



தமிழ்நாடு தமில்நாடு TAMILNADU

3912
12.7.2010.

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R 695355
P.S. SHANMUGA SUNDARAM,
STAMP VENDOR,
L. NO. B4/109/88
HIGH COURT CAMPUS,
CHENNAI-600 104. (TAMIL NADU)

BEFORE THE SOLE ARBITRATOR MR.D.SARAVANAN
.IN REGISTRY
(NATIONAL INTERNET EXCHANGE OF INDIA)

Disputed Domain Name: www.doubleclick.in

E M/s.Google Inc.

1600 Amphitheatre Parkway,
Mountain View,
California 94043,
U.S.A.
marula@iprights.com

Complainant

Vs.

Trillion Pay Ltd.

Unit 581, 5th Floor, Wing B
Ebene Cyber Tower,
Cyber City, Rose Hill,
Mauritius
Info@trillionpay.com

Respondent





1523
25.6.2010

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R 480920
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STAMP VENDOR,
L. No. B4/109/88
HIGH COURT CAMPUS,
CHENNAI-600 104. (TAMIL NADU)

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The Parties:

The Complainant is M/s.Google Inc., 1600 Amphitheatre Parkway, Mountain View, California 94043, U.S.A., represented by its Authorised Representative Mr.Ranjan Narula of M/s.Ranjan Narula Associates, Intellectual Property Attorneys at Vatika Towers, 10th Floor, Block B, Sector 54, Gurgaon-122 002.

The Respondent is Trillion Pay Ltd., Unit 581, 5th Floor, Wing B Ebene Cyber Tower, CyberCity, Rose Hill, Mauritius.

The Domain Name and Registrar:

The disputed domain name: www.doubleclick.in

The domain name registered with .IN REGISTRY



3. Procedural History:

April 14,2010 : Date of Complaint.

May 25, 2010 : The .IN REGISTRY appointed D.SARA VAN AN as Sole Arbitrator from its panel as per paragraph 5(b) of INDRP Rules of Procedure.

May 25, 2010 : The Arbitrator has submitted Statement of Acceptance and Declaration of Impartiality And Independence to the .IN REGISTRY.

May 28,2010 : Arbitrator was served with a copy of the complaint including the Annexures by the .IN REGISTRY.

May 28,2010 : Arbitral proceedings were commenced by sending notice to Respondent through e-mail as per Paragraph 4(c) of INDRP Rules of Procedure, marking a copy of the same to Complainant's authorised representative and .IN REGISTRY.

June 7, 2010 : Due date for filing Response by Respondent.

June 8, 2010 : Arbitrator sent an e-mail to Respondent notifying his default, a copy of which was marked to Complainant's authorised representative and the .IN REGISTRY.

June 8,2010 : The respondent sent an email communication requesting to mail them a copy of the complaint along with annexures so as to file their reply within 7 days from the receipt of the same.

June 9, 2010 : E-mail communication was sent from NIXI to the respondent stating that the copy of the complaint sent on May 26, 2010 was delivered to them on June 10, 2010 and received by Mr.Keeran, along with the attachment of the delivery report.

June 9,2010 : Respondent sent an email communication to NIXI stating that they will file the reply within 7 days if NIXI can provide them a copy of the complaint along with annexures.

June 11,2010 : There was an email communication from NIXI to the respondent requesting them to confirm the receipt of the hard copy of the complaint.



- June 13,2010 : Complainant's representative Mr.Ranjan Narula sent an email to the respondent attaching the copy of the complaint and also by a separate email attached the exhibits to the complaint.
- June 15, 2010 : Respondent sent an email confirming the receipt of the copy of the complaint and requested 10 days time for filing their reply.
- June 16,2010 : Arbitrator has sent a notice to the respondent extending time till June 25, 2010 for filing the written statement by the respondent as final chance.
- June 25,2010 : Respondent had submitted the written response dated 24.06.2010 through email.
- June 25,2010 : Arbitral Tribunal sent an email communication to file the rejoinder to the written statement by the complainant, if any on or before
- July 1,2010 : Complainant submitted their rejoinder.
- July 2, 2010 : Respondent had sent an email communication along with urgent submission stating that the authorized representative of the complainant Mr.Ranjan Narula is one of the listed arbitrator of NIXI which fact has been suppressed in these arbitration proceedings and hence the complaint should be cancelled and the complainant shall be further directed to file a fresh case before the .IN REGISTRY.
- July 5,2010 : Complainant submitted their objections to the urgent submission filed by the respondent.
- : The language of the proceedings in English.

4. Factual Background:

4.1 The Complainant:

M/s.Google Inc., 1600 Amphitheatre Parkway, Mountain View, California 94043, U.S.A., represented by its Authorised Representative Mr.Ranjan Narula of M/s.Ranjan Narula Associates, Intellectual Property Attorneys at Vatika Towers, 10th Floor, Block B, Secotor 54, Gurgaon-122 002.



4.2 Complainant's Activities:

The Complainant states that the Google Inc. is a company organized and existing and under the laws of Delaware and that the Complainant's business under the name "GOOGLE" was founded by Larry Page and Sergey Brin in the year 1997 and that the Complainant has grown to become a multi-billion dollar business. Further, it is stated that the Complainant's domain www.google.com hosts what is widely recognized as the World's best search engine, easy-to-use free service that returns relevant results within seconds. The complainant's business is headquartered in New York with 17 offices and development hubs and 14 data centers worldwide, including parts of Asia, Europe and North America. The complainant further states that DoubleClick delivers billions of digital communications a day and the service supports over 3,000 people in 10 languages. DoubleClick is the leading platform for display advertising and according to an April 2007 article on TheDeal.com, DoubleClick is the "largest player in its sector".

4.3 Complainant's Trading Name:

a) The complainant states that during the course of its business activities, the complainant uses the marks such as GOOGLE, GMAIL, ORKUT, YOUTUBE, BLOGGER, PICASA, DOUBLECLICK etc., and that the GOOGLE mark is one of the World's best known brands almost entirely through word of mouth publicity from satisfied users. The complainant further states that their website www.google.com generates revenue by providing advertisers with the opportunity to deliver measurable, cost effective online advertising which is relevant to the information displayed on any given page. The complainant further states that their product and services under the DOUBLECLICK mark have Worldwide reach including India and that the complainant has offices in many places around the world. In respect of which, the complainant has marked the press releases from around the world on the complainant's services under the DOUBLECLICK mark as Exhibit B which includes the Lexis Nexis news search shown that there are more than 3,000 articles available on the complainant's services under the DOUBLECLICK mark.

b) The complainant further states that the DOUBLECLICK mark was adopted and first used by the complainant's predecessor in title viz., DoubleClick Inc., in the year 1996 and in March, 2008 the complainant acquired the said company which specializes in developing



solutions that make advertising work on the internet and offers technology products and services that are sold primarily to advertising agencies and media companies to their clients and report on their interactive advertising campaigns.

c) The complainant further states that the DoubleClick is an arbitrary mark and that they are the registered proprietor of the said mark in a number of countries around the world including India and in respect of which the complainant has filed a number of applications for registration of the DOUBLECLICK mark in a number of other countries across the world. In respect of which, the complainant has filed a comprehensive list of files where the DOUBLECLICK mark is registered/pending registration. As regards registration in India is concerned, they have registered the DOUBLECLICK mark under clause 35, 38 and 42 vide Application Nos.1238126; 1238125; 1238124 respectively on 18.09.2003 and such registration is valid upto March 18, 2013. The complainant further states that they have been extensively using and advertising the "DOUBLECLICK" mark in relation to "Digital Marketing Technology and Services" and their mark is an asset of immense value to them as it has invested and continuously to spend huge amount of money towards brand building and providing services under the DOUBLECLICK mark. Further, the complainant states that they are also the proprietor of the domain name/website www.doubleclick.com and has been using it since 1996 and that their services under the DOUBLECLICK mark/name are popular and is firmly established in this arena as the services under DOUBLECLICK mark is truly global in nature. It is further stated that the services under DOUBLECLICK is located at www.doubleclick.com is accessible from Worldwide web and the same is available globally, including those in India. It is further stated that the complainant owns several other domain registrations for DOUBLECLICK which has been filed by the complainant under Exhibit D. The complainant further states that they own the intellectual property in the trade mark and the domain name DOUBLECLICK including its trade mark registrations and domain name registrations. The complainant states that they are the registrant of the domain name www.doubleclick.com and the complainant filed WHOIS report proving the ownership of www.doubleclick.com under Exhibit E. The complainant further states that their mark DOUBLECLICK has attracted millions of registered users since its launch in the year 1996 and there has been extensive coverage. In respect thereof, the complainant has filed a third party summary of DOUBLECLICK history



from Wikipedia under **Exhibit F**. The complainant further states that the DOUBLECLICK service with the backing of Google Inc., has gained further popularity across the world and the internet users recognize DOUBLECLICK as a part of Google Inc., across the world. It is further stated that the complainant is one of the largest internet search service providers in the world and is well known in the field of information technology and due to the success of the DOUBLECLICK service the complainant has gained extensive good will and reputation worldwide and in India. It is further stated that the users of the service and general trade and public exclusively associate the mark DOUBLECLICK with a business and services of the complainant and none other. It is further submitted that in view of the extensive use of internet by all the age groups from different strata of society for business, leisure and education the mark/name DOUBLECLICK is exclusively associated with the complainant in India and the use of mark DOUBLECLICK brings to mind the complainant's operation only and the mark has been popularized by the complainant on account of innovative business services carried out under the mark/name DOUBLECLICK. It is further stated that the complainant relies primarily on word-of-mouth advertising and one way marketing is done via www.doubleclick.com which features a blog, a media gallery, research reports, case studies and bench mark reports. It is further stated that the complainant's DOUBLECLICK business reported of \$300.2 million in 2002, \$271.3 million in 2003, and \$301.6 million in 2004 and in respect of which the complainant has filed a copy of the income account under **Exhibit G**.

d) The complainant further states that the respondent is an entity which is situated in Mauritius and registered the domain name on February 16, 2005 and in respect of which the complainant has filed WHOIS search for the domain name under **Exhibit A** and aggrieved by the respondent's registration of an infringing domain name, the complainant sent a notice to the respondent on the information/contact details obtained from the WHOIS records and in respect of which a copy of the letter sent by them to the respondent is filed under **Exhibit H** however, according to the claimant the respondent has failed to respond to the said notice or take any steps to transfer the domain name to the complainant. It is further stated that the complainant has made numerous effort to contact the respondent and elicit a response, however the respondent has not responded. It is also further stated that the respondent has recently renewed the registration of



domain name until February 16, 2011 despite the complainant's letter. It is further stated that the complainant apprehends that the respondent will use the conflicting domain and derive undue pecuniary benefit from their mark/name DOUBLECLICK and in such circumstances the complainant has no option but to file this complaint against the respondent to stop unauthorized use of its mark as part of the domain.

4.4.1 Respondent's Identity and activities:

The Respondent is Trillion Pay Ltd., Unit 581, 5th Floor, Wing B Ebene Cyber Tower, Cyber City, Rose Hill, Mauritius and the registrant of the Domain Name <www.doubleclick.in> which is registered with .IN REGISTRY, National Internet Exchange of India, New Delhi.

5. Parties contentions:

A. Complainant:

(a) The Domain Name is identical or confusingly similar to a Trademark or service mark of the Complainant has rights:

According to the complainant, they have used the DOUBLECLICK mark since well prior to February 16, 2005 the date of registration corresponding to the respondent's domain name www.doubleclick.in and the complainant owns registrations as contained in **Exhibits D and E** which were prior to, or resulting from applications filed prior to February 16, 2005 and each remains valid and in full force. Thus, the complainant has rights in the DOUBLECLICK mark that pre-date the registration date of the domain name. The complainant further states that it is a settled proposition that a domain name is "nearly identical or confusingly similar" to a complainant's mark when it "fully incorporate (s) said mark" and here the domain name incorporates the complainant's famous DOUBLECLICK mark in entirety and the users seeing the domain name are even more likely to believe that the domain name originate from the complainant and as such the disputed domain name is identical to the complainant's DOUBLECLICK mark.



(b) Respondent has no rights or legitimate interests in the domain name:

According to the Complainant, they have not authorized the respondent to register or use the domain name or licensed the respondent to use any of its trade marks in any way. Unlicensed and unauthorized use of domains incorporating the complainant's trade mark is strong evidence that the respondent has no rights or legitimate interest. Further, according to the complainant, the respondent is not known by the name or nick name of the domain name or any name containing the complainant's DOUBLECLICK mark. The respondent's WHOIS information makes no reference to DOUBLECLICK mark and the respondent's trading name is Trillion Pay Ltd.

(c) Respondent has registered and is using the domain name in bad faith:

According to the Complainant, their DOUBLECLICK mark is arbitrary. Thus, the respondent has clearly tried to ride upon the goodwill and reputation built by the complainant and its predecessor. According to the complainant, it is a settled proposition of law that where there is copying, dis-honesty ought to be presumed and the evidence overwhelmingly supports the conclusion that the respondent registered the domain name in bad faith. It is further stated that the fame and unique qualities of their DOUBLECLICK mark make it extremely unlikely that the respondent created the domain name independently and on the date of registration of the domain name, the complainant's mark DOUBLECLICK was well known all across the world including in India and that the complainant's domain name www.doubleclick.com was registered and active. It is further stated that the respondent thus, had constructive knowledge/notice of the complainant's rights and the respondent's registration and renewal of the domain name inspire of the notice amounts to evidence of bad faith registration. It is further stated that the complainant apprehends the respondents will disrupt and its business and derive undue pecuniary benefit from their goodwill and reputation in the DOUBLECLICK mark as the domain name is capable of falsely conveying to internet users that the products/services offered by the respondent originate with the complainant. Further, the respondent unwary internet users can be easily mis-lead into thinking that the website is directly or indirectly sponsored by/owned by/associated with the complainant as such the respondent has registered using the domain name in bad faith. It is further stated that any use of the DOUBLECLICK mark by the respondent will cause incalculable harm and injury to its goodwill, reputation and



business in general. If the respondent is allowed to maintain its registration of domain name www.doubleclick.in it will give him the ability to actively use the domain name and its convenience. It is further stated that the loss and damage will not only be the complainant's reputation but also resulting confusion and deception amongst the trade and public who would subscribe to the respondent's products/service assuming it to be sourced, sponsored, affiliated, approved, authorized or endorsed by the complainant and further the trade and public may also assume that there exists collaboration between the complainant and the respondent which is likely to further harm the reputation enjoyed by the complainant. Further, the complainant is exposed to the risk that the respondent can at any time sell or transfer the domain name to the third party.

B. Respondent:

a) In response to the complaint filed by the Complainant, the respondent states as follows: The respondent M/s.Trillion Pay Ltd is Mauritius based company which provides payment gateway solutions and other IT related services to clients all over the world. The complaint of the complainant is purely a REVERSE DOMAIN HIJACKING attempt as this complaint contains one and only thing i.e., the complainant has the trademark on the term "DoubleClick". However, as per the INDRP policy it clearly says that ALL THREE ELEMENTS should be present when a complaint is filed and burden of proof remain on the complainant. The complainant in this complaint giving emphasis to Trademark and has failed to prove and provide any evidence on other two elements which clearly shows that this complaint is brought to abuse the INDRP process and with intention to REVERSE HIJACKING THE DOMAIN NAME.

b) The respondent states that the date of registration of domain name is 16th February, 2005 (First Date of Open Registration of .IN Domains), and they checked from the Indian Trade Mark Registry and found that complainant filed all trademark applications on 18.09.2003 and on the date of registration of our domain name the term 'DoubleClick' was NOT REGISTERED TRADEMARK, all these trademark was just applied trademark and they got the registration status only in January 2006, almost one year after our registration of domain name. It is further stated that the Word 'DOUBLECLICK' is coined word from the two generic terms called 'DOUBLE' + 'CLICK', and it lacks uniqueness and word



DOUBLECLICK is a regular, common and frequently used term in computer languages. It is a commonly used word hence such trademark is not unique one and cannot be exclusively associated with the complainant only. It is further stated the respondent when we registered the domain name, complainant mark was not known mark in India or in Mauritius and this mark was not registered mark on the date of our registration of domain name and more importantly on seeing the Trademark registration it clearly says that 'Proposed to be used', Hence, complainant's point that they copied their trademark in their domain name is completely false and baseless. The respondent further states that the Complainant is not the authority to allow or authorize them to use this domain name as they were never knowing their presence at the time of registration of domain name in India or in Mauritius, as complainant itself admitted before the TM authorities that their TM terms are 'Proposed to be used' so they cannot give any right to anybody when complainant itself is not having any trademark or right on the term DOUBLECLICK on their registration date. The complainant completely ignored the policy requirement for proving the Bad faith in this case, instead of going through the policy requirement they are providing the instances of .com domain registration as the basis of Bad Faith but policy clearly given scopes of Bad faith in para 5(i), (ii) and (iii) which was ignored by the complainant. Complainant also ignored the fact that domain name 'doubleclick.biz' is not owned by the complainant as this domain extension (.BIZ) was also offered to all trademark holders as priority but complainant never bothered to protect its right when chances are given to them, this clearly proves that complainant is not serious about its IP right and he is trying to gain control on domain name as and when required by using its systematic hijack process.

c) The respondent further states that the domain name Doubleclick.in was registered by them on 16th February, 2005 when .IN REGISTRY opened the registration of .IN Domains for public. Before 16th February, 2005 registration was exclusively open for trademark holders and during that period complainant never bothered to protect their Intellectual Property right which is since because the complainant do not have any trademark registered in 2005. They also did not provide any proof that they tried to protect their right by writing to the .IN REGISRY about registering this domain name. The Complainant has also failed to provide any evidence that they tried to protect or secure this name during the open registration period which clearly shows that the complainant is not at all serious about protecting its IP rights. The Respondent further states that they registered this domain name



in February, 2005 for their regular business operation of IT services and since this word (DoubleClick) is a commonly used term in the field of internet so they chosen this term and they were not knowing about the complainant's mark on the date of registration as it was not registered mark in India and Mauritius. The complainant was just waiting to get Trademark certificate to brought this complaint and even not bothered till 2010 to protect its trademark, which clearly shows the complainant's seriousness about it's IP rights. Such complaints are also comes under Law of Limitations in India and they do not have any right to bring this dispute now.

d) As regards Para 4(i) the Registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights; the Respondent states that the their domain name DoubleClick.in is not identical or similar to the complainant mark which was 'proposed to be used', if we go in the details we found that the complainant was not at all having right in the said trademark on the date of their registration of domain name in 2005. As the complainant acquired right in the word 'DoubleClick' on April 13, 2007, as per the press release by complainant (<http://www.google.com/intl/en/press/pressrel/doubleclick.html>), at the time of registration of Respondent's domain name complainant do not have RIGHT in the trademark as their trademark was having UNREGISTERED STATUS as on 16th Feb, 2005 so this condition is not fulfilled by the complainant.

e) The Respondent further states that the Complainant is based in USA and they acquired right in doubleclick in 2007 almost two years after their registration of domain name, and the Respondent further investigate and found that DOUBLECLICK word is not the exclusive or unique word invented by the complainant but same term is in use and registered trademark in USA much before the complainant mark was applied, in respect of which the Respondent has attached the image of trademark registered in USA much before the complainant's registration (annexl.jpg) from the USPTO database, which clearly proves that complainant do not have exclusive right on word 'DoubleClick' as such trademark and word are already exist before the complainant acquire right in this word.

f) As regards Para 4 (ii) the Registrant has no rights or legitimate interests in respect of the domain name; the Respondent states *inter-alia* that 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; the Registrant has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or 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.

g) According to the Respondent, the complainant failed to provide any evidence in support of above and the respondent submits that from the date of registration to till the date, they kept this domain name for their bona fide offering of services and currently they are using this domain name for their setup and using of domain name for the purpose of email is also a bona fide use of the domain name. According to the Respondent, it is clear that they have not violated any condition of para 4 (ii) and complainant clearly failed to provide any evidence in support of para 4(ii) of policy or Para 4(iii) the Registrant's domain name has been registered or is being used in bad faith. According to the Respondent they never acquired this domain name for the purpose of sale or renting and in the complaint also the complainant not provided any such issue or evidence that the respondent to sale this domain name to them or their any competitor. According to the Respondent as found in Para 5 (ii) they never prevented the complainant from registering the said domain name and complainant also not provided any proof of that in their complainant.

h) As regards Para 5 (iii) the Respondent states that the Complainant never provided any evidence in its complaint that the Respondent tried to intentionally attract the user or creating a confusion in the user's mind that doubleclick.in is complainant's website, and the respondent never engaged in selling on this website any product or services which is similar to the complainant.

i) The Respondent further states that Para 4(iii) deals with Bad Faith registration of domain name and complainant clearly failed to provide any evidence in support of that and the Respondent has relied upon a WIPO Case No.D2000-0518 (Maruti Udyog Limited v. Telia Rao) located at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0518.html>, wherein Maruti Udyog Limited (Makers of Maruti Cars a Very Famous brand in India) try to gain control over the domain name Maruti.com in similar fashion with MARUTI trademark but



the complainant was denied just because complainant failed to prove Bad Faith element to the panel. By stating so, the Respondent pray that the complaint should be denied.

C. The sum and substance of the Rejoinder to written statement as follows:

a) The Complainant states that the DOUBLECLICK mark was adopted and first used by the Complainant's predecessor-in-title (DoubleClick Inc.) in the year 1996 and was acquired by the Complainant in March 2008. On the other hand, the Respondent registered the Domain Name DOUBLECLICK.IN on February 16, 2005. Therefore, adoption of the mark 'DOUBLECLICK' by the Complainant and their predecessor-in-title is much prior to the adoption/registration of the domain name by the Respondent. The Complainant enjoys valid and subsisting registration for the trade mark DOUBLECLICK in India since 18th September 2003 (it is the date of the filing that is considered the date of registration once the mark is registered). The statutory right conferred on the Complainant over the 'DOUBLECLICK' mark is *prima facie* prior in time to the registration of the domain name by the Respondent on February 16, 2005. The Complainant is also the proprietor of the domain name / website www.doubleclick.com and has been using it since 1996. The said top level domain name registration owned by the Complainant is prior in time to the adoption / registration of the disputed domain name by the Respondent. The Complainant also possesses other domain name registrations for DoubleClick, all of which involve the Complainant's predecessor-in-title's trademark / trading style 'DOUBLECLICK'.

b) The Complainant further states their trade mark 'DOUBLECLICK' is an arbitrary mark. It is not a dictionary word and has been popularized by the complainant on account of extensive use is in relation to 'digital marketing and technology'. It is due to this arbitrary character that the Complainant's mark is considered distinctive and has been conferred registration in a number of countries around the world including the United States of America, Argentina, Austria, Brazil, Canada, China, the European Union, Hong Kong, Israel, Norway, Singapore, South Korea, Switzerland, Taiwan, Venezuela, Japan, Mexico and India. On account of prior use of the mark in commerce as well as statutory trademark protection the world over, the Complainant enjoys prior and exclusive rights over the trademark 'DOUBLECLICK' to the exclusion of third parties, including the Respondent. The



popularity of the complainant's mark 'DOUBLECLICK' can be gauged from the fact that search engines such as Bing, Yahoo, Rediff, Sify all list complainant's website among the top 10 search results for the key work DOUBLECLICK.

c) The Complainant further states that the Respondent, as per the information on their website '<http://www.trillionpay.com>', is a payment gateway and is a sister concern of Target International, a Internet Marketing and a Web Development Company. Thus it is obvious that Registrant has a web based business. Being in the same realm of commerce as the Complainant and given the well-known nature of Complainant's DOUBLECLICK business, the Respondent is deemed and ought to have been aware of the existence, reputation and goodwill of the Complainant's DOUBLECLICK business and mark. In the written response, the Respondent has at no stage elaborated their basis of adoption of the mark or reason for adoption. Further their business plans in relation to the 'DOUBLECLICK' domain. Thus, in the absence of any evidence of use the disputed domain name in a *bona fide* offering of goods or services, the facts of record overwhelmingly support the conclusion that the Respondent registered the Domain Name in bad faith. By stating so, the Complainant denies the allegation of 'Reverse Domain Hijacking' as baseless, malicious and untrue. It is further stated that the Respondent has himself admitted that complainant owns the trademark 'DOUBLECLICK', thereby satisfying one of the three conditions outlined in Para 4 of the Policy, viz. "(i) the Registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights." It is also an established fact that the Respondent has not been authorized by the Complainant to register or use the Domain Name. The Complainant has not authorized or licensed the Respondent to use any of its trademarks in any way. Unlicensed, authorized use of domains incorporating the Complainant's trademark is strong evidence that the Respondent has no rights or legitimate interests. The Respondent is not making a legitimate non-commercial or fair use of the domain name which fact is demonstrated by the fact that the Respondent is not currently and has never been known under the name DOUBLECLICK. The disputed domain name has been registered by the Respondent to take advantage of the fame of the Complainant's trademark to confuse Internet users. The Complainant further states that as a matter of fact, the Respondent has not engaged in any action that shows he has right or legitimate interests in the disputed domain name. Moreover, by not responding to the cease and desist letter sent by the Complainant, the Respondent admits that he has no rights or



legitimate interests in the disputed domain name (*WIPO Arbitration and Mediation Center, Case No.D2005-1057-Confederation Nationale du Credit Mutuel, France versus Josh Self, United States of America*). In view of the above it is submitted that the complainant has satisfied the second condition outlined in Para 4 of INDRP viz., '(ii) the Registrant has no rights or legitimate interests in respect of the domain name.'

d) The Complainant further states that the proprietary rights in the mark / name DOUBLECLICK on account of priority in adoption, use and registrations has not been denied by the Respondent, and is thus, admitted by him. The Respondent has also not denied the immense worldwide popularity the Complainant's services enjoys under the disputed mark. Also, being involved in web-related activities, it is difficult to imagine that the Respondent could have been unaware of the disputed mark when he applied for registration of the disputed domain name. The Complainant further states that an inference can, therefore, be drawn of bad faith that the Respondent's purpose of registering the domain name was to block it and deprive the Complainant, who is the rightful owner, of the right to register and use the domain name that is India-specific. By parking the disputed domain, the intention of the Respondent is simply to generate revenue, either by using the domain for its own commercial purpose later or through the sale of the disputed domain name to a competitor for higher price. (*INDRP/051; NBA Proprieties versus Rickson Rodricks*). The Complainant states that the statements made by the respondent reek of a lack of understanding of the basic principles of Indian Trade Marks law. As per Section 23 of the Trade Marks Act, 1999, a trade mark, when registered, shall be registered as of the date of making the said application and that date shall be deemed to be the date of registration. As per this provision, rights conferred by registration shall accrue from the date of application. Thus, the registration date of the 'DOUBLECLICK' Indian trade marks is 18th September 2003, i.e., much prior to the date of registration of the disputed domain. The Complainant further states that they enjoys subsisting registration in India and Internationally, being prima facie evidence of validity of the trademark 'DOUBLECLICK' and vesting in them the exclusive right to use of the said mark to the exclusion of others, including the Respondent (*INDRP/061; Mothercare UK Limited versus Mr. Rajkumar Jalan*). It is submitted as the Complainant has been able to successfully make a *prima facie* showing that the Respondent lacks right to the domain name at issue, the Respondent must come forward with proof that it has some legitimate interest in the domain name to rebut this



presumption, which he has not done. (*Document Technologies, Inc. V. International Electronic Communications Inc., WIPO Case No. D2000-0270.*). The Complainant denies the allegation that they failed to prove any of the conditions of the INDRP. It is submitted that the overall objective of the Policy is to prevent abusive domain name holders and use the provisions for the benefit of legitimate trademark holders. It is also clear from a reading of the relevant paragraph that the examples of bad faith registration and use set forth in para 6 are not meant to be exhaustive of all circumstances from which such bad faith may be found. The Complainant relies Para 6 (INDRP) which states that "Evidence of Registration and use of Domain Name in Bad Faith - For the purposes of Paragraph 5(iii), 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..." It has been held that if the domain name is got registered by respondent by knowing or keeping in mind the trademark of the complainant then this will constitute bad faith (*WIPO case D - 2005-1057; Confederation Nationale du Credit Mutuel, France versus Josh Self, United States of America*).

e) The Complainant states that they are the prior adopter and rightful owner of the DOUBLECLICK mark and it is impossible to conceive with the evidence on record that the Respondent was not aware of this well-known mark at the time of disputed domain registration, and the purpose of registering the domain name was clearly to block the name and deprive the Complainant, who is the rightful owner to register and use the domain name that is India-specific. By parking the disputed domain, the intention of the Respondent is simply to generate revenue, either by using the domain for its own commercial purpose later or through the sale of the disputed domain name to a competitor for higher price. The Complainant denies the allegation that they do not have any right to bring the present action as per the Law of Limitation in India and states that as per the INDRP policy no limitation is prescribed, hence, this contention ought to be dismissed. As regards the Respondent's contentions in relation to a US registration for the mark DOUBLECLICK in the name of a third entity the Complainant states that they are not relevant to the present proceedings, in view of the admitted position that the Complainant's mark DOUBLECLICK enjoys valid and subsisting registration in various countries of the world, including India and United States. Therefore, the Respondent's reliance on third party registration that covers goods that are not of interest to Complainant or Respondent, namely writing instruments, is



misplaced and does not advance the Respondent's case. The Complainant further denies that the Respondent kept the disputed domain for their bonafide offering of services and currently using this domain name for their email set-up. The Respondent have failed to substantiate this claim by way of any documentary evidence, thus, reinforcing the fact that the disputed parked domain name was registered simply to generate revenue, either by using the domain or its own commercial purpose later or through the sale of the disputed domain name to a competitor for higher price.

D. The sum and substance of the "urgent submissions" by the Respondent as follows:

The complainant is represented by Mr. Ranjan Narula, who is also one of the listed Arbitrator of National Internet Exchange of India (NIXI - .IN REGISTRY) and Mr. Ranjan Narula has hidden this fact while representing his client the Complainant (Google Inc.) before the panel, which is against the law and Mr. Ranjan Narula and his legal firm should not be allowed to represent before any arbitration cases in .IN REGISTRY, as this may affect the outcome of the arbitration process. By stating so, the Respondent prays that the complaint should be immediately cancelled and the Complainant should be directed to file a fresh case before the .IN REGISTRY if they wish to file. The Respondent further states that some additional facts are added to the rejoinder which was never part of original complaint, which requires additional submission on their part.

E . The sum and substance of the Complainant's objection to urgent submission as follows:

The allegation in Paragraph 1 of the urgent submission that Mr. Ranjan Narula has hidden the fact of being a listed Arbitrator on NIXI is denied as baseless and malicious. The List of Arbitrators is a matter of public record and is publicly available on the .IN REGISTRY website at www.registry.in. This information was available at the time of institution of the complaint and at the time the Respondent filed its response to the complaint. It has no bearing on the merits of the case on merits therefore they are raising irrelevant arguments in order to delay the process. It is further denied that Mr. Narula's / his legal firm's representation of the Complainant in the present dispute is against the law. The Respondent be put to strict proof thereof and quote the relevant provision of law/code/rules which prohibits and listed Arbitrator of NIXI/.IN REGISTRY from acting as pleader/counsel for a party in a complaint filed before the NIXI/.IN REGISTRY, as directed



by the learned Arbitrator in notice to parties dated 3rd July 2010. The allegation in Paragraph 2 of the urgent submissions is denied as false. It is denied that the Complainant has added new facts in their rejoinder. The Complainant has merely reiterated the submissions made in the complaint in a way so as to effectively rebut all the allegations of the Respondent made in the written statement.

6. Issues, Discussion and Findings:

Is there any bar for a listed Arbitrator of National Internet Exchange of India (NIXI) from acting as Pleader / Authorised Representative on behalf of a party to a different complaint filed before NIXI?

There is no dispute over the constitution of this Tribunal, however, the Respondent, by their urgent submission dated July 2, 2010 raised an objection seeking to cancel the complaint on the ground that Mr. Ranjan Narula, the complainant's representative has hidden the fact that he is also one of the listed arbitrators of National Internet Exchange of India and filed the present complaint. By which the respondent attempts to emphasize that Mr. Ranjan Narula being a panel arbitrator of NIXI cannot act/represent as counsel to a party in a different complaint. The complainant has also filed an objection to the same dated July 5, 2010 stating that there is absolutely no fact has been hidden and the list of arbitrators is a matter of public record as published on the .IN REGISTRY'S website at www.registry.in. In the context of the dispute in reference, this tribunal has sent an email dated July 3, 2010 to the respondent specifically calling for him to quote the relevant provision of laws/code/rules which prohibits the listed arbitrator of NIXI/.IN REGISTRY from acting as pleader/counsel to a party in a complaint filed before the NIXI/.IN REGISTRY. However, the respondent was unable to cite any such laws/code/rules. There is absolutely no dispute over the role of Mr. Ranjan Narula in this case as authorized representative for the complainant and the role of the authorized representative for the complainant is only limited to the extent of pleading the case of the complainant who is not rendering any decision in this case. There is no mandate contemplated for a Counsel to disclose any circumstances likely to give rise to justifiable doubts as mandated under Section 12 of the Arbitration and Conciliation Act, 1996 to an Arbitrator. Therefore, the question of suppression does not arise. In the absence of any specific laws/code/rules prohibiting the panel arbitrator of NIXI from acting as



pleader/counsel/authorized representative for the complainant filed before the .IN REGISTRY, this tribunal is unable to accept the contention of the respondent. Hence, the contention of the respondent is rejected.

(ii) Whether the complaint is barred by Limitation ?

According to the respondent the domain name doubleclick.in was registered by them on February 16, 2005 when .IN REGISTRY opened the registration of .IN domains for public; prior to February 16, 2005 it was exclusively opened for trade mark holders and during that period the complainant never bothered to protect their intellectual property rights; however, after the period of 5 years, the complainant has preferred to challenge the domain name only in the year 2010 and hence the present complaint is barred by laws of limitation in India. To which the complainant has objected by stating that the present complaint has been filed as per the INDRP policy where there is no limitation has been prescribed. Now considering the submission of both the parties, this Tribunal is of the firm view that there is no dispute over the date of registration of trade mark i.e. DOUBLECLICK under clause 35, 38 and 42 on 18.09.2003 by the complainant before the Registry of Trade Mark in India. So also, there is no dispute that the complainant is in operation of the domain name/web site www.doublecUck.com and they have been using it since 1996. In this respect, it is pertinent to read Section 23 of the Trade Marks Act, 1999, which state that when an application for registration of trademark has been accepted and registered the date of making of the said application shall be deemed to be the date of registration. That being so, on coming to know of the registration of domain name www.doubleclick.in the complainant has caused to issue a letter dated June 15, 2009, under Exhibit H raising dispute over the domain name registration by the respondent and thereafter the complainant has lodged the present complaint before .IN REGISTRY as early as on May 14, 2010. Though there is a limitation of 3 years for filing the suit in terms of Section 134 of Trade Marks Act, 1999, is prescribed under the Limitation Act, 1963 from the date of impugned act of infringement or passing off, infringement of Trade Mark carried on from time to time would give a recurring cause of action to the holder of the trade mark to make his grievance about the same and to seek proper relief from the appropriate forum. The present complaint has been filed under the INDRP Policy and as stated by the complainant, INDRP policy does not prescribe any time limit for making complaint in the case of infringement of a domain name. In any event, as soon as the complainant came to know of the registration of domain name by the



respondent, they have caused to issue a letter of objection dated June 15, 2009, and has filed the present complaint within time i.e., May 14, 2010. Thus, this Tribunal comes to an irresistible conclusion that the complainant was vigilant enough in filing the present complaint as soon as they came to know of the registration of the disputed domain name. In the light of the above, the contention of the respondent that the complaint is barred by laws of limitation in India is hereby rejected.

iii) Now, considering the merits of the dispute this Tribunal is constrained to consider paragraph 4 of INDRP policy. Under paragraph 4 of the IN Domain Name Dispute Resolution Policy (INDRP), the Complainant must prove each of the following three elements of its case:

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

(a) Identical or confusing similarity:

(i) As regards this issue, the objection of the respondent is that even though the complainant had made their application on 18.09.2003 for registering their trade mark before the Indian Trade Mark Registry, the complainant got the status of registration only in January 2006. However, the respondent got registered the disputed domain name in February 2005 and hence the complainant cannot claim right over the word "DOUBLECLICK". In this respect, this Tribunal has already decided that as per Section 23 of the Trade Mark Act, 1999, the trade mark once registered would have its effect from the date of application which was originally made. Admittedly, in this case the complainant got the status of registration of DOUBLECLICK name in January, 2006 and subsisting and hence by application of Section 23 of Trade Marks Act, 1999 the registration will relate back to or will



date of application i.e., 18.09.2003. The respondent having stated that the complainant got the registration status only in 2006, further stated that the complainant being the trade mark holder has failed to protect their intellectual property rights during the period when the domain name registration was opened to the trade mark holders. Hence, it can be construed as clear admission of the respondent that the complainant is the registered holder of mark "doubleclick". In this respect, this Arbitral Tribunal has found that the complainant has proper evidence that it possesses registered trade mark under **Exhibit C** since 18.09.2003 and domain name registration under **Exhibit B**. Therefore, the respondent's domain "doubleclick.in" consists of entirely complainant's trade mark except cc TLD. In this respect, it can be seen that the domain name serves the same function as the trademark and is not a mere address and therefore entitled to equal protection as a trademark.

(ii) In a recent case of Satyam Infoway Ltd. Vs Sifynet Solutions Pvt. Ltd. reported in 2004 (6) SCC 145 the Supreme Court of India opined that 'with the increase in the commercial activity on the internet, a domain name is also used as a business identifier. Therefore, Domain name not only serves as an address for internet communication but also identifies the specific internet site. In the commercial field, each Domain name owner provides information/services which are associated with such Domain name. Thus the domain name may pertain to the provision of services within the meaning of section 2(z) of Trademark Act'. But apart from similarities, the Hon'ble Court has also pointed out a trademark is protected by the laws of the country in which it is registered. Consequently, a trademark may have multiple registrations in many countries of the world. On the other hand, since the internet allows for access without any geographical limitation, a Domain name is potentially accessible irrespective of the geographical location of the consumers. As the national laws became inadequate to effectively protect a domain name, Uniform Domain Name Dispute Resolution Policy has been framed and is made applicable to all member countries of the world.

(iii) In fact, in the Respondent has no where elaborated or established their basis of adoption of the trade mark or plausible reason for adoption. Thus, this Tribunal comes to the irresistible conclusion that the disputed domain name "doubleclick.in" is confusingly similar or identical to the "doubleclick" mark. Further, this Tribunal concludes that the complainant has established para 4 (i) of the IN Domain Name Dispute Resolution Policy.



(b) Respondent's rights or legitimate interests:

The Complainant states that the respondent has no legitimate interest in the disputed domain name. The INDRP policy sets out three elements, any of which shall demonstrate the respondents rights or legitimate interest in the disputed domain name for the purpose of paragraph 4 (ii) of the policy. In this case the complainant has established their trade mark rights over the word "doubleclick" and also registration and usage of domain name since 1996. On the other hand, the respondent's contention is that they got the domain name for their bonafide offering of services and currently they are using this domain name for their email purpose which is also a bonafide use of domain name. In this case, it is not in dispute that the Respondent has not engaged in any action relating to their right or legitimate interests in the disputed domain name. It is also not in dispute that the Respondent has not responded to the cease and desist letter sent by the Complainant. In this respect, the Complainant refers to WIPO Arbitration and Mediation Centre, Case No.D2005-1057; Confederation Nationale du Credit Mutuel, France Versus Josh Self, United States of America. The subsisting registration of trademark by the Complainant in India and internationally exhibits their exclusive right to use the said mark to the exclusion of others. In any event, the respondent has failed to file any piece of evidence regarding their rights or legitimate interest over the disputed domain name so as to rebut the contention of the complainant. Based on the record, the Respondent does not have rights or legitimate interests in the disputed domain name as the Respondent's current use is neither an example of a bonafide offering of goods or services as required under paragraph 7(i) of the Policy nor is there any legitimate non-commercial or fair use of the disputed domain name and as such there is no evidence that paragraphs 7(ii) or 7(iii) of the Policy apply.

The Arbitral Tribunal is satisfied that the Respondent has no rights or legitimate interests in respect of the disputed domain name and accordingly paragraph 4(ii) of the Policy is satisfied.

(c) Registration and Use in Bad faith:

i) Paragraph 6 of the Policy provides the circumstances evidencing registration and use of a domain name in bad faith are that, by using the same, the Respondent has engaged in a pattern of such conduct and the Respondent has intentionally attempted to attract, for



commercial gain, internet users to the Respondent's web site or other online locations, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's web site or location. In this respect, the respondent refers to WIPO Case No.D2000-0518 between Maruti Udyog Vs. Teli Rao, wherein the Maruti Udyog Limited tried to gain control over the domain name www.maruti.com in similar fashion with MARUTI trademark but the complaint of Maruti Udyog Limited was denied just because complainant failed to prove bad faith element to the Panel. On the other hand, the Complainant states that the said decision is not applicable to the present case on hand the Respondent in that case was able to show that "Maruti" was the name of his family member who in fact was using the disputed domain name in respect of a business interest absolutely disparate from that of the Complainant. Registration of Trademark "DOUBLECLICK" and domain name <doubleclick> by the Complainant are well within the knowledge of the Respondent. That being so, the proposition as held in WIPO case D-2005-1057; Confederation Nationale du Credit Mutuel, France Versus Josh Self, United States of America, that if the domain name is got registered by respondent by knowing or keeping in mind the trademark of the complainant would constitute bad faith, squarely applies and support the case of the Complainant. Further, in the case on hand, the Respondent's website <http://www.triUionpay.com> is a payment gateway and is a sister concern of Target International, a Internet Marketing and a Web Development Company being in the same realm of commerce as that of the Complainant. As admitted by the Respondent, currently they are using the dispute domain name for their email setup only even though it was registered as early as in the year 2005. In this respect, the Complainant has referred to the decision rendered by in INDRP/051; NBA Properties Versus Rickson Rodricks where I had drawn an inference of bad faith. In this case, the bad faith is explicit as the Respondent has parked the domain name simply for five continuous long years.

ii) Further, as held above, the Respondent has not all bothered to prove their basis of adoption of the mark or the reason for adoption. The Respondent has registered the domain name which appears to have been selected precisely for the reason that it is identical or confusingly similar to registered trademarks and trade names of the Complainant. Admittedly, the Respondent has no affiliation with the Complainant. Registration of a domain name that is confusingly similar or identical to a famous trademark by any entity,



which has no relationship to that mark, is itself sufficient evidence of bad faith registration and use.


iii) In view of the submitted evidence and in the specific circumstances of this case, this Arbitral Tribunal holds that Respondent's purpose of registering the domain name was in bad faith within the meaning of the Policy. The Respondent has no legitimate rights or interests in the disputed domain name and there was no real purpose for registering the disputed domain name other than for commercial gains, and that the intention of the Respondent was simply to generate revenue, either by using the domain name for its own commercial purpose or through the sale of the disputed domain name to a competitor or any other person that has the potential to cause damage to the ability of the Complainant to have peaceful usage of the Complainant's legitimate interest in using their own trade names.

In the light of the above, this Arbitral Tribunal finds that the Complainant has established that the disputed domain name was registered and is being used in bad faith.

7. Decision:

For all the foregoing reasons, in accordance with paragraph 10 of the Policy, the Arbitral Tribunal orders that the disputed domain name <doubleclick.in> be transferred to the Complainant.

Dated at Chennai (India) on this 12th day of July, 2010.


(D.SARAVANAN)
Sole Arbitrator