

தமிழ்நாடு தமில்நாடு TAMILNADU

37180/28/12/2012

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J. SANTI

STAMP VENDOR

L.NO. 20/B3/2000

PERAMBUR, CHENNAI - 600 036

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

ARBITRATION AWARD  
DATED: 10<sup>th</sup> December 2012

Yahoo! Inc.

...

Complainant

Versus

Beaulieu Anna of Oversea Investment Inc.

...

Respondent

Sridharan

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OF NATIONAL INTERNET EXCHANGE OF INDIA**

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**Yahoo! Inc.** ... **Complainant**

**Versus**

**Beaulieu Anna of Oversee Investment Inc.** ... **Respondent**

**1. The Parties**

- 1.1 The complainant Yahoo! Inc. is a Delaware Corporation, having its registered office at 701 First Avenue, Sunnyvale, California 94089, United States of America represented by Mr. Gunjan Paharia of ZeusIP Advocates at C-4, Jangpura Extension, New Delhi-110014.
- 1.2 Respondent is Beaulieu Anna of Oversee Investment Inc. at 77 Massachusetts Ave., Cambridge, MA, 02139, USA.

**The Domain Name and Registrar**

- 1.3 The disputed domain name <[flickr.in](http://flickr.in)> is registered with 1APi GmbH (R98-AFIN) on 21.06.2012

**2. Procedural History**

- 2.1 On 31<sup>st</sup> October 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 6<sup>th</sup> November 2012, I received hardcopy of the Complaint.
- 2.3 On 6<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 7<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.

**3. Factual Background**

**A Complainant**

- 3.1 Complainant is the premier digital media company in the world, with content covering news, shopping, photo sharing, and finance, among other things, and is the second most popular electronic mail service provider in the world. Complainant connects people to their passions, their communities, and the world's knowledge by offering a comprehensively-branded network of searching, directory, information, communication, shopping, electronic commerce, and other online services to millions of Internet users

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- daily. As one of the most trafficked Internet destinations worldwide, Complainant empowers its communities of users, advertisers, publishers, and developers by creating indispensable experiences built on trust.
- 3.2 Complainant is the owner of the service mark and trademark FLICKR and the trade name FLICKR (Collectively, the "FLICKR Mark") as well as the domain name FLICKR.COM. Complainant has attached a copy of the Whois information for FLICKR.COM domain name from September 19, 2012 has been attached at Exhibit 4. In continuous use since 2004, the FLICKR Mark has become one of the most recognized brands in the world for online image and video hosting, online community hosting, and other complementary services. The website printouts of the FLICKR website from February 26, 2004 and June 12, 2012 showing the FLICKR mark in use with these services are at Exhibit 5.
  - 3.3 FLICKR-branded websites have long been among the most visited and well-recognized websites on the Internet. For example, FLICKR is the number one rated photo website globally and in the United States. Specifically, FLICKR-branded websites reached over 67.5 million unique visitors, and receiving 143.4 million total visits worldwide in January 2012 (comScore Media Metrix, Worldwide, January 2012). FLICKR-branded websites also received and 21.5 million unique visitors from the United States, while receiving 52.3 million total visits in February 2012 (see comScore Media Metrix, U.S., February 2012). There are over 6 billion photos on FLICKR-branded websites, and, on average, consumers upload more than 2,500 images every minute, adding up to more than 3 million photos posted on FLICKR websites each day. For all of these reasons, FLICKR is the most-visited photo-related website in the United States, is the number forty-eighth (48th) most visited website in the world. Printouts of various Internet audience measurements and rankings by industry experts are at Exhibit 6.
  - 3.4 Many of Flickr's current online products and services are offered to the public free of charge, with Complainant's income being primarily derived from the sale of advertising and co-branding or sponsorship agreements with other companies. Much of the advertising consists of advertisements that appear on web pages throughout FLICKR-branded websites. Complainant also sells sponsorships, promotions, and a wide array of other marketing services to its clients. Complainant displays advertisements for thousands of companies each year, which include a majority of the "Fortune 100" companies. Complainant also receives revenues from an array of electronic commerce transactions originating from FLICKR-branded websites, as well as certain premium services offered to Internet users, such as through its FLICKR PRO accounts.
  - 3.5 The trade mark/service mark FLICKR has been continuously used worldwide by the Complainant since 2004 in respect of various services including computer, communication and storage related services.
  - 3.6 Because of the extreme success and popularity of its websites, products, and services, the FLICKR Mark is the subject of much third party press and media attention throughout the world. Indeed, Complainant 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.
  - 3.7 At least four (4) domain name arbitration decisions involving the FLICKR Mark have been issued in Complainant's favor. Copies of these decisions are at Exhibit 7.
  - 3.8 In India, the Complainant has registered its mark FLICKR under Registration No.1397295 with effect from 08.11.2005 in respect of goods and services under classes 9, 38, 38, 49, 40, and 41. A printout of the details of this registration is at Exhibit 2.
  - 3.9 In the United States of America, the Complainant has registered its mark FLICKR under Registration No.3,455,275 with effect from 24.06.2008 in respect of goods and services under classes 9, 38, 38, 49, 40, and 41. A printout of the details of this registration is at Exhibit 3.
  - 3.10 On June 21, 2012, long after Complainant began using and registered its FLICKR Mark in India and the United States Respondent registered the disputed domain name [<flickr.in>](http://flickr.in)
  - 3.11 Following the registration, Respondent activated the disputed domain name and directed it to a website which provided pay-per-click links to third parties. The website

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- also states in a link that the disputed domain name is for sale, and when internet users click on the link, the user is directed to a Sedo webpage offering to sell the disputed domain name <[flickr.in](http://flickr.in)> for \$9,000 USD. Website printouts of the disputed domain name <[flickr.in](http://flickr.in)> and Sedo websites from September 19, 2012 are at Exhibit 10.
- 3.12 On July 30, 2012, August 1, 2012, and August 20, 2012, Complainant e-mailed cease-and-desist letters to the Respondent demanding, among other things, the transfer of the disputed domain name <[flickr.in](http://flickr.in)>. Respondent responded by, among other things, offering to sell the disputed domain name to Complainant for \$5,000 USD. Copies of the correspondence between Complainant and Respondent are at as Exhibit 11.

## **B Respondent**

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

## **4. Parties Contentions**

### **A Complainant**

- 4.1 The disputed domain name <[flickr.in](http://flickr.in)> is identical to Complainant's FLICKR Mark in spelling and sound. There is nothing to distinguish the disputed domain name <[flickr.in](http://flickr.in)> from Complainant's FLICKR Mark. Moreover, the addition of the country-code top level domain ".IN" to FLICKR in the disputed domain name does not render the disputed domain name dissimilar to Complainant's FLICKR Mark. ".IN" is merely a signification of the country code in the domain and thus has no distinctive quality or function. "The addition of '.IN' to Complainant's marks does not change the likelihood of confusion, as '.IN' is an irrelevant distinction." The disputed domain name is <[flickr.in](http://flickr.in)> identical and thus confusingly similar to Complainant's FLICKR Mark.
- 4.2 Furthermore, given the distinctive and arbitrary nature of the FLICKR Mark, it is highly unlikely that consumers would not confuse the disputed domain name with Complainant's FLICKR Mark. In Yahoo! Inc. v. Finance Ya Hoo a/k/a Victor Lashenko et al., D2002-0694 (WIPO Sept. 20, 2002) it was held that "the arbitrary nature of the YAHOO! mark contributed to a likelihood of confusion with domain names incorporating the "yahoo" name".
- 4.3 Respondent registered the disputed domain name <[flickr.in](http://flickr.in)> on June 21, 2012. This was long after Complainant and its predecessors first began using and registered its FLICKR Mark in India, the United States, and elsewhere. Accordingly, at the time Respondent registered the disputed domain name <[flickr.in](http://flickr.in)>, Complainant and its predecessors had already built significant reputation and goodwill in the FLICKR mark and had actively begun using the website at FLICKR.COM, which has been accessed by millions of internet users from anywhere in the world, including India. There is no evidence to show that Respondent has any rights to or legitimate interests in the disputed domain name <[flickr.in](http://flickr.in)>. Respondent's registration of the disputed domain name <[flickr.in](http://flickr.in)> is in bad faith.
- 4.4 Although Respondent has had the registration for the disputed domain name <[flickr.in](http://flickr.in)> for nearly three (3) months, since June 21, 2012, Respondent is not using the disputed domain name <[flickr.in](http://flickr.in)> in connection with the bona fide offering of any goods or services. Respondent's only use of the disputed domain name <[flickr.in](http://flickr.in)> is to derive "pay-per-click" revenues from links to third parties. In CROWNPLAZA.CO.IN, decided April 23, 2011 it was held that "the Respondent using the Disputed Domain Name in connection with a website that contains links for [competing services] is clearly not bona fide under the Rules and, therefore, does not confer upon Respondent any rights or legitimate interests in the Disputed Domain Name."
- 4.5 Respondent is not and has never been commonly known by the disputed domain name <[flickr.in](http://flickr.in)>. Neither the name of the Respondent, Beaulieu Anna, nor the business name associated with the Respondent, Overseer Investment Inc, bear any similarity to

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the FLICKR.IN. Nothing in Respondent's WHOIS information, on Respondent's website, or in the record demonstrates that Respondent is commonly known by the disputed domain name, and Complainant has in no way authorized the Respondent to use its FLICKR Mark.

- 4.6 Respondent is not making a legitimate commercial or fair use of the disputed domain name <[flickr.in](http://flickr.in)>. Instead, Respondent's actions evidence a clear intent to commercially gain by misleading consumers who believe that the disputed domain name <[flickr.in](http://flickr.in)> is affiliated with Complainant. As noted above, it appears that the only "use" of the disputed domain name <[flickr.in](http://flickr.in)> is Respondent's use to derive revenue from links to third parties, and to appear to offer legitimate competing search services, and its only purpose to sell the disputed domain name <[flickr.in](http://flickr.in)>. Respondent has clearly adopted the disputed domain name <[flickr.in](http://flickr.in)> with the intent to attract web users who are searching for Complainant's website or Complainant's products and services, and then sell the disputed domain name <[flickr.in](http://flickr.in)>. Such a use of a domain name does not constitute a legitimate interest KETELONE.COM, decided April 18, 2011. It was held in that case that "the respondent's registration was a clear case of cybersquatting because of the respondent's intention is to take advantage of the Complainant's substantial reputation and its prominent presence on the internet and thereby to confuse the public at large."
- 4.7 Respondent's registration and use of the disputed domain name <[flickr.in](http://flickr.in)> squarely meet the grounds of bad faith outlined in the INDRP.
- 4.8 Respondent undoubtedly registered the disputed domain name <[flickr.in](http://flickr.in)> in bad faith with actual knowledge of Complainant's rights in the FLICKR Mark because Complainant's FLICKR Mark is internationally famous and is registered in India and the United States, where Respondent lives. Respondent clearly knew that the inclusion of the FLICKR Mark in the disputed domain name <[flickr.in](http://flickr.in)> would serve to draw traffic to the disputed domain name <[flickr.in](http://flickr.in)>, capitalizing upon the fame of the FLICKR Mark. Indeed, the registration of a well-known mark itself is evidence of bad faith registration.
- 4.9 It is the duty of a registrant to ensure, before he registers a domain name, that the registration does not violate any third party intellectual property rights. In TIGERAIRWAYS.IN, decided Jan. 28, 2008 whereby it was held that "it is the responsibility of the Respondent to find out before registration that the domain name he is going to register does not violate the rights of any body as per the INDRP paragraph 3. Since the Complainant's mark "TIGER AIRWAYS" is a famous and well-known mark and is registered in so many countries including the country of the Respondent, it is unlikely that the Respondent did not know about the Complainant's rights in the mark or the domain name."
- 4.10 As stated above, the disputed domain name <[flickr.in](http://flickr.in)> is identical and thus confusingly similar to Complainant's FLICKR Mark. By registering a confusingly similar domain name that is identical to Complainant's Mark to offer a pay-per-click website that offers competing Internet search services, Respondent had the clear goal to attract Internet users to Respondent's website for commercial gain by creating a likelihood of confusion with Complainant's Mark, which was previously and is also in use for competing legitimate Internet search services. Under Paragraph 6(iii) of INDRP, such actions constitute bad faith.
- 4.11 Respondent's bad faith is further established by the fact that Respondent offered to sell the disputed domain name <[flickr.in](http://flickr.in)> to Complainant for an amount above its registration costs. This is further evidenced by the registrant's offer to sell the disputed domain name <[flickr.in](http://flickr.in)> to Internet users on its website through Sedo. Pursuant to Paragraph 6(i) of INDRP, circumstances indicating that the Registrant has registered or acquired a disputed domain name for the purpose of selling the domain name registration to the Complainant, who bears the name or is the owner of the trademark or service mark for valuable consideration in excess of the Registrant's out-of-pocket expenses is direct evidence of registration and use of a domain name in bad faith. Here, Respondent offered to sell the disputed domain name <[flickr.in](http://flickr.in)> consisting solely of the famous mark FLICKR to Complainant, the owner of the FLICKR mark, for \$5,000, and to Internet users generally for \$9,000, amounts which are both well above Registrant's registration costs. Such actions alone demonstrate Respondent's bad-faith registration and use of the disputed domain name <[flickr.in](http://flickr.in)> under the INDRP.

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## **B. Respondent**

4.12 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. Since the Respondent chose not to respond to this Complaint, 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.

***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 FLICKR. Complainant has been using FLICKR mark continuously since 2004. In the United States of America, the Complainant has registered its mark FLICKR under Registration No.3,455,275 with effect from 24.06.2008. In India, the Complainant has registered its mark FLICKR under Registration No.1397295 with effect from 08.11.2005. The Complainant registered his domain name [www.flickr.com](http://www.flickr.com) on 22.11.2003. The disputed domain name <[flickr.in](http://flickr.in)> was registered on 21.06.2012. Obviously, the Complainant is the prior adopter and registrant of the mark FLICKR. The above facts have established that the Complainant has both common law and statutory rights in respect of its trade mark FLICKR.

5.5 The Complainant's FLICKR marks are famous and well known throughout the world including India. It is clearly seen that the disputed domain name <[flickr.in](http://flickr.in)> wholly incorporates FLICKR, the prior registered trade mark of the Complainant. The disputed domain name <[flickr.in](http://flickr.in)> is similar to the Complainant's prior registered domain name [www.flickr.com](http://www.flickr.com). In these domain names, FLICKR is the distinguishing feature and ".in" and ".com" are non-distinctive elements.

5.6 I, therefore, find that:

- (a) The Complaint has both common law and statutory rights in respect of its trade mark FLICKR.
- (b) The disputed domain name <[flickr.in](http://flickr.in)> is:
  - (i) Identical to the Complainant's prior registered trade mark FLICKR, and
  - (ii) Similar to the Complainant's domain name [www.flickr.com](http://www.flickr.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 mark FLICKR. The Complainant's mark FLICKR is well known in many countries across the globe including India.
  - b) The Complainant's trade mark FLICKR was adopted in the year 2004. The Complainant's services are available in India also. It was registered in India in 2005. The disputed domain name <[flickr.in](http://flickr.in)> was registered by the Respondent only on 21.06.2012.
- 5.8 Respondent did not register the disputed domain name <[flickr.in](http://flickr.in)> until 2012. As such, chances are slim to none that Respondent was unaware of the famous FLICKR marks and Complainant's rights thereto prior to registering the disputed domain name in <[flickr.in](http://flickr.in)> 2012. Respondent registered the disputed domain name <[flickr.in](http://flickr.in)> long after Complainant and its predecessors first began using and registered its FLICKR Mark in India, the United States, and elsewhere. At the time Respondent registered the disputed domain name, <[flickr.in](http://flickr.in)> Complainant and its predecessors had already built significant reputation and goodwill in the FLICKR mark and had actively begun using the website at [www.flickr.com](http://www.flickr.com), which has been accessed by millions of Internet users from anywhere in the world, including India.
- 5.9 I visited the web site of the Respondent under the disputed domain name <[flickr.in](http://flickr.in)>. The disputed domain name <[flickr.in](http://flickr.in)> led to the web page which was on sale. The expression "Buy this domain; the domain flickr.in may be for sale by its owner" appeared prominently at the top right of the web site. The disputed domain name <[flickr.in](http://flickr.in)> also provided links to web sites of third parties. It is obvious that the Respondent never intended to use the disputed domain name <[flickr.in](http://flickr.in)> in connection with a bona fide offering of goods or services.
- 5.10 In the absence of response from the Respondent, I accept the argument of the Complainant that:
- a) Respondent is not using the disputed domain name <[flickr.in](http://flickr.in)> in connection with the bona fide offering of any goods or services. Respondent's only use of the disputed domain name <[flickr.in](http://flickr.in)> is to derive "pay-per-click" revenues from links to third parties.
  - b) Respondent is not and has never been commonly known by the disputed domain name <[flickr.in](http://flickr.in)>. Neither the name of the Respondent, Beaulieu Anna, nor the business name associated with the Respondent, Overseer Investment Inc, bear any similarity to the FLICKR.IN. Nothing in Respondent's WHOIS information, on Respondent's website, or in the record demonstrates that Respondent is commonly known by the disputed domain name, and Complainant has in no way authorized the Respondent to use its FLICKR Mark.
  - c) Respondent is not making a legitimate commercial or fair use of the disputed domain name <[flickr.in](http://flickr.in)>. Instead, Respondent's actions evidence a clear intent to commercially gain by misleading consumers who believe that the disputed domain name <[flickr.in](http://flickr.in)> is affiliated with Complainant. Its only purpose is to sell the disputed domain name <[flickr.in](http://flickr.in)>. Respondent has clearly adopted the disputed domain name <[flickr.in](http://flickr.in)> with the intent to attract web users who are searching for Complainant's website or Complainant's products and services, and then sell the disputed domain name <[flickr.in](http://flickr.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 <[flickr.in](http://flickr.in)>.

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

- 5.12 The Complainant is the proprietor of the mark FLICKR. Complainant has been using the FLICKR mark continuously since 2004. Complainant's services are available in India. The Complainant has registration for the mark FLICKR in India. In the United States of America, the Complainant has registered its mark FLICKR under Registration No.3,455,275 with effect from 24.06.2008. In India, the Complainant has registered its mark FLICKR under Registration No.1397295 with effect from 08.11.2005. The Complainant registered his domain name [www.flickr.com](http://www.flickr.com) on 22.11.2003. The disputed domain name <[flickr.in](http://flickr.in)> was registered on 21.06.2012. Obviously, Complainant's rights in the FLICKR trademark pre-dates Respondent's

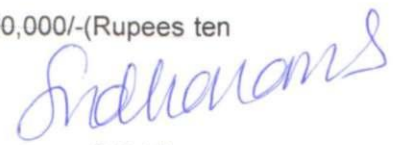
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- registration of the disputed domain name <flickr.in>. The Respondent could not have ignored, rather actually influenced by, the well-known trade mark FLICKR of the Complainant at the time he acquired the disputed domain name <flickr.in>.
- 5.13 As seen above, Respondent is currently holding the disputed domain name <flickr.in> primarily for sale and gives links to other web sites offered by third parties and not for any other purpose. The Respondent is no way connected with the Complainant. Respondent's adoption of the disputed domain name <flickr.in> is nothing but an unjust exploitation of the well-known reputation of the Complainant's prior registered trade mark FLICKR.
- 5.14 Respondent's lack of response to the Complaint indicates that the Respondent has no reason and/or justification for the adoption of the Complainant's trademark FLICKR.
- 5.15 Respondent undoubtedly registered the disputed domain name <flickr.in> in bad faith with actual knowledge of Complainant's rights in the FLICKR Mark because Complainant's FLICKR Mark is internationally famous and is registered in India and the United States, where Respondent lives. Respondent clearly knew that the inclusion of the FLICKR Mark in the disputed domain name <flickr.in> would serve to draw traffic to the disputed domain name <flickr.in>, capitalizing upon the fame of the FLICKR Mark. Indeed, the registration of a well-known mark itself is evidence of bad faith registration.
- 5.16 Respondent's bad faith is further established by the fact that Respondent offered to sell the disputed domain name <flickr.in> to Complainant for an amount above its registration costs. This is further evidenced by the registrant's offer to sell the disputed domain name <flickr.in> to Internet users on its website through Sedo. Pursuant to Paragraph 6(i) of INDRP, circumstances indicating that the Registrant has registered or acquired a disputed domain name for the purpose of selling the domain name registration to the Complainant, who bears the name or is the owner of the trademark or service mark for valuable consideration in excess of the Registrant's out-of-pocket expenses is direct evidence of registration and use of a domain name in bad faith. Here, Respondent offered to sell the disputed domain name <flickr.in> consisting solely of the famous mark FLICKR to Complainant, the owner of the FLICKR mark, for \$5,000, and to Internet users generally for \$9,000, amounts which are both well above Registrant's registration costs. Such actions alone demonstrate Respondent's bad-faith registration and use of the disputed domain name <flickr.in> under the INDRP.
- 5.17 Thus it is clearly established that Respondent registered the disputed the disputed domain name <flickr.in> in bad faith.
- 5.18 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 <flickr.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 <flickr.in> be transferred to the Complainant.
- 6.3 Respondent is ordered to pay the Complainant a sum of Rs.10,00,000/- (Rupees ten lakhs only) towards costs of the proceedings.



S.Sridharan

Arbitrator