

ADMINISTRATIVE PANEL DECISION

Metro Brands Limited v. Kishore Sharma

Case No. D2023-4819

1. The Parties

The Complainant is Metro Brands Limited, India, represented by Kayser & Company, India.

The Respondent is Kishore Sharma, India.

2. The Domain Name and Registrar

The disputed domain name <desimochi.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 22, 2023. On November 23, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same date, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Domains By Proxy, LLC) and contact information in the Complaint.

The Center sent an email communication to the Complainant on December 6, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on December 11, 2023.

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 December 11, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 31, 2023. The Response was filed with the Center on December 30, 2023.

The Center appointed Harini Narayanswamy as the sole panellist in this matter on January 9, 2024. 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 an Indian Public Limited company in the business of retailing footwear and garments. The Complainant uses the trademark MOCHI and owns Indian trademark registration bearing number 1361712, date June 6, 2005 under class 25 in respect of clothing and footwear for MOCHI device mark. The Complainant also owns word mark registration for MOCHI, trademark number 4719224, date of filing is October 26, 2020, under class 25, registered in 2023.

The disputed domain name was registered on September 12, 2017. The disputed domain name is being used by the Respondent in connection with its business of footwear. The website displays the Respondent's brand name DESIMOCHI with a stylized logo, that claims to be copyright protected "2024 Best Online Shoe Store". The webpage also displays an address and phone numbers and has drop down menus for various categories of footwear products. The bottom of the page displays links, such as "Customer Service" and "About Us". The link titled "The Brand", displays the following content:

"DesiMochi" comes from our native language, Hindi, when translated in English it means "Local Cobbler" and that's exactly who we are, your friendly neighbourhood shoemakers. We are a creative spirit in 21st-century fashion with resourceful imagination and revolutionary vision on footwear. We cultivate this incredible heritage of Rajasthan, offering women of the 21st-century the essence of a bold style and timeless allure. Our passion is handcrafting fineness and customizing shoes that are as exclusive as our clientele. All our shoes are handcrafted in the city of Jaipur, Rajasthan, literally the "Land of Kings"; an Indian state renowned for its vibrant mélange of hue in nature's majestic palette and its rich cultural heritage – the blue of royalty, the pink cities and the red of sands. No wonder DesiMochi is right at home here."

The website has three videos featuring Tania Sharma, who is apparently the founder of Nice Shoes LLP and uses the website for the shoes business. The first video is titled "Journey of Entrepreneurship", which is a TEDx talk by Tania Sharma in Hindi. Another video is titled "Brands are built at Taxila Business School" and the third one is an interview with Tania Sharma "Founder Desimochi Tania Sharma at Taxila Business School".

5. Parties' Contentions

A. Complainant

The Complainant states that it was formerly known as Metro Shoes Pvt Ltd. and has extensively used the MOCHI trademark for a period of over four decades. The mark was acquired by the Complainant through an assignment deed along with the goodwill from its predecessor. The Complainant states that it has 223 retail outlets in several cities and towns across India where its mark is prominently displayed. The Complainant contends that its other sales channels include its website at "www.mochishoes.com" and various ecommerce platforms.

The Complainant has provided figures of its sales turnover for the period 2000 to 2023 and alleges that it has spent large amounts on promoting the trademark MOCHI from the period 2012 to 2023. The Complainant alleges that, in order to convince the Registrar of Trademark India for obtaining trademark registration for the word mark MOCHI with registration number 4719224, it involved two hearings. The Complainant states that due to extensive use of the mark for over 46 years, it has acquired secondary meaning. The Complainant has filed as evidence the affidavit of use, which was submitted to the trademark office to obtain the registration of its mark.

The Complainant contends that in August 2022 it came across the disputed domain name and had sent a notice to the Respondent. The Complainant states that it also came across the Respondent's trademark application for DESIMOCHI under application number 3752268 in class 25 which was objected under section 9(1)(a) and 9(1)(b) of the Trade Marks. Act 1999, and has reproduced the contents of the section which reads as follows:

“9. Absolute grounds for refusal of registration.—(1) The trademarks—

- (a) which are devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person from those of another person;
- (b) which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service;”

Notably, the Complainant contends that the word MOCHI means “cobbler” in the Hindi and that the Respondent’s trademark DESIMOCHI which translates to “Indian Cobbler” was objected to as being a descriptive term. The Complainant argues that the word “desi” refers to India or the Indian subcontinent and prefixing the MOCHI trademark with the term “desi” would suggest that it is the Indian brand of the Complainant and the public may associate the Respondent’s business with the Complainant’s mark or its variant.

The Complainant states the disputed domain name is confusingly similar to its trademark, the Respondent lacks rights or legitimate interests in the disputed domain name and has registered and uses disputed domain name in bad faith. The Complainant requests for transfer of the disputed domain name as it has satisfied each of the elements required under the Policy.

B. Respondent

The Respondent sent a brief email reply to the Complainant’s contentions on December 30, 2023. The Respondent in the email has contended that the disputed domain name consists of generic dictionary words and implies that the Complainant lacks exclusive rights in term “mochi”. The Respondent contends that the Hindi term “desi mochi” translates to local cobbler, where “desi” means “local” and “mochi” means cobbler. In support of these contentions, the Respondent has filed a screenshot of definitions from Oxford Languages.

The Respondent argues that as the term “Mochi” is generic, therefore claiming rights in a word like “mochi” is like claiming rights in words such as “pilot” or “doctor”. The Respondent also argues that if the Complainant had rights in the word “Mochi” it ought to have obtained the domain name <mochi.com>, which it does not own.

The Respondent has submitted that it has registered copyright protection for the logo of its brand MD DESIMOCHI which was obtained in the year 2018. The Respondent has filed as evidence the copyright registration certificate bearing registration number A-125962/2018, dated June 25, 2018.

The Respondent states that the disputed domain name is used by a struggling young entrepreneur, who is focused on developing her start-up business called “Nice Shoes”. (The Respondent has however not expressly mentioned whether there is any relationship between the disputed domain name registrant, Kishore Sharma and Tania Sharma, who apparently uses the disputed domain name in connection with the start up business). The Respondent further states that as there is no likelihood of confusion between its website and its store with the Complainant’s brand or mark, the Respondent argues that it has legitimate right in the disputed domain name. The Respondent requests for protection of its legitimate rights.

6. Discussion and Findings

Three elements need to be established by the Complainant under paragraph 4 (a) of the Policy to obtain transfer of the disputed domain name, these are:

- (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 lacks rights or legitimate interests in the disputed domain name; and
- (iii) The disputed domain name was registered and is being used in bad faith by the Respondent.

A. Identical or Confusingly Similar

The first element under paragraph 4(a) of the Policy requires the Complainant to establish the disputed domain name is confusingly similar to a trademark or a service mark in which it has rights.

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7. The Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The mark is fully incorporated in the disputed domain name. Under the first element, the comparison of the mark and the disputed domain name is done without looking at the manner of actual use. Differences in goods and services, weakness or strength of the mark are typically not considered under this element, as such factors could be relevant when considering other elements.

The disputed domain name contains the mark and this is sufficient to find confusing similarity with the mark. For the reasons discussed, the Panel finds there is confusing similarity between the disputed domain name and the mark. Although the addition of the term "desi" may bear on assessment of the second and third elements, the Panel finds the addition of the term "desi" does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the first element of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

The second element under paragraph 4(a) of the Policy requires the Complainant to demonstrate that the Respondent lacks rights and legitimate interests in the disputed domain name. If the Complainant makes a prima facie case that the Respondent lacks rights or legitimate interests, the Respondent can rebut the Complainant's allegations with relevant submissions and supporting evidence to establish rights or legitimate interest in the disputed domain name. See [WIPO Overview 3.0](#). Section 2.1

The Complainant has argued that the Respondent lacks rights or legitimate interests in the disputed domain name and uses it to create customer confusion. The Respondent on the other hand, has drawn attention to its website and states that it is not trying to divert, misled or confuse potential customers as alleged by the Complainant.

The Panel visited the Respondent's website and has carried out limited searches, in the Panel's general discretion, see [WIPO Overview 3.0](#), section 4.8. In the Panel's assessment, the Respondent's website along with the other evidence on record does not give an indication that the Respondent is trying to target the Complainant's mark. The reasons being: (i) the Respondent does not use the disputed domain name to host a fake website or run a fraudulent business, (ii) the Respondent's website has clearly given details of the address and contact phone numbers and has not tried to concealing its identity or use false contact information, (iii) there is no evidence of the Respondent having engaged in any typical cybersquatting behaviour such as the use of the disputed domain name in a deceptive manner to target the mark or trying to sell the disputed domain name, and (iv) the disputed domain name or the website to which it resolves is not being used for any illegal activity.

The Panel finds there is merit in the Respondent's submission that the overall appearance of the Respondent's website does not falsely suggest any connection with the Complainant or display any intention to benefit from the Complainant's goodwill. Based on the evidence, the Panel is of the view that the disputed domain name is used by the Respondent for its footwear business under its brand name DESIMOCHI.

Both parties acknowledge that the word “mochi” in the Hindi language means cobbler and that the word is considered common to the trade for shoes and footwear related products and services. The parties have also alleged that the disputed domain name is a combination of two common words “desi” and “mochi”. Furthermore, the Complainant has emphatically argued that the Respondent’s mark DESIMOCHI has been objected by the Indian Trademark Office under section 9(1)(a) and 9(1)(b) of the Indian Trade Marks Act, 1999 as being nondistinctive and not capable of distinguishing goods.

Although the Complainant has argued that the Respondent’s use of the disputed domain name is a deliberate infringement of its rights in its mark, no evidence has been submitted by the Complainant to support its assertions. The Respondent is found to have successfully rebutted the Complainant’s allegations as the website content, the logo, and the entire the look and feel of the website does not indicate that the Respondent has tried to imitate, copy or target the Complainant’s mark or even try to benefit through a false association with the Complainant’s mark.

The Panel also finds the Respondent has not given false or misleading information on its website and does not appear to be engaged in any fraudulent activity. On balance Panel finds, based on the Respondent’s submissions and the material on record, that there is merit in the Respondent’s claim that its brand name has been derived independently. Where a respondent is found to have independently derived its trade name, the respondent can claim legitimate interest or rights. See *Ferox Capital. Management Limited v. Ferox. Advisors Limited*. WIPO Case No. [D2013-1926](#).

In view of the persuasive evidence of use of the name by the Respondent before receipt of notice of this dispute, and the lack of evidence on the part of the Complainant to demonstrate its claims of deception to the consuming public, the Panel is inclined to find that Complainant has not discharged the requirement of establishing that the Respondent lacks rights or legitimate interest in the disputed domain name. See *Millennium & Copthorne International Limited, Millennium & Copthorne Hotels plc v. M/s Hotel Millennium Continental Private Limited / Nikil Gopalan*, WIPO Case No. [D2014-2280](#).

The Panel finds based on the material on record that demonstrates the Respondent’s use of the disputed domain name in connection with a bona fide offering of goods or services, before notice to the Respondent of the present dispute, that the Respondent has successfully made its case under paragraph 4(c) of the Policy. The Panel finds the Complainant has failed to establish the second element under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

The Respondent having successfully defended its case in the previous section, the third element under paragraph 4(a) of the Policy need not be taken up. However, in order to fully address the issues raised by the parties, the Panel has briefly discussed the issues here.

Both parties have acknowledged is the word “mochi” in the Hindi language means cobbler and there is no dispute that the word is considered common to the trade in which the parties offer their products, namely shoes, footwear and related services. Common descriptive word trademarks are intrinsically weak, therefore the onus on the Complainant to demonstrate secondary meaning is high. A common descriptive word trademark, which is not used in fanciful manner, but is used in a descriptive sense can be found to have acquired secondary meaning when the word is associated with the trademark by the public. Such evidence of the mark have acquired secondary meaning for instance would be evidence of actual consumer confusion or of consumer surveys.

The Complainant’s word mark registration for MOCHI, without additional evidence of the mark having acquired secondary meaning does not give it unencumbered rights, under the circumstances of the present case. The evidence, facts and the material in the present case file does not indicate that the Respondent’s aim in registering the disputed domain name was to profit from or to exploit the Complainant’s trademark. There is no evidence of targeting, no evidence of consumer confusion, there is no evidence that the Respondent has engaged in a pattern of conduct or other activity which is indicative of intentionally trying to benefit from the Complainant’s mark.

As discussed in the previous section, the Respondent's use of the disputed domain name does not appear to be used in a fraudulent manner or to infringe or in manner that would be considered abusive registration and use or under the Policy. The evidentiary burden for the Complainant is much higher in a case where the Respondent is clearly not a cyber squatter. Bad faith cannot be found when the Respondent has been found to have shown legitimate rights and interests in the disputed domain name.

The Panel finds that the Complainant has not established the third element of the Policy paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Harini Narayanswamy/

Harini Narayanswamy

Sole Panelist

Date: January 23, 2024