



सत्यमेव जयते

INDIA NON JUDICIAL

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e-Stamp

Certificate No.

: IN-DL29222240176561T

Certificate Issued Date

: 11-Jan-2021 04:37 PM

Account Reference

: IMPACC (IV)/ dl721003/ DELHI/ DL-DLH

Unique Doc. Reference

: SUBIN-DL72100361876472497726T

Purchased by

: V P PATHAK

Description of Document

: Article 12 Award

Property Description

: Not Applicable

Consideration Price (Rs.)

: 0
(Zero)

First Party

: V P PATHAK

Second Party

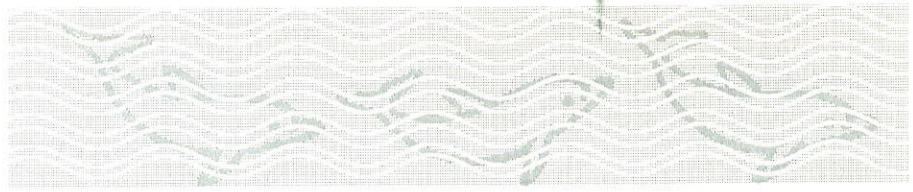
: Not Applicable

Stamp Duty Paid By

: V P PATHAK

Stamp Duty Amount(Rs.)

: 100
(One Hundred only)



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BEFORE THE ARBITRAL TRIBUNAL

V.P.PATHAK

SOLE ARBITRATOR

ARBITRAL AWARD

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.
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3. The onus of checking the legitimacy is on the users of the certificate.
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V.P. Pathak
V. P. PATHAK
H.J.S.
Former Judge
Sole Arbitrator

DISPUTED DOMAIN NAME: WWW.MERCADOLIBRE.IN
IN THE MATTER OF INDRP CASE NUMBER 1304/2020
.IN REGISTRY (NATIONAL INTERNET EXCHANGE OF INDIA)

MERCADOLIBRE, INC.

15 EAST NORTH STREET

DOVER, DELAWARE
19901-3609,

UNITED STATES OF
AMERICA

....COMPLAINANT

AND

YE GENRONG

NO.1 XUEYUAN
ROAD,

LISHUI, ZHEJIANG,

CHINA - 323000

....RESPONDENT

AWARD

1. The present domain name dispute relates to the registration of the domain name "www.mercadolibre.in" in favor of the Respondent.
2. The Complainant has filed the instant complaint challenging the registration of the domain name "www.mercadolibre.in" in favor of the Respondent. Pursuant to the ".in" Domain Name Dispute Resolution Policy {INDRP} and the rules framed there under, the Complainant has preferred this arbitration for raising this dispute for reprisal of its grievances.
3. The Declaration of impartiality and acceptance was sent by the Tribunal on 14/12/2020, but the Complaint was received to me on 18/12/2020 and according to **Rule 5 of the INDRP Rules**, I issued notice on the 18.12.2020 calling upon the Respondent to file its reply on the

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compliant within fifteen days from the date of receipt of the notice and rejoinder within fifteen days thereafter.

4. **Rule 2 of INDRP Rules of Procedure** provides for communication/services of complaint. In accordance with this rule, the respondent was sent a complaint on the email shown in the domain name registration data in .IN Registry's WHOIS database, which has not returned so far.
5. On the direction of the Tribunal, Complainant also sent an email and hard copy of the complaint to the Respondent. But, no reply was filed by the Respondent.
6. Since the complainant has been served through one of the modes as specified in Rule 2 (above mentioned), I am of the view that the service of the complaint upon the respondent is complied with.
7. A courier was also sent to the Respondent and as per the Complainant the courier was returned back to the Complainant with the reason that the address of the Respondent was incomplete/incorrect. This was brought to the Tribunals knowledge on Jan 4, 2021, 7:06 PM via email.
8. Since, there has been no response from the Respondents to the Complaint, so according to **Rule 12 of INDRP Rules of Procedure** which states about default of parties wherein it is clearly mentioned that:

"In the event of any party breaches the provisions of INDRP rules and/or directions of the Arbitrator, the matter can be decided *ex-parte* by the Arbitrator and such arbitral award shall be binding in accordance to law."

9. Further, **Section 25 of the Arbitration Act, 1996** says that the Arbitrator may pass *ex-parte* in the absence of any of the parties to Arbitration. It is also the duty of the Arbitrator to inform the parties concerned about his intention to proceed with the case *ex-parte*.
10. **Order VIII Rule 10 of CPC** also authorizes the arbitrator to pronounce judgment against the Respondent or to make such an order in relation to the Complaint as it thinks fit in the event, the Respondent fails to file its reply to the Complaint in the prescribed period of time as fixed.
11. Following are some of the cases in which the court has allowed *ex-parte*, when either of the parties have not responded to the Tribunals notice:

SARASWATHI CHEMICALS v. BALMER LAWRIE & CO. LIMITED. 2011

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(3) TMI 1759 MADRAS HIGH COURT: it was held that the Arbitrator has to inform the parties that he intends to proceed with the reference at a specified time and place , whether that party attends or not. If still a party does not attend, then only the Arbitrator is at the liberty to proceed *ex-parte* against him.

12. In the above situation when the Respondent has not responded even after lapse of stipulated period for filing their counter, an order was passed on 06/01/2021 that the case will now proceed *ex-parte* and an award will be passed. **Rule 6 of the INDRP Rules** also states that an Arbitrator has to be impartial and independent therefore, I accordingly proceed to pass the award on merit.

CONTENTIONS

13. Since the Respondent has been proceeded *ex-parte*, I shall deal with the contention of the Complainant. The complaint has been filed for transfer of the disputed domain name www.mercadolibre.in, which was registered by the Respondent.
14. The assertion of the Complainant in its complaint is that the disputed domain name is identical and similar to the trade mark of MERCADOLIBRE. The Complainant in its complaint has stated that the company is duly organized and existing under the laws of United States of America, established in 1999. Since its inception in the same year, the Complainant and its affiliates i.e. Tech Fund S.R.L, MercadoLibre Chile Limitada, MercadoLibre S.R.L. and Tiklral S.A. (collectively known as "MELI Group") have continuously and widely used the Trademarks, in connection with the operation of multiple online marketplaces dedicated to e-commerce and online auctions, including www.mercadolibre.com.
15. Document evidencing the incorporation of the Complainant and its adoption of the mark "MERCADOLIBRE" in the year 1999 showing continuous use of the said mark by the Complainant since 1999 until the present year are annexed in **ANNEXURE- B**.
16. The Complainant has advertised its services under the said marks through various means, including placement in leading online channels across Latin America, paid and organic positioning in leading search engines, email and

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push notification marketing, onsite marketing and presence in offline events, which are accessible by consumers globally.

17. Hence, by virtue of over twenty-one years of extensive marketing, sales, and enforcement, the Complainant now operates the largest online commerce ecosystem in Latin America under the Trademarks. As a result, such of such extensive use and promotion undertaken by the Complainant, the Trademarks are therefore now famously and solely associated with the Complainant. Copies of extracts from the Complainant's social media pages are annexed herewith as **Annexure-E**.
18. Complainant has further stated that it is the proprietor of mark "MERCADOLIBRE", having valid and subsisting Trademarks registration. The Complainant has produced on record showing the details of ownership of numerous trademark registrations for MERCADOLIBREI in various jurisdictions/ regions.
19. The Complainant also contends that the Respondent itself has reached out to the Complainant with an offer for sale of the Disputed Domain Name. Therefore, it is evident that the Respondent has registered the domain name with mala fide, and has no intention of using the same except to further re-sell the disputed domain name for unfair commercial gains. (**ANNEXURE- K**)
20. It is also pertinent to note that the Respondent has in the past registered domain names comprising third party trademarks, in bad faith. In actions taken against the Respondent by third parties who owned the concerned marks, adverse orders were passed against the Respondent.
21. This further indicates that the Respondent habitually engages in such illegal activities i.e. wrongfully registering domain names which are identical / similar to marks owned by third parties with the motive to earn unjust profits, and the same appears to be Respondent's *modus operandi* for making unfair commercial gains.
22. Full decisions passed in the cases of *Shiseido Co. Ltd. vs. Ye Genrong* and *Bloomberg Finance L.P. vs. Ye Genrong* are annexed herewith as **Annexure-L** and **Annexure-M**.
23. The Respondent is not a licensee of the Complainant nor has been otherwise authorized by the Complainant to make any use of its MERCADOLIBRE trademark, in a domain or otherwise. The Complainant has also stated that it operated to develop a strong presence online by being active on social media

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on Facebook, Youtube and LinkedIn. Copies of extracts from the Complainant's social media pages are annexed herewith as **Annexure-E.**

ANALYSIS

24. As the proceedings are set *ex-parte* the Respondent, I shall deal with the complaint on its prayer for transfer of the disputed domain name. The disputed domain name www.mercadolibre.in consists the mark 'MERCADOLIBRE', which is the registered trademark of the Complainant. 'MERCADOLIBRE' is a mark registered which has been established by the Complainant over a period of time by its use. The Complainant has used it world over, and owns registered trademark. In support of which, the Complainant has placed on record the details of trademark registration. All these support the Complainants right over the name 'MERCADOLIBRE'. Therefore, the Complainants claim that it has a right over the disputed name stands proved.
25. As the Respondent's action to register the said domain name is not bona fide, and has also in the past registered domain names comprising third party trademarks, in bad faith for which adverse orders were passed against the Respondent which indicates the Respondents habitual engagements in illegal activities by wrongfully registering identical/similar to marks, owned by third parties with the motive to earn unjust profits for making unfair commercial gains.
26. Therefore, the said registration is done in bad faith. The disputed domain name wholly incorporates the Complainant well known mark 'MERCADOLIBRE' and mentions the same multiple times creating an impression that the Respondent in some way is associated with the Complainant. The Complainant has specifically stated that it has no relation with the Respondent commercially or otherwise. So, therefore, the use of Trademark 'MERCADOLIBRE' by the Respondent is not lawful. Therefore, the Respondent has no legitimate right over the said domain name.

CONCLUSION:

27. In view of the above, it is evident that the Respondent has registered the said domain name solely to block it and sell it further to earn unjust profits and that it has no rights or

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H.J.G.
Former Judge
Sole Arbitrator

legitimate interest in the Disputed Domain Name. Considering the facts and circumstances of the present matter and taking view of the precedents in this context, I am of the view that the Complainant has proprietary right over the mark "MERCADOLIBRE" followed by the Complainants registered Trademark "MERCADOLIBRE" will not distinguish the Respondents disputed domain name. Under the facts and circumstances and on perusal of the records, I deem it fit and proper to allow the prayer of the Complainant and direct the Registry to transfer the said domain name i.e., www.mercadolibre.in in favor of the Complainant.

28. It is made clear to all concerned that the award is being passed in accordance with the INDRP Rules and Arbitration Act, 1996 has been fully followed by the Tribunal.
29. It is clear from record that Respondent has registered the domain name www.mercadolibre.in maliciously for wrongful gain so it should be liable for arbitration cost. Accordingly Respondent has to pay the Arbitration cost.

ORDER

30. Since the Complainant has proved its case through its documentary evidence under INDRP Rules, so it is directed that the disputed domain name www.mercadolibre.in be transferred to the Complainant forthwith. Respondent is directed to pay the Arbitration cost to the Complainant.
31. IN Registry to do the needful.
32. This award is passed today at New Delhi on 16/01/2021.

V.P. Pathak
16/01/21
V.P. PATHAK
H.J.S.
Former Judge
Sole Arbitrator
SOLE ARBITRATOR

DATE: 16/01/2021