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 Purchased by : R K KASHYAP SOLE ARBITRATOR
 Description of Document : Article 12 Award
 Property Description : Not Applicable
 Consideration Price (Rs.) : 0
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Please write or type below this line

NATIONAL INTERNET EXCHANGE OF INDIA
 B Wing, 9th Floor, Statesman House Building
 148, Barakhamba Road,
 New Delhi-110001

PARAMOUNT PICTURES CORPORATION

V/s

E-MARKETPLACE PTY LTD

Paramount Pictures

Statutory Note:

1. The authenticity of this Stamp certificate should be verified at www.shreestamp.com or using e-Stamp Mobile App of Govt. Holding and State Agency in the details on this Certificate and as available on the website / Mobile App renders it invalid.
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AWARD

1. THE PARTIES

The Complainant is **Paramount Pictures Corporation**, having office at 5555 Melrose Avenue, Hollywood, California 90038, United States of America, Telephone- +91.995.8918.715 by its authorized representative Sheja Ehtesham & Ashwani Balayan, ALG India Law Offices LLP, having their office at 244, Vedanta Apartments, Plot No. 6C, Sector 23, Dwarka, New Delhi - 110 077, India, Telephone: +91.995.8918.715, Email: domains@algindia.com

The Respondent is E-Marketplace Pty Ltd, 123 Refertoemail, Address, Queensland, Australia - 4034 and E-mail domainadmin@e-marketplace.com.au

2. THE DOMAIN NAME AND REGISTRAR:

This Arbitration pertains to a dispute regarding the Domain name <paramountplus.co.in>

The disputed Domain name is <paramountplus.co.in >

The abovesaid domain registered particulars in detail is provided along with the complaint.

Registrar Name: Instra Corporation PTY LTD

IANA ID : 1376

Date of creation: 05.05.2022

Date of Expiry : 05.05.2023

Registrant Client ID : DNA26070777417

Registrant ROID: C6C5207ABOA4C41AD88E1501FCA897C2F-IN

Email: domainadmin@e-marketplace.com.au

Phone: (+61). 435766276

3. PROCEDURAL HISTORY

- (a) The Complainant has filed a complaint on 12.07.2022 with the NATIONAL INTERNET EXCHANGE OF INDIA. The Complainant made the registrar verification in connection with the Domain name at issue. The annexures received with the complaint are **Annexure-1 to 22.**

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The exchange verified the complaint, satisfied the formal requirements of the Indian Domain Name Dispute Resolution Policy (INDRP) (the 'Policy') and the Rules framed thereunder.

- (b) The NIXI has appointed Sh. R.K. Kashyap, Advocate as the Sole Arbitrator vide Email dated 21.07.2022. The Arbitrator has duly submitted his Statement of acceptance and Declaration of Impartiality and Independence on 23.07.2022, as required by the Exchange.
- (c) The Arbitrator, as per the INDRP Policy and the Rules, has duly issued the notice on 25.07.2022 and directed the complainant to serve the Respondent with a copy of the Complaint alongwith annexures on the given e-mail as well as on physical address. In the Notice, it has also been mentioned that the respondent to file the reply/response within 10 days from the receipt of notice. The direction of the arbitrator to serve the respondent has duly been complied with vide Email dated 26.07.2022, and sent the receipt regarding the service through Email and also sent through post vide consignment no. ED9659794981IN, on 26.07.2022, showing item duly delivered on 22.08.2022. Till date the respondent has not filed any reply/response within the stipulated time, hence, the respondent proceeded Ex-parte and Ex-parte Award is being passed.

4. **Factual Background:**

The following information has been derived from the Complaint and the various supporting annexure to it, the Arbitrator has found the following facts:

Complainant's Activities

1. The complainant is the prior adopter, sole owner, registered proprietor and first and exclusive user across several countries worldwide, including in India, the entire details in this regard has been provided in **anx-5**. The complainant is a subsidiary of paramount global is a leading global media and entertainment company and is home to premier global media brands that create compelling television programs, motion pictures, short-form content, applications (apps),

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games, consumer products, social media experiences and other entertainment content in over 45 languages for an audience of more than 4.3 billion via more than 320 locally programmed and operated tv channels in more than 180 countries worldwide. Driven by iconic consumer brands, paramount global's portfolio includes paramount pictures, paramount+, paramount network, pluto tv, cbs, showtime, nickelodeon, mtv and comedy central among others. The entire relevant details is duly provided in Annexure 6.

2. The complainant is one of the largest entertainment and media brands of the world. Founded in the year 1912, the complainant is America's oldest running film studio and is consistently ranked as one of the top-grossing movie studios in the world. The complainant's predecessor, 'famous players film company' adopted the name "paramount pictures" in 1914. The complainant boasts of maintaining a library consisting of more than 3500 films and over 140,000 television-program episodes, the details in this regards is provided in Annexure 7 & 8.
3. In India, complainant has been using the paramount mark since at least as early as 1920 in respect of its goods and services, the relevant details are provided in Annexure 9.
4. The complainant also owns several domain name registrations featuring the marks paramount and paramount plus. representative list of the registered domains is as follows:

- <paramount.com> registered since October 29, 1993.
- <paramountplus.com> registered since January 3, 2012.
- <paramount.net> registered since April 5, 1996.
- <paramountmovies.com> registered since August 13, 1997.
- <paramountstudios.com> registered since February 26, 1999.
- <paramount.asia> registered since November 26, 2007.

The details are duly provided in Annexure 10.

Paramount

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5. In 1929, the complainant won the first-ever academy award for best picture for its movie *wings* released under the paramount mark. between 1940– 1950S, several of the complainant's movies were nominated for the academy awards, and the complainant also released many iconic movies such as *rosemary'sbaby*, *psycho*, *love story*, etc., in 1960. between 1970s and 1990s. the details in this regards are provided in **Annexure 11**. The complainant also owns a premium online streaming platform under the paramount plus mark, in particular, paramount+ ('paramount plus'), the website for which is hosted at www.paramountplus.com. , the relevant information are provided in **Annexure 12**.
6. In India, complainant's movies and tv programmes under the paramount mark have been released/viewed, have garnered a huge fan base, and are also available/accessible through electronic media such as video discs, dvds, blu-ray discs, etc. through the complainant's distributors/licensees/dealers as well as online through its website www.paramountstore.com , the entier details are provided in **Annexure 13, 14 & 15**. The longstanding, consistent and extensive use worldwide, including in india, complainant's paramount mark and paramount plus mark have acquired a significant degree of fame, reputation and well-known status across the globe. the marks have attained widespread awareness among relevant trade circles, customers, and across the industry. the outstanding reputation, goodwill and brand value associated with the PARAMOUNT Mark and PARAMOUNT PLUS Mark is inestimable value to the complainant.

5. **DISCUSSION AND FINDINGS:**

The Rules instructs this Arbitrator as to the Principles to be used in rendering its decision. It says that, "a panel shall decide a Complaint on the basis of the statements and documents submitted by the parties in accordance with the Policy, the Arbitration and Conciliation Act, 1996, the Rules and any Rules and Principles of Law that it deems applicable".

According to the Policy, the Complainant must prove that:-

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- A) The registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the complainant has rights;
- B) The registrant's has no rights or legitimate interests in respect of the domain name that is the subject of complaint; and
- C) The registrant's domain name has been registered or is being used in bad faith.

(A). **Identical or Confusingly Similar:**

- 1) The complaint is based on the complainant's prior, exclusive, and statutory rights in the paramount plus mark and paramount mark which have been established in 1914 internationally and 1920 in India. The paramount mark and paramount plus mark are sufficiently distinctive, unique, famous, and registered, refer judgments wipo case no. d2010-0858 and INDRP case no.278.
- 2) The disputed domain name <paramountplus.co.in> is identical to the complainant's paramount plus mark and is confusingly similar to the complainant's paramount mark. the disputed domain name <paramountplus.co.in> incorporates in entirety the complainant's trademarks paramount and paramount plus with the ccslid '.co.in'. it is submitted that the ccslid/cctld element of a domain name has no distinguishing capability and should be disregarded while considering whether a domain name is identical or confusingly similar to a trademark. in fact, it is a well-established principle that the ccslid/cctld suffix in a domain name (".co.in" in this case) should be disregarded for the purpose of comparison and similarity, since it is a technical requirement of registration of domain names. accordingly, disregarding the CCSLD ".CO.IN", the disputed domain name <paramountplus.co.in> is identical to paramount plus mark as well as the complainant's paramount domains, in particular, the domain name <paramountplus.com>, the complainant relied upon the following decisions:-

WIPO case no. d2001-0903
NIXI case no. INDRP/910
NIXI case no. INDRP/033
NIXI case no. INDRP/907

- 3) Thus, it is crystal clear that the disputed domain name is

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identical to the complainant's paramount plus mark as well as paramount domains, in particular, the domain name <paramountplus.com> and is confusingly similar to the paramountmark.

- 4) The disputed domain name < paramountplus.co.in > is virtually identical or at least confusingly similar to complainant's prior trademarks matrix and the official domain name <paramount and paramount plus>.
- 5) The domain name < paramountplus.co.in > reproduces complainant's trademark paramount and paramount plus in its entirety in many decisions, panels considered that the incorporation of a trademark in its entirety may be sufficient to establish that a domain name is identical or confusingly similar to complainant's registered trademark (wipo case no. d2013-0150 *swarovski aktiengesellschaft v. mei xudong*; indrp case no. indrp/887 <colgate.in> decided on may 26, 2017, indrp case no. indrp/741 <goodyear.in> decide on february 8, 2016). the following decisions may be referred in this regards:-

wipo case no. d2011-1627
wipo case no. d2010-1059
wipo case no. d2000-0113
wipo case no. d2011-0692
wipo case no. d2009-1050
wipo case no. d2008-1302
wipo case no. d2013-0368
wipo case no. d2015-2333

- 6) Accordingly, with the registration of the disputed domain name, respondent created a likelihood of confusion with complainant's trademarks. it is likely that this domain name could mislead internet users into thinking that this is, in some ways, associated with complainant and thus may heighten the risk of confusion.
- 7) The complainant has been continuously and extensively using the registered trademark paramount and paramount plus since its adoption way back from 1914 - both internationally - and thus its rights in the **matrix** marks are beyond reproach.

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- 8) The respondent's domain name paramountplus.co.in is identical to the complainant's trademark **paramount and paramount plus**. Therefore, the complainant is the sole legitimate owner of the trade/service mark **paramount and paramount plus**.
- 9) Respondent's registration and use of the domain paramountplus.co.in is bound to induce members of the public and trade to believe that the respondent has a trade connection, association, relationship or approval of the complainant, when it is not so.
- 10) The distinctive and the dominant element in the respondent's domain, the word matrix hence, the domain paramountplus.co.in is identical to the trade/service mark **paramount and paramount plus** in which the complainant has statutory and common law rights.

the disputed domain name clearly incorporates the famous trademark **paramount and paramount plus** of the complainant in its entirety.

(B). The Respondent has no Rights or Legitimate Interests :

1. The respondent never authorized by complainant to use the paramount plus mark or paramount mark in relation to any goods or services. Complainant never authorized or licensed the respondent to use the paramount mark and/or paramount plus mark in any way or for any purpose. Respondent has no connection or affiliation with complainant and has not received any consent, express or implied to use the paramount mark and/or paramount plus mark in a domain name or in any other manner. Respondent does not have any past dealing with the complainant and has no reason to adopt "paramountplus" as part of the disputed domain name. Relied on wipo case no. D2000- 0020.
2. The respondent is not making any legitimate, non-commercial, or fair use of the disputed domain name. The domain <paramountplus.co.in> was registered in May 2022, The domain name only directs to a parked page of 'Only Domains' which is likely a pay-per-click page. Such use is contrary to a bona fide offering of goods or services or a legitimate interest in the mark. Relied upon wipo case no. D2020- 0669.

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3. The respondent is not commonly known by the disputed domain name and does not have any trademark rights in disputed domain name. The respondent is not commonly known by the disputed domain name and to the knowledge of the complainant has not acquired any trademark rights in the marks paramount or paramount plus. the complainant owns trademark registrations and rights in the paramount mark and paramount plus mark across countries, including in Australia where the respondent appears to be located from the available details. in fact, the respondent has actively concealed its trading name or identity from the whois records as well as on the website. the respondent has no reason to adopt or register the domain name <paramountplus.co.in>. Relied upon wipo case no. D2017-1654.
4. The respondent is attempting to sell the disputed domain name to the complainant, the respondent's lack of legitimate interest in the disputed domain name is further evident from the respondent's conduct wherein the respondent directly approached the complainant via an unsolicited email dated may 25, 2022, offering to sell the disputed domain name to the complainant and stating as follows –
“we are contacting you about the domains and www.paramountplus.co.in which we have for sale.” Accordingly, respondent obviously had direct and actual knowledge of the complainant's paramount mark, paramount plus mark and paramount domains, in particular, <paramountplus.com>, at the time of registering the disputed domain name. it is evident from the above that the respondent does not have any legitimate rights and interest in the disputed domain name and has registered the same solely with the malafide intent of making illegitimate and illegal commercial gains by way of extorting the complainant. Relied upon wipo case no. D2021-1634. Refer **Annexure-20** in this regard.
5. The respondent is neither affiliated with complainant in any way nor has he been authorised or licensed by complainant to use and register its trademarks, or to seek registration of any domain name incorporating the previously mentioned trademark. In addition, respondent is not known by the name of paramount and paramount plus. The complainant relied upon:-

WIPO CASE NO. D2013-0188
Wipo case no. D2010-0138

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6. The respondent has no prior rights or legitimate interests in the disputed domain name. The registration of the paramount and paramount plus trademarks preceded the registration of the disputed domain name for years. Moreover, the domain name in dispute is virtually identical to the complainant's matrix trademark and the official domain name <paramountplus.co.in>. The respondent wishes to give an overall impression that the disputed domain name is related to complainant and misleadingly divert consumers for fraud or commercial gain, therefore, such composition cannot constitute fair use, further demonstrating a lack of legitimate interests regarding said domain name.
7. It is most likely to be believed that respondent has no legitimate interest or rights in the disputed domain name. It cannot be inferred that respondent is making a legitimate non-commercial or fair use of disputed domain name and the complainant relying upon the following decisions:-
- WIPO case no. D2009-1529
INDRP case no. INDRP/167
WIPO case no. D2001-0903
WIPO case no. D2010-1017
WIPO case no. D2003-0269
8. The complainant's goodwill and renown worldwide, and the nature of the disputed domain name, which is confusingly similar to complainant's trademark and virtually identical to the official domain name.
9. There is no justification for the respondent's registration and/or use of the disputed domain name. By virtue of a dishonest adoption and *malafide* intent of the respondent, as established in the preceding paragraphs of this complaint, together with its brazen usage of the complainant's Paramount and Paramount Plus marks, there is no scenario wherein the respondent can claim to make legitimate non-commercial or fair use of the disputed domain name.
10. The complainant is the sole legitimate owner of the trade mark **paramount** and **paramount plus**. The complainant neither licensed nor permitted the

Paramount Plus

respondent to use trade/service mark **paramountplus.co.in** or to apply for any domain name incorporating the said trade/service marks.

(C). **Registered and Used in Bad Faith:**

1. The disputed domain name resolves to a parked page and there is a lack of bona fide offerings or business on the website: the disputed domain name does not host any active webpage but resolves to a parked page which demonstrates that the respondent is using the disputed domain name passively. there is also no instance where the respondent has made (or has made preparations for) a bona fide offering of goods/services under the mark/name paramount plus orthrough hosting at the disputed domain name <paramountplus.co.in>.
2. The actual knowledge of paramount mark, paramount plus mark and paramount domains and mala fide intent of extorting the complainant, the bad faith on the part of the respondent is evident from the fact that the respondent, by its own admission, stated that the disputed domain name is receiving high traffic and further offered the disputed domain name for sale to extort the complainant
3. The misrepresentation of source, affiliation, sponsorship and endorsement, respondent's act diverts the complainant's consumers and potential consumers seeking information about the complainant to a parked page at the disputed domain name which is identical to the complainant's domain name <paramountplus.com>, and earlier paramount mark and paramount plus mark. The respondent's actions appear to be with the objective of deceiving the public by attracting consumers by creating a likelihood of confusion as to the source of respondent's offerings (or would be offerings) and that the respondent is in any manner affiliated, sponsored and/or otherwise endorsed by the complainant.
4. The respondent's address listed in whois records appears to be fake: as per the details disclosed by NIXI, the address of the registrant organization ('123 refertoemail address') appears to be fake and illegitimate. this indicates that the actual address of the registrant of the disputed domain

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name has deliberately not been disclosed by the registrant during registration of the domain, and further illustrates its bad faith. The complainant relied upon the following decisions:-

WIPO CASE NO. D2009-0320
WIPO CASE NO. D2009-0113
WIPO CASE NO. D2011-0692
WIPO CASE NO. D2009-1050

5. Bad faith has already been found where a domain name is so obviously connected with a well-known trademark that its very use by someone with no connection to the trademark suggests opportunistic bad faith, referred the following judgements:-

WIPO Case No. D2010-0494
WIPO Case No. D2006-0303
WIPO Case No. D2008-0226
WIPO Case No. D2000-0270
WIPO Case No. D2006-0464
WIPO Case No. D2008-0287
WIPO Case No. D2007-0077
WIPO Case No. D2000-0055
WIPO Case No. D2008-0281

6. The respondent is taking undue advantage of Complainant's trademark to generate profits. The use of a well-known trademark to attract Internet users to a website for commercial gains constitutes a use in bad faith pursuant to the policy and relied upon:-

WIPO Case No. D2007-0956
WIPO Case No. D2009-1231
WIPO Case No. D2007-1736

7. The Complainant would like to emphasize the fact that the initial Respondent, E-Marketplace PTY LTD, most likely to be the current owner of the disputed domain name, is a well-known cyber-squatter that has been the subject of a number of UDRP proceedings. Find below a few examples of the proceedings that have been instituted against the Respondent:

WIPO Case No. D2020-0991
WIPO Case No. D2020-1779
WIPO Case No. DCO2021-0014
WIPO Case No. DCO2020-0045

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8. It is finally submitted that the disputed domain name was registered and is being used in bad faith. If the respondent is not restrained from using the disputed domain name and the same is not transferred to the complainant, loss and hardship will be caused to the complainant.

The very use of a domain name by someone with no connection with the Complainant suggests opportunistic bad faith, refer **INDRP case No. 1167**.

6. **DECISION**

In light of the foregoing findings, namely, that the Domain name is confusingly/deceptively similar to Complainant's well-known brand "**Paramount and Paramount Plus**", a mark in which the Complainant has rights and the Respondent has no claims, rights or legitimate interests in respect of the disputed Domain name and that the disputed Domain name was Registered in bad faith and is being used in bad faith, in accordance with the policy and the rules. Hence, the Arbitrator orders that the disputed Domain name "**paramountplus.co.in**" be transferred to the Complainant.

This Award is passed at New Delhi on this 09th Day of September, 2022

Pravish Adv.
08/9/2022

R. K. KASHYAP
SOLE ARBITRATOR