



दिल्ली DELHI

S 403193

RANJAN NARULA
ARBITRATOR

Appointed by the .In Registry – National Internet Exchange of India

In the matter of:

AbeBooks Inc.
655 Tyee Road Suite 500
Victoria BC V9A 6X5 Canada

...Complainant

Mr. Ankit Gulati
AbeBooks.in
-60, Phase-10
Chandigarh-160019

...Respondent

AWARD

1) The Parties:

The Complainant is **Abebooks Inc.**, 655 Tyee Road, Suite 500, Victoria BC V9A 6X5, Canada. The Complainant is represented by its authorized representative Mr Vikrant

Rana of S. S. Rana & Co., 317 Lawyers Chambers, High Court of Delhi, New Delhi-110003, who have submitted the complaint against the domain. The Respondent is Mr Ankit Gulati, SCO-60, Phase-10, Chandigarh-160019 represented by his authorised representative Vinod Khurana of Khurana & Khurana Advocates & IP Attorneys, IFAI centre, S/20-22, Greater Noida Shopping Plaza, Plot No. 7/2, UPSIDC Site-IV, Kasna Road, Greater Noida-201308, India.

2) The Domain Name, Registrar & Registrant:

The disputed domain name is www.abebooks.in. The Registrar is Rediff.com India Limited. The registrant is Mr. Ankit Gulati (Respondent).

3) Procedural History:

The Complainant filed this complaint with the .IN Registry and the .IN Registry appointed "Ranjan Narula" ("The Arbitrator") as the Sole Arbitrator under clause 5 of its policy on, December 09, 2011. The complaint was produced before the Arbitrator and following email confirmation to NIXI on no conflict of interest, the Arbitrator submitted his statement of acceptance and declaration of impartiality and independence. The notice was issued to the Respondent on December 13, 2011 at his email address with a deadline of 10 days to submit his reply to the arbitration. On December 21, 2011 the Respondent's representative sought for an extension of 7 days to file a response. The Arbitrator allowed the same and extended the deadline to file a reply till January 03, 2012. Subsequently, the Respondent filed his response vide email dated January 03, 2012 and the Complainant filed a rejoinder thereto vide email dated January 23, 2012. Thereafter the Respondent was given an opportunity to file its comments to the new evidence submitted by the Complainant. The Respondent thus filed another response vide email dated February 03, 2012.

Since both parties have filed their respective submissions/ contentions, the Arbitrator is proceeding to decide the present dispute. In view of a number of supplemental submissions filed by the parties and voluminous documents and pleadings submitted by both parties, the award could not be passed within 60 days as provided in Rule 5 c of the INDRP rules of procedure.



4) Summary of the Complaint's contentions in the Complaint:

- i. That the Complainant, its partners, licensed affiliates, subsidiaries, etc have for over 15 years been engaged in the business of providing an online marketplace for sale of books through the various 'Abebooks' mark containing websites all of which have been under the trademark 'AbeBooks'.
- ii. That the 'AbeBooks' (formerly Advanced Book Exchange, Inc.) has been engaged in this business since 1995 and have also used it as a trademark internationally for over 15 years. The website abebooks.com went live in 1996 and immediately began to transform the World's used book business by making hard-to-find books easy to locate and purchase. The Complainant submits that the AbeBooks websites currently lists over 45 million books sourced from more than 11000 independent booksellers and further the independent booksellers who provide a source of books for listings via the Complainant's website are distributed through 44 countries worldwide.
- iii. That the Complainant has made substantial investments to promote its goods and services and because of their efforts they have been featured/ advertised in a wide variety of media, including newspapers, magazines, satellite TV channels as well as on the Internet. The detailed list of awards won by the complainant has been provided in the Complaint.
- iv. That in addition to being one of the best in the rare book category, the Complainant's sales through e-commerce transactions have extended to 50 countries including India with 6.22 million hits per day and 185000 transactions on average per month, further they claim to have 163 independent booksellers located in India, list provided in the complaint along with the statistics of buyers from India from the year 2005-2010.
- v. That along with helping people find books, Complainants portal also allows students to find cheap text books for years and as a responsible corporate citizen, the Complainant regularly participates in different charity and fundraisers events and activities, list of the activities is included in the complaint.



- vi. That the Complainant adopted the trademark 'AbeBooks' in the year 1995 and has been using it continuously and extensively, not only on trademark but also as a prominent key, and leading portion of its corporate name.
- vii. That the Complainant has applied in India of the trademark 'Abebooks'. The Complainant's registration for said mark is in Class 9 and 35 and bears the application Nos. 2103842 and 2103843. That the Complainant is also the proprietor, in other countries, of the following trademark registrations:

ABEBOOKS (US Reg. 2682429) in Class 9 and 35; ABEBOOKS (US Reg. 2825209) in Class 35; ABEBOOKS.COM (US Reg. 3016106) in Class 9; ABEBOOKS.COM(AUSTRALIA Reg. 941828) in Class 9, 35, 42; ABEBOOKS (CANADA Reg. 583514) in Class 9 and 35; ABEBOOKS.COM(CANADA Reg. 613322) in Class 9 and 35; ABEBOOKS.COM (CTM Reg. 4679072) in Class 16,35 and 41.
- viii. That the Complainant does not hesitate to initiate legal action against parties in order to protect its mark and had filed a domain name case under UDRP with the WIPO in respect of domain name www.abebbooks.com.au and was successful in securing the same.
- ix. That the Complainant at present owns a number of domain names, the majority of which contain the 'AbeBooks' mark. A list of the domain names which are claimed to be owned by the Complainant have been attached with the Complaint.

5) Summary of Registrant's/ Respondent's response

By way of email dated 03 January 2012, the Registrant/ Respondent filed their response to the complaint filed by the Complainant. The Respondent's allegations/submissions are summarized as under:

- i. That the Respondent has been in the business of selling books from the year 2005 and had applied for registration of the domain name 'abebbooks.in' on February 08, 2008, further has enjoyed successful uninterrupted business since then;
- ii. That the Respondent has further mentioned that the business further boosted its sales from the year 2008 to 2011 as evidenced from the Balance sheet and P/L accounts provided in the response;



- iii. That Respondents website is only meant for India;
- iv. That the Respondents mark is "Abebooks.in" which is an abbreviation of the phrase ' All Books Everywhere';
- v. That the Respondent has used the domain for the last 4 years, and that '.in' domains are meant to cater people of India;
- vi. That the Respondent has filed his application for registration of trade mark "abebooks.in" under application No. 1948616 on April 09, 2010;
- vii. That the Respondent owns and uses the domain name in good faith, and to promote Indian book sellers.
- viii. The Respondent has further provided evidence of the fact that the Complainant is not so well known in India and has been a part of legal tussles in the past.

6) Further submissions/ contentions raised by both parties

The Complainant filed their rejoinder to the Respondent's reply, by way of email dated 23 January, 2012. The key contentions raised by the Complainant in their rejoinder are summarized below:

- i. That domain names are accessible anywhere in the world, and not just in India;
- ii. That the Complainant has provided information/ service to its users through the internet since the year 1996;
- iii. The mark 'AbeBooks' and 'Abebooks.com' is registered as a trademark in various classes in different countries.
- iv. The mark 'AbeBooks' is not a mere dictionary word and that it is a registered trade mark. Further, that the 'AbeBooks' have become exclusively associated with the Complainant.
- v. The Respondent has also registered a domain name www.abebooks.co.in which also consists of the prominent part of the Complainant's trade name, further the



Complainant has also filed a complaint against the mentioned domain and the same is pending disposal.

vi. In the aforesaid rejoinder the Complainant along with their submission refuted all the Respondent's contentions and reiterated their earlier submissions.

By way of email dated 03 February 2012, the Respondent filed a reply to the rejoinder and further to the Complainant's contentions. The key submissions made by the Respondent are summarized below:

- i. That he registered the domain www.abebooks.in as it was short for "All Books Everywhere" and was the most appropriate abbreviation;
- ii. That the Respondent was not aware of the Complainant's website www.abebooks.com or the mark 'AbeBooks' as they had no visible presence in India;
- iii. That the Complainant's mark does not fit into the criteria to be called a 'well known' mark;
- iv. That the Respondent has invested extensively use of his website for selling of books and related services in the last 4 years;
- v. That the Complainant's website only gained recognition only after it was taken over by Amazon in the year 2008;
- vi. That the Complainant has attempted to register the mark 'recently' in India with a view to usurp the Respondent's domain name;
- vii. That the Respondents website abebooks.in is well know evidenced from the fact that the search result on Google gives the second most visited website as that of the Respondents;
- viii. In the aforesaid reply to the rejoinder the Respondent along with their submission refuted all the Complainant's contentions and reiterated their earlier submissions.



7) Discussions and Findings:

Having perused the submissions and documentary evidence placed on record, the Arbitrator is inclined to agree that the Complainant has established better and prior rights in the mark 'AbeBooks'. Further, the Arbitrator is of the view that the Complainant has satisfied all three conditions outlined in paragraph 4 of the Policy, viz. –

- A. The Domain Name is identical or confusingly similar to the trade mark/ name 'AbeBooks' in which the Complainant has the rights;
- 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 holds this view for the reasons discussed in the paragraphs below:

A. The Domain Name is identical or confusingly similar to the trade mark/ name AbeBooks in which the Complainant has rights

The Complainant is prior to the Respondent in their adoption and use of the trade mark 'AbeBooks'. The Complainant has for over 15 years been engaged in the business of providing an online marketplace where books of various categories are offered for sale through their website from thousands of booksellers around the world, all of which have been under the trademark 'AbeBooks'. The aforesaid mark also forms an integral part of the Complainant's corporate name. The Complainant's services are available across several countries including Canada, Australia, USA etc. Further, the Complainant has spent large sums of money for advertising/ marketing/ promoting their services. In addition to the foregoing, the Complainant owns registrations for the mark 'AbeBooks' in the U.S. and other countries as mentioned in paragraph 3 of the Complaint. It is pertinent to note that the earliest registration dates back to the year 2003, and use has been claimed since 1999. Even in India, the Complainant has applied for registration the mark 'AbeBooks' under application nos. 2103842 and 2103843 in class 9 and 35. Thus, the Complaint has successfully demonstrated their rights in the mark 'AbeBooks'.



On the other hand, the documents/evidence on record indicate that the Respondent adopted the domain not earlier than February 08, 2008, which is much subsequent to the Complainant's adoption and use of the trade mark 'AbeBooks'. In the Arbitrator's view, the Respondent has not offered any plausible or credible explanation for his adoption of a domain name which is identical/ confusingly similar to the Complainant's registered mark. The Respondent has merely stated that he is entitled to do so because he is of Indian origin and that he wishes to promote books through a country specific domain name www.abebooks.in wherein "AbeBooks" is abbreviated for "All Books Everywhere". The Arbitrator finds that this explanation is insufficient to establish the Respondent's rights in the mark 'AbeBooks', or his bona fides in adoption when considered that Respondent is in the same business and has the same business model.

In addition to the foregoing, it is also contended that the mark 'AbeBooks' is a coined word, and that the Respondent does not have any rights over the said mark. In the absence of any evidence to believe otherwise the Arbitrator finds this statement to be true, especially considering that the Complainant's mark 'AbeBooks' is a not a commonly used word in relation to book trade.

In view of the foregoing, the Arbitrator finds that the documents on record are sufficient to establish that the Domain Name is identical or confusingly similar to the Complainant's mark 'AbeBooks' and that the Complainant has better rights in the domain name.

B. The Registrant has no rights or legitimate interests in respect of the domain name

According to the Policy, the following circumstances, in particular but without limitation to, shall demonstrate the Registrant's rights to or legitimate interests in the domain name for the purposes of Paragraph 5 (ii):

- (1) *"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;"*



In this case, the Respondent has registered the disputed domain name in the year 2008, which is much subsequent to the Complainant's adoption and use of the mark 'AbeBooks' in respect of similar products/ services. There is no evidence to suggest that the Complainant had authorized or licensed the Respondent's registration or use of the Domain Name. For the reasons already mentioned in the preceding paragraphs of this decision, the Arbitrator finds that the Respondent has also not offered any plausible reason or justification for registering or using the identical Domain Name in the same trade.

In addition to the foregoing, the Respondent's Domain Name resolves to a page bearing contents that relate to services/ products that are directly competing with the Complainant's. Although the Respondent has contended that his website only caters to India, a mere perusal of the website shows that it also caters to Indian subcontinent. The Arbitrator finds that the Registrant contention in this regard belies the actual content on the website.

- (2) *"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"*

The Respondent's name is Mr Ankit Gulati. There is no evidence to suggest that the Respondent, at any point in time, has been commonly known by the name 'AbeBooks'. 'AbeBooks' is the mark of the Complainant.

- (3) *"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."*

For the reasons mentioned in the preceding paragraphs, the Arbitrator also finds that Respondent is not making a legitimate non-commercial or fair use of the Domain Name. The said Domain Name currently resolves to a page featuring services/ products which are directly competing with the Complainant's. Such use supports the Complainant's position that the Respondent is not making 'a legitimate non-commercial or fair use' of the Domain Name. The evidence adduced by the Complainant supports the claim that the Respondent has



adopted the Domain Name with intent for commercial gain, and to divert internet users to their website.

Based on the submissions/ evidence made by both parties, the Arbitrator finds that the Respondent has not been able to establish their rights or legitimate interests in the Domain Name.

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

As per the Policy, the following circumstances, in particular but without limitation, shall be evidence of the registration and use of a domain name in bad faith:

"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."

As mentioned earlier, the Respondent's Domain Name currently resolves to a webpage featuring services/ products which are directly competing with the Complainant's. By use of the Complainant's mark 'AbeBooks', it appears that the Respondent has deliberately tried to attract internet users to his website. Thus, the Arbitrator finds that there is a likelihood that Internet users will be confused as to the source, sponsorship, affiliation, or endorsement of the Respondent's website and the services advertised on it considering the Complainant's prior use and adoption of an identical mark/domain name.

The aforesaid circumstances suggest bad faith registration and use of the Domain Name by the Respondent.



8) Decision:

For all the reasons discussed above, the Arbitrator orders that the domain name <www.AbeBooks.in> be transferred to the Complainant.



RANJAN NARULA
SOLE ARBITRATOR
NIXI
INDIA

27 February 2012