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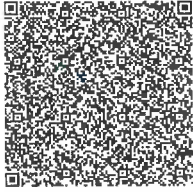
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Stamp Duty Paid By : ROBIN RATNAKAR DAVID
Stamp Duty Amount(Rs.) : 100
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BEFORE THE .IN REGISTRY OF INDIA
INDRP CASE NO. 1474

IN THE MATTER OF AN ARBITRATION UNDER THE .IN DOMAIN NAME DISPUTE
RESOLUTION POLICY; THE INDRP RULES OF PROCEDURE AND THE
ARBITRATION AND CONCILIATION ACT, 1996

FINAL AWARD

Robin

Page 1 of 17

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BEFORE THE .IN REGISTRY OF INDIA

INDRP CASE NO. 1474

**IN THE MATTER OF AN ARBITRATION UNDER THE .IN DOMAIN
NAME DISPUTE RESOLUTION POLICY THE INDRP RULES OF
PROCEDURE AND THE ARBITRATION AND CONCILIATION ACT,
1996**

IN THE MATTER OF:

SmileDirectClub, LLC
14 Union Street, 8th Floor
NashVille, TN 37219
United States of America

...Claimant

Versus

smiledirectclub.co.in
Through the owner / representative - "Alex Wang"
Email: himeme@foxmail.com
Pudong, Shanghai - 210016
China
Ph. +86.02186868888

...Respondent

A DISPUTE RELATING TO THE DOMAIN NAME -
smiledirectclub.co.in

FINAL AWARD

Dated: 16 February, 2022
Venue: New Delhi, India



**ROBIN RATNAKAR DAVID
SOLE ARBITRATOR**

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I. PARTIES TO THE ARBITRATION

a) The Complainant

The Complainant is SmileDirectClub, LLC, a Limited Liability Company formed and existing under the laws of the State of Tennessee, addressed at 414 Union Street, 8th Floor, Nashville, TN 37219, USA. The Complainant is the registered proprietor of the word mark “SMILE DIRET CLUB” in India and also the registrant of the top-level domain (TLD) name smiledirectclub.com and several other domain names. The Complainant is represented by BERUAR & BERUAR LLP, D-155, 3rd Floor, Defence Colony, New Delhi - 110024, Phone: +91 9910044787, rahul.beruar@beruar.com

b) The Respondent

The Respondent is smiledirectclub.co.in, Alex Wang, Pudong, Shanghai - 210016, China, Phone +86.02186868888, himeme@foxmail.com

II. APPLICABLE LAW AND JURISDICTION

The .IN Domain Name Dispute Resolution Policy

- a) The present arbitration proceeding is under and in accordance with the .IN Domain Name Dispute Resolution Policy (the Policy) which was adopted by the National Internet Exchange of India (NIXI) and sets out the legal framework for resolution of disputes between a domain name registrant and a complainant arising out of the registration and use of an .IN Domain Name. By registering the domain name smiledirectclub.co.in with the NIXI



accredited Registrar, the Respondent has agreed to the resolution of disputes under the .IN Dispute Resolution Policy and Rules framed thereunder. The Policy and the .IN Domain Name Dispute Resolution Rules of Procedure posted on 16 September 2020 (the Rules) were approved by NIXI in accordance with the Arbitration and Conciliation Act, 1996.

- b) The Complainant filed a Complaint under the .IN Domain Name Dispute Resolution Policy against the Respondent, seeking the transfer of Domain Name `smiledirectclub.co.in` to the Complainant. On 17th December, 2021, the .IN Registry sought the consent of Mr. Robin Ratnakar David (the undersigned), who is a listed .IN Dispute Resolution Arbitrator under Rule 5 (a) of the Rules, to act as Arbitrator in this matter. Accordingly, consent was given, and this Arbitral Tribunal was constituted on 17th December, 2021 under Rule 5(b) of the Rules. On 21st December, 2021 the Arbitral Tribunal issued the notice of arbitration as required under Rule 5(c) of the Rules. The Respondent was granted an opportunity to file its response by 28th December 2021. The Tribunal served the Notice of Arbitration on the Respondent by email. The Tribunal also directed the Complainant to serve the Respondent by email. The Complainant informed the Tribunal that it complied with the directions and effected service on the Respondent. However, no response was filed by the Respondent.
- c) The Arbitral Tribunal has been constituted properly and in accordance with the Arbitration and Conciliation Act, 1996, the INDRP Policy and the Rules as amended from time to time. No party has objected to the constitution and jurisdiction of the Arbitral Tribunal and to the arbitrability of the dispute.



III. THE DOMAIN NAME, REGISTRAR & REGISTRANT

The disputed domain name smiledirectclub.co.in is registered with Endurance Digital Domains Technology LLP, <https://publicdomainregistry.com> having registrar IANA ID :801217

User Form	smiledirectclub.co.in
ROID	D41440000005296247-IN
Registrar Name	Endurance Digital Domains Technology LLP
IANA ID	801217
Create Date	2021-10-18T08:54:45Z
Expiry Date	2017-11-02T15:40:21Z
Last updated Date	2022-11-02T15:40:21Z
Domain State	clientTransferProhibited
Assigned Name servers	
International Postal City	REDACTED FOR PRIVACY
International Postal State	Shanghai
International Postal Postcode/Zip Code	REDACTED FOR PRIVACY
International Postal Country	CN
Registrant Registrar Name	Endurance Digital Domains Technology LLP
Registrant Registrar IANA ID	801217

IV. PROCEDURAL HISTORY

- a) On 21st December, 2021, the Arbitral Tribunal issued the Notice of Arbitration to the Respondent by email alongwith the Complaint and Annexures. The Respondent was given an opportunity to file a Response in writing in opposition to the Complaint, if any, along with evidence in support of its stand or contention on or before 28th December, 2021. The Complainant was directed to serve a soft copy of the Notice of Arbitration with the Complaint and annexures on the Respondent. The Complaint (including annexures) was sent to the email address of the Respondent

shown in the WHOIS details, accordingly, the service on the Respondent was done in accordance with Rule 2 of the Rules.

V. PARTIES CONTENTIONS

a) THE CLAIMANT

1. The Complainant contends that the Respondent has no rights in any trademarks that comprise part or all of the disputed Domain Name and the same is identical to the Complainant's rights.
2. The Complainant has asserted that it is the owner of the following rights:
 - i) Indian Trade Mark Registration No. 3653330 for "SMILEDIRECTCLUB", registered on 9th October 2017 and covering "online direct-to-consumer retail store services for orthodontic appliances; online direct-to-consumer retail store services for dental apparatus and instruments; retail store services for orthodontic appliances; and retail store services for dental apparatus and instruments" in Class 35" and "dentistry services; orthodontic services; teeth whitening services; dental assistant services; dental consultations; provision of dental clinic services; provision of information relating to dentistry; and telemedicine services for dentistry" in Class 44;
3. Complainant relies on WIPO UDRP case no. DNL2019-0055 and CEPANI case no.44498 Panels rulings which have held that the Claimant enjoys a reputation in its SMILEDIRECTCLUB trademark:



- i) DNL2019-0055: SmileDirectClub, LLC had presented “...compelling evidence that its SMILEDIRETCLUB trademark has been registered in many countries around the world, transacts enormous amount of business by reference to those marks and is one of the market leaders in the clear aligner industry around the world”.
 - ii) 44498: SmileDirectClub, LLC “:... has registered its SMILEDIRETCLUB trademark in many countries around the world for inter alia clear aligner products and related dental services and is one of the market leaders in the world.”
4. It is asserted that the Respondent does not own any registered rights in any trademarks or any legitimate business in any industry that comprise part or all of the disputed Domain Name. The term ‘SMILEDIRECTCLUB’ is not descriptive in any way, nor does it have any generic, dictionary meaning. The Claimant has not authorised the Respondent to reproduce its registered trademark in a domain name registration.
5. Claimant states that the disputed domain name held by the Respondent is bound to cause confusion in the minds of the General Public as the Claimant’s trademark “SMILEDIRECTCLUB” is a well-known brand globally and the products/services has also acquired distinctiveness, tremendous goodwill and well-known reputation. Therefore, the Respondent cannot possibly have any reason or justification for adopting trademark/domain name identical to Claimant’s trademark “SMILEDIRECTCLUB”.



6. The Claimant submits that the Respondent was aware of the Claimant's Rights at the time it registered the Domain Name; the disputed Domain Name, smiledirectclub.co.in is virtually identical to the Claimant's core Domain Name, smiledirectclub.com and Trademark SMILEDIRECTCLUB, which the Claimant suggests was a calculated decision and hence done in bad faith.

7. The Complainant submits that the Respondent's details are not available on its website which indicates that the Respondent avoids and circumvent any legal liability in relation to the Disputed Domain name. The Respondent's disputed domain name smiledirectclub.co.in was registered on 2nd November 2017 after 3 years of the registration of the Claimants domain name smiledirectclub.com. The Respondent's disputed domain name "smiledirectclub.co.in" contains hyperlinks which directs to the third party websites which pertain to independent organizations offering similar services to those of Claimant i.e. dental care products and services including dentistry hospitals and clinics which is intended to deliberately posting content to deceive consumers of the Claimant's brand "SMILEDIRECTCLUB" and has caused loss to the Claimant in its business and goodwill by misleading the content.

8. The Claimant submits that the Respondent has also displayed a notice on the webpage hosted on the disputed domain name stating that "The domain smiledirectclub.co.in may be for sale. Click here to inquire about this domain." which shows that the Respondent is not doing any business or trade through the disputed domain name and is merely hoarding to sell the domain name to the highest bidder.



9. The Claimant submits that the Respondent has also registered other domain name “smiledirectclub.in” which is also entirely similar to the Claimant’s domain name and is misleading and deceptive in nature.

10. The Claimant submits that the counsel of the Claimant has attempted to resolve the dispute. The Claimant’s counsel on 12th March 2020 expressed interest in purchasing the dispute domain name by clicking through the tab provided on the webpage of the disputed domain name “The domain smiledirectclub.co.in may be for sale. Click here to inquire about this domain.” wherein it was quoted a consideration of 500 USD for the disputed domain name. The Respondent via email dated 13th March, 2020 stated that his client’s price is 5000 USD for each of the Disputed domain name “smiledirectclub.co.in” and “smiledirectclub.in” where the Respondent is reluctant to sell single domain name separately. Therefore, it shows the clear intention of the Respondent does not have any legitimate interest in the disputed domain name.

b) THE RESPONDENT

1. The Respondent has not filed any response to the Notice of Arbitration dated 21st December, 2021. The Respondent has not replied to the contentions of the Complainant even though the Respondent has been served under the Rules. The emails of service sent to the Respondent were not returned undelivered. However, the Respondent's default would not automatically result in a decision in favour of the Complainant. The Supreme Court in *Sudha Agrawal v X Additional District Judge and others* (1996) 6 SCC 332 held that even in an uncontested matter the petitioner’s case must stand on its own legs and it cannot derive any advantage by the absence of the defendants.



Therefore, the Complainant must still establish each of the three elements required by paragraph 4 of the Policy.

VI. DISCUSSIONS AND FINDINGS

1. A Complainant who alleges that the disputed domain name conflicts with its legitimate rights or interests must establish the following three elements required by Paragraph 4 of the Policy¹ namely:

- a) The Respondent's domain name is identical and confusingly similar to the trademark or service mark in which the Complainant has rights.
- b) The Respondent has no rights or legitimate interests in respect of the domain name; and
- c) The Respondent's domain name has been registered or is being used in bad faith.

2. Accordingly, the Arbitral Tribunal shall deal with each of the elements as under:

- a) **The Registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights.**

¹ 4. Class of Disputes

4. Class of Disputes: Any Person who considers that a registered domain name conflicts with his/her legitimate rights or interests may file a Complaint to the .IN Registry on the following premises:

- (a) the Registrant's domain name is identical and/or confusingly similar to a name, trademark or service mark in which the Complainant has rights; and
- (b) the Registrant has no rights or legitimate interests in respect of the domain name; and
- (c) the Registrant's domain name has been registered or is being used in bad faith.



- (i) The Complainant has contended that it owns Indian Trademark registrations as well as international trademark registrations of the SMILEDIRECTCLUB trademarks. The Complainant is the holder of trademark registered with the USTPO. The Complainant also placed reliance on WIPO Case No. DNL2019-0055 and CEPANI case No. 44498 to show that the Claimant enjoys a reputation in its SMILEDIRECTCLUB trademark. The Complainant also contends that it owns the website smiledirectclub.com and has sold 800,000 products and has generated 1 billion USD globally between 2016-2019. A careful consideration of the Trademark registrations and WIPO decisions abovementioned relied on by the Complainant establish the Complainant owns and holds intellectual property rights in the name, trademark and brand SMILEDIRECTCLUB in India and other jurisdictions.
- (ii) A visual comparison of the disputed domain name smiledirectclub.co.in of the Respondent with the Complainant's name, trademark, brand SMILEDIRECTCLUB demonstrate that "SMILEDIRECTCLUB" is entirely contained in the disputed domain name of the Respondent.
- (iii) In *Yahoo! Inc. v Akash Arora & Anr. (1999 PTC (19)210 Delhi)*, the Hon'ble Delhi High Court enjoined the use of domain name 'yahooindia.com' in a suit filed by Yahoo! Inc., the owner of the trademark "Yahoo" and the domain



name <yahoo.com> by holding that defendant's domain name incorporated the plaintiff's name in its entirety and was deceptively similar and could be perceived as being that of the Plaintiff's. In *eBay, Inc v. Progressive Life Awareness Network, WIPO Case No. D2001-0068*, the UDRP returned a finding that the domain name <gayebay.com> incorporated the Complainant's mark "ebay" in its entirety which is confusingly similar to Complainant's mark.

- (iv) The registered trademark(s) and brand name "SMILEDIRECTCLUB" is distinctive and the Respondent's domain name "smiledirectclub.co.in" bears the Complainant's registered trademark "SMILEDIRECTCLUB" in its entirety. Considering the similarity between the Complainant's trademark and domain name "SMILEDIRECTCLUB" and the disputed domain name "smiledirectclub.co.in" of the Respondent, the Arbitral Tribunal finds that an average consumer would be led to believe that the Complainant and the Respondent and/or the disputed domain name are related. After taking into consideration the facts of the present case and the settled law on the issue, the Arbitral Tribunal finds that the disputed domain name smiledirectclub.co.in is identical and confusingly similar to the Complainant's registered trademarks and service mark "SMILEDIRECTCLUB". Accordingly, the Arbitral Tribunal holds that the requirement of the first element in the INDRP Policy paragraph 4(a) is satisfied.



b) The Registrant has no rights or legitimate interests in respect of the domain name

(i) To pass muster under paragraph 4(b) of the Policy, the Complainant has to show that the Respondent has no rights to and legitimate interests in the disputed domain name under paragraph 6 of the Policy.

(iii) According to paragraph 3² of the Policy, it is the obligation of the Respondent (registrant) to provide complete and accurate particulars and find out before registration that the domain name intended for registration does not violate the rights of any third party. The Complainant has been able to establish that the Complainant and its trademark, service mark and brand name have been in use since long and is commonly known by the name "SMILEDIRECTCLUB" and that it owns and holds intellectual property rights in the name, trademark and brand name in India and other

² Paragraph 3 of the INDRP:

3. Registrant's Representations

By applying to register a domain name, or by asking a Registrar to maintain or renew a domain name registration, the Registrant hereby represents and warrants that:

- (a) the credentials furnished by the Registrant for registration of domain name are complete and accurate;
- (b) to the knowledge of registrant, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party;
- (c) the Registrant is not registering the domain name for an unlawful and malafide purpose; and
- (d) the Registrant will not knowingly use the domain name in violation or abuse of any applicable laws or regulations.



jurisdictions. However, the disputed domain name smiledirectclub.co.in was created in 2nd November 2017.

- (iv) Accordingly, the Arbitral Tribunal finds that the Complainant has made a prima facie case that the Respondent has no rights and legitimate interests in respect of the disputed domain name smiledirectclub.co.in and has satisfied the second element under paragraph 4 (b) of the Policy.

c) The Registrant's domain name has been registered or is being used in bad faith

- (i) It is evident that the Respondent knew of and targeted Complainant's trademark and Respondent has registered and used the Disputed Domain Name in bad faith. In *Tudor Games, Inc. v. Domain Hostmaster, Customer ID No. 09382953107339 dba Whois Privacy Services Pty Ltd / Domain Administrator, Vertical Axis Inc.*, D2014-1754 (WIPO Jan 12, 2014) has been considered by *Valvoline Licencing and Intellectual Property LLC v. jau Khan* WIPO Case No. D2018-1486 based on the balance of facts set forth above and the latitude of the trademark, it is more likely than not that the Respondent knew of and targeted that Complainant's trademark and Respondent should be found to have registered and used the disputed domain name in bad faith.



Further the use of the term ‘SMILEDIRECTCLUB’ in its entirety in the disputed domain name smiledirectclub.co.in is a deliberate attempt to attract Internet users to its website by creating a likelihood of confusion with the Complainant’s trademark to infringe and violate the rights of the Complainant.

- (ii) Considering the findings above, Arbitral Tribunal holds that the Respondent’s domain name smiledirectclub.co.in has been registered and is being used in bad faith. Therefore, the third element in paragraph 4(c) of the Policy has been satisfied.

Considering the findings above, Arbitral Tribunal holds that the Respondent’s domain name smiledirectclub.co.in has been registered with an opportunistic intention and is being used in bad faith. Therefore, the third element in paragraph 4(c) of the Policy has been satisfied.

VII. DISPOSITIONS

The Arbitral Tribunal holds that the Respondent’s domain name smiledirectclub.co.in is identical and confusingly similar to the name, trademark and brand name “SMILEDIRECTCLUB” owned by the Complainant. The Respondent has no rights or legitimate interests in the domain name smiledirectclub.co.in and the same have been registered in bad faith. The three elements set out in paragraph 4 of the INDRP Policy have been established by the Complainant.



The Arbitral Tribunal directs that the disputed domain name smiledirectclub.co.in be and is transferred to the Complainant, SmileDirectClub, LLC, 14 Union Street, 8th Floor, Nashville, TN37219, United States of America.

Place of Arbitration: New Delhi, India

Date: 16th February, 2022



Robin Ratnakar David
Sole Arbitrator
The Arbitral Tribunal