

**BEFORE ALOK KUMAR JAIN, SOLE ARBITRATOR
.IN REGISTRY
NATIONAL INTERNET EXCHANGE OF INDIA (NIXI)
INDRP ARBITRATION
INDRP Case No. 1780**

Disputed Domain Name: <BARBIECORE.IN>

ARBITRATION AWARD

Dated 26.12.23

IN THE MATTER OF:

Mattel, Inc,
333, Continental Boulevard,
El Segundo,
California 90245 – 5012,
United States of America.

Complainant

Versus

Ria Sardana
Bengaluru,
Karnataka – 560095, India.

Respondent

The Parties The Complainant, Mattel, Inc., is a public owned company listed on the NASDAQ as MAT. Its head office is located at '333, Continental Boulevard, El Segundo, California 90245 – 5012, United States of America'.

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1. The Complainant's authorized representative are Sourabh Nandrekar and Shruti Srivastava ,F-12,Ground Floor,Sector 8,Noida-201301,Phone 91-120-447550,Email:saurabh@fiduslawchambers.com and shruti@fiduslawchambers.com

1.1 Respondent in these proceedings is Ria Sardana, Bengaluru, Karnataka - 560095, India ,Email: sardanaria98@gmail.com
Phone +91 9999429419

1.2 **Domain Name and Registrar:-**

The Disputed Domain name is <WWW.BARBIECORE.IN> The Domain Name is registered with GoDaddy.com, LLC 14455 North Hayden Road, Suite 219 Scottsdale, AZ 85260 United States of America

2 **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

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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 17.11.2023 I was appointed as Sole Arbitrator to decide the disputes between the parties. I submitted statement of Acceptance and Declaration of Impartiality and Independence 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 17.11.2023 and served by email an electronic Copy of the Complaint with Annexures on the Respondent at the email addresses of the Respondent.
- 3.3. I issued notice to the parties via email dated 17.11.2023 directing the Complainant to serve complete set of Complaint on the Respondent in soft copies as well as in physical via courier /Post. The Respondent was directed to file its response within 10 days from the date of notice. Since

reply was received from the Respondent till 4.12.23. The Tribunal granted another opportunity to the Respondent to file its reply. On 11.12.2023 the tribunal received a brief reply from the Respondent along with a settlement duly signed by the parties through email. Accordingly now the complaint is being decided in terms of Rule 21 of INDRP rules of procedure.

3.4 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.

3.5. 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.

4. **Grounds for Arbitration Proceedings.**

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

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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.

5. The Case of the Complainant :-

1. It is averred in the complaint that the Complainant is a leading global toy company and owner of one of the strongest portfolios of children's and family entertainment franchises in the world which includes BARBIE, FISHER-PRICE, HOT WHEELS, AMERICAN GIRL, THOMAS & FRIENDS, UNO and MEGA BLOKS. The Complainant employs around 25,000 people in 40 countries and territories and sells products in more than 150 nations. Web extracts of the 'about us' and 'awards' pages from Complainant's official website "www.mattel.com" have been annexed as **Annexure-A**.

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2. It is stated that the Complainant adopted the trademark **BARBIE** in 1959 after one of the co-founders of the Complainant, Ruth Handler, observed her daughter Barbara playing with paper dolls and went on to create a 3-D doll for girls to play out their dreams. Then, in 1959, the first doll under the trademark **BARBIE** named after Ruth's daughter made its debut at the New York Toy Fair. Since then, the brand and character **BARBIE** has grown to become a global icon, inspiring girls everywhere to be anything.
3. The brand and character **BARBIE** is one of the most iconic figures in popular culture across the world. The trademark **BARBIE** has been licensed across wide variety of categories. **BARBIE** has thus grown to become an all-encompassing lifestyle brand. There is an official website of the Complainant, www.barbiecollector.com which redirects now to the Complainant's website www.barbie.mattel.com, which caters exclusively to **BARBIE** aficionados and collectors. Some excerpts from the membership page and the blog are enclosed as **Annexure C**. The Complainant has several mobile applications under the trademark **BARBIE** which feature games involving the life of the **BARBIE** character. The mobile application "**BARBIE**Fashion Closet" has been downloaded over 50 million times on the Google Play Store. Extracts from the Apple App Store and Google Play Store are collectively enclosed as **Annexure D**.

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4. The Complainant's website "www.shop.mattel.com" offers products under the trademark **BARBIE** for sale and "www.barbie.mattel.com" provides information about the **BARBIE** brand, its history, its upcoming launches etc. The said websites are accessible to people across the world, including in India. Some extracts from the website are collectively enclosed as **Annexure E**. Complainant's brand **BARBIE** has a strong presence on social media having 14 million likes on the Facebook page of **BARBIE** and the Instagram account of **BARBIE** has 3.6 million followers. Further, **BARBIE**'s vlog (video blog) on YouTube has over 11.6 million followers. The immense popularity of the trademark **BARBIE** on social media further indicates its global fame and reputation. Extracts from the Complainant's social media accounts are enclosed collectively as **Annexure F**.
5. Complainant introduced the doll under the trademark **BARBIE** in India at least as early as 1987 and has been continuously, extensively, and uninterruptedly been using the trademark **BARBIE** in India since then for a wide range of goods and services. The Complainant has an extensive distribution network for its products and services under the trademark **BARBIE** in India and also manufactures in India. In the 1990s, the Complainant introduced dolls under the trademark **BARBIE** in an Indian avatar, specifically aimed at the Indian market. The Complainant has over 1800 registrations for the trademark **BARBIE** in over 100 countries. An indicative list of the

Complainant's registrations for its trademark **BARBIE** is enclosed as **Annexure I**. In India, Complainant has registered the trademark **BARBIE** under The Trade Marks Act, 1999 ("Act") in several classes and details of some such registrations is given in the complaint. Copies of trademark registration certificates for aforementioned trademarks are enclosed as **Annexure J**. It is further stated that relevant to Complainant's trademark **BARBIE**, the Complainant also owns the domain names in its favour mentioned in the complaint as under:

Domain name	Registration Date
<barbie.com>	19 th June 1996
<barbie.in>	2 nd May 2007
<barbiemedia.com>	20 th October 2008
<barbiedoll.com>	6 th January 1998
<barbiecollector.com>	17 th December 1996

Copies of Whois extracts of the aforementioned domain name registrations of the Complainant have been annexed to this Complaint as **Annexure- K**. Based on its trademark rights in **BARBIE**, the Complainant has been successful in several domain name disputes under the Uniform Domain Name Dispute Resolution Policy ("UDRP"). Details of such UDRP decisions in the Complainant's are given in the complaint.

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It is further averred that the Complainant recently came across the Respondent's domain name <barbiecore.in>('disputed domain name') which was registered on 24th July 2023. The disputed domain name subsumes and is confusingly similar to the Complainant's trademarks **BARBIE** and **BARBIECORE**. This amounts to infringement of the Complainant's rights in the trademarks **BARBIE** and **BARBIECORE**. At the time of filing the instant Complaint, the disputed domain name is valid till 24th July 2024. The WHOIS extract of the disputed domain is enclosed as **Annexure L**. It is stated in the complaint that at the time of filing the instant Complaint, the disputed domain name resolves into a website ("*Respondent's website*"). The Respondent's website contains listings of products for sale like t-shirts, laptop stickers, sweatshirts, etc., all of which bear the Complainant's trademarks and other intellectual property or otherwise contain references to Complainant's Barbie movie. Many of the products listed on Respondent's website specifically bear the Complainant's **BARBIE** and **BARBIECORE** trademarks. Extracts of Respondent's Website showing the concerned weblinks are annexed as **Annexure-M** with the complaint .

Condition no.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.

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6. A perusal of the averments made in the complaint and documents annexed with the Complaint shows that the Complainant has established that it has statutory rights in the trademarks **BARBIE** and **BARBIECORE** and such rights predate the registration of the disputed domain name by many decades. The Complainant is also the holder of a domain name registration for <barbie.in> which is prior to the disputed domain name <barbiecore.in>.

The Complainant relies upon past INDRP decisions wherein it has been held that the fact that a domain name wholly incorporates a Complainant's registered trademark is sufficient to establish identity or confusing similarity for the purpose of INDRP, ITC Limited v. Travel India (*INDRP Case No. 065*), Allied DOMEQ Spirits and Wine Limited v. Roberto Ferrari (*INDRP Case No. 071*), International Business Machines Corporation v. Zhu Xumei (*INDRP Case No. 646*) and Jaguar Land Rover v. Yitao (*INDRP Case No. 641*).

The Complainant also relies on past INDRP decisions in Nike Inc. v. Nike Innovative CV Zhaxia (*Case No. INDRP/804*); Metropolitan Trading Company v. Chandan (*Case No. INDRP/811*); Lego Juris A/s v. Robert Martin (*Case No. INDRP/125*), where it was held that if a disputed domain name completely incorporates the trademark / service mark of the Complainant, then the mere addition of domain codes such as

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“.in” and/or “.co.in” will not distinguish the Respondent’s disputed domain name.

7. Hence, in the present case, the disputed domain name is confusingly similar to the Complainant’s trademark **BARBIE** and **BARBIECORE** and the Complaint has successfully satisfied the first requirement set out in clause 4(a) of the INDRP.

In view of the above facts and submissions of the complainant, and on perusal of the documents annexed with the Complaint, I hold that the Disputed Domain Name <**BARBIECORE.IN**> of the Registrant is identical and or confusingly similar to the trademark **BARBIE AND BARBIECORE** of the Complainant.

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

The Complainant stated in the complaint that the disputed domain name has not been used in connection with *bona fide* offering of goods or services by the Respondent. The disputed domain name is being used by the Respondent to attract consumers by portraying itself as an affiliate of the Complainant and making commercial gains by selling goods bearing the Complainant’s trademarks and other intellectual property, including Complainant’s **BARBIE** and

BARBIECORE trademarks. It is further stated that Respondent's use of the disputed domain name is for commercial gain as the Respondent's website offers for sale goods bearing the Complainant's intellectual property, including Complainant's **BARBIE** and **BARBIECORE** trademarks. The Respondent's use of Complainant's **BARBIE** and **BARBIECORE** trademarks and other intellectual property is unauthorised. Respondent's acts are probative of its intention to make illicit profit from unauthorised use of Complainant's **BARBIE** and **BARBIECORE** trademarks and other intellectual property. Therefore, the Respondent has no legitimate interest in the disputed domain name, rather the sole purpose of its registration is to misappropriate the reputation associated with the Complainant, including Complainant's famous trademarks **BARBIE** and **BARBIECORE**. It is further averred by the Complainant that the Complainant has not authorised, licensed, or permitted the Respondent to register or use the disputed domain name or to use the trademarks **BARBIE** and **BARBIECORE** or any of Complainant's other intellectual property. The Complainant clearly has prior rights

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in the trademarks **BARBIE** and **BARBIECORE**, which precedes the registration of the disputed domain name.

It is evident from the averments made in the complaint that the Complainant has established that the Respondent has no rights and legitimate interests in the disputed domain name. The conditions contained in clause 6(a), (b) and 6(c) of INDRP Policy are also not satisfied.

The Complainant relies on the decisions in Eurocopter, an EADS Company v. Bruno Kerrien (*Case No. INDRP Case No. 116*), Voltas Ltd. v. Sergi Avaliani (*INDRP Case No. 1257*), Hitachi Ltd v. Kuldeep Kumar (*INDRP Case No. 1092*), Do The Hustle, LLC v. Tropic Web, (*WIPO Case No. D2000-0624*); and Payoneer, Inc. / Payoneer Europe Limited v. Korchia Thibault, Quinv S.A. (*WIPO Case No. DEU2019-0013*).

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 will inevitably create a false association and affiliation with Complainant and its well-known trade mark **BARBIE AND BARBIECORE**

Therefore, in view of the submissions made in the complaint and on perusal of the accompanying documents and considering earlier

panel decisions , 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:

(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

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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.

The Complainant submits that the circumstance mentioned in clause (c) of the INDRP is indeed present in the instance case. The Respondent has registered the disputed domain name subsuming the Complainant's trademarks **BARBIE** and **BARBIECORE**, with the sole reason of attracting prospective customers to its website. By using the disputed domain name, the Respondent is attracting users to its website

to view product listings under the Complainant's trademarks **BARBIE** and **BARBIECORE** and other intellectual property in order to make commercial gains. Moreover, the product listings on the Respondent's website are unauthorised. Therefore, Respondent's use of the Complainant's trademark 'BARBIECORE' in the disputed domain name <barbiecore.in> is solely to ride on Complainant's reputation. The Respondent has *mala fidely* adopted the disputed domain name <barbiecore.in> which comprises of images and references from the recent movie of the Complainant which is the first ever live action **BARBIE** movie. The Respondent has *mala fidely* adopted the disputed domain name <barbiecore.in> from the viral fashion trend that has iconic **BARBIE** and **BARBIECORE** trade dress and brand visuals. That said, the Respondent has intentionally registered the disputed domain name in order to divert the audience to the disputed domain name and to make profit from it.

The Complainant relies on past decisions in *Bharti Airtel Limited vs. Rajeev Garg*, (*INDRP Case No. 285*), *Merck KGaA v. Zeng Wei* (*INDRP Case No. 323*), *General Motors India Pvt. Ltd. & Anr. v. Anish Sharma* (*INDRP Case No. 799*), and *Sensient Technologies Corporation v. Katrina Kaif*, *Corporate Domain* (*INDRP Case No. 207*), where

respondent's bad faith was found from intentionally attempting to attract for gain Internet users to the respondent's website or other online location by creating a likelihood of confusion with complainant's mark. The Respondent is also guilty of trademark infringement and passing off the Complainant's trademark **BARBIE**.

Further, clause 3(d) of the INDRP does not require a registrant to knowingly use the domain name in violation or abuse of any applicable laws or regulations. The obligations imposed by clause 3(d) are an integral part of the INDRP applicable to all registrants and cannot be ignored as was observed by the Ld. Arbitrator in *Momondo A/S v. Ijorghe Ghenrimopuzulu*, (INDRP Case No. 882). A search in the online database of Indian Trademarks Office or WIPO would reveal Complainant's rights in its trademarks **BARBIE** and/or **BARBIECORE**. Hence, the Respondent had an onus to ensure that the registration of disputed domain name did not violate the Complainant's trademark rights in **BARBIE** and **BARBIECORE**. It is therefore submitted that the disputed domain name has been registered and is being used in bad faith.

It is evident that from the material on record that the Respondent is using the identical combination with respect to the impugned domain name **<BARBIECORE.IN>**. There can be no other plausible explanation as to how the Respondent

arrived at the impugned domain name <BARBIECORE.IN> which incorporates the Complainant's mark **BARBIE** and **BARBIECORE** in toto.

The decision of prior Panel in *M/s Merck KGaA v Zeng Wei INDRP/323* can be referred wherein it was stated that:

"The choice of the domain name does not appear to be a mere coincidence, hut a deliberate use of a well-recognized mark... such registration of a domain name, based on awareness of a trademark is indicative of bad faith registration. "

The Respondent had no reason to adopt an identical name/mark with respect to the impugned domain name except to create a deliberate and false impression in the minds of consumers that the Respondent is somehow associated with or endorsed by the Complainant, with the sole intention to ride on the massive goodwill and reputation associated with the Complainant and to unjustly gain enrichment from the same.

The facts and contentions enumerated in the complaint establish that Respondent's domain name registration for <BARBIECORE.IN> is clearly contrary to the provisions of paragraph 4(c) of the INDRP POLICY and is in bad faith.

It is shown by the complainant that the Complainant is a well known reputed and global entity with extensive operations around the world since 1959 ,six decades prior to the registration of disputed domain in 2023,having registration of the mark **BARBIE** and **BARBIECORE** in all over the world with very high global reputation. 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 2023 is with the sole intention to trade upon and derive unlawful benefits from the goodwill accruing to the Complainant.

The Panel has no doubt that the choice of disputed domain registration by the registrant is not a mere coincidence as the registrant must have known about the complainant mark from the overwhelming and unprecedented use of the mark **BARBIE** and **BARBIECORE** over the globe and it leads to the conclusion that the registrant registered the said domain in bad faith which wholly contains the Complainant's prior globally acknowledged reputed trademark **BARBIE** and **BARBIECORE** to ride upon the goodwill of the complainant by attracting customers to the

Disputed Domain Name by creating confusion with the Complainant's trademark **BARBIE** and **BARBIECORE** and corresponding domain name. The panel finds such registration is definitely in bad faith.

In view of above facts, submissions of the Complainant and on perusal of the documents annexed with the Complaint and after considering the decisions of prior panels as well as reply of the Respondent, 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.

It is also pertinent to note the Respondent has shown its willingness to hand over disputed domain to the complainant vide its reply dated 5.12.23.

7. In view of the foregoing, I hold that the Disputed Domain Name is identical and or confusingly similar to the

Complainant's well-known **BARBIE** and **BARBIECORE'** 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.

In view of above discussion, the Complainant is entitled to transfer of the registration of disputed domain in its favour.

However as the complainant and the Respondent has entered in to a written settlement Agreement signed by Mr.Sourabh Nandrekar on behalf of the Complainant and by the Ria Sardana (Respondent herein) whereby the Respondent has agreed to transfer the disputed domain to the complainant. Accordingly on the basis of this settlement also the Complainant is entitled to transfer of the registration of disputed domain in its favour. The Copy of settlement agreement received through email is annexed herewith as **Annexure -A** and this settlement shall form part of the award in terms of Rule 21 of INDRP Rules of Procedure.

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DECISION

In view of above I direct that the Disputed Domain Name registration be transferred to the Complainant in accordance with the INDRP Policy and Rules. the Settlement Agreement Annexure A is made part of this award as per Rule 21 of IINDRP Rules of procedure.

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Dated 26.12.2023

Sole Arbitrator

Enclosed: Annexure A-Settlement Agreement

Settlement Form
INDRP Case Nos. 1780

This Standard Settlement Form is submitted by the Parties pursuant to paragraph 21 of the INDRP Rules Of Procedure (the "Rules") as approved by the Arbitration & Conciliation Act, 1996 amended as per the Arbitration and Conciliation (Amendment) Act, 2019 (as amended upto date) read with the Arbitration & Conciliation Rules.

The National Internet Exchange of India (the "NIXI") will not disclose the completed Standard Settlement Form to any third-party.

The Parties have reached an agreement regarding the following disputed domain name:

1. <barbiecore.in>

Pursuant to such agreement, the Parties request the Registrar to take the following action:

The disputed domain names should be transferred from the Respondent's control to the Complainant No.1 i.e., Mattel, Inc.

In accordance with paragraph 21 of the Rules, unless stipulated below, the Parties' settlement agreement is with prejudice.


/s/

Saurabh Nandrekar
For Complainants


/s/

For Respondent

Date: 05th December 2023

Date: 12/12/2023