



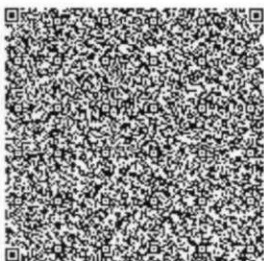
सत्यमेव जयते

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Certificate Issued Date	: 12-Dec-2013 11:30 AM
Account Reference	: IMPACC (IV)/ dl890903/ DELHI/ DL-DLH
Unique Doc. Reference	: SUBIN-DL89090391458458553561L
Purchased by	: V SHRIVASTAV
Description of Document	: Article 12 Award
Property Description	: Not Applicable
Consideration Price (Rs.)	: 0 (Zero)
First Party	: V SHRIVASTAV
Second Party	: Not Applicable
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Stamp Duty Amount(Rs.)	: 100 (One Hundred only)



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VISHESHWAR SHRIVASTAV

SOLE ARBITRATOR

IN

ARBITRATION PROCEEDINGS OF DOMAIN NAME

"www.newaysindia.co.in"

between

NEWAYS, INC.

AND

DALE GERKE & ANR.

...COMPLAINANT

...RESPONDENT

AWARD

1. This Arbitral Tribunal was constituted by nomination of undersigned as the Arbitrator in the aforesaid proceeding vide communication by NIXI and accordingly this Tribunal issued notice to the parties on 13/11/2013. However, while checking the records of the proceedings, this Tribunal found that there is nothing on record which shows that the copy of the complaint has been supplied to the Respondents and also there is no PoA in favour of Mr. Nandan Pendsey of M/s AZB & Partners the Counsels for the Complainants. Accordingly vide the aforesaid communication this Tribunal directed the Complainants to either supply proof of dispatch of the hard copy of the complaint to the respondent or send a copy of their complaint to the Respondents vide Courier.
2. That compliance of the order was done by the Complainants vide their email dated 14/11/2013. The tracking of DHL courier as supplied by the complainant shows that the Respondent has received both the soft as well as the hard copy of the complaint. This Tribunal has received both i.e. a scanned copy of POA of the complainant and the hard copy. This Tribunal vide order

dated 21/11/2013 directed the Respondents to send their Statement of Defense by 28/12/2013 as they were in receipt of the soft as well hard copy of the complaint and were aware of the Arbitration proceedings.

3. That this Tribunal received the soft copy of the Response vide email dated 27/11/2013 from the Respondent no. 1 Mr. Dale Gerke, but no signed hard copy to this Tribunal. Hence, this Tribunal vide order dated 29/11/2013 directed the Respondent No.1 to send the hard copy by 04/12/2013. On 02/12/2013 the Respondent No.1 vide his email asked for the address of the Arbitrator which had been given to all concerned on 13/11/2013 in the first notice itself, but still sent the same vide its order dated 03/12/2013 and also further extended the time of supply of SoD (hard copy) to 10/12/2013 besides reserving the award. The Respondent wanted further time till 23/12/2013 to which this Tribunal vide order dated 06/12/2013 notified that this Tribunal shall proceed ahead in the matter based on the materials available before it.

4. In view of these peculiar facts and circumstances of the present matter and also in view of INDRP this Tribunal accordingly proceeds in the matter as per the material available before it.

CLAIM

5. The claim as put forward by the complainant is briefly as under:
 - A. The Complainant claims that it is a multi-level marketing company engaged in the business of manufacture and sale of dietary supplements and home and personal care products ("**Goods / Services**") through a network of independent distributors and operates in about 29 countries around the world. The Complainant further claims that it operates in various parts of the world through its subsidiaries/affiliates such as Neways Enterprises, Inc., Neways International (Australia) Pty. Ltd., and Neways Services, Inc., etc. Complainant refers to itself and its subsidiaries and affiliates as the "**Neways Group**".

B. It is claimed that in the year 1992, the Complainant conceived and adopted the trademark NEWAYS, which is not only the Neways Group's house mark but also forms part of the Neways Group's corporate name / trade name and its' various domain names and ever since the year 1992, the Neways Group has been using the trademark NEWAYS *inter alia* in respect of its Goods / Services, continuously, till date. Reliance is placed on **Annexure – 4 & 5.**

C. It is further claimed the Neways Group also has a significant presence online on the internet, and owns / operates several domain names accessible globally. Reliance is placed on **Annexure – 6.**

D. The Complainant claims that its trademark NEWAYS has acquired immense reputation and unparalleled goodwill and the said trademark NEWAYS is associated globally and exclusively with the Complainant only and no one else and that the Complainant's trademark



NEWAYS has become a famous and well-known trademark the world over besides the Complainant has spent enormous sums of money for promoting, advertising and popularizing its trademark NEWAYS worldwide.

- E. It is claimed that the Complainant, with a view to explore the possibility of launching their products in the Indian market, had commenced preliminary discussions and negotiations with Respondent No. 1 and another, Eric Pereira, on or around the month of April 2009. In furtherance of the same, and in good faith, the Complainant had through letter dated June 4, 2009 confirmed the appointment of both, Eric Pereira and Respondent No. 1 as directors of the Complainant's operations in India and had further granted a limited permission to [Eric Pereira and Respondent No. 1] for use of the Complainant's trademark NEWAYS for the incorporation of a company in India. Reliance is placed on **Annexure – 7.**

F. It is also stated that the Complainant, had addressed a letter dated June 19, 2009 to the Registrar of Companies, Maharashtra, India, for the limited purpose of incorporating a company using the Complainant's trademark NEWAYS. Reliance is placed on **Annexure – 8**. Pursuant to the above the entity Neways Products India Private Limited ("**Indian Entity**") was incorporated in India on September 30, 2009 for the sole purpose of doing business in India under the Complainant's trademark NEWAYS, and solely for and on behalf of the Complainant. However, negotiations broke down between the Complainant, Respondent No. 1 and Eric Pereira; and the Complainant decided not to pursue Indian operations. The Complainant's decision not to pursue Indian operations along with the request to return confidential information supplied to Respondent No. 1, was communicated to Respondent No. 1 both verbally and through emails which were acknowledged by Respondent No. 1 while placing reliance on its letter

dated April 22, 2010 to Respondent No. 1. The complainant purportedly told the Respondents that they had decided not to pursue Indian operations and severed all connections with the entity and also revoked all authorizations that were granted to Respondent No. 1 during the negotiation period including use of the Complainant's trademark NEWAYS. Reliance is placed on **Annexure – 9**.

G. The Complainant, alleges that the Respondent No.1 without any right, authorization, legitimate interest or license from the Complainant has been using and operating certain websites using the Complainant's trademark NEWAYS, and without the Complainant's knowledge has registered, is using and operating various domain names which are as follows, prominently using the Complainant's trademark NEWAYS:

- www.neways.co.in
- www.newaysindia.com

- www.newaysindia.in
- www.newaysindia.co.in (Impugned domain in present proceedings)

H. The Complainant claimed that they had earlier called upon Respondent No. 1 to take down some of the Impugned Domain Names / websites verbally and through e-mail and the Respondent No. 1, through reply e-mail dated April 5, 2010 had confirmed that Respondent No. 1 had hidden / taken down certain websites / Impugned Domain Names. Reliance is placed on **Annexure – 10**. It is however, alleged that Respondent No. 1, in bad faith, without the Complainant's knowledge continued to use and operate such Impugned Domain Names.

I. The Complainant claims that it is the rightful owner and proprietor of the trademark NEWAYS and is entitled to use the trademark NEWAYS to the exclusion of all



others, including Respondent No. 1 and had contacted Respondent No. 1 through e-mail calling upon Respondent No. 1 to stop using the Complainant's trademark NEWAYS including in the Impugned Domain Names in the month of March 2013. However, Respondent No. 1 refused to comply with the Complainant's request.

- J. It is further claimed that the Complainant through its attorneys had issued a legal notice dated April 10, 2013 to (i) Respondent No. 1, (ii) the Indian Entity, and (iii) Eric Pereira, the directors and share holders of the Indian Entity revoking all previous authorizations including any permission or consent given for use of the Complainant's trademark NEWAYS and to cease and desist from using other websites and also to transfer the Impugned Domain Names registered by Respondent(s), including the Disputed Domain Name. Reliance is placed on **Annexure – 11**.

A handwritten signature in black ink, appearing to be 'Vijay', is written over the text 'Annexure – 11'.

K. The Respondent No. 1 had replied to the Legal Notice by e-mail and letter dated April 24, 2013, **Annexure – 12** and vide the said letter, had inter alia asked the Complainant to provide it with certain documents referred to in the Legal Notice. The Complainant, on the other hand through its attorneys had replied by letter dated May 1, 2013 stating that all documents and correspondence referred to in the Legal Notice were already in Respondent No. 1's possession (**Annexure – 13**).

L. It is seen that Respondent No. 1 had replied to the same through e-mail dated May 8, 2013, **Annexure – 14** denying that the Impugned Domain Names including the Disputed Domain Name infringe upon the Complainant's trademark or intellectual property or that the Complainant has any claim, right interest or entitlement to the Impugned Domain Names and had offered a settlement calling upon complainant to pay AUD 15,000 for transfer of the Impugned Domain Names to it and

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had also removed the content from websites / Impugned Domain Names from the Internet (**Annexure – 15**).

- M. It is further alleged that in reply to the Respondent's May 8 Reply, the Complainant, through its attorney had sent a letter dated June 13, 2013, (**Annexure – 16**) *inter alia* providing Respondent No. 1 with the documents as requested in the April 24 Reply and the Respondent's May 8 Reply, and had clearly rejected, refused the 'Settlement Proposal' of Respondent No. 1 including the claim for payment of AUD 15,000 for transfer of the Impugned Domain Names. This letter was refuted by the Respondent No.1. (**Annexure –17**)
- N. The complainants claim that in light of Respondent's uncompromising stand and refusal to transfer the Disputed Domain Name, they were constrained to institute the present proceedings against the Respondents' registration of the Disputed Domain Name (i.e.) www.newaysindia.co.in.

O. The complainants stress the point that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights. In support of the same, the Complainant rely upon the cases adjudicated by the WIPO Arbitration and Mediation Center and NIXI.

- Rolls-Royce PLC v. Hallofpain [Case No. D2000-1709]
- Amazon.com, Inc. v. A.R. Information & Publication Co. Ltd [Case No. D 2001-1392]
- C. & A. Veltins GmbH & Co. KG v. Heller Highwater Inc. [Case No. D2004-0466]
- PepsiCo, Inc. v. Kieran McGarry [Case No. D2005-0629]
- Kabushiki Kaisha Toshiba dba Toshiba Corporation v. WUFACAI [Case No. D2006-0768]
- E. Remy Martin v. Maria R. Dempsey [Case No.

INDRP / 422; Disputed domain name –



www.renymartin.co.in; Case decided on December 10, 2012.]

- Skype v. Hostmaster Skype Network Limited [Case No. INDRP / 363; Disputed domain name – www.skype.co.in; Case decided on June 16, 2012.]
- Clear Trip Travel Service Private Limited v. Rahul Bhatnagar [Case No. INDRP / 368, Disputed domain name – www.cleartripindia.co.in, Case decided on August 10, 2012]

P. It is further alleged that the Respondents have no rights or legitimate interests in respect of the Disputed Domain Name. The Complainant state that the Respondents had no authorization or permission from the Complainant to either use or register the Disputed Domain Name and had never consented to the registration of the Disputed Domain Name. The Complainant further allege that the Respondents are using the Disputed Domain Name to

intentionally attract Internet traffic and thereby intending to ride on the tremendous reputation and goodwill of the Complainant and make commercial gain. The Respondents' use of the Disputed Domain Name will create confusion with the Neways Group, as to the source, affiliation, endorsement or sponsorship of the Disputed Domain Name and the Respondents' business. They further allege that the Respondent No.1, at the time of entering into negotiations with the Complainant, in the month of April 2009 was well aware of the fame, reputation and goodwill attached to the Complainant's business and its trademark NEWAYS pursuant to which they had sought for the Complainant's permission for use of the Complainant's trademark NEWAYS in the corporate name of the Indian Entity. It is further alleged that the Respondents have registered the Disputed Domain Name without the Complainant's knowledge, authorisation, consent or permission, with malafide intention and further, continued use of the Disputed



Domain Name clearly indicates bad faith on the part of the Respondents.

Q. The complainants allege that the Respondent No.1's made an unreasonable demand of AUD 15,000 as payment for transfer of the Disputed Domain Name and further the use of the Disputed Domain Name www.newwaysindia.co.in for promoting Respondent No.1's business venture SUCCESS ALLIANCE, indicates a lack of bonafide on the part of Respondent No.1. This as per the complaint tantamounts to cyber squatting.

Reliance is placed upon

- Omnigraphics Capital (Pty) Ltd v. Fleximount, Guy Langevin [Case No. D2004-0471]
- S.O.R. Internacional S.A. v. Bellisima Inc. [Case No. D2010-1074]
- Bright Imperial Ltd. v. Senja Dumpin [Case No. D2009-1619]
- Yahoo! Inc. v. Feiji Gao [Case No. D2013-0521]

AND

- Neways, Inc. v. Miguel Jimenez [Case No. D2012-1426]
- Neways, Inc. v. Miguel Jimenez [Case No. D2012-1298]

R. The Respondent No.1 on the other has refuted the allegations and has raised *interalia* the following pleas:

“(xviii) The information on the website has now been changed as is the Respondent right. The information is now such that the domain name is no longer used for anything relating to the Complainant’s trade or business. The domain is to be used to advertise the sale of Respondent No. 1’s book “New Ways to Succeed” within India – an e-copy is attached as Annexure 2R. This book was first published in 1998 and has a proven and successful track record of sales.”

“(xix) The Respondent has made it clear he was willing to transfer the domains but he required compensation that is appropriate.”



" A.(b) In addition, the domain name is no longer used for anything relating to the Complainant's trade or business. The domain is to be used to advertise the sale of Respondent No 1's book "New Ways to Succeed" within India – an e-copy is attached as Annexure 2R. This book was first published in 1998 and has a proven successful record of sales."

"Further, there is no passing off of the Complainant's trademark. Rather, the Disputed Domain Name is merely combining the words "new" and "way", and adding the word India so that it is applied to Respondent No. 1's book which has been in publication for well over a decade."

"C (a) The Complainant was not registered in India before Respondent No. 1 established Neways India in 2009."

"The domains were benevolently registered by Respondent No. 1 and the Complainant had full acknowledged of this."

"(f) Rather, the Disputed Domain Name was registered for a bone fides business venture (refer to paragraphs above in particular xi) which subsequently failed. As the

business venture failed the Disputed Domain Name is now to be used for a completely different commercial purpose, as is my right as the registered owner. The Disputed Domain Name is no longer used for anything relating to the Complainant's trade or business. It is to be used to advertise the sale of my book "New Ways to Succeed" within India.

FINDINGS

- S. This Tribunal notes that the complainants and the Respondent no. 1 had entered into some kind of arrangement by which the Respondent no 1 and one Eric Rosario Pereira were given a no objection by the complainants to use their trade name "Neways" to incorporate a company in India under the Companies Act, 1956. This NOC was given vide their company Resolution dated 4th June 2009 however, it is seen from WHO IS that the disputed domain name was Registered by Respondent no. 1 on 6th of June 2009 i.e. within 2 days of the NoC.



T. This Tribunal notes that there is nothing on record to show that Complainants had given any license / NoC/ Consent or permission to the Respondent no. 1 to register the impugned domain name.

U. This Tribunal also notes the contention as raised by Respondent No.1 which *interalia* says that the complainants have moved for registration of their trade mark in India only on 18/1/2013. This fact does not help the Respondent no. 1's case as they have not been able to show any agreement /arrangement which permitted the Responded no. 1 to use their trade name and register the impugned domain name using the mark "Neways" without their explicit permission. This act of Respondent no. 1 is in my view an act of overreach of the NOC given to him and Mr. Eric by the Complainants only for incorporation of a company in India which as per the pleadings it carries the name "New ways Products India Private Limited". There is nothing on record to show as to its date of incorporation. Be it that as it may

this Tribunal is unable to understand as to why was not the registration of impugned domain name carried out in the name of the company incorporated by Respondent no.1 and Mr Eric? and why was it done by Mr Dale Gerke within two days of NoC granted by complainants to Mr. Gerke and Mr. Eric jointly?

V. This Tribunal also sees that the Respondent no.1 is using the domain name for his book "*New Ways to Succeed*". I do not find any document which shows any *consensus ad idem* between the parties for this activity. I also see that the rights *qua* the book is with Respondent No. 2 who has its own website "www.success-all.com" and has not even given any response in the present proceedings. Undersigned finds that the contentions of Respondent no.1 as raised in their SOD are devoid of merits and thus this Tribunal rejects the same.

W. Further, this Tribunal also notes that the Respondent vide his communication dated 6th April, 2009 (Annexure



10) had assured the complainants to take off the contents from the impugned domain name a fact which is alleged specifically in para 17 (xiii) of the SoC and which has not been specifically denied by the Respondent no. 1. What has been given is a general denial which is unacceptable. The respondent No.1 has not averred anything *qua* Annexure 10.

X. In view of this the contentions as raised by the Respondent No.1 cannot be sustained. Thus the complaint succeeds.

ORDER

6. This Tribunal has considered the allegations of the complainants and perused the response of the Respondent No.1 and holds that the respondents did not have any claim on the domain name <newaysindia.co.in>, hence this Tribunal directs the Registry to transfer the domain name <newaysindia.co.in> to the complainants. The Complainants



too are free to approach the Registry and get the same transferred in their name. There is no order as to the cost. The original copy of the Award is being sent along with the records of this proceeding to National Internet Exchange of India (NIXI) for their record and a copy of the Award is being sent to both the parties for their records.

Signed this 16th day of December, 2013.

NEW DELHI
16/12/2013

A handwritten signature in black ink, appearing to be 'V. Shrivastav', written in a cursive style.

V. SHRIVASTAV
ARBITRATOR