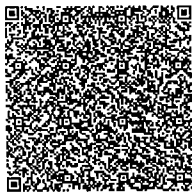


Government of National Capital Territory of Delhi

e-Stamp

Certificate No.	: IN-DL00579944085391U
Certificate Issued Date	: 07-Mar-2022 02:07 PM
Account Reference	: IMPACC (SH)/ dlshimp17/ HIGH COURT/ DL-DLH
Unique Doc. Reference	: SUBIN-DLDLSHIMP1790255258095173U
Purchased by	: ALOK KUMAR JAIN
Description of Document	: Article 12 Award
Property Description	: Not Applicable
Consideration Price (Rs.)	: 0 (Zero)
First Party	: ALOK KUMAR JAIN
Second Party	: Not Applicable
Stamp Duty Paid By	: ALOK KUMAR JAIN
Stamp Duty Amount(Rs.)	: 100 (One Hundred only)



Please write or type below this line

BEFORE ALOK KUMAR JAIN, SOLE ARBITRATOR
INDRP Case No. 1505

Disputed Domain Name: www.bikes24.co.in

ARBITRATION AWARD

Global Car Group Pte Ltd. And Anr

Complainants

Versus

Mr.Mallayya

Respondent

Page 1 of 42

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Statutory Alert:

1. The authenticity of this Stamp certificate should be verified at 'www.shcilestamp.com' or using e-Stamp Mobile App of Stock Holding. Any discrepancy in the details on this Certificate and as available on the website / Mobile App renders it invalid.
2. The onus of checking the legitimacy is on the users of the certificate.
3. In case of any discrepancy please inform the Competent Authority.

BEFORE ALOK KUMAR JAIN, SOLE ARBITRATOR

.IN REGISTRY

NATIONAL INTERNET EXCHANGE OF INDIA(NIXI)

INDRP ARBITRATION

INDRP Case No. 1505

Disputed Domain Name: www.bikes24.co.in

ARBITRATION AWARD

Dated 07.03.2022

IN THE MATTER OF:

1. Global Car Group Pte Ltd.,

1 Robinson Road # 18-00, AIA\ Tower,
Singapore-04852

Email: mohit@simandsan.com

Complainant No.1

2. Cars24 Services Private Ltd.,

4th Floor, Plot No. 65, Sector-44, Gurgaon,
Haryana-122003, India.

Email: mohit@simandsan.com

Complainant No.2

versus

Mr. Mallayya

No.26, 6th Floor Cross Kaggadasapura,
CV Raman Nagar, Bangalore,
Karnataka -560093

Respondent

Alok Kumar Jain

Phone: redacted

Email:sales@bikes24.co.in

info@bikes24.co.in

1. The Complainant no.1 in this arbitration proceeding is Global Car Group Pte Ltd., Robinson Road # 18-00, AIA\ Tower,Singapore-04852 Email: mohit@simandsan.com and Complainant No.2 is Cars24 Services Private Ltd., 4th Floor, Plot No. 65, Sector-44, Gurgaon,Haryana-122003India. Email: mohit@simandsan.comThe Complainants' authorized representative in this administrative proceeding is: **Sim And San, Attorneys At Law** ,176, Ashoka Enclave-III, Sector-35, Faridabad -121003, Address: National Capital Region (NCR), India. Telephone: +91 9784386634 Email: mohit@simandsan.com and akshay@simandsan.com

1.1 Respondent is Mr. Mallayya ,No.26, 6th Floor Cross Kaggadasapura, CV Raman Nagar, Bangalore, Karnataka-560093 Phone: redacted Email:sales@bikes24.co.in info@bikes24.co.in , support@namecheap.com

2 **Domain Name and Registrar:-**

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- 2.1 The Disputed Domain name is <www.bikes24.co.in> The accredited Registrar with whom the Disputed Domain Name is registered is NameCheap, Inc., 4600 East Washington Street, Suite 305, Phoenix, AZ 85034, USA. **Email:** legal@namecheap.com

3 Procedure History:

- 3.1. This arbitration proceeding is in accordance with the .IN Domain Name Dispute Resolution Policy (the "Policy") adopted by the National Internet Exchange of India ("NIXI") and the INDRP Rules of Procedure (the "Rules") which were approved in accordance with the Indian Arbitration and Conciliation Act, 1996. By registering the Disputed Domain Name with a NIXI accredited Registrar, the Respondent agreed to the resolution of disputes pursuant to the said Policy and the Rules.

As per the information received from NIXI, the history of the proceedings is as follows:

- 3.2. The Complaint was filed by the Complainant with NIXI against the Respondent. On 8.2.2022 I was appointed as Sole Arbitrator to decide the disputes between the parties. I .

submitted statement of Acceptance and Declaration of Impartiality and Independence same day as required by rules to ensure compliance with Paragraph 6 of the Rules.

NIXI notified the Parties of my appointment as Arbitrator *via* email dated 8.2.2022 and served by email an electronic Copy of the Complainant with Annexures on the Respondent at the email addresses of the Respondent.

- 3.3. I issued notice to the parties vide email dated 17.2.2022 directing the Complainant to serve complete set of Complaint on the Respondent in soft copies as well as in physical via courier /Post. The Complainant sent the copies of the Complaint (including Annexures) in electronic form at the email addresses of the Respondent and also sent copy of the Complaint to the Respondent by Courier. The Respondent was directed to file its response within 7 days from the date of notice. In Response, the Complainant sent an email dated 21.2.2022 informing the Tribunal that the Copies of complaint with annexures sent to the Respondent by Courier

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could not be delivered to the Respondent because of incomplete address. The address and other information were redacted by the Respondent. The accredited Registrar refused to disclose redacted information despite request made by NIXI without an order from US Court. Be that as it may. The Complainant also stated that the Respondent has responded to the legal notice sent by the Complainant through their email address 'info@bikes24.co.in'. The notice sent to Respondent vide email dated 17.2.2022 at the email addresses of the Respondent provided in the complaint were returned undelivered. In the mean time NIXI informed the tribunal that as per WHOIS details, the email address of the Respondent is 'support@namecheap.com'. Nixi had sent copy of the complaint with annexure to the Respondent at the said email address i.e. at the email address 'support@namecheap.com' vide email dated 8.2.2022 while informing the Parties about my appointment as Arbitrator. The notice issued to the parties on 17.2.2022 by the Tribunal was also sent to the

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Respondent at the email address at
'support@namecheap.com'.

Therefore, on 24.2.2022 the tribunal held that there was sufficient service on the Respondent at email address at 'support@namecheap.com'. And I granted further time to Respondent directing the Respondent to file response by 3.3.2022 failing which the matter shall be decided on merit. The extra time given to the Respondent expired on 3.3.2022. On 4.3.2022 I informed the parties that the Respondent has not filed any reply so far and now the complaint shall be decided on merit. No personal hearing was requested. All communications were sent to Complainant, Respondent and NIXI by email. The Respondent has not filed any response to the Complaint despite two opportunities and there has been no communication from the Respondent till date.

- 3.5. Clause 8(b) of the INDRP Rules requires that the Arbitrator shall at all times treat the Parties with equality and provide each one of them with a fair opportunity to present their case.

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3.6. Clause 12 of INDRP Rules provides that in event any party breaches the provisions of INDRP rules and/or directions of the Arbitrator, the matter can be decided ex-parte by the Arbitrator and such arbitral award shall be binding in accordance to law.

3.7 As stated above, Initially I gave 7 days time to the Respondent to file a Response and additional 7 days time to file response, but the Respondent failed to file any Response to the Complaint despite opportunities and chose not to answer the Complainant's assertions or controvert the Complaint and the contentions raised. As a result, I find that the Respondent has been given a fair opportunity to present his case but has chosen not to come forward and defend itself.

3.8 Further Clause 13(a) of the Rules provides that an Arbitrator shall decide a Complaint on the basis of the pleadings submitted and in accordance with the Arbitration & Conciliation Act, 1996 amended as per the Arbitration and Conciliation (Amendment) Act, 2015 read with the

Arbitration & Conciliation Rules, Dispute Resolution Policy, the Rules of Procedure and any by-laws, and guidelines and any law that the Arbitrator deems to be applicable, as amended from time to time.

In these circumstances the Tribunal proceeds to decide the complaint on merit in accordance with said Act, Policy and Rules in absence of the Respondent on Respondent's failure to submit a response despite having been given sufficient opportunity and time to do so.

4. Grounds for Arbitration Proceedings.

INDRP Policy para 4.Class of Disputes provides as under:

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

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- (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.

5. The Case of the Complainant :-

The Complainant is aggrieved with the registration of disputed domain and submits that the Registrant has registered disputed domain inter alia with the *mala fide* of making illegitimate and illegal commercial gains and that the Disputed Domain Name attracts, inter-alia, the provisions of Clause 4 (Types of Disputes) and clause 7 (Evidence of Registration and use of Domain Name in Bad Faith) of the Policy as per details given in the complaint. The Complainant has prayed inter alia that the Disputed Domain name be transferred to the Complainant.

In support of its case, the Complainant has stated inter alia as under:

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5.1. The Complainant stated in the complaint that Complainants are the first adopter, sole owner and registered proprietor including in India, of the mark “Cars24”, “Bikes24” and various other 24-Formative Marks, namely, “Unnati24”, “Auction24”, “Funding24”, etc. These 24-Formative Marks have been used in various stylized variant and that the Complainant owns trademark registrations/ has filed for trademark applications in numerous countries. A list of the Complainants’ trademark registrations for the 24-Formative Marks in India has been given in the complaint. Copies of Registration Certificates of the registered trademarks mentioned in the complaint are attached with complaint as **Annexure-3**. The Complainant is also the owner of domain name <bikes24.com> and <cars24.com>. Printouts of the Whois records are attached with complaint collectively as **Annexure-4**.

Complainant further averred that being the most prominent player in the used car segment, the Complainants also became the pioneer in the niche segment of buying and selling pre-owned bikes under the brand name Bikes24. Due to the ease with which customers could purchase used motorcycles, the Complainants revolutionized the used motorcycle market and firmly established the now well-known and well-reputed brand

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Bikes24. The enormous reputation subsisting in the Cars24 and other 24-Formative Marks also led to the Bikes24 marks rapidly acquiring distinctiveness and secondary meaning as denoting the services of the Complainants and has come to be exclusively associated with the Complainants alone. In order to promote and disseminate its offerings under the brand Bikes24, the Complainants run various social media handles including its Facebook page, Instagram page, Twitter page, etc.

It is stated in the Complaint that the Complainants have been actively enforcing its rights in its 24-Formative Marks through various legal actions and has also received favourable results. Such legal actions have included filing civil suits, trademark oppositions, cease & desist notices, etc. For instance, in the matter titled "*Cars24 Services Pvt. Ltd. and Anr. v. Girnarsoft Automobiles Private Limited & Ors., CS(COMM) 392 of 2019*" the Complainants had filed a suit before the Hon'ble Delhi High Court for infringement and passing off of the Plaintiffs' Cars24 Word Mark by the third-party therein as they were

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illegally bidding for the Plaintiffs' CARS24 Word Mark as an ad-word. In view of the same, an *ex parte* injunction was granted by the Hon'ble High Court in favour of the Complainants. The suit is currently pending before the Hon'ble Court. Further, recently in a matter before the Hon'ble Delhi High Court titled "*Cars24 Services Pvt. Ltd. and Anr. v. Mr Krishi Ramesh Khandelwal & Ors. (C.S. (COMM) 463/2021*", the Complainants secured an ex-parte ad interim injunction against a third-party using marks which were held as deceptively similar to 24-Formative Marks of the Complainants. The suit is currently pending before the Hon'ble Court. Copy of the order passed in the above-referenced case is annexed as **Annexure-6**.

The fame of the Complainants' Cars24 Mark is also evidenced by the number of cyber squatters who have sought to unfairly and illegally exploit the very significant consumer recognition and goodwill attached to its trademarks. The panel in *Global Car Group Pte Ltd., Cars24 Services Private Limited, Global Cars Aus Pty Ltd. v. Aman Nagpal, Proven Associated Services*

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Pty Ltd (WIPO Case No. DAU2021-0022) has recognized the strength and renown of the Complainants' Cars24 Marks, and has held that "The Cars24 mark has acquired a considerable reputation through promotion and use in connection with the Complainant's website for buying and selling used cars..."

Also, the panel in Global Car Group Pte Ltd., Cars24 Services Private Limited and Global Access Cars Automobile Trading L.L.C. v. Saygin Yalcin, SellAnyCar.com FZE (WIPO Case No. DME2021-0014), recognized the strength and renown of the Applicant's 24 Formative Marks and transferred the domain name <cars24.me> from an impersonator to the Applicant.

Owing to the extensive goodwill and reputation painstakingly created over the past six (6) years of use, combined with the widespread usage of their vast array of 24Formative Marks and far-reaching nature of their services, the Complainants, through its subsidiaries, has become a household name in several parts of the world, and especially in India, Australia, and GCC Countries. It is reiterated that the 24-Formative Marks are solely and exclusively associated with the

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Complainants and its subsidiaries, and none other. The Complainants have on date expended over USD 5 million in establishing its business in Australia and over USD 11 million in the UAE. Illustratively, the value of Sales Promotion Expenses of Complainant No.2 in the financial year 2019-20 amounts to approximately Rs. 141.64 Crores. Since 2015, the Complainants and its subsidiaries have received several international awards for its fast-growing and highly reputable services offered under the Complainants' Cars24 and other 24-Formative Marks.

The Complainant further submitted that in June 2021, the Complainants were alerted by the fact that the Disputed Domain Name was registered and was being used by a third party. The Disputed Domain Name, then, pointed to an active website offering identical services to that of the Complainants under the mark "Bikes24" Further, it had come to Complainants' notice that the Respondent has also filed for a trademark application for registration of the mark "Bikes24" bearing Application No. 4485077. It is pertinent to note that in

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the reply to the examination report for the aforementioned trademark application, the Respondent has stated that:

“Further reference should also be drawn to marks like Cars24 filled via application no 3004753 and 3161876 which already registered with the trademark registry and the they are also coined trademark and a combination of letters and word in a unique way which is neither a common word nor a common geographical name and is conceived and adopted by the applicant in respect of very specific goods/services likes our Bikes 24” and thereby alluding to the fact that they have imitated the Complainants’ 24-Formative Mark, specifically Cars24. Copy of the reply to the examination report is annexed with the complaint as **Annexure-8**. On 25 June 2021, the Complainants sent out a legal notice (hereinafter the **“First Legal Notice”**) to the Respondent directing the Respondent to cease all usage of the Bikes24 Marks and takedown and transfer the Disputed Domain Name to the Complainants. Copy of the First Legal Notice sent to the Respondent is attached with the complaint as **Annexure-9**. Thereafter, on 27

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July 2021, the Complainants received a response from the Respondent with acknowledgment of the rights of the Complainant in the Bikes24 Marks and with an undertaking to have shut down all business operations being run under the mark Bikes24. Following this, it was observed that the Disputed Domain Name was no longer active. Copy of the email sent by the Respondent is attached with the complaint as **Annexure-10**. On 04 August 2021, the Complainants sent out another legal notice/rejoinder (hereinafter, the “**Second Legal Notice**”) to the Respondent to transfer the Disputed Domain Name and the pending trademark applications to the Complainants and to take down the Facebook Page which at that point was branded under the Bikes24 Marks. The Respondent did not respond to the second legal notice but partially complied with it by taking down reference to the Bikes24 Mark. The Respondent blatantly refused to respond to any further communication attempts made by the Complainants, leaving the Complainants with no other choice but to file for the present Complaint to request the transfer of

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the Disputed Domain Name to protect its legitimate business interests and the rights of its user community.

6. Discussions and findings:

The Complainant has invoked Clause 4 of the Policy to initiate the Arbitration Proceeding.

Clause 4 of the INDRP Policy provides as under:

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.

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Therefore in order to succeed in the Complaint, the Complainant has to satisfy inter alia all the three conditions provided in clauses 4(a), 4(b) and 4(c) quoted above.

6.1 Condition 4(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;

6.1.1 I have gone through the complaint and perused all the documents annexed with the Complaint.

As per averments made in the Complaint, the Complainant is the inventor and bonafide adopter of the trading name and trademark <bikes24.com> since as early as 2015. And that the Complainants are the registered proprietor for these Bikes24, Cars24 and all other 24-Formative Marks, in India and many countries in the world. Such trademark registrations cover the word mark and logo mark renditions as stated in the Complaint. It is further submitted by the Complainant that the trademark registration constitutes *prima facie* evidence of the validity of trademark rights as it has been held by the panels

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constituted in Perfetti Van Melle Benelux BV v. Lopuhin Ivan, IPHOSTER (WIPO Case No. D2010-0858) and Inter-Continental Hotels Cooperation v. Abdul Hameed (NIXI Case No. INDRP/278, February 10, 2012). In any case, in Daifuku, Co., Ltd. v. X Herb Garden (WIPO Case No. D2003-0075), the Panel held that: *“For the question of similarity in the context of the Policy it is not relevant whether the trademark is famous, nor is it relevant for which goods or services the trademark has been registered, or whether other identical or similar trademarks exist.”* .

6.1.2 It is further asserted that the Disputed Domain Name <www.bikes24.co.in> is identical and confusingly similar to the Complainants’ Bikes24, Cars24, and other 24-Formative Marks. The present complaint is filed on account of the unauthorized registration by the Respondent of the Disputed Domain Name containing the Complainants’ trademark “Bikes24” in its entirety. In AREVA v. St. James Robyn Limoges, (WIPO Case No. D2010-1017) panel held that: *“In numerous UDRP decisions, panels have found that the fact*

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that a domain name incorporates a complainant's registered mark in its entirety is sufficient to establish confusing similarity for the purpose of the first element of paragraph 4(a) of the Policy."

6.1.3 That the conceptual similarities between the Trade Marks and the Disputed Domain Name (i.e. the use of the numeral "24" as a suffix to suggest a connection with the Complainants), the well-known reputation of the Complainants' Trade Marks, allied nature of the service purportedly provided by the Respondent, and the Complainants' statutory and common law rights over 24-Formative Marks, Internet users are likely to be confused about the relationship between the Complainant and the Disputed Domain Name. Complainant stated that in the case of Just Car Insurance Agency Pty Ltd. v. Throne Ventures Pty Limited (WIPO Case No. DAU2008-0015) panel held that "...given the conceptual similarities between the Trade Marks and the disputed domain name ... and the well-known reputation of the Complainant's Trade Marks,

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Internet users are likely to be confused about the relationship between the Complainant and the disputed domain name.”

Complainant further averred that it is generally accepted that the suffix, such as .CO.IN, is irrelevant when assessing whether a Disputed Domain Name is identical or confusingly similar to a trademark as it is a functional element. Therefore, the addition of Top-Level Domain (“TLD”) “.in” or Second Level Domain (“SLD”) “.co.in” to the Disputed Domain Name will be disregarded and shall not prevent the Disputed Domain Name from being identical to the Complainants’ Bikes24, Cars24 and other 24-Formative Marks. Various Panels have time and again recognized the practice of disregarding the TLD or ccTLD or SLD in a domain name while determining identity or confusing similarity, as these are only required for technical reasons and do not impact assessment of confusing similarity. [See, Section 1.11, WIPO Overview 3.0, *Facebook, Inc. v. Ronal Yau* (WIPO Case No. DIO2020-0001); *Rexel Developments SAS v. Zhan Yequn*, (WIPO Case No. D2017-0275)]. It

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follows that the Disputed Domain Name <bikes24.co.in> is identical to the Complainants' Bikes24, Cars24 and other 24-Formative Marks.

The Respondent has not filed any response to the complaint as such all the averments of the complainant has remained unrebutted.

It is evident from above submissions and documents annexed with the complaint that the complainant has sufficiently established its rights in and to the ownership of the <bikes24> Trademarks.

A perusal of disputed domain name shows that the Registrant has substantially subsequently adopted the Disputed Domain Name 'bikes24.co.in' on 9th March 2019. The Disputed Domain Name wholly incorporates the prior registered and reputed trademark BIKES24 and is in direct conflict with the corresponding trading name and domain name of the Complainant.

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The use of the Complainant's trading name in its entirety in the Disputed Domain Name will inevitably lead consumers to believe that the Disputed Domain Name is affiliated in some way to the Complainant.

In this regard, it is relevant to refer to following case.

- i. *Lego Juris AIS v. Robert Martin (INDRI/125)* wherein the Learned Arbitrator observed that it is well recognized that incorporating a trademark in its entirety, particularly if the mark is an internationally well-known mark, is sufficient to establish that the domain name is identical or confusingly similar to the Complainant's registered mark.
- ii. *Incase Designs Corp v. Stavros Fernandes (INDRP/ 1209)* wherein the Learned Arbitrator observed that it is well established that the mere addition of the Country Code Top Level Domain '.in' does not add any distinctive or distinguishing element. In view of the same the Learned Arbitrator adjudged that the domain name *www.incase.in* of the respondent was identical to the trade mark *INCASE* of the Complainant.

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iii. *The Gillette Company v. Mr Gaurav Kana (INDRJ/049)* wherein the disputed domain name was *www.gillete.in* and the complainant was the proprietor of the trademark and trading name GILLETTE. The Learned Arbitrator in the matter observed that:

"The Complainant has been using the trade name GILLETTE in many countries including the United States. As such consumers looking for GILLETTE may instead reach the Respondent's website. Therefore I hold that the domain name www.gillette.in is confusingly similar to the Complainant's trademark."

A mere perusal of the disputed domain name 'bikes24.co.in' of the Registrant/Respondent shows that the Respondent has used the Complainant's trading mark 'bikes24' in its entirety. it is well established that the mere addition of the Country Code Top Level Domain '.in' or second level domain 'co.in' does not add any distinctive or distinguishing element.

In view of the above facts and submissions of the complainant, and on perusal of the documents annexed with the Complaint and in view of various decisions of various panels, I hold that the Disputed Domain Name

‘www.bikes24.co.in’ of the Registrant is identical and or confusingly similar to the trademark ‘bikes24’ of the Complainant. Thus, the Complainant has established that the requirements of the INDRP Policy Paragraph 4(a) are fulfilled.

6.2 **Condition no.4 (b) the Registrant has no rights or legitimate interests in respect of the domain name;**

The Complainants submit that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The Respondent is nobody but an infringer trying to take advantage of the enormous reputation subsisting in the Bikes24, Cars24 and other 24Formative Marks. The Respondent is not a licensee of the Complainants, nor has it been otherwise authorized or allowed by the Complainants to make any use of its Bikes24, Cars24 and other 24-Formative Marks, in a domain name or otherwise. The Bikes24, Cars24 and other 24-Formative Marks are significantly unique and used by the Complainants as a trademark for a vast array of its

business activities and consequently, it cannot be contended that the Respondent had with *bona fide* intent adopted the identical name “Bikes24”.

In *Cavinkare Pvt. Ltd. v. LaPorte Holdings, Inc and Horshiy, Inc.*, (WIPO Case No. D2004-1072), the panel held that ‘*it stretches credulity to breaking point to believe that it was a mere coincidence that the Respondents adopted a name similar to Complainant's unique and distinctive name, and if it is not coincidence, the inference inevitably arises that the Respondents have misappropriated the Complainant's name which conduct cannot create rights or legitimate interest*’. Further, the Respondent is unable to invoke any of the circumstances set out in paragraph 4(b) of the Policy, in order to demonstrate rights or legitimate interests in the Domain Name as the Respondent was offering identical services of selling and buying pre-owned motorbikes under the identical mark Bikes24. Such offering cannot amount to *bona fide* offering of goods and services under any circumstances. As it has been held in *Madonna Ciccone, p/k/a*

Madonna v. Dan Parisi and "Madonna.com", (WIPO Case No. D2000-0847), that: "... use which intentionally trades on the fame of another cannot constitute a "bona fide" offering of goods or services. To conclude otherwise would mean that a Respondent could rely on intentional infringement to demonstrate a legitimate interest, an interpretation that is obviously contrary to the intent of the Policy."

Further as pointed out by the panel in Oki Data Americas, Inc. v. ASD, Inc (WIPO Case No. D2001-0903), that to be 'bona fide,' the offering must meet several requirements. Those include, at the minimum, the following:

- a. Respondent must be offering the goods or services at issue.
- b. Respondent must use the site to sell only the trademarked goods; otherwise, it could be using the trademark to bait Internet users and then switch them to other goods.
- c. The site must accurately disclose the registrant's relationship with the trademark owner; it may not, for example, falsely suggest that it is the trademark owner, or that the website is the official site, if, in fact, it is only one of many sales agents.

- d. The Respondent must not try to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in a domain name.

In the present case, the Respondent is offering services identical to those of the Complainants with no authorisation whatsoever from the Complainants, and therefore none of the above-cited circumstances is applicable. It is evident that the Respondent is trying to mislead the customers by misrepresenting and creating false associations/affiliations with the Complainants. The Respondent has with *mala fide* intention adopted and used the trademark Bikes24 in identical stylized design as the Complainants' Bikes24, Cars24 and other 24-Formative Marks, to take undue advantage of Complainants extensive goodwill and reputation subsisting in these marks. The Respondent is not commonly known by the term "Bikes24" particularly given the notoriety surrounding the Complainants' Bikes24, Cars24 and other 24-Formative Marks internationally and its exclusive association with the Complainants. The Respondent intends to operate identical services and take undue advantage of

Complainants' well-known Bikes24, Cars24 and other 24-Formative Marks. The Respondent, therefore, does not have any legitimate rights and interest in the Disputed Domain Name and has registered same with the *mala fide* of making illegitimate and illegal commercial gains.

While assessing claims by Respondents that they have "been commonly known" by an at-issue domain name, the Panel in *Banco Espirito Santo S.A. v. Bancovic* (WIPO Case No. D2004-0890) held that "*It is not sufficient for the Respondent to merely assert that he or she has been commonly known by the domain name in order to show a legitimate interest. The Respondent must produce evidence in order to show that he or she has been 'commonly known' by the domain name.*" In the present case, there is nothing in the evidence before the Panel that suggests the Respondent might otherwise have rights or legitimate interests in the Disputed Domain Name. There is no indication in the record that the Respondent has ever been commonly known as "Bikes24" and holds no association with the trademark and the Disputed Domain Name. Further, in its

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response to the legal notice sent by the Complainant, the Respondent has acknowledged rights of the Complainants and made no assertions on any prior association they hold with the Bikes24 Mark. The Bikes24 or the Cars24 trademarks are not generic or descriptive trademarks and hence, there arises no justification on part of the Respondent to purchase and/or use this Bikes24 Mark. The Complainants, therefore, assert that the Respondent has no rights or legitimate interest in the Disputed Domain Name, in accordance with paragraph 6(b) of the Policy. The Complainant further stated that the Respondent can not assert that he has made or is currently making a legitimate non-commercial or fair use of the Domain Name, according to paragraph 6(c) of the Policy.

The website on the Disputed Domain Name has been taken down pursuant to the legal notice sent to the Respondent by the Complainants and the Respondent has made admission of rights of the Complainants in the mark Bikes24. Consequently, it is evident that the Respondent does not have any legitimate rights and interest in the disputed domain name and has registered the

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same with the *mala fide* of making illegitimate and illegal commercial gains by riding on the goodwill of the Complainants. Furthermore, the fact that the website on the Disputed Domain Name used the Bikes24 mark in an identical stylized design as that of Complainants' well-known marks and strongly suggested affiliation/association with the Complainants to the internet users. This shall exclude any possible "fair use" as per paragraph 2.5 of the WIPO Overview 3.0 (*"Fundamentally, a respondent's use of a domain name will not be considered 'fair' if it falsely suggests affiliation with the trademark owner...Generally speaking, UDRP panels have found that domain names identical to a complainant's trademark carry a high risk of implied affiliation"*). Given the distinctiveness, notoriety and premium quality of the Complainants' marks and services, there simply cannot be any actual or contemplated good faith use of the Disputed Domain Name as this would invariably result in misleading diversion and taking unfair advantage of the Complainants' rights. See

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Telstra Corporation Limited v. Nuclear Marshmallows, (WIPO
Case No. D2000-0003).

The Respondent therefore does not have any legitimate rights and interest in the Disputed Domain Name and has evidently registered same with the mala fide intent of making illegitimate and illegal commercial gains. The Complainants, therefore, assert that the Respondent has no rights or legitimate interest in the Dispute Domain Name, in accordance with paragraph 4(b) of the Policy.

The Respondent has not filed any response as such the facts stated in the complaint had remained unrebutted. Further the Respondent has failed to satisfy the conditions contained in clause 6(a),(b) and 6(c) of INDRP Policy.

On the contrary the Complainant has established that the Registrant has no rights or legitimate interest in respect of the Disputed Domain Name and has never been identified with the Disputed Domain Name or any variation thereof. The Registrant's use of the Disputed Domain Name is dishonest and with the sole intention to divert and mislead customers

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onto unrelated and sponsored links belonging to third parties including Competitors.

Therefore, in view of the submissions made in the complaint and on perusal of the accompanying documents and in view of various decisions earlier referred herein I am of the opinion that the Respondent has no rights or legitimate interests in respect of the domain name;

Accordingly I hold that the Registrant has no rights or legitimate interests in respect of the Disputed Domain Name.

6.3

Condition 4(C): the Registrant's domain name has been registered or is being used in bad faith

Clause 7 of INDRP Policy provides as under:

Clause 7. Evidence of Registration and use of Domain Name in Bad Faith

For the purposes of Clause 4(c), 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:

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(a) 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 trademark 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

(b) the Registrant has registered the domain name in order to prevent the owner of the trademark 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

(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.

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Complainant submits that bad faith is implicit in the registration of the Disputed Domain Name. The Respondent unauthorizedly registered the Disputed Domain Name on 09 March 2019, by which time the Complainants' 24-Formative Marks, through extensive and continuous use for more than 4 years, had acquired immense goodwill and reputation amongst the public and trade.

The Complainants' Cars24, Bikes24 and other 24-Formative Marks are highly distinctive and well-known throughout the world. The Cars24, Bikes24 and other 24-Formative Marks in various stylized designs has been continuously and extensively used since 2015 and has rapidly acquired considerable goodwill and renown worldwide, including in India.

Paragraph 3(b) of the INDRP Policy enjoins the Respondent to ensure that *"the registration of the domain name will not infringe upon or otherwise violate the rights of any third party"*.

Yet, the Respondent registered the Disputed Domain Name, which is identical and deceptively similar to the Bikes24 Mark, in contravention of Paragraph 3(b) of the INDRP Policy. Such

acts impute explicit bad faith in registration. In WhatsApp Inc. v. Private Person / Mario Rieger (WIPO Case No. DRO2017-0005), the panel held that: "*The Panel is of the opinion that the Respondent has registered the Domain Name with the intent to profit from the reputation of the Complainant's trademark by choosing a domain name that is confusingly similar to the Complainant's mark.* Therefore, given the inherent and acquired distinctiveness of Bikes24, Cars24 and other 24-Formative Marks, the Complainants submit that the Respondent could simply not have chosen the Disputed Domain Name, which is confusingly similar to the Complainants' well-known marks, for any reason other than to take unfair advantage of the Complainants' goodwill and reputation.

Prior panels have held that actual and constructive knowledge of a Complainants' rights at the time of registration of a domain name constitutes strong evidence of bad faith. [See, eBay Inc. v. Sunho Hong, (WIPO Case No. D2000-1633), E. & J. Gallo Winery v. Oak Investment Group, (WIPO Case No. D2000-1213)]. The Complainants, therefore, submit that the

Respondent registered the Disputed Domain Name in full knowledge of the Complainants' rights and hence, amounts to bad faith.

After the First Legal Notice was sent by the Complainants, the Respondent in its reply dated 27 July 2021 acknowledged Complainants' rights in the Bikes24 Mark and also in the Disputed Domain Name. Although the Respondent took down the website which was being hosted on the Disputed Domain Name, the Respondent did not make any effort to transfer the Disputed Domain Name to the Complainants, despite multiple requests being made by the Complainants.

The Complainants had further sent a Second Legal Notice on 04 August 2021 directing the Respondent to transfer the Disputed Domain Name, however, received no reply. This passive holding of the Disputed Domain Name and the reluctance to reply to the notice issued by the Complainant leaves no doubt as to the Respondent's *mala fide* intention to further hold the Disputed Domain Name to take undue commercial advantage in the future. In Go Daddy Operating Company, LLC v. Wu Yanmei

(WIPO Case No. D2015-0177), the panel held that: "*The Respondent's lack of response to the Complainant's requests, is a further indication of the Respondent's bad faith registration and use of the disputed domain names.*"

As stated above, pursuant to the First Legal Notice being sent by the Complainants, the website which was being hosted on the Disputed Domain Name was taken down by the Respondent. However, the Respondent continues to hold the Disputed Domain Name passively which amounts to the usage of the domain name in bad faith. The term "*being used in bad faith*" has been interpreted to encompass *inaction* and passive holding of the domain name. That is to say, it is possible, for inactivity by the Respondent to amount to the domain name being used in bad faith. [See, *Telstra Corporation Limited v. Nuclear Marshmallows* (WIPO Case No. D2000-0003), *Jupiters Limited v. Aaron Hall* (WIPO Case No. D2000-0574), *Polaroid Corporation v. Jay Strommen* (WIPO Case No. D2005-1005)]

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Further, the Panel constituted in *Telstra Corporation Limited v. Nuclear Marshmallows* (WIPO Case No. D2000-0003) held that “*in considering whether the passive holding of a domain name, following a bad faith registration of it, satisfies the requirements of paragraph 4(a)(iii), the Administrative Panel must give close attention to all the circumstances of the Respondent’s behavior. A remedy can be obtained under the Uniform Policy only if those circumstances show that the Respondent’s passive holding amounts to acting in bad faith.*”

From perusal of above submissions of the complainant it is established that the Complainant has shown that the Complainant has acquired well known reputed and global entity with extensive operations around the world in short span since 2015. The Registrant was most certainly aware of the repute and goodwill of the Complainant. Therefore adoption of the substantially identical Disputed Domain Name by the Registrant in 2019 is with the sole intention to trade upon and derive unlawful benefits from the goodwill accruing to the Complainant. The Registrant has in fact knowingly adopted the Disputed Domain Name which wholly -

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contains the Complainant's prior trademark 'bikes24' to attract customers to the Disputed Domain Name by creating confusion with the Complainant's reputed trademark 'bikes24' and corresponding domain name.

In view of above facts, submissions of the Complainant and on perusal of the documents annexed with the Complaint and in view of various decisions of earlier panels, I find that the Complaint has proved the circumstances referred in Clause 7(a)(b) and (c) of INDRP policy and has established that the registration of disputed domain name is in bad faith. Accordingly I hold that the Registrant's Domain Name has been registered in bad faith.

Decision:

7.1. In view of the foregoing, I hold that the Disputed Domain Name is identical and or confusingly similar to the Complainant's well-known 'bikes24' Trademarks and that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and that the Disputed Domain Name was registered in bad faith.

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In accordance with the INDRP Policy and Rules, I direct that the Disputed Domain Name registration be transferred to the Complainant,

- 7.2. In the facts and circumstances, as discussed above, I deem it appropriate to order the Respondent to pay cost of Rs.50,000/- for present proceedings to the Complainant.

Delhi
Dated 07.03.2022

Alok Kumar Jain
Alok Kumar Jain
Sole Arbitrator