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ARBITRATION AWARD

.IN REGISTRY – NATIONAL INTERNET EXCHANGE OF INDIA [NIXI]

**.IN Domain Name Dispute Resolution Policy
INDRP Rules of Procedure**

Disputed Domain Name: <ECOTEXINDIA.IN>

INDRP Case No. 1648

Before the Sole Arbitrator: Mr. Maram Suresh Gupta

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ARBITRATION AWARD
.IN REGISTRY – NATIONAL INTERNET EXCHANGE OF INDIA [NIXI]
.IN Domain Name Dispute Resolution Policy
INDRP Rules of Procedure
Disputed Domain Name: <ECOTEXINDIA.IN>
INDRP Case No. 1648
Before the Sole Arbitrator: Mr. Maram Suresh Gupta

IN THE MATTER OF:

FORSCHUNGSINSTITUT
HOHENSTEIN PROF. DR. JURGEN
MECHEELS GMBH & CO. KG
OEKO-TEX, Schloss hohenstein,
74357 Bonningheim,
Germany.

.....Complainant

Versus

Mr. Zaid Elias
15A BECK BAGAN ROW
Kolkata, West Bengal – 700 017,
India.

.....Respondent

1. The Parties

- a) The Complainant in the present arbitration proceedings is FORSCHUNGSINSTITUT HOHENSTEIN PROF. DR. JURGEN MECHEELS GMBH & CO. KG (hereinafter referred as '**Complainant**'), with its office at OEKO-TEX, Schloss hohenstein, 74357 Bonningheim, Germany. The Complainant is represented by **Mrs. Laxmi Bisht, Ms. Ragini Ghosh**, and others of **L.S. Davar & Co.** having office address: F-1/2, Okhla Industrial Area, Phase – I, New Delhi – 110 020, India, Phone: 011-2681 1041/42, Mobile: 09810578767, E-mail: trademark@lsdavar.in.
- b) The Respondent in the present arbitration proceedings is **Mr. Zaid Elias** (hereinafter referred as '**Respondent**'), an individual, having postal address: 15A BECK BAGAN ROW, Kolkata, West Bengal – 700 017, India, **Phone No.:** 91.9831 7202, **Email:**

ecotexindia13@gmail.com. The Respondent is represented by **Ms. Zeba Zar Nigar (Advocate)**, Founder & Managing Partner of Lawcave, Lawyers and Consultants LLP having Office Address at No. 31, Hare Krishna Konar Road, (Beniapukur Road), Kolkata – 700 014, **Mobile:** +918240 6195 83, **Email:** lawcavelawyers.consultants@gmail.com, and lawyers@lawcave.co.in.

2. The Disputed Domain Name and The Registrar

- a) The following information about the disputed domain name and the registrar is as per the information furnished by the Complainant in its complaint and supporting annexures.
- b) The disputed domain name is <ECOTEXINDIA.IN> which was created on 23rd February 2018 and it was set to expire on 23rd February 2023. Based on information from WHOIS database, the registrant client ID is CR363421919 and registrant ROID is CD6C1448EEB584D5AAEBCF8E160E1E287-IN.
- c) The accredited Registrar with whom the disputed domain name was registered is GoDaddy.com.


3. Procedural History

- a) The present arbitration proceeding is as per the .IN Domain Name Dispute Resolution Policy (the “Policy”), adopted by the National Internet Exchange of India [NIXI] and the INDRP Rules of Procedure (the “Rules”), under the Indian Arbitration and Conciliation Act, 1996. By registering the disputed domain name with a NIXI accredited Registrar, the Respondent agreed to the resolution of disputes according to the Policy and the Rules thereunder.
- b) NIXI vide its email dated 4th January 2023 requested the availability of Mr. Maram Suresh Gupta to act as the Sole Arbitrator in the present matter. In return, on the same day, the Arbitrator indicated his availability and accordingly submitted the fully signed



Statement of Acceptance and Declaration of Impartiality and Independence, which complied with the .INDRP Rules of Procedure.

- c) Pursuant to the above acceptance and declaration of the Sole Arbitrator, NIXI appointed, vide in its email dated 4th January 2023, Mr. Maram Suresh Gupta as the sole Arbitrator and the same was also intimated to both the Complainant and Respondent (hereinafter '*parties*'). Thereafter, on same day, 4th January 2023, a notice having directions to both the parties was issued by me. In the said notice, the Complainant was directed to formally furnish copies of the complaint along with supporting annexures to the Respondent both via email and courier/ speed post. In addition, the Respondent was also directed to file a response/ reply to the complaint within 10 [ten] days from the date of the notice. Besides, the Complainant was also instructed to furnish confirmation copies of both the means of communication with the Arbitrator and a copy to NIXI. Further, the Complainant was also directed to file missing parts of the complaint. In response, the Complainant filed a revised complaint with annexures, dated 7th January 2023.
- d) Based on the records supplied to me by NIXI, it is evident that copies of the complaint and its annexures are already served to the Respondent via email, dated 4th January 2023. Nonetheless, pursuant to my directions, the Complainant has once again served copies of the Complaint and its supporting annexures both via email and courier to the Respondent and to their advocates. A receipt of the same was also acknowledged by the advocate of the Respondent.
- e) On 10th January 2023, the Respondent filed a reply, to the Complaint, in the form of an Affidavit, duly signed and verified by the Respondent and the same is officially taken on record by me. In the reply affidavit, first and foremost, the Respondent admits to the



phonetic similarity between the disputed domain name and the Complainants registered trademark, **OEKO-TEX**, see *Screen shot # 1 and 2* below:

4. That it is also germane to mention herein that the root of the instant dispute is observed at the fact that the Complainant herein is owning/possessing the domain name of OEKO-TEX which is a surrogate to M/s FORSCHUNGSINSTITUT HOHENSTEIN PROF. DR. JURGEN MECHEELS GMBH & CO. KG, and that the instant Respondent herein is the owners/possessors of a domain written and spelled as ECOTEX INDIA, and herein as we admit to the fact that both may sound equi complementing when pronounced but it is also a notable fact that both the names are completely different when spelled and looked on to.

Screen shot # 1: Clause 4 of the affidavit filed as a response to complaint

10. The Respondent further submits that the Complainant has also failed to appreciate the fact that the issue relating to the domain name is completely a mere coincidence and both the domain names even if claimed as "SAME SOUNDING" in nature but both when penned down, are completely different at sight, and it is an admitted fact that we tend to pronounce only after we read, and hereby the denotations of both domain names are completely different and in no way does one overlap the other.

Screen shot # 2: Clause 10 of the affidavit filed as a response to complaint

Secondly, the Respondent expressed his willingness to withdraw or retract the disputed domain name from further usage. Additionally, the Respondent mentioned that he will completely discontinue usage of the disputed domain name and will procure a new domain name for its business. Further, the Respondent also states that they are inclined to forego the use of the domain name to avoid any and all legal disputes – see *Screen shot # 3* – having clauses 11 to 12 and 15 to 17.

11. That the Respondent also states that the Respondent is a responsible Samaritan of the country and is a regular taxpayer of the same, therefore the Respondent is not willing to incline towards any litigation process and thus the Respondent is ready and willing to withdraw the domain name "ECOTEX INDIA", and is also ready to retract from any further usage of the domain name "ECOTEX INDIA".

12. The Respondent further states that the Respondent will completely discontinue the usage of the domain name under the style of "ECOTEX INDIA" and will surely frame/obtain/procure, a new domain name and will keep his business operational until and after the change of name of the Respondent's domain.

15. The Respondent further states that the Respondent is currently operating under the domain name of ECOTEX INDIA, and therefore holds a very respectable position in his circle of business, furthermore keeping in mind the face value and the goodwill of the Respondent, there is a high presumption that the same might be hurt and pushed back if the Respondent entertains any litigation, therefore the Respondent is inclined to forego the use of the domain name as to avoid any and all issues.

16. The Respondent further states that the Respondent is not ready to pay damages or compensation in any form to the Complainant, and is only ready to withdraw the usage of the domain name which is operative under the name and style of ECOTEX INDIA. The Respondent also clearly reinstates that the decision to abstain /change the domain name of the Respondent shall not in any way press the Respondent to change his style and nature of business and such will remain the same under any and all circumstances and it is solely the domain name which shall be changed.



17. The Respondent is keen to act in accordance with law and equity and thus under any and all circumstances he is ready to withdraw the usage of the domain name i.e. ECOTEX INDIA, but it is also made clear herein that nothing in the form of compensation or damages will be paid to the Complainant by the Respondent.

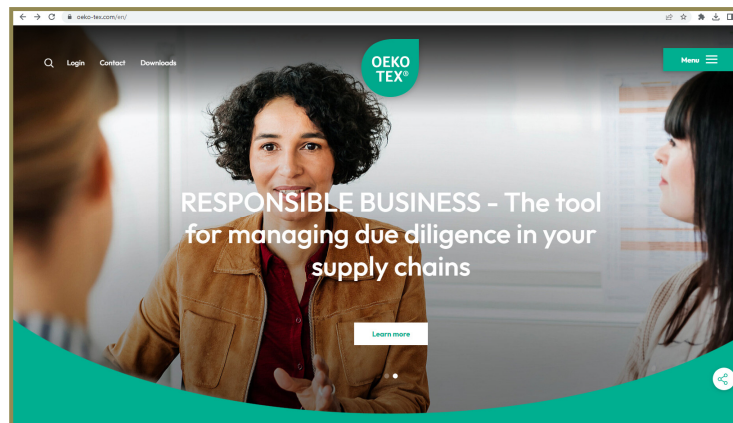
Screen shot # 3: Clause 11 to 12, and 15 to 17 of the affidavit filed as a response to complaint Furthermore, the Respondent has mentioned various other contentions in the reply affidavit which are beyond the scope of review by the present arbitration panel. In short, from the reply affidavit of the Respondent, it is abundantly evident that he agrees to fully and completely discontinue usage of disputed domain name, retract the disputed domain name from any further usage and willing to withdraw the disputed domain name or forego its usage. Therefore, in light of the reply affidavit of the Respondent, I directed the parties to see if they can amicably settle the matter. Moreover, I also directed the parties to share a copy of the settlement agreement, if any, signed between the parties after their mutual settlement discussion. As and when requested by the Parties, I have also provided them with sufficient time to settle the dispute amicably. Nonetheless, the parties failed to settle the matter amicably for various reasons which are beyond the scope of review of the present panel.

f) All in all, once the panel has set the final deadline, on 15th day of February 2023, this Panel received a Rejoinder from the Complainant, wherein the Complainant filed a reply to the Affidavit filed by the Respondent in view of the Complaint. Most importantly, the Rejoinder prayed the Panel to either cancel or transfer the disputed domain name to the Complainant. Further, on 16th day of February 2023 the Respondent filed reply to rejoinder, wherein the Respondent once again expressed his willingness to withdraw the disputed domain name as detailed in the reply affidavit filed on 10th January 2023.



4. Factual background

- a) The Complainant is based out of Germany and is in the business for over six decades. It is actively involved in testing and certifying of textile products at different locations of the world. It also has official website as www.oeko-tex.com/en/ (see below snapshot). The Complainant has also provided various product brochures along with the Complaint under Annexure – 4.



- b) The Complainant employed usage of the mark “OEKO-TEX” since 1992 and has attained a formidable goodwill and reputation in the market. Additionally, the Complainant has registered the said trademark in India (see **Annexure – 8** of the Complaint) and in various other jurisdictions in the world (see **Annexure – 5** of the Complaint). As regards India, it has a registered trademark, **OEKO-TEX**, bearing application number **1771043**, which is **valid till 2029**. Further, a perusal of Annexures 9 and 10 convey the message on sales generated by the Complainant under its registered trademarks.
- c) The Complainant has also filed the present complaint praying to this Tribunal that the Respondent be restrained from using the disputed domain name and that the said domain be cancelled or transferred to the Complainant, as registration and use of the disputed domain name is causing hardship to the Complainant.

[Handwritten signature]

d) The Respondent/ the registrant of the disputed domain name is an individual by name, Mr. Zaid Elias, based out of Kolkata. The Respondent has filed a reply affidavit with a clear willingness to withdraw the disputed domain name or forego the use of the disputed domain name (*see Screen shot # 1 to 3*), which is presently under server lock mode – as confirmed by NIXI, dated 20th February 2023, in view of the Complaint filed by the Complainant.


5. Discussion and findings

Given the facts and circumstances of the present dispute, the decision of the sole Arbitrator is based upon the contentions and evidences adduced by the Complainant and conclusions drawn from the Respondent's willingness to withdraw disputed domain name/ discontinue further usage or forego further usage of the disputed domain name to the Complainant.

Additionally, the Complainant invoked Paragraph 3 of the Rules to initiate arbitration proceedings by filing a Complaint with NIXI. The Respondent in registering the disputed domain name has submitted to the mandatory arbitration proceedings in terms of the Policy, which determines the three **essential elements** for a domain name dispute, which are as follows:

- Whether the disputed domain name is identical or confusingly similar to the registered trademark (legal right) of the Complainant?
- Does the Registrant/ Respondent have any right or legitimate interest in the disputed domain name?
- Does the disputed domain name of the Registrant/ Respondent is registered and is being used in bad faith?

The Respondent has expressed willingness to withdraw or forego the use of disputed domain name in its reply Affidavit, dated 10th January 2023. The Respondent failed to



sufficiently defend or file proper reply/ response to the grounds/ elements raised by the Complainant under paragraph 4 of the Policy. Hence, the Arbitrator is of the view that there is no need to assess the facts supporting the claim. Nonetheless, the Arbitrator provides the following findings.

A. Identical or Confusingly Similar

It is necessary to analyze the first condition of the INDRP, though the Respondent has agreed voluntarily to withdraw or forego usage of disputed domain name (by surrendering or transfer of the disputed domain name), previously held in the matter of *Homer TLC, Inc. v. Jacek Woloszuk* [NAF Claim Number: FA1504001613637]. A necessary prerequisite to Complainant obtaining its requested relief, even where Respondent agrees to such relief, Complainant must demonstrate that it has rights in a mark that is confusingly similar or identical to the disputed domain name.

The test for confusing similarity involves the comparison between the registered trademark and the disputed domain name, <ECOTEXINDIA.IN>. In the present case, the disputed domain name incorporates the Complainant's registered trademark **OEKO-TEX** in its **phonetic entirety** with the addition of 'INDIA'. The addition does not prevent a finding of confusing similarity. In order to assess confusing similarity, it is permissible for the Panel to ignore the country code Top-Level Domain ("ccTLD") ".in". In short, the disputed domain is confusingly similar to the Complainant's mark, **OEKO-TEX**, based on a phonetic comparison. In addition, the Complainant has furnished sufficient evidence (*see Annexure 8* of the Complaint) in support of its registered trademark **OEKO-TEX**, arising out of its use. Therefore, given the Complaint and its accompanying annexure documents, I am convinced beyond any ambiguity that the disputed domain name is PHONETICALLY same/ identical to the Complainants registered trademark **OEKO-**



TEX. Accordingly, the disputed domain name is identical to Complainant's registered trademark. The complainant has satisfied the first essential element.

B. Willingness to voluntarily withdraw or forego further usage of the disputed domain name

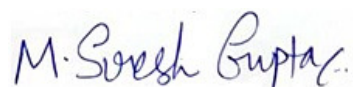
It is well established that the Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name, and then the burden shifts to the Respondent to come forward with concrete evidence of such rights or legitimate interests. In the present case, in light of the Respondents reply affidavit, wherein the Respondent has expressly agreed in to withdraw/ discontinue/ forego usage of the disputed domain name without admitting to the elements of paragraph 4 of the policy. Accordingly, the Panel is of the opinion that it need not substantively discuss the second and third elements. Therefore, this panel deems it appropriate to grant the request to transfer the disputed domain name to the Complainant.

DECISION

In light of the aforementioned reasons, in accordance with INDRP Policy and rules thereunder, the Arbitrator orders that the disputed domain name <**ECOTEXINDIA.IN**> be transferred to the Complainant.

The Parties are to bear their own costs.

This award is being passed within the statutory deadline of 60 days from the date of commencement of arbitration proceedings.



**Maram Suresh Gupta
Sole Arbitrator**

Date: 20th February 2023