



## DISPUTE RESOLUTION SERVICE

D00008779

### Decision of Independent Expert

The Condé Nast Publications Limited

and

Utsav

#### 1. The Parties:

Lead Complainant: The Condé Nast Publications Limited  
Fulwood House  
12 Fulwood Place  
London  
WC1V 6HR  
United Kingdom

Respondent: Utsav  
67-68, Saraogi Mansion, M.I.Road  
Jaipur  
Rajasthan  
302003  
India

#### 2. The Domain Name(s):

vogueindia.co.uk

### **3. Procedural History:**

The Complaint was filed 2 July 2010 and brought to the attention of the Respondent on 6 July 2010. A formal response was not received by the due date. Instead the Respondent sent an e mail to Nominet indicating that it required money to transfer the Domain Name. The Complainant paid the Expert decision payment on 3 August 2010. Having indicated her ability to act as a neutral expert in this matter Dawn Osborne of Palmer Biggs Legal was appointed as an expert to decide the case on 5 August 2010.

### **4. Factual Background**

The Complainant is the publisher of the famous fashion magazine VOGUE published in nineteen countries, the British edition since 1916 and VOGUE INDIA in India since 2007. Together with its parent company it owns, inter alia, UK and Indian trade mark registrations for VOGUE and has pending trade mark applications in India for VOGUE INDIA. On 18 February 2009 the Respondent applied to register the Domain Name. Although not in use at present the Respondent at one point ran a site at the Domain Name selling clothing, footwear, handbags and home decor items.

### **5. Parties' Contentions**

The Complainant's submissions can be summarised as follows:

The Domain Name is identical or similar to a name or mark in which the Complainant has Rights.

The Domain Name in the hands of the Respondent is an Abusive Registration.

The Complainant is a UK company. Together with its parent company Advance Magazine Publishers Inc it owns the fashion and lifestyle magazine VOGUE which is published in nineteen countries. The British edition has been published since 1916 and in 2009 has a readership in excess of two million. In 2007 the Indian edition of Vogue, VOGUE INDIA was launched together with an accompanying website at [www.vogue.in](http://www.vogue.in). VOGUE INDIA is also sold in the UK where there are 22 UK annual subscribers and 240 copies sold on average per month.

The Complainant and its parent company are the owner of many trademark registrations worldwide including VOGUE in the UK and India and they have pending applications in India for VOGUE INDIA.

At the time when the Respondent applied to register the Domain Name the Complainant already owned registrations for VOGUE in the UK and India and had substantial reputation and goodwill in the marks VOGUE and VOGUE INDIA through use.

The Domain Name at the time it was registered clearly took unfair advantage of or was unfairly detrimental to the Complainant's Rights in the marks VOGUE and VOGUE INDIA. Clearly the name was adopted with the purpose and effect of diverting customers who were seeking the Complainant's

UK or Indian magazines and related on line business activities. The Respondent has been using and threatens to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated by, authorised or otherwise connected with the Complainant. Although not currently in use the Respondent has used the Domain Name for a site selling clothing, footwear, handbags and home decor items.

The Respondent refuses to answer correspondence, although use of the Domain Name ceased after the Complainant's Indian attorneys wrote to the Respondent.

By not transferring the name back to the Complainant the Registrant is now using the Domain Name primarily to sell or use for profit, as a blocking registration or to unfairly disrupt the Complainant's business.

The Respondent did not file a formal Response but sent an e mail to Nominet indicating that it required money to transfer the Domain Name.

## **6. Discussions and Findings**

### General

To succeed in this Complaint the Complainant has to prove to the Expert pursuant to paragraph 2 of the Policy on the balance of probabilities, first, that it has Rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Domain Name and, secondly, that the Domain Name, in the hands of the Respondent, is an Abusive Registration (as defined in paragraph 1 of the Policy).

### Complainant's Rights

The Complainant or its parent company is the proprietor of registered trade marks for VOGUE in a number of countries including the UK and India and reputation and goodwill in the mark VOGUE INDIA in both India and the UK. Accordingly the Domain Name is identical to VOGUE INDIA a mark in which the Complainant has Rights (save for the generic suffix .co.uk ignored for the purposes of the Policy) and confusingly similar to the Complainant's registered trade mark VOGUE. Accordingly the Expert finds that the Complainant has Rights in respect of a mark identical to and a mark confusingly similar to the Domain Name.

### Abusive Registration

This leaves the second limb. Is the Domain Name, in the hands of the Respondent, an Abusive Registration? Paragraph 1 of the Policy defines “Abusive Registration” as:-  
“a Domain Name which either:

i. was registered or otherwise acquired in a manner, which at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant’s Rights; OR

ii. has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights.”

A non-exhaustive list of factors, which may be evidence that the Domain Name is an Abusive Registration is set out in paragraph 3a of the Policy. There being no suggestion that the Respondent has engaged in a pattern of making Abusive Registrations and there being no suggestion that the Respondent has given false contact details or has a relationship with the Complainant, the only potentially relevant ‘factors’ in paragraph 3 are to be found in subparagraph i and ii which read as follows:

i “Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

A. for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

B. as a blocking registration against a name or mark in which the Complainant has Rights; or

C. for the purpose of unfairly disrupting the business of the Complainant;”

ii “Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant”

The Expert is of the opinion that the Respondent’s conduct and use of the Domain Name is indicative of relevant abusive conduct. The Domain Name is identical for the purposes of the Policy to the Complainant’s VOGUE INDIA mark and confusingly similar to its registered trade mark VOGUE. The VOGUE mark is highly distinctive through use and given the launch of the Complainant’s VOGUE INDIA magazine in 2007 it is likely on the balance of probabilities the Respondent who is based in India had the Complainant in mind when he registered the Domain Name which indicates use as a blocking registration or to ride on the Complainant’s goodwill, thereby disrupting the Complainant’s business and taking undue advantage and causing detriment.

There is no obvious reason why the Respondent might be said to have been justified in registering the Domain Name and the Respondent has produced no evidence to counter the Complainant’s allegations. Indeed the Domain Name has been used by the Respondent for a site selling clothing, footwear, handbags and home decor products similar to those featured in the publications of the Complainant, but which have no connection to the Complainant. In so doing, the Respondent, in the opinion of the Expert, is likely to have confused Internet users into thinking that the site at the Domain Name is connected to the Complainant.

Finally, by writing to Nominet stating that it expected to “charge a price” for transfer the Expert finds that the Respondent registered the Domain Name with a view to selling it for profit or in other words has indulged in cybersquatting behaviour which also amounts, in itself, to Abusive Registration under the Policy.

Accordingly, in the view of the Expert, in its registration and use of the Domain Name, the Respondent took unfair advantage of and caused detriment to the Complainant’s Rights. Accordingly, the Expert finds Abusive Registration within the definition of that term in paragraph 1 of the Policy.

## **7. Decision**

In light of the foregoing findings, namely that the Complainant has Rights in respect of a mark which is identical to and a mark which is confusingly similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, the Expert directs that the Domain Name, vogueindia.co.uk be transferred to the Complainant.

**Signed .....Dawn Osborne.....**

**Dated 5 August 2010**