

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

Disputed Domain Name: www.remitly.in

Dated: 27th July, 2021

IN THE MATTER OF:

Remitly, Inc.

1111, 3rd Avenue,

21st Floor, Seattle

WA 98101, United States of America

.....Complainant

Vs.

Kenneth Palo

..... Respondent

1. Parties

- 1.1 The Complainant in this arbitration proceeding is Remitly Inc., having address at 1111, 3rd Avenue, 21st Floor, Seattle WA 98101, United States of America. The Complainant is represented by Anand & Anand law firm in India.
- 1.2 The Respondent in this arbitration proceeding as per 'Whois' record is Kenneth Palo (as per **Annexure A** of complaint). Upon enquiry from NIXI made by the Complainant, the email address of the respondent was found to be kenpalo@outlook.com.

2. **The Dispute-** The domain name in dispute is “www.remitly.in” registered by the Respondent on 24-7-2017. According to the .IN ‘Whois’ search, the Registrar of the disputed domain name is 1APi GmbH.

3. **Important Dates**

S. No	Particulars	Dates (All communication in electronic mode)
1.	Date on which NIXI’s email was received for appointment as Arbitrator.	March 1, 2021
2.	Date on which consent was given to act as an Arbitrator in the case.	March 1, 2021
3.	Date of Appointment as Arbitrator.	March 2, 2021
4.	Soft Copy of complaint and annexures were received from NIXI through email.	March 2, 2021
5.	Date on which notice was issued to the Respondent	March 3, 2021
6.	Date on which Complaint filed proof of completed service of complaint on Respondent	July 26, 2021
7.	Date on which Award passed	July 27, 2021

4. **Procedural History**

- 4.1 This is 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 accredited Registrar of NIXI, the Respondent agreed to the resolution of the dispute pursuant to the .IN Dispute Resolution Policy and Rules framed thereunder.

- 4.2 In accordance with the Rules 2(a) and 4(a) of INDRP Rules, NIXI formally notified the Respondent of the complaint and appointed Dr. Karnika Seth as a 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.
- 4.4 The Arbitrator issued notice to the Respondent on March 3rd, 2021 at the email address kenpalo@outlook.com calling upon the respondent to submit his reply to the complaint within fifteen (15) days of receipt of the Arbitrator's email i.e., March 17, 2021. Due to Covid Pandemic time was further extended by three weeks. The Complainant also filed proof of completed service of the complaint upon Respondent on 26th July, 2021. However, the Respondent failed to submit any response.
- 4.5 Despite notice, the Respondent failed to file any reply. Therefore, in accordance with the Rule 12 of INDRP Rules, the Arbitration proceedings were conducted ex-parte and the Award is passed which is binding on both parties herein.



5. Factual Background

- 5.1 The Complainant is engaged in the business of providing products and Solutions to facilitate international payments and was incorporated on 13th October, 2011 in the United States. The Complainant leverages digital channels including mobile phones to enable its customers to send money internationally.
- 5.2 The Complainant's trademark 'REMITLY' has been allegedly used by over three million people based in 17 countries such as USA, Canada, United Kingdoms, Singapore and Australia for transferring money internationally. The Complainant also has a mobile app under the trademark REMITLY with a rating of 4.5/5 on Google play Store. The Complainant's service is also used by people living outside India to send money in India through 135+ trusted banks, UPI or direct bank transfer.
- 5.3 The Complainant owns numerous trademark registrations/pending Applications using the words REMITLY and its formatives in USA, Argentina and Brazil (as per **Annexure B** of complaint). The Complainant owns exclusive rights in the 'REMITLY' trademark in many countries around the world including in India. The trademark REMITLY (device) is also registered in India in classes 9, 36 and 42 under IRDI no.3304159 (IR No.1283040) (as per **Annexure B** of Complaint). The trademark "REMITLY" by virtue of its long use, substantial advertising and promotion throughout the world, the trademark "REMITLY" is exclusively associated with the Complainant and has earned significant goodwill and international recognition.
- 5.4 The Complainant has been using the "REMITLY" trademark distinctively for use in connection with its goods and services and also



maintains the website www.remitly.com since 2012 as part of its corporate name and domain name (collectively referred to as “the Remitly marks and names”).

- 5.5 The Complainant also has extensive following of its trademark on social Media websites such as Facebook, Twitter and Instagram showing the popularity and reputation it has earned for its goods and services (as per **Annexure C** of Complaint). The Complainant’s trademark when searched online on search engines like www.google.com and www.google.co.in shows REMITLY in search results pertaining to only the Complainant (as per **Annexure D** of complaint).
- 5.6 The Respondent in this administrative proceeding as per ‘Whois’ database is Kenneth Palo (as per **Annexure A** of the complaint). Upon enquiry from NIXI made by the Complainant, the email address of the respondent was found, that is kenpalo@outlook.com.

6. Parties Contention

6.1 Complainants’ Submission

- 6.1.1 The Complainant operates its business using trademark REMITLY and facilitates international payments through digital channels including mobile phones. The Complainant claims that it has been using its mark continuously for its goods and services, not only in India but across various other countries such as United States, Argentina and Brazil. Due to its established reputation across various countries including India, the word “REMITLY” has been exclusively associated with the Complainant and no one else. The Complainant claims to have gained popularity and reputation through use of its trademark REMITLY on



social media websites such as Facebook, Twitter and Instagram wherein the Complainant has extensive following (as per **Annexure C** of the complaint).

- 6.1.2 The complainant states the mark REMITLY (word) is registered in India in classes 9, 36 and 42 under IRDI no.3304159 (IR No. 1283040). The trademark has been applied in several jurisdictions through international application including United States of America, Argentina and Brazil. A list of trademark registration certificates for India and USA granted in favour of Complainant /pending applications are annexed with the complaint (as per **Annexure B** of complaint)
- 6.1.3 The Complainant submits it is the owner and proprietor of registered domain name www.remitly.com which features information about the goods and services of the Complainant using the mark REMITLY. The Complainant also has a very strong social media presence as well as popular search engines like www.google.com and www.google.in displays Complainant's trademark as the main search result that pertain to complainant and no other (as per **Annexure D** of complaint).
- 6.1.4 The Complainant submits that the disputed domain name remitly.in is identical to and clear imitation of the 'REMITLY' trademark and has been used with an intention to deceive and mislead consumers at large. The Respondent has no legitimate interest or right in the domain name and has registered it to mislead consumers and capitalize on the Complainant's reputation and goodwill. The Complainant further states that the Respondent's impugned domain name showcases "Money Transfer", a service identical to those offered by the Complainant, on the top of the list of services and it gets redirected to the website of a

competitor, Google Pay https://pay.google.com/intl/en_in/about when a viewer clicks on the icon of "Money Transfer". -.

6.1.5 Further, the impugned website prominently mentions a notification that "The domain name Remitly.in may be for sale. Click to inquire about this domain". On clicking on such this notification, the viewer/consumer is redirected to a form to fill where the Respondent is actively entertaining offers for sale of the impugned domain name (as per **Annexure E** of complaint).

6.1.6 In addition, the Complainant submits that the Respondent has a pattern of bad faith conduct and has presently and previously indulged in registering various other domain name in prior INDRP orders in the name of "Kenneth Palo". The Complainant has relied on *Immochan v. Milen Radumilo*, WIPO case no. D2017-0113 (March 7, 2017).

6.2 Respondent's Defence

6.2.1 Despite the service of notice by email, the Respondent failed to reply to the notice within the stipulated time

6.2.2 The INDRP Rules of Procedure require under Rule 8(b) that the arbitrator must ensure that each party is given a fair opportunity to present the case. Rule 8(b) reads as follows:

"The Arbitrator shall at all times treat the parties with equality and provide each one of them with a fair opportunity to present their case."

6.2.3 Further the INDRP Rules of Procedure empowers the Arbitrator to proceed with arbitration proceedings ex-parte and decide arbitration in case any party does not comply with the stipulated time limit to file its response. Rule 12 reads as follows:



“In event 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.”

6.2.4 In present arbitration, the Respondent has failed to file any reply to the Complaint and has not sought any further time to answer the Complainant's assertions, contentions or evidences in any manner. The Arbitrator thus finds that the Respondent has been given a fair chance to present its case. Since the Respondent has failed to reply to Notice to submit its response, Arbitration has been conducted ex-parte in accordance with Rule 12 of the INDRP rules and decided on merits ex-parte.

7. Discussion & Finding

7.1 The .IN Domain Name Dispute Resolution 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 right
- 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 submitted that it owns various trademark registrations using word & device 'REMITLY' in many jurisdictions throughout the world including in India and has filed documents of its registered trademark in India/pending applications to prove its right in the trademark "REMITLY" (as per **Annexure B** of complaint). The Complainant is the registered proprietor of the mark "REMITLY" (word) in India and is registered in India in classes 9, 36 and 42 respectively. The Complainant has filed sufficient proof to substantiate that trademark "REMITLY" is registered in India and in the mentioned countries abroad. Therefore, it is established that the Complainant has statutory protection in trademark in "REMITLY" in India. The Complainant submitted that REMITLY is a trademark well recognized amongst the consumers worldwide, including in India as is extensively followed on social media and has huge goodwill both offline and on internet as well (as per **Annexure C and D** of complaint).

The Arbitrator finds that the disputed domain name www.remitly.in is clearly identical and deceptively similar to Complainant's trademark in which the Complainant has exclusive trademark rights and the Complainant has submitted enough documentary evidence to prove its rights and ownership in REMITLY and REMITLY formative marks. A cursory glance at the disputed domain name <Remitly.in> makes it obvious that the Respondent has exactly incorporated the essential elements of the Complainant's REMITLY marks and names and thus the disputed domain name is identical/ deceptively similar to the Complainant's mark.



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 the purposes of UDRP standing. (*Dell Inc. v George Dell & Dell Netsolutions*, case no. D2004-0512 (WIPO Aug 24, 2004), *Busybody Inc. v Fitness Outlet Inc.* D 2000-0127 (WIPO April 22, 2000).

The Disputed domain name consists of "REMITLY", the Complainant's trademark in entirety and the ccTLD ".in" which is likely to deceive and confuse consumers. It is well recognized that incorporating a trademark in its entirety, particularly if the mark is internationally well recognized mark, is sufficient to establish that the domain name is identical or confusingly similar to the Complainant's registered mark. The Respondent's disputed domain name www.remitly.in is just a replacement of the top-level domain name ".com" with ".in". (*LEGO Juris A/S v. Robert Martin*, INDRP/125(2010); *Viacom International Inc. v. MTV ALBUMS-Mega Top Video Albums Peter Miadshi*, WIPO case No. D2002-0196; *Wal Mart Stores Inc. v. Kuchora Kal*, WIPO case no. D2006-0033)

As the Respondent's disputed domain name is exactly same in structure and appearance with the Complainant's registered trademark, and the Respondent failed to file any reply to rebut the contention of the Complainant, the Arbitrator finds that the Respondent's domain name

is identical to Complainant's registered trademark and is likely to deceive the customers.

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

Under para 6 of the policy, a Respondent or a Registrant can prove rights or legitimate interest in the domain name. The Complainant has filed sufficient evidence to prove disputed domain name is identical to 'REMITLY' trademark, in which the Complainant enjoys substantial reputation and goodwill including screen shots of social media websites namely twitter, Facebook and Instagram (annexed as **Annexure C** to the complaint) and registration of trademark in several countries including in India (annexed in **Annexure B** to the complaint). The Respondent has failed to submit its reply to prove any rights or legitimate interests in the disputed domain name/ trademark 'REMITLY'. Thus, the Respondent has failed to establish legitimate interest and/or rights in the disputed domain name. Complainant has also submitted that it has not authorized Respondent to use its REMITLY mark and Respondent has failed to rebut the same. The burden of proof thus shifts to Respondent to demonstrate the rights or legitimate interests it holds in the mark as per WIPO Overview 3.0, section 2.1. Despite the notice the Respondent has not rebutted the contentions of the Complainant and has not produced any documents or submissions to show its interest in protecting its own right and interest in the domain name.

The Complainant submitted that the Respondent is not authorized by the Complainant to register and/or use the disputed domain name in the absence of any license or agreement from Complainant.

The Complainant has further submitted that the Respondent is engaging in unfair commercial use of the disputed domain name and domain mark with the sole aim to make illegal benefits from the goodwill and reputation of the Complainant's mark REMITLY. The disputed domain name is being used by the Respondent to actively advertise its offers for sale of the disputed domain name .The Respondent is also misleading the viewers and consumers looking for Complainant's goods and services by redirecting them to the website of a competitor namely Google Pay (annexed in **Annexure E** to the Complaint) The fact that the disputed domain name has not been put to legitimate non-commercial fair use but to the contrary it is being used for commercial/business use shows Respondent holds no legitimate rights or interest in the disputed domain name (under ICANN Policy 4(b)). Further, the panels under WIPO Overview 3.0, Section 2.5.3 have held that such an offer to sell the disputed domain name does not constitute legitimate non-commercial or fair use of the disputed domain name and any use of the disputed domain name would result in deception and diversion of users or potential users of the Complainant. (*Government Employees Insurance Company v. ICS, INC, case no. D2019-1923,*)

Further, the Complainant submitted that the Respondent has no rights or legitimate interests in the disputed domain name and has merely registered the domain name with the intent to commercially exploit the

Complainant's REMITLY mark for purpose of selling, renting or transferring the domain name registration to the Complainant. Complainant relies on (*Ganeden Biotech, Inc. and Kerry Luxembourg S.a.r.l v. Rob Monster, WIPO* case no. D2019-3012) to support its submissions. Arbitrator finds that the fact that the disputed domain name has not been put to legitimate non-commercial fair use or commercial/business use shows Respondent, holds no legitimate rights or interest in the disputed domain pursuant to ICANN Policy 4(b).

Since, the Complainant's said website and trademarks were in existence and extensively used when disputed domain name was registered by the Respondent on 24.07.2017 (as per **Annexure A** of complaint) and it is presumed that Respondent was aware of complainant's rights in the trademark and registered disputed domain in bad faith. The Respondent has to prove that he was not aware of Complainant's marks at the time of registration and with no reply filed, he failed discharge this responsibility. The Respondent also failed to file any reply 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 viewers or tarnish trademark by registering the disputed domain name. Thus, for the aforesaid reasons the Arbitrator finds that the Respondent has no rights and / or legitimate interests in the disputed domain name.

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

For the purpose of Para 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 submitted that 'REMITLY' trademark has acquired considerable amount of goodwill worldwide including in India in respect of making international payments through digital channels, including mobile phones to enable its customers to send money internationally. The Complainant has secured registration of the mark "REMITLY" (word mark) in India in classes 9, 36 and 42 under IRDI no.3304159 (IR No.1283040). The Respondent has produced no evidence or justification for registering the disputed domain name. In fact, the Complainant has filed evidence to show bad faith registration of disputed domain name by filing the screenshot of the web page of the same showing its unfair use by the Respondent. On the disputed domain name, the Respondent runs a website which redirects the viewers and consumers to the website of a competitor, namely Google Pay, (as per **Annexure E** of complaint). The disputed domain name also displays the message "The domain Remitly.in may be for sale. Click here to inquire about this domain". The Complainant has relied on *Société Air France v. Ebills Online Services* (WIPO case no. D2018-2421) and *Google Inc. USA v Vaibhav Jain INDRP /132* (April 3, 2010), *Ganaden Bioech Inc. & Kerry Luxembourg Sarl v Rob monster* (WIPO case no. D 2019-3012) to prove bad faith registration.

The Arbitrator in the present case finds bad faith in the registration and use of the disputed domain name. (Ref. *Virgin Enterprises Limited v. Syed Hussain*, WIPO Case no. D2012-2395)

Thus, Arbitrator finds that Respondent's disputed domain name misleads and redirects the consumers to the competitor's website for Money Transfer with the Complainant's trademark "REMITLY", together with statement that it is available for resale clearly establishes the bad faith. (*Yusuf A. Alghanism & sons WLL v Anees Salah Salahmeh* (WIPO case no. D2018-1231).

It also shows that the Respondent intended to hoard the disputed domain name preventing the Complainant from using it. The Respondent was under obligation to check if registering disputed domain name would not infringe another entity's rights an onus which he failed to discharge (Ref: *AB Electrolux v. Liheng* INDRP/700 (August,2015)).

Moreover, it is settled law that the incorporation of a well-known trademark into a domain name by a registrant having no plausible explanation for doing so may be, in and of itself, an indication of bad faith. (*Microsoft Corporation vs. Montrose Corporation*, (WIPO Case No. D2000-1568). In present case, the Respondent failed to file any response to the contention and submission of the Complainant.

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 rebut averments, contentions and submissions of the Complainant.

The Arbitrator directs the .IN Registry of NIXI to transfer the domain name "www.remitly.in" to the Complainant.

The Award is passed on this 27th July, 2021

Place: Noida



Dr. Karnika Seth
Sole Arbitrator