to the confirmed information from the Registrar the registrant of the disputed domain name is Om Soft Solutions. Therefore, in the present proceedings, Om Soft Solution has been rightly indicated as the Respondent by the Complainant.

A. Identical or Confusingly Similar

According to the information submitted by the Complainant, the Complainant is the owner of several KHADI trademark registrations. The Complainant possesses a large number of other domain names with the word "khadi". The Complainant is also the owner of trademarks KHADI and KHADI INDIA. The Complainant has created most of these domain names and registered its trademarks much before the date of creation of the disputed domain name by the Respondent. The disputed domain name includes the trademark of the Complainant and is very much similar or identical to other domain names and the trademarks of the Complainant.

Therefore, the Panel finds that the disputed domain name is confusingly similar or identical to the trademarks of the Complainant.

B. Rights or Legitimate Interests

According to paragraph 4(c) of the Policy, the Respondent may demonstrate its rights to or legitimate interest in the disputed 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 disputed domain name or a name corresponding to the disputed 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 disputed domain name, even if the Respondent has acquired no trademark or service mark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

There is no evidence to suggest that the Respondent has become known by the disputed domain name anywhere in the World. The Respondent is known by the name of Om Soft Solution. The Complainant has not authorized the Respondent to use the name and their trademark KHADI.

Even if the Panel were to accept that Mr. Harsh Gaba is the underlying or beneficial registrant, and in particular noting the Complainant's longstanding use of its said mark and also its relation an official government body, none of the arguments made above persuade the Panel that such party would not be infringing on the Complainant's rights, not even the fact that there is a trademark URBAN KHADI CLUB registered in the name of one Mr. Harsh Gaba.

It is evident that the Respondent can have no legitimate interest in the disputed domain name. Further, in view of the fact that the Complainant has not licensed or otherwise permitted the Respondent to use its trademark or to apply for or use the disputed domain name incorporating the trademark of the Complainant and that nobody would use the word "khadi" unless seeking to create an impression of an association with the Complainant.

Based on the evidence in the Complaint, the Panel finds 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.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that 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 disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that the 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 disputed 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 disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) By using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 the Respondent's website or location or of a product or service on its website or location.

The Complainant contends that the disputed domain name was registered or acquired by the Respondent primarily for the purpose of carrying on some of the business competitive to the Complainant. The disputed domain name is being used with the intent to deceive the members of the public deliberately and intentionally, with a view to trade upon and encash on the name, fame, reputation, image and goodwill acquired by the Complainant.

It is a systematic attempt by the Respondent or Mr. Harsh Gaba to derive unfair advantage, wrongful commercial gains and to mislead the general public. The Respondent is not making a noncommercial or fair use of the disputed domain name.

This and the other evidence submitted by the Complainant leads to the presumption that the disputed domain name <urbankhadiclub.com> was registered and used by the Respondent in bad faith.

The Panel concludes that the registration of the disputed domain name amounts to the registration and use of the disputed domain name in bad faith. Paragraph 4(a)(iii) of the Policy is satisfied.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <urbankhadiclub.com>, be transferred to the Complainant.

/Vinod K. Agarwal/

Vinod K. Agarwal

Sole Panelist

Date: June 24, 2021