

Bond	 <b>Indian-Non Judicial Stamp Haryana Government</b> 		Date : 17/09/2020
Certificate No.	G0Q2020I1904		Stamp Duty Paid : ₹ 101 <small>(Rs. Only)</small>
GRN No.	67563238		Penalty : ₹ 0 <small>(Rs. Zero Only)</small>
<b>Deponent</b>			
Name :	C A Brijesh		
H.No/Floor :	Na	Sector/Ward : 27	Landmark : Millennium plaza
City/Village :	Gurugram	District : Gurugram	State : Haryana
Phone :	79*****10		
Purpose : AWARD to be submitted at Others			

**BEFORE THE SOLE ARITRATOR C.A. BRIJESH  
.IN REGISTRY  
C/o NIXI (NATIONAL INFORMATION EXCHANGE OF INDIA)  
NEW DELHI, INDIA**

**Sazerac Brands, LLC**  
10101 Linn Station Road  
Suite 400, Louisville, Kentucky - 402 23  
USA

**...Complainant**

**Versus**

**Dean Chandler**  
Treadall Inc  
32, Henry Goulburn Way  
Ottawa – K2S 1P4  
CANADA

*Also at:*

12 Morningsun Cres  
Ottawa - K2S 1J6  
CANADA

**... Respondent**

## **1. The Parties**

The Complainant is Sazerac Brands, LLC, a company incorporated in Louisiana, United States of America (USA), having its registered office at 10101 Linn Station Road, Suite 400, Louisville, Kentucky – 402 23, USA through its Authorized Representative, Pushpam Jha, Saikrishna & Associates having office at B-140, Sector-51, Noida – 201 301, India (hereinafter referred to as **Complainant**).

The Respondent is Dean Chandler of Treadall Inc., residing at 12 Morningsun Cres, Ottawa – K2S 1J6, Ontario, Canada and having office at 32, Henry Goulburn Way, Ottawa – K2S 1P4, Ontario, Canada through its Authorized Representative, Ankur Raheja, Cylaw Solutions having office at 805, Kaveri Kaustubh I, Bain Bazar, Sikandra, Agra – 282 007, India (hereinafter referred to as **Respondent**).

## **2. The Domain Name and Registrar**

The disputed domain name is <FIREBALL.IN>. The said domain is registered with ‘**Dynadot, LLC**’.

## **3. Procedural Timeline**

**July 15, 2020:** The .INRegistry appointed C.A. Brijesh as Sole Arbitrator from its panel as per paragraph 5(b) of INDRP Rules of Procedure.

**July 16, 2020:** Arbitrator accorded his consent for nomination as Arbitrator and submitted Statement of Acceptance and Declaration of Impartiality and Independence to the .IN Registry.

**July 21, 2020:** Parties to the dispute were informed of the constitution of the Arbitration panel and the effective date of handover i.e. July 20, 2020. NIXI also

forwarded the soft copy of the Complaint alongwith the Annexures to both the Arbitrator and the Respondent on this date.

**July 21, 2020:** Arbitral Tribunal addressed an email to the Respondent, with a copy marked to the Complainant and NIXI, directing the Respondent to file its response, if any, in ten days.

**July 21, 2020:** The Tribunal received an email from the Respondent seeking extension of time of thirty days to file a Reply to the Complaint on account of the extensive nature of the Complaint as well as challenges posed by the outbreak of COVID-19.

**July 22, 2020:** The Tribunal granted an extension of three weeks to the Respondent to file its Reply *via* email latest by August 12, 2020.

**August 11, 2020:** The Tribunal received an email from the Respondent requesting that the deadline to file the Reply be interpreted in terms of the time zone of the Respondent since the Respondent is located in Canada and therefore, the same be treated as 9:30AM (IST) on August 13, 2020.

**August 11, 2020:** As per the request, the Tribunal addressed an email to the Respondent, the Complainant and NIXI clarifying that the deadline of August 12, 2020 to file a Reply be interpreted as 9:30AM (IST) on August 13, 2020.

**August 13, 2020:** The Tribunal received the Reply filed by the Respondent alongwith the Annexures *via* multiple emails at around 9:30 AM (IST) on August 13, 2020. Since the Reply was forwarded within the prescribed deadline, the same was taken on record and the Complainant was directed to file a Rejoinder to the Reply within ten days i.e. by 10:00 AM (IST) on August 24, 2020.

**August 20, 2020:** The Tribunal received an email from the Complainant seeking an extension of five days to file its Rejoinder in order to be able to successfully collate requisite information in support of the Rejoinder as well as on account of the challenges posed by the outbreak of COVID-19.

**August 20, 2020:** The Tribunal granted an extension of five days to the Complainant to file its Rejoinder *via* email latest by 10:00 AM (IST) on August 29, 2020.

**August 29, 2020:** The Tribunal received the Rejoinder filed by the Complainant along with relevant Annexures *via* email at around 9:00 AM (IST) on August 29, 2020. Since the Rejoinder was forwarded within the prescribed deadline, the same was taken on record. Pleadings in the Arbitration proceedings were closed and the Tribunal proceeded to pass an Award.

The Tribunal received certain emails on August 31, 2020 from the Respondent as well as the Complainant and on September 04, 2020 from the Respondent making further requests and submissions in the matter. However, since the Tribunal had clearly declared pleadings in the matter as closed on August 29, 2020 and at some point submission of additional pleadings had to end to enable this Tribunal to pass an Award, the aforesaid emails were not acknowledged as the Tribunal had proceeded to pass the Award.

This Tribunal deems it prudent to mention that request for a hearing in the extant dispute was received from the Respondent much after the pleadings were closed. In terms of Rule 10 of the INDRP Rules of Procedure, in-person hearings (including hearings by teleconference, videoconference and web conference) are not to be conducted unless the Arbitrator determines, in his **sole discretion** and as an **exceptional** matter that such a hearing is necessary for deciding the Complaint.

This Tribunal is of the opinion that the parties were provided with ample opportunities to put forth their submissions and contentions at length and therefore, a hearing was not deemed as necessary or appropriate for deciding this dispute. Accordingly, no hearing in the matter was appointed. Further, this Tribunal being conscious of its responsibility to pass an Award with due expedition in a time-bound manner did not deem it prudent to further delay proceedings since both parties had already placed extensive submissions/documents on record. Therefore, this Award is being passed after due consideration of all facts placed before this Tribunal.

The language of the proceedings shall be English.

#### **4. Factual Background**

##### **4.1. Complainant's Activities**

The Complainant states, *inter alia*, that it is a company incorporated in Louisiana, USA having its registered office in Louisville, Kentucky, USA. The Complainant claims that its predecessor was one of America's oldest family owned and privately held distillers and that the Complainant was founded in the year 1869 and owns some of America's most venerable distilling companies i.e. Buffalo Trace Distillery, A. Smith Bowman, Glenmore Distillery and 1792Barton.

The Complainant states that it has received numerous accolades/awards/recognitions in the industry such as "Distiller of the Year" in London for the year 2014; "Americas & Caribbean Spirits Producer of the Year" trophy in the year 2015; "Gold Medal" as part of the San Francisco World Spirits Competition in the year 2010; "Double Gold-Best Overall" for Packaging Design as part of the Los Angeles International Wine & Spirits Competition in the year 2009; etc. The Complainant has enlisted various other recognitions received by it in the industry as part of the Complaint filed by it.

The Complainant states that it manufactures and markets the extremely popular and successful cinnamon whisky under the name 'FIREBALL' and the associated merchandise therewith consisting of the said brand name. The Complainant further states that it is the legitimate owner of the domain name "fireballwhisky.com" and is the registered owner of the trade mark 'FIREBALL' under Classes 32 and 33 in India as well as in more than 70 jurisdictions globally. The Complainant further claims that it has garnered immense social media popularity and that in the year 2013, its 'FIREBALL' whisky became one of the top ten most popular liquors in United States of America (USA) and in the year 2015, Bloomberg reported that the brand had overtaken Jägermeister in popularity to become the top-selling liqueur in the USA. In this regard the Complainant has provided copies of media articles marked as **Exhibit-3**.

Further, the Complainant states that the popularity of its brand 'FIREBALL' is also evidenced by the fact that the official Facebook page of its whisky has approx. 9.72K likes and 9.58K followers; the official Twitter account has more than 96K followers; and the official Instagram page has more than 100K followers. In this regard, the Complainant has provided extracts from the respective social media accounts marked as **Exhibit-4**. Therefore, the Complainant claims that the goodwill and reputation associated with the mark 'FIREBALL' rests with the Complainant and no one else.

#### **4.2. Complainant's Use of 'FIREBALL'**

The Complainant states that one of its top selling whiskies' is called 'FIREBALL', which is readily available across five continents. In this regard, the Complainant has provided an official distributor list indicating the wide presence of 'FIREBALL' whisky worldwide marked as **Exhibit-1**. The Complainant further states that it acquired the brand 'FIREBALL' in the year 2000 which was initially called '*Dr. McGillicuddy's Fireball Whisky*' and was originally launched in the year 1989 in USA and has since witnessed astounding sales and popularity accruing in its favour in the global liquor market. The Complainant submits that besides

advertising and promoting their goods and services through digital and social media, the Complainant also hosts websites such as '[www.fireballwhisky.com](http://www.fireballwhisky.com)' and '[www.sazerac.com](http://www.sazerac.com)' which are aimed at informing the consumers of its wide range of products and services. In this regard, the Complainant has provided extracts from its websites and social media accounts marked as **Exhibit-2**.

The Complainant submits that 'FIREBALL' is a unique and fanciful term which has no connection with the goods provided by the Complainant and has acquired substantial goodwill and is an extremely valuable commercial asset of the Complainant. The Complainant states that it is the registered proprietor of the mark 'FIREBALL' with the earliest registration in India dating back to July 19, 2013 in Class 33 under registration No. 2567409 and for the mark



in Classes 32 and 33 under registration No. 4009136 dating back to February 25, 2019, and the same are valid and subsisting in India. In this regard, the Complainant has provided copies of registration certificates issued by the Indian Trade Marks Registry marked as **Exhibit-6**.

The Complainant also claims to have secured various registrations for the trade mark 'FIREBALL' internationally in more than 70 jurisdictions including but not limited to Argentina, Australia, Bahrain, Brazil, Chile, China, Costa Rica, Ethiopia, European Union, France, Hong Kong, Israel, Japan, Malaysia, Mexico, New Zealand, Norway, United Kingdom, United States of America, etc. with the earliest registration for the mark 'FIREBALL' dating back to February 25, 1997 in Canada. In this regard, the Complainant has provided copies of registrations certificates issued by respective trade mark offices marked as **Exhibit-7**.

The Complainant also claims to sell its 'FIREBALL' whisky in over 90 jurisdictions globally and has placed on record sales volumes thereunder in terms of cases across jurisdictions such

as Chile, China, EU and USA between the years 2013 to 2020 as part of the Complaint. The Complainant has placed on record various articles appearing on global platforms as well as by the Indian media featuring unsolicited stories regarding the Complainant's goods under the mark 'FIREBALL' marked as **Exhibit-8, Exhibit-9 and Exhibit-10**. The Complainant has also placed on record extracts from various social campaigns and promotions in India for its brand 'FIREBALL' marked as **Exhibit-11**.

The Complainant states that it has registered numerous domain names comprising the mark 'FIREBALL' such as 'fireballbeer.com', 'fireballdrinks.com', 'fireballuk.com', 'fireballwhiskey.com', 'fireballwhiskey.in', 'fireballwhiskyindia.com', etc. In this regard, the Complainant has provided WHOIS details of selective domain names marked as **Exhibit-13**. The Complainant also submits that it has been active and vigilant in enforcing and protecting its rights in its mark 'FIREBALL' and has consistently filed domain name complaints, oppositions against third party infringing marks, legal notices/take down notices, etc. Selective copies of such actions and orders passed in respect thereof have been placed on record by the Complainant marked as **Exhibit-12**.

Based on the aforesaid, it is the Complainant's assertion that due to extensive and continuous use of the mark 'FIREBALL' for several years in India and internationally, the mark 'FIREBALL' has acquired substantial goodwill and reputation and has acquired inherent distinctive character and recognition such that it is exclusively associated with the business/products/services offered by the Complainant and any reference to the said name/mark is instantly associated with the Complainant to the exclusion of all others. Therefore, the Complainant states that it alone has the exclusive right to use the mark 'FIREBALL'.

#### **4.3. Respondent's Activities**



Respondent in his response states that he is a resident of 12 Morningsun Cres, Ottawa, Ontario K2S 1J6, Canada and his office address i.e. for Treadall Inc. is 32, Henry Goulburn Way, Ottawa K2S 1P4, Canada. The Respondent further submits that he has a bachelor's degree in Engineering and Management from McMaster Faculty of Engineering, McMaster University, Hamilton, Ontario, Canada (hereinafter, McMaster Faculty of Engineering or McMaster) wherein he pursued the five year engineering course between the years 1995-2000. In this regard, the Respondent has provided a copy of his degree issued in the year 2001 as **Annexure 1**.

The Respondent claims that professionally, he is engaged in the business of rubber mats, vinyl and form flooring as part of 'Treadall Inc.'. The Respondent states that details of his business can be accessed through the website '[www.treadall.com](http://www.treadall.com)' as well as other websites such as 'matsflooring.com', 'horsematscanada.com' and 'horsematsusa.com'. The Respondent further claims that his Facebook page '*The Treadall*' depicts various gyms wherein the Respondent has supplied his flooring products.

The Respondent states that he has registered many common-word and combined letter domain names (such as 'cruisepackages.in', 'allinsurance.in', 'usnews.in', 'matsflooring.com', 'horsematscanada.com', 'horsematsusa.com') for development and investment purposes for the last many years. The Respondent submits that he owns many generic, inherently valuable short '.COM', '.CA' and '.IN' domain names and is also engaged in the business of investing in domain names.

#### **4.4 Respondent's use of 'FIREBALL'**

The Respondent states that all the students and alumni members of the McMaster Faculty of Engineering are referred to as 'Fireball Family' and that the official symbol of McMaster Faculty of Engineering is a 'FIRBALL' since the year 1960. The Respondent claims to have

been a part of McMaster's 'Fireball Family' since the year 1995. In this regard, the Respondent has provided printouts from websites such as Wikipedia, Instagram and Twitter demonstrating use of the hashtag 'Fireball Family' marked as **Annexure III**.

The Respondent claims that it is very common for the Respondent to use the word 'FIREBALL' and that the Respondent is still a part of the 'Fireball Family' as the McMaster Faculty of Engineering regularly holds events for alumni members and issues monthly newsletters, holds chat sessions with alumni, etc. In this regard, the Respondent has provided extracts from the website of McMaster Faculty of Engineering indicating hosting of events and virtual 'Fireball' chats with alumni members marked as **Annexure II** as part of the response.

The Respondent then states that being fond of astronomy, the Respondent relates the word 'Fireball' to fireballs visible in the Canadian sky and associates the word 'FIREBALL' to a large bright meteor visible in the sky. The Respondent then presents a personal account of his hobbies involving indulging in sky gazing through a telescope, etc. to claim that the domain name 'fireball.in' was registered by the Respondent owing to its dictionary meaning and not because of its value as a trade mark.

The Respondent submits that prior to registration of the said domain name, the Respondent alongwith a fellow batch mate intended to set up a website for graduates of McMaster from the year 2000 resolving to the said domain name. Hence the domain name was registered. Further, admittedly, the Respondent is also actively involved in investing in domain names as part of his business. Insofar as registration of the domain name 'fireball.in' is concerned, the same was registered by the Respondent on July 03, 2018 and is valid till July 03, 2021.

## **5. Contentions of Parties as summarized in the pleadings**

*Both parties have placed extremely detailed pleadings on record and set out numerous facts and authorities in relation to their respective case. This Tribunal has gone through the same*

*in detail, and for the sake of brevity, only the salient points that the parties makes in support of their case are summarized hereinbelow.*

## **5.1. Complaint**

### **a) The domain name is identical or confusingly similar to a trade mark/service mark in which the Complainant has rights**

- i. The Complainant submits that the disputed domain name ‘fireball.in’ is identical to the Complainant’s registered trade mark ‘FIREBALL’ and contains and incorporates the Complainant’s well-known and unique trade mark ‘FIREBALL’ in entirety such that the essential and distinctive element of the Complainant’s trade mark which forms the basis of its identity is blatantly copied in full. In this regard, the Complainant places reliance on the cases of *Microsoft Corporation v. Chun Mun Kam*, INDRP Case No. 119, *International Business Machines Corporation v. Zhu Xumei*, INDRP Case No. 646, *Jaguar Land Rover v. Yitao*, INDRP Case No. 641, *Banco Bradesco S/A v. NA*, WIPO Case No. D2008-1949 and *Black & Decker, Inc. v. Domain Admin, Whois Privacy Corp.*, WIPO Case No. D2015-0768.
- ii. The Complainant further submits that the disputed domain name is near identical to the Complainant’s other URL/websites such as ‘fireball.red’, ‘fireballwhiskyindia.com’, ‘fireballwhisky.in’ and ‘fireballwhisky.com’ and does not even include generic additional terms so as to attempt to differentiate from the Complainant’s trade mark ‘FIREBALL’. The Complainant places reliance on the case of *Six Group AG v. mayangroup*, WIPO Case No. D2013-0008 to substantiate that the ‘.com’ at the end of a disputed domain name is to be ignored in deciding the issue of confusing similarity and the same is not a factor in adjudging similarity.
- iii. The Complainant claims that in light of the glaring identity between the disputed domain name and Complainant’s trade mark, it is very likely that an internet user may be misled

when coming across the disputed domain name to believe that the Respondent is in some way associated with or affiliated to the Complainant or that the Respondent is acting with the consent or endorsement of the Complainant.

- iv. The Complainant submits that the internet users will be forced to associate/derive a nexus between the Respondent's website and the Complainant's popular whisky 'FIREBALL' so as to create a very high chance of association in the minds of the internet users. In this regard, the Complainant places reliance on the case of *Apple Inc. v. Fred Nergstrom, LottaCarlsson, Georges Chaloux and Marina Bianchi*, WIPO Case No. D2011-1388 to submit that '*merely causing internet users to wonder whether the domain name is associated with the Complainant is confusion enough*'.

**b) The Respondent has no rights or legitimate interest in respect of the domain name**

- i. It is the contention of the Complainant that it is the registered proprietor of the trade mark 'FIREBALL' in India and that the mark has become highly distinctive of the goods and services of the Complainant on account of extensive use and popularity and promotion thereof on the national and international level. The Complainant states that the trade mark 'FIREBALL' has acquired substantial goodwill and reputation and is an extremely valuable commercial asset of the Complainant.
- ii. The Complainant submits that the Respondent is in no way related to the Complainant or its business activities, nor has the Respondent entered in any agreement granting him the right/license/authorization to make use of the Complainant's registered trade mark(s). The Complainant states that it has not consented to the use of its registered trade mark by the Respondent and relies on the findings of the Panel in the case of *F. Hoffmann-La Roche AG v. WhoisGuard Protected, WhoisGuard Inc./Samantha Park*, WIPO Case No. D2018-2495 in this regard. It is the contention of the Complainant that the Respondent can have no possible justification for registering the disputed domain name which incorporates the

Complainant's registered trade mark 'FIREBALL' in entirety without the knowledge or consent of the Complainant.

- iii. The Complainant submits that the date of registration of the disputed domain name is July 03, 2018 which is much subsequent to the dates of adoption and use of the trade mark 'FIREBALL' by the Complainant i.e. 2003 and 2013, respectively and additionally since the Respondent is from Canada, he cannot claim that he is not aware of the Complainant's products and services under the mark 'FIREBALL' as the 'FIREBALL' whisky of the Complainant originated in Canada and is extremely popular in the country. The Complainant claims that the Respondent had complete knowledge of the Complainant's goods under the mark 'FIREBALL' prior to registering the disputed domain name and therefore, knew that it had no rights or legitimate interest in the disputed domain name and places reliance on the case of *Star India Pvt. Ltd. v. Suezan Jackson*, WIPO Case No. D2014-0820 on this aspect.
- iv. The Complainant also submits that the Respondent is not commonly known by the disputed domain name nor does the Respondent engage in any business or commerce under the said name and therefore, the Respondent cannot be said to have any legitimate rights or interest in the disputed domain name. In this regard, the Complainant has placed reliance on the cases of *Neteller plc v. Prostoprom*, WIPO Case No. D2007-1713 and the *Toro Company v. Dick Egy*, USDRP Case No. FA1404001553926.
- v. The Complainant further states that the Respondent has not made any legitimate use of the disputed domain name since its registration in July 2018 and that there is no evidence of the Respondent's use of the same or even any demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods/services. The Complainant submits that the failure of the Respondent to use the disputed domain name demonstrates that it has no legitimate rights or interest vesting in the disputed domain name, other than

to cash upon the Complainant's goodwill and reputation vesting in its prior registered trade mark 'FIREBALL'.

**c) The domain name was registered and is being used in bad faith**

- i. The Complainant contends that the bad faith of the Respondent can be established based on the fact that the Respondent has simply parked the disputed domain name since its creation with the ulterior motives to make monetary profits by either selling, renting or otherwise transferring the domain name registration to the Complainant or its competitor. The Complainant further submits that such blocking of the disputed domain name would also prevent the Complainant from making commercial use of the disputed domain name which comprises its well-recognized and registered trade mark 'FIREBALL'.
- ii. It is also the contention of the Complainant that the disputed domain name was registered by the Respondent with complete knowledge of the Complainant's extremely popular whisky under the mark 'FIREBALL' with the ill-motive to gain unfair advantage at the expense of the Complainant. The Complainant states that given that the disputed domain name has remained inactive since the time it was registered, the Respondent's dishonesty and bad faith is apparent. In this regard, the Complainant places reliance on the cases of *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003, *Aventis and Aventis Pharma SA v. Bug Software/Paulo Andrade*, WIPO Case No. D2004-0878 and *Clerical Medical Investment Group Limited v. Clericalmedical.com (Clerical & Medical Services Agency)*, WIPO Case No. D2000-1228 to further substantiate that such inactivity could amount to use in bad faith.
- iii. The Complainant relies on the case of *Estee Lauder Inc. v. estelauder.com, estelauder.net and Jeff Hanna*, WIPO Case No. D2000-0869 to submit that the fact that users once so diverted or attracted, are confronted with an inactive page does not cure the initial and illegitimate diversion. In fact, the Complainant submits that since the registration of the

disputed domain name is much subsequent to the Complainant's adoption and use of the mark 'FIREBALL', the Respondent had substantial knowledge and constructive notice of the 'FIREBALL' trade marks as he belongs to Canada and the Complainant's whisky is extremely popular there. In this regard, the Complainant has placed reliance on the cases of *Expedia Inc. v. European Travel Network*, WIPO Case No. D2000-0137, *Consitex S.A., Lanificio Ermenegildo Zegna & Figli S.p.A., Ermenegildo Zegna Corporation v. Mr. Lian Ming*, WIPO Case No. DWS2003-0001, *Mari Clarie Album v. Marie-Claire Apparel Inc.*, WIPO Case No. D2003-0767, *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. Herreveld*, WIPO Case No. D2000-0776 and *Adidas-Salomon AG v. Domain Locations*, WIPO Case No. D2003-0489 to substantiate that registration of a well-known trade mark of which the Respondent must reasonably have been aware is in itself sufficient to amount to bad faith.

## **5.2. Reply filed by the Respondent**

At the outset, the Respondent states that this is not a case of cybersquatting and places reliance on the cases of *Audi AG v. Stratofex*, WIPO Case No. D2012-1894, *Clockwork IP LLC, One Hour Air Conditioning Franchising, LLC v. Elena Wallace*, WIPO Case No. D2009-0485, *Bennett, Coleman and Co. Ltd. v. Sarv Webs Pvt. Ltd.*, INDRP Case No. 1195, *M/s. Butterfly Gandhimati Appliances Limited v. Amit Sindhwani*, INDRP Case No. 919 and *Century 21 Real Estate LLC v. Alchemist Ltd.*, INDRP Case No. 1231 to submit that the extant dispute is without jurisdiction before this Tribunal as the INDRP procedure is available only in respect of deliberate, bad faith, abusive, domain name registrations or cybersquatting and is not applicable to disputes between parties that tantamount to trade mark infringement with competing rights acting in good faith. Complainant has vehemently argued that UDRP is not a Court and this is not a typical case of cybersquatting so as to be adjudicated by UDRP (INDRP herein).

**a) The domain name is not identical or confusingly similar to a trade mark/service mark in which the Complainant alleges enforceable rights**

- i. The Respondent submits that 'FIREBALL' is a generic word having a dictionary meaning or otherwise a natural occurrence and states that the said mark is widely used by numerous businesses/entities globally as a brand name. In this regard, the Respondent has provided extracts from online dictionaries and third party websites and extracts from databases of different trade mark offices of different countries as **Annexure IV, V, VII and VIII**. The Respondent also places reliance on the case of *Rollerblade, Inc. v. CBNO and Ray Redican Jr.*, WIPO Case No. D2000-0427 to submit that generic-ness, if established, will defeat a claim of trade mark rights, even in a mark which is the subject of an incontestable registration.
- ii. The Respondent states that the Complainant's mark 'FIREBALL' was registered in Canada in the year 1997 while the Complainant has been a part of the 'Fireball Family' of the McMaster University where he pursued his Engineering course during the period 1995-2000 and is therefore, a prior user of the term 'Fireball'. The Respondent claims that the Complainant's mark has only been used in India since the year 2019 with the Complainant's India specific domain names such as 'fireballwhisky.in' having been registered only in the year 2019 before which the Complainant did not have any active presence in India. The Respondent also claims that many similar trade marks exist on the Trade Marks Register with many other organizations being prior users of the mark 'FIREBALL'.
- iii. The Respondent also submits that the Complainant's initial trade mark application for the mark 'FIREBALL' in India was filed on a 'proposed to be used' basis and that no real use of the mark was commenced by the Complainant in India until 2019, which is after the registration of the disputed domain name. The Respondent states that the mark



'FIREBALL' is being used by several other organizations and that the mark is a generic word over which the Complainant cannot claim exclusive rights.

**b) The Respondent has rights and a legitimate interest in the domain name**

- i. The Respondent submits that the Complainant must prove that there is total lack of any right or legitimate interest in the disputed domain name insofar as the Respondent is concerned and not just that the Complainant has a "better" right or legitimate interest. In this regard, the Respondent has placed reliance on the cases of *Borges, S.A., v. James English*, WIPO Case No. D2007-0477 and *Bennett Coleman & Co. Ltd. v. Sarv Webs Pvt. Ltd.*, INDRP Case No. 1195.
- ii. The Respondent further states that where a Respondent registers a domain name consisting of a dictionary term because the Respondent is under the good faith belief that the domain name's value derives from its generic or descriptive qualities rather than its specific trade mark value, then such use of the domain name would establish legitimate interest. The Respondent submits that the mark 'FIREBALL' is an English dictionary word which has a clearly descriptive and well-known meaning that is wholly separate and distinct from the Complainant's brand name.
- iii. The Respondent states that where a domain name is descriptive, the first person to register it in good faith is entitled to the domain, and that is considered as 'legitimate interest'. It is the Respondent's submission that the Respondent has legitimate right to use the domain name as it comprises a generic word and in this regard places reliance on the cases of *Zero Int'l Holding v. Beyonet Servs*, WIPO Case No. D2000-0161, *FilmNet Inc. v. Onetz*, National Arbitration Forum, Case No. FA96196 and *Energy Source Inc. v. Yur Energy Source*, National Arbitration Forum, Case No. FA96364.
- iv. The Respondent submits that the main purpose of registration of the disputed domain name was to build an alumni website of graduates from the year 2000 of the McMaster Faculty

of Engineering who refer to themselves as ‘Fireball Family’ and that the development of the website is underway. He further states that since the Dean of Faculty of his college was of Indian origin i.e. Mr. Iswar K Puri, the .IN domain was a preferred choice.

- v. The Respondent further claims that he associates the word ‘FIREBALL’ with the frequent fireballs visible in the Canadian sky and places on record his interest in astronomy as a hobby and claims to follow happenings in the sky on a regular basis.
- vi. The Respondent states that the Respondent has registered many common word and combined letter domain names for development purposes such as the disputed domain name and relies on several cases such as *Aurelon B.V. v. Abdul Basit Makrani*, WIPO Case No. D2017-1679 and *Piaggio & C. S.p.A. v. Xu Xiantao*, INDRP Case No. 1132 to claim that his business strategy of investing in domain names is legitimate and legal. The Respondent also claims to have no knowledge about the Complainant’s mark ‘FIREBALL’ in respect of whisky as he claims to be a ‘teetotaler’.
- vii. The Respondent further claims that the mark ‘FIREBALL’ has been adopted by various businesses all across the world with several trade mark registrations in USA for the same. The Respondent also submits that many domains are registered comprising the mark ‘FIREBALL’ and in this regard, places reliance on various trade mark registrations secured for the mark ‘FIREBALL’ in India and internationally by other entities as well as websites resolving to domain names that comprise the mark ‘FIREBALL’ as **Annexures VII and VIII**.
- viii. The Respondent places reliance on the case of *Canned Foods, Inc v. Ult. Search Inc.*, National Arbitration Forum, Case No. FA96320 to substantiate that a trade mark that equally describes businesses conducted by many other people is not a protectable term and relies on the case of *HSM Argentina S.A. v. Vertical Axis, Inc.* WIPO Case No. D2007-0017 to state that evidence of third party use of terms identical to the trade mark mitigates against a finding that Respondent knew specifically of Complainant or its mark when the

disputed domain name was registered, particularly where the terms may have a number of potential associations, unconnected with Complainant. The Respondent further claims that in such situations, there is a greater onus on the Complainant to present compelling evidence of secondary meaning or distinctiveness where there are various other entities using a similar mark. The Respondent further states that while the Complainant may be able to claim rights in domains comprising 'Fireball Whisky', the Complainant cannot do so with mark 'FIREBALL' alone. The Respondent also submits that the Complainant does not have any prior rights in domain names comprising the mark 'FIREBALL' alone apart from 'fireball.red'.

- ix. The Respondent submits that by being part of 'Fireball Family' since the year 1995, he has prior common rights in the mark 'FIREBALL' and is commonly known by the disputed domain name in order to provide him with a legitimate interest in the same.

**c) The domain name was not registered and is not being used in bad faith**

- i. The Respondent submits that it was not targeting the Complainant's trade mark when it registered the disputed domain name and in fact claims to be unaware of the Complainant's prior existing rights in the mark 'FIREBALL' and states that the Complainant has failed to prove goodwill and reputation accruing in its favour across relevant jurisdictions such as Canada in order to allege that the Respondent must have known about the Complainant's mark at the time of registering the domain name.
- ii. The Respondent submits that he intends to use the disputed domain name for an alumni website and that the same is under construction. The Respondent submits that the parking page to which the disputed domain name resolves did not make any reference to the Complainant or its trade mark and relies on cases such as *Javier Narvaez Segura, Grupo Loading Systems S.L. v. Domain Admin, Mrs. Jello, LLC*, WIPO Case No D2016-1199 and *E-Renter USA Ltd. v. Domain Hostmaster, Customer ID: 55391430909834, Whois Privacy*

*Services Pty. Ltd. / Domain Administrator, Vertical Axis Inc*, WIPO Case No. D2015-0784 to substantiate that a parking page generating ‘pay per click’ revenue can be deemed to be a *bona fide* offering of goods or services if the mark in question is a generic or non-exclusive term.

#### **d) Reverse Domain Name Hijacking**

The Respondent claims that the Complainant is guilty of reverse domain name hijacking and is making an attempt to acquire a disputed domain name through the INDRP procedure after having failed to acquire it in the marketplace and deems it to be a calculated attempt designed to steal a highly valuable domain name from its rightful owner after failing to acquire it otherwise in the marketplace. The Respondent further submits that the complaint was brought in bad faith in an attempt at reverse domain name hijacking or was brought primarily to harass the Respondent. In this regard, the Respondent has placed reliance on several cases such as *Navasard Limited v. Humberto DAbreu De Paulo, Duranbah Limited*, WIPO Case No. D2017-2414, *Tobam v. M. Thestrup / Best Identity*, WIPO Case No. D2016-1990 and *Shevaldas C Raghani v. Stephen Koenig*, INDRP Case No. 009.

#### **5.3. Rejoinder**

- i. The Complainant in its rejoinder states that the Respondent’s submission that this matter is not a matter of a cyber-squatting is legally misplaced and that this dispute is within the scope of the INDRP Policy which clearly covers disputes arising out of registered .IN domain names when they conflict with legitimate rights or interests of a person/entity. Further, the Complainant submits that the registration agreement pursuant to which the disputed domain name was purchased by the Respondent also incorporates the INDRP Policy and therefore, the INDRP Policy applies to the present dispute.

- ii. The Complainant also submits that no case of reverse domain name hijacking is made out as the present complaint was initiated on the basis and strength of the Complainant's statutory rights arising out of its numerous registrations in several jurisdictions, and its common law rights by virtue of decades of extensive use worldwide *re* the mark 'FIREBALL'. Accordingly, it is the contention of the Complainant that the question of the present complaint having been filed in bad faith does not arise and further states that the onus of proving a case of reverse domain name hijacking lies on the Respondent who bears a heavy evidentiary burden to justify such a finding. The Complainant states that the Respondent has failed to fulfil the aforesaid and has merely made bald assertions, failing to establish its own legitimate rights or interest in the disputed domain name to allege bad faith on the part of the Complainant.
- iii. The Complainant states that the Respondent has repeatedly resorted to making contradictory statements in an attempt to justify his conduct of bad faith. The Complainant submits that on one hand, the Respondent claims to have genuinely registered the disputed domain name to develop a website for its college's alumni group of the year 2000; on the other hand, the Respondent is also arguing that it is interested in astronomy and relates it to meteor events in the sky and that the mark FIREBALL itself is generic; at the same time, the Respondent has also argued that he is involved in the business of investing in domain names, and that its registration of the disputed domain name is merely an extension of his business. The Complainant claims that this makes it apparent that the Respondent has attempted to come up with as many justifications as possible to cover up its bad faith and dishonesty and that these justifications are a mere after thought and the disputed domain name was registered simply to take advantage of the Complainant's registered and well-known mark FIREBALL.
- iv. The Complainant has also placed on record the case of *Easton Corp Pty Ltd. v. Mr. Dean Chandler*, INDRP Case No. 844 to submit that the Respondent has already been ruled

against in a previous decision under the INDRP Rules of Procedure wherein the Respondent's conduct and abusive pattern of registering domain names was held to be in bad faith. The Complainant further relies on this case to submit that if the Complainant owns a trade mark and has statutory rights over the mark, then it generally satisfies the threshold requirement of having trade mark rights and the location of the trade mark, its date of registration (or first use) and the goods and/or services for which it is registered, are irrelevant for the purposes of finding rights in a trade mark.

- v. The Complainant also places reliance on a case of the Hon'ble High Court of Delhi (India) viz. *Stephen Koenig v. Arbitrator, National Internet Exchange of India (NIXI) & Anr.*, [(2012) 186 DLT 43] to substantiate that a trade mark registration raises a presumption of validity of the registration by placing the registered proprietor of a mark in a better position than a non-registered one for the purposes of the INDRP Rules of Procedure and that it was more than sufficient to be a registered proprietor of the trade mark in question in order to demonstrate legitimate rights.
- vi. The Complainant places reliance on the WIPO Overview of WIPO Panel Views on Selected UDRP Questions which summarizes consensus panel views on a range of common and important substantive and procedural issues and state that the fact that a particular term has a dictionary meaning is sometimes confused with the notion of a "generic" term but when used in a non-dictionary distinctive sense (i.e., in a manner that bears no relation to the goods or services being sold), such dictionary terms can function as "arbitrary" trade marks. The Complainant states that when this principle is applied to the present case, it becomes clear that the Complainant's trade mark FIREBALL bears no relation to the goods being offered under it (i.e., liquor), and is thus an arbitrary trade mark.
- vii. The Complainant strongly opposes the Respondent's averment that its college and its alumni group is referred to as the "Fireball Family" and states that even if this is true, it does not justify how the Respondent himself is commonly known and/or referred by the

phrase “Fireball Family” since it is used in connection with the alumni group collectively, and not an individual such as the Respondent. The Complainant submits that the Respondent’s business is referred to as ‘Treadall’ and it is thus submitted that the Respondent has absolutely no rights over the Complainant’s well-known trade mark FIREBALL. The Complainant further submits that it is a well-accepted principle that in order to demonstrate that an entity has been commonly known by a name corresponding to the domain name, it must be “commonly known”, as opposed to merely incidentally known by the relevant moniker/nickname and that in the present matter, the Respondent is not even incidentally known as “Fireball” let alone to be “commonly known”.

viii. The Complainant also claims that Respondent has merely averred that he registered the disputed domain name to build an alumni website for its college when in fact till date, the Respondent has failed to commence any use on the disputed domain name and on the contrary, the landing page in fact showed an option to purchase the domain in August, 2018, i.e. soon after the Respondent had registered the domain name. In this regard, it is the submission of the Complainant that if the Respondent has failed to make use of the registered domain name for a considerable period, it may be inferred that the Respondent does not have any legitimate right or interest in the said domain name and that in the present matter, the Respondent’s supporting documents are not sufficient to establish whether any preparations to use the domain name have been made.

ix. The Complainant submits that in light of the fact that the Respondent has simply parked the disputed domain name since its creation, it is amply clear that the Respondent has registered the domain name with ulterior motives to make monetary profits by either selling, renting, or otherwise transferring the domain name registration to the Complainant or to its competitor. The Complainant has also relied on a YouTube interview of the Respondent based on which the Complainant claims that the Respondent is one of the largest holders of .IN domain names in the world and has admitted to picking and

registering domain names around which he can get searches for real products or services online.

- x. The Complainant states that domainers undertaking bulk purchases or automated registrations like the Respondent have an affirmative obligation to avoid the registration of trade mark-abusive domain names and that an assumption of bad faith exists if the Respondent has professionally invested in domain names, or if it has been found to have engaged in a pattern of abusive registrations of domain names and therefore, the Respondent ought to have known about the Complainant's registered and well-known trade mark.

## **6. Discussion and Findings**

As per paragraph 4 of the .IN Domain Name Dispute Resolution Policy (INDRP), any person who considers that a registered domain name conflicts with his legitimate rights or interests may file a Complaint to the .IN Registry on the following premises:

- i. The Registrant's domain name is identical or confusingly similar to the name, trade mark or service mark in which the Complainant has rights;
- ii. The Registrant has no rights or legitimate interests in respect of the domain name;
- iii. The registrant's domain name has been registered or is being used in bad faith.

This Tribunal considers the extant dispute to be well within the scope of the INDRP Policy and does not find merit in the Respondent's contention that this case is not one of cybersquatting on account of which this Tribunal is not the appropriate forum. It is a clear case of domain name dispute and falls within the ambit of the INDRP Policy and Rules of Procedure. At any rate, the registration agreement pursuant to which the disputed domain name was purchased by the Respondent also incorporates the INDRP Policy and therefore, the INDRP Policy would



apply to the present dispute. Thus, this Tribunal has the jurisdiction to adjudicate the extant dispute.

Based upon the pleadings, it is now required to be examined as to whether the parties have been able to justify/rebut the aforesaid premises:

### **6.1. Identical or confusingly similar trade/service mark**

As per the WHOIS records, the Respondent registered the disputed domain name ‘fireball.in’ on July 03, 2018.

The Complainant is the proprietor of the registered trade mark ‘FIREBALL’/



in classes 32 and 33 and has obtained registrations in respect of the same with the earliest registration for the mark ‘FIREBALL’ dating back to the year 2013 in India and the earliest registration internationally dating back to the year 1997 in Canada. In order to substantiate the aforesaid, the Complainant has relied on registration certificates for the trade mark ‘FIREBALL’ and claims to have been substantially and continuously using the mark ‘FIREBALL’ in relation to its business/products/services.

The disputed domain name incorporates the mark ‘FIREBALL’ in its entirety. It has been held in *Inter-Continental Hotels Corporation vs. Abdul Hameed* (INDRP/278) as well as in *Indian Hotels Company Limited vs. Mr. Sanjay Jha* (INDRP/148) that when a disputed domain name incorporates a mark in entirety, it is adequate to prove that the disputed domain name is either identical or confusingly similar to the mark.

Coming to the Respondent’s contention that the mark FIREBALL has become generic and that the Complainant should not be seen to have “rights” in respect of the mark used and/or registered, this Tribunal is unable to agree with the same. FIREBALL is the registered trade

mark of the Complainant in India and in numerous other countries and the fact that Complainant is diligently enforcing its rights in the said trade mark itself demonstrates to the contrary. At any rate, it is a well-accepted principle of law that where a party owns a registration for its mark, such registration would carry with it a presumption of validity. To decide whether the domain name in question is identical or deceptively similar to complainant's trade mark, this Tribunal need not embark on a detailed exercise as to whether the mark is generic or not, which is the domain of Courts.

Therefore, as seen from above, the Complainant has registered the trade mark 'FIREBALL' in India dating back to the year 2013 as well as internationally dating back to the year 1997 in Canada and is doing/operating business thereunder continuously. The Respondent on the other hand registered the domain 'fireball.in' much subsequent to the Complainant i.e. on July 03, 2018.

In view of the foregoing discussions, the Complainant has satisfied this Tribunal that:

- i. The domain name in question 'fireball.in' is confusingly similar to the Complainant's prior registered trade mark 'FIREBALL'; and
- ii. It has prior statutory rights in respect of the mark 'FIREBALL'.

## **6.2 Rights and legitimate interests**

The Complainant has asserted that the Respondent has no rights or legitimate interests in the disputed domain name. Paragraph 7 of the INDRP enumerates three circumstances (in particular but without limitation) and if the Arbitrator finds that the Registrant has proved any of the said circumstances that shall demonstrate its rights to or legitimate interests in the disputed domain name. The said paragraph is reproduced hereinbelow:

*“7. Registrant's Rights to and Legitimate Interests in the Domain Name – Any of the following circumstances, in particular but without limitation, if found by the Arbitrator to be proved based on its evaluation of all evidence presented, shall demonstrate the Registrant's rights to or legitimate interests in the domain name for the purposes of Paragraph 4 (ii):*

*i. Before any notice to the Registrant of the dispute, the Registrant's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name with a bona fide offering of goods or services;*

*ii. The Registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trade mark or service mark rights; or*

*iii. The Registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.”*

The Respondent claims that since the domain name consists of a dictionary term and is descriptive, then such use of the domain name would establish legitimate interest.

Merely registering a domain name comprising a dictionary word or phrase does not by itself automatically confer rights or legitimate interests on the Respondent. On the contrary, in order to find rights or legitimate interests in a domain name based on its dictionary meaning, the domain name should be genuinely used, or at least demonstrably intended for such use and not to trade off third-party trade mark rights. In the present case, the Respondent has not commenced use of the domain name even two years after having registered it. The Respondent has merely averred that he registered the disputed domain name to build an alumni website yet has failed to demonstrate any tangible preparation for use of the disputed domain name. The Respondent was an alumni since the year 2000 and registered the domain name purportedly for

an alumni website in the year 2018. There are numerous other ccTLDs but the Respondent chose the .IN extension since the Dean of Faculty of his college happened to be an Indian. In addition, Respondent has pleaded varied reasons for adoption of the disputed domain name such as by being a person interested in astronomy, etc. The said theories and stories to justify adoption of the disputed domain name seem far from having any legitimate interest.

There is no evidence on record to suggest that the disputed domain name is being used by the Respondent in the course of its trade or business or that the Respondent has undertaken demonstrable preparations for the same. The Respondent claims to be commonly known as 'FIREBALL' and has averred that its college and its alumni group is referred to as the "Fireball Family". However, this does not justify how the Respondent himself is commonly known and/or referred by the phrase "Fireball Family" since it is used in connection with the alumni group collectively on behalf of the McMaster Faculty of Engineering, and not an individual such as the Respondent. By its own admission, the Respondent's business is referred to as 'Treadall' and therefore, the Respondent as an individual cannot claim to be commonly known as 'FIREBALL'.

It has been held in *Imperial College of Science, Technology and Medicine v. Zahid Khan (for Imperial College Management School Alumni Association - ICMSAA)*, WIPO Case No. D2000-1079 that members graduated from a college were not entitled to capitalize on the said fact by using domain names, in respect of which the college clearly had a legitimate claim, without the consent of the college. In fact, it was held that the Respondent therein did not have any right to go about appropriating other domain names in respect of which the complainant (i.e. the college the respondent graduated from) had a strong legitimate claim. Therefore, in the present circumstances, the Respondent cannot be allowed to appropriate the domain name 'fireball.in' at any rate since the mark/slogan 'Fireball Family' can be said to be proprietary to the McMaster Faculty of Engineering and not the Respondent personally to claim any right in

respect of. Going by the Respondent's logic, alumni's from IVY league universities should be allowed to register and claim rights over domain names comprising the registered trade marks/names of universities, which would have absurd consequences and perpetrate trade mark violations.

It is a settled position that if the Respondent does not have trade mark rights in the word corresponding to the disputed domain name and in the absence of evidence that the Respondent was commonly known by the disputed domain name, the Respondent can have no rights or legitimate interest. [See *Shulton Inc. v. Mr. Bhaskar*, (INDRP/483)].

This Tribunal deems it prudent to mention that the Respondent has sought to rely on various decisions of different Panels to demonstrate its legitimate rights or interest in the disputed domain name, however, the Respondent has not considered that most of these decisions rely on circumstances where the Respondent could demonstrate a reasonable use or a connection between the use and the disputed domain name, which unfortunately is not the case with the Respondent in the present proceedings.

The final ingredient to be proved by the Respondent is that the disputed domain name is used in a non-commercial manner or that there is fair use of the domain name without intent for commercial gain misleading divert consumers or to tarnish the trade mark or service mark at issue. As stated above, the Respondent has not even commenced use of the domain name even two years after registering it to amount to fair use and at any rate, prior to the Complaint, admittedly, the domain name was simply parked and was available for purchase some time back as well.

In view of the above, this Tribunal is of the view that the Respondent has been unable to prove that it has been using the mark 'FIREBALL' or the disputed domain name 'fireball.in' in

connection with a *bona fide* offering of goods or services. The Complainant has thus proved that the Respondent has no rights or legitimate interests in the disputed domain name.

### **6.3 Bad faith**

Paragraph 6 of the INDRP enumerates the circumstances evidencing registration and use of domain name in bad faith. The said paragraph is reproduced herein under:

*“6. Evidence of Registration and use of Domain Name in Bad Faith – For the purposes of Paragraph 4(iii), the following circumstances, in particular but without limitation, if found by the Arbitrator to be present, shall be evidence of the registration and use of a domain name in bad faith:*

- i. Circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant, who bears the name or is the owner of the trade mark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented out-of-pocket costs directly related to the domain name; or*
- ii. the Registrant has registered the domain name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that the Registrant has engaged in a pattern of such conduct; or*
- iii. by using the domain name, the Registrant has intentionally attempted to attract Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.”*

The Respondent, by its own admission, has stated that it has registered several common-word and combined letter domain names for investment purposes. It is submitted that a history of registering .IN domain names indicates that the Respondent has been actively engaged in buying domain names and therefore, an affirmative obligation is cast upon the Respondent to avoid the registration of trade mark-abusive domain names. Accordingly, an assumption of bad faith exists if the Respondent has professionally invested in domain names comprising legitimate trade marks of third parties, or if it has been found to have engaged in a pattern of abusive registrations of domain.

By the Respondent's own admission in the YouTube interview placed on record by the Complainant, the Respondent states that he is one of the largest holders of .IN domain names in the world who cumulatively owns around 7500 .IN domain names out of which around 900 pertain to three-lettered .IN domain names; around 450 pertain to '.CO.IN' domain names; around 180 pertain to three-numbered .IN domain names and around 300 pertain to four-numbered .IN domain names. It is pertinent to note that the Respondent admits to picking and registering these domain names where he can get a creative business around the product or where he can get searches for real products or services online. Therefore, it is evident that the Respondent has indulged in a carefully thought out practice of selectively registering domain names to maximise its business and views.

It is further implied that the Respondent conducts brief internet searches around a domain name that he intends to register and therefore, the Respondent cannot feign complete ignorance about the Complainant's registered trade mark 'FIREBALL', a brand of whisky that originated in Canada which evidently appears to have numerous references and articles available online in order to come into the knowledge of the Respondent. The Respondent also admits that he has absolutely no connection to India whatsoever, and that he adopted .IN domain names purely because of the fact that India is gigantic and is growing quickly. The Respondent's own

admissions placed on record by the Complainant clearly establish that the Respondent chooses domain names that are similar to already existing products and/or services to misdirect consumers and the public to its own parked pages. Therefore, the Respondent's practice of buying .IN domain names in bulk appears to a business model to augment and garner profits with little or no regard for the trade mark rights of legitimate intellectual property right holders.

It was held in *Mobile Communication Service Inc. v. WebReg, RN*, WIPO Case No. D2005-1304 and *Terroni Inc. v. Gioacchino Zerbo*, WIPO Case No. D2008-0666 that where a Respondent registers large swaths of domain names for resale with no attention whatsoever to whether they may be identical to trade marks, such practices may well support a finding that the Respondent is engaged in a pattern of conduct that deprives trade mark owners of the ability to register domain names reflecting their marks.

Additionally, it was held in *mVisible Technologies, Inc. v. Navigation Catalyst Systems, Inc.*, WIPO Case No. D2007-1141 that there may be no obligation that a domain name registrant is required to conduct trade mark or search engine searches to determine whether a domain name may infringe trade mark rights, but a sophisticated domainer, such as the Respondent, who regularly registers domain names cannot be wilfully blind to whether a particular domain may violate trade mark rights. In this context, a failure to conduct adequate searches may give rise to an inference of bad faith and knowledge. Several decisions have applied this concept of wilful blindness on the Respondent's part as a basis for a finding of bad faith on the part of the Respondent. In the instant case, the present Respondent can be termed as a sophisticated domainer having registered approx. 7500 domain names and has even postulated arguments about a trade mark being generic in nature but did not even bother to check before registering whether the domain name may end up violating another one's trade mark rights or not. In the instant case, from the documents, it appears that Complainant's mark/brand FIREBALL has



obtained notoriety in USA and Canada and it is hard to believe that the Respondent who is based in Canada is completely ignorant of the same.

Further, the Respondent has claimed that he registered the domain 'fireball.in' since he belongs to the "Fireball Family" being an alumni of McMaster University however as per the Complainant, the Respondent did not register domains such as 'fireballfamily.com', 'fireballalumni.com', etc. but chose to register 'fireball.in'. It is pertinent to note that the aforementioned domain names if registered by the Respondent would clearly signify the Respondent's connection to the university on behalf of which it claims rights in the mark 'FIREBALL' as against just the domain 'fireball.in' and yet, the Respondent has not registered any such domain names which could advance the connection it seeks to build with its alumnus.

Interestingly, the Respondent claims to have also registered several other domain names comprising the mark 'FIRE' such as 'fireprotection.in', 'firewood.in', 'firesafe.in', etc. to establish his good faith in registering the disputed domain name. However, these domain names consist entirely of generic words, which cannot be compared to the disputed domain name that comprises the Complainant's registered trade mark 'FIREBALL' and given that the Respondent has simply parked these domain names as well, continues to offer some of them for sale even and has failed to make any genuine use of them to date further establishes its *mala fide* in registering them in the first place.

Additionally, the aforesaid argument at any rate appears to be flawed at best as going by that logic, the Respondent registered the domain name 'fireball.in' because it comprises the generic word 'fire' whereas it is the case of the Respondent that the rationale for registration of the disputed domain name is its connection to the 'Fireball Family' of the McMaster University. This conduct of the Respondent clearly smacks of *mala fide* and demonstrates how the Respondent is constantly blowing hot and cold in an attempt to portray *bona fide* intentions of registering the disputed domain name when none exist.

The Respondent's submission that it was his intention to develop a website on the disputed domain name appears to be unsupported since soon after registration of the disputed domain name, the said domain was available for purchase by third parties as is evidenced by the screenshot from Wayback Machine dating back to August 2018 placed on record by the Complainant. Therefore, the fact that that the Respondent sought to offer the disputed domain name for sale establishes its dishonest conduct and bad faith and clearly demonstrates that the Respondent never intended to make any *bona fide* use of the disputed domain name for any legitimate business interest, let alone an alumni website. To the contrary, the reasonable conclusion that follows is that the Respondent's business and conduct was armed with the motive of parking the disputed domain name and/or selling it to its rightful owner/third parties at a high price for profit.

In fact, by registering the disputed domain name, the Respondent has attempted to attract internet users by creating likelihood of confusion with the Complainant's mark/source of origin. [See *Colgate – Palmolive Company and Colgate Palmolive (India) Ltd. v. Zhaxia*, (INDRP/887)]. Thus, it can be inferred that the Respondent has registered the disputed domain name in bad faith to tarnish the trade mark and cause confusion in the minds of the public. It has also been held in the cases of *LinkedIn Corporation v. David Naranjo, All Play Media*, WIPO Case No. D2019-2784 and *V&V Vin&Sprit AB v. Wallin*, WIPO Case No. D2003-0437 that bad faith can be established where a domain name is so obviously connected with a well-known trade mark that its very use by someone with no connection to the trade mark suggests opportunistic bad faith. It is also evident that the objective of registering the disputed domain name was aimed at preventing the legitimate owner of the trade mark from reflecting the same in a corresponding domain name since to date no website is functional corresponding to the disputed domain name.

Substantial number of precedents establish that registration of a domain name that is identical/confusingly similar to a famous trade mark by any entity that has no relationship to that mark is itself sufficient evidence of bad faith registration and use. [See *Pepperdine University v. BDC Partners, Inc.*, WIPO Case No. D2006-1003; *Veuve Clicquot Ponsardin, Maison Fonde en 1772 v. The Polygenix Group Co.*, WIPO Case No. D2000-0163, *Mastercard International Incorporated v. Total Card Inc.*, WIPO Case No. 2000 – 1411].

Considering that the current status of the webpage corresponding to the domain name ‘fireball.in’ is non-operational/inaccessible and the WHOIS records do not indicate the domain being available for sale, this would constitute passive/parked holding of the domain name/website, which further contributes to bad faith. [See: *HSBC Holdings plc v. Hooman Esmail Zadeh* (INDRP/032), *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003].

In view of the foregoing, the Tribunal is of the view that the Respondent has registered the domain name ‘fireball.in’ in bad faith.

Lastly, on the question of reverse domain name hijacking, this Tribunal is of the opinion that the Complainant has filed the present complaint in good faith based on its prior statutory and proprietary rights vesting in the mark ‘FIREBALL’ and based on its common law rights by virtue of extensive use thereof worldwide. It was held in *Futureworld Consultancy (Pty) Limited v. Online Advice*, WIPO Case No. D2003-0297 that a finding of reverse domain name hijacking is only made if the Complainant knew or should have known at the time that it filed the Complaint that it could not prove that the domain name was registered in bad faith. In such cases, the Respondent must show either that the Complainant knew of Respondent’s unassailable right or legitimate interest in the disputed domain name or the clear lack of bad faith registration and use. Based on the foregoing, the complaint has been found to have a *bona fide* basis and the Complainant has made detailed submissions on its part to emphasize a

legitimate concern on its part that the disputed domain name was registered in bad faith by the Respondent and therefore, this Tribunal declines to make a finding of reverse domain name hijacking in the present case.

## **7. Award**

From the foregoing findings, it is established beyond doubt that (1) the domain name is confusingly similar to the mark 'FIREBALL' which is proprietary to the Complainant, (2) the Respondent has no rights or legitimate interests in respect of the disputed domain name, and (3) the domain name is registered in bad faith.

Thus, in accordance with the Policy and Rules, this Arbitral Tribunal directs the Respondent to immediately transfer the disputed domain name 'fireball.in' to the Complainant.

The parties shall bear their own cost.

**Dated: September 23, 2020**

**C.A. Brijesh**  
Sole Arbitrator