

REGISTRANT / RESPONDENT	Jing Ren Wuchang Mingzhulu Wuhan Hubei 430 021. CN
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IN THE MATTER OF DISPUTED DOMAIN NAME: - 'TIKTOK.IN'

ARBITRATION PANEL: - MR.S.C.INAMDAR, B.COM. LL.B., F.C.S.
SOLE ARBITRATOR

**DELIVERED ON THIS 2nd DAY OF JULY TWO THOUSAND TWENTY AT
 PUNE, INDIA.**

I] SUMMARISED INFORMATION ABOUT THE DISPUTE: -

SR. NO.	PARTY TO THE DISPUTE	NAME	ADDRESS
01	COMPLAINANT	ByteDance Ltd.	P. O. Box 31119, Grand Pavilion, Hibiscus Way, 802 West Bay Road, Grand Cayman. KYI -1205 Cayman Islands
02	AUTHORISED REPRESENTA TIVE OF THE COMPLAINANT	Paddy Tam CSC Digital Brand Services Group AB	Drottninggatan 92-94, 111 36 Stockholm, Sweden
03	RESPONDENT / REGISTRANT	Jing Ren	Wuchang Mingzhulu Wuhan Hubei 430 021. CN
04	DOMAIN NAME REGISTRAR	Dynadot LLC	P.O.Box 345, San Mateo CA 94401, United States of America

II] CALENDER OF MAJOR EVENTS:-

Sr. No.	Particulars	Date (All communications in electronic mode)
01	National Internet Exchange of India (NIXI), Ministry of Communications and Information Technology, Government of India referred the case for Arbitration to me	22.05.2020

02	Acceptance was given by me to undertake arbitration proceedings	22.05.2020
03	PDF files of Complaint and Annexures were received from NIXI through internet	28.05.2020
04	Notice of Arbitration issued, with the period to file reply by the Respondent, if any, latest by 10.06.2020	01.06.2020
05	Respondent's reply received	09.06.2020
06	Complainant was asked to file rejoinder, if any, latest by 15.06.2020	10.06.2020
07	Complainant's rejoinder received	12.06.2020
08	Respondent was asked to file rejoinder, if any	13.06.2020
09	Respondent filed his rejoinder	18.06.2020
10	Complainant was asked to file his sur-joiner, if any, latest by 21.06.2020	18.06.2020
11	Since no sur-joiner was filed by the Complainant, Notice of Closure of Arbitration was sent	24.06.2020
12	Award passed	02.07.2020

III] PARTICULARS OF DISPUTED DOMAIN NAME & REGISTRATION:

1. Disputed domain name is 'TIKTOK.IN'.
2. Date of registration of disputed domain name by Respondent is 01.09.2018
3. Registrar is Dynadot LLC

IV] PROCEDURE FOLLOWED IN ARBITRAION PROCEEDINGS: -

- 1) Arbitration proceedings were carried out as per .In Domain Name Dispute Resolution Policy (INDRP) read with INDRP Rules of Procedure, Indian Arbitration Act, 1996 (including amendments thereto) and Code of Civil Procedure (India), wherever necessary.
- 2) The parties were requested to expedite their submissions so as to enable this panel to pass award within the prescribed time frame of 60 days.
- 3) Copies of all communications were marked to both the parties and NIXI.
- 4) No personal hearing was requested / granted / held.

VI] BRIEF INFORMATION OF THE COMPLAINANT: -

The Complainant in these arbitration proceedings is ByteDance Ltd. The Complainant submits that it is an internet technology company enabling users to discover a world of creative content platforms, through machine learning technology including Toutiao, Douyin and Tik Tok. It allows users to create vertical videos running for 15 seconds. It is available in more than 150 different countries in 75 languages. It has offices at several places including Los Angeles, New York, London, Paris, Berlin, Dubai, Mumbai, Singapore, Jakarta, Seoul, and Tokyo. Briefly tiktok brand is well recognized and respected worldwide and in their industry. The Complainant has made significant investment to advertise and promote its trademark worldwide in media and internet.

VII] SUMMARY OF THE COMPLAINT: -

The Complaint is, inter-alia, based on the following points, issues, representations or claims in brief:-

(A) CONTRAVENTION OF THE REGISTERED TRADEMARKS AND DOMAIN NAMES OF THE COMPLAINANT (CONTRAVENTION OF POLICY PARA 4(i) OF THE .IN DOMAIN NAME DISPUTE RESOLUTION POLICY) (INDRP) : -

- i. The Complainant states that he had filed application for registration of his Tik Tok trademark on 23.10.2017 in US. He also had registered trademark in the name Tik Tok in Hongkong dated 20.06.2018, in Japan dated 20.07.2018 and in Australia dated 17.08.2018. The Respondent registered disputed domain name on 01.09.2018 and after the Complainant's first use in commerce of its trademark in 2017. When the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for the purposes of standing to file a UDRP case. (*WIPO Overview of WIPO Panel Views on Selected UDRP Questions Third Edition.*)
- ii. The ccTLD can be disregarded for the purposes of assessing similarity of the domain names to the trademarks. (*Morgan Stanley V/s Barat Jain – INDRP/156.*)
- iii. The Second Level domain of the disputed domain name consists solely of Complainant's TikTok trademark which is completely identical to the said trademark, which meets with the requirements

of Para 4(i) of INDRP. (*Tiger Airways Pte. V/s Steven Toumbas – INDRP/053*).

- iv. Respondent's omission of the space between 'tik' and 'tok' does nothing to distinguish the disputed domain name from the Complainant's trademark.

(B) NO RIGHT OR LEGITIMATE INTEREST IN DISPUTED DOMAIN NAME (PARA 4(ii) OF INDRP): -

- i. The Complainant has marketed and sold its goods and services using this trademark since 2017, which is well before the Respondent's registration of the disputed domain name on 1.09.2018.
- ii. The Respondent is not sponsored by or affiliated with the Complainant in any way and the Complainant has not given license, authorization or permission to the Respondent to use the Complainant's trademark in any manner including in domain names.
- iii. The Respondent is not commonly known by the disputed domain name.
- iv. The Disputed Domain name currently redirects to Sedo's page where the disputed domain name is being offered for sale at US\$ 39980, which far exceeds the Respondent's out of pocket expenses in registering the domain name. The only use of the domain name is an offer to sell. This is evidence of the Respondent's lack of rights and legitimate interests. (*Kabushiki Kaisha ASICS V.s SC Gaticonstruct- DRO2008-0010- WIPO*)

(C) REGISTRATION AND USE IN BAD FAITH (PARA 4(iii)) OF INDRP: -

- i. It is not possible to conceive of a plausible situation in which the Respondent would have been unaware of the Complainant's brands at the time of registration of disputed domain name. (*Telstra Corp. Ltd. V/s Nuclear Marshmallows – D2000-0003 – WIPO*).
- ii. The Respondent's registration of the disputed domain name a month after the Complainant unified its two platforms, musical.ly and TikTok under the TikTok brand strongly suggests that the Respondent knew of the Complainant. Registration of disputed domain name by the Respondent can be construed as intending to

cause confusion among internet users as to the source of the disputed domain name and it must be considered as done in bad faith.

- iii. The disputed domain name is identical to the Complainant's trademark as well as its domain name – tiktok.com. As such the Respondent has demonstrated a knowledge of and familiarity with the Complainant's brand and business. It is not possible to conceive of a plausible situation in which the Respondent would have been unaware of the Complainant's brands at the time of registration of disputed domain name. **(Telstra Corp. Ltd. Vs Nuclear Masrhmallows – D2000-0003-WIPO 18.02.2000)**
- iv. It is well established that seeking to profit from the sale of a confusingly similar domain name that incorporates a third party's trademark demonstrates bad faith. **(Groupe Auchan V/s Bui Tan Dat/ Domain ID Shield Service Co. Ltd. – D2014-1935- WIPO).**
- v. Previous panels have concluded that evidence of prior Panel decisions in which domain names have been transferred away from the Respondent to complainants supports a finding that Respondent has engaged in a bad faith pattern of cybersquatting. **(Arai Helmet Americas Inc. V/s Goldmark D2004-1028 – WIPO – 22.01.2005).** The Respondent has been involved in the below mentioned cases which provides evidence of the pattern of cybersquatting of the Respondent: -
 - Zulily Inc. V/s Jing Ren –FA 1473789 (NAF 14.01.2013)
 - Blue Nile Inc V/s Jing Ren – FA 1422932 (NAF 17.02.2012)
 - Hungry Machine Inc. V/s Jing Ren – FA 1395592 (NAF 08.08.2011)

(D) REMEDIES SOUGHT BY THE COMPLAINANT: -

On the above background of the Complaint and reasons described therein the Complainant has requested for TRANSFER OF DISPUTED DOMAIN to the Complainant.

VIII] RESPONDENT'S DEFENSE: -

The Respondent filed his say / reply which contains mainly the following contentions: -

- i. In respect of the Complainant's trademark application of No.3853842 under Class 35, the Respondent noticed that the

trademark is wholly as annexed by an image which looks like the letter 'd', which is completely different from the term tiktok. There is no result on search of Application No.3853842 at the website Public Search of Trade Marks by Indian Trademark registry.

- ii. Another trademark Application No.3853841 filed by the Complainant was objected by Indian Trademark registry. So it can be concluded that the Complainant has no rights in term 'tiktok' and the domain name tiktok.in is not identical or confusingly similar to the Complainant's trademark.
- iii. In respect of the Trademark Application No.3960172 the Respondent noticed that the application was filed on 29.09.2018, which is later than the creation date of the disputed domain name that was created on 01.09.2018. Therefore the Respondent did not know that trademark existed when the disputed domain name was registered.
- iv. The term tiktok is the sound that the generic word ticktock makes. Ticktock is a generic word that has been defined by Dictionary.com and which means an alternating ticking sound as that made by a clock. Tiktok and Ticktock has the same meaning and sound. It has been held in the INDRP decision that the both sound the same phonetically. (***Pradeep Misra V.s Radiantly Life – INDRP / 957.***)
- v. The word tiktok being generic in nature, it is not-distinctive and thus the rights to use or own the word tiktok cannot exist with one single entity or individual. There are many entities around the world using the word tiktok prior to the Complainant's Trademark, such as popular music song which title is tik tok released in 2009 and in this song tiktok is the same as ticktock etc. ([https://simple.wikipedia.org/wiki/tik tok](https://simple.wikipedia.org/wiki/tik_tok))
- vi. The term tiktok has been registered for many different top TLDs like .net, .org, .us, .co.uk, .in, .cn and so on. The domain name tiktok.net is owned by a Canada National and was registered in the year 2004, prior to the Complainant's trademark.

VIII] REJOINDERS OF THE PARTIES: -

Upon filing of reply / say by the Respondent / Registrant, rejoinder from the Complainant was called for.

(A) The Complainant in his rejoinder submitted inter-alia the following main points: -

- i. Though disputed domain name was registered by the Respondent on 29th September 2018, by September 1, 2018 the Complainant had trademarks in Tiktok in numerous jurisdictions, from June 2018.
- ii. It has been held that the Complainant and its tik tok trademark are known internationally with trademark registrations across numerous countries. (**Bytedance Ltd. V/s Vu Dinh Dat – HK 2001329.**)
- iii. While 'ticktock' in its generic use is a verb, the term 'tiktok' which does not have a dictionary meaning, is a noun and source identifier. (**Whois Privacy Services Pty Ltd. V/s Domain Administrator. Vertical Axis Inc. – D2014-1754 – WIPO).**
- iv. To find rights or legitimate interests in a domain name based on its dictionary meaning, the domain name should be genuinely used or at least demonstrably intended for such use. In the present case the Respondent has not used or shown such demonstrable efforts. On the contrary he has offered the disputed domain name for sale. (**Allinaz Sigoria A.S. Allianz Hayat V/s Emeklilik A.S. V Selcuk Yildiz – D 2015-1762- WIPO).**
- v. The Complainant has its origin and foundation in China and has a significant following in China and hence it is unlikely that the Respondent was not targeting Complainant and its tiktok brand.

(B) In response to the Complainant's rejoinder, the Respondent filed his rejoinder containing mainly following points: -

- i. There are many entities in the world using the word 'tiktok' including disputed domain name, prior to the Complainant's trademark.
- ii. The Complainant is blocked from China and hence the Respondent was not aware of the Complainant's trademark.
- iii. The Complainant was known by 'douyin' firstly and not by 'tiktok'. The Complainant rebranded the popular Musical.ly app as Tiktok. Before the Complainant did not own even the main domain name 'tiktok.com'.

- iv. It has been held that investment in generic domain names is like an opportunity to invest in a virtual property as soon as some new domain TLD is launched with future expectations. ... the Respondent may carry on the business upon it or sell a domain name, of course subject to the law of land. (***Tickets Worldwide LLP V/s India Portals – INDRP/1187***).
- v. It is not bad faith that the disputed domain name is just for sale.
- vi. The Complainant and its brother company often infringe the intellectual property rights of other companies. Indian court has banned TikTok for encouraging pornography.
- vii. The Complainant was trying to harass the Respondent for the disputed domain name.

(C) In view of the Rejoinder of the Respondent, the Complainant was given one more opportunity to file rejoinder, if any. However he did not file any more submission and hence arbitration proceedings were closed at this point of time.

IX] EVIDENCE RELIED UPON: -

This panel has, *inter-alia*, placed reliance upon the following evidences / details thereof, submitted by the Complainant: -

1. Copies of trademarks registered in India and in other countries in the name of the Complainant
2. Copy of printout of the *whois* details

X] DISCUSSION: -

Based on the complaint, Respondent's say, rejoinders of the Complainant and the Respondent contentions, this panel makes following observations: -

1. Though the Complainant is an owner of registered trade / service marks incorporating the word TIKTOK in which he has legitimate interests and rights, date of registration of the same in India is subsequent to the date of registration of disputed domain name.

However in case of trademarks of the Complainant in other countries like Hong Kong, Japan and Australia, they are prior to the registration of disputed domain name.

As against this, the Respondent has not claimed having any trademark / service mark with the term 'tiktok'. The submission of the Complainant that the Respondent's omission of space between tik and tok does nothing to distinguish the disputed domain name from the Complainant's trademark has not been countered by the Respondent. Moreover the disputed domain name is phonetically similar to the trademark of the Complainant. Thus the disputed domain name is identical, confusingly similar to the registered trademark of the Complainant.

The above facts establish that the Complainant has rights, legitimate interests in respect of the disputed domain name.

2. The contentions of the Complainant stating that TikTok is now available in more than 150 countries, in 75 languages, more than 500 million users have downloaded it from Google Play and that it has offices in many globally big cities across the world, are not denied by the Respondent. These facts establish that Tiktok is a well recognized and established app in several countries including in China.

3. The Respondent has produced screenshots of trademark registry website pertaining to tiktok and stated that one of the applications is misspelled, another one is objected. The Respondent has also stated that the term tiktok has been registered for many different top TLDs like .net, .org, .us, .co.uk, .in, .cn and so on, prior to the registration of the Complainant's trademark. According to the Respondent, there is no evidence that the Complainant owns any other TLDs of the term tiktok. He also stated that the domain name tiktok was registered on July 21, 1996, almost 22 years before the complainant obtained it.

It appears that the Respondent has made extensive search on the term tiktok, its usage by others, dates of such usage and other TLDs. This establishes that he was well aware of the tiktok app, its owners, its popularity and wide usage by people in several countries. This confirms that the Respondent was well aware of the fact that he cannot legally own the disputed domain name, due to prior use of the term tiktok by others, whether it is the Complainant or someone else. Despite this he chose to register the disputed domain name, which in itself is contravention of INDRP 3(b) and 6(i).

His search on Indian trademark registry must have revealed about application made for registration and its pending status. Procedurally registration of trademark takes considerable time from the date of submission of its application. Though, technically Indian trademark is not registered prior to the date of registration of disputed domain name, the Respondent was fully aware

of the rights and interests of the Complainant in the term tiktok. What transpires is that the Respondent attempted to take advantage of this time lag for registration of disputed domain name. It can be inferred that the Respondent was aware of the Complainant's brands at the time of registration of disputed domain name. It becomes imperative to disbelieve that the Respondent registered the disputed domain name coincidentally, without having knowledge of Complainant's trademarks and rights and interests in the term tiktok. This panel concurs with the WIPO Jurisprudential Overview that any nationally or regionally registered trademark or service mark, satisfies the threshold requirement of having trademark rights for the purposes of standing to file a UDRP Case.

4. The Respondent has categorically admitted that he is a domainer which regularly registers domain names that include generic words for the purpose of selling them. He has also posted the disputed domain name on Sedo's webpage for sale for a big amount of US \$ 39980, which is heavily in excess of out of pocket expenses required for registration of disputed domain name. Further he has also admitted that it is his business to register and sell domain names. He claims this activity to be legitimate and not in breach of the Policy so long as they do not encroach third party's trademark rights.

When any activity is carried out as business, it is always with the object of making profit. In case of the business of registering and selling domain names, profit means making money by selling the domain name, at the higher amount than spent on the registration of the same. So long as the Respondent registers any domain name which is not infringing any third party rights, registering and selling domain name, may become legitimate and lawful activity. However when it is a purposeful act to gain profits on the basis of business standing, reputation and credentials of others, this business cannot be considered as legitimate and lawful. This confirms the bad faith in registering disputed domain name in terms of INDRP 6(i).

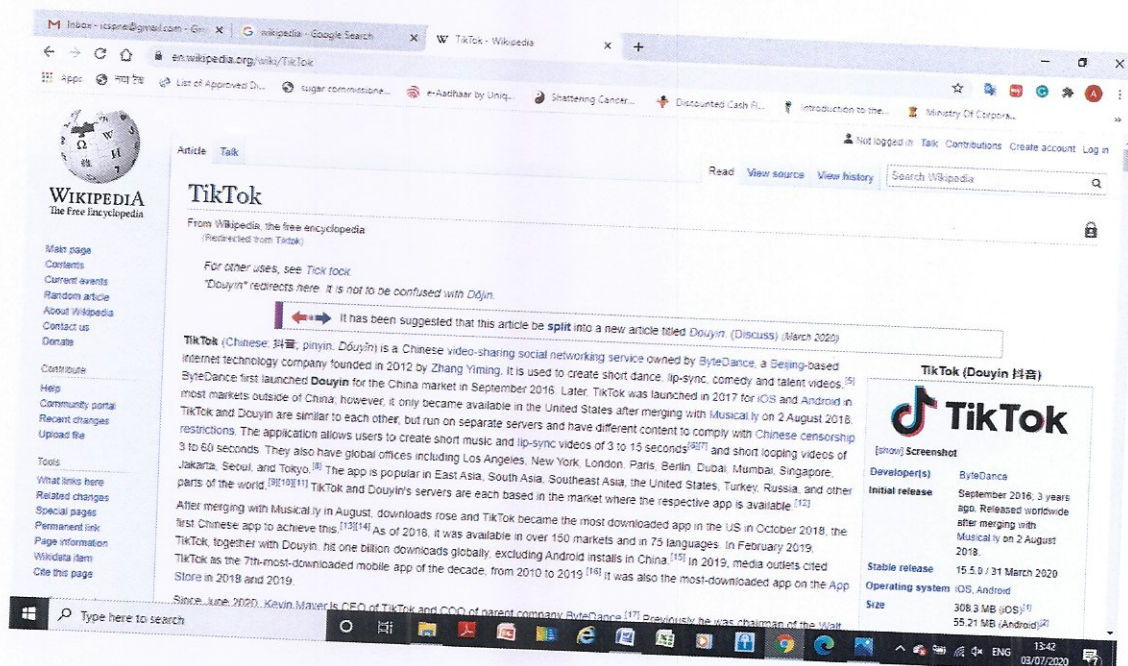
5. The Complainant affirmed that he has neither authorized / licensed to the Respondent to use the word 'TIKTOK' in any manner or the Respondent has claimed such authority having issued by the Complainant in his say.

6. The Respondent is Jing Ren who is not known by the word TIKTOK or any resembling word to it. There is no submission by the Respondent against this fact.

7. The Respondent is not making bona fide use of disputed domain name for non-commercial or charitable purposes. Contrarily, the Respondent is attempting to sell the same for making profits.

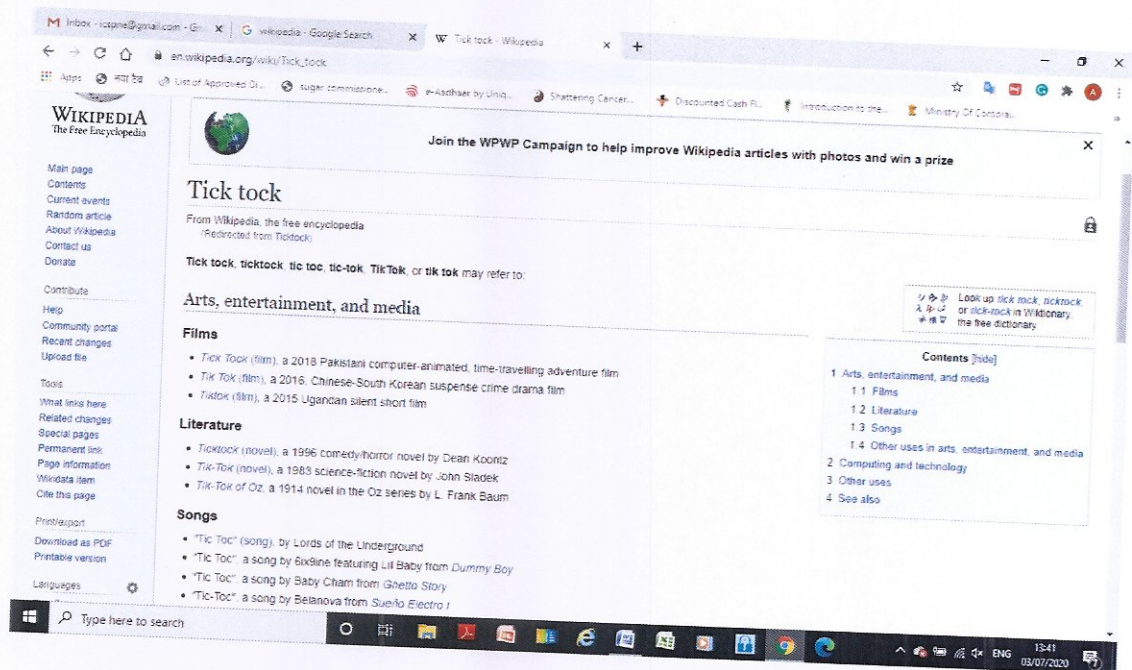
The Respondent has clearly stated that he registered the disputed domain name for the purpose of selling it. He further added that he never attempted to sell it directly to the Complainant. It is therefore quite likely that the competitors of the Complainant would purchase it without having any legitimate rights and interests in it. In most of domain name related disputes, the probability of selling the disputed domain name to the competitors of the Complainant, who has registered trademarks, reputation, and association with the term used in such disputed domain name, is the serious most threat due to which the Complainant has to opt either for purchase it from the Respondent or from some third party at prices much excessive than the actual cost of its registration.

8. The Respondent has referred to Wikipedia to claim that the term tiktok and ticktock are one and the same and sound same phonetically. The term being generic in nature it is available for use by anybody and especially for domain name registration. This panel visited Wikipedia site and found results for the term tiktok, the screenshot of which appears as follows: -



The above screenshot clearly associates tiktok with the Complainant by giving detailed information about the Complainant, its founder, historical events in respect of merger of music.ly and tiktok platforms etc. It also states that tiktok was launched in the year 2017, which is prior to the date of registration of disputed domain name by the Respondent.

The search for the term ticktock on Wikipedia resulted in following screenshot:



As claimed by the Respondent, Wikipedia has clubbed the terms Tick Tock, ticktock, tic toc, tic-tok, TikTok, and tik tok for this search. There are instances of use of some of these terms by persons other than the Complainant in films, literature, songs etc. world over. However there is no mention of trademark rights vested in any of them.

Assuming for the sake of debate that the term tiktok is same as tick tock and that it is generic in nature, there is no evidence of trademark / service mark rights or interests vested in any other party. As against this there are some trademarks registered by the Complainant in countries other than India, prior to the registration of disputed domain name. Undoubtedly generic words are available for use by any one till the moment someone **first** creates rights and interests in it by registering trademark / service mark including the said generic word, whereby he gains lawful advantage over others.

All this leads to the conclusion that though the trademark of the Complainant was registered about 28 days after registration of disputed domain name, the Complainant had rights and legitimate interests in the term tiktok world over. It is very difficult to believe that the Respondent was not aware of the Complainant's rights and interests in the disputed domain name at the time of registration of it. It can be inferred that the Respondent took advantage of delay in procedures for actual registration of the Complainant's trademark in India and is using it as a shelter.

XI] FINDINGS: -

On the basis of above discussion this panel finds that: -

1. The Respondent's domain name is identical or confusingly similar to trademark or service mark in which the Complainant has rights;
2. The Respondent has no rights or legitimate interests in respect of the domain name;
3. The Respondent's domain name has been registered in bad faith.
4. The circumstances indicate that the Respondent has registered or acquired the domain name primarily for the purpose of selling, or otherwise transferring to the Complainant, who 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.


XII] AWARD: -

On the basis of above findings on issues, foregoing discussion, and findings and as per the remedies requested by the Complainant, this panel passes the following award: -

- a. The disputed domain name 'TIKTOK.IN' be transferred to the Complainant.

Date: - 02.07.2020

Place: - Pune, India


(S.C. INAMDAR)
SOLE ARBITRATOR
NATIONAL INTERNET
EXCHANGE OF INDIA