

## Government of Karnataka

## ARBITRATION AWARD

**.IN REGISTRY – NATIONAL INTERNET EXCHANGE OF INDIA [NIXI]**

**.IN Domain Name Dispute Resolution Policy**

**INDRP Rules of Procedure**

**Disputed Domain Name: <googlemaps.in>**

**INDRP Case No. 1469**

**Before the Sole Arbitrator: Mr. Maram Suresh Gupta**

### **IN THE MATTER OF:**

**Google LLC**

1600 Amphitheatre Parkway

Mountain View,

CA 94043

United States of America.

**.....Complainant**

***Versus***

**Rachel Bailey**

5845 Floyd Ct #2126

Weed, California, 96094

United States of America.

**.....Respondent**

### **1. The Parties**

- a) The Complainant in the present arbitration proceedings is **GOOGLE LLC** (hereinafter referred as '*Complainant*'), with its office at 1600 Amphitheatre Parkway, Mountain View, CA 94043, United States of America (USA). The Complainant is represented by **Ms. Shwetasree Majumder, Ms. Astha Negi, Ms. Shipra Shandilya, and Ms. Taranjeet Kaur** of M/s. Fidus Law Chambers, F-12, Ground Floor, Sector 8, Noida – 201 301, India, Phone: +91 120 4847550, Fax: +91 120 4847551, Email: [google@fiduslawchambers.com](mailto:google@fiduslawchambers.com).



- b) The Respondent in the present arbitration proceedings is **Rachel Bailey** (hereinafter referred as '**Respondent**') having postal address: No. 5845 Floyd Ct #2126, Weed, California, 96094, United States of America having email id as: [raurahul10@gmail.com](mailto:raurahul10@gmail.com) and contact phone number as +1.5309383276. These contact details of the Respondent were provided by NIXI from WHOIS database and the same were also provided by the Complainant in its complaint dated 13<sup>th</sup> December 2021.

## **2. The Disputed Domain Name and The Registrar**

- a) The following information about the disputed domain name and the registrar is as per the information furnished by the Complainant in its complaint and supporting annexures.
- b) The disputed domain name is **<googlemaps.in>** which was created on 5<sup>th</sup> March 2021 and was set to expire on 5<sup>th</sup> March 2022. Based on information from WHOIS database, the registrant client ID is CR469725015 and registrant ROID is CB9C8E22A25F04863B62C886E50FDF3FF-IN.
- c) The accredited Registrar with whom the disputed domain name was registered is GoDaddy, LLC.

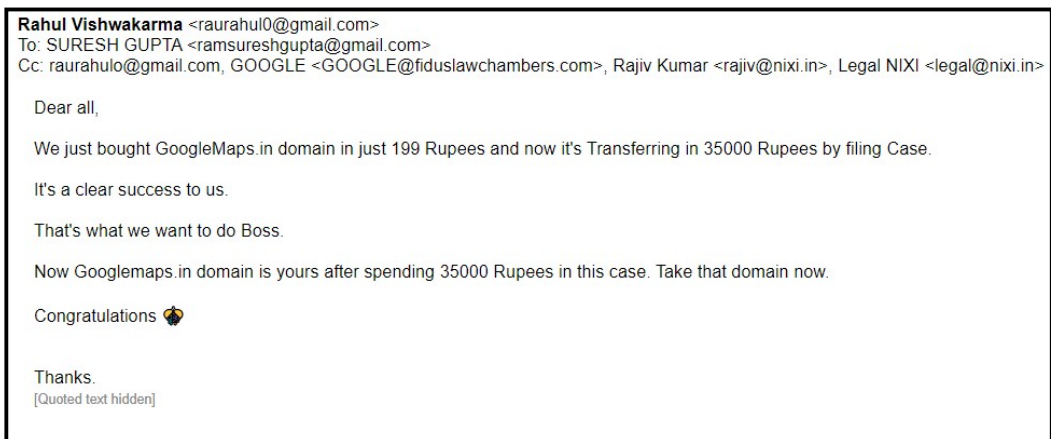
## **3. Procedural Timeline**

- a) The present arbitration proceeding is as per the .IN Domain Name Dispute Resolution Policy (the "Policy"), adopted by the National Internet Exchange of India [NIXI] and the INDRP Rules of Procedure (the "Rules"), under the Indian Arbitration and Conciliation Act, 1996. By registering the disputed domain name with a NIXI accredited Registrar, the Respondent agreed to the resolution of disputes according to the Policy and the Rules thereunder.
- b) NIXI vide its email dated 9<sup>th</sup> December 2021 requested the availability of Mr. Maram Suresh Gupta to act as the Sole Arbitrator in the present matter. In return, on the same

day, I have indicated my availability and accordingly submitted the fully signed Statement of Acceptance and Declaration of Impartiality and Independence, which complied with the .INDRP Rules of Procedure.

- c) Pursuant to the above acceptance and declaration of the Sole Arbitrator, NIXI appointed, vide in its email dated 9<sup>th</sup> December 2021, Mr. Maram Suresh Gupta as the sole Arbitrator and the same was also intimated to both the Complainant and Respondent (hereinafter '*parties*'). Thereafter, on 10<sup>th</sup> December 2021, I requested the Complainant to provide respondent contact details as the same were missing on originally filed Complaint document. On the same day, NIXI responded by providing me with the details of respondent from WHOIS database. Following this, on 11<sup>th</sup> December 2021, a notice having directions to both the parties was issued by me. In the said notice, the Complainant was directed to furnish copies of the complaint along with supporting annexures to the Respondent both via email and courier. In addition, the Respondent was also directed to file his response to the complaint within 10 days from the date of notice. Further, the Complainant was also instructed to furnish confirmation copies of both the means of communication to the Arbitrator with a copy to NIXI.
- d) On 13<sup>th</sup> December 2021, the Complainant sent the revised complaint by duly mentioning the full and complete contact details of the Respondent. Thereafter, the Complainant served copies of the Complaint and its supporting annexures both via email and via courier to the Respondent. The confirmation copies of the email and courier (DHL: WAY BILL 21 6087 5603) sent to the respondent were submitted by the Complainant to the panel with a copy to NIXI, dated 14<sup>th</sup> December 2021.
- e) On 17<sup>th</sup> December 2021, the Respondent replied. The panel quotes the reply/ communication in full as a screenshot (**see screenshot # 1**) for reference below:





**Screenshot # 1:** Reply/ response from the Respondent

Thereafter, on the same day i replied back to the respondent with a copy to the Complainant that the panel has noted the contents of the reply and an award would be passed based on the merits.

#### **4. Factual Background and Parties Contentions**

The Complainant has made the following submissions in support of its complaint against the Respondent. The contentions are detailed as follows:

- a) From **Annexures – A to F** it is abundantly evident that the complainant is the largest and widely recognized in the domain of internet search technologies and its allied services. Its primary website is [www.google.com](http://www.google.com) and the same is registered in 1997. Besides, it also owns and operates at over 190 Google formative domain names. Further, the complainant is also actively offering different goods and services under the trademark GOOGLE and the same is evidenced under **Annexure – B**. The products and services include but not limiting to online advertising, web browser software, email/mobile phones, laptops etc. A perusal of **Annexures A and B** details different domain names of google, goods and services, it further substantiates the aspects recited in this paragraph. Furthermore, **Annexures C to E** highlights different rankings and accolades received by the Complainant from different agencies in the world. It is pertinent to state



that the agency Forbes rated/ ranked, in its 2020 report, GOOGLE trademark as second in the list of top 10 valuable brands of the world, valuing at \$ 207.5 billion. The Complainant has been using the mark GOOGLE since the year 1997 (see **Annexure E**) and is also active in facebook and twitter (see **Annexure F**).

- b) Similarly, a perusal of **Annexure G and Annexure H** indicates that the Complainant has created the mark GOOGLE MAPS in 2005 and has been used since then by many users. Besides, the Complainant has also created a downloadable app from Google Play Store (see **Annexure H**). Most importantly, **Annexure I** provides registration certificates (see **Screenshot # 2** provided two certificates for reference) for the word mark and device marks of the mark GOOGLE as per the Trademarks Act, 1999. The said mark is registered under different classes of Trademarks. Besides, India, the Complainant has also registered the mark GOOGLE in different countries such as USA, UK and the respective certifications are provided under **Annexure I**.

The image displays two trademark registration certificates from the Government of India Trade Marks Registry. Both certificates are for the trademark 'GOOGLE' and were issued on 05/02/2016.

**Left Certificate (Form D-2):**

- Class:** 42
- Under No.:** 2297910
- As of the Date:** 13 March 2012
- In respect of:** PROVISION OF INTERNET SEARCH ENGINES
- Registered Trademark:** Google
- Applicant:** Google Inc., 1601 AMPHITHEATRE PARKWAY, MOUNTAIN VIEW, CA 94043, USA, a company incorporated and duly organized under the laws of the state of Delaware, U.S.A. Service Provider, (Body Incorporated)
- Priority:** claimed from 09/02/2012 Priority Application No. 88551, U.S.T. Country: United States of America

**Right Certificate (Form O-2):**

- Class:** 99
- Under No.:** 3178084
- As of the Date:** 05 February 2016
- In respect of:** Goods and service as annexed
- Registered Trademark:** Google
- Applicant:** GOOGLE INC., 1600 Amphitheatre Parkway, Mountain View, California 94043, U.S.A. A PUBLICLY-OWNED COMPANY INCORPORATED IN THE STATE OF DELAWARE, Manufacturer and Service Provider, (Body Incorporated)
- Priority:** claimed from 24/08/2015 Priority Application No. 50293 Country: Trinidad and Tobago

**Screenshot # 2: Registration certificates of the trademark 'GOOGLE'**

- c) The Complainant has successfully enforced its rights in the trademarks both at WIPO and also at National Arbitration Forum. Copies of the decisions were furnished by the Complainant under **Annexure – J**. Most importantly, the Complainant's mark GOOGLE has been recognized as well-known marks in various jurisdictions such as India, Brazil, China and Denmark (see **Annexure – K**).
- d) The Complainant contends that the disputed domain name ([www.googlemaps.in](http://www.googlemaps.in)) was registered by the Respondent on 5<sup>th</sup> March 2021 which is much later than originally adopted by the Complainant. It is further contended that this act of the Respondent is done with an intention to illegally misappropriate the trademarks GOOGLE and GOOGLE MAPS which are owned by the Complainant.
- e) The Respondent did not provide a substantive reply/ response to the contentions raised by the Complainant. Nonetheless, the Respondent sent two email communications. Of which the first one is provided as a **screenshot # 1** and the second communication is sent to the legal counsel of the Complainant during the fag end of May 2021 with some non-specific aspects. The panel quotes the communication in full as **screenshot # 3** for reference below:

From: **Trailer** <raurahul0@gmail.com>  
To: **Vayra, Fabricio (Perkins Coie)** <FVayra@perkinscoie.com>; **Nee, Vicki (Perkins Coie)** <VNee@perkinscoie.com>; **pctrademarks@perkinscoie.com** <pctrademarks@perkinscoie.com>  
Subject: Contact GoogleMaps.com Domain Registrant  
Date: 24,05,2021 14:37:59 (+02:00)

Dear Legal Team,

Sir You Got all the domains from us by filing UDRP Dispute Domain Case.

Now we only left with GoogleMaps.in and Googleleft.in Domain.

Please take these domain from us as well.

Stop 🚫 Please don't file another UDRP Disputes.

Please give us that amount of fees and take all these domains.

I have lost my Job in this Covid 19 pandemic. Please help me.

Thank you.

**Screenshot # 3:** Respondent's reply to complainant's legal counsel

## 5. Discussion and Findings

- a) As per Paragraph 4(i) of the Policy, the Complainant is required to show that it has a right in the trademark which it intends to assert. Based on the documents furnished by the Complainant it is evident that the trademark GOOGLE *per se* is registered since 1999 in India (**see Annexure I**). On the other hand, the Complainant has not provided any registration certificate with respect to registration of the trademark GOOGLE MAPS *per se*. Nonetheless, the Complainant has offered the services under this mark from 8<sup>th</sup> February 2005 and is used as a downloadable app from google play store by more than 5 billion users (**see Annexure G**). In short, from the annexures supplied by the Complainant it is evident that GOOGLE MAPS *per se* is not registered as a trademark in India under The Trademarks Act, 1999. But, it has been extensively used by public at large since 2005.
- b) In addition, the Complainant has never authorized the Respondent in any manner whatsoever to offer the goods/ services for sale under its registered trademark GOOGLE. Therefore, from the averments made by the Complainant, it is clear that the Respondent is neither a licensee nor has it otherwise obtained the authorization of any kind whatsoever to use the registered trademark GOOGLE. Accordingly, the Respondent does not have any legitimate interest and it appears that the Respondent has registered the disputed domain name only to enrich itself unjustly from such unauthorized adoption and registration.
- c) Once the Complainant makes a *prima facie* case showing its legal rights and lack of any kind of rights/ authorizations to the Respondent from the Complainant, the Respondent must come with proof of legitimate interest in the disputed domain name to rebut the presumption. Nonetheless, the Respondent reply (**see screenshot # 1 and 3**) is not





convincing towards the contentions raised in the Complaint by the Complainant.

Accordingly, I have decided to proceed based on the merits in the case to pass an award.

- d) In light of the above circumstances, my decision is based upon the assertions; evidences presented by the Complainant and inferences drawn from the Respondent's reply.

## **6. Issues in the Dispute**

The Complainant invoked Paragraph 3 of the Rules to initiate arbitration proceedings by filing a Complaint with NIXI. The Respondent in registering the disputed domain name has submitted to the mandatory arbitration proceedings in terms of Paragraph 4 of the Policy, which determines the essential elements for a domain name dispute, which are as follows:

- Whether the disputed domain name is identical or confusingly similar to the registered trademark (legal right) of the Complainant?
- Does the Registrant/ Respondent have any right or legitimate interest in the disputed domain name?
- Does the disputed domain name of the Registrant/ Respondent is registered and is being used in bad faith?

All the above three essential elements are discussed in the following sections:

**Essential Element No. 1:** Whether the disputed domain name is identical or confusingly similar to the registered trademark (legal right) of the Complainant?

The test for confusing similarity involves the comparison between the registered trademark and the disputed domain name (googlemaps.in). The Complainant has provided sufficient evidence of its trademark rights towards the mark GOOGLE. Additionally, the Panel has noticed that the trademark rights of the Complainant have been fully recognized through several decisions, such as the following:



❖ *Google Inc. v. Mr. Gulshan Khatri (Case No. INDRP-189; 6<sup>th</sup> May 2011)*

❖ *Google Inc. V. Vineet Keshav (Case No. INDRP-940; 19<sup>th</sup> January 2018)*

❖ *Google Inc. V. Billa Rajinikar Reddy (Case No. D2009-1390)*

In the present case, the disputed domain name incorporates the Complainant's registered trademark GOOGLE in its entirety with the deliberate addition of descriptive element "MAPS". In order to assess confusing similarity, it is permissible for the Panel to ignore the generic Top-Level Domain ("gTLD") ".in". This in combination with the above mentioned evidence/ cases of the Complainant satisfies the Panel that the disputed domain name registered by the Respondent is identical or confusingly similar to the Complainant's registered trademark. Therefore, the complainant has satisfied the first essential element.

**Essential Element No. 2:** Does the Registrant/ Respondent have any right or legitimate interest in the disputed domain name?

Firstly, from the submissions of the Complainant it is clear that they have never authorized the Respondent in any fashion or otherwise not licensed to use its registered trademark GOOGLE for registration of the disputed domain name. Besides, the Panel notes that the Respondent's reply/ email communications (**see screenshot # 1 and 3**) failed to provide proper response to the contentions raised in the complaint by the Complainant. This behaviour of the Respondent is an indication of lack of legitimate interest towards the disputed domain name. Additionally, the Panel noticed nothing in the case that suggests the Respondent's bonafide use of the disputed domain name.

Secondly, the burden of proof to establish legitimate interest over the disputed domain name lies with the Respondent. However, the Respondent's communication/ reply (**see screenshot # 1 and 3**) clearly fail to establish any kind of legitimacy whatsoever towards the disputed domain name. In addition, from the reply it is clear that the Respondent is



using the disputed domain name to gain undue commercial benefits by exploiting the registered and well-known trademark, GOOGLE, of the Complainant by offering them for sale to the Complainant itself. Accordingly, the Complainant has made prima facie case that the Respondent has no right or legitimate interest in the disputed domain name. Therefore, the complainant has satisfied the second essential element.

**Essential Element No. 3:** Does the disputed domain name of the Registrant/ Respondent is registered and is being used in bad faith?

The Respondent registered the disputed domain name in March 2021. At that point of time, the Complainants registered trademark GOOGLE is well-known. Additionally, the Respondent via the disputed domain name has mirrored the Complainants website with a malafide intention to divert the users. From the Complaint and its annexures, it is evident that the Respondent has intentionally adopted Complainant's registered and well-known trademark GOOGLE with an intention of capitalizing on its reputation by diverting the internet browsers for commercial gain by offering to sell the disputed domain name to the Complainant. Further, the panel accepts that the Complainant's mark GOOGLE enjoys world-wide reputation and also has wide presence in the internet. Furthermore, from **screenshot # 3** it is evident that the Respondent has registered multiple domain names in his name – therefore appears to be a habitual offender. From **screenshot # 1**, it is also evident that the Respondent has contacted the Legal Counsels of the Complainant and has offered to sell the disputed domain name. It is apparent that the Respondent aims to illegitimately monetize the disputed domain name either by itself (website mirroring) or by selling the disputed domain name at a premium to the Complainant. Moreover, the contact details provided by the Respondent on WHOIS for registering the disputed domain name appear to be false and incomplete. This aspect also indicates bad faith registration. Considering that the Complainant's registered trademark is well-known and


that the Respondent most certainly had knowledge of the Complainant's trademark, the Panel finds that the Domain Name was registered and is used in bad faith. In light of the above, it is evident beyond reasonable doubt that the Respondent has adopted the disputed domain name in bad faith. Therefore, the complainant has satisfied the third essential element.

## **7. Decision**

The Complainant has succeeded in establishing all the three essential elements of the .INDRP Policy.

In light of the above discussions and in accordance with the Policy and Rules, the Panel directs the transfer of disputed domain name <googlemaps.in> to the Complainant with a request to NIXI to monitor the transfer.

This award is being passed within the statutory deadline of 60 days from the date of commencement of arbitration proceedings.

  
**Maram Suresh Gupta**  
**Sole Arbitrator**

Date: 20<sup>th</sup> December 2021