

दिल्ली DELHI

ARBITRATION CASE NO.8 OF 2011

N 998009

IN THE ARBITRATION MATTER OF:-

GOOGLE, INC..

COMPLAINANT

VERSUS

MR. GULSHAN KHATRI

RESPONDENT

AWARD

The present dispute relates to the registration of the domain name <googlee.in> in favour of the Respondent.

The Complainant has filed the instant complaint challenging the registration of the domain name <googlee.in> in favour of the respondent. The grievance of the complainant is not with the date or mode of registration of the domain name in favour of the Respondent but the later's act of adopting an identical domain name and that also in respect of similar services to that of the complainant.

The Complainant has contended that it is in the business of running the internet search engines and has established itself world-wide. The complainant exerts its right over the brand name/ registered mark 'GOOGLE' and has contended that it has adopted its extensive usage way back from 1997. The Complainant has

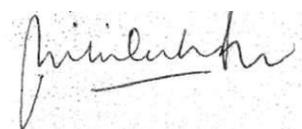
that it has adopted its extensive usage way back from 1997. The Complainant has contended in its claim that the Respondent simply wishes to usurp the domain name and ride on the goodwill that the Complainant has built over the years by its hard work.

The Complainant has contended that the disputed domain name is visually, conceptually and substantially identical to the Complainant's domain name and that there is no difference between both the domain names. The complainant further contended that the name <googlee.in> appears immediately and obviously connected with the Complainant and its business and the public would perceive it as such. It is also contended that both the domain names are used as search engines. The Complainant further contended that the confusion which is likely to be brought into people's mind through the disputed domain name would not only improperly benefit the Respondent but also disrupt the business of the Complainant, dilute its rights and expose it to the risk of fraud.

The Complainant has further submitted that the disputed domain name was registered in favour of the respondent on 17th February 2007 whereas the same domain name <googlee.in> had been extensively operating and serving the market worldwide way back from 1997. Furthermore the Complainant submitted that it has not authorized, licensed or otherwise consented to the Respondent's use of its mark or brand.

Thus being aggrieved by the said registration of the disputed domain name in favour of the respondent, the Complainant filed the present complaint under the INDRP policy. However, in response to the instant complaint, Respondent has Offered no explanation for adoption of a virtually identical domain name 'googlee.in'. Further, it has also not denied the knowledge and use of the domain name/trade mark 'google' by the Complainant. The respondent has even failed to give any explanation/ evidence in adopting a domain name which is virtually identical to the Complainant's already existing and renowned mark/ domain name. In the interest of justice. any further delay in decidina this matter is uncalled for.

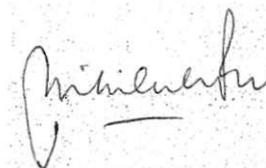
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Hence I choose to proceed with the adjudication of the said matter on the basis of the documents and pleadings which are already on record.

In support of the contentions the Complainant relied on the following findings of the various Hon'ble Courts and Designated Authorities:

1. Satyam Infoway Ltd v Sifynet Solutions Pvt Ltd, Civil appeal No 3028/2004 (supreme Court) wherein it was held that " use of same or similar domain name may lead to diversion of users which could result from such users mistakenly accessing one domain instead of another"
2. Yahoo Inc V Akash Arora, Suit No 2469/1998 (Delhi High Court) which held that "it is obvious where the parties are engaged in common or overlapping fields of activity, the competition would take place. If the two contesting parties are involved in the same line or similar line of business, there is grave and immense possibility for confusion and deception and, therefore, there is probability of sufferance of damages"
3. Acqua Minerals Ltd V Pramod Bose and another Suit No 371/2000 wherein it was held that "With the advancement of internet communication, the domain name has attained as much legal sanity as a trade name. Since the services rendered by the internet are crucial for any business, the domain name needs to be preserved so as to protect such provider of services against anyone else trying to traffic or usurp the domain name"
4. WIPO Arbitration and Mediation Cente (ADMINISTRATIVE PANEL DECISION) Germanwings GmbH v. Domain Admin. Privacy Protect.org which held that "the Complainant is under no obligation to use the provisions available during the sunrise period in order to protect its mark. It is perfectly free to invoke the Policy after the sunrise period and this whether or not it invoked the special provisions available during the sunrise period".



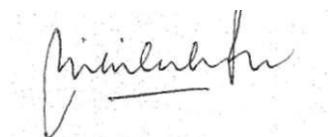
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On the analysis of the document and record submitted by the Complainant it is found that the Complainant had registered the trademark "GOOGLE" and it has been in use with respect to the business activities of the Complainant since 1997. The Complainant is also the registrant of the domain names <googlee.in>. The connection between trademarks and domain names has been well observed in various national and international cases. Recently, authorities in India **Yahoo! Inc VS. Akash Arora; 78(1999) Delhi Law Times 285**], the U.K. (**Marks & Apences & Ors Vs. One in a Millions & Ors.**), Taiwan(**fair Trade Committee 89 Gong Zhu Zi No.036**), Italy, Germany, and the USA, among other jurisdiction, have ruled that the act of registering a domain name similar to or identical with or famous trade mark is an act of unfair competition whereby the domain name registrant takes unfair advantage of the fame of the trademark to either increase traffic to the domain, or to seize a potential asset of the trademark owner in the hope that the trademark owner will pay the requirement to relinquish the domain name.

In this context, I rely on the findings in the landmark judgment of **Yahoo! Inc. Vs. Akash Arora & Anr. 78(1999) Delhi Law Times 285**; The Court observed that the services of the plaintiff under the trademark/domain name 'Yahoo!' have been widely publicised and written about globally. In an internet service, a particular internet site could be reached by anyone anywhere in the world who proposes to visit the said internet site.... as a matter of fact in matter where services are rendered through the domain name in the internet, a very alert vigil is necessary and a strict view is to be taken for its easy access and reach by anyone from any corner of the globe.....there can be no two opinions that the two marks/domain names 'Yahoo!' of the plaintiff and "Yahooindia" of the defendant are almost similar.... and there is every possibility and likelihood of confusion and deception being caused. The plaintiffs herein were thus granted ad interim injunction restraining the defendants from using the domain name 'Yahooindia.com'.

In this context I also rely upon a decision in **Sony Ericsson Mobile Communications AB vs. Farhang Farnood, Decision of INDRP dated**

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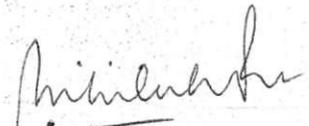
February 20th ,2007 wherein the dispute was with respect to Complainant's registered domain name 'sonyericsson.in' vis-a-vis Respondent's registration of the domain name 'sonyericson.in'. They were phonetically similar and they both consist of similar 'letters or words' except that in respondent's domain name alphabet, "s", was absent. Here the Complainant's registered trademark was 'SONYERICSSON'. Herein the complainant's submission that the respondent's domain name was conceptually and confusingly similar to the complainant's trade mark was accepted and judgement was passed by protecting the rights of the complainant.

From the evidences submitted by the Complainant, I find that the Complainant is the proprietor and registered owner/mark of the word 'google' and its associated domain name <googlee.in>. I find that the impugned domain name <googlee.in> is identical and confusingly similar to the other prior registered domain name and registered trade mark of the complainant.

Considering the facts and circumstances of the present matter and taking view of the precedents laid in the context,thereof, I am of the view that the complainant has proprietary right over the domain name <googlee.in>. Under the facts and circumstances and on perusal of the records, I deem it fit and proper to allow the prayer of the Complainant regarding cancellation of the disputed domain name granted in favour of the respondent and direct the Registry to cancel the said domain name forthwith and transfer the said domain name i.e. <googlee.in> in favour of the Complainant.

Parties to bear their costs.

DATED: 06th May 2011


[NIKILESH RAMACHANDRAN]
ARBITRATOR