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INDIA NON JUDICIAL

Government of National Capital Territory of Delhi

e-Stamp

Certificate No.

: IN-DL19319950867816S

Certificate Issued Date

: 18-Dec-2020 03:00 PM

Account Reference

: IMPACC (IV)/ di925103/ DELHI/ DL-DLH

Unique Doc. Reference

: SUBIN-DL92510342695809889167S

Purchased by

: SRIDHARAN RAJAN RAMKUMAR

Description of Document

: Article 12 Award

Property Description

: Not Applicable

Consideration Price (Rs.)

: 0
(Zero)

First Party

: SRIDHARAN RAJAN RAMKUMAR

Second Party

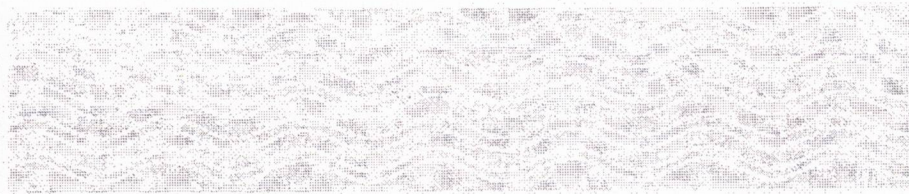
: Not Applicable

Stamp Duty Paid By

: SRIDHARAN RAJAN RAMKUMAR

Stamp Duty Amount(Rs.)

: 100
(One Hundred only)



Please write or type below this line

**BEFORE THE SOLE ARBITRATOR UNDER THE .IN DOMAIN NAME DISPUTE
RESOLUTION POLICY**

INDRP Case No: 1284

IN THE MATTER OF:

Facebook, Inc.

1601 Willow Road

Menlo Park, California 94025

United States of America

Email: domaindisputes@hoganlovells.com

... Complainant

VERSUS

Alice Collier

4682, Haven Lane

Michigan - 48933

United States of America

Email: domainstorepro@gmail.com

...Respondent

AWARD

1. THE PARTIES:

The Complainant in this administrative proceeding is **Facebook, Inc.**, an American corporation with its principal place of business at 1601 Willow Road, Menlo Park, California, 94025, United States of America (hereinafter the **Complainant** or **Facebook**). The Respondent is one **Ms. Alice Collier having her address as** 4682, Haven Lane, Michigan – 48933, United States of America

2. THE DOMAIN NAME AND REGISTRAR:

The disputed domain name : facebookhome.in

The domain name registered with .IN REGISTRY

3. PROCEDURAL HISTORY:

October 22, 2020:

Date of Complaint

November 05, 2020:

The .IN REGISTRY appointed Sridharan Rajan Ramkumar as Sole Arbitrator from its panel as per paragraph 5 (b) of INDRP Rules of Procedure after taking a signed statement of acceptance and declaration of impartiality and independence.

November 05, 2020

Arbitral proceedings were commenced by sending notice to

Respondent through e-mail as per Paragraph 4 (c) of INDRP Rules of Procedure, marking copy of the same to Complainant's authorized representative and to the .IN REGISTRY to file response within 15 days of receipt of same.

Respondent failed to file his response within the 15 days time period intimated to all parties

4. **FACTUAL AND LEGAL BACKGROUND :**

The Complainant's authorized representative in this administrative proceeding is one David Taylor / Jane Seager, of Hogan Lovells (Paris) LLP. A copy of the Power of Attorney duly signed by the Complainant was provided at **Annexure 1**.

According to the WHOIS database, the Respondent in this administrative proceeding is unknown (hereinafter the **Respondent**). The copy of the publicly-available WHOIS record for the Domain Name was provided as **Annexure 2**.

According to the information transferred by NIXI further to the Complainant's filing of the Complaint, the Domain Name is registered to **Alice Collier** based in the United States of America.

This dispute concerns the domain name <facebookhome.in> (hereinafter the **Domain Name**), which was registered by the Respondent on 3 February 2020.

The Complainant

The Complainant, **Facebook, Inc.**, is the world's leading provider of online social networking services. Founded in 2004, Facebook allows internet users to stay connected with friends and family, and to share information mainly via its website available at www.facebook.com at **Annexure 3** for a screen capture of www.facebook.com. It was stated that since its launch in 2004, Facebook rapidly developed considerable renown and goodwill worldwide, with 1 million active users by the end of 2004. Further, it was submitted that today, Facebook has over 2.6 billion monthly active users and 1.73 billion daily active users on average worldwide. In addition, in March 2020, there were more than 334 million Facebook users in India. **Annexure 4** was cited as containing the statistics concerning the popularity of the Complainant's website and of its mobile application. **Annexure 5** was cited as containing Facebook's company information, "Facebook Reports Fourth Quarter and Full Year 2019 Results" press release, Facebook's Wikipedia entry and press articles on Facebook's explosive growth and popularity worldwide including India.

It was submitted that given the exclusive online nature of the Complainant's social networking business, the Complainant's domain names consisting of its trade marks are not only the heart of its entire business but also the main way for millions of users to avail themselves of its services. Reflecting its global reach, Facebook is the owner of numerous domain names consisting of its FACEBOOK trade mark at **Annexure 6**.

It was submitted that the Complainant has also made substantial investments to develop a strong presence online by being active on the different social media forums. Screen captures of the Complainant's social media websites was at **Annexure 7**.

It was submitted that the fame of the Complainant's trade marks is, ironically, also evidenced by the number of cybersquatters who have sought to unfairly and illegally exploit the very significant consumer recognition and goodwill attached to its trade mark. Prior domain name dispute panels have recognized the strength and renown of the Complainant's trade mark, and have ordered infringing respondents to transfer the disputed Domain Name to the Complainant, including but not limited to the following decisions:

- a) *Facebook, Inc. v. Emma Boiton*, WIPO Case No. D2016-0623, <facebookatwork.com> and <fbatwork.com> (registered in 2014 and 2015);
- b) *Facebook, Inc. v. Mirza Azim*, WIPO Case No. D2016-0950, <facebookwork.com> (registered in 2014) ("It results from the Complainant's undisputed allegations and evidence that Facebook, Inc. was established in 2004 and has worldwide goodwill and renown");

- c) *Facebook, Inc. v. Xiamen eName Network Co., Ltd. / Shawn, Wang*, WIPO Case No. D2015-1339, <facebookmessenger.com> (registered in 2014);
- d) *Facebook, Inc. v. Domain Admin, Whoisprotection.biz / Murat Civan*, WIPO Case No. D2015-0614 (<facebookdealers.org>) (registered in 2014); and
- e) *Facebook, Inc. v. Sleek Names, SL Names, VSAUDHA*, WIPO Case No. D2015-0547, <facebookanalytics.com> *et al.* (registered between 2008 and 2012).

It was submitted that the term FACEBOOK is exclusively associated with the Complainant. All search results obtained by typing the term FACEBOOK in Google search engine available at www.google.com and www.google.co.in refer to the Complainant was at **Annexure 8**.

It was submitted that in addition to its strong presence online, Facebook owns numerous trade mark registrations in the term "FACEBOOK", in many jurisdictions throughout the world. It was further submitted that the said trade mark registrations include but are not limited to the following at **Annexure 9 viz:**

- United States Trademark Registration No. 3041791, FACEBOOK, registered on 10 January 2006 (first use in commerce in 2004);
- United States Trademark Registration No. 3122052, FACEBOOK, registered on 25 July 2006 (first use in commerce in 2004);
- Indian Trade mark No. 1622925, FACEBOOK, registered on 9 November 2011; and
- International Registration No. 1075094, FACEBOOK, registered on 16 July 2010.

It was submitted that the Complainant's valuable reputation offline and online is not only crucial to maintain the value and distinctiveness of its brand, but also vital to the success, integrity and protection of its business and customers. It was further submitted that the Complainant devotes significant resources to protect its trade mark rights and goodwill in forums such as this administrative proceeding.

The Respondent, the Domain Name and the associated website

It was submitted that the Complainant's FACEBOOK trade mark and company name had been registered with the addition of the dictionary term "home" under the .IN country code Top Level Domain (ccTLD) by the Respondent.

It was submitted that at the time of the filing, the Domain Name is not active. Screen capture of the website associated with the Domain Name was provided at **Annexure 10**.

It was submitted that on 19 March 2020, the Complainant's lawyers received a message from the email address kpmving@gmail.com proposing to sell the Domain Name. On 2 April 2020, the Complainant lawyer replied with a cease and desist letter by email asserting the Complainant's trade mark rights and asking the sender of the email to transfer the Domain Name to the Complainant. On 16 April, the Complainant's lawyers sent a reminder notice to the email address from which they received the initial correspondence. It was submitted that the user of the email address kpmving@gmail.com did not reply, but restated its proposal to sell the Domain Name to the Complainant on 14 July 2020 and 19 September 2020 at **Annexure 11**.

It was submitted that a search was carried out by the Complainant which revealed that the email address kpmving@gmail.com is currently associated with other trade mark abusive domain names, including <amazonwebstore.us>, <armanibeauty.net>, <flyemirates.us>. In addition, the email address kpmving@gmail.com used to be associated with the domain name <amazonbooks.fr> at **Annexure 12**.

It was also submitted that the owner of the email address kpmving@gmail.com was involved in at least two previous domain name proceedings where the panellists ordered the transfer of the disputed domain names to the complainants. See:

- a) *Calligaris S.p.A. v. Christine K. Hoyer* INDRP / 503 (<calligaris.in>), where the respondent, Christine K. Hoyer, used the email address kpmving@gmail.com and
- b) *Simba Sleep Limited, Turner, LLM v. Lorraine Konovalova* .EU Dispute Case No.: 07591 (<simbasleep.eu>) where the respondent, Lorraine Konovalova, also used the email address kpmving@gmail.com.

It was submitted that furthermore, further to the disclosure of the underlying details of the Domain Name by NIXI on 17 September 2020, the Complainant conducted a search on the Respondent's details, Alice Collier of Lansing, MI, using the email address domainstorepro@gmail.com. The search revealed that the Respondent is or used to be the registrant of at least seven other trade mark abusive domain names:

- a) <workplacebyfacebook.fr> - previously registered to Francesca Konovalova using the email address domainstorepro@gmail.com;
- b) <hewlettpackard.mx> – registered to Alice Collier of Lansing, MI;
- c) <thenorthface.net> – registered to Alice Collier with the email address domainstorepro@gmail.com;

- d) <tesla.mx> – registered to Alice Collier of Lansing, MI;
- e) <buzzfeed.info> – previously registered to Alice Collier with the email address domainstorepro@gmail.com;
- f) <dolce-gabbana.com.mx> – previously registered to Alice Collier of Lansing, MI;

Annexure 13 filed were copies of the current and historical WhoIs records of other trade mark abusive domain names registered by the Respondent.

In addition, it was submitted that the Respondent was also involved in another previous domain name proceeding where the panellist ordered the transfer of the disputed domain name to the complainant. See *Cimpress Schweiz GmbH v. Virginie Trotter*, INDRP/849 (<cimpress.in>), where the respondent, Virginie Trotter, also used the email address domainstorepro@gmail.com

Although the Respondent's email address, domainstorepro@gmail.com, differs from the email address kpmving@gmail.com from which the offer to sell the Domain Name was sent to the Complainant's lawyers, there is reason to believe that the Domain Name is subject to common control by either the same person or connected parties using two different email addresses. Indeed, as found by the panel in the decision *Cimpress Schweiz GmbH v. Virginie Trotter* quoted above, the Respondent is a habitual cyber squatter and uses various details while registering domain names, as strongly suggested by the past decisions invoked in the previous paragraphs of this Complaint.

5. PARTIES CONTENTIONS:

A. Complainant

- (a) The Domain Name is identical or confusingly similar to a Trademark of the Complainant
- (b) Respondent has no legitimate interest in the domain name
- (c) Respondent has registered the domain name in bad faith

The Complainant asserts that each of the aforementioned factors are established, as substantiated as substantiated below:

The Domain Name is identical or confusingly similar to the Complainant's trademarks

It was submitted that the Complainant owns numerous trade mark registrations for FACEBOOK in many jurisdictions throughout the world, including India under registration no 1622925 with FACEBOOK AS A WORD MARK IN CLASS 9, 38 & 42. The said registrations are as on date valid and subsisting, the details of which are provided in the factual-background section above as per **Annexure 9**. The Complainant has therefore established rights in FACEBOOK for the purposes of paragraph 4(i) of the Policy.

It was submitted that the Domain Name is confusingly similar to trade marks in which the Complainant has rights. That the Domain Name incorporates the Complainant's FACEBOOK trade mark in its entirety with the addition of the descriptive term "home". The Complainant submits that the combination of the Complainant's FACEBOOK trade mark together with the descriptive term does not prevent a finding of confusing similarity between the Domain Name and the Complainant's FACEBOOK trade mark, which remains clearly recognizable in the Domain Name. That it is well established under the .IN Policy that a suffix, such as .IN, is immaterial when assessing whether a domain name is identical or confusingly similar to a complainant's trade mark. That it is the responsibility of the Respondent to find out before registration that the domain name it is going to register does not violate the rights of any proprietor/brand owner. Thus the Domain Name is confusingly similar to the Complainant's trade mark in accordance with paragraph 4(i) of the .IN Policy.

The Respondent has no rights or legitimate interests in respect of the Domain Name

That the Respondent has no rights or legitimate interests in the Domain Name. That since I have held that the Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests, the burden of production on this element shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. That though sufficient opportunity was provided to the respondent to come forward with such relevant evidence which she has failed to do. Hence, the complainant is deemed to have satisfied the second element. That the Respondent has failed and neglected to invoke any of the circumstances set out in Paragraph 7 of the .IN Policy, in order to demonstrate rights or legitimate interests in the Domain Name.

That the Complainant has not authorised, licensed or otherwise allowed the Respondent to make any use of its FACEBOOK trade mark, in a domain name or otherwise and neither has it been asserted before me by the Respondent that, prior to any notice of this dispute, she was using, or had made demonstrable preparations to use, the Domain Name in connection with a *bona fide* offering of goods or services in accordance with paragraph 7(i) of the .IN Policy. As described above, the Domain Name has never been resolving to an active website. Thus such passive holding of the Domain Name cannot constitute a bona fide offering of goods and services under the .IN Policy. That the Respondent, Alice Collier, cannot conceivably assert that she is commonly known by the term FACEBOOK, in accordance with Paragraph 7(ii) of the .IN Policy, and has not secured or even sought to secure any trade mark rights in the terms FACEBOOK or FACEBOOK HOME.

That neither can the Respondent assert that she has made or is currently making a legitimate non-commercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert users or to tarnish the trade mark or service mark at issue, pursuant to Paragraph 7(iii) of the .IN Policy. As previously mentioned, the Complainant's lawyers received a message offering the sale of the Domain Name. Such use of the Domain Name, which is confusingly similar to the Complainant's distinctive and well-known trade mark, cannot be considered as *bona fide* use, nor can it be deemed as non-commercial or fair use of the Domain Name within the meaning of 7(iii) of the .IN Policy. Thus the Respondent has no rights or legitimate interests in the Domain Name, in accordance with paragraph 4(ii) of the .IN Policy.

The Domain Name was registered or is being used in bad faith

That the Domain Name was registered *and* is being used in bad faith for following reasons:

Registration in bad faith

That it is inconceivable for the Respondent to state that she did not have knowledge of the Complainant's FACEBOOK trade mark at the time of registration of the Domain Name in the year 2020, particularly as the Complainant's trade mark rights predate the registration date of the Domain Name by many years. Moreover, in 2020 the Complainant's social networking service had already acquired significant goodwill, with approximately 334 million Facebook users in India as detailed in Annexure 4 and 5 to the Complaint. Furthermore, the offer to sell the Domain Name addressed to the Complainant's lawyers leaves no doubt as to the Respondent's awareness of the Complainant's rights at the time of registration. This is also confirmed by the fact that the Respondent previously registered another domain name targeting the Complainant, <workplacebyfacebook.fr> at **Annexure 13**.

That the Respondent registered the Domain Name in full knowledge of the Complainant's rights, and that actual and constructive knowledge of a complainant's rights at the time of registration of a domain name constitutes strong evidence of bad faith. That given the Complainant's visibility and renown at the time of registration of the Domain Name and the Respondent's prior knowledge of the Complainant's rights and its renown in India, it is apparent that the Respondent knowingly and deliberately registered the Domain Name in bad faith seeking to somehow profit from the Complainant's goodwill and renown. That the above is reinforced by the fact that the Complainant's lawyers received an unsolicited offer to sell the Domain Name clearly demonstrates that the Respondent registered the Domain Name primarily for the purpose of selling it to the Complainant for valuable consideration in excess of her documented out-of-pocket costs directly related to the Domain Name, in accordance with Paragraph 6(i) of the .IN Policy.

The Complainant further submits that the Respondent has engaged in a pattern of conduct within the meaning of Paragraph 6(ii) of the .IN Policy. As previously explained, the Respondent has a history of trade mark abusive registrations at **Annexure 13** for copies of current or historical WhoIs records of other trade mark abusive domain names registered using the Respondent's email address. That from the submissions made in the Complaint it is clear that the Respondent's pattern of abusive domain name registrations can only be interpreted as a strong

indication of her bad faith in the present case. Thus the Respondent registered the Domain Name in bad faith in accordance with paragraph 4(iii) of the Policy.

Use in bad faith

That the Domain Name is not resolving to an active website. However, it is a well-established principle that it is not necessary for a disputed domain name to be associated with an active website for a finding of bad faith to be made under the Policy.

That though it was fairly submitted that to the best of the Complainant's knowledge, the Respondent has never actively used the Domain Name. I hold that such passive holding of the Domain Name would not preclude a finding of bad faith given the overall circumstances of the case. I have given considerable thought to the totality of the circumstances in this case and considered all relevant factors in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. I thereafter have no hesitation to hold that in the present case, all factors are satisfied. That inspite of the Complainant's efforts to contact the Respondent prior to submitting the present Complaint, the Respondent has failed to engage with the Complainant or otherwise come forward with any actual or contemplated good-faith use of the Domain Name. In addition, the Respondent's contact details in the WhoIs are most probably false. The underlying registrant details of the Domain Name revealed by NIXI mention the email address domainstorepro@gmail.com and the name Alice Collier. However, the same email address was used to register another trade mark abusive domain name in the name of Francesca Konovalova (see **Annexure 13** for the WHOIS record of the domain name <workplacebyfacebook.fr>). Also, as stated above, the Respondent contacted the Complainant's lawyers using the email address kpmving@gmail.com and the name "Jessica" at **Annexure 11**. In fact, the same email address has previously been used to register many trade mark abusive domain names in the past, but the associated registrant names in the WHOIS have been different for each registration. I hold that the use of incomplete, inaccurate or false contact information in the WHOIS constitutes clear evidence of bad faith on the part of the registrant. Finally, I hold that given the renown and well known name, stature and reputation of the Complainant's FACEBOOK trade mark worldwide, it is simply not possible to conceive of any plausible actual or contemplated active use of the Domain Name by the Respondent (or a third party) that would not be illegitimate, as it would inevitably result in misleading diversion and taking unfair advantage of the Complainant's rights.

6. DISCUSSION AND FINDINGS:

In view of all the above facts and well known legal propositions and legal precedents I find and hold as under:

- that that the Respondent's domain name is deceptively similar to the trademark/ trade name in which the Complainant has rights,
- that the disputed domain name facebookhome.in registered by the Respondent incorporates the Complainant's well-known FACEBOOK trademarks in their entirety,
- that due to the fame of the distinctive and reputation of the trade mark FACEBOOK,

the first impression in the minds of the users shall be that the Respondent's website originates from, is associated with, or is sponsored by the Complainant.

- that the Respondent has no rights or legitimate interests in respect of the domain name.
- that none of the exemptions provided under paragraph 7 of the .IN Domain Dispute Resolution Policy (INDRP) apply in the present circumstances.
- that Complainant has not authorised, licensed, or permitted the Respondent to register or use the Domain Name or to use the FACEBOOK trademark.
- that the Complainant has prior rights in the trademark FACEBOOK which precedes the registration of the disputed domain name by the Respondent.
- that the Complainant has therefore established a *prima facie* case that the Respondent have no rights and legitimate interests in the disputed domain name and thereby the burden of proof shifts to the Respondent to produce evidence demonstrating rights or legitimate interests in respect of the Domain Name.
- that the disputed domain name has been registered in bad faith
- that the disputed domain name is deceptively similar to the Complainant's registered trademark FACEBOOK, in which the Respondent cannot have any rights or legitimate interest.

That I received no Response / Reply to the Complaint on behalf of the Respondent though proper service was effected to her email addresses provided and I am satisfied that the Respondent has received the copy of the Complaint as well as the Order and direction of this Tribunal to submit her reply within 15 days of receipt of the Complaint and the email of the Tribunal. I have therefore proceeded only on the basis of available documents and assertions on the law and facts made before me.

7. DECISION

- a) In view of the above facts and circumstances, it is clear that the Complainant has succeeded in its complaint.
- b) That the .IN Registry of NIXI is hereby directed to transfer the domain name/URL of the Respondent "facebookhome.in" to the Complainant;
- c) In the facts and circumstances of the case no cost or penalty is imposed upon the Respondent. The Award is accordingly passed on this 24th Day of December, 2020.

Sridharan Rajan Ramkumar
Sole Arbitrator
Date: 24/12/2020