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N1721/703/1643/6286

BEFORE THE SOLE ARBITRATOR C.A. BRIJESH
IN REGISTRY
C/o NIXI (NATIONAL INTERNET EXCHANGE OF INDIA)
NEW DELHI, INDIA

Softnews NET SRL

Aleea Suraia 4, Bldg. 21B,
Entrance 1, 7th floor, Apt. 46,
3rd District, Bucharest, Romania.

.... Complainant

Versus

Arianna Bureau,

Avenida del Valle 34,
Madrid - 28003, Spain.

Ph.: +34-915545858

Email: domainsmart2@gmail.com

.... Respondent

I. The Parties

The Complainant in this proceeding is Softnews NET SRL, a limited liability company, having its office at Aleea Suraia 4, Bldg. 21B, Entrance 1, 7th floor, Apt. 46, 3rd District, Bucharest, Romania, through its Authorised Representative, Ms. Shivani

Dhagat, Advocate, having office at B-55, VIP Estate, Khamardih, Vidhan Sabha Road, Raipur (Chhattisgarh) – 492001, India.

The Respondent is Arianna Bureau of Avenida del Valle 34, Madrid - 28003, Spain.
The Respondent is self-represented.

2. The Domain Name and Registrar

The disputed domain name is Softpedia.in. The Registrar of the said domain is IAPi GmbH (R98-AFIN)

3. Procedural Timeline

April 11, 2017 : The .INRegistry was inclined to appoint Mr. C.A. Brijesh as Sole Arbitrator from its panel as per paragraph 5(b) of INDRP Rules of Procedure. Arbitrator accorded his consent for nomination as Arbitrator and submitted Statement of Acceptance and Declaration of Impartiality and Independence to the .INRegistry.

April 19, 2017 : Parties to the dispute were informed of the constitution of the Arbitration panel and the effective date of handover. Further, NIXI forwarded the soft copy of the Complaint along with the annexures to the Respondent with a copy marked to the Complainant's Authorised Representative and Arbitral Tribunal.

April 20, 2017 : Arbitral Tribunal addressed an email to the Respondent, with a copy marked to the Complainant's Authorised Representative and NIXI, directing the Respondent to file its response, if any, within ten days.

April 27, 2017 : NIXI addressed an email to the Arbitral Tribunal, with a copy marked to the parties intimating that the courier containing the Complaint and the annexures was returned to them undelivered as the Respondent was unknown at the address provided in the Complaint. This Arbitral Tribunal requested

NIXI to confirm whether the Complaint along with the annexures were delivered to the Respondent on its email address.

April 28, 2017

NIXI addressed an email to the Arbitral Tribunal, with a copy marked to the parties intimating that the Complaint along with the annexures were successfully delivered to the Respondent at its email address; DOMAINSMART2@GMAIL.COM - which is as per the WHOIS records.

May 2, 2017

The Arbitral Tribunal addressed an email to the Respondent, with a copy to NIXI and the Complainant intimating that an Award shall be passed on the basis of the material available on record.

The language of the proceedings shall be English.

4. Factual Background

4.1 Complainant's Activities

The Complainant states, *inter alia*, that it is a Romanian company established in the year 2001 by two Romanian students, Cătălin Gârmacea and Bogdan Gheorghe. The Complainant is engaged in the business of providing a wide variety of services and associated goods under the trade mark SOFTPEDIA, including but not limited to electronic publications; providing online forums, online chat rooms, electronic bulletin boards for transmission of messages among users in the fields of IT software or hardware and general interest; audio, text and video broadcasting services over computer or other communication networks; providing online network service and providing consumer product information from searchable indexes and databases of information; providing temporary use of non-downloadable software applications; computer services in the nature of customized web pages; providing a web site featuring technology that enables online users to create personal profiles featuring social networking information and to transfer and share such information among multiple web sites. The

Complainant operates a website under the domain name softpedia.com viz. www.softpedia.com which comprises its mark SOFTPEDIA. The Complainant further states that through the said website, it offers downloads for a lot of games, driver programs, mobile phones and software for various operating systems, such as Windows, Macintosh and Linux. This website also classifies important news from computers, as well as technology, science, health and leisure, from both other sources and its own. The website hosts a forum as well and the SOFTPEDIA forum hosts the greatest Romanian community, approaching various thread subjects in an organized way: IT, telecommunications, multimedia, auto, social topics, health, real estate, tourism and other thread subjects of wide interest. Globally, Complainant's domain name is in the top of download portals.

The Complainant claims that as per Alexa Internet Inc., the Complainant's portal www.softpedia.com receives 19.6 million visitors per month which includes 11.9% visitors from India and is ranked #1422 globally and ranked # 892 in India. A perusal of **Annexure 2** evidences traffic data information.

4.2 Complainant's Use of 'SOFTPEDIA'

The Complainant has been using the mark SOFTPEDIA worldwide and in India since 2003. Since then, the Complainant has maintained a commendable presence on the internet, with electronic publications, online forums and related goods and services being launched under the trade mark SOFTPEDIA. Further, the Complainant states that the trade mark SOFTPEDIA is extensively and consistently used, applied for and registered in Classes 9, 35, 38, 41 and 42 in various jurisdictions around the world including Romania, U.S.A., WIPO, U.K., Australia etc. In India, the Complainant filed applications for registration of the mark SOFTPEDIA on February 23, 2017 under Nos. 3492415, 3492720 and 3492719 which are currently pending. To substantiate the claim, the Complainant has provided a few international registration certificates. A perusal of the annexures marked as **Annexure 3** and **Annexure 4** substantiate Complainant's aforesaid claims.

Further, the Complainant owns numerous domains all of which redirect to its main global corporate website www.softpedia.com. The Complainant has



provided names of a few of the said domains viz. Softpedia.at; Softpedia.bg; Softpedia.biz; Softpedia.cc; Softpedia.club; Softpedia.cn; Softpedia.co; Softpedia.co.id; Softpedia.co.il; Softpedia.co.in; Softpedia.com.tr; Softpedia.cz; Softpedia.de; Softpedia.dk; Softpedia.es; Softpedia.eu; Softpedia.fr; Softpedia.hk; Softpedia.info; Softpedia.it; Softpedia.me; Softpedia.mobi; Softpedia.net; Softpedia.org; Softpedia.pw; Softpedia.ro; Softpedia.tel; Softpedia.tw; Softpedia.us; Softpedia.xxx; Softpedia.com; Softpedia.com; Softpediacafe.com; Softpediacafe.net; Softpediacafe.ro; Softpediaclub.com; Softpediaclub.net; Softpediaclub.org; Softpediaclub.ro; Softpediaforum.com; Softpediaforum.ro; Softpediamall.com; Softpediamall.ro; Softpedianetwork.com; Softpedianews.com; Softpedianews.ro; Softpedianewsletter.com; Softpedia-secure-download.com; Softpedia-static.com. The aforesaid showcases that the Complainant's goods and services can be accessed over the internet by users from anywhere in the world, including India. The webpages of the Complainant's website www.softpedia.com marked as **Annexure 6** is on record and a perusal of the said document corroborates the claim of the Complainant in this regard.

The Complainant claims to exercise extreme vigilance in protecting its intellectual property rights and guards the trade mark SOFTPEDIA zealously. The decision from WIPO annexed at **Annexure-7**, internationally recognizing the well-known status of the trade mark SOFTPEDIA corroborates the Complainant's aforesaid claim.

Based on the aforesaid, it is the Complainant's assertion that the Complainant has extensively and consistently used its trademark(s) for a significant period of time, and keeping in view the fact of exhaustive worldwide presence of the Complainant, the said trade mark acquired cross-border reputation and became clearly distinctive to the Complainant's products and services. Through the efforts of the Complainant, the Complainant's trade marks SOFTPEDIA/**SOFTPEDIA** are associated throughout the world with quality and reliability for such services offered by the Complainant.

4.3 Respondent's activities and its use of SOFTPEDIA



The domain name softpedia.in was created on September 7, 2016 as is clearly discernible from the WHOIS records, registered in the name of the Respondent. **Annexure 1** confirms the same. Further, the Registrant maintains a website www.softpedia.in, which upon being accessed, is claimed to be redirected to a 'scam' website which further redirects to other spam websites. It appears that the Complainant has not annexed any document to corroborate the aforesaid. Further, the Complainant claims that the said domain name incorporates the Complainant's mark SOFTPEDIA. Further, the Complainant has asserted that the Respondent is engaged in cybersquatting and has registered other domain names comprising reputed trade marks such as 'hewlettpackard-enterprise.jp', 'naturevalley.at', etc. which is evident from **Annexure 8**. Further, the Complainant claims that the domain in question is available for sale to the public on the website www.sedo.com. The same is corroborated by the document marked as **Annexure 9**.

Given that the Respondent has not furnished a response to the Complaint, no further information is available on its business activities and/or its use of the domain comprising the Complainant's trade mark SOFTPEDIA.

5. Contentions of Parties as summarised in the pleadings

5.1 Complainant

a) **The Respondent's (Registrant's) domain name (Disputed Domain Name) is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights**

- i. The Complainant submits that the disputed domain name is identical with and/or confusingly similar to the Complainant's registered trade mark SOFTPEDIA. The disputed domain name incorporates and reproduces the Complainant's trade mark SOFTPEDIA in its entirety.
- ii. The Complainant's trade mark SOFTPEDIA has been used and associated with the Complainant since as early as the year 2001. The trade mark SOFTPEDIA has been used internationally since its foundation and has been accepted in India. Further, the Complainant is

the owner of many trademark registrations/applications, domain names and corporate/trading name incorporating predominantly the trade mark SOFTPEDIA.

iii. The Complainant has well-established rights in respect of the trade mark SOFTPEDIA. The reputation vesting in the trade mark SOFTPEDIA has been recognized and confirmed by WIPO as well.

iv. The Complainant submits that owing to the similarity between the Complainant's domain name and the disputed domain name, there is a high likelihood that a consumer would be led to believe that the Respondent is a branch/off-shoot of the Complainant in India, which is precisely one of the markets in which the Complainant's trade mark SOFTPEDIA is well-known. Thus, there is strong possibility that the consumers would perceive a nexus between the businesses of the Complainant and the disputed domain name/Respondent's website.

b) **The Respondent (Registrant) has no rights or legitimate interests in respect of the domain name**

i. It is the contention of the Complainant that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not making a legitimate, non-commercial or fair use of the disputed domain name.

ii. The Complainant submits that it has never assigned, granted, licensed, sold, transferred or in any way authorized the Respondent to register or make use of its trade mark SOFTPEDIA. Accordingly, the Respondent is neither a licensee of the Complainant nor has it otherwise obtained authorization of any kind whatsoever, to use the Complainant's trade mark.

iii. The Complainant asserts that the inclusion of the word "SOFTPEDIA" in the disputed domain name clearly reflects that the intention of the Respondent is to deceive the public into believing that some association exists between the Complainant and the Respondent. Further, the

Respondent's dysfunctional and scam website www.softpedia.in is bound to tarnish the goodwill and reputation enjoyed by the Complainant worldwide with respect to its high quality services under the trade mark SOFTPEDIA and eventually leading to its dilution.

iv. The Complainant submits that the Respondent neither offers any goods/services through the disputed domain name nor does it appear to have ever been activated.

c) **The domain name was registered and is being used in bad faith**

- i. The Complainant submits that it has a commendable presence across the globe including India through the services provided under its trade mark SOFTPEDIA which has resulted in the Complainant's mark acquiring significant reputation and substantial goodwill in respect of a range of products and services. The Respondent is bound to have knowledge of the world-renowned repute of the Complainant and hence has no reasons for adoption of a trade mark and domain name that is identical to the Complainant's trade mark SOFTPEDIA. The Complainant believes and asserts that the Respondent is fully aware of the use, goodwill and reputation of the Complainant's mark both in India and worldwide and has registered the disputed domain name completely in bad faith and with *mala fide* intention.
- ii. The Complainant submits that the Respondent is using the disputed domain name to intentionally attract internet users to its website or other on-line location, by creating a likelihood of confusion with the Complainant's trade mark SOFTPEDIA, as to the source, sponsorship, affiliation or endorsement of the impugned website www.softpedia.in.
- iii. The Complainant submits that the Respondent has acquired the disputed domain name to cash in on and unfairly profit from the considerable investment the Complainant has made in creating and maintaining the high profile and goodwill in the trade mark SOFTPEDIA for close to 16 years. Further indication of bad faith is the fact that the Complainant's



rights predate the Respondent's registration of the disputed domain name by about 15 years.

- iv. The Complainant further asserts that mere registration of the domain name similar to a well-known mark is evidence of Respondent's bad faith.

5.2 Respondent

As per the INDRP Rules of Procedure, NIXI forwarded a copy of the Complaint along with all annexures to the Respondent on April 19, 2017 with a copy marked to the Complainant and this Arbitral Tribunal.

On April 20, 2017, this Tribunal issued a notice to the Respondent directing it to file a response within 10 days. However, no response was received from the Respondent.

Absent a response from the Respondent thereto or any intimation by the Respondent of its desire to furnish a response, the matter has proceeded *ex-parte*.

6. Discussion and Findings

As per paragraph 4 of the .IN Domain Name Dispute Resolution Policy (INDRP), any person who considers that a registered domain name conflicts with his legitimate rights or interests may file a Complaint to the .INRegistry on the following premises:

- 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;
- ii. The Registrant has no rights or legitimate rights in respect of the domain name;
- iii. The Registrant's domain name has been registered or is being used in bad faith.

Based upon the pleadings, it is required to be examined as to whether the parties have been able to justify/rebut the aforesaid premises:

6.1 Identical or confusingly similar trade/service mark



As per the WHOIS records, the disputed domain name softpedia.in was registered on September 7, 2016.

The Complainant is the proprietor of the trade mark SOFTPEDIA in diverse Classes and has applications/registrations for the trade mark SOFTPEDIA in various jurisdictions of the world including India, U.S.A., WIPO, U.K., Australia, Romania etc. To substantiate the same, the Complainant has placed on record copies of registration certificates from various jurisdictions for the trade mark SOFTPEDIA, the earliest dating back to July 2004. In India, the Complainant's trade mark applications are currently pending. Further, the Complainant also claims to have registered the domain name softpedia.com, as well as India specific domain name softpedia.co.in at prior point in time. It claims to have been substantially and continuously using the trade mark SOFTPEDIA in relation to its business/products/services.

The disputed domain name incorporates the trade mark SOFTPEDIA in its entirety. It has been held in *Inter-Continental Hotels Corporation vs. Abdul Hameed* (INDRP/278) as well as in *Indian Hotels Company Limited vs. Mr. Sanjay Jha* (INDRP/148) that when a disputed domain name incorporates a mark in entirety, it is adequate to prove that the disputed domain name is either identical or confusingly similar to the mark. Similarly, in case of *Farouk Systems Inc. vs. Yishi*, WIPO Case No. D2010-006, it has been held that the domain name wholly incorporating a Complainant's registered mark may be sufficient to establish identity or confusing similarity, despite the additions or deletions of other words to such marks. It was also held in *Continent Hotels, Inc. vs. The Omnicorp*, WIPO Case No. D2005-1249 that the fact that a domain name wholly incorporates a Complainant's registered mark is sufficient to establish identity or confusing similarity for purposes of the Policy.

As can be seen from above, the Complainant has claimed to have registered the domain name softpedia.com (in the year 2003); trade mark SOFTPEDIA in various jurisdictions with the earliest dating back to 2004 and is doing/operating business/website under the said domain names. The Respondent on the other hand registered the domain softpedia.in much subsequent to the Complainant.



In the view of the foregoing discussions, the Complainant has satisfied this Tribunal that:

- i. The domain name in question softpedia.in is phonetically as well as visually identical to the Complainant's trade mark SOFTPEDIA and that the ccTLD ".in" does nothing materially to distinguish the same from Complainant's mark SOFTPEDIA; and
- ii. It has prior proprietary rights in respect of the trade mark SOFTPEDIA.

6.2 Rights and legitimate interests

The Complainant has asserted that the Respondent has no rights or legitimate interests in the disputed domain name. Paragraph 7 of the INDRP enumerates three circumstances (in particular but without limitation) and if the Arbitrator finds that the Registrant has proved any of the said circumstances, the same shall demonstrate its rights to or legitimate interest in the disputed domain name. The said paragraph is reproduced herein under:

“Registrant's Rights to and Legitimate Interest in the Domain Name - Any of the following circumstances, in particular but without limitation, if found by the Arbitrator to be proved based on its evaluation of all evidence presented, shall demonstrate the Registrant's rights to or legitimate interest in the domain name for the purposes of Paragraph 4 (ii):

- i. 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 with a bona fide offering of goods or services;
- ii. The Registrant (as an individual, business, or other organisation) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or



- iii. 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.”

The Respondent ought to have been aware of the reputed trade mark SOFTPEDIA of the Complainant. There is no documentary evidence to suggest that the Respondent has used or made demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with *bona fide* offering of goods/services; or is commonly known by the disputed domain name; or has made fair use of the domain name. On the other hand, the Respondent’s website is dysfunctional.

The Complainant has relied on the decision in *Six Continents Hotels, Inc. v. Patrick Ory*, WIPO Case No. D2003-0098 wherein it was held that “*there is no evidence of any commercial relationship between the Complainant and the Respondent which would entitle the Respondent to the mark. Consequently, the Panel concludes that the Respondent has no rights nor legitimate interests in the Domain Name given there exists no relationship between the Complainant and the Respondent that would give rise to any license, permission or authorization by which the Respondent could own or use the Domain Name*”.

It is also a well-settled position that the “*registration of a domain name that incorporates a reputed mark by an entity that has no relationship to the mark is evidence of bad faith [The Ritz Carlton Hotel Company LLC vs. Nelton! Brands, Inc. INDRP/250]*”.

Further, as observed by the panel in the case of *International Hotels v. Abdul Hameed* (INDRP/278), it is well established, that trade mark registration is recognised as *prima facie* evidence of rights in a mark. Complainant, in the instant case, is the owner of the prior registered trade mark SOFTPEDIA in various jurisdictions in the world; has a ‘.com’ registration for the same since 2003; and has prior trade mark applications for registration in India and thus has sufficiently demonstrated its rights in the trade mark SOFTPEDIA.

In view of the foregoing, it is evident that Respondent has no rights or legitimate interests in the disputed domain name.

6.3 Bad faith

Paragraph 6 of the INDRP enumerates the circumstances evidencing registration and use of domain name in bad faith. The said paragraph is reproduced herein under:

"Evidence of Registration and use of Domain Name in Bad Faith: For the purposes of Paragraph 4(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:

- i. 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
- ii. 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
- iii. by using the domain name, the Registrant has intentionally attempted to attract Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location."

The very fact that the domain name in question has been parked at www.sedo.com which is a domain name online market place and parking provider with an offer of



USD 6999 clearly indicates Respondent's illegitimate interest in monetary gains which evidences bad faith.

Further, the Respondent has registered/renewed domain names comprising reputed brands such as 'hewlettpackard-enterprise.jp', naturevalley.at' etc. which shows the *mala fide* conduct of the Respondent engaged in the business of cyber squatting. The said factor also contributes towards establishing bad faith.

The website being dysfunctional, clearly depicts that the Registrant has registered the domain name to cash in on and unfairly profit from the considerable investment the Complainant has made in creating and maintaining the high profile and goodwill in the trade mark SOFTPEDIA for close to 16 years.

In view of the foregoing, this Arbitral Tribunal is of the view that the Respondent has registered the domain name 'softpedia.in' in bad faith.

7. Award

From the foregoing findings, it is established beyond doubt that (1) the domain name is confusingly similar to the trade mark SOFTPEDIA which is proprietary to the Complainant; (2) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and (3) the domain name is registered in bad faith.

Thus, in accordance with the Policy and Rules, this Arbitral Tribunal directs the Respondent to immediately transfer the disputed domain name softpedia.in to the Complainant.

The parties shall bear their own cost.

Dated: June 22, 2017



C.A. Brijesh
Sole Arbitrator