



Government of National Capital Territory of Delhi

e-Stamp

सत्यमेव जयते

Certificate No.

Certificate Issued Date

Account Reference

Unique Doc. Reference

Purchased by

Description of Document

Property Description

Consideration Price (Rs.)

First Party

Second Party

Stamp Duty Paid By

Stamp Duty Amount(Rs.)

: IN-DL16164491964668S

: 10-Dec-2020 01:39 PM

: SELFPRINT (PU)/ dl-self/ NEHRU/ DL-DLH

: SUBIN-DLDEL-SELF36588126657435S

: KARNIKA SETH

: Article 12 Award

ARBITRATION AWARD UNDER IN REGISTRY POLICY

0

(Zero)

: KARNIKA SETH

: NOT APPLICABLE

: KARNIKA SETH

100

(One Hundred only)



SELF PRINTED CERTIFICATE
TO BE VERIFIED BY THE RECIPIENT

Please write or type below this line

ARBITRATION AWARD

Before the Sole Arbitrator, Dr. Karnika Seth

IN INDRP Case no. 1277

Statutory Alert:

1. The authenticity of this Stamp certificate should be verified at 'www.shcilestamp.com' or using e-Stamp Mobile App of Stock Holding. Any discrepancy in the details on this Certificate and as available on the website / Mobile App renders it invalid.
2. The onus of checking the legitimacy is on the users of the certificate.
3. In case of any discrepancy please inform the Competent Authority.

.IN REGISTRY
(NATIONAL INTERNET EXCHANGE OF INDIA)
.IN Domain Name Dispute Resolution Policy (INDRP)

IN INDRP Case no. 1277

Disputed Domain Name: www.backmarket.in

Dated: 10th December, 2020

IN THE MATTER OF:

JUNG S.A.S

154, Boulevard Macdonald

75019 Paris, France

..... Complainant

Vs.

JASON LAMANQUE

5 Hillrise

Trabuco Canyon

USA 92679

..... Respondent

1. Parties

- 1.1 The Complainant in this arbitration proceeding is JUNG S.A.S 154, Boulevard Macdonald, 75019 Paris, France.
- 1.2 The Respondent in this arbitration proceeding, according to 'Whois' database extract (as per Annexure 3 of complaint) and details of Respondent provided by NIXI is JASON LAMANQUE 5 Hillrise, Trabuco Canyon, USA 92679.

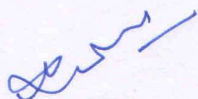
2. **The Dispute**-The domain name in dispute is “**backmarket.in**”. According to the .IN ‘Whois’ search, the Registrar of the disputed domain is InterNetworX Ltd & Co.KG

3. **Important dates**

S.No.	Particulars	Date (All communications in electronic mode)
1.	Date on which NIXI’s email was received for appointment as Arbitrator	Oct 22, 2020
2.	Date on which consent was given to act as an Arbitrator in the case	Oct 22, 2020
3.	Date of appointment as Arbitrator	Oct 26, 2020
3.	Soft copy of complaint and annexures were received from NIXI through email	Oct 26, 2020
4.	Date on which notice was issued to the Respondent	Oct 27, 2020
5.	Date on which Respondent sent a reply	Nov 2, 2020
6.	Date on which time to file rejoinder was sought by complainant	Nov 19, 2020
7.	One week’s time granted to complainant to file Rejoinder	Nov 21, 2020
8.	Rejoinder was filed by the complainant	Nov 25, 2020
9.	Award passed	December 10, 2020

4. **Procedural History**

- 4.1 This is a mandatory arbitration proceeding in accordance with the .IN Domain Name Dispute Resolution Policy (INDRP) adopted by the National Internet Exchange of India (NIXI). The INDRP Rules of



Procedure (the Rules) were approved by NIXI on 28th June, 2005 in accordance with the Indian Arbitration and Conciliation Act, 1996. The updated rules are available on <https://www.registry.in/INDRP%20Rules%20of%20Procedure>. By registering the disputed domain name with NIXI, accredited Registrar, the Respondent agreed to the resolution of the disputes pursuant to the .IN Dispute Resolution Policy and Rules framed thereunder.

- 4.2 In accordance with the Rules 2(a) and 4(a), NIXI formally notified the Respondent of the complaint and appointed Dr. Karnika Seth as the sole arbitrator for adjudicating upon the dispute in accordance with the Arbitration and Conciliation Act, 1996 and the rules framed thereunder. The Arbitrator submitted the statement of Acceptance and Declaration of impartiality and independence, as required by NIXI.
- 4.3 The Complaint was filed in accordance with the requirements of the .IN Domain Name Dispute Resolution Policy.
- 4.4 The Arbitrator issued notice to the Respondent on Oct 27, 2020 at his email address jasonlamanque@gmail.com intimating about the appointment of the Arbitrator and calling upon the Respondent to submit his reply to the Complaint within fifteen (15) days of receipt of the Arbitrator's email i.e. before 11 Nov 2020.
- 4.5 The Respondent filed his reply by email on 2 Nov 2020 contending that the said domain name is composed of generic words and claiming he has legitimate interest in it. It was averred therein that he acquired the disputed domain name for his business as a design sprint facilitator and product manager and development of his website is in process. Respondent proposed therein to sell domain name for a price of \$5,000 to cover costs of his website under development.



5. Factual Background

- 5.1 The Complainant, trading as BACKMARKET is an e-commerce company incorporated under the French law in 2014. The Company was founded by Thibaud Hug de Larauze, Quentin Le Brouster and Vianney Vaute as an electronic e-commerce company and is a leading online marketplace company providing consumers with access to refurbished or reconditioned electrical and electronic products by certified professionals including smartphones, computers and televisions.
- 5.2 The Complainant is a worldwide leading company in electronic e-commerce business and has its main office in Paris, France and also has offices in Bordeaux (France), Prague (Czech Republic) and New York (USA) employing more than 400 employees in its company. The Complainant owns the trademark "BACK MARKET" and by virtue of its long use, substantial advertising through offline and online marketing campaigns, the trademark "BACK MARKET" is associated with Complainant and has earned significant goodwill and recognition. (The Complainant filed annexures 4 to 8 along with complaint to support this claim).
- 5.3 The Respondent is Jason LaManque who is a design sprint facilitator and product manager who bought the disputed domain name on March 27, 2020. The prior registrant had registered the disputed domain name on Aug 26, 2018. This position is as per Whois record and information received by the complainant from NIXI.

6. Parties Contentions

6.1 Complainant submissions-

- 6.1.1 The Complainant states that in relation to its business, the Complainant adopted the trading name BACK MARKET which is

combination of two words with no independent meaning apart from referring to the complainant. Results of search for BACK MARKET on google were filed by the complainant as Annexure 5 with the complaint. The complainant states that over 200,000 products are sold in a month through the Complainant with around 50 million Euros worth of Gross Merchandise value in a month.

6.1.2 The complainant states that it uses the trademark "BACK MARKET" in several countries and the mark is registered in word and logo form in France and the mark has also been applied for in several other jurisdictions through an international application including European union, USA, UK, India, Canada, Brazil, China, Mexico, Singapore, amongst others and application is registered in some countries or pending consideration. A list of trademark registration granted in favour of the Complainant alongwith some registration certificates are enclosed with the complaint as **Annexure 9**.

6.1.3 The Trademark BACK MARKET (word) is also registered in India in classes 9, 35 and 37 under IRDI no.3904831(IR No. 1415150). The Complainant also submits that its trademark logo under IRDI no.4442395 (IR no. 1514729) is advertised in Trademark journal no.1943 dtd March 2,2020 which has not been opposed till date of filing complaint. Extracts of relevant journal for status of both marks in India are annexed by the Complainant as **Annexure 10 (colly)**.

6.1.4 The Complainant states it is the owner and proprietor of various domain names incorporating 'backmarket' and operates websites www.backmarket.com registered and used since 10th May, 2002, www.backmarket.fr registered and used since 12th September, 2014, www.backmarket.co.uk registered and used since April 8,2015 and backmarket.us which was registered on 8th April, 2015. The printouts



of the WHOIS page relating to the said domain names of the Complainant is annexed as **Annexure 11** to the complaint.

6.1.5 The complainant states that it has taken legal action against unauthorized registration of its domain names using BACK MARKET and received favorable decisions in respect of backmarket.se, backmarket.nl, backmarket.fi, backmarkt.si and filed certain decisions as *Annexure 12* to the complaint. The complainant states it has exclusive statutory and common law rights in trademark BACKMARKET. By prior adoption, inherent distinctiveness, extensive use and marketing and enforcement, the said mark is exclusively associated with business of the complainant. It is further claimed that the said mark also qualifies as a 'well known mark' and is entitled to protection against its unauthorized use.

6.1.6 The Complainant submits that in and around of October 2019 while the Complainant noticed that domain name backmarket.pl has been registered by one Mr. Christian Eder and also had many other registered domain names including the disputed domain name www.backmarket.in which it registered in 26th August, 2018. The Complainant served a cease and desist notice in October 2019. But before the negotiations between Mr. Christian Eder and Complainant could be concluded, Mr. Christian Eder transferred the disputed domain name to the Respondent on March 27, 2020. Complainant learnt respondent had acquired another domain backmarket.mx around same time.

6.1.7 Thereafter, the Complainant sent a legal notice dated 6th August, 2020 via email informing the Respondent of the Complainant's rights in the name and trademark BACK MARKET. The Respondent vide email dated 15th August, 2020 asked for some time till August 23rd, 2020 and subsequently sent an email dated 26th August, 2020 to the

Complainant that he is willing to sell the disputed domain name for USD 5,000. The Complainant responded to the email of Respondent by asking him to transfer the disputed domain name and all the domain names including 'back' and 'market' registered by Respondent. The Complainant also asked him to sign an undertaking to not register, use directly or otherwise, any domain using 'back' and 'market' as words. The Respondent did not agree and reiterated to sell disputed domain for USD 5000. The correspondence exchanged between parties is filed by complainant as Annexure 13 to the complaint.

6.1.8 The Complainant submits that the purchase of the disputed domain name by the Respondent (disputed domain shown in Whois as updated on 27 March 2020) is clearly subsequent to the use and registration of the Complainant's trademark BACKMARKET (since 2014) and is also subsequent to the registration of the domain name and websites registered by Complainant as shown in Annexure 9 to the Complaint. In India BACK MARKET (wordmark) was registered in name of complainant wef 17-1-2018 with respect to classes 9,35,37.

6.2 RESPONDENT'S DEFENCE

6.2.1 The Respondent filed his reply with submissions as follows: the said domain name is composed of generic words and that he registered domain name in good faith and not to target the Complainant's trademark which shows his legitimate interest. He claims that he acquired the disputed domain name in 2020 for his business as a design sprint facilitator and product manager and development of his website is in process. Respondent proposed therein to sell domain



name for a price of \$5,000 to cover costs of his website under development.

6.3 REJOINDER OF THE COMPLAINANT

6.3.1 The Complainant filed Rejoinder reiterating its submissions in the complaint and denying the averments and contentions of the Respondent. The complainant submitted that the Respondent is deemed to have constructive knowledge of the Complainant's trademark and business. A simple google search also shows sufficient evidence of rights of complainant in its trademark BACK MARKET. The Respondent did not file any proof of claiming any rights or legitimate interest in the mark. It is alleged that the bad faith registration is evident from registering disputed domain name has no apparent connection or interest in India. The Complainant along with its Rejoinder filed decision of Arbitrator dtd 7 Nov 2020 in arbitration concerning blackmarket.mx wherein Respondent was directed to transfer the said domain name to the Complainant.

7. DISCUSSION & FINDINGS

7.1 The .IN Domain Name Dispute Resolution Policy ("IN Policy"), in para 4 requires Complainant, to establish the following three requisite conditions –

- (a) The disputed domain name is identical or confusingly similar to the trademark in which complainant has rights,
- (b) The Respondent has no rights or legitimate interest in the domain name and
- (c) The Respondent's domain name has been registered or is being used in bad faith.

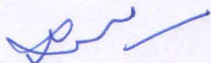


7.2 The Registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights (Paragraph 4(a))

The Complainant has filed documents of its registered trademarks in France and other countries as well as in India to prove its rights in the trademark "BACK MARKET" (annexed in Annexure 9-10 of the complaint). The Complainant is the registered proprietor of the mark "BACK MARKET" (word mark) in India under the Trade Marks Act, 1999. The Trademark BACK MARKET (word) is registered in India in classes 9, 35 and 37 under IRDI no.3904831(IR No. 1415150). The Complainant also submits that its trademark logo under IRDI no.4442395 (IR no. 1514729) is advertised in Trademark journal no.1943 dtd March 2,2020 which has not been opposed till date of filing complaint. Further Complainant has filed supporting proof (annexure 10,11 of complaint) of extensive use, marketing and enforcement of trademark in other countries too and claimed it qualifies as a 'well known mark' recognized worldwide (see *Jung S.A.S v Yvonne van Zadelhoff*, WIPO Case no. DNL20200013.)

The Complainant submits that as the disputed domain name is www.backmarket.in, it is clearly identical/ confusingly similar to the Complainant's trademark in which the Complainant has exclusive rights and legitimate interests. Therefore, it is established that the Complainant has statutory trademark rights in the mark BACK MARKET in India as early as 17 January 2018.

As per WIPO Synopsis 3.0, while each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be



considered confusingly similar to the mark for purposes of UDRP standing.

The disputed domain name consists of "BACK MARKET", the Complainant's trademark in entirety and the cc TLD ".in". It is settled law that the presence or absence of spaces, punctuation marks between words or indicators for top-level domains, such as .com, or ccTlds .in, co.in are irrelevant to the consideration of similarity between a trademark and a disputed domain name. (*Six Continents Hotels ,inc v Contact privacy inc Customer 0151534653/ Mark Serrano, Crown Plaza, Crowne Plaza, WIPO Case No.D2018-2872*).

Therefore, the Arbitrator finds that the Complainant's registered trademark and the disputed domain name www.backmarket.in are identical or confusingly similar.

7.3 The Registrant has no rights or legitimate interests in respect of the domain name (Paragraph 4(b))

Under paragraph 6 of the policy, a Respondent or a Registrant can prove rights or legitimate interest in the domain name. The submission of the Respondent that he was not targeting the Complainant's trade mark when he registered the disputed domain name is unacceptable as it is the duty of the Respondent to perform trademark searches prior to registration of a domain name, about any third-party rights, interests or privileges that may be violated/ infringed by the proposed registration and thus this stand of Respondent cannot be considered tenable. Particularly so, as the disputed domain name comprised of a trademark which was widely used by the Complainant both offline and online evident from Google



search results filed by the complainant at Annexure 5 to the complaint. Also, the contentions of the Respondent that he registered the disputed domain name for his business as a design sprint facilitator and product manager and his website is in process of development is rejected as no supporting proof of the same has been filed by the Respondent. Thus, merely on basis of an averment unsubstantiated with proof, the Respondent has failed to establish alleged legitimate interests in the domain name. (*Capitalmatch Pty Ltd v Registrar Technician, bestregistrar.co*, ,Case WIPO No.D2015-2165; *Vita-Cos-Med Klett-Loch GmbH v. Perfect Privacy, LLC / MVB & Associates, Inc. and Theresa Wainright*, WIPO Case No. D2014-0978)

The Arbitrator finds that the disputed domain name was registered to take advantage of the distinctive character and reputation of the Complainant's trademark as evident from his proposal to sell the disputed domain name at an exorbitant price of USD 5000 to the Complainant as evidenced from the email correspondences exchanged between parties filed as Annexure 13 to the complaint and reply filed by Respondent in present arbitration proceedings.

Also, Respondent has failed to show any right or legitimate interest in the disputed domain name as neither he nor his business has any bonafide connection with trademark 'back market'. The Respondent also failed to show that he is making any legitimate, non commercial or fair use of domain name without intent for commercial gains nor is likely to divert consumers or tarnish trademark by registering the disputed domain name. Registration of domain name for reselling or preventing its legitimate use did not give any rights to the respondent

as held in *Permira IP Limited v Paperboy & Co INDRP /092 and LF LLC v Lira INDRP /1128*.

The Arbitrator finds that the Respondent has no rights and/or legitimate interests in the disputed domain name as the Respondent.

7.4 The Registrant's domain name has been registered or is being used in bad faith (Paragraph 4 (c))

For the purposes of Paragraph 4 (c) of .IN Policy, under Paragraph 7 of the policy the Complainant is required to establish that the domain name was registered or is being used in bad faith.

The Complainant has secured registration of the mark "BACK MARKET" (word mark) in India since 17 January, 2018 in relation to electronic e-commerce products and goods. Respondent has produced no evidence or justification for registering the disputed name which shows he intended to hoard the domain and use it for purposes of selling it to complainant or his competitor at an exorbitant price. This is evident from correspondence exchanged between parties filed at Annexure 13 of complaint and reply filed by the Respondent. Respondent stated therein that he would agree to transfer the disputed domain name to complainant only if he is paid USD 5000, which is an exorbitant price for transfer of a domain name. In his reply to present arbitration proceedings he sought to justify the offer price by stating that he bought domain for his business and in order to compensate him for costs of website development, which is underway he was seeking the said price. However, Respondent failed to file any supporting proof to substantiate his averments. For the said reasons, the contentions and submission of the Respondent is rejected.

(see section 3.3 of WIPO Synopsis 3.0, Virgin Enterprises Limited v. Cesar Alvarez, Case No. D2016-2140; Telstra Corporation Ltd v Nuclear Marshmallows, WIPO case no. D2000-0003; Polaroid Corporation v Jay Strommen WIPO Case No. D2005-1005.)

The Respondent has registered the disputed domain name to prevent complainant from registering or using the mark. The Respondent has engaged in pattern of such conduct as he has also registered another domain backmarket.mx which he refused to transfer to Complainant despite cease and desist notice served upon him through counsel of complainant (Annexure 13 filed with the complaint). The Complainant also filed along with its Rejoinder decision of Arbitrator dtd 7 Nov 2020 whereby the respondent has been directed to transfer the domain backmarket.mx to the complainant.

It is evident from aforesaid facts that Respondent had no connection with trademark BACK MARKET and his sole aim was to sell it at a higher price to complainant or his competitor which amounts to bad faith registration under .IN policy.

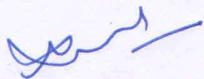
As stated before, Respondent was under obligation to check if registering disputed domain name would not infringe another entity's rights which he failed to fulfill. The complainant's domain name www.backmarket.com was created and used since 2002, www.backmarket.fr from Sept 12, 2014 and www.backmarket.us since 8.4.2015 (supporting document filed as annexure 11 to complaint). The disputed domain name www.backmarket.in was registered by earlier registrant on 26.08.2018 and was registered by respondent on 27 March 2020. Thus, Complainant's rights in the BACKMARKET



mark pre-date Respondent's registration of the disputed domain name and on basic keyword search (as filed in **Annexure 5** with complaint), respondent would have known that registration of disputed domain name will infringe complainant's rights in trademark BACK MARKET. The transfer of a disputed domain name to a new registrant, with new contact details is considered new registration (see *Vita-Cos-Med Klett-Loch GmbH v Perfect Privacy, LLC /MVB & Associates, Inc and Theresa Wainright WIPO Case No. D2014-0978*)

The Respondent is also currently not using the disputed domain name in any manner and preventing its bonafide registration and use by complainant, particularly when he has not been able to show any legitimate interest or connection for registering backmarket.in in India. Further, the Complainant affirmed that he has neither authorized nor licensed to the Respondent to use the word 'Back Market' in any manner and the Respondent in no way is connected with the Complainant.

The Respondent has offered to sell it to the Complainant for \$5,000 which is exorbitant price without showing any supporting proof that he has incurred costs for development of the website for the disputed domain. Therefore, it is evident that the Respondent has registered the disputed domain name solely for selling domain name to the complainant or its competitors at a high and unreasonable price which or capitalize on reputation with BACKMARKET trademark of complainant amounts to bad faith registration as per the INDRP policy.



For the aforesaid reasons, the Arbitrator finds the disputed domain name has been registered and used in bad faith under the .IN Policy.

8. DECISION

On the basis of the abovesaid findings the sole arbitrator finds that:

- (a) The Complainant has successfully established three grounds required under the policy to succeed in these proceedings
- (b) Respondent has failed to successfully rebut averments, contentions and submissions of the complainant.

The Arbitrator directs the .IN Registry of NIXI to transfer the domain name “backmarket.in” to the Complainant.

The Award is passed on this 10th December 2020.

Place: Noida



Dr. Karnika Seth
Sole Arbitrator