

ఆంధ్రప్రదేశ్ ఆంధ్ర ప్రదేశ్ ANDHRA PRADESH

Sl. No. 7731 Dt. 21/11/14  
Sold to Harini Narayan Swamy  
S/o, No. W/o B. Narayan Swamy R/o Hyd  
To Whom Self

K. Geetha Rani  
BH 322733

KODALI GEETHA RANI  
Licenced Stamp Vendor  
Licence No 16-04-1/2013  
# 8-3-191/132 167/C. Behind E-Seva  
Vengal Rao Nagar, Hyderabad (South)  
Cell 94920 25252

BEFORE THE NATIONAL INTERNET EXCHANGE OF INDIA

ARBITRATION AWARD

In The Matter Between

Living Proof Inc.  
301 Binney Street  
Cambridge MA 02142  
United States of America

COMPLAINANT

Versus.

Wan Delai  
Wan delai  
Laifu shanzhuang, Guangzhou  
Guangzhou, Shanghai 510000  
China

RESPONDENT

Harini Narayan Swamy

### **1. The Parties**

The Complainant is Living Proof Inc. of Cambridge MA United States of America, represented in these proceedings by SILKA Law AB, 11456 Stockholm, Sweden. The Respondent is Wan Delai of Guangzhou, P.R. China self represented in these proceedings.

### **2. The Domain name, Registrar and Policy**

The present Arbitration proceeding pertains to a dispute regarding the domain name <livingproof.co.in> (hereinafter referred to as disputed domain name). The registrar for the disputed domain name is Endurance Domains Technology Pvt. Ltd. The Arbitration proceeding is conducted in accordance with the Arbitration and Conciliation Act of 1996 (India), the .IN Domain Name Dispute Resolution Policy (the "INDRP Policy" or "Policy"), and the INDRP Rules of Procedure (the "Rules").

### **3. Procedural History**

The sole arbitrator appointed in the case is Mrs. Harini Narayanswamy. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, in compliance with the Rules. The Arbitrator received the Complaint from the .IN Registry on January 8, 2018 and on January 10, 2018 communicated by email, a notification of commencement of the arbitration proceedings to the Respondent. Under the INDRP Rules, copies of the said notification were sent to other interested parties to the dispute. The Respondent was given three weeks from the date of the notification to file a response. The Respondent submitted the Response by email on January 24, 2018. The Complainant sent a reply to the Response by email on January 29, 2018. The Arbitrator informed the Respondent of the Complainant's reply and invited the Respondent to send any further response within a week from the date of the email. The Arbitrator further provided both parties an opportunity to make any further submissions,

*Harini Narayanswamy*

if they so wished, before February 7, 2018. The parties did not make any further submissions in the proceedings.

### **Factual Background**

The Complainant is in the business of hairstyling services and related products, and uses the trademark LIVING PROOF in connection with its business. The Complainant owns trademark registrations in several jurisdictions including the International trademark registration for the word LIVING PROOF with registration number 967762 registered on June 24, 2008.

The Respondent registered the disputed domain name on February 21, 2013. The webpage that the disputed domain name resolves to the registrar parking page and has links related to hair care products. There is a message on the top of the webpage stating "Livingproof.co.in May Be For Sale", and another related message that reads "The owner of Livingproof.co.in has chosen to receive offer inquiries regarding this domain name."

### **The Parties Contentions**

#### **A. Complainant's Submissions**

The Complainant states that it has twenty patents for over forty products and has received more than one hundred awards for its hair styling products. The Complainant states it has won over 130 awards from Marie Claire, Allure, SELF, Dr. Oz Show, Essence, People Style Watch, O the Opera Magazine, Ladies Home Journal, WWD and more. In 2012, the Complainant states, actor Jennifer Aniston was signed as an investor and spokesperson by the Complainant "in an attempt to make waves" in the hair care industry.

The Complainant states it is visible in several social media channels such as Facebook, Youtube, Pintrest, Twitter and Google +. The Complainant alleges it owns several

*Haris Narayana*



domain names with the LIVING PROOF mark and communicates on the Internet from the websites linked to its domain names, such as the domain name <livingproof.com>.

The Complainant states it has numerous trademark registrations for the LIVING PROOF mark, including International trademark registration for the word LIVING PROOF bearing registration number 967762, registered on June 24, 2008. The said International trademark registration is designated to China, where the Respondent resides. The Complainant states the disputed domain name, entirely incorporates its well known trademark with the country code top level domain (ccTLD) “.co.in”, and is identical or confusingly similar to the mark in which it has rights. The Complainant argues that the disputed domain name being confusingly similar to its mark, could be perceived by Internet users as an online location to find information about the Complainant’s products.

The Complainant contends the Respondent has no rights or legitimate interests in disputed domain name. As the Whois information shows the registrant’s name as Wan Delai, the Complainant states the Respondent is not commonly known by the disputed domain name. The Complainant adds that the Respondent is not running a website or a business from the disputed domain name and has no *bona fide* or legitimate interests in the disputed domain name. The Complainant claims a search prior to registering the disputed domain name would have revealed the Complainant’s rights in the mark. The Complainant states that the term LIVING PROOF has become a distinct identifier associated with its business and its products, and the disputed domain name has been registered to take advantage of its business.

The Complainant states that the disputed domain name points to a parking page provided by the registrar with links related to haircare, some of which directly reference the Complainant and other links point to its competitors such as Wella. The Complainant further states that a link on top of the website states: “*This domain might be for sale*”. The Complainant argues that the use of a parked page with links that are related to LIVING PROOF brand is likely to cause confusion to the public. Such a page, the Complainant states, raises a presumption that the Respondent is receiving pay-per click revenue from

*Hanin Narayanan*

the links. The Complainant argues that the Respondent had ample time to activate a website but has not done so although the disputed domain name was registered in 2013.

The Complainant states the pay-per-click landing page linked with the disputed domain name is likely to receive redirected Internet traffic meant for the trademark owner and such use does not provide a legitimate interest in the disputed domain name. The Complainant argues that the Respondent could disable the links, instead of attracting Internet users for commercial gain, misleading consumers and thereby trying to tarnishing the Complainant's trademark.

The Complainant states the Respondent is not authorized or licensed to use its mark, therefore the use of the mark by the Respondent without its permission violates its rights. The Complainant states the disputed domain name has been put up for sale by the Respondent, and has filed evidence of the sale advertisement for the disputed domain name.

The Complainant states the disputed domain name was registered in bad faith and is being used in bad faith. The Complainant emphasizes that its mark predates the registration of the disputed domain name that currently resolves to a parking page. The Complainant further asserts that the Respondent has registered several other domain names containing well known trademarks which shows a pattern of cybersquatting behavior. The Complainant states that the disputed domain name resolves to an inactive website, and argues that the Respondent's lack of use of the disputed domain name shows bad faith, as passive holding of a domain name containing a well-known mark, by a party unconnected to the mark, even after five years of its creation would be considered among the cumulative circumstances that constitutes bad faith registration and use.

The Complainant states the Respondent ought to have known of the Complainant's rights in the LIVING PROOF trademark and argues that the disputed domain name ought to have been registered for causing confusion among Internet users. The Complainant requests for the transfer of the disputed domain name.

*Havini Narayanan*

## **B. Respondent's Submissions**

The Respondent argues that the Complainant lacks enforceable rights in the LIVING PROOF mark in India, and therefore the disputed domain name is not identical or confusingly similar to a mark in which the Complainant alleges rights. The Respondent states that the Complainant's trademark status in India, are shown as "opposed" and argues that prior to the registration of the disputed domain name, the Complainant did not have any "civil rights in India". The Respondent alleges that the Complainant's services were not that well known in India when the disputed domain name was registered.

The Respondent further argues that the Complainant has used its present Google search results to prove its reputation five years ago, and not when the disputed domain name was registered in 2013. The Respondent also argues that Complainant has failed to provide any evidence that it had set up a presence or office in India or that it had advertised its services in India prior to the registration of the disputed domain name. The Respondent adds that although the Complainant is not required to show trademark rights in India under the INDRP Policy, and it is sufficient to show trademark registration in another country, the Complainant must however show evidence that it has some reputation in India.

The Respondent argues that the words "living proof" are not exclusive to the Complainant, as other people have registered trademarks with the same words. The Respondent has provided evidence of other trademark registrations for LIVING PROOF, and argues that other trademark owners and the Respondent can register the domain name reflecting the word "living proof", due to the Complainant's alleged lack of rights in the words "living proof".

The Respondent states that the words "living proof" is commonly used, and adds that it is a combination created by the Respondent and therefore has rights and legitimate interests in the disputed domain name. The Respondent further argues that the Complainant is not

*Hari Narayanan*

the exclusive trademark holder for the LIVING PROOF mark, as other also have the same mark, and therefore argues that the Complainant cannot claim monopoly on the words.

The Respondent argues that the registration principle of domain names is “first register, first serve”, and on the basis of being the first to register the disputed domain name, the Respondent claims rights in the disputed domain name. The Respondent additionally states that the Complainant’s trademark is not well known and that nothing prevented the Complainant from registering the disputed domain name prior to the Respondent.

The Respondent argues that as the Complainant or other trademark holders did not register the disputed domain name, they have therefore given up their rights to register the disputed domain name. The Respondent further adds that the Complainant had the option to register the disputed domain name at the time it registered the domain name <livingproof.com>. However, as the Complainant is an American company, with services in USA and not in India, the Complainant did not opt to register the disputed domain name. The Respondent states that the Complainant not having registered the disputed domain name indicates their given up the right to do so. The Respondent then argues that if the Complainant wants the disputed domain name, they should buy it “instead of using this reverse plunder”. The Respondent adds that if the disputed domain name is awarded to the Complainant, it is unfair to the Respondent and other trademark owners.

The Respondent denies that the disputed domain name was registered or used in bad faith. The Respondent alleges not being aware of the Complainant prior to registration of the disputed domain name. The Respondent states there is no intention to sell the disputed domain name and has parked the disputed domain name with a view to earn some “meager income”. The Respondent states that as the content is generated by the parking merchant, the Respondent does not have any control over the content, and argues that merely parking the disputed domain name, where the content is generated by parking service provider, does not satisfy bad faith as stipulated under the Policy. The Respondent further states that the Complainant could have requested the Respondent to

Havir Narayn



cancel the parking or asked for change of content, instead of requesting transfer of the disputed domain name.

Alluding to the other domain names owned by the Respondent, the Respondent states that those domain names have nothing to do with the present case, and that registration of domain names is a legitimate activity undertaken for investment, if trademarks are not infringed. The Respondent poses a rhetorical question, whether Google being the owner of several domain names, could be accused of cybersquatting. The Respondent concludes by stating that the Complainant is "suspected" of reverse domain name hijacking for the reasons that: (i) the Complainant's trademark rights are not strong (ii) the disputed domain name is registered based on a word combination, therefore the Respondent and other trademark holders have rights (iii) the Complainant is relying on its prior registration of the domain name <livingproof.com>, when the LIVING PROOF mark was not well known.

#### **The Complainant's Supplemental submissions**

The Complainant sent a reply to the Respondent's response by email on January 29, 2018. The Complainant states that the Respondent is only referring to India, and it is not necessary to have a trademark registration or an office in India for showing rights in the mark. The Complainant argues that the Respondent is Chinese, and the Complainant has shown its international registered rights in the mark including China. The Complainant adds that its international trademark was registered five prior to the registration of the disputed domain name.

The Complainant argues that even if the words "living proof" are used in different categories, the websites to which the domain names resolve displays pay-per-click links related to the Complainant's trademark and its competitor's hair care products. The Complainant reiterates that the links and content are controlled by the Respondent, and the links are intentionally placed for diverting traffic to the Respondent based on the Complainant's mark.

*Haini Narayana*



## **Discussion and Findings**

Under the INDRP Policy the Complainant has to establish the following three elements to succeed in the proceedings:

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

### **Identical or Confusingly Similar**

The first element requires the Complainant to prove that the disputed domain name is identical or confusingly similar to a mark in which the Complainant has rights.

The Respondent has argued that the Complainant's trademark applications in India are pending and with the status shown as "opposed". The Respondent has also argued that the Complainant did not show a presence in India or evidence of its promotion of the trademark in India to prove its rights. The crux of the Respondent's argument is that the Complainant lacks enforceable rights in India at the time of registration of the disputed domain name.

Under the the INDRP Policy, as correctly mentioned by the Respondent, it is sufficient for a complainant to show rights in a trademark in another jurisdiction. The location of the trademark, its date of registration or first use are irrelevant for purposes of finding rights in a trademark under the first element of the Policy. These factors may have significance when determining the second and third elements, depending on the facts and circumstances of the case. It is sufficient that a Complainant shows rights in the

*Haim Naragun*

trademark and this meets the threshold requirements under the first element of the Policy. Furthermore, the status of a pending trademark application shown as “opposed”, does not signify that the Complainant lacks rights, it only signifies that the application is pending and the registration process is still incomplete. However, as discussed in the next paragraph, the Complainant’s prior rights in the mark, although in other jurisdictions, is sufficient to establish its rights in the mark. For these reasons, it is found that the Respondent has not been able to successfully put forward a case that the Complainant lacks rights in the LIVING PROOF trademark.

The Arbitrator finds from the evidence, that the Complainant has adopted and used the LIVING PROOF mark in relation to its business prior to the registration of the disputed domain name. The evidence of trademark registrations filed by the Complainant establish its ownership and use of the LIVING PROOF mark and shows the Complainant’s prior adoption and use of the mark in commerce in several jurisdictions world-wide. The Arbitrator finds, based on the evidence on record, that the Complainant has established its rights in the LIVING PROOF trademark.

The disputed domain name incorporates the Complainant’s mark in its entirety and it is accordingly found to be identical to the mark except for the country code top level domain (ccTLD).

It is well established that if the disputed domain name contains the entire trademark, it is found that confusing similarity is established as required under the INDRP Policy, See for instance *Oracle International Corporation v. Ritesh Galam*, INDRP 883 (<peoplesoft.in>) June 21, 2017, and *Kimberley Clark Worldwide Inc. v. Lin Yanxiao*, (<huggies.in>), INDRP Case No. 823, November 29, 2016 (where it was held that if the disputed domain name bears the complainant’s registered trademark in its entirety, and is its essential and memorable feature, consumers are likely to associate the mark and the disputed domain name with the complainant) .The Arbitrator accordingly finds that the disputed domain name in the present case, is identical or confusingly similar to the Complainant’s LIVING PROOF trademark.

*Havin Narayana*

The Complainant is found to have successfully established the first requirement under paragraph 4 of the Policy.

### **Rights and Legitimate Interests**

The second element requires the Complainant to put forward a *prima facie* case that the Respondent lacks rights and legitimate interests in the disputed domain name. The burden of proving rights and legitimate interest is on the Respondent. If the Respondent fails to come forward with relevant evidence to prove rights and legitimate interest in the disputed domain name, the Complainant prevails.

The Complainant has argued that the Respondent has no rights or legitimate interests in the disputed domain name, as the Respondent is not known by the disputed domain name, has no business by the name or any authorization to use its mark or any other rights and interests connected with the term "living proof". The Respondent has not rebutted these allegations made by the Complainant.

The INDRP Policy states that the Respondent can demonstrate legitimate interests in the disputed domain name if there are circumstances that show (i) that before notice of the dispute, the respondent had used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services or (ii) the respondent (as an individual, business organization) has been commonly known by the domain name, or (iii) The respondent is making legitimate, non-commercial or fair use of the domain name without intent for commercial gain. The Arbitrator finds there is no evidence on record to show any preparations are made by the Respondent to use the disputed domain name in connection with a *bona fide* offering of goods or services or that the Respondent has been commonly known by the disputed domain name or makes any legitimate non-commercial fair use of the disputed domain name or any other evidence to show rights.

*Havini Navagunna*



The Respondent's arguments that the words "living proof" are generic or that the Respondent was the first to adopt that word combination, does not help the Respondent's case. Clearly, the evidence shows the Complainant is the prior adopter of the combination of words "living proof". The Complainant has also established that its adopted mark is being used in commerce, and has shown that the words have acquired secondary meaning as the Complainant's mark. Further, it is argued by the Respondent that others have also adopted the same combination of words for their trademarks. This argument also does not help the Respondent's case, as others who may have adopted the same combination of words for their trademarks is not germane to the issue in the present case. The fact that others have adopted or used the same word combination for their trademark does not show any rights in favor of the Respondent. Furthermore, in order to prove or establish rights in the disputed domain name, the Respondent has not shown any evidence that it has used the combination of words in connection with a *bona fide* offering of goods or services in commerce and thereby obtained rights in the word combination. The Arbitrator also finds that the Respondent's submission that investing in domain names is legitimate activity, provided someone else's trademark is not violated by such registration. On balance, based on the evidence before the Arbitrator, the Complainant has shown its prior rights in the mark LIVING PROOF, and the Respondent's merely parking the disputed domain name and offering no plausible reason for registering a domain name that is the trademark of another, as rightly pointed out by the Respondent, is not a basis of legitimate rights or interests.

The Arbitrator finds, on the basis of the discussions, that the Complainant's unrebutted submissions prevail. Accordingly, it is found that the Complainant has made a *prima facie* case that the Respondent lacks rights and legitimate interests in the disputed domain name and has established the second requirement under paragraph 4 of the Policy.

### **Bad Faith**

The third element of Policy requires the Complainant to establish the disputed domain name was registered in bad faith or is being used in bad faith.

*Kavita Narayana*

The Complainant has provided evidence that the disputed domain name has been registered and is being used in bad faith. Such evidence includes the Respondent's advertising the disputed domain name for sale. The Complainant has also provided evidence that the Respondent has registered other domain names containing trademarks of other third parties, which is indicative of a pattern of behavior widely considered bad faith under the Policy.

The lack of use of the disputed domain name, incorporating the Complainant's well known mark is also indicative of bad faith, as rightly argued by the Complainant, it is evidence of passive holding of a domain name containing a well-known mark by a party unconnected to the mark. Under the circumstances discussed, further inference of bad faith can be drawn from the fact that there is the Respondent's intention to sell or transfer the disputed domain name to the Complainant for financial gain, which is recognized as bad faith under the Policy.

It is quite clear from the evidence, that the Complainant has shown its prior adoption and the use of the LIVING PROOF mark in commerce much prior to the registration of the disputed domain name. The Respondent has registered a domain name that is virtually identical or confusingly similar to the Complainant's mark. The Respondent has not shown use the disputed domain name in connection with a *bona fide* offering of goods or services, or established any rights or legitimate interests in the disputed domain name. Registration of a domain name incorporating a known mark is an indication of the Respondent's intention to ride upon the goodwill and reputation attached to the mark. See *Robert Bosch GMBH v. Zhao Ke*, INDRP Case No. 894 (<bosch.in>), August 10, 2017. (Where it was found that, as the respondent has not established rights or legitimate interests in the domain name, adverse inference can be drawn about the respondent's adoption of the domain name that corresponds to a mark, and consequently establishes the respondent's bad faith).

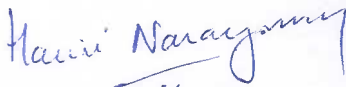
*Hanvi Narayana*

The Arbitrator finds from the entire circumstances and facts in the present case that there is lack of evidence of any actual good faith use of the disputed domain name by the Respondent. On balance, the Arbitrator finds the circumstances and the evidence on record indicates there is no reason to register the disputed domain name except to gain from the association with the Complainant's mark. It is reasonable to infer, under the circumstances discussed, that the Respondent has deliberately registered the disputed domain name using the Complainant's trademark with the intention to exploit it.

Based on the material on record, and the discussed facts and circumstances, the Arbitrator finds the Complainant has established that the disputed domain name has been registered and is being used in bad faith. Accordingly, it is found that all three elements required under paragraph 4 of the Policy has been satisfied by the Complainant for the transfer of the disputed domain name.

#### **Decision**

In light of all that has been discussed, it is ordered that the disputed domain name <livingproof.co.in> be transferred to the Complainant.



**Harini Narayanswamy**

**(Arbitrator)**

**Date: March 5, 2018**