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INDIA NON JUDICIAL

Government of National Capital Territory of Delhi

e-Stamp

Certificate No.

: IN-DL29222932978181T

Certificate Issued Date

: 11-Jan-2021 04:37 PM

Account Reference

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

Unique Doc. Reference

: SUBIN-DL72100361876237338713T

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

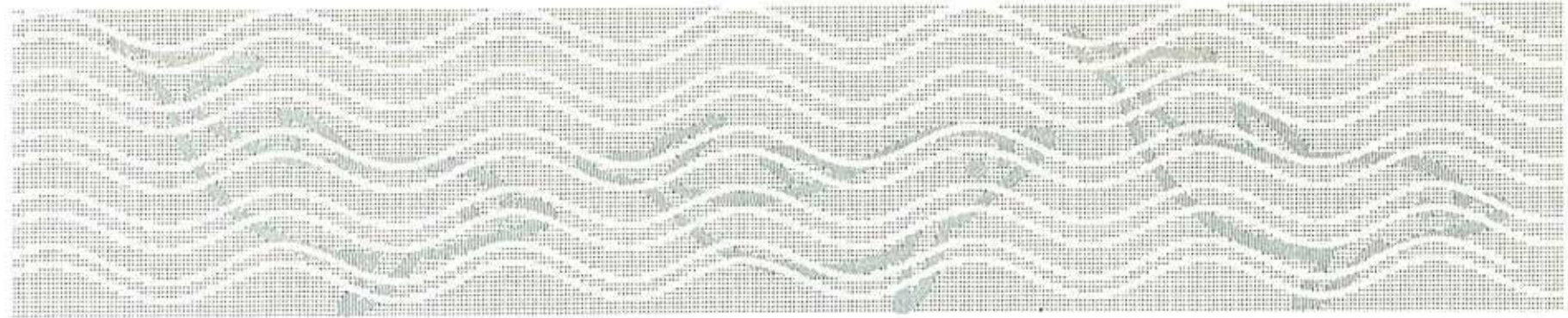
Stamp Duty Paid By

: 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 AWARDDISPUTED DOMAIN NAME: WWW.TABOOLA.CO.IN

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.
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V.P. Pathak
V. P. PATHAK
H.J.S.
Form
Sole Arbitrator

IN THE MATTER OF INDRP CASE NUMBER 1309/2020
.IN REGISTRY (NATIONAL INTERNET EXCHANGE OF INDIA)

TABOOLA.COM LTD.
2 JABOTINSKY STREET,
RAMAT GAN 5250501,
ISRAEL

....COMPLAINANT

AND

CHENG GONG LI
10,XITUCHENG,HAIDIAN
BEIJING
CHINA - 100876

....RESPONDENT

AWARD

1. The present domain name dispute relates to the registration of the domain name "www.taboola.co.in" in favor of the Respondent.
2. The Complainant has filed the instant complaint challenging the registration of the domain name "www.taboola.co.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 30/12/2020, and according to **Rule 5 of the INDRP**

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Former Judge
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Rules, I issued notice on the 01.01.2021 calling upon the Respondent to file its reply on the complaint 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. 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."

8. 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*.
9. **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,

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the Respondent fails to file its reply to the Complaint in the prescribed period of time as fixed.

10. 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 (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.

11. 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 16/01/2021 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

12. 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.taboola.co.in, which was registered by the Respondent.
13. The assertion of the Complainant in its complaint is that the disputed domain name is identical and similar to the trade mark of TABOOLA. The Complainant in its complaint has stated that the Complainant was incorporated on September 3, 2006 in Israel for operating as a recommendation engine for video content. From the date of its inception, the Complainant has become an internationally operating enterprise and a leading entity for private advertising services.

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HATHAK
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14. The Complainant is the ultimate parent company of 22 entities located across various jurisdictions including Taboola Inc. (located in Delaware, USA) and Taboola India Private Limited (located in Delhi, India). A chart depicting the related companies of the Complainant is annexed herewith as **ANNEXURE NO. 1**. Taboola India Private Limited, a wholly owned subsidiary of the Complainant, operates as a reseller of the Complainant in India; also provides services to the Complainant.
15. The Complainant honestly and *bona fide* adopted/registered the trademark "**TABoola**" on January 14, 2016 with the Indian Trademarks Registry under Class 9 and Class 42. The Complainant has a legal interest in its registered trademark (in Indian and numerous other countries) and well-known brand "**TABoola**" ("**Complainant's Trademark**") that has been adversely affected by the Respondent's conduct. Furthermore, the Complainant's wholly owned subsidiary Taboola Inc. has registered 221 domain names under its own name.
16. The Complainant's Trademark is distinctive to the Complainant's services alone and the services provided under the trademark have a large-scale global impact, including in India. By virtue of the said sale/wide advertisements, the Complainant's Trademark has acquired enviable goodwill/reputation in respect of the services of the Complainant in India as well as abroad.
17. The Complainant has common law/statutory rights in the Complainant's Trademark. Additionally, the Complainant has also registered trademarks, with regards to its Internet and advertising services, in several countries of the world including but not limited India, China, Japan, Canada, Israel, Thailand, Korea, United States of America, Turkey, Mexico, Brazil, Australia and European Union. Copies of the registration certificates of the abovementioned Complainant's Trademark is annexed herewith as **ANNEXURE NO. 8**.
18. The disputed domain name <www.taboola.co.in> directs the viewer to a page which states that the disputed domain name

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<taboola.co.in> may be available for sale and then instantly redirects the user to a blank landing page. The contents of the website leaves the impression that the Respondent has no intention to carry out any business activities but only to direct Internet traffic to a website which is broken and/or damaged. The Respondent has failed to use the disputed domain name <www.taboola.co.in> in connection with a *bona fide* offering of goods or services or legitimate non-commercial or fair use. Instead, the disputed domain name <www.taboola.co.in> appears to be a broken page containing no information regarding the Respondent or any other third party.

19. The disputed domain name <www.taboola.co.in> has been registered under the name of the Respondent since February 19, 2013. There is no evidence that the disputed domain name <www.taboola.co.in> has been continuously used to carry out the commercial activities of the Respondent as the disputed domain name <www.taboola.co.in> does not resolve to an active website. The disputed domain name <www.taboola.co.in> directs the viewer to a page which states that the disputed domain name <taboola.co.in> may be available for sale and then instantly redirects the user to a blank landing page. Moreover, the Respondent does not have rights or legitimate interests in the disputed domain name <www.taboola.co.in> because the Respondent is not commonly known by the disputed domain name <www.taboola.co.in>.

20. It is further submitted that due to the success and popularity of the Complainant's business operations the Respondent had actual knowledge of the Complainant's trademarks prior to registration of the disputed domain name <www.taboola.co.in>. The Complainant's Trademark is used on the domain name <taboola.net>, registered on August 24, 2012, which further evidences that the Complainant's Trademark is used prior to the Respondent's existence. Due to the prior existence of the Complainant's Trademark, the Respondent ought to have known

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Sole Arbitrator

about the business operations of the Complainant and should have exercised due caution and care while registering the disputed domain name <www.taboola.co.in>.

21. The disputed domain name <www.taboola.co.in> is being used to cause the *bona fide* users/customers of the Complainant's goods/services to mistakenly believe that the broken landing page created by the Respondent has a connection with the business operations of the Complainant. Contents displayed on the disputed domain name <www.taboola.co.in> is annexed herewith as **ANNEXURE NO. 6.**

22. The effect of the disputed domain name registration <www.taboola.co.in> is that consumers looking for the Complainant are misdirected to the Respondent's website and that the Respondent obtains a commercial advantage from using the Complainant's Trademark. As a result, the Respondent is riding upon the goodwill and reputation of the Complainant for its own benefit, thus constituting bad faith.

23. That the Complainant is extremely vigilant when it comes to protection of its trademark in order to prevent the same from becoming generic in nature or getting diluted. The Complainant has been successful in taking action against similar, *mala fide* and deceptive domain names. The domains names against which successful actions have been taken by the Complainant and where reliefs have been granted in favor of the Complainant, are listed below :

- *Taboola.com Ltd. v. Domain Manager / samirnet -domain names for sale, FA1752333 (Nat. Arb. Forum, Nov. 22, 2017)*
- *Taboola.com Ltd. v. Raaj Brar, FA 1752345 (Nat. Arb. Forum, Nov. 16, 2017)*
- *Taboola.com Ltd. V Domain Admin/Whois Privacy Corp, FA1811228 (Nat. Arb. Forum, October 15, 2018)*

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- *Taboola.com Ltd. v. Fusberta Fraser, FA1813357 (Nat. Arb. Forum, October 25, 2018)*
- *Taboola.com Ltd. v. Tomas, FA1901001825538 (Nat. Arb. Forum, February 12, 2019)*
- *Taboola.com Ltd v. jac ma, FA1904001839036 (Nat. Arb. Forum, May 14, 2019)*
- *Taboola.com Ltd. v. Gear Adx, FA1908001858744 (Nat. Arb. Forum, Sept. 21, 2019)*
- *Taboola.com Ltd. v. Whois privacy protection service/ Internet Invest, Ltd. dba Imena.ua FA1912001876393 (Nat. Arb. Forum, Jan. 23, 2020)*
- *Taboola.com Ltd. v. Jaskirat Narula, FA2003001888868 (Nat. Arb. Forum, April 14, 2020)*
- *Taboola.com Ltd. v. Samanta Francis / PR Brands, FA2004001890831 (Nat. Arb. Forum, May 6, 2020)*
- *Taboola.com Ltd. v. Francis, FA2009001911247 (Nat. Arb. Forum, October 6, 2020)*
- *Taboola.com Ltd. v. Elisabeth Dunn, FA2005001896261 (Nat. Arb. Forum, June 11, 2020)*
- *Taboola.com Ltd. v. Bianca Stafford, FA1910001867776 (Nat Arb. Forum, November 27, 2019)*
- *Taboola Ltd. v. Mr. C., FR - 2020-02032 (AFNIC Arb Forum, July 06, 2020)*
- *Taboola.com Ltd. v. Steven Csepregi, FA2010001918360 (Nat. Arb. Forum, November 18, 2020)*

24. The copies of the above-mentioned arbitral awards in the domain name disputes are annexed herewith as **ANNEXURE NO. 10.**

V. *[Signature]*
H.J.S.
Former
Sole Arbitrator

ANALYSIS

25. 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.taboola.co.in consists the mark 'TABOOLA', which is the registered trademark of the Complainant. 'TABOOLA' 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 'TABOOLA'. Therefore, the Complainants claim that it has a right over the disputed name stands proved.
26. Therefore, the said registration is done in bad faith. The disputed domain name wholly incorporates the Complainant well known mark 'TABOOLA' 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 'TABOOLA' 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 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 "TABOOLA" followed by

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H.J.S.
Former Judge
Sole Arbitrator

the Complainants registered Trademark "TABOOLA" 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.taboola.co.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.taboola.co.in maliciously for wrongful gain.

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.taboola.co.in be transferred to the Complainant forthwith. Parties are directed to bear their own Arbitration cost.

31. IN Registry to do the needful.

32. This award is passed today at New Delhi on 23/01/2021.

V.P. Pathak
23/01/2021
V.P. PATHAK
H.J.S.
Sole Arbitrator
SOLE ARBITRATOR
DATE: 23/01/2021