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ARBITRATION AWARD

.IN REGISTRY

(C/O NATIONAL INTERNET EXCHANGE OF India)

Before the Sole Arbitrator, Binny Kalra

Disputed domain name <**PRIDESTAFFING.IN**>

In the matter of:

INDRP Case No: 1489

PrideStaff, Inc.

vs

Shagun Duggal

Binny Kalra

Complainant

Respondent

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Before the Sole Arbitrator, Binny Kalra

Disputed domain name <**PRIDESTAFFING.IN**>

In the matter of:

PrideStaff, Inc.

7535 N. Palm Ave, Ste. 101

Fresno, California 93711

United States

Complainant

v.

Shagun Duggal

C-2303 GardeniaSquare,

Crossing Republic, Ghaziabad,

Uttar Pradesh 201016

India

Respondent

INDRP Case No: 1489


1. The Parties:

The Complainant is PrideStaff, Inc., a corporation organized under the laws of the State of California, United States. The Complainant is represented in these proceedings by Ms. Samantha M. Quimby, Esq. and Mr. Carl Eppler Esq. of the US law firm Frost Brown Todd LLC.

The Respondent is Shagun Duggal. The respondent is not represented in these proceedings.

2. The domain name, Registrar, and Policy:

The disputed domain name is www.pridestaffing.in (hereinafter referred to as the "**Disputed domain name**"). The Registrar for the Disputed domain name as per



the WHOIS data is Endurance Digital Domain Technology LLP. The present arbitration is being conducted in accordance with the Arbitration and Conciliation Act, 1996, the .IN Domain Name Dispute Resolution Policy ("**Policy**") and the INDRP Rules of Procedure ("**Rules**").


3. Procedural history:

- 6 January 2022: The .IN Registry transmitted information of appointment of the arbitrator and circulated the complaint and its annexures to the parties
- 7 January 2022 The amended complaint with updated annexures was circulated by NIXI
- 7 January 2022 Notice of commencement of the arbitration proceedings was sent by the Panel to the Parties. The Respondent was given 3 weeks' time until 29 January 2022 (mis-typed as 2021) to file its statement of defense
- 31 January 2022 The Panel informed the Parties that since no statement of defence had been filed, the Respondent was deemed to have forfeited its right to do so. The award was reserved.

4. Complainant's case:

The Complainant's submissions in the complaint are summarized below:

- i. Complainant was founded in 1978 and is one of the most well-known staffing firms in the United States where it has over 85 offices. It is in the business of providing professional staffing services for employers with professional staffing needs and individuals looking for job placement services (the "PrideStaff Services").
- ii. Complainant has used the PrideStaff Mark in connection with the PrideStaff Services since at least as early as 1995. It has owned and used the domain name <pridestaff.com> since 1996. Information about the Complainant can be



found on the <pridestaff.com> website where customers can request staffing services and apply for posted positions. The domain <pridestaff.com> is an important asset of the Complainant and a key means of communicating with its customers and the public. Reliance is placed on Annex C for this pleading.

- iii. Complainant is the owner of all intellectual property rights in and to a valid and subsisting trademark registration in the United States as per the details below:

PRIDESTAFF (U.S. Reg. No. 2,116,589), Registered November 25, 1997, for use in connection with: employment agency services; personnel relocation services; personnel placement and recruitment services; temporary personnel placement and recruitment services; contract staffing services; personnel management consulting services; and personnel outplacement services in Class 35, with a first use date of March 1, 1995.

Reliance is placed on the TESS extract at Annex B.

- iv. The PrideStaff Mark is the subject of an incontestable trademark registration, which subsisted much prior to the registration of the Disputed domain name. The Respondent would thus be precluded by operation of law from arguing that the PrideStaff Mark is descriptive. There is also a legal presumption that the PrideStaff Mark is conceptually strong. Complainant refers to the decisions in *Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189 (1985); *Debbie Robus and Greg Robus v. Nicky Suard (DrivenOne, Inc.)* (WIPO D2000-0941) quoting from the latter "...the incontestable status of Complainant's trademarks forecloses an attack based upon contentions that the marks are or have become merely descriptive".
- v. Complainant maintains strict control over the use of the PrideStaff Mark as its services are only offered to the public directly through Complainant, or its authorized franchisees.
- vi. Complainant is well-known in the staffing industry and its PrideStaff Services have received numerous independent awards and recognitions from unrelated third parties, showcasing the strength and value of the PrideStaff Mark. Reliance is placed on Annex D.



vii. Complainant does not have a trademark registration in India but reliance is placed on *Instant Domain Search, Inc. v. Thrive Travel Servs., Ltd.*, INDRP/1267 (Oct. 30, 2020) (citing *ZipRecruiter Inc. v. Amy Cox*, INDRP/1102 (Aug. 6, 2019) wherein it was held that “possessing an Indian trade mark application or registration is not a prerequisite for establishing trade mark rights under the Policy.”

viii. Complainant cites several UDRP cases that have recognized its rights in the PrideStaff Mark, e.g.:

- *PrideStaff, Inc. v. James Butler-Fleming* (WIPO D2021-2031) involving the domain name <pridestaffing.org>;
- *PrideStaff, Inc. v. Mike Gregor* (WIPO 2021-2030) involving the domain name <pridstaff.com>;
- *PrideStaff, Inc. v. Marilyn Foster, Pride Staffing LLC* (WIPO D2021-1971) involving the domain name <pridestaffingservice.com>;
- *PrideStaff, Inc. v. Pearl Njinjoh, Trearl* (WIPO D2021-2033) involving the domain name <pridestaffjobs.com>.

ix. The incontestable US trademark registration of Complainant, coupled with a long history of use of the mark and corresponding common law rights, and numerous UDRP decisions recognizing its rights in the PrideStaff Mark, is sufficient to establish its rights for the same under the INDRP.

x. The disputed domain name PRIDESTAFFING.IN incorporates the PrideStaff Mark in its entirety. The changing of “Staff” to “Staffing” does not obviate this confusion and the mark is virtually exactly the same. Reliance is placed on *PrideStaff, Inc. v. James Butler-Fleming* (WIPO D2021-2031) wherein the panel held “[t]he letters “ing” which are added to the ending of the “pridestaff” portion of the Domain Name (pridestaffing.org), does not prevent a finding of confusing similarity as the PRIDESTAFF mark remains clearly recognizable”.

xi. Further, adding a suffix like “.in” or “.org” does not differentiate the domain name from the marks as held in several arbitral decisions in India. Thus, Respondent’s use of PRIDESTAFFING.IN is confusingly similar to the trademark in which Complainant has rights.



xii. Complainant recently discovered the existence of the PRIDESTAFFING.IN domain name. Upon review of the website associated with the PRIDESTAFFING.IN domain name, Complainant discovered that it resolved to a website for a company purporting to specialize in enterprise workforce management solutions, employment recruitment outsourcing, and staffing. Moreover, the website explicitly solicited business in the United States, utilizing a U.S. based phone number and providing a physical address in the U.S., namely "111 Pemberton-Browns Mills Road #8060, Browns Mills, NJ 08015." Reliance is placed on printouts of the PRIDESTAFFING.IN website dated November 29, 2021 at Annex E. Complainant upon investigation discovered that as per Google maps the physical address listed on the website associated with the PRIDESTAFFING.IN domain name appeared false. Reliance is placed on Annex F.

xiii. Complainant addressed a communication to Respondent on December 6, 2021 at the email address info@pridestaffing.in provided on its website, demanding that Respondent cease all use of the PrideStaff Mark in connection with employment recruitment outsourcing and staffing services directed to customers in the U.S. and to transfer the PRIDESTAFFING.IN domain name to Complainant. Reliance is placed on Annex G.

xiv. On December 8, 2021, Complainant received a response to its communication from the email address info@pridestaffing.in, purporting to be on behalf of "Pridestaffing LLC" and stated that Respondent has been registered with "Harvard Business Services", a corporate services company in the United States. The email admitted that Respondent has been working with clients in the U.S. market. Complainant researched the so-called "Pridestaffing LLC" and found its LinkedIn profile, which states that Pridestaffing LLC offers services in the U.S. and lists numerous employees as located in various cities in the U.S. Reliance is placed on Annex H.

xv. On December 9, 2021, Complainant responded to the Respondent's email noting the admissions and reiterated its demand for the latter to cease all use of the PrideStaff Mark and to transfer the <pridestaffing.in> domain name to



Complainant. Complainant did not receive a further response thereafter.

xvi. The foregoing factors, coupled with the use of a U.S. based phone number and listing of an apparently false U.S. address on the website associated with the disputed domain name, it is evident that the use and registration of the PRIDESTAFFING.IN domain name is for illegitimate purposes.

xvii. Complainant has no relationship with Respondent. Respondent is neither a licensee or franchisee of, nor otherwise currently affiliated with, Complainant. Respondent is under no contractual relationship with Complainant to distribute any PrideStaff services. Respondent has never been authorized by the Complainant to use the PrideStaff Mark or to register the Disputed domain name or any other domain name containing "PrideStaff" or confusingly similar variations thereof. Hence, Respondent has no legitimate interest in the Disputed domain name. Reliance is placed on *Research In Motion Limited v. Dustin Picov* (WIPO D2001-0492) in support of Complainant's contention that the use of the disputed domain name suggests "opportunistic bad faith."

xviii. Respondent is using the disputed domain name and email addresses to appear to be a legitimate staffing firm, but there is no indication that the business is a going concern hence such use is for illegitimate purposes rather than a bona fide offering of services in connection with the disputed domain name. Reliance is placed on *PrideStaff, Inc. v. Registration Private, Domains By Proxy, LLC / Code optimal Solutions, Code optimal solutions <pridestaffingco.com>* (WIPO D2020-0154) in which respondent's use of the disputed domain name to host a website that purported to offer the same or similar services as the Complainant was found to be sufficient to infer that respondent's use was neither a bona fide offering of goods or services or a noncommercial use.

xix. Complainant has been using the PrideStaff Mark and the <pridestaff.com> domain name for approximately 25 years prior to Respondent's registration of <pridestaffing.in>. Respondent registered the disputed domain name in December 2020, well after the PrideStaff Mark had



become a well-known and incontestable trademark of Complainant. It can be reasonably inferred that Respondent was aware of Complainant's prior rights in the PrideStaff Mark at the time the disputed domain name was registered. Respondent, claiming to be located in the U.S. and targeting U.S. customers, had constructive knowledge of Complainant's superior and prior rights in the PrideStaff Mark. Respondent's conduct violates paragraph 7(c) of the INDRP.

xx. Respondent registered the disputed domain name clearly with the intention to trade off and capitalize on the goodwill associated with the Complainant's PrideStaff Mark which is prominent in the field of employment recruiting and staffing services, especially since Respondent appears to be located in the U.S. with targeted advertising and promotion of its competitive services in the U.S. and to U.S. customers and businesses. The disputed domain name falsely leads internet browsers and potential consumers to visit the domain to receive further information about PRIDESTAFF® branded services i.e., staffing opportunities.

xxi. Respondent maintains MX-records for the disputed domain name as seen in Annex I. This allows Respondent to send and receive emails from the disputed domain name indicating that this may be used for fraudulent email communications. The fact that Complainant received an email from info@pridestaffing.in is evidence that Respondent is actively using such email address. Reliance is placed on *Tetra Laval Holding & Fin. S.A. v Himali Hewage* (WIPO D2020-0472) wherein the panel held: "[g]iven the Respondent's lack of rights or legitimate interests in the disputed domain name, and the confusing similarity of the disputed domain name to the Complainant's trademark, any use of the disputed domain by Respondent for email communication would carry a high risk of implied affiliation with the Complainant and be a use in bad faith." Even if Complainant had not received an email from info@pridestaffing.in, Respondent's mere ability to send such communications is also sufficient to prove bad faith. Reliance is placed on *bioMérieux v. Registration Private* (WIPO D2020-3499) stating "The establishment of MX records for a domain name is a use of it. Where the use of the disputed domain name sets up the Respondent to engage in behaviour



that would falsely imply an affiliation with the Complainant, that is a use of the disputed domain name in bad faith.”

xxii. Due to the assignment of MX-records for the disputed domain name, coupled with the lack of an established and bona fide business use of the disputed domain name, it can be inferred that the disputed domain name was set up to engage in some type of employment scam.

5. Respondent’s case:

The Respondent has not filed a statement of defense.

6. Legal grounds:

Under paragraph 4 of the Policy, the Complainant must establish the following three elements to succeed:

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

7. Discussion and findings:

The Panel has gone through the complaint and annexures submitted by the Complainant. The basis of the complaint is the rights in the Pridestaff Mark owned and used by the Complainant in the U.S. and the related goodwill and reputation enjoyed by it in the U.S. It is neither the Complainant’s case that it owns any statutory or common law rights in the Pridestaff Mark in India nor that it enjoys a reputation in relation to the said mark in India arising from use or transborder reputation that spills over into India. The case of the Complainant is against the registration by the Respondent of the disputed domain name <pridestaffing.in> with a .in ccTLD which is said to trespass on its rights because the Respondent is



said to be based in the U.S. and operates out of the U.S. and targets its services to U.S. customers / clients in the same area of business as that of the Complainant. The U.S. focus of the Respondent also seems to be an admitted position emerging from the communication of its representative to the Complainant referred to in para 4 (xiv) above, and its LinkedIn profile at Annex H. The Panel has thus examined the merits of the Complainant's case within this compass.

Since the Complainant's submissions in the complaint are uncontroverted, these can be accepted as substantially correct.

A. Whether the Disputed domain name is identical and/or confusingly similar to a name, trademark or service mark in which the Complainant has rights:

- i. The Disputed domain name is <**pridestaffing.in**>.
- ii. The Complainant asserts rights in the trademark PRIDESTAFF in the U.S. by virtue of US registration no. 2,116,589 in class 35 with filing date of 6 March 1995 and registration date of 25 November 1997, and first use in commerce since 1 March 1995.
- iii. The domain name <**pridestaff.com**> was registered by the Complainant in 1996. The Complainant's website at www.pridestaff.com is accessible in India and confirms the online presence of the Complainant and information about its services offered in the U.S. under the trademark 'PrideStaff'.
- iv. The Complainant's case of prior and superior rights in the U.S. by virtue of registration of the trademark 'PrideStaff' in the U.S. and long, continuous and extensive use, including through its online presence on the website www.pridestaff.com is well supported by the Annexes filed as documentary evidence.
- v. The disputed domain name <**pridestaffing.in**> was registered by the Respondent on 9 December 2020 as per the Whois data, which is many years subsequent to the registration of the Complainant's trademark PRIDESTAFF and the domain <**pridestaff.com**>.



- vi. The trademark 'PrideStaff' is contained in entirety in the Disputed domain name <**pridestaffing.in**>. The combination of the words 'pride' and 'staff' is an arbitrary and unusual one and renders the Complainant's mark 'PrideStaff' distinctive in relation to its services. The adoption and use of an identical or deceptively similar mark by the Respondent gives rise to a presumption of copying on the part of the Respondent of the prior mark of the Complainant, especially when such use is in respect of the same services as the Complainant.
- vii. Mere addition of the letters 'ing' to 'pridestaff' does not reduce the similarity between the two domain names / trademarks i.e. 'PrideStaff' and PRIDESTAFFING, when there is no change in the essential and salient feature of the Respondent's mark which contains the identical words 'PRIDE STAFF' in that order. The name PRIDESTAFFING is not sufficiently distinct or distinguishable from the Complainant's mark 'PrideStaff'.

The above points confirm that the disputed domain name is identical and/or confusingly similar to a name / trademark in which the Complainant has rights.

B. Whether the Respondent has any rights or legitimate interests in respect of the Disputed domain name:

The Panel concludes that the Respondent does not have any rights or legitimate interests in respect of the disputed domain name. The reasons for this finding are:

- i. The Complainant's contention regarding its incontestable rights in registration of the trademark 'PrideStaff' in the U.S. is accepted. This also indicates that the Respondent ignored a red flag clearly warning against the adoption of a mark or domain name comprising of the Complainant's mark 'PrideStaff' for similar services in the U.S.
- ii. The fact that the Complainant put the Respondent on notice of its rights in the 'PrideStaff' Mark in the U.S. and the Respondent in its response did not dispute the Complainant's assertions in its legal notice shows that the Respondent accepted the Complainant's rights as asserted.



- iii. Since the Complainant's case is uncontroverted by the Respondent, and basis the material filed with the complaint and seen by the Panel, there is no justification to conclude that the Respondent had independent rights or legitimate interest in the disputed domain name. The Respondent's unresponsiveness to the communications from the Panel in these proceedings and its abstention by non-filing of a statement of defence is also a factor weighing heavily against it, notwithstanding that there is no pleading or evidence on record in support of the Complainant's rights in the 'PrideStaff' mark including through use or reputation in India.

C. Whether the Disputed domain name has been registered or is being used in bad faith

The following factors establish to the Panel's satisfaction that the disputed domain name was registered in bad faith:

- i. The fact that the Respondent lists its address in the U.S., albeit the Complainant discovered this to be an incorrect address, and the Respondent has admitted that its clients/customers are U.S. based and its advertising is targeted to entities and customers in the U.S., strongly suggests that the Respondent was aware of the Complainant's business under the mark 'PrideStaff' and sought to take advantage of the existing use and reputation of the Complainant's mark for its own business.
- ii. The Panel is of the opinion that it is obligatory on an entity that adopts a new name or mark for a new business to embark on such a venture with caution and after due diligence. Exercise of due diligence is expected of a later entrant in a business especially when its activities are undertaken in a sophisticated market where information about existing third party rights is easily and freely accessible on trademark databases and commercial registers.
- iii. The Respondent's use of an email address info@pridestaffing.in which contains the Complaint's trademark 'PrideStaff', that also forms the totality of the latter's domain name <pridestaff.com>, can be highly misleading and cause confusion



or deception about a possible association of the Respondent with the Complainant. In the hands of an entity with dubious intentions, such an email address can be a potent handle for fraud.

- iv. Among the circumstances illustrated in paragraph 7 of the Policy that evidence the registration and use of a domain name in bad faith, one is present in this case, namely:

"c) 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."

Hence the Panel concludes that the disputed domain name was registered in bad faith.

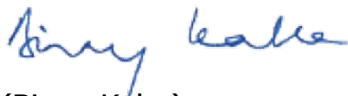
Decision:

In conclusion, the Panel finds that the Complainant has succeeded in making a case for transfer of the disputed domain name by meeting the criteria under paragraph 4 of the Policy.

The Panel directs that the disputed domain name <**pridestaffing.in**> be transferred to the Complainant.

No order is made as to costs.

Signed:



(Binny Kalra)

Arbitrator

Date: 23 February 2022