



INDIA NON JUDICIAL

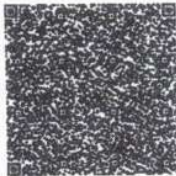
Government of National Capital Territory of Delhi

e-Stamp

Certificate No. : IN-DL80795393532308U
Certificate Issued Date : 24-Jan-2022 01:39 PM
Account Reference : SELFPRINT (PU)/ dl-self/ NEHRU/ DL-DLH
Unique Doc. Reference : SUBIN-DLSELF52284936831225U
Purchased by : JASKARAN SINGH
Description of Document : Article 12 Award
Property Description : STAMP PAPER FOR NIXI ARBITRAL AWARD
Consideration Price (Rs.) : 101
(One Hundred And One only)
First Party : SHEETAL VOHRA
Second Party : SHEETAL VOHRA
Stamp Duty Paid By : SHEETAL VOHRA
Stamp Duty Amount(Rs.) : 101
(One Hundred And One only)

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₹101



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Sheetal Vohra

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**BEFORE THE SOLE ARBITRATOR UNDER THE .IN DOMAIN
NAME DISPUTE RESOLUTION POLICY**

INDRP ARBITRATION

THE NATIONAL INTERNET EXCHANGE OF INDIA [NIXI]

INDRP Case No: 1463

ARBITRAL TRIBUNAL CONSISTING OF SOLE ARBITRATOR

DR. SHEETAL VOHRA, LLB, LLM, PHD (LAW) ADVOCATE,

DELHI HIGH COURT

**COMPLAINT UNDER .IN DOMAIN NAME DISPUTE
RESOLUTION POLICY (INDRP)**

IN THE MATTER OF:

Island Yoga, LLC

1880, Century Park East,
1600 Los Angeles,
CA 90067, USA
inf@ssrana.com

...Complainant

versus

Charles Lambrou

51 Alsid, St. Andrews Rd,
Bandra West, Mumbai,
Maharashtra – 400050
suraagl@gmail.com

...Respondent

ARBITRATION AWARD

I. THE PARTIES:

1. COMPLAINANT

The Complainant in these proceedings is Island Yoga, LLC, a limited liability company incorporated under the laws of Delaware, USA, having its address at 1880, Century Park East, 1600 Los Angeles, CA 90067, USA which has filed the present complaint under rules framed under the INDRP. A copy of the .IN Domain Dispute Resolution Policy and Rules of Procedure was annexed with the Complaint and

Sheetal Vohra

marked as **Annexure C-1 (Colly)**. Copy of Certificate of Formation of Island Yoga LLC was annexed with the complaint and marked as **Annexure C-2**.

The Complainant's counsel in this administrative proceeding is:

Mr. Vikrant Rana,
S.S. Rana & Co. Advocates
317, Lawyers Chambers, High Court of Delhi,
New Delhi-110003
India
Tel: +91 11 – 4012300
Email: info@ssrana.com

2. RESPONDENT

The Respondent/Registrant of the Disputed Domain Name is Mr. Charles Lambrou, of the address 51 Alsid, St Andrews Rd, Bandra West, Mumbai, Maharashtra – 400050, India. A copy of the complete WHOIS details of the Respondent as received by the Complainant from NIXI was annexed with the Complaint and marked as **Annexure C-3**.

The Respondent's contact details are:

Charles Lambrou
51 Alsid, St Andrews Rd,
Bandra West, Mumbai,
Maharashtra- 400050
Email: suraagl@gmail.com
Phone: +91-9870472228

The Respondent did not engage any counsel / advocate and represented himself in these administrative proceedings.

II. THE DOMAIN NAME AND REGISTRAR:

The Disputed Domain Name is: www.yogagirl.in

The Domain Name is registered with the IN Registry.

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The Domain Name is registered with the Registrar GoDaddy.com, LLC.

The Registrar's contact information is as under:

Godaddy.com, LLC

14455 N Hayden Rd Ste 226.

Scottsdale, AZ 85260-6993.

Phone: (480) 505-8877

Fax Numbers (480) 624-2546

Email: abuse@godaddy.com, trademarkclaims@godaddy.com,
udrpdiscutes@godaddy.com

III. PROCEDURAL HISTORY:

November 01, 2021	Date of Complaint
November 29, 2021	Ld. Sole Arbitrator was appointed to adjudicate the dispute
November 29, 2021	Arbitral proceedings were commenced by sending notice to Respondent through e-mail as per Paragraph 4 (c) of INDRP Rules of Procedure, marking copy of the same to Complainant's authorized representative and to the .IN REGISTRY to file response within 15 days of receipt of same.
December 3, 2021	Respondent submitted its Reply to the Complaint through mail
December 3, 2021	Sole Arbitrator informed Respondent to file soft copy of the Reply as an attachment to an email addressed to all persons involved in the administrative proceeding
December 8, 2021	Reply to the Complaint filed by the

Shubal Vohra

	Respondent as an attachment to the mail (EMAIL 1) along with some pictures of Yogagirl clothing (EMAIL 2) but marked solely to the Ld. Arbitrator and not the Complainant
December 10, 2021	Reply and the documents filed by the Respondent served on the Complainant through e-mail by the Ld. Arbitrator
December 17, 2021	Rejoinder filed on behalf of the Complainant to the Reply filed by the Respondent
December 17, 2021	Completion of Pleadings notified to both parties by the Ld. Sole Arbitrator


This award is proceeded with on basis of the available pleadings and documents filed by both the Complainant and the Respondent.

CASE OF THE COMPLAINANT

The Complainant has provided a table of the relevant trademarks of the Complainant in foreign jurisdictions as follows:

Trade mark	Country/IP Office	App. Reg. No.	App./Reg/ Date	Class
YOGA GIRL	USA	86369217	18-Aug-2014	25
YOGA GIRL	USA	86369204	18-Aug-2014	14
YOGA GIRL	USA	87023651	03-May-2016	41
YOGA GIRL	USA	88034129	11-July-2018	18
YOGA GIRL	USA	88977233	11-July-2018	09, 18, 36, 41
YOGA GIRL	USA	90083751	30-July-2020	29, 30, 32
YOGA GIRL	USA	90281990	27-Oct-2020	14

Sheetal Vohra

YOGA GIRL	USA	90307952	09-Nov-2020	03, 04
	EUIPO	017354523	17-Oct-2017	3, 4, 5, 9, 11, 14, 16, 18, 21, 24, 25, 27, 28, 29, 30, 32, 35, 36, 39, 41, 43

Copy of the relevant registration certificates in this regard were annexed with the Complaint and marked as **Annexure C-6 (Colly)**.

The Complainant has also provided a table of the relevant trademarks of the Complainant in India as follows:

Reg. no.	Trade Mark	Reg. Date	Class	Status
3897329	 / RB	27-March- 2018	3, 4, 5, 9, 14, 25, 36, 41	Registered
4527363	YOGA GIRL	11-June-2020	36	Registered

Copy of the relevant registration certificates in this regard were annexed with the Complaint and marked as **Annexure C-7 (Colly)**.

IV. FACTUAL AND LEGAL BACKGROUND:

About the Complainant:

1. The Complainant submitted that Rachel Brathen, a Swedish citizen famously known as "Yoga Girl", is the founder of Island Yoga LLC (the Complainant) which term shall include its predecessors-in-interest, subsidiary companies, licensees, franchisees, sub-franchisees, associates and affiliates, including but not limited to Yoga Girl AB, Yoga Girl Foundation, Cleanfield Holding NV and oneOeight Yoga Inc.). Copies of relevant documents testifying the

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afore-mentioned entities, were attached with the Complaint and marked as **Annexure C-4 (colly)**.

- It was submitted that the origin of the brand/trade mark YOGA GIRL can be traced back to 2015, when the Complainant's founder, Rachel Brathen, released her first book titled Yoga Girl, which is still available worldwide. It was submitted that the said book "Yoga Girl" is a part self-help guide, and part memoir. It was submitted that this book is an inspirational, full-color look at the adventure that took the founder of the Complainant from her hometown in Sweden to the jungles of Costa Rica and finally to the paradise island in the Caribbean that she now calls home. It was submitted that the said book is widely available for sale, including in India, on e-commerce portals like Amazon.in, among other channels for distribution, as displayed in the image attached below:



It was submitted that the mark/name YOGA GIRL was already being used by Rachel Brathen even before the release of the said book in 2015. The Complainant submitted that the Instagram account of its founder Rachel Brathen under the handle @yoga_girl has been active since at least 2014, and the mark YOGA GIRL has been used in conjunction with her name, Rachel Brathen, in many news articles/publications since 2014.

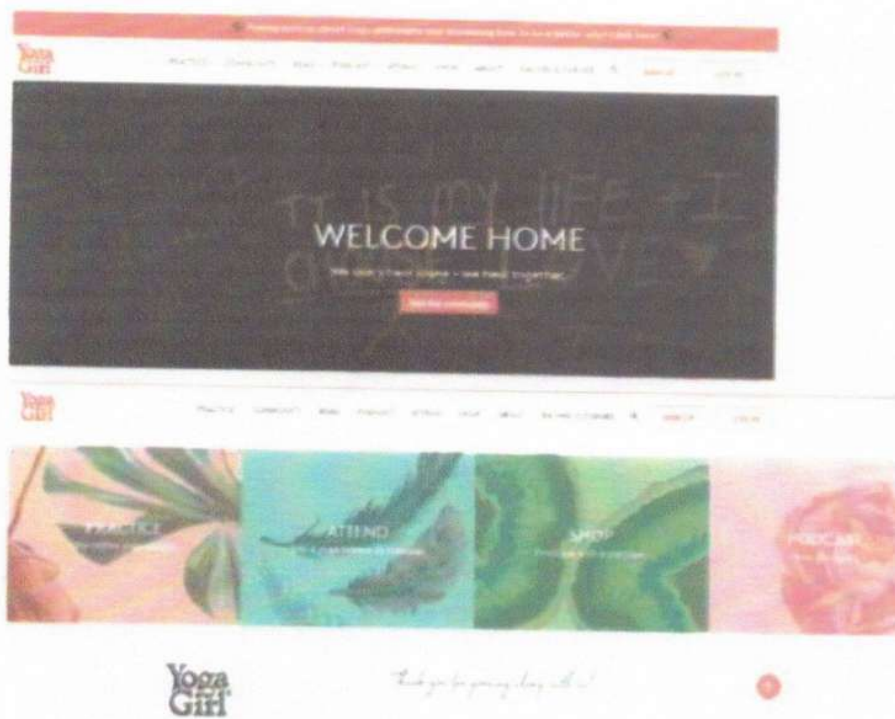
- It was submitted that since 2014-2015, the efforts of Rachel Brathen, have seen an exponential rise in her global fame and goodwill, and the name/mark

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YOGA GIRL has become synonymous with her. It was submitted that such a huge acquisition of goodwill, reputation and worldwide fame over the name/mark YOGA GIRL since 2014-2015 necessitated the incorporation of various business/corporate/IP Holding entities over the years, including the Complainant herein and the entities mentioned in the preceding paragraphs. As such, the Complainant submitted, the **Yoga Girl®** group of companies is the coming together of several different organizations, all emanating from the founder Rachel Brathen, who is popularly known as the "Yoga Girl".

4. It was submitted that in view of the above, as Rachel Brathen, who is popularly known as the "Yoga Girl", is, in essence, the progenitor of all the **Yoga Girl®** entities, she may claim rights in all trade mark registrations for her brand/name YOGA GIRL via the said companies in various countries of the world, including in India. It was submitted that the term "Complainant" as used henceforth in the Complaint would also include Mrs. Rachel Brathen, along with the other Yoga Girl® group companies.
5. It was submitted that the Complainant (through her husband, Mr. Michael Dennis Schoneveld) is also the proprietor of the top-level domain name <**YOGAGIRL.COM**>, which was registered on April 24, 1999, on which an interactive website has been and continues to be operated. It was submitted that the said website showcases information about the various goods and services under the YOGA GIRL brand and also features Rachel Brathen's blogs and podcasts. It was submitted that the said website is accessible globally and its contents and interactive features can be viewed and explored by persons all over the world, including in India. Snapshots of the website pages of the Complainant prominently displaying the name/ mark YOGA GIRL were attached in the Complaint as reproduced below:

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Welcome to Yoga Girl®.

We are a community, a movement and a lifestyle.

It is our core belief that to heal the world we must first heal ourselves; and that inner and outer work goes hand in hand. Our mission is to provide support for healing and to expand self-love into a modern lifestyle so that we can find the ground from which to give. We look within... So we can look up. Being able to do this work is a privilege. With tools like yoga, meditation, holistic therapy and mental health support made accessible for everyone we lay the foundation for a community that not only holds each other up when times are hard, but that inspires hope and creates change for people in need. It is through community that we are able to make a genuine difference in this world around us. We build community through words. Through practice. Through service. In person and online. We are love. In action. We are Yoga Girl®.

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It was submitted that Rachel Brathen, being the founder and the face of the brand YOGA GIRL, is prominently featured on the Complainant's website <YOGAGIRL.COM>.

6. The Complainant further submitted that as reported in the world-famous FORBES magazine, the Complainant's founder Rachel Brathen, popularly known as the YOGA GIRL, became a social media influencer in 2013, when she realized that she could conduct her yoga classes from anywhere in the world and reach a wider audience via Instagram. It was submitted that FORBES also listed her in their list of 'Top Influencers -Fitness 2017'. Copy of Rachel Brathen's profile as available on Forbes.com was annexed with the Complaint and marked as **Annexure C-5**. It was submitted that since her humble beginnings, Rachel Brathen has become a New York Times Bestselling Author, Podcaster, International Yoga Teacher, with over 2 million+ followers on social media. It was submitted that Rachel's fame and positive impact on this world is also seen from the fact that she was the subject matter of the music video/song 'She's a Church' by the artist After Eden, which was released in 2019. The said video/song is available at URL: <https://www.youtube.com/watch?v=yOKkhXAGpMY>. A screenshot of the said video featuring the founder of the Complainant was also attached as reproduced herein below:

Sheetal Vohra



It was submitted that in this unique collaboration, Rachel a.k.a. the 'Yoga Girl' joins in the music video to symbolize the modern preacher and help women and children in need. It was submitted that through this collaboration, 10% of all royalties were donated to her instituted charity **Yoga Girl® Foundation**.

7. It was also submitted that Rachel opened a yoga studio in Aruba in 2016 under the name Island Yoga, which till date remains the largest yoga studio in the Caribbean. It was submitted that the said yoga studio Island Yoga hosts yoga teacher trainings, retreats, workshops, and classes year-round. It was submitted that Rachel strongly believes in giving back to the community, and hence the name YOGA GIRL has also become synonymous with charitable work and social service. The Complainant submitted that Rachel, along with her staff and volunteers, runs two quite famous non-profit organizations -Sgt. Pepper's Friends (which is an animal rescue foundation) and the Yoga Girl Foundation (benefitting women and children who are victims of abuse and in need). Besides the above accolades and achievements, the Complainant submitted that Rachel is also the founder of oneOeight.com, which was one of the first online yoga platforms and was also the most successful crowd-funded yoga project of all time. It was submitted that oneOeight.com has been retired for a while, and the said platform was eventually transformed into the Yoga Girl site, which her loyal fans, followers and customers now experience at YOGAGIRL.COM. It was submitted that YOGAGIRL.COM is now made up of a vast community of dedicated practitioners from all over the world looking to cultivate balance, create space for inner healing, and to deepen their yoga practice.

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COMPLAINANT'S AFFILIATE/GROUP COMPANIES

8. The Complainant submitted that Rachel Brathen is the founder of the **Yoga Girl® group of companies**, which includes but is not limited to Island Yoga, LLC, Yoga Girl Foundation, and oneOeight Yoga Inc. Brief profiles of some of the Complainant's affiliate entities was provided by the Complainant as follows:

Yoga Girl Foundation

9. It was submitted that by the year 2017, Mrs. Rachel Brathen had been living in Aruba for almost a decade. It was submitted that during this time, she realized that almost 50% of children in Aruba are victims of abuse and in an attempt to provide help to those in need, Mrs. Rachel founded the Yoga Girl Foundation in 2018 in Sweden. It was submitted that the Yoga Girl Foundation was founded to use the established brand YOGA GIRL towards the greater good, and to provide support to survivors of abuse and injustice. It was submitted that Yoga Girl Foundation's mission is the desire to make a difference, one woman and one child at a time, and that the Foundation supports women and children who suffer the consequences of trauma, injustice, abuse and poverty, and provides emotional, financial and medical aid to support healing and empower growth.
10. It was submitted that the Yoga Girl Foundation endeavours to make this world a better place for women and children by means of a wide variety of projects (not limited to) such as a children's sanctuary in Aruba, infant care in Venezuela, providing scholarships to women who are in need of emotional and physical support and cannot afford to join Yoga Girl programs, etc.
11. It was submitted that the reach and impact of the Yoga Girl Foundation is evident from the fact that the Foundation has over 3.1 million followers on social media, and has already raised thousands of dollars for social causes.

Wheeler v. Wheeler

12. It was submitted that the Yoga Girl Foundation has an interactive website at <https://www.yogagirlfoundation.com/>, from where donations can be made, and further details about the Foundation's social causes can be accessed. A screenshot of the said website was produced by the Complainant prominently featuring the YOGA GIRL mark on the said website as follows:



13. It was submitted that the Foundation has also created the Yoga Girl® Scholarship Program, to help create a world where everyone can reach their dreams, without exclusion due to systemic disadvantage. It was submitted that in order to fulfil their mission and help the world heal, the Foundation offers scholarships to yoga teacher trainings, yoga memberships and retreats all over the world for people in need of support and healing. It was submitted that 2019 was the Foundation's first year of scholarship programs. The Complainant submitted that the Foundation funded spots in every retreat and teacher training that took place at Island Yoga in Aruba. It was submitted that further details about the Yoga Girl Foundation's scholarship programs could be accessed at <https://www.yogagirlfoundation.com/yoga-scholarship>.

oneOeight Yoga Inc.

14. The Complainant, in furtherance of the submissions in the preceding paras of the Complaint, submitted that Rachel is also the founder of **oneOeight.com**, which was one of the first online yoga platforms and was also the most successful crowd-funded yoga project of all time. It was submitted that **oneOeight** was a TV subscription-based platform, offering yoga and meditation lessons online, and was founded in 2015. **oneOeight** eventually gave way to Yoga Girl, which, the Complainant submitted, quickly became

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Instagram handle of Island Yoga has over 87,500 followers.

COMPLAINANT'S REVENUE AND ADVERTISING FIGURES

16. The Complainant submitted that its worldwide annual revenue figures in respect of its various products sold under the trade name / mark YOGA GIRL and variations thereof run into thousands of Swedish kronor. The Complainant's annual revenue profit figures were provided as under:

Year	Revenue Figures (Svenska Kronor)
2017	3,706
2018	974,704
2019	106,465
2020	905,595

Copies of relevant excerpts from the Complainant's Annual Reports (in Swedish) were annexed with the Complaint and marked as **Annexure C-8 (colly)**.

The Complainant further submitted that its goodwill and reputation in the trade mark YOGA GIRL and variations thereof, have not come from sales alone. It was submitted that thousands of Swedish Kronor have been spent till now for promoting its trade marks by means of advertising.

COMPLAINANT'S YOGA GIRL MARK IN THE MEDIA

17. It was submitted that through the years, the Complainant and its trade mark YOGA GIRL, have been advertised in a wide variety of print and electronic media, including newspapers, magazines, catalogues, brochures, and other promotional material (which are distributed to the Complainant's existing and potential customers all over the world), via the Internet as well as other media. It was submitted that many articles have been written about the Complainant, adding to widespread awareness of its products/ services under the mark

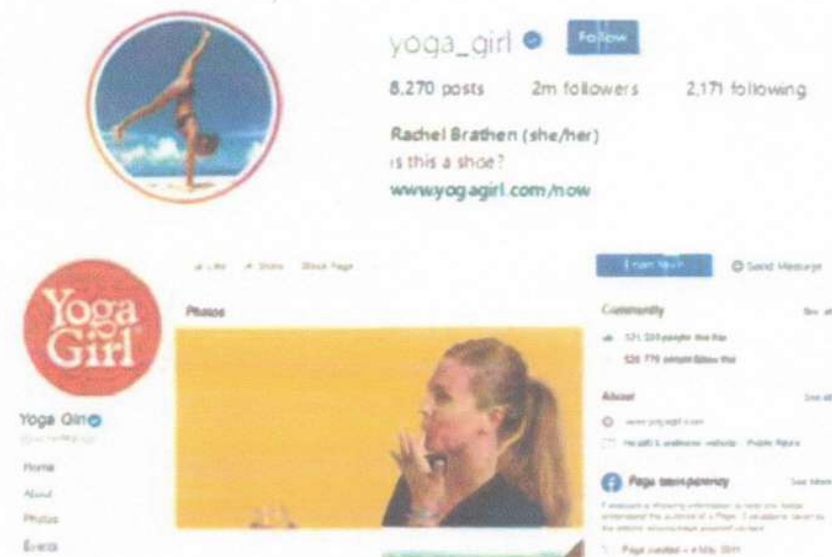
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YOGA GIRL among consumers - including in world famous publications such as UK's Guardian and Telegraph. Details of some of the news articles published in newspapers, magazines and on the internet (prior to the date of registration of the disputed domain name) were annexed with the Complaint and marked as Annexure C-9.

Complainant's YOGA GIRL Mark on social media

18. The Complainant submitted that the Complainant is a social media star and one of the most popular Instagrammers in the industry of health and fitness and yoga. The Complainant submitted that Rachel Brathen's Instagram account under the name "yoga_girl" (YOGA GIRL) has over 2 million followers, thus making her one of the most popular yoga Instagrammers in the world. Further, her account on Facebook under the name YOGA GIRL has over 521,320 likes and 529,779 followers. Snapshots of the said accounts were produced in the Complaint as reproduced below:

Instagram



It was submitted that Mrs. Rachel hosts another very popular Instagram account at the handle **yogagirlofficial**, which also prominently features the Yoga Girl marks and has also garnered over 136,000 followers, as shown below:

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19. It was submitted that the likes and followers on the Complainant's said social media accounts increase daily. It was submitted that in modern times, the number of likes and followers of an entity on social media websites have become the benchmarks to ascertain its popularity among the masses. Copies of pages from Complainant's various social media accounts were annexed with the Complaint and marked as **Annexure C-10 (colly)**.
20. It was submitted that the Complainant considers its name and trade mark YOGA GIRL and its variations as its valuable intellectual property and makes every effort to protect the same. The Complainant submitted that the protection of Yoga Girl trademarks extends beyond registration activities to enforcement actions, which range from opposing trade mark applications for the same or similar trademarks, filing domain name complaints and commencement of legal action in a court of law, if necessary.
21. The Complainant submitted that YOGA GIRL is not only the trade mark and trade name of the Complainant, but it is also by nature, its trading style as well as its principal house mark. It was submitted that by virtue of the prior adoption, long standing and uninterrupted use, extensive publicity and the Complainant's proprietary rights in its trade mark and name YOGA GIRL and variations thereof, both under common law and statutory protection, the said trade mark has acquired a high degree of distinctiveness and is identified by the market and general trade and public as exclusively belonging to the Complainant and its goods/ services and have acquired a significant reputation amongst the trade and public. It was also submitted that there are also significant personality and image rights vested in the mark YOGA GIRL, as

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the same is inextricably linked with Rachel Brathen.

22. It was submitted that as a result of the above-described extensive use and promotion, the Complainant's mark YOGA GIRL and variations thereof have become distinctive and well-known and have enjoyed distinctiveness, goodwill and reputation long prior to the date on which the Respondent registered the disputed domain name.

DISPUTED DOMAIN NAME

23. It was submitted that it was recently brought to the Complainant's notice that a domain name, namely <YOGAGIRL.IN> was registered on July 29, 2019 by the Respondent, Charles Lambrou.
24. It was submitted that as the said domain name is identical to the Complainant's registered trade mark YOGA GIRL, as well as its prior registered domain names <YOGAGIRL.COM> and <YOGAGIRLFOUNDATION.COM>; and also its corporate names Yoga Girl AB and Yoga Girl Foundation, the Complainant was constrained to file the present complaint, in order to safeguard its valuable Intellectual Property rights.

GROUND

The Complainant has based its Complaint on the following grounds:

i. The domain <YOGAGIRL.IN> is identical and/or confusingly similar to the Complainant's trade mark YOGA GIRL in which the Complainant has rights

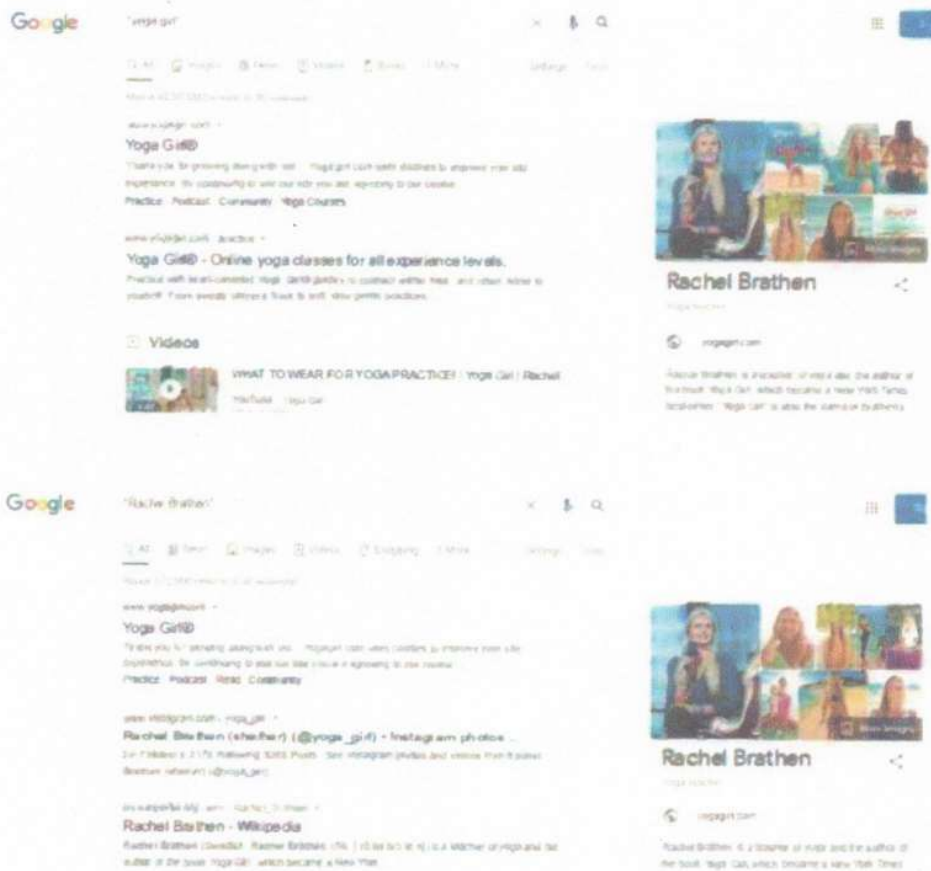
1. It was submitted that in respect of Paragraph 4(a) of the .IN Policy, the Complainant is the proprietor of the trademark YOGA GIRL in various jurisdictions, including but not limited to the European Union (EUIPO) and India, and the mark has been in continuous use since at least 2015, which by far predates the registration of the disputed domain name by the Respondent, i.e., June 23, 2019. The Complainant submitted that by virtue of long-standing use and

Shweta Vohra

registration, and immense global fame and reputation, the Complainant's trademark YOGA GIRL qualifies to be a well-known mark.

2. It was further submitted that the impugned domain name <YOGAGIRL.IN> comprises of the Complainant's trade mark YOGA GIRL in toto. The Complainant submitted that therefore, the domain name <YOGAGIRL.IN> is identical/deceptively and confusingly similar to Complainant's corporate and trade names Yoga Girl AB and Yoga Girl Foundation, registered trade mark YOGA GIRL and the Complainant's domain names <YOGA GIRL.COM> and <YOGAGIRLFOUNDATION.COM>.
3. It was also submitted that Rachel Brathen has substantial personality/ image rights over the name/mark YOGA GIRL and, as such, the said name/mark is exclusively associated with her, and by extension, her businesses. Reference was drawn to sample Google Search Results for the terms "YOGA GIRL" and "RACHEL BRATHEN" as displayed below:

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It was submitted that considering that the very first results for the search terms "YOGA GIRL" and "RACHEL BRATHEN" on Google exclusively relate to the Complainant, it is highly likely that any average internet user can be easily deceived/misled into believing that the disputed domain name <YOGAGIRL.IN> is associated with the Complainant. The Complainant submitted that the ubiquitous intertwined nature of "YOGA GIRL" and "RACHEL BRATHEN" demonstrate that the domain name <YOGAGIRL.IN> also infringes upon the personality rights of the Complainant/ Rachel Brathen. It was submitted that in this present case, not only does the Complainant have strong personality rights in the name YOGA GIRL, the same is also globally used as a trade mark (commercial use), which provides the Complainant with in fact dual protection.

4. It was submitted that such trade mark rights in a name, have been observed by many prior UDRP panels. The Complainant sought to place reliance on the case

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of *HELEN FOLSADE ADU* known as *SADE* v. *QUANTUM COMPUTER SERVICES INC.*, WIPO Case No. D2000-0794, in which case the Complainant was the famous singer/artist Helen Folsade Adu who was globally known by her stage name SADE. It was submitted that even though the Complainant had not registered the word "SADE" either as a trademark or as a service mark in any jurisdiction, the Panel found in favour of the Complainant had ordered the transfer of the domain name <SADE.COM> to the Complainant. Similarly, the Complainant submitted, the disputed domain name <femikuti.com> was transferred to the Complainant Mr. Olufela Olufemi Anikulapo Kuti in the case of *Mr. Olufela Olufemi Anikulapo Kuti v. Domain Administrator, NameFind LLC* (WIPO Case No. D2016-0575), wherein the Complainant was popularly known by his stage name "Femi Kuti", a name over which the Complainant had in fact no registered trade mark rights. Similarly, in the case of *Diane Hof a/k/a Sunset Thomas v. Lorna Kang* before the National Arbitration Forum (Claim No. FA0303000151119), the UDRP panel inter alia noted that the Complainant, Ms. Diane Hof, was famously known as "Sunset Thomas" and ordered that the domain name <sunsetthomas.com> be transferred to the Complainant. In the case of *Mary L. Cummings v. V7 Productions* (Forum Claim No. FA0808001221136), the Complainant, Mary L. Cummings, was popularly known as Missy Cummings, and the UDRP panel that the domain name <missycummings.com> be transferred to the Complainant. In yet another instance, a UDRP panel had ordered that the domain name <stormy-daniels.net> be transferred to the Complainant (wherein Stormy Daniels is the alias/stage name of the adult star Stephanie Gregory Clifford), in the case of *Stormy Entertainment, Inc. v. George Thomas* (Forum Claim No. FA0811001235235).

The Complainant also heavily placed reliance on WIPO Panel's decision in the case of *AST Sportswear, Inc. v. Steven R Hyken* (WIPO Case No: D2001-1324) regarding the domain name <johnnyblaze.com>. In this case, the Complainant was the registered proprietor of the trade mark JOHNNY BLAZE whereas the Respondent was an individual named Mr. Steven R. Hyken, who had used the stage name "Johnny Blaze" in past appearances including on TV shows. The Panel upheld the Respondent's submissions regarding its rights over the assumed/stage name Johnny Blaze and decided in favour of the Respondent, and

Shakeela Vohra

ordered that the domain name should not be transferred to the Complainant.

5. It was submitted that given the identity of the impugned domain name <YOGAGIRL.IN> with the Complainant's name and mark YOGA GIRL, the same is bound to cause confusion and deception in the minds of the public that the Respondent has some connection, association or affiliation with Complainant, when it is not so. It was submitted that it has been held by prior panels deciding under the INDRP that there is confusing similarity where the disputed domain name wholly incorporates the Complainant's trade mark such as *Kenneth Cole Productions vs. Viswas Infomedia INDRP/093* <kennethcole.in>, *Inter-Continental Hotels Corporation vs. Jaswinder Singh (INDRP/238)* <Carrier.net.in>, *M/s Merck KGaA vs. Zeng Wei (INDRP/332)* <Merckchemicals.in>, *Colgate-Palmolive Company & Anr. V. Zhaxia (INDRP/887)* <Colgate.in> and *The Singer Company Limited v. Novation In Limited (INDRP/905)* <singer.co.in>.

The Complainant submitted that the well-established principle discussed above has also been upheld by various UDRP panels, including but not limited to *Oki Data Americas Inc. v. ASD Inc. (WIPO Case no. D2001-0903)* <okidataparts.com>, *GO Daddy.com, Inc. v Shoneye's Enterprise (WIPO Case no. D2007-1090)* <domainnamedaddy.com>, *Qalo, LLC v. Chen Jinjun and Magnum Piercing Inc. v. The Mudjackers (WIPO Case No. D2000-1525)* <magnumpiercing.com>, <magnumpiercinginc.com>, <magnumpiercing.net>, <magnumpiercinginc.net>, <magnumpier.net>, <magnumpiers.com>, <magnumpiers.net>, <magnum-piercing.com>, <magnum-piercing.net>, <magnum-pier.com>, <magnum-pier.net>, <magnumpier.com>, <magnumpiers.com>, <magnum-piers.net>.

The Complainant further submitted that a ccTLD such as ".in" is an essential part of domain name. Therefore, it was submitted that it cannot be said to distinguish the Respondent's domain name <YOGAGIRL.IN> from the Complainant's trademark YOGA GIRL. This has been held by prior panels in numerous cases, for instance in *Dell Inc. v. Mani, Soniya (INDRP/753)* <dellservicecenter.m>, *Patagonia Inc. v Double.fist Ltd. (INDRP/1185)* <patagonia.co.in> and *Humor*

Sheetal Vohra

Rainbow, Inc. v. Yin Jun, China (INDRP/153) <okcupid.in>.

6. The Complainant also placed reliance on a prior decision of this panel in *Mis Retail Royalty Company v. Mr. Folk Brook* INDRP/705 wherein on the basis of the Complainant's registered trademark and domain names for "**AMERICAN EAGLE**", having been created by the Complainant much before the date of creation of the disputed domain name <americaneagle.co.in> by the Respondent, it was held that:

"The disputed domain name is very much similar to the name and trademark of the Complainant. The Hon'ble Supreme Court of India has recently held that the domain name has become a business identifier. A domain name helps identify the subject of trade or service that an entity seeks to provide to its potential customers. Further that there is a strong likelihood that a web browser looking for AMERICAN EAGLE products in India or elsewhere would mistake the disputed domain name as of the Complainant."

It was submitted that in the present dispute as well, the Complainant has acquired rights in the trade mark YOGA GIRL by way of trademark registrations, and by virtue of use as part of their corporate and domain names since much prior to the date on which the Respondent created the impugned domain <YOGAGIRL.IN>, namely July 29, 2019, incorporating the Complainant's identical company name, trade mark and trade name YOGA GIRL in toto.

7. It was submitted that this evident identity between the Respondent's domain name and the Complainant's marks, domain names and company name incorporating YOGA GIRL is likely to mislead, confuse and deceive the Complainant's customers as well as the general lay public as to the source, sponsorship, affiliation or endorsement of the Respondent's domain name. It was submitted that as evidenced in the preceding paragraphs, Complainant's rights over the marks YOGA GIRL pre-date the Respondent's registration of the impugned domain <YOGAGIRL.IN>.

Sheela Roha

8. The Complainant further submitted that, in view of Paragraph 3 of the INDRP, and by relying upon the panel decision in *Lockheed Martin Corporation v. Aslam Nadia (INDRP/947)* <lockheedengineering.in> wherein the Respondent failed to discharge its responsibility of determining whether the Registrant's domain name infringes or violates someone else's rights as required under Paragraph 3 of INDRP, the panel concluded that the Complainant has satisfied the first element required by Paragraph 4 of the INDRP. It was submitted that in the present dispute as well, the Respondent, at the time of registering the impugned domain name, has clearly failed to make the determination that the name/ mark YOGA GIRL and the rights subsisting therein vest exclusively with the Complainant.

Therefore, the Complainant submitted that the conditions under INDRP Paragraph 4(a) stood suitably established.

ii. The Respondent has no rights or legitimate interest in respect of the domain name

9. It was submitted by the Complainant that the Respondent had no right or legitimate interest in the disputed domain name <YOGAGIRL.IN> in view of Paragraph 4(b) and Paragraph 6 of the .IN Policy. The Complainant submitted that it has not authorized, licensed or otherwise allowed the Respondent to make any use of its trademark YOGA GIRL and neither does the Respondent have any affiliation or connection with the Complainant and/or the Complainant's goods/services under the name/mark YOGA GIRL. It was further submitted that where the Respondent is not known by the domain name and has not made any legitimate non-commercial use of the same, the Respondent cannot be found to have any legitimate right or interest over the domain name. Reliance was placed on *M/s. Merck KGaA v. Zeng Wei (INDP/323)* <Merckchemicals.in>. It was further submitted that the Respondent cannot assert that it is using the domain name in connection with a bona fide offering of goods and services in accordance with Paragraph 6(a) of the .IN Policy, as it is not operating any website from the impugned domain and is instead using the domain in connection with a parked page hosting Pay-Per-Click (PPC) links. It was submitted that such links cannot constitute a bona fide offering of goods and services. Reliance was placed on Case

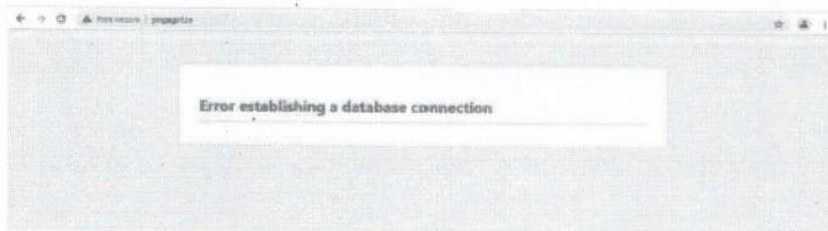
Sheetal Vohra

No. INDRP/ 481 L'Oreal v. Yerec International Limited and LYFT, INC. v. Linda Hac (INDRP/1163) <lyft.co.in>.

10. It was submitted that unlike the Complainant, with whom the name YOGA GIRL is exclusively tied, the Respondent is not commonly known by the name YOGA GIRL within the meaning of Paragraph 6(b) of the Policy, nor did it appear to have been known as such prior to the date on which Respondent registered the impugned domain name. It was submitted that the Respondent is not making a legitimate, non-commercial fair use of the domain name. The Complainant submitted that as per the relevant WHOIS records, the Respondent in the present matter is known by the name Charles Lambrou. Therefore, the Complainant submitted, the Respondent does not have any right or legitimate interest in the name YOGA GIRL within the meaning of Paragraph 6(c) of the Policy. It was submitted that the Respondent had deliberately chosen to use the domain name <YOGAGIRL.IN>, which is identical to Complainant's trademark, so as to suggest a direct connection or affiliation with Complainant's trademark YOGA GIRL and to create a direct affiliation with Complainant and its business when in fact there is none.
11. It was submitted that any use of the domain name <YOGAGIRL.IN> by the Respondent in relation to any goods and/ or services is likely to create a false association and affiliation with the Complainant and its well-known trade mark YOGA GIRL as well as its official websites at <YOGAGIRL.COM> and <YOGAGIRLFOUNDATION.COM>. Therefore, it was submitted that Respondent has no rights or legitimate interests in respect of the impugned domain name and is incapable of making a legitimate, non-commercial or fair use of the domain name in accordance with Paragraph 6(c) of the Policy.
12. It was submitted that the Respondent could not assert that they are currently making a legitimate, non-commercial or fair use of the domain name, in accordance with Paragraph 6(c) of the Policy. It was submitted that the Respondent, in fact, did not appear to be making any use of the impugned domain at all, as it reflected an error page when accessed, however has kept it blocked for

Sheetal Vohra

use by legitimate users.



It was further submitted that the domain name <YOGAGIRL.IN> was selected and used by Respondent with the intent to attract for commercial gain Internet users to Respondent's web site by trading on the fame of Complainant's mark, and any use of the domain name <YOGAGIRL.IN> in the future by the Respondent is likely to create a false association and affiliation with the Complainant and its well-known trade mark YOGA GIRL. It was submitted that Respondent had no rights or legitimate interests in respect of the impugned domain name and that the Respondent is incapable of making a legitimate, non-commercial or fair use of the domain name in accordance with Paragraph 6(c) of the Policy.

13. It was submitted that Paragraph 6(b) of the INDRP states that a Registrant can show its rights or legitimate interests in a disputed domain name by showing that the Registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights. In this case, the Complainant submitted that it was evident from the preceding paragraphs that Rachel Brathen is commonly and famously known as YOGA GIRL – she is the 'YOGA GIRL', and as such the Respondent, whose name is Charles Lambrou as per the WHOIS records, cannot claim to be commonly known as YOGA GIRL.
14. It was also submitted that the Respondent herein registered the impugned domain <YOGAGIRL.IN> almost 4 years after the Complainant adopted the trade mark YOGA GIRL. Further, the Complainant submitted that the Respondent is presently not making any use of the domain with a bona fide offering of goods or services, in fact, it is not currently making any use of the domain at all. It was submitted that in the circumstances of this case, the Respondent's use of the disputed domain name is not "bona fide" within the meaning of Paragraph 6(c) of the Policy since there is no apparent legitimate justification for the Respondent's

Charles Lambrou

registration of the <YOGAGIRL.IN> domain name that is visually, phonetically, conceptually, deceptively and confusingly identical/ similar to the Complainants' trade name/mark. Further, it was submitted that considering the ubiquitous online presence of the Complainant's YOGA GIRL mark and its almost exclusive association with Rachel Brathen, it is likely that the Respondent had constructive notice of Complainant and its rights over the YOGA GIRL name/mark prior to July 2019, and yet registered a confusingly similar domain name. It was submitted that as such, the Respondent could not claim to have any right or legitimate interest in the domain name.

It was further submitted that the continued ownership of the disputed domain <YOGAGIRL.IN> by the Respondent, despite not having any legitimate or fair reason to do so, prevents the Complainant from reflecting their trademark in the subject domain name. The Complainant cited the case of *Motorola, Inc. vs NewGate Internet, Inc. (WIPO Case D2000-0079)*, wherein it was held that use of the trademarks can not only create a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation or endorsement of its web site, but also creates dilution of the marks.

15. The Complainant also submitted that prior to instituting the present complaint, the Complainant had come across the Respondent actively hosting a website at the domains <YOGA GIRL.IN> and <YOGAGIRLFOUNDATION.IN> (including the disputed domain <YOGAGIRL.IN>) under the name "Yoga Girl Foundation" (thereby mimicking the name of the Complainant's charitable organization under the same name, without any authorization). It was submitted that the Respondent was, inter alia, orchestrating a fund-raising initiative via the erstwhile active website, purportedly to aid migrant workers adversely affected by the outbreak of the COVID-19 pandemic. It was submitted that however, upon deeper exploration, the Complainant observed that the said website provided little to no information that Respondent was operating in India, nor was there any provision to contact the website creators, or verify the authenticity of or acquire more information about the fundraising services offered therefrom. It was submitted that the Complainant further came to the knowledge that no payment receipt was being generated upon making a charitable donation through the details

Sheela Vohra

available at the said website. Copies of the erstwhile website pages, inter alia advertising the name "Yoga Girl Foundation" and calling for donations, as available till last year, were annexed with the Complaint and marked as **Annexure C-11 (Colly)**.

It was submitted that this apparent attempt to scam unwary Internet users under Complainant's trade name and registered trademark "YOGA GIRL" / "YOGA GIRL FOUNDATION" became of concern to the Complainant who attempted to reach out to the Respondent by way of a legal notice dated December 04, 2020, inter alia calling upon the Respondent to cease all use of their trade name and registered trademark "YOGA GIRL"/ "YOGA GIRL FOUNDATION" and also voluntarily surrender all similar domain names, including the present disputed domain name, <YOGAGIRL.IN>, in favour of Complainant. It was submitted that no response was received to this communication, which instigated Complainant to reach out once again via reminder letter dated December 29, 2020.

It was submitted that no response to either letter was received from Respondent till the date of the Complaint, thereby further necessitating Complainant to institute the present domain complaint.

16. It was further submitted that while the burden of establishing that the Respondent has no rights or legitimate interest in respect of the disputed domain name lies on the Complainant, the same shifts to the Respondent if the Complainant makes a prima facie case showing that the Respondent has no legitimate interest in the domain name. It was submitted that this had been upheld in various prior INDRP panels, including but not limited to in *Luxottica Holdings Corp v. Lokesh Morade* [INPRP/139] for <sunglasshut.in>; *Alticor Inc v. Aryanent* [INDRP/192] for <nutriliteindia.co.in>; and *Hitachi Limited v. Kuldeep Kumar* [INDRP/1092] for <hitachicorporation.in>.

17. It was submitted that it was not possible to conceive of any plausible use of the domain name <YOGAGIRL.IN> by Respondent that would not be illegitimate, as it would inevitably create a false association and affiliation with Complainant

Shruti Vohra

and its well-known trade mark YOGA GIRL. Therefore, it was submitted, that Respondent had no rights or legitimate interests in respect of the impugned domain name.

iii. The Domain name was registered or is being used in bad faith

18. The Complainant submitted that Paragraph 7(c) of the Policy stipulates that a "bad faith" registration and use of a domain name can be established inter alia by showing circumstances indicating that the Respondent has registered and was previously using the domain name to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation or endorsement of Respondent's website or location; or of a product or service on Respondent's website or location.
19. It was submitted that in light of the continuous and exclusive use of the mark YOGA GIRL by the Complainant including as part of their trade/ corporate name over many years, this mark has no meaning other than as an identifier of the Complainant, and, as illustrated above, simple searches on the global search engine Google reinforce the fact, as shown in para xxxvi of the Complaint. Reliance was also placed on a prior decision of this Panel in *M/s Merck KGaA v Zeng Wei INDRP/323* wherein it was stated that:

"The choice of the domain name does not appear to be a mere coincidence; but a deliberate use of a well-recognized mark ... such registration of a domain name, based on awareness of a trademark is indicative of bad faith registration."

Hence, the Complainant submitted that the Respondent had no reason to adopt an identical name/ mark with respect to the impugned domain name except to create a deliberate and false impression in the minds of consumers that the Respondent is somehow associated with or endorsed by the Complainant, with the sole intention to ride on the massive goodwill and reputation associated with the Complainant and to unjustly gain enrichment from the same.

Usha Vohra

20. It was also submitted that the fact that the Respondent does not appear to be currently using the domain at all, while continuing to hold onto its registration. It was submitted that this gave the impression that it is a case of *passive holding* and the same is tantamount to the fact that the Respondent does not hold any legitimate interest in the domain name. Reliance was placed on the INDRP panel's decision in *Flipkart Online Services Private Limited v. Azeem Ahmed Khan* wherein it was held that "*parking of domain names incorporating someone else's trademark constitutes bad faith.*"

The Complainant also placed reliance on *Instagram, LLC v. Contact Privacy Inc. / Sercam Lider* (WIPO Case No. D2019-0419) wherein it was held that "*passive holding can be sufficient to find bad faith use*". In another decision in *Johnson & Johnson v. Daniel Wistbacka* (WIPO Case No. D2017-07-09) while discussing the elements constituting bad faith with respect to passive holding of respondent's domain name as noted in the landmark case of *Telstra Corporation Limited v. Nuclear Marshmallows* (WIPO Case No. D2000- 0003), it was held that:

".. In particular it seems fit that the fifth element (i.e., impossibility to conceive of any plausible active use) is actually a conclusion which was made on the base of the preceding four elements and that this fifth element plays a decisive role in determining whether any particular passive holding can be regarded as a "bad faith" use of a domain name in dispute.

In the present case like in the above cited case, the Panel cannot conceive of any plausible use of the disputed domain name that would be legitimate, absent an authorization from the Complainant. As the disputed domain name is strictly identical to the Complainant's distinctive mark, consumers would certainly mistakenly assume that an active website connected to the disputed domain name is operated or endorsed by the Complainant, when such is not the case.

Shreya Vohra

The Panel accordingly reaches the conclusion that the passive holding of the disputed domain name amounts to use in bad faith given the circumstances of the case."

It was submitted that the facts and contentions enumerated above establish that Respondent's domain name registration for <YOGA GIRL.IN> is clearly contrary to the provisions of Paragraph 4(c) of the INDRP.

21. It was submitted that in consideration of the Complainant's longstanding reputation, and the ubiquitous presence of the Complainant's mark YOGA GIRL on the Internet, Respondent was, or should have been, aware of the Complainant's trademarks long prior to registering the domain name. In view of the aforesaid, it was submitted that the Respondent had constructive notice of the Complainant's mark YOGA GIRL which is registered and used in many countries of the world, including in India.
22. Further, the Complainant submitted that the Respondent's intent appears reflective of a blatant attempt to ride on the association and goodwill of the Complainant's brand as acquired among the consuming public and thereby drive traffic towards the Respondent's domain and website by misleading, confusing and deceiving Complainant's customers and the general lay public as to the source, sponsorship, affiliation or endorsement of the Respondent's domain name and website as hosted thereon.

It was submitted that sometime in the past year, prior to instituting the present complaint, the Complainant had come across the Respondent actively hosting a website at the disputed domain <YOGAGIRL.IN> under the name "Yoga Girl Foundation" (thereby mimicking the name of the Complainant's charitable organization under the same name, without any authorization). It was also submitted that the realization that the Respondent's fund-raising activities using the subject domain name, incorporating the Complainant's registered trademark, were prima facie fraudulent and akin to a scam, only goes to establish the inherent bad faith of Respondent's registration of the subject domain name, towards maliciously tarnishing the reputation of the Complainant's registered trademark, YOGA GIRL,

Sheetal Vohra

by their inherently fraudulent activities.

23. It was submitted that in view of the above, the Complainant has established that the mark YOGA GIRL is distinctive and well known, and it is highly likely that Respondent had prior knowledge of Complainant's aforesaid name and mark. It was submitted that owing to the well-established global fame attached to Complainant's mark YOGA GIRL, which is a result of extensive use and promotion in relation to its world-renowned goods / services, it is implausible for the Respondent to have registered the domain name for any reason other than to trade off the reputation and goodwill of Complainant's mark YOGA GIRL, and the significant personality/image rights over the same, which is so inextricably linked with Rachel Brathen and her likeness. It was submitted that the Complainant is also concerned that the impugned domain registration by the Respondent can also tarnish the goodwill and reputation of the Complainant, if the Respondent sells the domain name to any third party/ or person.

CASE OF THE RESPONDENT

1. The Respondent submitted his reply to the averments in the Complaint vide his email dated 3rd December 2021 without marking a copy to Complainant and others and was therefore directed to file his reply as an attachment and mark a copy to all concerned. The Respondent therefore again sent his reply vide email dated 8th December 2021 again without marking a copy to Complainant or others. On 8th December 2021, the Respondent sent three photographs of yogagirl clothing with undisclosed persons wearing YOGAGIRL t-shirts. On this email also, the Complainant and others were not marked a copy. The photographs were undated and no invoices were provided showing commercial use of YOGAGIRL clothing by Respondent. This Arbitral Tribunal forwarded pleadings and documents to the Complainant calling upon the Complainant to file its Rejoinder and comment on attached documents.
2. It was submitted by the Respondent that the Respondent has a registration over the

Shubh Vohra

YOGAGIRL

device mark in India since 31st August, 2015 in Class 25 vide Registration no. 3043641. A copy of internet webpage indicating the registration of the said "Yogagirl" device mark of the Respondent was filed along with the Reply.

3. It was further submitted that the Respondent also has a registration over the word mark "Yogagirl" with EUIPO dated 05/08/2016 vide Filing Number 015245319 in respect of goods falling in Classes 3, 25 and 28. It was submitted that thus, the Respondent was the rightful owner of Yogagirl.in. It was also submitted that the Complainant was attempting to steal the "protected property" of the Respondent by way of the present Complaint proceedings. A copy of the Status page of the Respondent's mark from the EUIPO website was also filed along with the Reply.
4. It was contended by the Respondent that the Complainant only has a registration over RB Yoga Girl in Europe and not Yogagirl. It was submitted that the Complainant has only two registrations for its marks in USA, one dated February 2016 and the other one dated in 2017. It was submitted that the Respondent's

YOGAGIRL

registrations for the mark Yogagirl and the device precedes these registrations of the Complainant since the Respondent's registration is dated 31/08/2015.

5. The Respondent submitted that he was shocked to see that the Complainant Island Yoga LLC has received registration for the trademark Yogagirl in Class 36 on 11 June, 2020 and that he was not aware of such registration.
6. It was submitted that the Respondent was also not aware of the Complainant's

Yoga Girl

registration over the mark / RB Yogagirl in Europe. It was submitted that the Complainant was "being a predator" and trying to usurp what was rightfully of the Respondent. It was submitted that the Respondent was not contacted by the Complainant for filing the said RB Yogagirl trademarks and that the Complainant

Sheetal Vohra

has also not purchased the disputed domain name from the Respondent.

CONTENTIONS AND SUBMISSIONS OF COMPLAINANT IN THE REJOINDER

1. The Complainant filed rejoinder on 17th December 2021 marking a copy to all including the Respondent. The Complainant denied all statements, averments and contentions made by the Respondent in its Reply dated December 03, 2021, except as was admitted thereafter in the Rejoinder by the Complainant. It was submitted that the Reply filed by the Respondent was contrary to the strictures of INDRP which requires under Rule 2(f) that the parties should keep all other parties in copy in every communication made on their behalf in respect of the administrative proceedings. It was submitted that the Complainant was a necessary party to the proceeding and that the Complainant should have been supplied with the Reply by the Respondent itself.
2. Commenting on merits of the proceedings, the Complainant chose to rely on all arguments, averments, statements and contentions as placed before this Arbitral Tribunal vide the initial domain complaint, which were not replicated in toto but which were meant to be read as part and parcel of the submissions under the Rejoinder.
3. In the para-wise reply on merits, the Complainant submitted that the Respondent's claims of owning rights to disputed domain name <yogagirl.in> relying on purported registrations for YOGAGIRL were denied as being false and evidently mala fide. It was submitted that as it had been established vide the domain complaint, the Complainant's rights in the name/mark YOGA GIRL precede Respondent's purported rights as they stem from at least 2014 by virtue of use and may even be stretched back as far as 1999, by virtue of registration of the domain name <yogagirl.com> wherein Complainant's official global website is hosted.

It was also submitted that Respondent's claimed EU trademark registration no. 015245319 for YOGAGIRL has been the subject of trademark cancellation proceedings before the EUIPO under Revocation No. 000050894. It was submitted

Shree Vohra

that the said proceedings have recently concluded (ruling/order reserved) without the EUTM proprietor/IR holder (namely the Respondent herein) having filed any evidence in support of his registration.


It was submitted that accordingly, the Respondent's claimed registration in the EU stands liable to be cancelled and his further claims that the subject disputed domain name is his rightful protected property is wrong, misconceived, untenable in law or in fact and obviously *malafide*. It was submitted that by virtue of being in the same spheres of activity (yoga training and purported charitable missions), it is inconceivable that the Respondent's adoption of the identical name/mark YOGA GIRL in the course of his enterprise can be seen as being merely coincidental, especially given that the Respondent herein himself is a male/ man and not a female/ woman. It was submitted that the Respondent had the option of adopting a name/mark such as YOGAGUY, YOGABOY or YOGAMAN or any variation thereof, however he specifically chose to adopt a name which was already famous due to the Complainant, i.e., YOGA GIRL and Rachel Brathen, to unjustly enrich from the same. It was submitted that the above clearly illustrates the Respondent's *malafide* intention and bad faith inherent in the registration and use of the disputed domain name YOGAGIRL.IN.

4. The Complainant submitted that the Respondent's claims as set out in Paragraph 3 of the Reply are wrong, misconceived and untenable in law or in fact. The Complainant, while referring to paragraph nos. viii, ix and xi of the complaint, the Complainant's rights in the name/mark YOGA GIRL stem from at least 2014 by virtue of use and may even be stretched back as far as 1999, by virtue of registration of the domain name <yogagirl.com> wherein Complainant's official global website is hosted, which pre-dates any of the Respondent's purported registrations. It was also submitted that The Complainant also has substantial transborder reputation in India over its YOGA GIRL trademarks, which pre-date any alleged use or trademark application of the Respondent in India.

With respect to the Respondent's contentions against the Complainant's filings for

Sheela Vohra



the logo / mark , the Complainant submitted that that the "RB" component of the said mark indicates Rachel Brathen, who is YOGA GIRL, and from whose business and activities Complainant's mark YOGA GIRL draws reputation, fame and recognition and international goodwill. The Complainant, while relying on paragraphs ix, x and xxviii of the Complaint, submitted that Rachel Brathen established her reputation as a yoga, health and wellness teacher and influencer under the name and brand "Yoga Girl". It was submitted that Rachel Brathen is the "Yoga Girl", and apart from the same being her core brand and house mark, it also involves significant image and personality rights for her. The Complainant submitted that across the online and offline space, the name/mark YOGA GIRL is inextricably linked with Rachel Brathen and her companies. It was submitted that the Respondent's arguments towards differentiating between Complainant's trademarks and his own mala fide filings are tenuous and redundant and merely an effort to deflect attention from his own mala fide activities trading upon the reputation and goodwill of the Complainant's established trademarks.

5. It was submitted that Complainant has followed due process in protecting their valuable intellectual property and, in recognition thereof, have been rightfully granted protection by respective trademark offices worldwide. It was submitted that the Complainant is not concerned with Respondent's lack of vigilance regarding his own purported intellectual property, as the same is not pertinent to the matter at hand.

With regard to the Respondent's claims that... *"They are now being a predator and trying to take what is rightfully mine. They have not contacted me and have not tried to purchase my domains or IP."*, the Complainant denied these statements as being fundamentally wrong, false, misconceived and untenable in law and/or in fact. It was submitted that owing to the Complainant's evidently prior rights over the name/mark YOGA GIRL, and the fame attached thereto, due to its progenitor, i.e. Rachel Brathen (who is the YOGA GIRL), it was the Respondent who may be said to be the "predator", as he specifically chose to register the disputed domain

Usheta Vohra

name and file trade mark applications for the mark YOGAGIRL rather than YOGAGUY, YOGABOY or YOGAMAN or variations thereof, which may still have been considered to be *bonafide*, considering that the Respondent is a man.

The Complainant placed reliance on its established rights in the name/mark YOGA GIRL as was laid out in the domain complaint. It was submitted that the facts and statements laid out in the domain complaint were sufficient to establish the Complainant's rights in the name/mark YOGA GIRL which far pre-dates the Respondent's purported rights. It was submitted that given the mala fide intention behind the Respondent's adoption of the name/mark YOGAGIRL as well as registration of the subject disputed domain name <yogagirl.in> (as well as an associated domain name, <yogagirlfoundation.in>, which is subject matter of a separate complaint), the Respondent's bad faith and *malafides* were clearly evident, which, as noted above, was grossly exacerbated by the fact that the Respondent chose to register the disputed domain name given that he himself is a man.

The Complainant submitted, while relying on the contents of Paragraphs xlvii and liv of the domain complaint, that when the Complainant had come across the Respondent's websites (active at the time) on the subject disputed domain name <yogagirl.in> (as well as an associated domain name, <yogagirlfoundation.in>), the same had been found to be perpetrating an apparent scam in the guise of requisitioning donations for COVID relief for the underprivileged and less fortunate sections of society under the name of "Yoga Girl Foundation", as there was no option for verification of the receipt and correct utilization of funds donated given on the said websites, or anywhere else. It was also submitted that when the Complainant's known associate had attempted to make a donation, the receipt issued there against had termed the donation as a "purchase", thereby giving rise to grave doubts as to the veracity of the Respondent's claimed charitable mission in securing donations for the benefit of India's underprivileged, afflicted by the COVID crisis. The Complainant submitted that such a devious scheme to extract money from unwary Internet users hoping to make a difference in the lives of these underprivileged people is blatantly telling of the Respondent's mala fide intentions behind registering the subject disputed domain name <yogagirl.in> and will further tarnish the reputation of Complainant's marks YOGA GIRL/ YOGA GIRL

Sheetal Vohra

FOUNDATION, under which they run actual beneficial charitable institutions. Copy of the receipt issued against Complainant's attempted donation was annexed with the Rejoinder and marked as **Annexure C-12**.

It was submitted that the Complainant reached out to the Respondent vide Letters dated December 04 and December 29, 2020 detailing all of Complainant's concerns and requisitions, to which no response of any kind has been received till date. IT was submitted that in view of the same, the Respondent's contention that "*They have not contacted me...*" stands evidence of his mala fide intentions in this matter.

It was submitted that the Respondent's malafides were further apparent from the fact that the said websites were taken down shortly after the Complainant served its letters aforementioned letters, although the domains (including the subject disputed domain name) continued to be held by Respondent. It was submitted that the Respondent had received the Complainant's communications and, having been apprised of Complainant's superior rights, took down the websites, however refused to comply or communicate with us further, being well aware that the Complainant has prior rights and that he himself cannot have any *bonafide* reason for registration or use of the name/mark YOGA GIRL or the disputed domain name.

6. It was further submitted that the photographs shared by the Respondent dated December 08, 2021 were unverified, undated, uncaptioned and unsupported by any statement from the Respondent in this regard. It was submitted that the said photographs did nothing to support the Respondent's case and the Complainant's claims and rights stood unaffected thereby.
7. It was again submitted that this was a fit case in which Respondent's domain name <yogagirl.in> was liable to be cancelled or transferred to the Complainant.

In a nutshell, I give herein below contentions of the Complainant and the Respondent:

Usha Vohra

V. PARTIES CONTENTIONS:

A. COMPLAINANT'S CONTENTIONS

- (a) The disputed domain name <YOGAGIRL.IN> is identical and/or confusingly similar to the Complainant's registered trade mark YOGA GIRL



/ RB YOGA GIRL as well as its prior registered domain name <YOGAGIRL.COM> and <YOGAGIRLFOUNDATION.COM> and its corporate and trade names Yoga Girl AB and Yoga Girl Foundation.

- (b) The founder of the Complainant Rachel Brathen has substantial personality / image rights over the name / mark YOGA GIRL and the said name / mark is exclusively associated with her, and by extension, her business.

- (c) Identity of the disputed domain name <YOGAGIRL.IN> with the



Complainant's mark YOGA GIRL / RB YOGA GIRL / is bound to create confusion and deception in the minds of the public that Respondent has some connection, association or affiliation with the Complainant.

- (d) The Complainant's mark YOGA GIRL / RB YOGA GIRL /



but also part of its trading style and the founder of the Complainant Rachel Brathen has celebrity rights over it.

- (e) The Respondent has no right or legitimate interest in the disputed domain

Shweta Vohra

name <YOGAGIRL.IN>.

- (f) The name YOGA GIRL is exclusively tied with the Complainant and the Respondent is not commonly known by the name YOGA GIRL.
- (g) The use of the disputed domain name by the Respondent is likely to create a false association and affiliation with the Complainant and its well-known trade mark YOGA GIRL as well as its official websites at <YOGAGIRL.COM> and <YOGAGIRLFOUNDATION.COM>.
- (h) The Respondent deliberately selected the disputed domain name <YOGAGIRL.IN> to attract Internet users to the Respondent's website by trading on the fame of Complainant's YOGA GIRL marks and domain names.
- (i) The Respondent is presently not making any use of the disputed domain with a bona fide offering of goods or services.
- (j) The domain name was registered and is being used in bad faith.
- (k) The Respondent's use of disputed domain name is only to imitate Complainant and to deceive customers into purchasing false and inaccurate goods and availing unreliable services of Respondent.
- (l) The mark YOGA GIRL of the Complainant has no meaning other than as an identifier of the Complainant.
- (m) The Respondent is engaged in passive holding as it is not currently using the disputed domain name at all.
- (n) The Respondent had constructive notice of the Complainant's mark YOGA GIRL due to its longstanding reputation and ubiquitous presence of the Complainant's mark YOGA GIRL on the Internet and also due to its registrations in many other countries.

Shelva Vohra

- (o) The Respondent has attempted to ride on the association and goodwill of Complainant's brand.
- (p) The Respondent's registration with the EUIPO bearing no. 015245319 is subject of cancellation proceedings.

B. RESPONDENT'S CONTENTIONS

- (a) The Respondent has registration over the device mark

YOGAGIRL

in India vide Registration nos. 3043641 in Class 25 and in Europe vide filing number 015245319.

- (b) The Respondent's Indian and European registrations make him the rightful owner of the disputed domain name <YOGAGIRL.IN>.
- (c) The Respondent's registration for YOGAGIRL in India precedes registrations of the Complainant.
- (d) The Respondent is not aware of the Complainant's registrations for the

Yoga Girl

YOGA GIRL / RB YOGA GIRL / trademarks in India and Europe.

VI. DISCUSSION AND FINDINGS:

1. The INDRP (.IN Domain Name Dispute Resolution Policy), adopted by NIXI, provides that a domain name owner must transfer its domain name registration to a complainant/trademark owner if:

Shweta Vohra

- i. The Registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant have rights;
- ii. The Registrant has no rights or legitimate interests in respect of the domain name; and
- iii. The Registrant's domain name has been registered or is being used in bad faith.

I have gone through the pleadings i.e., the Complaint filed by Complainant, Reply filed by Respondent and Rejoinder filed by Complainant. I have also gone through documents filed by both sides with their Complaint, Reply and Rejoinder. Further, I have also gone through case laws cited by the Complainant with the Complaint. After giving due consideration to pleadings, documents, fact and legally settled principles, I hold that in the present case all three requirements for transfer have been met. I further hold that the disputed domain name of the Respondent is visually, phonetically, structurally and conceptually deceptively similar to the trademark and domain name of the Complainant over which the Complainant, who is prior adopter, prior user and registered proprietor of trademark and domain name YOGA GIRL, has absolute and sole rights. I hold that that the name "Yoga Girl" has exclusively and solely become associated and recognized with Rachel Brathen, founder of Island Yoga LLC (the Complainant). I hold that due to such exclusive



association of the YOGA GIRL / RB YOGA GIRL / marks with the Complainant, and also considering the prior registered domain names <YOGAGIRL.COM> and <YOGAGIRFOUNDATION.COM> of the Complainant, the Complainant alone has the right to utilize the mark / trade name / corporate name YOGA GIRL as a domain name registered with the .IN Registry. I hold that the Respondent is not entitled to register the disputed domain name as he has failed to establish any right over the YOGA GIRL mark and the same is associated only with Rachel Brathen and the Complainant.

A. The domain <YOGAGIRL.IN> is identical and/or confusingly similar

Shweta Vohra

to the Complainant's trade mark YOGA GIRL in which the Complainant has rights

1. I find that the Complainant is the proprietor of the trademark YOGA GIRL in USA, European Union (EUIPO) and India, and the mark has been in continuous use. The US Registration Certificate bearing number 4,899,600 in class 25 shows first use in commerce since the year 2014 and US Registration Certificate bearing number 5,239,405 in class 41 shows first use in commerce since the year, which by far predates the registration of the disputed domain name by the Respondent, i.e., June 23, 2019. However, I also find that the

YOGAGIRL

Respondent owns the trademark bearing trademark registration no. 3043641 dated 31/08/2015 wherein use has been claimed since 22/08/2015. The Respondent has not filed any documents to show commercial use either before Learned Registrar of Trade Mark at the time of prosecution of trademark

YOGAGIRL

3043641 nor before this Arbitral Tribunal. In contrast, I have found that the Complainant owns trademark registrations bearing no. 3897329 and 4527363 dated 27/03/2018 and 11/06/2020 respectively which have been filed on "proposed to be used" basis. I note that there has been no attempt by the Complainant to seek cancellation of the above registered mark of the Respondent nor has any Indian court order been furnished by the Complainant injuncting the Respondent from using the trademark

YOGAGIRL

YOGAGIRL. Similarly, the Respondent has not taken steps to file for cancellations of Complainant's trademarks. I have perused information and documents filed by Complainant to show trademark rights and reputation attached to the mark YOGA GIRL in other jurisdiction

Shelva Wale

including India viz. especially Indian and foreign trademark registration certificate, complainants annual revenue profit figures, news articles about the Complainant in newspapers, magazines and internet. I note that Complainant's Founder Rachel Brathen has huge social media following. I further note that domain name www.yogagirl.com was registered on 24th April 1999. The said website is accessible globally including from India. The FORBES magazine which has wide circulation in India has listed the Complainant's Founder Rachel Brathen in their list of "Top Influencers-Fitness 2017". The Complainant's Founder Rachel Brathen, founded Yoga Girl Foundation in the year 2018 in Sweden which has an interactive website www.yogagirlfoundation.com. Giving due regard to the pleadings and documents on record detailed in the foregoing paragraphs, I hold that the domain <YOGAGIRL.IN> is identical and/or confusingly similar to the Complainant's trade mark YOGA GIRL in which the Complainant has international prior rights and trans-border reputation in India.

2. I find that the impugned domain name <YOGAGIRL.IN> comprises of the Complainant's trade mark YOGA GIRL in toto. I hold that the domain name <YOGAGIRL.IN> is identical/deceptively and confusingly similar to Complainant's corporate and trade names Yoga Girl AB and Yoga Girl Foundation, registered trade mark YOGA



GIRL and the Complainant's domain names <YOGA GIRL.COM> and <YOGAGIRLFOUNDATION.COM>.

3. I find that Rachel Brathen has substantial personality/ image rights over the name/mark YOGA GIRL and, as such, the said name/mark is exclusively associated with her, and by extension, her businesses. I find that the very first search results for the term "YOGA GIRL" on Google exclusively relate to the Complainant, owing to which it is

Sheetal Vohra

highly probable that any average internet user can be easily deceived/misled into believing that the disputed domain name <YOGAGIRL.IN> is associated with the Complainant. I hold that the ubiquitous intertwined nature of "YOGA GIRL" and "RACHEL BRATHEN" adequately demonstrates that the domain name <YOGAGIRL.IN> also infringes upon the personality rights of the Complainant/ Rachel Brathen. I hold that not only does the Complainant have strong personality rights in the name YOGA GIRL, but the same is also globally used as a trade mark (commercial use), which lends dual rights to the Complainant in the YOGA GIRL marks.

4. I find that there have been a plethora of decisions by both UNDRP as well as INDRP panels wherein the Complainants, who did not even possess registrations over their stage names by which they were popular among the general public as against their legal name, were granted relief and the domain names which were surreptitiously incorporating the said stage names without having any association with the Complainants were transferred to their rightful owners who had the exclusive right to use the said names. I hold that these decisions adequately support the Complainant's case in the present administrative proceedings and that the Complainant's rights using the mark YOGA GIRL mark as a domain name is established.
5. I find that the disputed domain name <YOGAGIRL.IN> and the Complainant's name and mark YOGA GIRL are identical enough to create confusion and deception in the minds of the public. I hold that Respondent's registration over the disputed domain name is bound to make Internet users believe that the Respondent has some connection, association or affiliation with the Complainant, when it is not so.
6. I find that since a ccTLD such as ".in" is an essential part of a domain name, it cannot distinguish the Respondent's domain name <YOGAGIRL.IN> from the Complainant's trademark YOGA GIRL.

Usha Vohra

7. I hold that the Complainant has acquired adequate rights in the trade mark YOGA GIRL by way of trademark registrations and also by virtue of use as part of its corporate and domain names since much prior to the date on which the Respondent created the disputed domain name <YOGAGIRL.IN>, viz. July 29, 2019, incorporating the Complainant's identical name, trade mark and trade name.
8. I hold that there is evident identity between the Respondent's domain name and the Complainant's marks, domain names and company name incorporating YOGA GIRL and that this is likely to mislead, confuse and deceive the Complainant's customers as well as the general lay public as to the source, sponsorship, affiliation or endorsement of Respondent's Domain Name.
9. Therefore, in view of the abovesaid findings, I hold that the conditions under Paragraph 4(a) of the INDRP stand suitably established.

B. The Respondent has no rights or legitimate interest in respect of the domain name

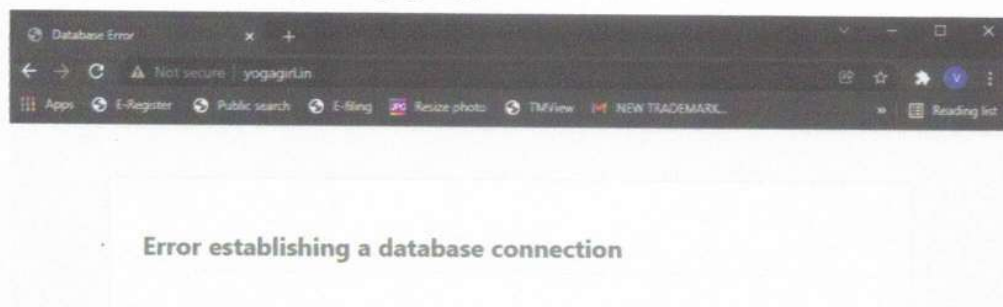
I hold that the Complainant has successfully demonstrated by way of its Complaint and the Rejoinder that the Respondent has no right or legitimate interest in the disputed domain name <YOGAGIRL.IN> for the following reasons:

- a. I find that the Complainant has not authorized, licensed or otherwise allowed the Respondent to make any use of its trademark YOGA GIRL and neither does the Respondent have any affiliation or connection with the Complainant and/or the Complainant's goods/services under the name/mark YOGA GIRL. I hold that the Respondent is not known by the domain name <YOGAGIRL.IN>. I find that the Respondent has not made any legitimate non-commercial use of the disputed domain name, due to which the Respondent cannot

Shrestha Vohra

be found to have any legitimate right or interest over the disputed domain name.

- b. I find that the Complainant's lack of interest in the disputed domain name is further evidenced from the fact that the Complainant is not running any functional website from the disputed domain name. I find that on accessing the disputed domain name from any Internet Search Engine, the following error page appears:



I find that this clearly indicates that the Respondent is squatting over and is merely passively holding the disputed domain name with no intention of making a legitimate, non-commercial and fair use of the disputed domain name. I hold that due to such non-user of the disputed domain name by the Respondent, clear lack of legitimate interest of the Respondent is made out in respect of the same.

- c. I also find that the Complainant is the proprietor of the domain name <YOGAGIRL.COM> which has a much prior registration date of April 24, 1999 as compared to that of the disputed domain name of the Respondent which has been registered on 29/07/2019. I find that the said domain name of the Complainant hosts an interactive website which showcases various goods and services provided by the Complainant under the YOGA GIRL brand. I find that this domain name also features Rachel Brathen's blogs and podcasts, all of which

Gheta Vohra

acts as a prominent portal for promotion and advertisement of the Complainant and its businesses. I hold that such long association of the domain <YOGAGIRL.COM> exclusively with the Complainant establishes the bona fide right of the Complainant over the mark YOGA GIRL as part of the domain name and the Respondent is thereby outside his right to obtain registration over the disputed domain name.

- d. I further find that the Complainant has valid and subsisting rights in its trademark registrations across various jurisdictions around the world as displayed in the table reproduced at para no. xxvii of this award. I find that the Complainant also has valid and subsisting rights in respect of its Indian trademark registrations vide registration nos.



3897329 and 4527363 for the marks / RB YOGA GIRL and the word mark YOGA GIRL respectively. The Complainant has also amassed massive goodwill under its YOGA GIRL / RB YOGA GIRL word and device marks and has produced its annual revenue profit figures in the Complaint. I hold that the aforesaid trademark registrations, complimented by the extensive revenue generated by the Complainant in respect of the various products sold under the trade marks / trade name YOGA GIRL / RB YOGA GIRL and the variations thereof sufficiently establish the Complainant's rights and legitimate interests in respect of the mark / name YOGA GIRL. domain name.

- e. I find that unlike the Complainant, with whom the name YOGA GIRL is exclusively tied, the Respondent is not commonly known by the name YOGA GIRL within the meaning of Paragraph 6(b) of the Policy, nor did it appear to have been known as such prior to the date on which Respondent registered the impugned domain name. I hold that the Respondent is not making a legitimate, non-commercial fair

Shekhar Vohra

use of the domain name. As per the relevant WHOIS records, Respondent in the present matter is known by the name Charles Lambrou, who does not conduct any business or otherwise has any relation to the trademark / trade name / corporate name YOGA GIRL. The Respondent has himself not revealed any such business venture of his under the mark / name YOGA GIRL in its Reply to the Complaint dated 03/12/2021 and has only chosen to rely upon its two trademark registrations, one in India and one in Europe, for establishing its rights in respect of the disputed domain name as against the Complainant. The Respondent has suppressed that his European Trademark Registration Number 015245319 for YOGAGIRL has been subject of trademark cancellation proceedings before EUIPO under Revocation No. 000050894, which has been concluded and orders have been reserved. The Respondent has further suppressed that he has not filed any evidence in support of his registration. The Respondent has in his reply not stated as to how he hit upon the trademark "YOGA GIRL" more so as he is not a girl or woman. This also shows his malafide and tainted adoption of trademark YOGA GIRL and domain name www.yogagirl.in and hence, the Respondent cannot take advantage of trademark registrations he holds in India and in EU. It is a well-established judicial principle in India that prior user / holder of transborder reputation in India can stop registered proprietor who is junior adopter / user and more so when registration has been obtained malafidely. I hold that merely obtaining trademark registrations over the mark "YOGA GIRL" in two jurisdictions does not give the Respondent a better right over the marks and disputed domain name, as compared to Complainant, in the absence of any evidence of the bonafide use of mark / name YOGA GIRL and disputed domain name by the Respondent. I hold that the Complainant's statutory and common law rights over the mark / name YOGA GIRL and prior registered and used domain names www.yogagirl.com and www.yogagirlfoundation.com restrain the Respondent from holding and using any identical or deceptively similar disputed domain name

Shree Vohra

like the disputed domain name www.yogagirl.in. I hold that any use of the YOGA GIRL trademark / trade name / domain name as part of the disputed domain name would tantamount to and make the Respondent liable to an action of passing off. I hold that it is a legally settled judicial principle that passing off action is maintainable even against registered proprietor by prior user as held by Hon'ble Supreme Court in the case of *S. Syed Mohideen vs. P Sulcchana Bai* 2016 (66) PTC 1 (SC).

- f. I find that any use of the disputed domain name <YOGAGIRL.IN> by the Respondent in relation to goods and/or services is likely to create a false association and affiliation with the Complainant and its trade mark YOGA GIRL as well as its official websites at <YOGAGIRL.COM> and <YOGAGIRLFOUNDATION.COM>. I hold that the Respondent has no rights or legitimate interests in respect of the impugned / disputed domain name and is incapable of making a legitimate, non-commercial or fair use of the domain name in accordance with Paragraph 6(c) of the Policy.
- g. I find that the Respondent registered the impugned / disputed domain name <YOGAGIRL.IN> only in 2019, much after the Complainant first adopted the trademark YOGA GIRL and after she released her first and highly acclaimed and successful book titled "YOGA GIRL". I also find that the Respondent is presently not making any use of the disputed domain with a bona fide offering of goods or services. Hence, I hold that the Respondent's use of the disputed domain name is not "bonafide" within the meaning of Paragraph 6 (c) of the Policy since there is no apparent legitimate justification for the Respondent's registration of <YOGAGIRL.IN> that is visually, phonetically, conceptually, deceptively and confusingly identical to the Complainant's trade mark / name with mere replacement of ".COM" with ".IN". I find that the continued ownership of the disputed domain name by the Respondent, despite not having any legitimate or fair reason to do so prevents the Complainant from asserting their

Sheela Vohra

legitimate IPR rights.

- h. I also find that the Respondent's attempts at scamming unwary internet users by soliciting funds from them in the name of Complainant's charitable organization disputed domain name <YOGAGIRL.IN and from another deceptively similar domain <YOGAGIRLFOUNDATION.IN> in the guise of requisitioning donations for COVID-19 relief for the underprivileged and less fortunate sections of society under the name YOGA GIRL FOUNDATION can be seen from the fact that when the Complainant's known associate had attempted to make a donation, the receipt generated had termed the donation as "purchase" as can be seen from **Annexure C-11** filed with the rejoinder.. Copies of the erstwhile website pages calling for the said donations as aforesaid were annexed with the Complaint and marked as **Annexure C-11(Colly)**.
- i. Therefore, I hold that the Respondent has no rights or legitimate interests in respect of the disputed domain name under the provisions of Paragraph 4(b) and Paragraph 6 of .IN Policy.

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

I hold that the Respondent had registered the impugned domain name in bad faith as per Paragraph 7(c) of the INDRP for the following reasons:

- a. I find that the continuous and exclusive use of the mark YOGA GIRL by the Complainant including as part of their trade/ corporate name over many years has made this mark an identifier of the Complainant, and, simple searches on the global search engine Google reinforce the fact, as shown in para xxxvi of the Complaint. I hold that the Respondent had no reason to adopt an identical name/ mark with respect to the impugned domain name except to create a deliberate and false impression in the minds of consumers that the

Shelley Vohra

Respondent is somehow associated with or endorsed by the Complainant, with the sole intention to ride on the massive goodwill and reputation associated with the Complainant and to unjustly gain enrichment from the same. The observations of the INDRP Panel in *M/s Merck KGaA v Zeng Wei INDRP/323* are relevant in this regard wherein it was stated that:

"The choice of the domain name does not appear to be a mere coincidence; but a deliberate use of a well-recognized mark ... such registration of a domain name, based on awareness of a trademark is indicative of bad faith registration."

- b. I hold that the non-user of the disputed domain name by the Respondent also gave the impression that it is a case of *passive holding* and the same is tantamount to the fact that the Respondent does not hold any legitimate interest in the domain name. I find that the Respondent is merely squatting over the disputed domain name and has no legitimate right in the same, nor does he have any intention of putting the same to any bona fide use. In *Flipkart Online Services Private Limited v. Azeem Ahmed Khan*, it was held that *"parking of domain names incorporating someone else's trademark constitutes bad faith."* The observations in the case of *Instagram, LLC v. Contact Privacy Inc. / Sercam Lider (WIPO Case No. D2019-0419)* it was held that *"passive holding can be sufficient to find bad faith use"*. In another decision in *Johnson & Johnson v. Daniel Wistbacka (WIPO Case No. D2017-07-09)* while discussing the elements constituting bad faith with respect to passive holding of respondent's domain name as noted in the landmark case of *Telstra Corporation Limited v. Nuclear Marshmallows (WIPO Case No. D2000-0003)*, it was held that:

".. In particular it seems fit that the fifth element (i.e., impossibility to conceive of any plausible active use) is actually a conclusion which was made on the base of the

Shubra Vohra

preceding four elements and that this fifth element plays a decisive role in determining whether any particular passive holding can be regarded as a "bad faith" use of a domain name in dispute.

In the present case like in the above cited case, the Panel cannot conceive of any plausible use of the disputed domain name that would be legitimate, absent an authorization from the Complainant. As the disputed domain name is strictly identical to the Complainant's distinctive mark, consumers would certainly mistakenly assume that an active website connected to the disputed domain name is operated or endorsed by the Complainant, when such is not the case.

The Panel accordingly reaches the conclusion that the passive holding of the disputed domain name amounts to use in bad faith given the circumstances of the case."

I hold that the facts and contentions enumerated above establish that Respondent's domain name registration for <YOGAGIRL.IN> is clearly contrary to the provisions of Paragraph 4(c) of the INDRP.

- c. I hold that owing to the Complainant's longstanding reputation, and the ubiquitous presence of the Complainant's mark YOGA GIRL on the Internet, Respondent was, or should have been, aware of the Complainant's trademarks long prior to registering the domain name. In view of the aforesaid, I hold that the Respondent had constructive notice of the Complainant's mark YOGA GIRL which is registered and used in many countries of the world, including in India.
- d. I hold that the Respondent's intent appears reflective of a blatant attempt to ride on the association and goodwill of the Complainant's

Shubal Vohra

brand as acquired among the consuming public and thereby drive traffic towards the Respondent's domain and website by misleading, confusing and deceiving Complainant's customers and the general lay public as to the source, sponsorship, affiliation or endorsement of the Respondent's domain name and website as hosted thereon.

e. I find that the Respondent's attempts at scamming unwary internet users by soliciting funds from them in the name of Complainant's charitable organization from the disputed domain name <YOGAGIRL.in> as well as from another domain name deceptively similar domain <YOGAGIRLFOUNDATION.IN> as stated in preceding paragraphs only goes to establish the inherent bad faith of Respondent's registration of the subject domain name, towards maliciously tarnishing the reputation of the Complainant's registered trademark, YOGA GIRL, by their inherently fraudulent activities.

f. I find weight in the Complainant's contentions in Paragraph 5 of the Rejoinder wherein it has been averred that it is inconceivable that the Respondent's adoption of the identical name/mark YOGA GIRL in the course of his enterprise could merely be coincidental as the Respondent is himself a man/male and not a female/woman. I find that the Respondent's deliberate act of registering/attempting to obtain registration over the word / device YOGAGIRL /

YOGAGIRL

despite having the option of adopting the name/mark such YOGAGUY, YOGABOY, YOGAMAN or any variation thereof illustrates the *malafides* of the Respondent in registering the disputed domain name YOGAGIRL.IN.

g. The Respondent has not given an explanation as to how he hit upon the mark YOGAGIRL.

h. Finally, I hold that the Complainant has established that the mark

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YOGA GIRL is distinctive and identified with it and it is highly likely that Respondent had prior knowledge of Complainant's aforesaid name and mark. I hold that owing to prior rights of the Complainant attached to Complainant's mark YOGA GIRL, it is implausible for the Respondent to have registered the domain name for any reason other than to trade off the reputation and goodwill of Complainant's mark YOGA GIRL, and the significant personality/image rights over the same, which is so inextricably linked with Rachel Brathen and her likeness. I hold that the impugned domain registration by the Respondent can also tarnish the goodwill and reputation of the Complainant, if the Respondent sells the domain name to any third party/ or person. This would also entail financial loss the Complainant.

- i. For aforesaid reasons, I hold that the facts and evidence overwhelmingly support the conclusion that the Respondent has registered the disputed domain name in bad faith.

In view of all the above facts and well-known legal precedents, I find and hold as under:

- That the disputed domain name of the Respondent is identical and confusingly similar to the Complainant's trademarks.
- That the disputed domain name <YOGAGIRL.IN> is deceptively similar to the Complainant's earlier/prior trademarks / trade name / corporate name YOGA



GIRL, RB YOGA GIRL, and domain names <YOGAGIRL.COM>, <YOGAGIRLFOUNDATION.COM>.

- That due to the extensive reputation of the Complainant in the YOGA GIRL marks, the first impression in the minds of the users shall be that the Respondent's website/domain name originates from, or is associated with, or is sponsored by the Complainant.

Shubra Vohra

- That the disputed domain name was registered and used in bad faith by the Respondent.
- That the disputed domain name is strictly identical to the Complainant's distinctive mark, consumers would certainly mistakenly assume that a website / disputed domain name www.yogagirl.in is operated or endorsed by the Complainant, when such would not be the case.
- That the Respondent has deliberately attempted to create a false impression in the minds of the consumers that the Respondent is somehow associated with or endorsed by the Complainant to ride on the goodwill and reputation associated with the Complainant and to unjustly enrich from the same.
- That the Respondent has no rights or legitimate interests in respect of the disputed domain name.
- That the Respondent does not have any affiliation or connection with the Complainant and/or its goods / services under the name/mark YOGA GIRL and consequently it is inconceivable that the Respondent's adoption of the name YOGAGIRL.IN which is identical to the Complainant's marks and domain name www.yogagirl.com can be seen as merely coincidental, more so considering the fact that both the Complainant and the Respondent are in the same spheres of activity (yoga training and charitable missions).

VII. DECISION

- a) In view of the above facts and circumstances, it is clear that the Complainant has succeeded in its complaint.
- b) That the .IN Registry of NIXI is hereby directed to transfer the domain name/URL of the Respondent <YOGAGIRL.IN> to the Complainant;
- c) In the facts and circumstances of the case no cost or penalty is imposed upon the Respondent. The Award is accordingly passed on this 25th day of January, 2022.



Dr. Sheetal Vohra

Sole Arbitrator

Date: 25/01/2022