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9th Floor, B-Wing, Statesman House
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SmileDirectClub, LLC, USA vs. Alex Wang, China

INDRP Case no. 1473

Arbitrator : Mr. P.K.Agrawal

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AWARD

1. The Parties

The Complainant is M/s SmileDirectClub, LLC, 414 Union Street, 8th Floor, Nashville, TN 37219, USA.

The Respondent is Alex Wang, Pudong, Shanghai-210016, China.

2. The Domain Name and Registrar

The disputed domain name is <www. smiledirectclub.in >. The said domain name is registered with the Registrar – Endurance Domains Technology LLP (IANA ID: 801217). The Registrar URL is <https://publicdomainregistry.com>.

The details of registration of the disputed domain name (as per Annexure attached to the Complaint) are as follows:

- a. Domain ROID: D414400000005296248-IN
- b. Date of creation: Nov 02, 2017
- c. Expiry date: Nov 02, 2022

3. Procedural History

- (a) A Complaint dated 3rd December, 2021 (amended complaint on 20.12.2021) has been filed with the National Internet Exchange of India (NIXI). The Complainant has made the registrar verification in connection with the domain name at issue. The print outs confirmed that the Respondent is listed as the registrant and provided the contact details for the administrative, billing, and technical contact. The Exchange verified that the Complaint satisfied the formal requirements of the Indian Domain Name Dispute Resolution Policy (INDRP) (the “Policy”) and the Rules framed thereunder.
- (b) The Exchange appointed the undersigned Mr. P.K.Agrawal, Advocate and former Addl. Director General in the Government of India, as the sole Arbitrator in this matter. The Arbitrator finds that he has been properly appointed. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Exchange.

- (c) In accordance with the Policy and the Rules, the copies of complaint with annexures were served by the National Internet Exchange of India on 17.12.2021 (amended complaint on 20.12.2021) by email. The Arbitrator served the Notice under Rule 5(C) of INDRP Rules of procedure along-with copies of complaint with annexures to the parties through email on 17.12.2021. The Respondent was given 14 days for reply to the complaint. The Complainant sent the physical copies of complaint & annexures by courier to the Respondent on 20.12.2021, after he was instructed to do so. In view of this, the Complaint and its annexures may be deemed to have been served to the Respondents as per Arbitration and Conciliation Act, 1996 and INDRP rules. Since, the Respondent has not responded to the repeated notices served through emails, the present proceedings have to be conducted ex-parte as per the Arbitration and Conciliation Act, 1996 and the .IN Domain Name Dispute Resolution Policy and the Rules of Procedures framed there under.

4. Factual Background

The Complainant is a limited liability company formed on 16th July 2014 under the laws of the State of Tennessee. The Complainant, an oral care company, is the medtech platform for teeth straightening revolutionizing the oral care industry offering clear aligner therapy to its affordable, premium oral care product line, under the Complainant's trademark "**SMILE DIRECT CLUB**". The Complainant's products/services include SmileDirectClub Aligners and services for capturing a 3D image of the customer's smile at any of the Complainant's SmileShopTM locations or at home through Complainant's Impression Kit to create draft custom treatment plans that are reviewed by licensed dentists and orthodontists for clinical determinations. The Complainant has removed the hassle of in-office visits for customers through its well-established network of licensed dentists and orthodontists offering its customers the peace-of-mind of professional treatment.

According to the complaint, the Complainant has consciously coined and adopted the phrase "**SMILE DIRECT CLUB**" as its primary mark in complete and absolute honesty as early as in 2014 – 2015, commenced use of said brand for its products and services and used the brand as an integral and dominant element of its trading name in the year 2016, at a time when no other entity or individual had adopted or used the said

combination of word. From the Complaint and the various annexures to it, the Arbitrator has found the following additional facts:

Additional Facts:

- The Complainant is the exclusive owner and registered proprietor of the word mark **"SMILEDIRECTCLUB"** in India registered vide **Trademark No. 3653330** since **9th October 2017** in Classes 35 and 44 vide **Certificate No. 1819903** dated 30th March 2018.;
- The Complainant is owner and registered proprietor of the word marks **"SMILEDIRECTCLUB"** / **"SMILE DIRECT CLUB"** and various formative marks in several other jurisdictions such as Australia, Brazil, China, Colombia, Costa Rica, Germany, South Korea, Mexico, New Zealand, Singapore, Spain and Taiwan. The Complainant is also exclusive licensee of the trademark's registrations owned by Complainant's affiliate SDC U.S. SMILEPAY SPV in the United States, Canada, the European Union, Hong Kong and the United Kingdom for the word marks **"SMILEDIRECTCLUB"** / **"SMILE DIRECT CLUB"** as well as various formative marks thereof which comprise of the phrase **"SMILEDIRECTCLUB"** / **"SMILE DIRECT CLUB"** as one of the dominant and essential elements. Details of trademark registrations and pending applications during the period 2017 to 2020 for Complainant's **"SMILE DIRECT CLUB"** trademarks across the globe in the name of the Complainant/SDC U.S. SMILEPAY SPV.
- Complainant is the registrant of the top-level domain (TLD) **smiledirectclub.com** since 1st February 2015 and hosts an interactive website at **www.smiledirectclub.com** accessible globally including in India. The Complainant has also, thereafter, registered several other domain names including country code top-level domain (ccTLDs) comprising of Complainant's wordmark **"SMILE DIRECT CLUB"** as the most essential and dominant element.

The disputed domain name **< smiledirectclub.in >** was registered on November 2nd, 2017 and resolves to parking page with commercial links. According to the complaint, the Complainant's counsel had, in March 2020, attempted purchase of the disputed domain name through the portal available on the webpage hosted at the disputed domain name and received a response from a "Richard Richard" who negotiated the

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sale of the disputed domain name and referred to the owner of the disputed domain name as his "Client".

Respondent's Identity and Activities

The Respondent's activities are not known. The Respondent has not responded to the Notice and complaint.

5. Parties Contentions

A. Complainant

The Complainant contends that each of the elements specified in the Policy are applicable to this dispute.

In relation to **element (i)**, the Complainant contends that the disputed domain name <smiledirectclub.in> is confusingly similar to its trademark SMILEDIRECTCLUB. The association of the generic term refers to the activities of the Complainant.

Furthermore, the Complainant contends that the addition of the ccTLD ".IN" is not sufficient to escape the finding that the domain is confusingly similar to its trademark and does not change the overall impression of the designation as being connected to the trademark of the Complainant.

Therefore, the Complainant contends that the disputed domain name <smiledirectclub.in> is confusingly similar to its trademarks.

In relation to **element (ii)**, the Complainant contends that the Respondent does not have any legitimate interest in using the disputed domain name. The Respondent is neither known by the name of SMILE DIRECT CLUB nor carries on any legitimate trade under the trademark "SMILEDIRECTCLUB" in any industry much less in the oral health industry.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the domain name and he is not related in any way with the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither

license nor authorization has been granted to the Respondent to make any use of the trademark, or apply for registration of the disputed domain name by the Complainant.

Finally, the complainant has contended that the Respondent secured registration for the disputed domain name only on 2nd November, 2017 around 3 years after the Complainant secured registration of its domain name <smiledirectclub.com>. The disputed domain name in this case is <www. smiledirectclub.in> which redirects to parking page with commercial links. Past arbitration panels have found such act not a bona fide offering of goods or services or legitimate non-commercial or fair use.

Based on the above-mentioned arguments, the Complainant argues that the Respondent has no rights or legitimate interests in the disputed domain name.

Regarding the **element (iii)**, the Complainant contends that the bad faith is implicit in the registration of the Disputed Domain Name. The association of the generic term "SMILEDIRECTCLUB" to the Complainant's trademark proves that the Respondent had actual knowledge of the Complainant's prior rights while the registration of the disputed domain name. Thus, given the distinctiveness of the Complainant's trademarks and reputation, it is inconceivable that the Respondent could have registered the disputed domain name <smiledirectclub.in > without actual knowledge of Complainant's rights in the trademark, which evidences bad faith.

Furthermore, the disputed domain name resolves to a parking page with commercial links. The Complainant contends the Respondent has attempted to attract Internet users for commercial gain to his own website thanks to the Complainant's trademarks for its own commercial gain, which is evidence of bad faith. In addition to the misleading content displayed on the disputed domain name which is close to the Complainant's products / services, the Respondent has also displayed a notice on the webpage hosted at the disputed domain name stating that "The domain smiledirectclub.in may be for sale. Click here to inquire about this domain". Evidently, the Respondent is not interested in carrying out any genuine trade or business through the disputed domain name.

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The Complainant contends that the Respondent's malafide is further evident from its response to Complainant's attempt to resolve the dispute amicably by purchasing the disputed domain name. The Complainant's counsel had on 12th March 2020 expressed interest through the tab available on the disputed domain name and quoted a consideration of 500 USD for the disputed domain name. However, the Respondent's counsel via email dated 13th March, 2020 informed that his client's price is 5000 USD for the disputed domain name.

On these facts, the Complainant contends that the Respondent has registered the disputed domain name and is using it in bad faith.

B. Respondent

The Respondent did not submit any evidence or argument indicating his relation with the disputed domain name <www.smiledirectclub.in> or any trademark right, domain name right or contractual right.

6. Discussion and Findings

The Rules instruct this arbitrator as to the principles to be used in rendering its decision. It says that, "a panel shall decide a complaint on the basis of the statements and documents submitted by the parties in accordance with the Policy, the Arbitration and Conciliation Act, 1996, the Rules and any rules and principles of law that it deems applicable".

According to the Policy, the Complainant must prove that:

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

Although Respondent has failed to respond to the complaint, the

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default does not automatically result in a decision in favour of the Complainant, nor is it an admission that Complainant's claims are true. The burden remains with Complainant to establish the three elements of the Policy by a preponderance of the evidence.

A. Identical or Confusingly Similar

The disputed domain name <www.smiledirectclub.in> was registered by the Respondent on November 2nd, 2017.

The Complainant is an owner of the registered trademark "SMILEDIRECTCLUB" for the last many years. The Complainant is also the owner of the domain as stated above and referred to in the Complaint. These domain names and the trademarks have been created by the Complainant much before the date of creation of the disputed domain name by the Respondent. In the present case the disputed domain name is < smiledirectclub.in >. Thus, the disputed domain name is very much similar to the name, activities and the trademark of the Complainant.

The Hon'ble Supreme Court of India has 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 "SMILEDIRECTCLUB" products would mistake the disputed domain name as of the Complainant.

In the case of *Wal Mart Stores, Inc. v. Richard MacLeod*, (WIPO Case No. D2000-0662) it has been held that "When the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name" it is identical or confusingly similar for purposes of the Policy.

Therefore, I hold that the domain name <www. smiledirectclub.in > is phonetically, visually and conceptually identical or confusingly similar to the trademark of the Complainant.

B. Rights or Legitimate Interests

The Respondent may demonstrate its rights to or legitimate interest in the domain name by proving any of the following circumstances:

- (i) before any notice to the Registrant of the dispute, the Registrant's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) 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; or
- (iii) The Registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

In Case No. INDRP/776, *Amundi v. GaoGou*, the arbitration panel found that the Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests. Once such *prima facie* case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4 (II) of the INDRP Policy.

The Respondent's response is not available in this case. There is no evidence to suggest that the Respondent has become known by the disputed domain name anywhere in the world. The name of the Registrant / Respondent is Alex Wang as given in Whois details. Based on the evidence adduced by the Complainant, it is concluded that the above circumstances do not exist in this case and that the Respondent has no rights or legitimate interests in the disputed domain name.

Further, the Complainant has not consented, licensed or otherwise permitted the Respondent to use its name or trademark "SMILEDIRECTCLUB" or to apply for or use the domain name incorporating said trademark. The domain name bears no relationship with the Registrant. Further that, the Registrant has nothing to do remotely with the business of the Complainant.

As has been contended by the Complainant, the Respondent is not making a legitimate, fair or bona fide use of the said domain name for offering goods and services. The Respondent registered the domain name for the sole purpose of creating confusion and misleading the general public.



I, therefore, find that the Respondent has no rights or legitimate interests in the domain name <www. smiledirectclub.in > under INDRP Policy, Paragraph 4(ii).

C. Registered and Used in Bad Faith

Any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration or use of the domain name in bad faith:

- (i) circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who bears the name or is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented out of pocket costs directly related to the domain name; or
- (ii) the Registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Registrant has engaged in a pattern of such conduct; or
- (iv) by using the domain name, the Registrant has intentionally attempted to attract the internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.

The contention of the Complainant is that the present case is covered by the circumstances mentioned herein above. There are circumstances indicating that the Respondent has intentionally attempted to attract, for commercial gain, internet users to its web site, by creating a likelihood of confusion with the Complainant's mark. It may also lead to deceiving and confusing the trade and the public.

In WIPO Case No. D2007-1695, Mayflower Transit LLC v.

Domains by Proxy Inc./Yariv Moshe - "Respondent's use of a domain name confusingly similar to Complainant's trademark for the purpose of offering sponsored links does not of itself qualify as a bona fide use."

The circumstances as evident from the foregoing paragraphs lead to the conclusion that the domain name in dispute was registered and used by the Respondent in bad faith.

7. Decision

In light of the foregoing findings, namely, that the domain name is confusingly similar to the trademark in which the Complainant has rights, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the domain name was registered in bad faith and is being used in bad faith, it is clear beyond doubt that the Respondent has violated the provisions of Rule-3 of the Policy. Therefore, in accordance with the Policy and the Rules, the Arbitrator orders that the domain name <www.smiledirectclub.in> be transferred to the Complainant.

No order to the costs.



Prabodha K. Agrawal

Sole Arbitrator

Dated: 5th January, 2022