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S.V.L.NO.2/2005, H.NO.25/3 RT.
BESIDE UDIPI HOME COMPLEX
OPP. CHAITNYA COLLEGE
S.R. NAGAR
HYDERABAD - 500 038
AP-23/GSO/KL-(PB)-21/2005



BEFORE THE NATIONAL INTERNET EXCHANGE OF INDIA
ARBITRATION AWARD

In The Matter Between

Yahoo! Inc.

Complainant

Versus.

Yaquooob Yousif

Respondent

1. The Parties

The Complainant is Yahoo! Inc. of 701 First Avenue, Sunnyvale California 94089, United States of America represented in these proceedings by Gunjan Paharia of Zeus IP Advocates C-4 Jangpura Extension, New Delhi India.

The Respondent is Yaquooob Yousif . The contact details of the Respondent as per the record is Manama , Baharin 32621.

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2. The Domain name, Registrar and Policy

The present Arbitration pertains to the domain name <maktoob.in> registered by the Respondent. The sponsoring registrar for the disputed domain name is Enom Inc.

The Arbitration Proceeding is conducted in accordance with the Arbitration and Conciliation Act of 1996 (India), the .IN Domain Name Dispute Resolution Policy (the “INDRP Policy” or “Policy”), and the INDRP Rules of Procedure (the “Rules”).

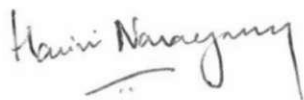
3. Procedural History

The sole arbitrator appointed in the case is Mrs. Harini Narayanswamy. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, in compliance with the Rules.

The Arbitrator received the Complaint from the .IN registry on June 21, 2012 and on June 22, 2012 transmitted by email a notification of commencement of the arbitration proceedings to the Respondent. Under the INDRP Rules, copies of the said notification were sent to other interested parties to the dispute. The Respondent was given twenty-one days time from the date of the notification to file a response. The Respondent did not reply to the notification or file any response in these proceedings. Based on the material on record the Arbitrator now proceeds to determine the case on its merits.

Factual Background

The Complainant is an internationally well-known digital media company and its business includes developing content covering news, online gaming, shopping, photo sharing and finance. The Complainant uses the trademark MAKTOOB in connection with its business and has provided details of its trademark registrations for the said mark in several countries.



The Complainant has submitted documents of its trademark registration in the United States of America bearing numbers 2,563,368 and 2,563,369 under classes 35, 38, and 42, where its first use in commerce is from October 1998. The Complainant has also provided details of its trademark registration in the countries of the Middle East including Bahrain, where the Respondent resides.

The Respondent registered the disputed domain name <maktoob.in> on November 19 2007.

4. Parties contentions

A. Complainant's Submissions

The Complainant submits that its website is one of the most visited Internet destinations worldwide and claims it is the second most popular electronic mail service provider in the world. The Complainant further states that it has continuously used its trademark "YAHOO!" since 1994. The Complainant asserts its YAHOO! mark is a well-known brand and is among the top 100 global brands as per "BRANDZ Top 100 Most Powerful Brands" report (2008 -2009) by Milward Brown in co-operation with Financial Times.

The Complainant states that Yahoo's products are offered free to the public and its income is derived from sale of advertisements and from co-branding or sponsorship agreements with other companies. Much of its advertisement appears on web pages through "YAHOO!" and through its co-branded websites such as YAHOO! MAKTOOB, YAHOO! GAMES, FLICKER FROM YAHOO! BABEL FISH and ASSOCIATED CONTENT FROM YAHOO!. The Complainant claims it sells sponsorships, promotions and a wide array of marketing services to its clients including displaying advertisements for numerous companies including the "Fortune 100 companies". It also receives revenues from an array of electronic commerce transactions originating from several of its websites, as well as certain premium services such as website hosting. Due to the success of its products and services and its co-branded

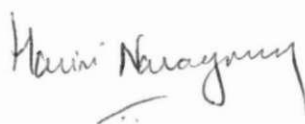
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services the Complainant claims it is the subject of much third party press and media attention through out the world. The Complainant states that Yahoo is regularly covered in major media outlets including The New York Times, The Wall Street Journal, The Washington Post, Time Magazine, Newsweek, Business Week, Associated Press, Reuters, MSNBC, CNN and Bloomberg because of the success and popularity of its website and products.

The Complainant states that Maktoob.com was founded in the year 2000 and started offering a variety of Internet based goods and services under the name MAKTOOB.COM. In the year 2010 Maktoob.com assigned the MAKTOOB trademark including its interests and goodwill in the mark, the trademark registrations pertaining to MAKTOOB and domain names formed with the MAKTOOB mark to the Complainant. The Complainant has furnished documents showing the assignment of the MAKTOOB trademark in its favor. The Complainant therefore claims that it has used the said mark since 2000 along with its predecessor in interest. The Complainant further alleges that the MAKTOOB website is highly visited and that it is the Arab world's largest web portal and online community. According to its internal web traffic measurement, the Complainant claims that more than 50,000 unique visitors from India have viewed over 80,000 MAKTOOB branded WebPages.

The Complainant states the success and popularity of its website products and services offered from Maktoob.com is the subject of third party press and media attention throughout the world. Accordingly the MAKTOOB mark is well known and famous in India and through out the world. The Complainant further states that it had sent cease and desist letters to the Respondent in June 2011 and July 2011 and received no reply. Both letters sent to Respondent by the Complainant were returned as undeliverable.

The Complainant contends that the disputed domain registration meets the three criteria for obtaining a remedy under the INDRP Policy: First, that the name is identical or confusingly similar to its registered trademark MAKTOOB due to the distinctive and arbitrary nature of the mark. Second, the Respondent has no rights and legitimate



interests in the domain name, as MAKTOOB is not the personal name or the trading name of the Respondent and the Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods or services but has registered the disputed domain name based on the Complainant's mark to mislead consumers. Third, the Respondent has registered the disputed domain name in bad faith as the Respondent has intentionally attempted to attract Internet users to the Respondent's website or other online location, by creating a likelihood with the Complainant's mark and seeks to exploit the fame associated with its marks to attract Internet users. Further, the Respondent has given false and incomplete Whois information that constitutes a breach of the Registration agreement and the Respondent has neglected his duty of verifying that the domain name registration does not violate third party rights argues the Complainant.

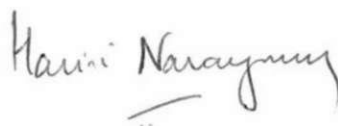
The Respondent's bad faith acts include the registration of a domain name on November 19, 2007 with knowledge of the Complainant's famous mark that is a registered trademark in USA and Bahrain. The Complainant further argues that the Respondent has been using the disputed domain name for pay per click links to third party sites and has submitted the print out of the website used by the Respondent from the year 2008 to 2012. The Complainant asserts that these facts show the disputed domain name was registered and is being used in bad faith by the Respondent and therefore requests for the transfer of the disputed domain name for the above stated reasons.

Respondent's Submissions

The Respondent has not filed a response in these proceedings.

Discussion and Findings

Under the .IN Policy, the registrant of the domain name is required to submit to a mandatory arbitration proceeding in the event that a complaint is filed in the .IN Registry, in compliance with the .IN Policy and the INDRP Rules.



The .IN Policy, Paragraph 4 requires the Complainant, to establish the following three elements:

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

Identical or Confusingly Similar

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

The Complainant has established its prior rights in the trademark MAKTOOB in these proceedings by furnishing details of its trademarks registrations in several countries. Furthermore, the Complainant has also furnished copies of its trademark registration documents in the USA and in Bahrain, the country where the Respondent is located.

If a trademark is found in its entirety in a disputed domain name, it is sufficient to establish that the disputed domain name is identical or confusingly similar to the mark. See for instance *G.A Modefine S.A v. Naveen Tiwari* , INDRP / 286 (February 20, 2009 and *L'Oreal v. Zeng Wei* <loreal-paris.in>, INDRP/342 (May 3, 2012) . In the present case, the disputed domain name is found to be identical to the Complainant's mark, and as argued by the Complainant, as the mark is an arbitrary and distinctive mark it further contributes to the confusing similarity of the disputed domain name with the mark.

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The country code top-level domain (cc TLD) “.in” suffix also does not lessen the confusing similarity of the domain name with the trademark. See *Morgan Stanley v. Bharat Jain*, INDRP Case No. 156 dated October 27, 2010.

For the reasons discussed, the Complainant is found to have satisfied the first element under paragraph 4 of the Policy, that the disputed domain name is identical to the trademark in which the Complainant has established rights.

Rights and Legitimate Interests

The second element requires the Complainant to show that the Respondent has no rights and legitimate interests in the disputed domain name.

The Complainant has asserted that the Respondent has no rights or legitimate interests in the disputed domain name for the following reasons: (a) The MAKTOOB mark is well known and is widely used and associated with the Complainant (b) The Respondent is not commonly known by the disputed domain name and (c) The Respondent has not used the disputed domain name for *bona fide* purposes, but uses it to mislead the public.

Under Paragraph 7 of the Policy, a respondent or a registrant can establish rights in the domain name, if (i) before notice of the dispute, the registrant had used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services or (ii) the registrant (as an individual, business organization) has been commonly known by the domain name, or (iii) The registrant is making legitimate, non commercial fair use of the domain name without any commercial gain.

The Respondent has not responded in these proceedings and has not provided any material to show rights in the disputed domain name. The Complainant has furnished evidence that the Respondent has been using the disputed domain in connection with third party pay per click links. Such use is not recognized as legitimate use in numerous previous domain name cases, particularly if the domain name is found to be identical or



confusingly similar to a well-known trade mark, See for instance *Mobile Communication Service Inc. v. WebRegRN*, WIPO Case NoD2005-1304, or *Gerber Products Co. v. La Porte Holdings*, WIPO Case No. D2005-1277.

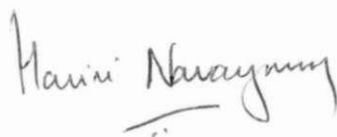
The Arbitrator finds the material on record does not show the Respondent is commonly known by the disputed domain name. If the Respondent does not put forward any evidence that it is known by the disputed domain name, it is a strong basis to infer that the Respondent lacks rights. See *Starbucks Corporation v. Mohan Raj* INDRP Case 118, (<starbucks.co.in> November 26, 2009). Further, there is no indication from the material on record that the Respondent is using the disputed domain name in connection with a *bona fide* offering of goods or services, or for any legitimate noncommercial fair use purposes. The use of the Complainant's mark in the disputed domain name in the Arbitrator's view is likely to mislead the public and does not meet the criteria of legitimate use under the Policy.

The Arbitrator finds the Complainant has made a *prima facie* case that the Respondent lacks rights and legitimate interests in the disputed domain name and has satisfied the second element under paragraph 4 of the Policy.

Bad Faith

Under the INDRP Policy the Complainant is required to establish that the domain name was registered or is being used in bad faith.

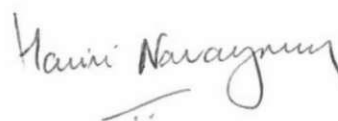
The Complainant has *inter alia* asserted that the Respondent has registered and has used the disputed domain name in bad faith for the reasons: that the Complainant has well-established rights in the trademark MAKTOOB and the Respondent has intentionally attempted to attract users by creating a likelihood of confusion with the Complainant's mark as to source of endorsement and affiliation; The Respondent has provided false and incomplete contact information for the Whois records.



The Complainant has clearly established its prior trademark rights and that its trademark applications were made in the year 2000, whereas the disputed domain name was registered in November 2007. The Complainant has also filed documents that show the first use of its MAKTOOB trademark dates back to 1998. The evidence therefore clearly shows the Complainant and its predecessor in interest has adopted and used the trademark for about nine years prior the disputed domain name registration. It can therefore be reasonably inferred that the Respondent who is residing in Bahrain was aware of the Complainant's prior rights in the mark at the time the disputed domain name was registered. Taking into account these facts and circumstances, the registration of the disputed domain name appears to be a deliberate use of a recognized mark to attract unsuspecting Internet users to the Respondent's website. Registration of a domain name, based on awareness of a complainant's trademark rights is indicative of bad faith registration under the Policy. See *Worckhardt Limited v. Kishore Tarachandani* INDRP Case No. 382, August 14, 2012 (<wockhardt.in>), where it was found that a domain name registration that is based on the Respondent's presumed knowledge of the Complainant's rights leads to the inference that the Respondent intends to target the trademark rights of the complainant.

The evidence furnished by the Complainant shows the Respondent has used the disputed domain name in connection with pay per click links. It can be inferred from the facts discussed, that the Respondent has registered the disputed domain name to obtain undue advantage of the goodwill and fame associated with the Complainant's trademark. The registration and use of a domain name that exploits the goodwill and fame of another's trademark is an indication of bad faith registration and use. See *Bloomberg Finance L.P v. Domain Admin / Bharat DNS Pvt Ltd.*, INDRP / 365 August 13, 2012 <bloombergnews.in>.

Under Paragraph 6 (iii) of the Policy, if the registrant of the domain name in dispute, has used the domain name to intentionally attract Internet users to the Registrant's website or other online location by creating a likelihood of confusion with the trademark of another, it is considered evidence of bad faith. The Arbitrator finds the circumstances here



suggest that there is no reasonable explanations for the registration and use of the disputed domain name except that the Respondent seeks to exploit the reputation and goodwill associated with the Complainant's mark in the manner mentioned under Paragraph 6 (iii) of the Policy and by registering and using the disputed domain name the Respondent has acted in disregard of the Complainant's prior rights in the MAKTOOB mark.

Accordingly the Complainant has satisfied the third element under paragraph 4 of the Policy.

Decision

The Complainant has established the disputed domain name is identical or confusingly similar to a mark in which it has rights, the Respondent lacks rights or legitimate interests in the disputed domain name and the disputed domain name has been registered or is being used in bad faith. The Complainant has successfully established these three grounds required under the Policy to succeed in these proceedings.

For the reasons discussed, it is ordered that the disputed domain name: <maktoob.in> be transferred to the Complainant.



Harini Narayanswamy

(Arbitrator)

Date: August 21, 2012