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INDIA NON JUDICIAL

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Property Description	: Not Applicable
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**BEFORE THE NATIONAL INTERNET EXCHANGE OF INDIA
[NIXI]**

**SOLE ARBITRATOR: PANKAJ GARG
COMPLAINT NO.INDRP 1308/2020**



**GOOGLE LLC
V.**

**XIAMEN TIANMU ZHUANGSHI
SHEJI YOUXIAN GONGSI**

**ARBITRATION AWARD
DISPUTED DOMAIN NAME:GOOGLECLASSROOM.IN**

Statutory Alert:

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CORAM:
HON'BLE MR. PANKAJ GARG

REPRESENTATIONS:

a. The Complainant **GOOGLE LLC**

Through,
Authorized Representative in these proceedings are :
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Fidus Law Chambers,
Email: shwetasree@fiduslawchambers.com
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b. The Respondent **XIAMEN TIANMU
ZHUANGSHI SHEJI YOUXIAN GONGSI**
Huliqu Jiangtoug Taiwanjie 288hao, Xiamen,
Fujian, 361000,
China
Through None- *Ex parte*

The present Complaint has been filed by the Complainant against the Respondent before the National Internet Exchange of India (NIXI) under the INDRP Rules of Procedure (The Rules of Procedure) with regard to the domain dispute googleclassroom.in seeking the transfer of the



impugned domain name to the Complainant, who is the legitimate owner of the trade mark "GOOGLE".

2. The NIXI referred this Complaint to this Tribunal and this Tribunal accepted the reference of the NIXI on 18.12.2020.

3. On 7.1.2021 this Tribunal passed an order proceeding *ex parte* against the Respondent after declaring the service of the documents and Complaint sufficient upon the Respondent in terms of the provisions of Rule 3 of the INDRP Rules.

4. The Complainant is a Delaware limited liability company, having its Headquarters at Mountain View, California, U.S.A. Complaint is based on the adoption and use of the registered well known trade mark "GOOGLE" of the Complainant and is used in connection with its domain name. The "GOOGLE" trade mark has also been registered under the Indian Trade Mark laws in favour of the Complainant.

5. The Complainant avers as under:-

- i. The Complainant's highly reputed search engine under the trademark **GOOGLE** was created in 1997 by Stanford Ph.D. candidates Larry Page and Sergey Brin.



Since that time, the Complainant's search engine has become one of the most highly recognized and widely used Internet search services in the world. The Complainant's primary website is located at www.google.com, and the Complainant owns and operates hundreds of additional domain names under the trademark **GOOGLE** and its variants, including nearly every top-level country code domain consisting solely of the **GOOGLE** trademark.

- ii. In addition to search technologies and related activities, the Complainant is well-known for a wide range of goods and services, including online advertising, web browser software, email services, mobile phones, laptops, and its accessories. The Complainant's search engine platform is integrated with these other products and services of the Complainant.
- iii. The search engine service under the trademark **GOOGLE** maintains one of the world's most impressive collections of indexed online content. It provides an easy-to-use interface, advanced search technology, and a



comprehensive array of search tools that allows internet users to search for and find a wide variety of online content in many different languages. The search technology is not only accessible from desktop computers but can also be accessed from most mobile and wireless platforms. The search engine service under the trademark **GOOGLE** is available in 150 languages.

- iv. The trademark **GOOGLE** was found to be one of the top five Best Global Brands throughout the last several years. In fact, in 2019, the Brand Finance Global 500, which identifies the world's most valuable brands, ranked the Complainant as one of the top-most valuable brands in the world and was valued at USD 142.8 Billion. Additionally, the Complainant's website has been recognized as one of the most popular destinations on the Internet for many years, well before the registration of the Domain Name.comScore, among others, ranked the Complainant's websites as among the most visited group of websites as early as 2004.



- v. The trademark **GOOGLE** is also a part of the Complainant's company name i.e. Google LLC as well as various other trademarks of the Complainant. Thus, the trademark **GOOGLE** is not only associated to the search engine services offered under it but also with various other goods and services that the Complainant offers. According to Forbes, the trademark **GOOGLE** ranked second in the top 10 most valuable trademarks and brand in the world, valued at \$ 167 billion as per their 2019 report.
- vi. As per 2019 report of 'Best Global Brands' issued by Interbrand, a brand consultancy involved in brand analytics and valuation, the Complainant was ranked no. 2 amongst the top 15 brands worldwide. According to comScore Media Metrix from the year 2018, **GOOGLE** is the number 1 Web property in the United States, with over 240 million unique visitors/month. Alexa, a web traffic ranking company, lists the search engine under the trademark **GOOGLE** as the top-most visited website for many countries, including India.



- vii. The Complainant's highly reputed search engine service has been operating under the trademark **GOOGLE** since its launch in 1997. The trademark **GOOGLE** is a unique mark for the services for which the same is used and it has no meaning or resemblance whatsoever to services of any kind or nature.
- viii. The Complainant has a significant global presence with more than 150 offices worldwide. The products and services of the Complainant reach more than 150 countries worldwide, including India. The Complainant owns and operates over 190 **GOOGLE** based domains where search can be accessed.
- ix. The Complainant has consistently used the trademark **GOOGLE** as a part of its products, services and business since the year 1997 and has been given the status of a well-known trademark globally.
- x. The Complainant has consistently been honored for its technology and its services and has received numerous industry awards.



I. THE COMPLAINANT'S TRADEMARK RIGHTS

- xi. The trademark **GOOGLE** identifies the Complainant's award-winning, proprietary, and unique search services, search engine technology, and associated products and services. The trademark **GOOGLE** is well known and is therefore, subject to broad protection in India and internationally. The protection is a result of the Complainant's worldwide use of the trademark **GOOGLE**, extensive advertising and promotion of the services offered under it, media coverage, and a high degree of consumer recognition.
- xii. The Complainant owns numerous registrations for the trademark **GOOGLE** in the United States and across the globe dating back to as early as 1999. Each registration remains valid and in full force and effect.
- xiii. The Complainant has registered its trademark "**GOOGLE**" and various forms of the trademark in India in Classes 9, 16, 20, 25, 38, and 42, details of which are set out below:



Trademark	Registration /Application no.	Application Date	Class(s)	Status
GOOGLE	845041	12/03/99	9	Registered
GOOGLE	1480385	17/8/06	38	Registered
GOOGLE	1237958	18/09/03	42	Registered
GOOGLE	1351909	20/04/05	35	Registered
GOOGLE	1351910	20/04/05	16	Registered
GOOGLE	1351911	20/04/05	25	Registered
GOOGLE	2378924	13/08/12	39	Registered
GOOGLE	1480380	21/08/06	36	Registered
Google	1404165	06/12/05	9	Registered



Google	1404168	06/12/05	42	Registered
Google	2176019	15/07/11	9, 35, 36, 42	Registered
GOOGLE	2166829	28/06/11	3,20	Registered
Google	2297910	13/03/12	42	Registered
Google	3178084	05/02/2016	9, 25, 35, 36, 38, 39, 42,	Registered

II. RECOGNITION OF THE TRADEMARK GOOGLE AS A WELL-KNOWN TRADEMARK IN INDIA:

- xiv. The Complainant has conceived, adopted and used the trademark “**GOOGLE**” in connection with its online search engine services since 1997 and the same has been in use continuously till date. By virtue of its adoption more than twenty years ago, and extensive use thereof, the trademark **GOOGLE** has become exclusively and



globally associated with the Complainant in the eyes of consumers. Additionally, the trademark **GOOGLE** has also been declared a 'well known' trademark by the Delhi High Court in 2011. By the virtue of the said order, the trademark **GOOGLE** has been included in the well-known trademark list maintained by the Indian Trademark Registry. Therefore, use of this mark by any third party will lead to confusion and deception among the consumers and general public.

- xv. The Complainant also owns a country specific domain at www.google.co.in that is registered since June 23, 2003.
- xvi. Since August 2014, the Complainant has provided a free web service titled "Google Classroom," developed by the Complainant for schools, that aims to simplify creating, distributing, and grading assignments in a paperless way. The primary purpose of the web service under the trademark 'Google Classroom' is to streamline the process of sharing files between teachers and students.



- xvii. The Complainant has successfully pursued domain name complaints before the WIPO and National Arbitration Forum and obtained favorable decisions in respect of numerous infringing domain names such as ‘*googleplace.in*, *googleseoservices.in*, *googlepays.in*, *googleblog.com*, *google-0.com*, *chotagoogle.com*, *google-montenegro.me*, *google-sina.com*, *google-vietnam.com*’ etc. All these decisions acknowledge the Complainant’s proprietorship over the trademark **GOOGLE**.

III. THE RESPONDENT

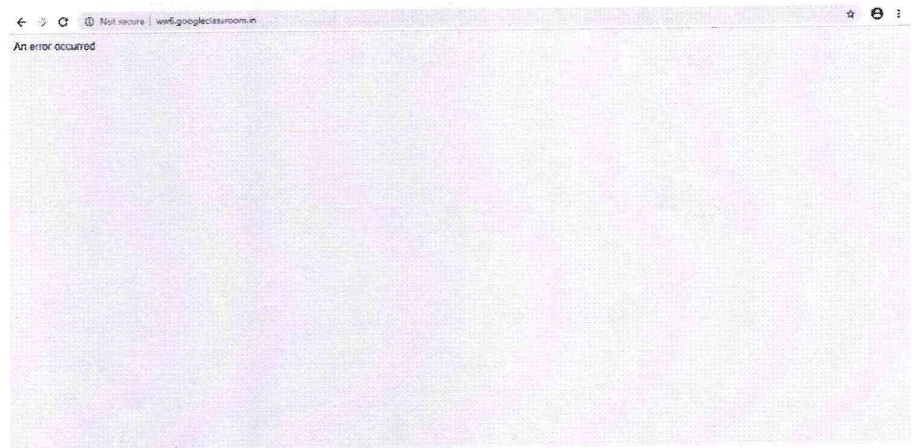
- xviii. The Complainant was recently made aware of the existence of the domain name *googleclassroom.in* (hereinafter referred as ‘the disputed domain’) which subsumes the Complainant’s registered trademark **GOOGLE** in its entirety. This amounts to infringement of the Complainant’s rights in the trademark **GOOGLE**.

- xix. The disputed domain was registered on March 29, 2020, significantly subsequent to the Complainant’s adoption



and use of the trademark **GOOGLE** and registration of the domains www.google.com and www.google.co.in.

- xx. The disputed domain, when accessed, is redirected to http://ww6.googleclassroom.in/ and the landing page displays the following message i.e. "*An error occurred*". Screenshot of the landing page is reproduced below:



- xxi. By registering a domain that comprises the Complainant's well-known trademark **GOOGLE**, the Respondent presumably intends to profit commercially via exploitation of the Complainant's rights in the trademark, irrespective of the fact whether a website is being hosted on the disputed domain as on today. Thus, it is evident that as of today, the sole value of the



disputed domain name is dictated by its relation to the Complainant's registered trademark **GOOGLE**.

xxii. The Complainant has filed the present complaint which is based on the following legal grounds:

A. The disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights

a) According to the Brand Finance Global 500, which identifies the world's most valuable brands, the trademark **GOOGLE** is the most valuable brand in the world. "The notoriety of the [Google] trade-name and trademark is therefore a fact which by itself constitutes proof of ownership and distinctiveness and Complainant's legitimate rights." *Google Inc. v. Gillespie*, FA1203001434643 (Nat'l Arb. Forum May 10, 2012).



b) The Complainant has used the trademark **GOOGLE** since well prior to March 29, 2020, the registration date of the Disputed domain. Indeed, all of the Complainant's registrations for the trademark **GOOGLE** listed in

Annexure L were issued well prior to that date and these filings remain valid and in force. In light of these filings and the Complainant's substantial and exclusive use of the trademark **GOOGLE**, Complainant owns protectable rights in these marks that predate the registration date of the disputed domain. *See, e.g., Pirelli & C. S.p.A. v. Tabriz*, FA921798 (Nat'l Arb. Forum April 12, 2007); *FDNY Fire Safety Edu. Fund, Inc. v. Miller*, FA 145235 (Nat'l Arb. Forum March 26, 2003) ("[T]he FDNY's successful registration of its mark on the Principal Register is evidence of its rights in the mark."); *Google Inc. v. Smithers*, FA0610000826563 (Nat'l Arb. Forum Dec. 7, 2006) ("Although [r]espondent's registration of the [disputed domain names] predate [sic] Complainant's USPTO registration, Complainant's filing date of September 16, 1998 predates [r]espondent's registration [which] sufficiently establishes rights in the GOOGLE Mark.").



c) The Sole Arbitrator appointed in the matter of *Google Inc. v. Mr. Gulshan Khatri* (Case No. INDRP-189 May 06, 2011), in relation to the domain *googlee.in*, held that the act of registering a domain name similar to or identical with or famous trade mark is an act of unfair competition whereby the domain name registrant takes unfair advantage of the fame of the trademark to either increase traffic to the domain, or to seize a potential asset of the trademark owner in the hope that the trademark owner will pay the requirement to relinquish the domain name. As such, the same principle is applicable here as well since the disputed domain name is identical to the trademark **GOOGLE** of the Complainant.

d) A domain name is “nearly identical or confusingly similar” to a complainant’s mark when it “fully incorporate[s] said mark.” *PepsiCo, Inc. v. PEPSI SRL*, D2003-0696 (WIPO Oct. 28, 2003) (holding *pepsiadventure.net*, *pepsitennis.com*, and others confusingly similar to complainant’s PEPSI mark since they “incorporate[ed the] trademark in its



entirety”) Here, the disputed domain `googleclassroom.in` incorporates the Complainant’s famous trademark **GOOGLE** in its entirety, merely adding the generic or descriptive term “classroom,” and therefore is confusingly similar to the trademark **GOOGLE**.

- e) In this instance, the disputed domain name merely adds the generic term “classroom.” The addition of this element in the Complainant’s trademark does not negate a finding of confusing similarity under the Policy. *See Multi Media, LLC v. Private Whois, Global Domain Privacy Services Inc. / Waist Corset*, D2018-0420 (WIPO April 16, 2018) (“Panel agrees with the Complainant’s contentions that the addition to CHATURBATE, of the numbers ‘2018’ does not distinguish the disputed domain name from the Complainant’s trademark, which is clearly identifiable in the disputed domain name.”); *Am. Online, Inc. v. Oxford Univ.*, FA 104132 (Nat. Arb. Forum Mar. 19, 2002) (finding several domain names that added the numeral “7” or the term “seven” to the complainant’s AOL mark



were confusingly similar to the mark under UDRP Policy4(a)(i)); *see also Am. Online, Inc. v. garybush co uk*, FA 360612 (Nat. Arb. Forum Dec. 22, 2004) (“Respondent’s domain name is confusingly similar to Complainant’s AOL mark because the disputed domain name incorporates the mark with the mere addition of the non distinctive number ‘0.’ The addition of the number ‘0’ is insufficient to distinguish the domain name from Complainant’s mark.”).

- f) The fame of the distinctive trademark **GOOGLE** will cause users encountering the disputed domain name to mistakenly believe that the disputed domain name originates from, is associated with, or is sponsored by the Complainant. *Google Inc. v. Gillespie*, FA1203001434643 (the Forum May 10, 2012) (concluding that the domain names <googlelivejournal.com>, <googlechiefs.com>, and <googlepoland.com>, among many others, confusingly similar to Complainant’s trademark **GOOGLE** where the registrant incorporated non-distinctive generic and/or



geographic terms to the trademark **GOOGLE**, and ordering transfer of such domain names to Complainant); *Google Inc. v. Renz*, FA1609001694123 (Nat. Arb. Forum October 28, 2016) (finding <googleqq.com> confusingly similar to the trademark **GOOGLE** for purposes of UDRP Policy 4(a)(i)).

- g) As such, the disputed domain name is nearly identical and confusingly similar to Complainant's trademark **GOOGLE**.

B. The Respondent has no rights or legitimate interests in respect of the disputed domain name:

- a) Under paragraph 7 of the .IN Domain Dispute Resolution Policy (INDRP), any of the following circumstances, if found by the Panel, may demonstrate a Respondent's rights or legitimate interests in a disputed domain name:

- Before any notice to it of the dispute, the Respondent's use of, or demonstrable preparations to use, the domain name or a



name corresponding to the domain name in connection with a bona fide offering of goods or services; or

- The Respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- The Respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

b) In the present case, the Respondent is not a part of or is related to the Complainant. The Complainant has not authorized or licensed Respondent to use any of its trademarks, including its registered trademark **GOOGLE**. Unlicensed, unauthorized use of domains incorporating a Complainant's trademark is strong evidence that Respondent has no rights or legitimate interest in the disputed domain name. See, e.g., Time



Warner Inc. v. MLM Capital LLC d/b/a Domains,
FA0709001076561 (Oct. 26, 2007).

c) As already shown above, the Respondent is not using the said domain and has been passively holding the same. The Respondent has no intention to use the disputed domain name or a name corresponding to the domain name in connection with a bona fide offering of goods and services. Reliance is placed on *HSBC Holdings PLC vs. Hooman Esmail Zadeh* [INDRP Case No. 032] where it was held that non-use and passive holding of a domain are evidence of bad faith registration.

d) It is submitted in the words of the Sole Arbitrator in *Kraft Foods Global Brands, LLC v. Jet Stream Enterprises Limited, Jet Stream* (Case No. D2009-0547) that "...while the overall burden of proof rests with Complainant, panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is often primarily within the knowledge of the respondent. Therefore, a



complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests. Once such *prima facie* case is made, respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP. See *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. D2003-0455; *Belupod.d. v. WACHEM d.o.o.*, WIPO Case No. D2004-0110.”

It is submitted that the said threshold has been satisfied in the present instance.

- e) Hence it is submitted that the Respondent is not using the disputed domain name for a *bona fide* offering of services, nor making a legitimate non-commercial or fair use of the Complainant’s trademark under the Policy.



Based on the above, it is evident that the Respondent’s use of the disputed domain name is neither a *bona*

fide offering of services, nor a legitimate non-commercial or fair use pursuant to the Policy.

C. The disputed domain name was registered and is being used in bad faith.

a) The evidence overwhelmingly supports the conclusion that Respondent registered and is using the disputed domain name in bad faith. The fame and unique qualities of the trademark **GOOGLE**, which was adopted and used by the Complainant prior to the registration of the disputed domain name, render it wholly implausible that Respondent created the disputed domain name independently. The Respondent's willful intent to violate the Complainant's intellectual property rights is further exhibited by the inclusion of the entirety of the trademark **GOOGLE** apparently to refer to the Complainant's trademark **GOOGLE** and 'Google Classroom' offering in the disputed domain name. *See, e.g., The J. Jill Group, Inc. v. Zuccarini d/b/a RaveClub Berlin*, FA0205000112627 (Nat'l Arb.



Forum Jul. 1, 2002) (“Because of the famous and distinct nature of Complainant’s mark and Complainant’s J. JILL listing on the Principal Register of the USPTO, [r]espondent is thought to have been on notice as to the existence of Complainant’s mark at the time [r]espondent registered the infringing <jjilll.com> domain name. Thus, [r]espondent’s registration despite this notice is evidence of bad faith registration”). It is thus clear that Respondent intentionally registered the at-issue disputed domain name to improperly exploit its trademark value, rather than for some benign reason. See *Google LLC v. Weilong*, FA1810001810319 (Nat’l Arb. Forum October 30, 2018).

- b) *In Google Inc. v. Ning Yang WIPO Case No. D2011-1044*, it was held that – “the Respondent knew or ought to have known of the Complainant’s worldwide exclusive rights in the GOOGLE trademark dating back to September 1997 and the sale of the Complainant’s products and services in well over 150



countries including Australia where the Respondent is based. Secondly, the Respondent with the deliberate intention to create a likelihood of confusion with the Complainant's trademark in the minds of Internet visitors elected to register the disputed Domain Name in February 2011. Accordingly, as the Complainant argues, the Respondent must be deemed to have had actual or constructive notice of the Complainant's established rights in the GOOGLE trademark, which considered on its own, is clear evidence of bad faith registration."

- c) Given Respondent's registration of a disputed domain that fully incorporates the trademark **GOOGLE**, it is impossible to conceive of any potential legitimate use of the disputed domain. Here, the "[r]espondent has appropriated a trademark having a strong reputation and widely known." *Ferrari S.p.A. v. Joohee*, D2003-0882 (WIPO Dec. 18, 2003). "[I]t is [therefore] not possible to conceive of any plausible



actual or contemplated active use of the domain name[s] by the [r]espondent that would not be illegitimate, such as passing off, or an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law." *Id.*; see also, *Banco Bilbao Vizcaya Argentaria, S.A. v. Okon*, D2004-0245 (WIPO May 31, 2004) (finding that registrant's "passive use" amounted to bad faith use due to the fame of the complainant's mark and lack of evidence of any good faith). As such, the Respondent is using the disputed domain name in bad faith.

- d) Furthermore, where a disputed domain name is "so obviously connected with such a well-known name and products," "it's very use by someone with no connection with the products suggests opportunistic bad faith." *Parfums Christian Dior v. Quintas*, D2000-0226 (WIPO May 17, 2000). Indeed, Respondent "could not have chosen or subsequently used...its domain name[s] for any reason other than



to trade on that name and to confuse Internet users and by that means to attract them to a website with a name which is the same as that of the prominent mark. That is, in itself, evidence of bad faith.” *Control Techniques Ltd. v. Lektronix Ltd.*, D2006-1052 (WIPO Oct. 11, 2006).

e) Accordingly, Respondent has registered and is using the disputed domain name in bad faith.

6. The Complainant prays for the following reliefs:-

- (i) That the dispute outlined in the present Complaint be submitted to arbitration in accordance with the dispute resolution policy and rules framed thereunder, as per Rule 3(b)(i) of the INDRP Rules of Procedure, 2005;
- (ii) That the .IN Registry of NIXI be directed to transfer the disputed domain name/URL of the Respondent -googleclassroom.in- to the Complainant;
- (iii) That the costs of the present proceedings be granted to the Complainant;



(iv) That any other order, in the facts and circumstances of the case and in the interest of justice, may be passed in present case.

APPRECIATION & OBSERVATION:

7. Since no reply was filed by the Respondent even after giving sufficient opportunities to the Respondent, this Tribunal now in terms of its order dated 7.1.2021, proceeds for passing an *ex parte* Award on merits.

8. The Complainant filed the Complaint along with all necessary documents and evidences. In the evidence, the Complainant proved the facts stated in the Complaint by way of documents duly annexed with the Complaint.

9. The dispute relates to the domain name googleclassroom.in, which is a trade mark backed domain name. The Respondent's domain name googleclassroom.in also amounts to an infringement of the statutory and common law rights of the Complainant in its registered 'GOOGLE' mark. The Trade Mark 'GOOGLE' is already registered in India and complainant has already acquired a legal right in the trade mark



‘GOOGLE’ in terms of the provisions of section 17 of The TM Act, 1999. It is also a settled law that domain name may have all the characteristics of a Trade Mark and could found a connection for passing of (*Satyam Infoway Ltd. Vs. Sify Net Solutions Pvt. Ltd.*, (2004) 6 SCC 145—Para 16).

10. For the purpose of examination that whether the reliefs sought by the Complainant can be allowed or not, it is much necessary to appreciate the legal position along with the facts submitted by the Complainant. In this regard it is much necessary to discuss the provisions of Section 29 of the Trade Marks Act, 1999 (for short ‘T M Act, 1999’). Section 29 of the T M Act, 1999 reads as under:-

“29. Infringement of registered trade marks.—

(1) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.



(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of—

(a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or

(b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or

(c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark, is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

(3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public.

(4) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which—

(a) is identical with or similar to the registered trade mark; and



(b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and

(c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.

(5) A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern dealing in goods or services in respect of which the trade mark is registered.

(6) For the purposes of this section, a person uses a registered mark, if, in particular, he—

(a) affixes it to goods or the packaging thereof;

(b) offers or exposes goods for sale, puts them on the market, or stocks them for those purposes under the registered trade mark, or offers or supplies services under the registered trade mark;

(c) imports or exports goods under the mark; or

(d) uses the registered trade mark on business papers or in advertising.



(7) A registered trade mark is infringed by a person who applies such registered trade mark to a material intended to be used for labelling or packaging goods, as a business paper, or for advertising goods or services, provided such person, when he applied the mark, knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee.

(8) A registered trade mark is infringed by any advertising of that trade mark if such advertising—

*(a) takes unfair advantage of and is contrary to honest practices in industrial or commercial matters;
or*

(b) is detrimental to its distinctive character; or

(c) is against the reputation of the trade mark.

(9) Where the distinctive elements of a registered trade mark consist of or include words, the trade mark may be infringed by the spoken use of those words as well as by their visual representation and reference in this section to the use of a mark shall be construed accordingly."



11. Section 29 of The TM Act speaks the owner/proprietor of the registered trade mark claiming the infringement of the said mark by another person, who is neither a registered

Proprietor in relation to the goods and services, for which the mark is registered, nor has permission to use such mark in the course of his trade. Under the provisions of Section 29(1), infringement results if the mark is identical with or deceptively similar to the already registered trade mark and is in relation to the goods and services, for which the trade mark has been registered.

12. Under Section 29(2)(b), infringement occurs where the impugned mark is similar to the registered mark and the goods and the services, for which is used is identical with or similar to the goods and services, for which the registered mark is used. Under Section 29(2)(c), infringement occurs where the impugned trade mark is identical to the registered trade mark and the goods or services, for which the impugned mark is used is also identical to the goods and services covered by the registered trade mark.



13. An additional ingredient in the above three situations for the infringement is that the use of impugned trade mark is likely to cause confusion on the part of the public or is likely to have an association with the registered trade mark. Under

Section 29(3), when the impugned trade mark is identical to the registered trade mark and the goods/services, for which it is used, are also identical to the goods or services, for which the registration has been granted, then the adjudicating authority shall presume that it is likely to cause confusion on the part of the public.

14. Thus, under Section 29(1), (2) and (3) for infringement to result-

- (a) The impugned mark has to be either similar to or identical with the registered mark;
- (b) The goods or services, for which the impugned mark is complained, has to also either be identical with or similar to the goods or services, for which the registration has already been granted.

The scenario is different as regards Section 29(4) of The TM Act, 1999. For infringement to result under Section 29(4), the following conditions are required to be fulfilled:-



- (i) The person using the impugned mark is neither a registered Prop. in relation to the goods and services, for which the mark is registered, nor is using it by way of permitted use;
- (ii) The impugned mark must be used in course of trade;
- (iii) The impugned mark has to be either similar to or identical with the registered mark;
- (iv) The impugned mark is used for goods and services different from those, for which the registration has been granted;
- (v) The registered trade mark has a reputation in India;
- (vi) The use of impugned mark is without due cause and takes unfair advantage of or is detrimental to-

- The distinctive character of the registered trade mark; or



- The reputation of the registered trade mark.

15. The question to be adjudicated by this Forum is whether the person using the impugned mark has obtained it *bona fide*ly or whether the permission given for the impugned trade mark/mark does not violate the conditions, as discussed hereinabove. For the purpose of analyzing this, the expression “mark” has to be understood. The mark has been defined under Section 2(m) of The TM Act to include a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of good, packaging or combination of colour and any combination thereof. Thus, for the purpose of Section 29(4), the use of mark which is a part of domain name would also attract infringement. What is important is that the registered trade mark must be shown to have been used by the infringer. It should be shown without such adoption or use as resulted into infringer taking unfair advantage of the registered trade mark or is detrimental to the distinctive character or reputation of the registered trade mark.



16. Section 2(zg) of The TM Act defines a well-known trade mark in relation to any goods or services to mean a mark, which has become so popular to the substantial segment of the public, which uses such goods or receives such services that the use of such mark in relation to either goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first mentioned goods and services.

17. In *Apple Computer Inc. Vs. Apple Leasing and Industries*, 1999 SCC Online Del. 308 it is held that where improper use of the name or trade mark is considered, then the confusion created between the two trade mark has to be considered. Further, coming to Section 29(5) of The TM Act, it is seen that it relates to a situation where the infringer uses his trade mark as his trade name or part of his trade name and the business concerned of the infringer is for the same goods or services, in respect of which the trade mark is registered. In view of this Tribunal, the provisions of Section 29(5) cannot be said to render Section 2(4) of The TM Act, 1999 as



infructuous. Even when the infringer is the registered user of the same mark, then the question arises for the purpose of adjudication is whether the registration of the mark was obtained in good faith or whether it is being used in good faith or whether it is creating a confusion in the public or whether it is a creature of the infringer or not or whether it is copied by the infringer from the mark of the Complainant.

CONCLUSION:

18. As per the material placed on record and the averments made in the Complaint and also in the annexed evidences and documents, which have been proved in evidence since un rebutted and admitted by the Respondent and also in view of the cited case laws, it is evident that the trade mark "GOOGLE" is a well known trade mark and addition of generic word "classroom" cannot change its specific and statutory character. The same is known to most of the people of the entire world. No one is entitled and can be authorized to use the same either as a domain name or as a trade mark in relation to the similar or dissimilar business, as the said domain name/trade mark has got a unique goodwill and reputation.



19. The impugned domain name consists of a prefix word 'GOOGLE', which is already a registered trade mark of the Complainant. Henceforth, it is immaterial whether the impugned domain name was registered prior to or after the registration of the 'GOOGLE' trade mark. The impugned domain name pertains to the territory of India and the Complainant's trade mark 'GOOGLE' is not only worldwide recognized but also a registered trade mark in India, therefore, only the Complainant can be the legitimate owner of the trade mark 'GOOGLE' and impugned domain name and not the Respondent.

20. In the opinion of this Tribunal, the impugned domain name is a trade mark backed domain name and it not only violates the provisions of The TM Act, 1999 but also violates Clause 4 of the INDRP policy issued by the NIXI. The impugned domain name conflicts with the legitimate rights and interest of the Complainant on the following premises:-



- (a) The impugned domain name is identical and confusingly similar to a named trade mark as

well as service mark, in which the Complainant has a right;

- (b) Respondent has no right or legitimate interest in respect of the impugned domain name;
- (c) The Respondent's impugned domain name has been registered and is being used in bad faith by using the registered trade mark of the Complainant and giving a pecuniary loss to the Complainant by using the name and trade mark of the Complainant.

21. The evidences filed by the Complainant have gone un rebutted as well as proved by the Complainant, therefore, the statements and documents filed by the Complainant are accepted as correct deposition. In view of the facts and settled law, with the deposition and documents of the Complainant placed before this Tribunal, the Complaint is deserves to be allowed for an Award on merits in favour of the Complainant, as prayed in Para No.21 of the Complaint by the Complainant.



DECISION

- a) In view thereof, it is directed that the domain name googleclassroom.in be transferred in favour of the Complainant by the Registry. As a result, the Respondent, his agents, servants, dealers, distributors and any other person(s) acting for and on its behalf are permanently restrained from using the domain name googleclassroom.in or any other deceptively similar trade mark, which may amount to infringement of Complainant's registered trade mark and also from doing any other thing, which is likely to create confusion and deception with the goods/services of the Respondent for any connection with the Complainant.
- b) The Complaint is allowed in the above terms.
- c) Respondent is hereby directed to pay to the Complainant a sum of Rs.50,000/- (Rupees Fifty Thousand only) towards costs of the proceedings.



- d) National Internet Exchange of India (NIXI) is advised to take incidental or ancillary action involved in the transfer of the domain name, as directed.


(PANKAJ GARG)
SOLE ARBITRATOR

Place: New Delhi
Date : 13th of January, 2021

