



चंडीगढ़ (संघ राज्यक्षेत्र) CHANDIGARH (U.T.)

699863

ARBITRATION AWARD

(On Stamp Paper)

INDRP ARBITRATION

THE NATIONAL INTERNET EXCHANGE OF INDIA [NIXI]

ARBITRAL TRIBUNAL CONSISTING OF

SOLE ARBITRATOR:

DR. ASHWINIE KUMAR BANSAL, L.L.B; Ph.D.

*Ashwinie Bansal*

**In the matter of:**

Mozilla Foundation,  
331 E. Evelyn Ave, Mountain View,  
CA- 94041, USA,

...Complainant

**VERSUS**

Mr. Md. Riyaz  
No. 32 Katcthapora Street  
Edalakudy, Kottar Post  
Coimbatore 629002, Tamilnadu

...Respondent

**REGARDING: DISPUTE DOMAIN NAME: WWW.FIREFOX.IN**

**1. The Parties:**

**Complainant:**

The Complainant in this arbitration proceedings is: Mozilla Foundation, 331 E. Evelyn Ave, Mountain View, CA- 94041, USA, Email [legal-notices@firefox.com](mailto:legal-notices@firefox.com).

**Respondent:**

The Respondent in this arbitration proceeding is Mr. Md. Riyaz,  
No. 32 Katcthapora Street, Edalakudy, Kottar Post, Coimbatore 629002,  
Tamilnadu, Email [mdriasn@gmail.com](mailto:mdriasn@gmail.com), [riyaz.me@gmail.com](mailto:riyaz.me@gmail.com)

**2. The Domain Name and the Registrar:**

The disputed domain name <[www.firefox.in](http://www.firefox.in)> is registered with Dynadot LLC (R117-AFIN) (the "Registrar").

*Ashume Patel*



### 3. Procedural History [Arbitration Proceedings]

A Complaint has been filed with the National Internet Exchange of India (NIXI). The Complainant has made the registrar verification in connection with the disputed domain name <firefox.in>. It is confirmed that at present the Respondent is listed as the Registrant and provided the administrative details for administrative, billing and technical contact. NIXI appointed Dr. Ashwinie Kumar Bansal, Advocate, as the sole arbitrator in this matter. The Arbitrator has submitted his Statement of Acceptance and Declaration of Impartiality and Independence, as required by NIXI.

NIXI sent the hard copy of the complaint and annexures by Blue Dart courier vide consignment No.14502475400 which has been duly delivered to the Respondent as per receipt sent by Blue Dart Courier.

In accordance with the INDRP Rules of Procedure (the Rules), Arbitrator notified the Respondent officially through email addresses given in the complaint as well as in the Whois-lookup. The arbitrator had sent notice on 9.4.2015 to the Respondent, with copy to Complainant and NIXI, through the email addresses to give his response in 15 days. There after one more opportunity was given to the Respondent to give his response by email dated 25.4.2015. Arbitrator had also sent a letter dated 25.4.2015 through speed post at given address of the Respondent but letter has been received back with the remark "not known". Sending letter to the last known address is a deemed communication under section 3 of the Arbitration and Conciliation Act, 1996. The Respondent has not filed any response to the said Complaint hence the case is being decided on merits.

### 4. Factual Background

The Complainant, Mozilla Foundation, was founded in the year 2003 as a California non-profit corporation. M/s Mozilla corporation was established in the

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year 2005 as a wholly owned subsidiary and licensee of Mozilla Foundation. The Complainant is registered owner of trademark FIREFOX. The Respondent as registered the disputed domain name <firefox.in> on 22.12.2014. Hence, present Complaint has been filed.

## **5. Parties Contentions**

### **A. Complainant**

The Complainant submits that disputed domain name <firefox.in> is identical and/ or confusingly similar to the trademark FIREFOX in which the Complainant has rights. The disputed domain name <firefox.in> contains the Complainant's complete trademark registered in India and other countries. The disputed domain name <firefox.in> is identical and/ or confusingly similar to the trademark of the Complainant. Such registration by the Respondent amounts to violation of Paragraph 3 of .IN Domain Name Dispute Resolution Policy ( the Policy) which states that a Registrant is solely responsible to ensure before the registration of the disputed domain name <firefox.in> that such domain name registration does not violate the rights of any third party. The Complainant contended that trademark has garnered extensive reputation and goodwill as a result of extensive promotion.

The Complainant has stated that it had coined and evolved the trademark which connotes distinctiveness, reputation, quality and goodwill acquired over several years and is associated and identified solely with the Complainant. Since adoption, the Complainant has using the trade mark in respect of its distinguished products and further it had taken steps to prevent third party for diluting the brand value associates with the trademark.

The Complainant is the owner of the trademark FIREFOX in various jurisdictions.

The Complainant submits that the disputed domain name <firefox.in> is identical or deceptively similar to its trademark and that the Respondent has no rights and

*Ashwani Bala*



legitimate interests in the disputed domain name <firefox.in>. The Respondent's registration of the disputed domain name <firefox.in> violates the Complainant's rights in its marks. As the Respondent is not connected to the mark, the Respondent's registration of disputed domain name <firefox.in> constitutes infringement and dilution of the trademark.

The Complainant submits that the disputed domain name <firefox.in> was registered in bad faith. The disputed domain name <firefox.in> was created by the Respondent for commercial gain to misleadingly divert the consumers or traders of the Complainant to the disputed domain name <firefox.in> thereby causing damage to the goodwill and business of the Complainant.

#### **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

#### **6. Discussion and Findings**

As per Paragraph 11 of the INDRP Rules of Procedure where a Respondent does not submit a response, in the absence of exceptional circumstances, the arbitrator may decide the Complaint in accordance with law. The Arbitrator does not find any exceptional circumstances in this case preventing him from determining the dispute based upon the Complaint, notwithstanding the failure of the Respondent to file a response.

It remains incumbent on the Complainant to make out its case in all respects under Paragraph 4 of the Policy, which sets out the three elements that must be present for the proceeding to be brought against the Respondent, which the Complainant must prove to obtain a requested remedy. It provides as follows:

##### *"4. Types of Disputes*

*Any Person who considers that a registered domain name conflicts with his legitimate rights or interests may file a Complaint to the .IN Registry on the following premises:*

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(i) the Registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;

(ii) the Registrant has no rights or legitimate interests in respect of the domain name; and

(iii) the Registrant's domain name has been registered or is being used in bad faith.

*The Registrant is required to submit to a mandatory Arbitration proceeding in the event that a Complainant files a Complaint to the .IN Registry, in compliance with this Policy and Rules thereunder."*

The Arbitrator will address the three aspects of the Policy listed above.

#### **A. Identical or Confusingly Similar**

The Complainant has established that it has registered trademarks rights in FIREFOX in India as per certificate dated 12.6.2008 granted by the Registrar of Trade Marks. The Complainant has also produced few other trademark certificates granted in other countries.

The trademark FIREFOX has become associated by the general public exclusively with the Complainant. The Complainant also has domain name registration incorporating the trademark FIREFOX.

The Respondent has registered the disputed domain name <firefox.in> wholly incorporating the trademark FIREFOX of the Complainant, which the Arbitrator finds is sufficient to establish confusing similarity for the purpose of the Policy.

The generic Top-Level Domain (gTLD) is typically not an element of distinctiveness that is taken into consideration when evaluating the identity or confusing similarity between a complainant's trademark and a disputed domain name<sup>1</sup>.

The Arbitrator finds that the registration of the trademark FIREFOX is *prima facie*

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<sup>1</sup> See *Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr.*, WIPO Case No. D2000-1525; *Rollerblade, Inc. v. Chris McCrady*, WIPO Case No. D2000-0429; *Phoenomedia AG V. Meta Verzeichnis Com*, WIPO Case No. D2001-0374.

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evidence of the Complainant's trademark rights for the purposes of the Policy<sup>2</sup>. Internet users who enter the domain name <firefox.in> being aware of the reputation of the Complainant may be confused about its association or affiliation with the Complainant.

The Arbitrator finds that the disputed domain name <firefox.in> is confusingly similar to the trademark FIREFOX of the Complainant.

#### **B. Rights or Legitimate Interests**

The Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in the domain name. Nevertheless, it is well settled that the Complainant needs only to make out a *prima facie* case, after which the burden of proof shifts to the Respondent to rebut such *prima facie* case by demonstrating rights or legitimate interests in the domain name<sup>3</sup>. The Complainant has registered the disputed domain name consisting of the trademark FIREFOX. The Complainant has been using the trademark for a long time. The Complainant has not authorized or permitted the Respondent to use the trademark FIREFOX. The Arbitrator finds that the Complainant has made out a *prima facie* case.

The Respondent has not filed a Response to rebut the Complainant's *prima facie* case and the Respondent has thus failed to demonstrate any rights or legitimate interests in the disputed domain name <firefox.in> as per Paragraph 7 of the Policy.

Based on the facts as stated above, the Arbitrator finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name <firefox.in>.

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<sup>2</sup> See *State Farm Mutual Automobile Insurance Company v. Periasami Malain*, NAF Claim No. 0705262 ("Complainant's registrations with the United States Patent and Trademark Office of the trademark STATE FARM establishes its rights in the STATE FARM mark pursuant to Policy, paragraph 4(a)(i)."); see also *Mothers Against Drunk Driving v. phix*, NAF Claim No. 0174052 (finding that the Complainant's registration of the MADD mark with the United States Patent and Trademark Office establishes the Complainant's rights in the mark for purposes of Policy, paragraph 4(a)(i)).

<sup>3</sup> See *Hanna-Barbera Productions, Inc. v. Entertainment Commentaries*, NAF Claim No. 0741828; *AOL LLC v. Jordan Gerberg*, NAF Claim No. 0780200.

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### **C. Registered and Used in Bad Faith**

Paragraph 6 of the Policy identifies, in particular but without limitation, three circumstances which, if found by the Arbitrator to be present, shall be evidence of the registration and use of the Domain Name in bad faith. Paragraph 6 of the Policy is reproduced below:

#### *"6. Evidence of Registration and use of Domain Name in Bad Faith*

*For the purposes of Paragraph 4(iii), the following circumstances, in particular but without limitation, if found by the Arbitrator to be present, shall be evidence of the registration and use of a domain name in bad faith:*

- (i) circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant, who bears the name or is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented out-of-pocket costs directly related to the domain name; or*
- (ii) the Registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Registrant has engaged in a pattern of such conduct; or*
- (iii) by using the domain name, the Registrant has intentionally attempted to attract Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location."*

*Ashura Bant*



Each of the three circumstances in Paragraph 6 of the Policy, if found, is evidence of "registration and use of a domain name in bad faith". Circumstances (i) and (ii) are concerned with the intention or purpose of the registration of the domain name, and circumstance (iii) is concerned with an act of use of the domain name. The Complainant is required to prove that the registration was undertaken in bad faith and that the circumstances of the case are such that the Respondent is continuing to act in bad faith.

The Respondent has registered the disputed domain name <firefox.in> and he is using the same as per **Annexure B** which is print out of web page pertaining to disputed domain name. Thus he is causing confusion in the general public. The Complainant has not granted the Respondent permission, or, a license of any kind to use its trademark FIREFOX and register the disputed domain name <firefox.in>. Such unauthorized registration and use of the trademark by the Respondent suggests opportunistic bad faith. The Respondent's true purpose in registering the disputed domain name <firefox.in> which incorporates the trademark of the Complainant is, in this Arbitrator's view, to capitalize on the reputation of the trademark FIREFOX.

The Arbitrator therefore finds that the Domain Name <firefox.in> has been registered and is being used by the Respondent in bad faith.

The trademark FIREFOX has been a well-known name in India. The domain disputed name <firefox.in> is confusingly similar to the Complainant's trademark FIREFOX, and the Respondent has no rights or legitimate interests in respect of the domain name, and he has registered and used the domain name <firefox.in> in bad faith. These facts entitle the Complainant to an award transferring the domain name <firefox.in> from the Respondent. The Arbitrator allows the Complaint and directs that the Respondent's domain name <firefox.in> be transferred in favour of the Complainant.

## 7. Decision

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Keeping in view all the facts and circumstances of the matter this Complaint is allowed here in. The disputed domain name <firefox.in> is similar to the trademark FIREFOX in which the Complainant has rights.

The Arbitrator orders in accordance with the Policy and the Rules, that the domain name <www.firefox.in> be transferred to the Complainant.

The award has been made and signed at Chandigarh on the date given below.

Place: Chandigarh

Dated: May 28, 2015

*Ashwinie Bansal*

**Ashwinie Kumar Bansal**

Sole Arbitrator

#187, Advocates Society, Sector 49-A

Chandigarh, India