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37/81/28/12/2012

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BEFORE S SRIDHARAN, SOLE ARBITRATOR  
OF NATIONAL INTERNET EXCHANGE OF INDIA

ARBITRATION AWARD  
DATED: 30<sup>th</sup> December 2012

Research In Motion Limited

... Complainant

Versus

Rajeev Roy

... Respondent

Sridharan

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OF NATIONAL INTERNET EXCHANGE OF INDIA**

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<b>Research In Motion Limited</b>	...	<b>Complainant</b>
<b>Versus</b>		
<b>Rajeev Roy</b>	...	<b>Respondent</b>

**1. The Parties**

- 1.1 The complainant, Research In Motion Limited, is an entity organized and existing under the laws of Canada, having its principal place of business at 295 Phillip Street, Waterloo, Ontario, Canada N2L 3W8 represented by Mr. Tarvinder Singh & Mr. Anshuman Sharma, of KOCHHAR & CO at Technopolis Building, 3rd Floor, Tower B, Sector- 54, DLF Golf Course Road, Gurgaon – 122002.
- 1.2 Respondent is Rajeev Roy at Madapuram, Tiruvarur, Kerala 610009.

**The Domain Name and Registrar**

- 1.3 The disputed domain name <[blackberry.org.in](http://blackberry.org.in)> created on 21.12.2009 is registered with Directi Internet Solutions (P) Limited (R5-AFIN).

**2. Procedural History**

- 2.1 On 22<sup>nd</sup> November 2012, NIXI asked me about my availability and consent to take up the Complaint for arbitration. On the same day, I informed my availability and consent. I also informed NIXI that I had no conflict of interest with either of the parties and could act independently and impartially.
- 2.2 On 29<sup>th</sup> November 2012, I received hardcopy of the Complaint.
- 2.3 On 29<sup>th</sup> November 2012, I issued by email a Notice to the Respondent setting forth the relief claimed in the Complaint and directing him to file his reply to the Complaint within 15 days. I also sent an email about my appointment to arbitrate the complaint to the Complainant and asked the Complainant to send a soft copy of the complaint to me.
- 2.4 On 30<sup>th</sup> November 2012, I received a soft copy of the Complaint.
- 2.5 Respondent has not filed any response to the Complaint.
- 2.6 Email is the medium of communication of this arbitration and each email is copied to all, Complainant, Respondent and NIXI.

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### 3. Factual Background

#### A Complainant

- 3.1 The Complainant is a leading designer, manufacturer and marketer of innovative wireless solutions for the mobile communications market with a history of developing breakthrough wireless solutions. Present across the world, the Complainant has several subsidiaries and associate companies, which are collectively referred to as RIM Group of Companies.
- 3.2 The Complainant was founded in the year 1984 and is amongst the first wireless data technology developers in North America. The Complainant is a designer, manufacturer and marketer of innovative wireless solutions for the worldwide mobile communications market. Through the development of integrated hardware, software and services that support multiple types of wireless networks, the Complainant provides individuals with the ability to remotely access time-sensitive information including email, telephone, short message service (SMS) messaging, instant messaging, Internet, global positioning (GPS) as well as software and intranet based applications, all from a device no larger than the palm of a hand. The Complainant's technology also enables a broad array of third party developers and manufacturers to enhance the productivity levels of their products and services.
- 3.3 The Complainant had coined and adopted the 'BlackBerry' in the international market as early as the year 1999 with respect to its goods/services and is consequently prima facie distinctive trade marks. The Complainant filed trade mark applications for the registration of the 'BlackBerry' mark in India as early as the year 2002. The Complainant is the owner of the mark BlackBerry and various other marks containing the word BlackBerry.
- 3.4 The Complainant's portfolio of award-winning products, services and embedded technologies are used by tens of thousands of organizations around the world and include the BlackBerry wireless platform, software development tools, radio-modems and software/hardware licensing agreements. The Complainant's sales and marketing efforts include collaboration with strategic partners and distribution channel relationships to promote the sales of its products and services as well as its own supporting sales and marketing teams.
- 3.5 The main products, among several others, developed, manufactured and sold by the Complainant are the BlackBerry wireless handheld devices along with accessories, software and services associated therewith.
- 3.6 The BlackBerry wireless solution allows users to stay connected with wireless access to email, corporate data, phone, web, instant messaging, global positioning system (GPS), social networking and organizer features. BlackBerry devices are revolutionary communication tools that allow professionals to send and receive emails wherever they go. All BlackBerry devices incorporate breakthrough wireless technology to deliver simple, mobile communications access.
- 3.7 The goods/services under the BlackBerry mark are extremely popular among the members of the trade and public. The said goods/services of the Complainant under the BlackBerry mark are available in many countries since the time of its launch. The goods/services under the said mark have also been continuously and extensively available in India.
- 3.8 Owing to the huge and instantaneous success of BlackBerry products and services, the Complainant has sought to expand its ever-growing BlackBerry business by launching a variety of mobile handsets under the BlackBerry Family of Mark. The BlackBerry range of products include but not limited to BlackBerry Torch, Tour, Storm, Bold, Curve, 8800 series, pearl, 8700 series, 7130 series, 7100 series, 7200 series and 7520.
- 3.9 The Complainant has been expending several hundreds of millions of dollars each year towards its research and development efforts and to this effect has been employing a large team of experts in its research facilities from various technical disciplines with specialized

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skills in the areas of hardware and software engineering. The research and development expenditures for the last six years, which have been taken from the books and records of the Complainant are given herein below:

S. No.	*Fiscal Year	R & D Expenditure in Millions (USD)
1	2011	1,351
2	2010	965
3	2009	685
4	2008	359
5	2007	236
6	2006	159

In support of the above, the Complainant has attached copies of extracts from the Annual Financial Reports highlighting the R&D expenditures at Exhibit 3.

- 3.10 The Complainant has registered tremendous global sales for its products under the BlackBerry Marks right from the year of its adoption. Encouraged by the ever increasing global of sales, the Complainant has been consistently expanding its operations under the BlackBerry Marks throughout the world. A substantial portion of the Complainant's sales are attributed to its international operations in Asia Pacific. The extent of use and popularity of the Complainant's BlackBerry Marks is further evident from the fact that as of August, 2011, there are more than 70 million subscribers, using the BlackBerry products and services of the Complainant throughout the world. The Complainant's products/services under the BlackBerry Marks have been sold/distributed on a wide and extensive scale all over the world by itself and/or through its subsidiaries and/or authorised distributors for the last several years. Following are the year-wise worldwide revenue sales figures shown in USD for the last 13 years arising out of the sale of products/services bearing the BlackBerry Marks:

*Fiscal Year	Global Sales Revenue in USD (Millions)
2011	19,907
2010	14,953
2009	11,065
2008	6,009
2007	3,037
2006	2,066
2005	1,350
2004	595
2003	307

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2002	294
2001	221
2000	85
1999	47

The above figures have been taken from the books and records of the Complainant. In support of the above, the Complainant has filed copies of extracts of select Annual Financial Reports at Exhibit 4. Complainant has also filed copies of a few illustrative sales invoices evidencing the sale of BlackBerry products/services in the global market at Exhibit 5.

- 3.11 The Complainant has also entered into strategic and research alliances with major network operators and channel partners, wireless networks infrastructure suppliers, manufacturers and wireless technology innovators. The Complainant's products/services under its BlackBerry Marks are available in the Indian markets, especially through its strategic alliance with Aircel, Bharti Airtel, BSNL, Idea, Loop Mobil, MTNL, Vodafone Essar, Reliance GSM, TATA DoCoMo, and TATA Indicom to provide customers a wireless solution that includes integrated e-mail, phone, SMS browser and Organizer features. On 19th October, 2004, Bharti Airtel announced the launch of a BlackBerry Wireless Solution in India consequent to a relationship between Bharti Airtel and the Complainant. The BlackBerry Marks have become a household name for Indians who use mobile communication technology on the move. The devices bearing the BlackBerry Marks have become an inseparable part of the daily professional life for millions of Indians. The details of yearly revenue earned from the sale of devices under the BlackBerry Marks in India since the year of its launch are given herein below:

<b>*Fiscal Year</b>	<b>Indian Sales Revenue In USD (Millions)</b>
2011	262.7
2010	109.2
2009	35.2
2008	25.6
2007	13.5
2006	4.3
2005	2.6

The above figures have been taken from the books and records of the Complainant. In support of the above, the Complainant has filed a few copies of sale invoices evidencing the sale of devices under the BlackBerry Marks in India at Exhibit 6.

- 3.12 The Complainant expended significant resources in promotion and advertisement worldwide, including in India, and has established significant Internet presence over the years. Advertisements pertaining to the BlackBerry Family of Marks have been featured

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regularly in print and electronic media which inter alia include magazines, television, and the internet. The Complainant has incurred hundreds of millions of US dollars in promotional expenses worldwide. As a result of Complainant's efforts, the BlackBerry Family of Marks enjoys tremendous reputation and goodwill in the minds of the consumers as well as the members of the trade all over the world, including in India. Consequently, the members of the trade and public associate and recognize the BlackBerry Family of Marks exclusively with the Complainant and none else.

- 3.13 Further, due to the Complainant's efforts the BlackBerry mark is rated amongst the best global brands in the world. The Complainant has enclosed copies of extracts obtained from one of the Complainant's official website "[www.rim.com](http://www.rim.com)" and other third party websites giving details of the awards and accolades received by the Complainant for its products/services under the BlackBerry at Exhibit 11.
- 3.14 The Complainant is the registered proprietor of a global portfolio of BlackBerry Marks, having secured more than 2,800 registrations of the same in 155 (this includes AIPO and OHIM-CTM) jurisdictions around the world including India, in various international classes. Therefore, the Complainant has a well-established proprietary claim over the trade/service mark BlackBerry and people all over the world associate the same exclusively with the Complainant. A list of worldwide registrations of the BlackBerry Marks together with a few copies of extracts taken from the data base of the respective Trade Marks offices of the concerned countries are at Exhibit 12.
- 3.15 The profile and popularity of the Complainant under the trade/service mark BlackBerry has been continuously increasing since the date of adoption and use of the mark. At present, the Complainant's trade/service mark is a world famous brand and has acquired an enormous goodwill internationally, including in India. It is submitted that the BlackBerry mark, due to its extensive use, advertisements, publicity and awareness throughout the world, has acquired the status of a well-known trade mark under Section 2(1)(zg) of the Trade Marks Act, 1999. The said mark qualifies all tests for the well-known status of a mark under Section 11 (6) of the Trade Marks Act, 1999, which includes considerations like knowledge or recognition among relevant section of public, duration, extent and geographical area of use, promotion and publicity of mark etc. It is further submitted that the BlackBerry mark also falls under the category of a famous mark as provided by Article 6 bis of the Paris Convention.
- 3.16 The Complainant considers its trade/service marks an important and an extremely valuable asset and thus in order to protect the same, has obtained trade mark registration for the BlackBerry mark in India. The Complainant has enclosed copies of extracts from the data base of the Indian Trade Marks Registry at Exhibit 13.
- 3.17 The BlackBerry mark has acquired unique importance and is associated with the Complainant. A mere mention of the said mark establishes an identity and connection with the Complainant and none else. The Complainant owns all the rights in the said mark which is its "Trade Mark" & "Service Mark". The use of the said mark by a third party either as a mark, name and domain name, or in any other form whatsoever constitutes infringement and passing off and is a violation of the Complainant's rights in the said mark. Further, the use of the disputed domain name <[blackberry.org.in](http://blackberry.org.in)> by the Respondent amounts to misrepresentation and the Respondent by doing so is indulging in unfair competition.
- 3.18 As the Internet has become an essential medium to conduct business, the Complainant in order to expand its presence obtained a domain name registration for "blackberry.com" on January 20, 1995. The said domain name is a natural extension of its trade/service mark. The Complainant has spent a considerable amount of money and skill to develop the BlackBerry mark. The website [www.blackberry.com](http://www.blackberry.com) is a comprehensive, unique and acclaimed site of the Complainant.

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- 3.19 The Complainant has also registered/acquired a number of domain names containing the word "BlackBerry" such as [www.blackberrystore.com](http://www.blackberrystore.com), [www.discoverblackberry.com](http://www.discoverblackberry.com), [www.blackberrycurve.com](http://www.blackberrycurve.com), and [www.shopblackberry.com](http://www.shopblackberry.com), [www.blackberryappworld.com](http://www.blackberryappworld.com) and, the India specific website [www.in.blackberry.com](http://www.in.blackberry.com) and so on for the sale of its own authentic products, and has an authorized distributor network, of which the Respondent is not a member.
- 3.20 Considering the impeccable reputation, goodwill and notoriety enjoyed by the Complainant in its trade/service mark BlackBerry the world over including in India, its unauthorized usage and thereby infringement by unscrupulous traders in all array of business activities has been on a rise. To safeguard its intellectual property rights in the trade/service mark BlackBerry, the Complainant has been extremely vigilant and, wherever geographically possible, has been taking stringent legal actions against the unscrupulous traders and infringers, including in India. A copy of recent precedential decision of the U.S. Patent and Trademark Office (US PTO) in Research In Motion Limited vs. Defining Presence Marketing Group Inc. is annexed hereto and marked as Exhibit 14, wherein the US Trademark Trial and Appeal Board recognized that the trade mark BlackBerry "... *should be ranked among the most famous and valuable trade marks in the world*".
- 3.21 In addition to the above, the Complainant has also been successful in restraining various third parties from using deceptively similar domain names bearing the word BlackBerry all across the world and has been able to get those domain names transferred in its favour. Of particular note is the UDRP decision in [blackberryhelp.com](http://blackberryhelp.com) (D2011-2197), wherein the panel accepted Complainant's contention that the trade mark BlackBerry is well-known to the extent that it was "...*inconceivable that the Respondent did not know of the Complainant's trade mark upon registration of the domain name*".
- 3.22 Recently, the Complainant came to know that someone has obtained a domain name registration for [www.blackberry.org.in](http://www.blackberry.org.in). The Complainant immediately searched the WHOIS database for the disputed domain name and found that the disputed domain name is registered in the name of Rajeev Roy of Kerala, India. The registrar for the disputed domain name is Directi Internet Solutions (P) Limited d/b/a Publicdomainregistry.com. The malafide and devious intention of the Respondent is evident from the glaring fact that the disputed domain name registration is the verbatim duplication of the Complainant's mark/domain name.
- 3.23 Thus aggrieved by the registration of the disputed domain name <[blackberry.org.in](http://blackberry.org.in)> the Complainant has approached this Honorable Forum.

#### **B Respondent**

- 3.24 The Respondent has not filed any reply to the Complainant's Complaint in this arbitration.

#### **4. Parties Contentions**

##### **A Complainant**

- 4.1 A mere glance at the disputed domain name <[blackberry.org.in](http://blackberry.org.in)> gives rise to confusion as to its origin as the domain name used by the Respondent is identical to the trade/service mark of the Complainant. The utmost *malafide* intention of the Respondent is evident from the fact that not even a single letter differs between the disputed domain name and the trade/service mark of the Complainant. In fact, the WIPO Arbitration & Mediation Center in cases such as Reuters Ltd. Vs. Global Net 2000 Inc. (WIPO Case No. D2000-0441), Altavista Company Vs. Grandtotal Finances Ltd. (WIPO Case No. D2000-0848), Playboy Enterprises v. Movie Name Company (WIPO Case No. D2001-1201) has held that even the mere omission of one letter of a trade mark has no effect on the determination of confusing similarity between a trade mark and a domain name. The present case is on an

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even higher footing as the Respondent has picked up the mark of the Complainant verbatim without even changing a single letter. Thus, the use of the disputed domain name <[blackberry.org.in](http://blackberry.org.in)> by the Respondent is a prima facie case of cyber squatting and trade/service mark infringement.

- 4.2 The mark 'BlackBerry' is distinctive, unique and has an established reputation in India and internationally. The mere mention of the said mark establishes an identity and connection with the Complainant and none else. The Complainant owns all the rights including statutory and common law rights in the said mark in India and is entitled to protection under the Indian Trade Marks Act, 1999. The use of the said mark by a third party either as a mark, name and domain name, or in any other form whatsoever constitutes violation of the Complainant's rights.
- 4.3 It is well-established that the addition of a generic or country code top-level domain names or second level domain names to the disputed domain name does not avoid confusing similarity. Therefore, the specific top-level and/or second-level of a domain name such as ".com", ".org", ".in" and/or "org.in" may be disregarded when determining whether it is identical or confusingly similar to the trade mark in which the Complainant has rights. The decisions of the WIPO Arbitration & Mediation Center in F. Hoffmann-La Roche AG v. Macalve e-dominios S.A. (WIPO Case No. D2006-0451), Telstra Corporation Limited v. Nuclear Marshmallows (WIPO Case No. D2000-0003), Magnum Piering Inc. v. The Mudjacks and Garwood S. Wilson (WIPO Case No. D2000-1525) and Rollerblade Inc. v. Chris McCrady (WIPO Case No. D2000-0429) may be referred to and relied upon in this regard.
- 4.4 Thus, the ccSLD "org.in" is without legal significance since use of a ccSLD is technically required to operate the domain names and it does not serve to identify the source of the goods or services provided by the registrant of the disputed domain name.
- 4.5 It is a well-established principle that an unauthorized party cannot claim a legitimate interest in a domain name that contains, or is comprised of, the Complainant's mark.
- 4.6 There has never been any relationship between the Complainant and the Respondent. The Respondent has no proprietary or contractual rights in any registered or common law trade mark corresponding in whole or in part to the disputed domain name <[blackberry.org.in](http://blackberry.org.in)>. Further, the Respondent is not authorized or licensed by the Complainant to use its trade/service mark or to use the disputed domain name <[blackberry.org.in](http://blackberry.org.in)>. The Respondent is misusing the domain name by hosting an unauthorised website.
- 4.7 The disputed domain name <[blackberry.org.in](http://blackberry.org.in)> incorporates the whole of the BlackBerry trade/service mark, and the domain name on its face suggests that it is associated with a website affiliated with, or otherwise connected to, the Complainant. Such a registration cannot be considered bona fide in nature or otherwise performed in good faith. The Respondent may have registered the disputed domain name <[blackberry.org.in](http://blackberry.org.in)> with a view to reaping a significant financial windfall by attempting to sell it.
- 4.8 The illegality in the registration of the disputed domain name <[blackberry.org.in](http://blackberry.org.in)> arises from the fact that domain names today are a part and parcel of the corporate identity of a large business enterprise. A domain name acts as the address of the company on the Internet and can be termed as a web address or a web mark just like a trade mark or service mark. It is also the Internet address of a company and/or its mark(s) and/or its goods/services. The mere act of registration by the Respondent of the disputed domain name <[blackberry.org.in](http://blackberry.org.in)> containing the mark of the Complainant in it constitutes infringement and passing off.
- 4.9 The Respondent's website at <[blackberry.org.in](http://blackberry.org.in)> displays sponsored links to competitors of the Complainant. This does not constitute bona fide use of the disputed domain name <[blackberry.org.in](http://blackberry.org.in)>. Further, registering a domain name incorporating a well-known mark belonging to another party, for the purpose of attracting Internet users and then guiding them to a website offering goods/services for reward, or gaining revenue from click-through

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licenses, does not give rise to legitimate rights or interests. The Respondent is not making a legitimate noncommercial or fair use of the disputed domain name <[blackberry.org.in](http://blackberry.org.in)>.

- 4.10 The disclaimers displayed on the Respondent's website are what might be expected if its business were to be operated from an innocuous domain name but they do not legitimize operation of the business from a domain name confusingly similar to the Complainant's trade/service mark. Moreover the disclaimers posted by the Respondent on the website <[blackberry.org.in](http://blackberry.org.in)> demonstrate that the Respondent registered and has been using the disputed domain name <[blackberry.org.in](http://blackberry.org.in)> with full knowledge of the valuable intellectual property rights belonging to the Complainant in the mark BlackBerry.
- 4.11 The fact that the Respondent registered the disputed domain name <[blackberry.org.in](http://blackberry.org.in)> years after the registration of the Complainant's domain name [www.blackberry.com](http://www.blackberry.com) is prima facie evidence of *malafide* intentions and bad faith.
- 4.12 The Respondent has obtained registration for the disputed domain name <[blackberry.org.in](http://blackberry.org.in)> in bad faith for either or all of the following motives:
- a) Through the disputed domain name <[blackberry.org.in](http://blackberry.org.in)>, the Respondent may be able to represent itself as the Complainant or its authorized representative and cause damage to some innocent party by entering into transactions or contracts with them under the garb of being associated with the Complainant. This can be extremely dangerous and prejudicial to public interest as well.
  - b) The Respondent can transfer or sell the domain name <[blackberry.org.in](http://blackberry.org.in)> to some competing interest of the Complainant who may damage the goodwill and reputation of the Complainant by inserting prejudicial material in relation to the Complainant. This will lead to complete tarnishment of the Complainant's image if a valuable property like the domain name falls into wrong hands.
  - c) The Respondent registered the disputed domain name <[blackberry.org.in](http://blackberry.org.in)> for the purpose of disrupting the Complainant's business. The disputed domain name <[blackberry.org.in](http://blackberry.org.in)> also offers pay-per-click links to various websites. The Respondent has been earning pay-per-click revenue from the sponsored links on the Respondent's website. In so doing, the Respondent has been attempting to attract Internet users, for commercial purposes, to the Respondent's website by creating a likelihood of confusion with the Complainant's trade/service mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. Further, the sponsored links on the Respondent's website belong to the businesses that offer goods and services that compete with, or rival, those goods and services offered by the Complainant. A copy of screenshot of the disputed domain name is enclosed at Exhibit 15, showing the sponsored links to Nokia, HomeShope18, Shopping.Indiatimes etc.
  - d) Further, the Respondent's website <[blackberry.org.in](http://blackberry.org.in)> displays several advertisements, where Internet users can click on an advertisement which takes them to a web page where goods/services are sold / offered. In the circumstances, it can be inferred that the Respondent stands to gain financially in one way or another from the use it makes of the disputed domain name <[blackberry.org.in](http://blackberry.org.in)>. It is thus profiting or intending to profit from the adoption of a famous mark in which it has no rights, by generating a misleading impression of some legitimate connection between the disputed domain name <[blackberry.org.in](http://blackberry.org.in)> and the Complainant. The way it has constructed the disputed domain name further supports the conclusion that its real designs are to profit from the unauthorized use of the Complainant's trade/service mark and the reputation that adheres to it.
  - e) Currently, the Respondent's website carries advertisements for Quiker.com, Rediff Shopping, selling mobile phones of the Complainant brand as well as its competitors and links to websites of Quiker.com and Rediff Shopping. The website corresponding to the disputed domain name also consist of links relate to Complainant's brands and products as well as products from Complainant's competitors like Nokia. A copy of screenshot of the disputed domain name <[blackberry.org.in](http://blackberry.org.in)> is at Exhibit 16, showing

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the advertisements. The registration and use of a domain name to re-direct Internet users to websites that offer products and services in competition with Complainant's services, constitutes a bad faith registration and use. The decision of the WIPO Arbitration & Mediation Center in Encyclopedia Britannica Inc. v. Sheldon.com (WIPO Case No. D2000-0753) and Edmunds.com v. Ult. Search Inc. (WIPO Case No. D2001-1319) may be referred to and relied upon in this regard.

- f) It is suggestive of the Respondent's bad faith that the mark/domain name, owned by the Complainant, were registered before the registration of the disputed domain name. The decision of the WIPO Arbitration & Mediation Center in Sanofi-Aventis v. Abigail Wallace (WIPO Case No. D2009-0735) may be referred to and relied upon in this regard.
- g) It is an established principle, when a domain name is so obviously connected with the Complainant and its goods/services, it's very use by someone with no connection to the Complainant suggests 'opportunistic bad faith'. The decision of the WIPO Arbitration & Mediation Center in Tata Sons Limited v. TATA Telecom Inc/Tata-telecom.com, Mr. Singh (Case No. D2009-0671) may be referred to and relied upon in this regard.
- h) The existence of the disclaimers is evidence that the Respondent was aware that use of the disputed domain name [blackberry.org.in](http://blackberry.org.in) was likely to cause confusion with the Complainant's trade/service mark BlackBerry. The disclaimers are ineffective because it is the unauthorized use of the Complainant's mark BlackBerry that brings Internet users to the Respondent's website in the first place. In this respect, the decisions of the WIPO Arbitration & Mediation Center in World Natural Bodybuilding Federation, Inc. v. Daniel Jones TheDotCafé (WIPO Case No. D2008-0642) and ISL Worldwide and The Federal Internationale de Football Association v. Western States Ticket Service (WIPO Case No. D2001-0070) may be referred to and relied upon in this regard.
- i) Further, the disputed domain name is virtually identical and confusingly similar to the Complainant's mark and domain name. A likelihood of confusion is presumed, and such confusion will inevitably result in the diversion of Internet traffic from the Complainant's site to the Respondent's site. Attracting Internet traffic by using a domain name that is identical or confusingly similar to a registered trade/service mark may be evidence of bad faith. The decision of the WIPO Arbitration & Mediation Center in Edmunds.com, Inc. v. Ult. Search Inc. (WIPO Case No. D2001-1319) may be referred to and relied upon in this regard.

## **B. Respondent**

4.13 Respondent has not filed any reply to the Complainant's Complaint in this arbitration.

## **5. Discussion and Findings**

5.1 Respondent has not filed his response. I have not received any communication from him until the date of this award. Therefore, I am proceeding to determine this Complaint on the basis of the materials available on record.

5.2 The Complainant in order to succeed in the Complaint must establish under Paragraph 4 of .IN Domain Name Dispute Resolution Policy (INDRP) the following elements:

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

5.3 Each of the aforesaid three elements must be proved by a Complainant to warrant relief.

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***Disputed domain name is identical or confusingly similar to a trade mark of the Complainant.***

- 5.4 The Complainant is the proprietor of the mark BlackBerry. Complainant has been using BlackBerry mark continuously since 1999 internationally. In India, the goods/services under the BlackBerry mark have been continuously and extensively available in India. The Complainant started offering its services in India in collaboration with Airtel on 19.10.2004. The Complainant has secured more than 2,800 registrations for Blackberry marks in 155 jurisdictions around the world including India, in various international classes. The first registration in Canada under Application No.1022752 dates back to 19.07.1999. The first registration in India under Application No.1148491 dates back to 28.10.2002. The Complainant registered [www.blackberry.com](http://www.blackberry.com) on 20.01.1995. The disputed domain name <[blackberry.org.in](http://blackberry.org.in)> was registered on 21.12.2009. Obviously, the Complainant is the prior adopter of Blackberry marks. The above facts have established that the Complainant has both common law and statutory rights in respect of its Blackberry marks.
- 5.5 The Complainant's Blackberry marks are famous and well known throughout the world including India. It is clearly seen that the disputed domain name <[blackberry.org.in](http://blackberry.org.in)> wholly incorporates the prior registered Blackberry marks of the Complainant. The suffixes .org and .in are descriptive and are not distinguishing part of the domain name. The specific top-level and/or second-level of a domain name such as "org.in" needs to be disregarded when determining the similarity or identity with the Complainant's Blackberry marks. The disputed domain name <[blackberry.org.in](http://blackberry.org.in)> is similar to the Complainant's domain name [www.blackberry.com](http://www.blackberry.com).
- 5.6 I, therefore, find that:
- (a) The Complaint has both common law and statutory rights in respect of its Blackberry marks.
  - (b) The disputed domain name <[blackberry.org.in](http://blackberry.org.in)> is:
    - (i) Identical to the Complainant's prior registered Blackberry marks, and
    - (ii) Identical to the Complainant's domain name [www.blackberry.com](http://www.blackberry.com).

***Respondent has no rights or legitimate interests in respect of the disputed domain name***

- 5.7 It is already seen that:
- (a) The Complainant is the prior adopter and user of the Blackberry marks. The Complainant's Blackberry marks are well known in many countries across the globe including India.
  - (b) The Complainant's Blackberry mark was adopted in the year 1999. It was registered in India in 2002. The disputed domain name <[blackberry.org.in](http://blackberry.org.in)> was registered by the Respondent only on 21.12.2009.
- 5.8 Respondent did not register the disputed domain name <[blackberry.org.in](http://blackberry.org.in)> until 2009. Complainant has registered and used domain names consisting of its mark Blackberry before Respondent registered the disputed domain name <[blackberry.org.in](http://blackberry.org.in)>. It is unlikely that the Respondent was unaware of Complainant's existence of trademark rights before registering the disputed domain name <[blackberry.org.in](http://blackberry.org.in)>.
- 5.9 I visited the web site of the Respondent under the disputed domain name <[blackberry.org.in](http://blackberry.org.in)>. The disputed domain name <[blackberry.org.in](http://blackberry.org.in)> offers pay-per-click links to various websites. The Respondent has been earning pay-per-click revenue from the sponsored links on the Respondent's website. The sponsored links on the Respondent's website belong to the businesses that offer goods and services that compete with, or rival, those goods and services offered by the Complainant. It is obvious that in so doing, the Respondent has been attempting to attract Internet users, for commercial purposes, to the Respondent's website by creating a likelihood of confusion with the

*Indhavan*

Complainant's trade/service mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website.

5.10 In the absence of response from the Respondent, I accept the arguments of the Complainant that:

- (a) There has never been any relationship between the Complainant and the Respondent. The Respondent has no proprietary or contractual rights in any registered or common law trade mark corresponding in whole or in part to the disputed domain name <[blackberry.org.in](http://blackberry.org.in)>. Further, the Respondent is not authorized or licensed by the Complainant to use its trade/service mark or to use the disputed domain name <[blackberry.org.in](http://blackberry.org.in)>. The Respondent is misusing the domain name by hosting an unauthorized website.
- (b) The illegality in the registration of the disputed domain name <[blackberry.org.in](http://blackberry.org.in)> arises from the fact that domain names today are a part and parcel of the corporate identity of a large business enterprise. A domain name acts as the address of the company on the Internet and can be termed as a web address or a web mark just like a trade mark or service mark. It is also the Internet address of a company and/or its mark(s) and/or its goods/services. The mere act of registration by the Respondent of the disputed domain name <[blackberry.org.in](http://blackberry.org.in)> containing the mark of the Complainant in it constitutes infringement and passing off.
- (c) The Respondent's website at <[blackberry.org.in](http://blackberry.org.in)> displays sponsored links to competitors of the Complainant. This does not constitute bona fide use of the disputed domain name <[blackberry.org.in](http://blackberry.org.in)>. Further, registering a domain name incorporating a well-known mark belonging to another party, for the purpose of attracting Internet users and then guiding them to a website offering goods/services for reward, or gaining revenue from click-through licenses, does not give rise to legitimate rights or interests. The Respondent is not making a legitimate noncommercial or fair use of the disputed domain name <[blackberry.org.in](http://blackberry.org.in)>.

5.11 Therefore, I have no hesitation to hold, for the above reasons that the Respondent has no right or legitimate interest in respect of the disputed domain name <[blackberry.org.in](http://blackberry.org.in)>.

***Respondent's domain name has been registered or is being used in bad faith.***

5.12 The Complainant is the proprietor of the Blackberry marks. Complainant has been using Blackberry marks continuously since 1999. The Complainant's products and services are available in India. Complainant owns numerous trademark registrations for Blackberry marks throughout the world. The first registration in India under Application No.1148491 dates back to 28.10.2002. The Complainant registered [www.blackberry.com](http://www.blackberry.com) on 20.01.1995. The disputed domain name <[blackberry.org.in](http://blackberry.org.in)> was registered on 21.12.2009. Obviously, Complainant's rights in the Blackberry marks pre-date Respondent's registration of the disputed domain name <[blackberry.org.in](http://blackberry.org.in)>. The Respondent could not have ignored, rather actually influenced by, the well-known blackberry marks of the Complainant at the time he acquired the disputed domain name <[blackberry.org.in](http://blackberry.org.in)>.

5.13 As seen above, Respondent is currently holding the disputed domain name <[blackberry.org.in](http://blackberry.org.in)> primarily for providing sponsored links to competitors of the Complainant and for earning pay-per-click revenue. The Respondent is no way connected with the Complainant. Respondent's adoption of the disputed domain name <[blackberry.org.in](http://blackberry.org.in)> is nothing but an unjust exploitation of the well-known reputation of the Complainant's prior registered blackberry marks.

5.14 In the absence of response from the Respondent, I accept the arguments of the Complainant that:

- (a) Through the disputed domain name <[blackberry.org.in](http://blackberry.org.in)>, the Respondent may be able to represent itself as the Complainant or its authorized representative and cause



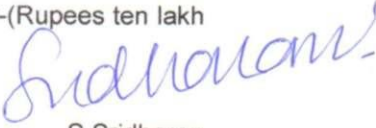
damage to some innocent party by entering into transactions or contracts with them under the garb of being associated with the Complainant. This can be extremely dangerous and prejudicial to public interest as well.

- (b) The Respondent can transfer or sell the domain name [<blackberry.org.in>](http://blackberry.org.in) to some competing interest of the Complainant who may damage the goodwill and reputation of the Complainant by inserting prejudicial material in relation to the Complainant. This will completely tarnish the Complainant's image if a valuable property like the domain name falls into wrong hands.

- 5.15 Respondent's website [<blackberry.org.in>](http://blackberry.org.in) displays several advertisements, where Internet users can click on an advertisement which takes them to a web page where goods/services are sold / offered. Respondent stands to gain financially in one way or another from the use it makes of the disputed domain name [<blackberry.org.in>](http://blackberry.org.in). It is thus profiting or intending to profit from the adoption of a famous mark in which it has no rights, by generating a misleading impression of some legitimate connection between the disputed domain name [<blackberry.org.in>](http://blackberry.org.in) and the Complainant. The way it has constructed the disputed domain name [<blackberry.org.in>](http://blackberry.org.in) further supports the conclusion that its real designs are to profit from the unauthorized use of the Complainant's trade/service mark and the reputation that adheres to it.
- 5.16 Thus it is clearly established that Respondent registered the disputed the disputed domain name [<blackberry.org.in>](http://blackberry.org.in) in bad faith.
- 5.17 The actions of the Respondent should not be encouraged and should not be allowed to continue. Respondent never intended to put the disputed domain name [<blackberry.org.in>](http://blackberry.org.in) into any fair/useful purpose. Respondent not even considered it worth responding the complaint of the Complainant. Respondent did not file any response. The conduct of the Respondent has necessitated me to award costs of the Complaint to and in favour of the Complainant.

## **6. Decision**

- 6.1 For all the foregoing reasons, the Complaint is allowed as below.
- 6.2 It is hereby ordered that the disputed domain name [<blackberry.org.in>](http://blackberry.org.in) be transferred to the Complainant.
- 6.3 Respondent is ordered to pay the Complainant a sum of Rs.10,00,000/- (Rupees ten lakh only) towards costs of the proceedings.

  
S.Sridharan  
Arbitrator