



INDIA NON JUDICIAL

Government of National Capital Territory of Delhi

e-Stamp

सत्यमेव जयते

Certificate No.

Certificate Issued Date

Account Reference

Unique Doc. Reference

Purchased by

Description of Document

Property Description

Consideration Price (Rs.)

First Party

Second Party

Stamp Duty Paid By

Stamp Duty Amount(Rs.)

: IN-DL99336102886017S
 : 28-Oct-2020 05:12 PM
 : IMPACC (IV)/ dI916803/ DELHI/ DL-DLH
 : SUBIN-DL91680305106534454074S
 : LUCY RANA
 : Article Others
 : Not Applicable
 : 0
 : (Zero)
 : LUCY RANA
 : Not Applicable
 : LUCY RANA
 : 100
 : (One Hundred only)



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BEFORE THE SOLE ARBITRATOR UNDER .IN DISPUTE RESOLUTION POLICY
(Appointed by .IN Registry- National Internet Exchange of India)

ARBITRATION AWARD

Disputed Domain Name: <INSTANTDOMAIN.IN>

IN THE MATTER OF

Instant Domain Search. Inc.
10796 Madrona Drive,
North Saanich,
BC V8L 5M5 Canada

...Complainant

-----versus-----

THRIVE TRAVEL SERVICES LTD.

6 Hardrada Way, York,
Yorkshire YO41 1LT
United Kingdom

...Respondent

Statutory Alert:

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2. The onus of checking the legitimacy is on the users of the certificate.
3. In case of any discrepancy please inform the Competent Authority.

Arana

1. The Parties

The **Complainant** in this arbitration proceeding is **Instant Domain Search, Inc.**, of the address 10796 Madrona Drive, North Saanich, BC V8L 5M7, Canada, which is a Canadian company that provides online domain name services, founded by Beau Hartshorne in 2003.

The **Respondent** in this arbitration proceeding is “**Thrive Travel Services, Ltd.**”, as per the WHOIS records submitted by the Complainant. The Complainant has submitted that **Thrive Travel Services Ltd** is a company registered in the United Kingdom, of which one “Mr. Mark Richard Cambridge” is the owner/ person with significant control. Complainant has further submitted that the disputed domain name redirects to <**businessnamegenerator.com**>, which upon information and belief is owned by the aforesaid Mr. Cambridge, thereby showing the connection between **Mr. Cambridge** and the disputed domain name.

The Domain Name, Registrar and Registrant

The present arbitration proceeding pertains to a dispute concerning the registration of domain name <**INSTANTDOMAIN.IN**> with the .IN Registry. The Registrant in the present matter is “**Thrive Travel Services, Ltd.**”, and the Registrar is **GoDaddy, LLC**.

2. Procedural History

The arbitration proceeding is in accordance with the .IN Domain Name Dispute Resolution Policy (INDRP), adopted by the National Internet Exchange of India (NIXI).

NIXI vide its email dated September 04, 2020, had sought consent of Mrs. Lucy Rana to act as the Sole Arbitrator in the matter. The Arbitrator informed of her availability and gave her consent vide Statement of Acceptance and Declaration of Impartiality and Independence in compliance with the INDRP Rules of Procedure vide email on the same day, i.e. September 04, 2020. Thereafter the Arbitrator received soft copies of the Domain Complaint and the annexures thereto on September 09, 2020. The Arbitrator confirmed receipt of the same via email dated on the same day, i.e. September 09, 2020, and also asked the Complainant's Representative to provide authorisation documents/ proof of authorisation (showing that they are authorised to represent the Complainant and sign the complaint on their behalf) on or before September 16, 2020. The Complainant then provided the said authorisation document (a signed Declaration from Beau Hartshorne, founder and owner of **Instant Domain Search, Inc.**) via email on the same day, i.e. September 09, 2020. The Arbitrator then confirmed receipt of the said authorisation document via email addressed to NIXI on September 10, 2020, and also requested NIXI to confirm whether the soft copy of the Complaint (along with annexures) has been served upon the Respondent, which NIXI shortly thereafter confirmed via email on the same day, i.e. September 10, 2020.

Thereafter, the Arbitrator, vide email dated September 10, 2020, announced that the Complaint along with Annexures had been duly served upon the Respondent, vide email. The Respondent was deemed to have been duly served with the Complaint and Annexures thereto and was granted a period of **fourteen (14) days** from the date of receipt of the email dated September 10, 2020, within which to file a response to the Complaint and forward copies of the same to the Complainant, the Arbitrator and the .IN Registry, failing which, the matter will be decided on the basis of material already available on record and on the basis of applicable law. The arbitration proceedings were therefore deemed to have commenced from September 10, 2020.

On September 24, 2020, the Arbitrator, vide email addressed to the Respondent, brought it on record that despite the prescribed deadline for the Respondent to respond in the matter having elapsed on September 24, 2020, in the interests of justice the Respondent was being granted an additional but final and non-extendable period of **seven (7) days** within which to submit a response (if any) in the matter.

As no response to the Complaint was preferred by the Respondent in the matter even after expiration of the additional time period, the Arbitrator, vide email dated October 09, 2020, reserved the award to be passed on the basis of facts and documents available on the record.

3. Factual Background and Complainant's Contentions

Complainant has submitted that it was founded by Mr. Beau Hartshorne in 2003, and that Mr. Hartshorne registered the accompanying domain name <**instantdomainsearch.com**> on October 17, 2005. In this regard, the Complainant's founder Mr. Hartshorne has reiterated the same vide his Affidavit dated July 29, 2020, which has been annexed as **Annex 6**, with the Complaint. Although I must note that the Complainant has not annexed a copy of the WHOIS records for the said domain name.

The Complainant has submitted that it is the owner of the Canadian registered trademark No. TMA1005883 for the mark **INSTANT DOMAIN SEARCH** in Nice Class 35 (for selling domain names) and in Class 45 (in respect of: *domain name registration; leasing of internet domain names; and registration of domain names for identification of users on a global computer network*). In this regard, the Complainant has annexed what prima facie appears to be an excerpt from the Canadian Trade Mark Database, inter alia showing the details of the aforesaid trade mark registration, as **Annex 7**. The above factual submissions have also been reiterated in the Affidavit marked as **Annex 6**, wherein it has been further stated that while the trade mark was filed on April 20, 2017, the first-use date mentioned therein is October 17, 2005.

Complainant has further submitted that since its launch in the year 2005, it has established a successful business having acquired an impeccable reputation of offering high-quality services, and that it has been receiving media attention since November 2005, and has since received extensive media coverage. In this regard, the Complainant has annexed a copy of an article from the technological review website, 'Tech Crunch' dated November 13, 2005, as **Annex 10**.

Complainant has also submitted that they have spent a considerable amount of time, effort and resources for developing the **INSTANT DOMAIN SEARCH** mark and website over the past 15 years, which has led to numerous mentions and recommendations in various publications. In this regard, the Complainant has annexed copies of excerpts from various online sources/websites, as **Annex 11**.

The Complainant, vide its Affidavit annexed as **Annex 6**, has further submitted that it has been using the name/mark **INSTANT DOMAIN SEARCH** and the domain name **<InstantDomainSearch.com>** since 2005 as a source identifier for online domain services offered by it. Complainant has further submitted that they started using the insignia “®” next to its trade mark **INSTANT DOMAIN SEARCH** since 2017, to further put others to notice of the Complainant's trade mark rights. Complainant has further submitted that the mark **INSTANT DOMAIN SEARCH** has been prominently displayed at all times on the Complainant's domain name **<InstantDomainSearch.com>** since 2005.

Complainant has also submitted that their efforts has led to a steady increase in traffic and that since 2014, the number of users of Instant Domain Search's search-service passed 1 million. In this regard, the Complainant has annexed usage, revenue and web-analytics data for Instant Domain Search for the years 2014-2020, as **Annex 12**, which inter alia show that till 2020, the Complainant has earned a total revenue of over USD 3.5 million, and over 8 million visitors.

Complainant has submitted that the Respondent registered the disputed domain name in October 2018 with full knowledge of the Complainant and its rights in the **INSTANT DOMAIN SEARCH** mark, and that Respondent has directed the disputed domain name to a website at **<businessnamegenerator.com>**, which is a similar and competing business to the Complainant. In this regard, the Complainant has annexed screenshots from its website **<instantdomainsearch.com>** and from the re-directed website **<businessnamegenerator.com>**, as **Annex 8**. In furtherance thereto, Complainant has submitted that the Respondent has created confusion with Instant Domain Search users, and are profiting off of such confusion by siphoning off Instant Domain Search users and customers.

Complainant has submitted that it had earlier filed a similar UDRP case against the same Respondent on March 20, 2020 with the National Arbitration Forum (vide claim number FA2003001889089), with respect to the domain names **<instantdomains.com>** and **<instantdomain.com>**, wherein the Panel had found that all three elements of the UDRP had been established and had issued a decision in favor of the Complainant. In this regard, the Complainant has annexed a copy of the said Award as **Annex 9**. Complainant has submitted that it was unaware about the disputed domain name herein at the time of filing the UDRP case with respect to the domain names **<instantdomains.com>** and **<instantdomain.com>**, and that upon information and belief, Respondent only began directing the Disputed Domain to the competing business website after losing the domain names in the aforesaid UDRP proceedings.

Regarding the above case under claim number FA2003001889089, and as background for this present case, the Complaint vide its affidavit (Annex 6) has submitted that two years prior to the aforesaid UDRP proceedings, the Respondent had reached out to Mr. Beau Hartshorne on

June 04, 2018, inter alia asking Mr. Hartshorne whether he would be willing to sell the domain name <**InstantDomainSearch.com**> (the Complainant's website) to him (copy of the email dated June 04, 2018 from the Respondent has been annexed as Annex 13 to the domain complaint), to which Mr. Hartshorne had replied via email on the same date and informed that the domain name is not for sale. Complainant has further submitted that a few months after the above correspondence, the Respondent (Mr. Cambridge) had begun purchasing confusingly similar domain names to Instant Domain Search and begun redirecting the said domain names to competing business websites. The Complainant has also submitted that the Respondent, Mark Cambridge, is in fact the owner of a competing brand Domainify.com.

Complainant has further submitted (in the affidavit) that the redirection of the disputed domain name to a competing website/company confuses or outright tricks internet users into believing that the same is associated or connected with Instant Domain Search, and that the Respondent is not authorized to use the mark INSTANT DOMAIN SEARCH. Complainant has further submitted that the Respondent is also using the mark "Instant Domain Search" in their "title tags", for the purpose of displaying Google search results, and that because of the same, whenever an internet user searches for "Instant Domain Search" on Google, the Disputed Domain Names appear directly beneath the Complainant's results. Complainant has submitted that the Respondent started directing the Disputed Domain Name to a competing businesses' website immediately after the NAF's decision, wherein it was held that the Respondent was cybersquatting. Complainant has further submitted that the Respondent is clearly simply continuing to try and profit off of Instant Domain Search's reputation and goodwill, undeterred by the NAF Panel's ruling in the First UDRP Proceeding.

4. Legal Grounds Submitted by the Complainant

The Complainant has submitted the following legal grounds in support of its complaint:

A. The domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

The Complainant has submitted that by virtue of its Canadian Trade Mark Registration No. TMA1005883 for the mark **INSTANT DOMAIN SEARCH** in classes 35 and 45 (of the Nice Classification) and extensive use of the said mark since 2005, it is the exclusive owner of the mark **INSTANT DOMAIN SEARCH**. Complainant has further relied upon the earlier UDRP case against the same Respondent before the Forum (in claim number FA2003001889089) to submit that *"The omission of the word "SEARCH" from Complainant's mark and the addition of the letter "s" and the inconsequential gTLD do not sufficiently distinguish the domain names for the purposes of Policy"*, as was held by the Panel. Complainant has also submitted that the absence of the word "SEARCH" does not render the domain name functionally distinct from Complainant's mark, and in this regard, relied upon the case of *Amerimark Direct, LLC and its affiliate Dr. Leonard's Healthcare Corp. v. Carolina Rodrigues, FA1605001675674*.

In view of the above, Complainant has contended that the disputed domain name <**INSTANTDOMAIN.IN**> is confusingly similar to Complainant's **INSTANT DOMAIN SEARCH** mark.

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

The Complainant has contended that the Respondent was aware of the Complainant's **INSTANT DOMAIN SEARCH** mark and business prior to registering the Disputed Domain, and that the Complainant's common law rights date back to nearly 13 years before the Respondent registered the Disputed Domain Name. Complainant has further contended that it has been using the **INSTANT DOMAIN SEARCH** mark and the domain name <**InstantDomainSearch.com**> exclusively and extensively in commerce since 2005 as a source identifier for the online domain services offered by them. Based on the evidence submitted by the Complainant (excerpts from media websites, website traffic data, etc.), the Complainant has contended that the **INSTANT DOMAIN SEARCH** mark is widely associated with Complainant in its niche market of domain search and affiliate referral services, and the fact that Respondent is a competitor targeting Complainant's mark supports Complainant's assertion that the **INSTANT DOMAIN SEARCH** mark has achieved significance as a source identifier.

Complainant has relied on the cases of *LeSportsac, Inc. v. K Mart Corp.*, 754 F.2d 71, 78 (2d Cir.1985); *RJR Foods, Inc. v. White Rock Corp.*, 603 F.2d 1058, 1060 (2d Cir.1979); cf. *Perfect Fit Industries, Inc. v. Acme Quilting Co.*, 618 F.2d 950, 954 (2d Cir.1980), to contend that the copying of a trademark by a competitor may serve as persuasive, if not conclusive, proof of the mark's acquired distinctiveness.

Complainant has further contended that a few months prior to Respondent's registration of the Disputed Domain, the Respondent had approached the Complainant to enquire about the possible purchase of the Complainant's domain name <**instantdomainsearch.com**>, which was declined by the Complainant. Complainant has also contended that the Respondent has used the Disputed Domain to target and confuse Complainant's customers by redirecting to <**businessnamegenerator.com**>, a similar and competing business to Instant Domain Search. Further, use of the mark "**Instant Domain Search**" in the disputed domain name's "title tags", i.e. when a user searches for **Instant Domain Search** on Google, the Disputed Domain Name/website appears directly beneath the search results for the Complainant. Complainant has contended that the Respondent's registration and use of the Disputed Domain is an obvious attempt to damage a competitor and steal its business, by redirecting to a similar and competing domain name services business, and that such usage of the disputed domain name is neither a bona fide offering of goods or services under the Policy. In this regard, the Complainant has relied upon the case of *Bank of Am. Corp. v. Nw. Free Cmty. Access*, FA 180704.

Complainant has further contended that the Respondent acquired the Disputed Domain with full knowledge and awareness of Complainant's trademark and domain name, and well after

Complainant had registered and established common law rights in the **INSTANT DOMAIN SEARCH** mark, which is further evidence of Respondent's lack of legitimate interests in the Disputed Domain Name. In this regard, the Complainant has cited the case of *Dr. Paul Guerrino v. Yin Chew*, FA 110873.

Complainant has also contended that the Respondent is not commonly known by any of the Disputed Domain, and has not also been authorised by the Complainant to use the trade mark (reliance placed on *Charles Jourdan Holding AG v. AAI*, Case No. D2000-0403). In this regard, the Complainant has quoted an excerpt from its earlier UDRP proceeding against the same Respondent, wherein the NAF Panel had stated that *"There is no suggestion that Respondent is commonly known by either of the domain names. The Panel notes that Respondent sought to purchase Complainant's <instantdomainsearch.com> domain name some 4 months before registering the disputed domain names. The Panel is satisfied that Respondent was well aware of Complainant's mark when registering the domain names and has used them in order to trade off Complainant's reputation in its mark. Such use is not a bona fide offering of goods or services nor a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue."*

Complainant has also quoted the earlier UDRP Panel's below finding regarding the factum of redirection of disputed domain name to a completing business website:

"The mere fact that a disputed domain name redirects to a third-party website does not mean that it cannot disrupt a complainant's business. A domain name registrant is responsible for the content of any website to which the domain name resolves. See WIPO Jurisprudential Overview 3.0, paragraph 3.5: "...a respondent cannot disclaim responsibility for content appearing on the website associated with its domain name...")."

In view of the above submissions, Complainant has contended that the Respondent lacks any right or legitimate interest in the Disputed Domain Name.

C. The Registrant's Domain Name has been registered or is being used in bad faith

The Complainant has inter alia contended that as the Respondent has failed to show rights or legitimate interests in the disputed domain name, bad faith can therefore be inferred, and in this regard, has cited the UDRP case of *Imerys v. Unknown*, WIPO Case No. D2007 0045. Complainant has contended that even without the above inference, there is overwhelming evidence suggesting that the Respondent registered and is using the Disputed Domain in bad faith. Complainant has contended that the Respondent begun directing the Disputed Domain to the competitive business website immediately following the UDRP Panel's decision against him in claim number FA2003001889089, wherein the Panel held that the Respondent was cybersquatting. In view of the foregoing, Complainant has contended that the Respondent is simply continuing to try and profit off of Instant Domain Search's reputation and goodwill, undeterred by the earlier Panel's ruling.

Complainant has further contended that the timing of the registration of the Disputed Domain, which occurred a few months after the Complainant received an enquiry from the Respondent about purchase of the Complainant's Domain Name <**instantdomainsearch.com**>, shows that the Respondent was well aware of Complainant's mark when registering the Disputed Domain Name, and that the Respondent did so primarily for the purpose of disrupting and stealing the business of Complainant. Complainant has also contended that the fame of the Complainant and its mark **INSTANT DOMAIN SEARCH** also supports the finding that Respondent was made aware of Complainant's rights in the **INSTANT DOMAIN SEARCH** mark, and in this regard has cited the UDRP case of *Viceroy Cayman Ltd. v. Anthony Syrowatka, Case No. D2011-2118*. Complainant has further contended that in cases where a Respondent has intentionally attempted to attract, for commercial gain, Internet users to respondent's website at the disputed domain by creating a likelihood of confusion with the complainant's mark, is also indicative of Bad Faith, and in this regard has relied upon the decision in *Am. Univ. v. Cook, FA 208629*.

Complainant has further contended that bad faith is also indicated by the fact that the Respondent first registered the Disputed Domain that is confusingly similar to that of the Complainant and its **INSTANT DOMAIN SEARCH** mark, and then redirecting the Disputed Domain Name to a similar competing business. Complainant in this regard has further contended that the Respondent also advertises the competing business and its services as "**INSTANT DOMAIN SEARCHII**" in the title tags for its competing site, which are used by Google for a website's description in search results. Complainant has also contended that bad faith is also indicated by the Respondent's contradictory statements in the response as filed by him in the earlier UDRP proceeding (claim no. FA2003001889089), wherein the Respondent had purportedly attempted to fool the Panel by claiming he had sold the disputed domains at issue, but then later in their Response, Respondent had admitted that he would be willing to entertain an offer from Complainant to purchase the disputed names.

Complainant has contended that the Respondent has also acted in bad faith by preventing the Complainant to reflect its **INSTANT DOMAIN SEARCH** mark in a corresponding domain name, since Respondent has registered dozens of similar domain names using several different gTLDs, which was observed in the earlier UDRP proceeding vide claim no. FA2003001889089, and hence has a pattern of such malafide conduct. It has further been contended that the Respondent did not simply target a random or descriptive phrase – he targeted a competitor's (Complainant's) known and registered trademark in order to siphon traffic from the competitor's website, despite the competitor (Complainant) informing him that the website was not for sale – and to prevent the competitor (Complainant) from acquiring the Domain Names (reflective of its trademark rights), which is clear evidence of bad faith.

In view of the foregoing submissions, Complainant has contended that the Respondent has registered and is using the Disputed Domain in bad faith.



Other Legal Proceedings

The Complainant has submitted that there are no other legal proceedings that have been commenced against the Respondent in relation to the domain name <INSTANTDOMAIN.IN>.

Reliefs claimed by the Complainant

The Complainant has claimed for the disputed domain name, i.e. <INSTANTDOMAIN.IN> to be transferred to them.

5. Respondent's Contentions

As already mentioned in the Factual Background of the matter, despite being duly served with a copy of the Domain Complaint as filed and thereafter granted adequate time to respond to the same, the Respondent had not submitted any response thereto, or in fact any communication of any kind to either the Complainant, NIXI or the Arbitrator in respect of the matter.

6. Discussion and Findings

In a domain complaint, the Complainant is required to satisfy three conditions as outlined in Paragraph 4 of the .IN Domain Name Dispute Resolution Policy, i.e.:-

- a. The Registrant's domain name is identical and confusingly similar to a name, trade mark or service mark in which the Complainant has rights;
- b. The Registrant has no rights and legitimate interest in respect of the domain name;
- c. The Registrant's domain name has been registered or is being used in bad faith.

i. The Registrant's domain name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights
(Paragraph 4(a) of the .IN Domain Name Dispute Resolution Policy)

The Complainant has established its rights in the mark **INSTANT DOMAIN SEARCH**, by way of common law rights dating back to the year **2005** and the **Canadian Trade Mark Registration No. TMA1005883** for the mark **INSTANT DOMAIN SEARCH**, which has a first-use date of October 17, 2005. Although based on the contents of the Complaint and the evidence placed on record, it prima facie appears that the Complainant does not possess any trade mark application or registration in India. However, in this regard, it is pertinent to state that possessing an Indian trade mark application or registration is not a prerequisite for establishing trade mark rights under the Policy. For example, in a similar case, in *ZipRecruiter Inc. v. Amy Cox (INDRP/1102)* - with respect to the domain name <ZipRecruiter.in>, the Complainant did not have any application/registration in India but had registrations in other countries and was also operating a website at <ZipRecruiter.com>, the Panel had noted that the Complainant had established its rights over the mark

"ZIPRECRUITER" via foreign trade mark registrations, and that the said rights were similarly recognized in other UDRP cases, in favor of ZipRecruiter Inc. In the present case, the Complainant has established that it has common law rights over the mark **INSTANT DOMAIN SEARCH** and also a trade mark registration vide **Canadian Trade Mark Registration No. TMA1005883** for the mark **INSTANT DOMAIN SEARCH**. Moreover, the Complainant's rights over the said mark were also recognized in the UDRP proceeding in the case of *Instant Domain Search, Inc. v. Mark Cambridge / Thrive Travel Services Ltd.* (Claim Number: FA2003001889089).

It has been held by the Hon'ble Supreme Court of India in the landmark case of *M/s Satyam Infoway Ltd. v. M/s Sifynet Solutions (P) Ltd.* [JT 2004 (5) SC 541], that a domain name may possess all the characteristics of a trade mark and principles of trade mark law may be applicable on domain names as well. In this case, it is evident that the Complainant has rights over the trade mark **INSTANT DOMAIN SEARCH** and upon a comparison of the same as a whole with the disputed domain name <INSTANTDOMAIN.IN>, that there exists confusing similarity between the Complainant's mark **INSTANT DOMAIN SEARCH** and the disputed domain name <INSTANTDOMAIN.IN>. The mere omission of the word "SEARCH" from the domain name does not distinguish the disputed domain name from the Complainant's trade mark, especially in lights of the facts and circumstances of the case. In this regard, Complainant has cited the case of *VNY Model Management, Inc. v. Lisa Katz / Domain Protection LLC*, FA 1625115, wherein the domain name <vnymodels.com> was held to be confusingly similar to the mark VNY MODEL MANAGEMENT, as well as the case of *Amerimark Direct, LLC and its affiliate Dr. Leonard's Healthcare Corp. v. Carolina Rodrigues*, FA1605001675674. The core component and major part of the Complainant's trade mark **INSTANT DOMAIN SEARCH** and prior registered domain name <INSTANTDOMAINSEARCH.COM> is "INSTANT DOMAIN".

Complainant has established that it has a ubiquitous presence on the internet, and to that end has also submitted details of their website's visitors, and media coverage.

The disputed domain name <INSTANTDOMAIN.IN> incorporates the dominant portion of the Complainant's trade marks, i.e. **INSTANT DOMAIN** in toto, and it has been noted that the Respondent is prima facie using the domain name to redirect internet traffic to the website of a competing business.

It has been upheld by prior INDRP panels, including the ones cited by the Complainant - *Inter-Continental Hotels Corporation vs. Jaswinder Singh (INDRP/278)* and *Indian Hotels Company Limited v. Mr. Sanjay Jha (INDRP/148)*, that in cases where the disputed domain name incorporates a mark in its entirety, it is adequate to prove that the domain name is either identical or confusingly similar to the mark. The same has also been held by other INDRP panels, such as *Kenneth Cole Productions v. Viswas Infomedia INDRP/093 <kennethcole.in>*, *Carrier Corporation, USA v. Prakash K.R. INDRP/238 <Carrier.net.in>*, *M/s Merck KGaA v. Zeng Wei INDRP/323 <Merckchemicals.in>*, *Colgate-Palmolive Company & Anr. v. Zhaxia INDRP/887 <Colgate.in>* and *The Singer Company Limited v.*

Novation In Limited INDRP/905 <singer.co.in>. Accordingly, it may be noted that the same can be extended to apply to the present case, wherein the disputed domain name comprises of the dominant portion of the Complainant's trade marks, i.e. **INSTANT DOMAIN SEARCH**.

It has further been upheld in various prior UDRP panels that similarity between a trademark and a disputed domain name is not eliminated only by the fact that the trademark includes additional generic elements which are not included in the disputed domain name. This has been upheld in the cases of *Intesa Sanpaolo S.p.A. v. George Papadakos*, Case No. D2008-1531 (in this case, the Complainant had registered the marks "**INTESA**" and "**INTESA BANK CANADA**" in **Canada** vide registration nos. TMA641,178 and TMA640,760 respectively, and the disputed domain name was <intesacanada.com> - omission of the word "**BANK**"); *Octopustravel Group Limited v. Alexander Rosenblatt aka Yana Belkova* Case No. D2011-0417 (the Complainant's trade mark was **OCTOPUSTRAVEL** and the disputed domain name was <octopus.com> - i.e. omission of the word "**Travel**"); *La Société des Autoroutes Paris Rhin Rhône v. Keyword Marketing Inc.*, WIPO Case No. D2006-1270 (Complainant's trade marks were **AUTOROUTES PARIS RHIN RHONE** and **AUTOROUTES PARIS-RHIN-RHONE** and the disputed domain name was <parisrhinrhone.com> - i.e. omission of the word "**autoroutes**"); *Corcom, Inc. v. Jazette Enterprises Limited*, Case No. D2007-1218 (Complainant's trade mark was **DON BEST SPORTS** and the disputed domain name was <donsbest.com> - i.e. omission of the word "**SPORTS**"); *Pieter de Haan v. Orville Smith Ltd.*, Case No. DNL2008-0017 (wherein the Complainant's trade mark was "**AMSTERDAM INTERNATIONAL FASHION WEEK**" and the disputed domain name was <amsterdamfashionweek.nl> - i.e. omission of the word "**INTERNATIONAL**"); and *Nishan Systems, Inc. v. Nishan Ltd.*, Case No. D2003-0204 (wherein the Complainant's mark was "**NISHAN SYSTEMS**" and the disputed domain name was <nishan.com> - i.e. omission of the word "**SYSTEMS**"). Thus, the mere omission of the generic word/term "**SEARCH**" (of the trade mark **INSTANT DOMAIN SEARCH**) from the disputed domain name <INSTANTDOMAIN.IN>, does not eliminate or detract from the similarity between the trademark and the domain name.

Further, the presence of the ccTLD ".IN" in the domain name is insufficient to distinguish the domain name from the Complainant's trade marks, as has been observed in numerous prior INDRP cases also. It is also pertinent to note the fact that the disputed domain name redirects to the website of a competing business offering similar/identical services, which exacerbates the similarity between the disputed domain name and the Complainant's trade mark.

It may be pertinent to note that a finding of confusing similarity was also pronounced by an earlier UDRP Panel (vide claim no. FA2003001889089), between the Complainant's trade mark **INSTANT DOMAIN SEARCH** and the similar domain names <INSTANTDOMAINS.COM> and <INSTANTDOMAIN.COM>. Based on the evidence placed on record, it is also evident that the disputed domain name <INSTANTDOMAIN.IN> is also confusingly similar to the Complainant's top-level domain name <INSTANTDOMAINSEARCH.COM>, which the Complainant has been operating since the

year 2005. These rights significantly pre-date the registration of the domain name <INSTANTDOMAIN.IN> by the Respondent.

In view of the aforesaid, the Arbitrator finds that the Complainant has successfully established the requirements as under Paragraph 4(a) of the .IN Domain Name Dispute Resolution Policy, and that the Respondent's domain <INSTANTDOMAIN.IN> is confusingly similar to the Complainant's trade mark. The Arbitrator further notes that the disputed domain name <INSTANTDOMAIN.IN> is also confusingly similar to the Complainant's prior registered top-level domain name <INSTANTDOMAINSEARCH.COM>.

ii. **The Registrant has no rights and legitimate interest in respect of the domain name (Paragraph 4(b) and Paragraph 6 of the .IN Domain Name Dispute Resolution Policy)**

The Complainant has established that the Respondent was well-aware of the Complainant and its ownership and rights over the name/mark **INSTANT DOMAIN SEARCH**, as evident by the prior communication between the Complainant and the Respondent in June 2018, wherein the Respondent had enquired about acquiring the domain name <InstantDomainSearch.com>, which was refused by the Complainant. This is further established by the fact that the Respondent is using the domain name to redirect traffic to the website of a competing business (<businessnamegenerator.com>), and that the Respondent acquired the Disputed Domain Name well after Complainant had registered and established common law rights in the **INSTANT DOMAIN SEARCH** mark. Complainant has further contended that the Respondent is not commonly known by any of the Disputed Domain, and was not authorised by the Complainant to use the trade mark.

In the present dispute, Complainant has established that it has rights over the mark **INSTANT DOMAIN SEARCH** and that the disputed domain name <INSTANTDOMAIN.IN> is confusingly similar to the Complainant's trade mark and prior registered domain name <InstantDomainSearch.com>. Based on the Complainant's contentions and the documents placed on record, coupled with the Respondent's lack of response, it prima facie appears that the Respondent indeed has not been commonly known by the disputed domain name and thus does not appear to have rights or legitimate interests in the disputed domain name. The Respondent rather appears to be known by the names "**Mark Cambridge**" and "**TIIRIVE TRAVEL SERVICES LTD.**"

The Complainant has also contended that due to the usage of the mark "**Instant Domain Search**" on the disputed domain name's "title tags" by the Respondent, when a user searches for "**Instant Domain Search**" on Google, the Disputed Domain Name/website appears directly beneath the search results for the Complainant, and that the Respondent's registration and use of the Disputed Domain is an obvious attempt to damage a competitor and steal its business, by redirecting to a similar and competing domain name services business, and that such usage of the disputed domain name is neither a bona fide offering of goods or services under the Policy.

In light of the Complainant's unrebutted assertions, it is pertinent to state that while the burden of establishing that the Respondent has no rights or legitimate interest in respect of the disputed domain name lies on the Complainant, the same shifts to the Respondent if the Complainant makes a prima facie case showing that the Respondent has no legitimate interest in the domain name. This has been upheld by INDRP panels in the cases of *Luxottica Holdings Corp v. Lokesh Morade [INDRP/139] for <sunglasshut.in>*; *Alticor Inc v. Aryanent [INDRP/192] for <nutriliteindia.co.in>*; and *Hitachi Limited v. Kuldeep Kumar [INDRP/1092] for <hitachicorporation.in>*.

The element under Paragraph 4(ii)(b) and Paragraph 6 of the .IN Domain Name Dispute Resolution Policy necessitates that Complainant has to establish a prima facie case that Respondent has no rights or legitimate interests in the disputed domain in question. The burden thereafter lies on the Respondent to rebut the showing by providing evidence of its rights or legitimate interests in the domain name. It has been held in numerous cases, including in *Huolala Global Investment Limited v Li Chenggong (INDRP /1027)* that the onus of proving rights or legitimate interest in the disputed domain name lies on the Respondent. If the Respondent fails to come forward with relevant evidence to prove rights and legitimate interest in the disputed domain name, and if the Complainant is found to have put forward a prima facie case, then the Complainant prevails.

Under paragraph 6 of the INDRP, it is stated that Respondent can demonstrate rights or legitimate interests in a disputed domain by showing - (a) before any notice to the Registrant of the dispute, the Registrant's use of, or demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; (b) the Registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or (c) the Registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

In this case, the Respondent has not submitted any response and/or any evidence of its rights and interests. The Respondent has not been able to establish any of the conditions pre-requisite for considering a registrant's rights and legitimate interests in a domain name as set out under Paragraph 6 of the INDRP.

In the present case, based on the contents of the complaint and the unrebutted evidence placed on record, it is evident that the Respondent was aware of the Complainant and its trade marks prior to registering the disputed domain name. Moreover, as contended by the Complainant, it appears that the Respondent is attempting to divert Internet users to a competitor's website, which is not a bona fide offering or legitimate use under Policy. The circumstances are further exacerbated by the Complainant's unrebutted assertion that the Respondent, Mark Cambridge, is in fact the owner of a competing brand **Domainify.com**, and that the disputed domain name

is being redirected to the competing website <businessnamegenerator.com>, which prima facie appears to be connected/affiliated with the Respondent herein.

The Complainant has established a prima facie case of its rights in the mark **INSTANT DOMAIN SEARCH**, and in view of the facts and circumstances and evidence on record, the Arbitrator finds that Respondent has not established any rights or legitimate interests in the disputed domain name and that the Respondent is not using the disputed domain name for a bonafide offering of services and is not making legitimate non-commercial or fair use of the Complainant's trade mark.

In view of the aforesaid, the Arbitrator finds that the Complainant has successfully established the requirements as under Paragraph 4(b) of the .IN Domain Name Dispute Resolution Policy.

iii. The Registrant's domain name has been registered or is being used in bad faith (Paragraph 4(c) and Paragraph 7 of the INDRP)

Paragraph 7 of the INDRP stipulates the below circumstances which show 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 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.

Complainant has contended that the Respondent has registered and uses the disputed domain name in bad faith because the Respondent is attempting to attract, for commercial gain, Internet users to Respondent's own website by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the content thereon.

Complainant has inter alia further contended that that the Respondent is simply continuing to try and profit off Instant Domain Search's reputation and goodwill, undeterred by the earlier Panel's ruling (in claim no. FA2003001889089), and that the timing of the registration of the Disputed Domain Name, shows that the Respondent was well aware of Complainant's mark when registering the Disputed Domain Name, and that the Respondent did so primarily for the purpose of disrupting and stealing the business of Complainant. Complainant has further contended that the Respondent appears to be attempting to attract, for commercial gain, Internet

users to respondent's website at the disputed domain by creating a likelihood of confusion with the complainant's mark, which is indicative of bad faith.

Complainant has also contended that bad faith is also indicated by the fact that the Respondent first registered the Disputed Domain that is confusingly similar to that of the Complainant and its **INSTANT DOMAIN SEARCH** mark, and then redirecting the Disputed Domain Name to a similar competing business. It has further been contended that bad faith is also indicated by the Respondent's contradictory statements in the response as filed by him in the earlier UDRP proceeding (claim no. FA2003001889089), wherein the Respondent purportedly attempted to fool the Panel by claiming that he had sold the disputed domains at issue, but then later in their Response, Respondent admitted that he would be willing to entertain an offer from Complainant to purchase the disputed names. Complainant has also contended that the Respondent has also acted in bad faith by preventing the Complainant from reflecting its **INSTANT DOMAIN SEARCH** mark in a corresponding domain name, since Respondent has registered dozens of similar domain names using several different gTLDs, which was observed in the earlier UDRP proceeding vide claim no. FA2003001889089, and hence has created a pattern of such adverse and malafide conduct. Further, the act of the Respondent targeting a competitor's known and registered trademark is also indicative of bad faith.

Based on the evidence on record and the Complainant's assertions, it appears that by registering and using the domain <INSTANTDOMAIN.IN>, the Respondent has engaged in conduct as encompassed under paragraph 7 (c) of the INDRP, that *it 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* – which is exacerbated by the fact that the disputed domain name redirects to the website at <businessnamegenerator.com>, which prima facie appears to be connected/affiliated with the Respondent herein.

It further appears that the Respondent has also engaged in conduct as enumerated in paragraph 7 (b) of the INDRP also – i.e. *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.*

In addition to the above, the Respondent's registration and use of the disputed domain name has not been defended as having been bona fide and the Respondent has not submitted any reply or rebuttal to the Complainant's contentions, or evidence in support of its bona fide use of the disputed domain name.

In light of the above and evidence placed on record in support thereto, the Arbitrator finds that the disputed domain name was registered and is being used in bad faith.

In view of the aforesaid, the Arbitrator concludes that the Complainant has satisfactorily proved the requirements of Paragraph 4(c) and Paragraph 7 of the INDRP.


7. Decision

Based upon the facts and circumstances and further relying on the materials as available on the record, the Arbitrator is of the view that the Complainant has rights over the name/mark **INSTANT DOMAIN SEARCH**. The Complainant has herein been able to prove conclusively that:

- (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.

The Arbitrator therefore allows the prayer of the Complainant and directs the .IN Registry to transfer the domain **<INSTANTDOMAIN.IN>** to the Complainant.

The Award is accordingly passed and the parties are directed to bear their own costs.



Lucy Rana, Sole Arbitrator

Date: October 30, 2020.

Place: New Delhi, India.