

मध्य प्रदेश MADHYA PRADESH

BN 783672

**BEFORE THE ARBITRATOR RAJESH BISARIA
UNDER THE
.IN DOMAIN NAME DISPUTE RESOLUTION POLICY (INDRP)
[NATIONAL INTERNET EXCHANGE OF INDIA (NIXI)]**

ARBITRAL AWARD

Date-26.10.2022

**Disputed Domain Name: www.nianticlabs.in
INDRP Case no -1592**

THE PARTIES

(1)

The **Complainant** is **Niantic, Inc.** 1 Ferry Building, Suite 200, San Francisco, California 94111, United States of America **Phone:** +91.995.8918.715,

Fax: +91.11.2656.2546, **Email:** domains@alindia.com

The **Respondent** is Privacy Guardian, See PrivacyGuardian.org , 928E.Highland Ave. Ste F104, 255, Phoenix, Arizona 85016, United States of America, Phone-+1.3478717726.

E mail: pw-1bd43e2744d32fbe531b97be4dfd3300@privacyguardian.org



THE DOMAIN NAME AND REGISTRAR

(2)

- (a) This dispute concerns the domain name bearing ROID - D27D6344C6A3C4036BD2B9BD23A968D24-IN and is identified as **http:// www.nianticlabs.in**
- (b) The disputed domain name: **http:// www.nianticlabs.in** is registered with Registrar NameSilo, LLC, on 29.12.2021 and expiry date 29.12 2022

PROCEDURAL HISTORY

(3)

The NIXI appointed RAJESH BISARIA as Arbitrator from its panel as per paragraph 5(b) of INDRP Rules of procedure	05.08.2022
Arbitral proceedings were commenced by sending notice to Respondent through e-mail as per paragraph 4(c) of INDRP Rules of Procedure, marking a copy of the same to Complainant's authorized representative and NIXI .	06.08.2022
Due date of submission of Statement of Claim by Complainant (instructed by mail dated 06.08.2022)	15.08.2022
Complainant's response by submitting their Statement of Claim. Soft copy(PDF) Soft copy(Non PDF) Hard copy	08.08.2022 07.09.2022 10.08.2022
Due date of submission of Statement of Defense by Respondent (instructed by mail dated 06.08.2022)	30.08.2022
Further due date of submission of Statement of Defense by Respondent (instructed by mail dated 07.09.2022)	16.09.2022



Respondent's response by submitting their Statement of Defense against the due date of submission as 30.08.2022 & upto 16.09.2022	Not submitted
Complainant's response by submitting their Rejoinder. (Statement of Defense not submitted by Respondent)	Not required
Complainant's response by submitting proof of delivery of complaint along with all annexures to Respondent - Soft copies vide their mail dated 08.08.2022, delivered on 08.08.2022 Vide their mail dated 07.09.2022 intimated that the Hard Copies were sent by FedEx Express courier, vide Tracking No. 777608095111 dated 09.08.2022 which could not be delivered to Respondent on 10.08.2022(as per the tracking record submitted with the same mail, mentioned that -INCORRECT ADDRESS-RECIPIENT MOVED)	08.08.2022 07.09.2022
Communicated by AT mail dated 28.09.2022 that the 'Respondent failed to submit the required documents within the time limit mentioned in mail dated 06.08.2022 & 07.09.2022 ie 30.08.2022 & upto 16.09.2022 , therefore the Respondent lost their right to entertain it. The proceeding of this case was kept closed for award and the matter would be decided ex-parte on the basis of the material on record with this tribunal as per INDRP policy'.	28.09.2022
The language of the proceedings.	English

FACTUAL BACKGROUND

(4) The Complainant :

Privacy Guardian, See PrivacyGuardian.org , 928E.Highland Ave.Ste F104, 255,
Phoenix, Arizona 85016, United States of America,

Authorized Representative of the Complainant:

Sheja Ehtesham & Ashwani Balayan,



ALG India Law Offices LLP,
A-142 Ground Floor, Neeti Bagh , New Delhi - 110 049, India
Phone-+91.995.8918.715, Fax-+91.11.2656.2546,
E mail ID-domains@algindia.com

Preferred Mode of Communication:

Electronic-only material

Method: Email

Address-domains@algindia.com

Contact: Sheja Ehtesham & Ashwani Balayan

Material including hardcopy(whenever applicable)

Method: Post/Courier

Address- ALG India Law Offices LLP,

A-142 Ground Floor, Neeti Bagh , New Delhi - 110 049, India

Fax--+91.11.2656.2546

Contact: Sheja Ehtesham & Ashwani Balayan

(5) The Respondent:

The Respondent is Privacy Guardian, See PrivacyGuardian.org ,
928E.Highland Ave.Ste F104, 255, Phoenix, Arizona 85016, United
States of America, Phone-+1.3478717726.

E mail:pw-

1bd43e2744d32fbe531b97be4dfd3300@privacyguardian.org

(6) Complainant's Activities:

- a) Founded in 2010, as an internal start-up named 'Niantic Labs' within Alphabet, Inc. (Google), the Complainant today, is the world's leading augmented reality ('AR') company, best known for development and creation of immersive AR video games. The Complainant's predecessors were instrumental in shaping the technology behind Google Earth, Google Maps, Street View, etc. Later, in 2015, the Complainant became an independent entity. The Complainant is the creator of the iconic AR mobile game INGRESS and several leading AR mobile games such as Pokémon Go, Harry Potter: Wizards Unite, and Pikmin Bloom. Today, the Complainant is the world's leading geospatial technology and real-world



gaming AR company, and the Complainant's products and services touch hundreds of millions of people across the globe. Copies of relevant web pages were submitted as Annexure 6.

- b) Since its establishment in 2010, the Complainant's Niantic Mark and the Niantic Labs Mark have been used extensively in relation to its goods and services, as well as a key, leading, prominent and essential portion of its corporate name, house mark, trade name and trading style in respect of various aspects of its operations and activities all over the world, including in India. The Complainant has launched several games and mobile applications under the banner of the Niantic Mark and Niantic Labs Mark and has dedicated efforts towards bringing augmented reality experiences to individuals. For instance:
- c) In 2012, the Complainant, under the banner of the Niantic Mark, launched a location-based mobile app 'Field Trip', which allowed users to discover unique things around them. The Complainant subsequently released the app on wearable and augmented reality hardware.
- d) In November 2012, the Complainant, under the banner of the Niantic Mark, launched a mobile game for Android devices called Ingress. Thereafter, on July 13, 2014, the game under Ingress was launched for iOS devices as well. The game was a first of its kind location-based AR multi-player mobile game which transforms the real world into the landscape for a global game of mystery, intrigue, and competition. Since its launch in 2012, the game released under the Complainant's banner of the Niantic Mark has been downloaded more than 20 million times, and players in more than 200 countries have participated in more than 2,000 real-world events and visited more than 1.2 billion portals.
- e) In 2016, the Complainant, under the banner of the Niantic Mark, also released the famous game – Pokémon Go worldwide, including in India. The Complainant was funded by The Pokémon Company Group, Google, and Nintendo to release this new age augmented reality game. The Complainant's game became an overnight global phenomenon and continues to be one of the most profitable and popular augmented reality apps of all time. The Complainant under the Niantic Mark gained significant global recognition and fame following the launch of Pokémon Go.



- f) In 2021, the Complainant in collaboration with Nintendo, released yet another augmented reality mobile game in the Pikmin series called Pikmin Bloom, which rewards players for spending time outside. In a short time, the Complainant's game enjoys global recognition and fame under the banner of the NIANTIC Mark, including in India even before its launch in the country. Copies of some relevant web pages were submitted as Annexure 7.
- g) In India, the Complainant has been using the NIANTIC Mark since at least 2012 in respect of its goods and services. Many of the Complainant's popular games are available for download on Google Play Store and Apple App Store worldwide as well as in India. The NIANTIC Mark is featured prominently on these mobile game applications. Through its mobile apps, the Complainant has achieved enormous popularity, fame, and accreditation internationally as well as in India. The Complainant continues to expand its presence and user base in India. Copies of some relevant web pages were submitted as Annexure 8.
- h) The Complainant uses the NIANTIC LABS Mark a part of its domain name <nianticlabs.com>(registered on April 1, 2012), which resolves to an active website, www.nianticlabs.com, since 2015. The website extensively and prominently features the Complainant's NIANTIC Mark and NIANTIC LABS Mark for disseminating information regarding the different games, events, and also hosts a community discussion forum. The Complainant's website is accessible to users worldwide, including in India. Further, the NIANTIC LABS Mark is also used as a part of the Complainant's social media handles on Facebook, Instagram and Twitter. Copies of some relevant web pages are attached as Annexure 9.
- i) The Complainant also has a record of successful enforcement of its rights in the NIANTIC Mark, and the NIANTIC Mark has been found to be associated solely with the Complainant in domain name proceedings as well. For instance, in Niantic, Inc. v. Privacy service provided by Withheld for Privacy ehf / Redde reddy (WIPO Case No. D2021-3801), it was observed "It is uncontroverted that the Complainant has established rights in the NIANTIC Mark based on its years of use as well as its registered trademarks for the NIANTIC Mark in the United States



and jurisdictions worldwide." A copy of the decision was submitted as Annexure 10.

- j) The Complainant uses the NIANTIC Mark and NIANTIC LABS Mark in several countries worldwide, including in India, in relation to mobile apps and augmented reality experiences. The popularity and international repute of the Complainant under the NIANTIC Mark is evident from the fact that the Complainant and its goods and services under the banner of the NIANTIC Mark have received extensive recognition, acclaim, and awards over the years. Details of select and recent awards and accolades won by the Complainant are provided as under:
- k) In 2019, the Complainant received the Sport in Life award from Japan's Ministry of Education for its games Ingress, Pokémon Go and Harry Potter: Wizards Unite;
- In 2015, the Complainant won the Game Designer's Award at the Japan Game Awards;
 - In 2014, the Complainant's Ingress game won at the 18th Japan Media Arts Festival Grand Prize for Entertainment Division; and
 - In 2013, the Complainant's Ingress game received an award at the Android Players' Choice Awards.

Copies of some relevant web pages were submitted as Annexure 11.

- l) The popularity and appeal of the Complainant is also evident from the fact that in 2018, the Complainant produced an anime series titled 'Ingress: The Animation', based upon its mobile game - INGRESS. The series was first released on October 18, 2018, in Japan and subsequently worldwide in 2019. The series can also be viewed in India on Netflix. Copies of some relevant web pages were submitted as Annexure 12.
- m) The Complainant and fans of the Complainant's products frequently host events, community days and meet-ups to socialize with other players and play the games together. For instance, the 'Ingress XM Anomaly' is a series of events in which the players compete for control of the local XM network, the winners of which gain special rewards. These events are either free or ticketed, and players can sign up on the Complainant's website to find out about upcoming events. Further, the Complainant organized an in-game event - Festival of Lights, globally to celebrate Diwali between November 4, 2021 and November 14, 2021 giving



additional bonus to Indian players . Copies of some relevant web pages were submitted as Annexure 13.

- n) The Complainant has invested substantial sums of money in developing and marketing its goods and services under the NIENTIC Mark and NIENTIC LABS Mark. The widespread prevalence of the Complainant and its NIENTIC Mark and the NIENTIC LABS Mark can be gauged from the fact that the Complainant's products under the banner of the NIENTIC Mark and NIENTIC LABS Mark have received widespread media attention from various publications, journals, newspapers, and magazines across the world, including India, such as The New York Times, Forbes, Indian Express, The Economic Times, etc. Representative copies of relevant web pages are attached herewith as Annexure 14.
- o) The Complainant's Mark enjoys immense reputation and goodwill amongst customers and the public at large, which is evident from the Complainant's extensive online presence on social media platforms, such as Facebook, Instagram, Twitter, YouTube, etc. Copies of some relevant web pages were submitted (Refer Annexure 9).
- p) The NIENTIC Mark and NIENTIC LABS Mark are exclusively associated with the Complainant. A search on third-party online search engines (such as Google®, Yahoo! ® and Bing®) for the word 'NIENTIC' or the phrase 'NIENTIC LABS' immediately reveals a direct and exclusive association of the mark with the Complainant. Representative prints of the search results were submitted as Annexure 15.
- q) Owing to long, consistent, and extensive use worldwide, including in India, Complainant's NIENTIC Mark and NIENTIC LABS Mark have acquired a significant degree of fame, reputation and well-known status across the globe. The mark has attained widespread awareness in relevant trade circles, customers, and across industry. The outstanding reputation, goodwill and brand value associated with the NIENTIC Mark and NIENTIC LABS Mark is of inestimable value to the Complainant.

(7) Complainant's Trade Marks And Domain Names :

- a) The Complainant is the prior adopter, sole owner, registered proprietor, and first and exclusive user across several countries worldwide, including in India, of –

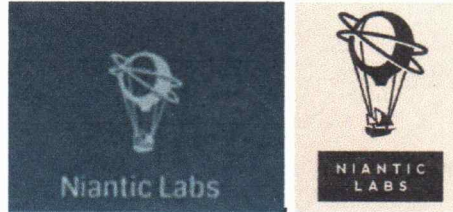


-the trademark Niantic and its formative marks including, but not limited to,



, Niantic, Niantic Supply, Niantic Lightship, etc.(all of which are hereinafter collectively, singly as well as jointly, referred to as the "Niantic Mark").

- the trademark Niantic Labs and its formative marks, including but not limited to



etc. (all of which hereinafter collective, singly as well as jointly referred to as the "Niantic Labs Mark").

b) Hereinafter, unless repugnant and inapposite to the context otherwise, the Niantic Mark shall include the Niantic Labs Mark.

c) The Complainant owns several trademark registrations and applications for the Niantic Mark and the Niantic Labs Mark across numerous jurisdictions worldwide. In India, the Complainant owns trademark registration for the Niantic Mark since 2016. A list of the

Complainant's select trademark registrations for the Niantic Mark and Niantic Labs Mark in select jurisdictions, including in India, is as follows:

Mark	Registration No.	Date of Application	Class(es)	Goods & Services
INDIA				
Niantic	3512302	August 4, 2016	9, 41	<i>Class : 9</i> <i>Computer software for detecting a user's location and displaying relevant local information of general interest; computer software enabling users to view information about locations, events, and points of interest; computer game software; downloadable computer game software for use on wireless devices;</i>



				<p>video game programs; interactive video game programs; downloadable electronic game programs and computer software platforms for social networking.</p> <p><i>Class : 41</i></p> <p>Entertainment services, namely, providing online computer and electronic games; computer gaming entertainment services provided via a web-based system and on-line portals that enable their users to play online computer and electronic games; recreational, leisure and entertainment services provided via virtual environments in which users can interact through social games.</p>
UNITED STATES OF AMERICA				
NIANTIC LABS	5003615	November 1, 2012	9, 41	<p><i>Class 9:</i></p> <p>Computer software for detecting a user's location and displaying relevant local information of general interest; computer software enabling users to view information about locations, events, and points of interest; computer game software; downloadable computer game software for use on wireless devices; video game programs; interactive video game programs; downloadable electronic game programs and computer software platforms for social networking</p> <p><i>Class 41:</i></p> <p>Entertainment services, namely, providing online computer and electronic games; providing a web-based system and on-line portal for users to play online computer and electronic games; providing virtual environments in which users can interact through social games for recreational, leisure or entertainment purposes</p>

NIANTIC	6262160	February 18, 2016	9, 41	<p><i>Class 9:</i></p> <p><i>Computer software for detecting a user's location and displaying relevant local information of general interest; computer software enabling users to view information about locations, events, and points of interest; computer game software; downloadable computer game software for use on wireless devices; video game programs; interactive video game programs; downloadable electronic game programs and computer software platforms for social networking</i></p> <p><i>Class 41:</i></p> <p><i>Entertainment services, namely, providing online computer and electronic games; providing a web-based system and on-line portal for users to play online computer and electronic games; providing virtual environments in which users can interact through social games for recreational, leisure or entertainment purposes</i></p>
UNITED KINGDOM				
NIANTIC LABS	UK0091177 7471	April 29, 2013	9, 41	<p><i>Class 9:</i></p> <p><i>Computer software for detecting a user's location and displaying relevant local information of general interest; computer software enabling users to view information about locations, events, and points of interest; computer game software; downloadable computer game software for use on wireless devices; video game programs; interactive video game programs; downloadable electronic game programs and computer software platforms for social networking.</i></p> <p><i>Class 41:</i></p> <p><i>Entertainment services, namely, providing online computer and</i></p>



				<p>electronic games; providing a web-based system and on-line portal for users to play online computer and electronic games; providing virtual environments in which users can interact through social games for recreational, leisure or entertainment purposes.</p>
NIANTIC	UK0091513 3581	February 22, 2016	9, 41	<p>Class 9:</p> <p>Computer software for detecting a user's location and displaying relevant local information of general interest; computer software enabling users to view information about locations, events, and points of interest; computer game software; downloadable computer game software for use on wireless devices; video game programs; interactive video game programs; downloadable electronic game programs and computer software platforms for social networking.</p> <p>Class 41:</p> <p>Entertainment services, namely, providing online computer and electronic games; providing a web-based system and on-line portal for users to play online computer and electronic games; providing virtual environments in which users can interact through social games for recreational, leisure or entertainment purposes.</p>
EUROPEAN UNION				
NIANTIC LABS	011777471	April 29, 2013	9, 41	<p>Class 9:</p> <p>Computer software for detecting a user's location and displaying relevant local information of general interest; computer software enabling users to view information about locations, events, and points of interest; computer game software; downloadable computer game software for use on wireless devices; video game programs; interactive</p>



				<p>video game programs; downloadable electronic game programs and computer software platforms for social networking.</p> <p>Class 41:</p> <p>Entertainment services, namely, providing online computer and electronic games; providing a web-based system and on-line portal for users to play online computer and electronic games; providing virtual environments in which users can interact through social games for recreational, leisure or entertainment purposes.</p>
NIANTIC	015133581	February 22, 2016	9,41	<p>Class 9- Computer software for detecting a user's location and displaying relevant local information of general interest; computer software enabling users to view information about locations, events, and points of interest; computer game software; downloadable computer game software for use on wireless devices; video game programs; interactive video game programs; downloadable electronic game programs and computer software platforms for social networking.</p> <p>41- Entertainment services, namely, providing online computer and electronic games; providing a web-based system and on-line portal for users to play online computer and electronic games; providing virtual environments in which users can interact through social games for recreational, leisure or entertainment purposes.</p>
CANADA				
NIANTIC	TMA98880 5	August 2, 2016	9, 41	<p>Class 9:</p> <p>Computer software for detecting a user's location and displaying</p>



				<p>relevant local information of general interest; computer software enabling users to view information about locations, events, and points of interest; computer games, computer software for making computer games; downloadable computer games for use on wireless devices, downloadable software for making computer games for use on wireless devices; video games, software for making video games; interactive video games, interactive software for making video games; downloadable electronic games, downloadable software for making electronic games and computer software platforms for social networking</p> <p>Class 41:</p> <p>Entertainment services, namely, providing online computer and electronic games; providing a web-based system and on-line portal for users to play online computer and electronic games; providing virtual environments in which users can interact through social games for recreational, leisure or entertainment purposes</p>
CHILE				
NIANTIC	1254932	July 29, 2016	9, 41	<p>Class 9:</p> <p>software for detecting the user's location and displaying relevant local information of general interest; computer software that allows users to view information about places, events and points of interest; computer game software; downloadable computer game software for use on wireless devices; video game programs; interactive video game programs; downloadable electronic game programs and social networking software platforms.</p>



				<p><i>Class 41:</i></p> <p><i>entertainment services, namely, provision of online computer games; electronic game services provided via the internet; provision of games comprising virtual environments in which users can interact for recreational, entertainment and leisure purposes.</i></p>
CHINA				
NIANTIC	20989427	August 16, 2016	41	<p><i>Club services [entertainment or education]; Entertainment Services; Game services provided on-line from a computer network</i></p>
NIANTIC	20989428	August 16, 2016	9	<p><i>Computer software applications, downloadable; Video game programs; Computer software for locating user locations and displaying local information related to popular interests; Interactive video game program; Downloadable video game programs for social networks; Downloadable computer game software for wireless devices; Computer game software; Computer software, recorded; Computer software for users to browse information related to locations, events and points of interest; Computer programmes [programs], recorded; Computer programs [downloadable software]</i></p>
<p>INTERNATIONAL REGISTRATION (designating UAE, Australia, Brazil, Canada, Switzerland, China, Columbia, Egypt, European Union, United Kingdom, Indonesia, Israel, India, Iceland, Japan, Korea, Mexico, Malaysia, Norway, New Zealand, Philippines, Russia, Singapore, Turkey, Ukraine, Vietnam, Thailand)</p>				
NIANTIC SUPPLY	1644775	January 12, 2022	35	<p><i>Online retail store services featuring clothing, hats, gloves, bandanas, towels, drinkware, plush toys, pins, phone chargers, coolers, backpacks, carrying bags, fanny packs, shoe laces, patches for clothing, and hair scrunchies.</i></p>



ARGENTINA				
NIANTIC	2900371	August 10, 2016	9	<i>Software to detect a user's location and display relevant local information of general interest.; software that allows users to visualize information about places, events, and points of interest.; Games software; downloadable game software for use on wireless devices; Video game programs; Interactive video game programs; downloadable electronic game programs and social networking software platforms.</i>
NIANTIC	2900372	August 10, 2016	41	<i>Entertainment services, namely, provision of computer and electronic games online; provision of a web-based system and online portal for users to play computer and electronic games online; provision of virtual environments in which users can interact through social games for recreational, leisure or entertainment purposes.</i>
ISRAEL				
NIANTIC	291277	August 4, 2016	9, 41	<p><i>Class 9:</i></p> <p><i>Computer software for detecting a user's location and displaying relevant local information of general interest; computer software enabling users to view information about locations, events, and points of interest; computer game software; downloadable computer game software for use on wireless devices; video game programs; interactive video game programs; downloadable electronic game programs and computer software platforms for social networking.</i></p>



				<p><i>Class 41:</i></p> <p><i>Entertainment services, namely, providing online computer and electronic games; computer gaming entertainment services provided via a web-based system and on-line portals that enable their users to play online computer and electronic games; recreational, leisure and entertainment services provided via virtual environments in which users can interact through social games.</i></p>
BRAZIL				
NIANTIC	911457283	August 9, 2016	9	<p><i>Computer software to detect a user's location and display relevant local information of general interest; computer software that enables users to view information about locations, events, and points of interest; computer game software; downloadable computer game software for use on wireless devices; video game programs; Interactive video game programs; downloadable electronic game programs and computer software platforms for social networking.</i></p>
NIANTIC	911457321	August 9, 2016	41	<p><i>Entertainment services, namely the supply of electronic and computer games online; services for providing a web-based system and online portal for users to play computer and electronic games online; services providing virtual environments in which users can interact through social games for recreation, leisure, or entertainment purposes.</i></p>



Copies of the Registration Certificates/status pages of some of the
aforementioned trademark registrations was submitted as Annexure 5.

(8) Respondent's Identity and activities :

Respondent failed to submit any document, so his identity is not clear.

SUBMISSIONS BY COMPLAINANT

- (9) Complainant submitted Domain name complaint with pages 1 to 28
and annexure from 1 to 24 (Pages from 1 to 106)

As per the INDRP Rules of Procedure, Clause 4(a) –

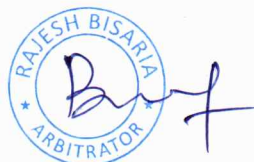
*The (maximum) word limit shall be 5000 words for all pleadings
individually (excluding annexure). Annexure shall not be more than 100
pages in total. Parties shall observe this rule strictly subject to
Arbitrator's discretion.*

The Complainant submitted pleadings of around 5000 words and
annexures more than 100 pages, which is not as per the above norms.
The application is accepted with a caution to the Complainant to
submit the application in future as per the INDRP Rules of Procedure.

THE CONTENTIONS OF THE COMPLAINANT

- (10) **The domain name is identical or confusingly similar to
a trade mark or service mark in which the Complainant
has rights:**

- a) The Complaint is based on the Complainant's prior, exclusive
rights in the NIANTIC Mark, in particular the marks NIANTIC and
NIANTIC LABS, which have been established in para [10.] above
and are relied upon here. The Complainant owns rights in the
NIANTIC Mark, internationally, since as early as 2010 and in
India since 2012. The NIANTIC Mark and NIANTIC LABS Mark are



sufficiently distinctive, unique, famous, and registered. In *Perfetti Van Melle Benelux BV v. Lopuhin Ivan*, IPHOUSTER (WIPO Case No. D2010-0858) and *Inter-Continental Hotels Cooperation v. Abdul Hameed* (NIXI Case No. INDRP/278, February 10, 2012) it was held that trademark registration constitutes prima facie evidence of the validity of trademark rights. Copy of the decision is submitted as Annexure 16.

- b) The disputed domain name <nianticlabs.in> is identical to the Complainant's NIENTIC LABS Mark and is confusingly similar to the Complainant's NIENTIC Mark. The disputed domain name <nianticlabs.in> incorporates in entirety the Complainant's trademarks NIENTIC and NIENTIC LABS with the ccTLD '.in'. It is submitted that the ccTLD element of a domain name has no distinguishing capability and should be disregarded while considering whether a domain name is identical or confusingly similar to a trademark. In fact, it is a well-established principle that the ccTLD suffix in a domain name (".in") should be disregarded for the purpose of comparison and similarity since it is a technical requirement of registration of domain names. Accordingly, disregarding the ccTLD ".in", the disputed domain name <nianticlabs.in> is identical to the NIENTIC LABS Mark as well as the Complainant's domain name <nianticlabs.com>. Following decisions are relied upon:

- *Williams Sonoma, Inc. v. Liheng* (NIXI Case No. INDRP/910, September 26, 2017), the panel held that '...when a domain name contains a trademark in its entirety, the domain name is identical or at least confusingly similar to the trademark'.
- *Kingston Technology Co., v. Web Master Skype Network Limited* (NIXI Case No. INDRP/033, November 6, 2007), the panel held that 'The Respondent's domain name, www.kingston.co.in, consists of entirely Complainant's trademark, except for .co and .in i.e., ccTLD. Thus, this Arbitral Tribunal comes to an irresistible conclusion that the disputed domain name...is confusingly similar or identical to the Complainant's marks.'



-Slickdeals LLC v. Srujan Kumar(NIXI Case No. INDRP/907, September 12, 2017), the panel held that 'it is also well-established that the extensions in a disputed domain name does not affect a finding of similarity'.

-Oki Data Americas, Inc. v. ASD, Inc., (WIPO Case No. D2001-0903)panel held "[T]he fact that a domain name wholly incorporates a complainant's registered mark is sufficient to establish identity or confusing similarity for purposes of the Policy despite the addition of other words to such marks". [Annexure 17].

- c) Thus, it is submitted the disputed domain name is identical to the Complainant's NIENTIC LABS Mark as well as the domain name <nianticlabs.com> and is confusingly similar to the NIENTIC Mark.

(11) The Respondent has no rights or legitimate interests in respect of the domain name:

- a) The Respondent has no rights or legitimate interest in either the trademark NIENTIC or in the disputed domain name <nianticlabs.in>.
- b) Respondent never authorized by Complainant to use the NIENTICLABS Mark or NIENTIC Mark in relation to any goods or services. Complainant never authorized or licensed the Respondent to use the NIENTIC Mark and/or NIENTIC LABS Mark in any way or for any purpose. Respondent has no connection or affiliation with Complainant and has not received any consent, express or implied, to use the NIENTIC Mark and/or NIENTIC LABS Mark in a domain name or in any other manner. Respondent does not have any past dealing with the Complainant and has no reason to adopt "nianticlabs" as part of the disputed domain name. Following decision is relied upon
- c) Compagnie de Saint Gobain v. Com-Union Corp, (WIPO Case No. D2000-0020), while transferring the domain name <saint-gobain.net>, the panel held "Complainant has not licensed or otherwise permitted Respondent to use any of its trademarks or



to apply for any domain name incorporating any of those marks...it appears that Respondent has not registered nor used the name "Saint-Gobain" as a trademark, nor has it ever been known by this name... Panel therefore finds that Respondent has no right or legitimate interest in the Domain Name." [Annexure 18].

- d) Respondent is NOT making any legitimate, non-commercial, or fair use of the Disputed Domain Name: The domain <nianticlabs.in> was registered in December 2021, and it does not resolve to any active website. The domain name only directs to a parked page which the Respondent has created for the sole purpose of selling the disputed domain name. The webpage features a message "The domain name nianticlabs.in is for sale!", and the Respondent has listed the disputed domain name for sale at an inflated price of USD 20, 000. Relevant webpage is attached as Annexure 19. These actions of the Respondent clearly show that the Respondent was well-aware of the value and reputation of the Complainant's NIENTIC Mark, and has registered the domain name with the sole intention of diverting traffic to the webpage hosted at the disputed domain name and then offering to sell the disputed domain name at an inflated price. This establishes that the Respondent does not have any legitimate rights and interest in the disputed domain name and has evidently registered the same with the malafide intent of making illegitimate and undue commercial enrichment by attracting consumers to the domain name and offering the domain name for sale. Moreover, the composition of the disputed domain name <nianticlabs.in> is identical to the NIENTIC LABS Mark and carries a high risk of implied affiliation and cannot constitute fair use. Such use is contrary to a bona fide offering of goods or services or a legitimate interest in the mark.
- e) Following decisions are relied upon:
- Niantic, Inc. v. Privacy service provided by Withheld for Privacy ehf / Redde reddy (WIPO Case No. D2021-3801), in deciding the complaint in favour of the present Complainant, the panel held that the Respondent did not have legitimate rights and interests



in the disputed domain name <niantic.careers> on the grounds that- "the composition of the Disputed Domain Name, which is identical to the NIANTIC Mark, carries a high risk of implied affiliation and cannot constitute fair use here, as it effectively impersonates or suggests sponsorship or endorsement by the Complainant." [Refer Annexure 10]

-Right move Group Limited v. Domain Admin, Privacy Protect, LLC (PrivacyProtect.org) / Richard Shaw (WIPO Case No. D2021-3867), the panel held "The Panel finds that the Respondent's use of the disputed domain name unfairly targets the Complainant's goodwill in its RIGHTMOVE mark... both by attempting to divert Internet users to the Respondent's PPC website and by offering the disputed domain name for sale for a sum in excess of its likely out-of-pocket costs. The Panel finds that neither such use can constitute a bona fide commercial use of the disputed domain name and finds therefore that the Respondent has no rights or legitimate interests in respect of the disputed domain name."

-Supernac's (Holdings) Limited v. Domain Administrator, DomainMarket.com (WIPO Case No. D2018-0540), the panel held "The Respondent's use of the disputed domain name is simply to offer it for sale, at a high price: USD 19,888...In the Panel's opinion, the Respondent's use of the disputed domain name - offering it for sale at USD 19,888 - is seeking to trade off third-party trademark rights, and in particular the trademark rights of the Complainant. While the Respondent is no doubt willing to sell the disputed domain name to any person willing to pay the price, in reality the Panel believes that the person to whom the disputed domain name has the greatest value - and, hence, the person most likely to be willing to pay the price - is the Complainant, since it is a person whose trademark rights the disputed domain name trades off... The Panel does not consider that the purpose of buying for re-sale a domain name that is identical or nearly identical to a trademark in which a third party has rights, is a purpose that, of itself, gives rise to rights or legitimate interests in the domain name, even if the domain name is partially or wholly descriptive. Absent some genuine use, or intended use, of the



domain name in a way that relates to the asserted descriptive meaning, merely offering such a domain name for sale does not give rise to rights or legitimate interests in it.”[Annexure 20]

- f) Respondent is not commonly known by the Disputed Domain Name and does not have any trademark rights in Disputed Domain Name: The Respondent is not commonly known by the disputed domain name and, to the knowledge of the Complainant, has not acquired any trademark rights in the marks NIENTIC or NIENTIC LABS. The Complainant owns trademark registrations and rights in the NIENTIC Mark and NIENTICLABS Mark across countries, including in USA where the Respondent appears to be located from the available details. In fact, the Respondent has actively concealed its trading name or identity from the Whois records as well as on the website. The Respondent has no reason to adopt or register the domain name<nianticlabs.in>.Following decision is relied upon:

-Golden Goose S.P.A. v. Whois guard Inc. / wei zhang (WIPO Case No. D2017-1654) panel held “...absence of any trademarks or trade names registered by the Respondent corresponding to the disputed domain name, or any possible link between the Respondent and the disputed domain name, that could be inferred from the details known of the Respondent or the webpage relating to the disputed domain name, corroborate with a finding as to the absence of a right or legitimate interest.”. [Annexure 21]

- g) Respondent's Knowledge of the Complainant's NIENTIC and NIENTIC LABS Marks: The Complainant's NIENTIC Mark and the NIENTIC LABS Mark have garnered impeccable reputation and goodwill owing to their longstanding and continuing use across the world, including in India. The Complainant's video games and mobile applications under the marks NIENTIC and NIENTIC LABS are popular and accessible to consumers across the world, including in USA (where the Respondent appears to be located from the available details). Therefore, it is unlikely that the Registrant did not know about the Complainant's rights in its NIENTIC Mark and NIENTIC LABS Mark. Registration of a domain



name based on awareness of a Complainant's trademark rights is recognized as bad faith registration. In *Lego Juris v. Robert Martin*, (NIXI Case No. INDRP/125, February 14, 2010), it was held that 'The Respondent ought to have been aware when he registered the disputed domain name that such registration would impede the use of the domain name by the legitimate owner of the trademark: such practice is found to be bad faith'. [Annexure 22].

- h) Thus, it is submitted that the Complainant has established a prima facie case of Respondent's lack of legitimate rights and interests in the domain name thus shifting the burden on the Respondent to show rights or legitimate interests [refer *Emirates of Emirates Group v. Zhan Yun* (NIXI Case No. INDRP/606)] and the Registrant has evidently registered the same with mala fide intent.

(12) The domain name was registered and is being used in bad faith :

- a) Bad faith is implicit in the registration of the disputed domain name without any legitimate interest therein. Bad faith in the Respondent's registration and current use of the disputed domain name is evident from the following:
- (i) Disputed domain name resolves to a parked page and there is a lack of bona fide offerings or business on the website: The disputed domain name does not host any active webpage thereat but resolves to a parked page which demonstrates that the Respondent is holding the disputed domain name passively. There is also no instance where the Respondent has made (or has made preparations for) a bona fide offering of goods/services under the mark/name NIENTIC and/or NIENTIC LABS or through hosting at the disputed domain name <nienticlabs.in>.
 - (ii) Knowledge of the Complainant's Mark and offering the domain name for sale: The webpage hosted by the Respondent at the disputed domain name lists the domain name <nienticlabs.in> for sale at a price of USD 20,000. The inflated price quoted for the



purchase of the disputed domain shows that the Respondent was aware of the Complainant's reputation and value of the NIANTIC Mark. In E. Remy Martin & C v. Christopher MacNaughton (WIPO Case No. D2018-2106), the panel held that, "the offer of the <louis13cognac.com> domain name for sale for USD 2,500 is a further indication of the Respondent's bad faith." and transferred the domain name to the Complainant.[Annexure 23]

(iii) Fake / masked / fictitious particulars in Whois records:

Respondent's particulars, including name and address provided in the Whois records appear to be fake, masked, and fictitious. See Philip Morris USA Inc. v. Domains by Proxy / Ray A Board (WIPO Case No. D2016-0840) where panel held "...when registering the Disputed Domain Name, the Respondent shielded its identity by using a masking service. This is an indication of bad faith registration and use under the Policy." [Annexure 24].

(iv) Misrepresentation of source, affiliation, sponsorship and

endorsement: Respondent's act diverts the Complainant's consumers and potential consumers seeking information about the Complainant to a parked page at the disputed domain name which is identical to the Complainant's domain name <nianticlabs.com>. Respondent's actions appear to be with the objective of deceiving the public by attracting consumers and creating a likelihood of confusion as to the source of Respondent's offerings (or would be offerings) and that the Respondent is in any manner affiliated, sponsored and/or otherwise endorsed by the Complainant.

b) The Complainant's NIANTIC Mark and NIANTIC LABS Mark have garnered immense reputation and goodwill owing to the long and continuing use, and have consequently become well-known much prior to the registration of the disputed domain name by the Respondent. Registration of a domain name based on awareness of a complainant's trademark rights is recognized as bad faith registration. (refer Annexure 22).

c) Furthermore, the Complainant is the Registrant of the domain name <nianticlabs.com> that incorporates the NIANTIC LABS Mark. This is bound to give rise to consumer confusion as to whether the



impugned domain name <nianticlabs.in> is associated with the Complainant.

- d) In view of (i) Complainant's registered and common law rights in NIENTIC Mark and NIENTIC LABS Mark, (ii) longstanding use of the NIENTIC Mark and the NIENTIC LABS Mark by Complainant at least a decade prior to Respondent's registration of the domain name, (iii) Complainant's prior use of the marks on the Internet, and in other domain name(s), and (iv) tremendous fame, goodwill, and reputation associated with the marks, it is impossible to conceive of any circumstance in which Respondent could have registered the domain name in good faith or without knowledge of Complainant's rights in the NIENTIC Mark and the NIENTIC LABS Mark.
- e) In light of the above, it is apparent that the registration and use of the domain name <nianticlabs.in> by the Respondent is not bona fide and the Respondent has prima facie registered and is using the disputed domain name in bad faith.

(13) Other Legal Proceedings:

No other legal proceedings have been commenced or terminated in connection with or relating to the disputed domain name <nianticlabs.in> that is the subject of this complaint.

(14) Remedy Sought:

In accordance with Paragraph 10 of the Policy, for the reasons described in Section V. above, the Complainant requests the Hon'ble Arbitration Panel appointed in this domain name dispute, to issue a decision that the disputed domain name <nianticlabs.in> be transferred to the Complainant.

RESPONSE BY THE RESPONDENT

- (15) Communicated by AT mail dated 28.09.2022 that the 'Respondent failed to submit the required documents within the time limit mentioned in mail dated 06.08.2022 & 07.09.2022 ie 30.08.2022 & 16.09.2022 ,



therefore the Respondent lost their right to entertain it. The proceeding of this case was kept closed for award and the matter would be decided ex-parte on the basis of the material on record with this tribunal as per INDRP policy'.

REJOINDER BY THE COMPLAINANT

- (16) Since Respondent failed to file the Statement of Defense , so there is no question of submitting the Rejoinder by the Complainant.

DISCUSSION AND FINDINGS

- (17) After going through the correspondence, this AT comes to the conclusion that the Arbitral Tribunal was properly constituted and appointed as per Clause 5 of the INDRP Rules of Procedure and Respondent has been notified of the complaint of the Complainant.
- (18) Respondent was given enough opportunity to submit Reply of Complaint (Statement of Defense) by 30.08.2022 & up to 16.09.2022 . But Respondent failed to submit the same within said time limit, therefore the Respondent had lost their right to entertain it. The proceeding of this case was kept closed for award on 28.09.2022 and the matter is be decided ex-parte on the basis of the material on record with this tribunal as per INDRP policy.
- (19) Under Clause 4, of the .IN Domain Name Dispute Resolutions policy (INDRP), the Complainant has filed a complaint to .IN Registry on the following premises:
- (a) the Registrant's domain name is identical or confusingly similar to a Name , Trademark or Service Mark in which the Complainant has rights; and
 - (b) the Registrant's has no rights or legitimate interest in respect of the domain name; and
 - (c) The Registrant's domain name has been registered or is being used either in bad faith or for illegal/unlawful purpose



- (20) **The Registrant's domain name is identical or confusingly similar to a Name , Trademark or Service Mark in which the Complainant has rights:**

Facts & Findings

On the basis of the referred Awards of WIPO, INDRP cases and other above mentioned facts by Complainant and due to non submission of Statement of Defense by Respondent, the Arbitral Tribunal concludes that the Complainant has established 4(a) of the .IN Domain Name Dispute Resolution Policy (INDRP) and accordingly satisfies the said Clause of policy.

- (22) **The Registrant's has no rights or legitimate interest in respect of the domain name:**

Facts & Findings

On the basis of the referred Awards of WIPO, INDRP cases and other above mentioned facts by Complainant and due to non submission of Statement of Defense by Respondent, the Arbitral Tribunal concludes that the Complainant has established Clause 4(b) of the .IN Domain Name Dispute Resolution Policy (INDRP) and accordingly satisfies the said Clause of policy.

- (23) **The Registrant's domain name has been registered or is being used either in bad faith or for illegal/unlawful purpose:**

Facts & Findings

On the basis of the referred Awards of WIPO cases , other above mentioned facts by Complainant and due to non submission of Statement of Defense by Respondent, the Arbitral Tribunal concludes that the Complainant has established Clause 4(c) of the .IN Domain Name Dispute Resolution Policy (INDRP) and accordingly satisfies the said Clause of policy.



(22) **ARBITRAL AWARD**

I, **Rajesh Bisaria** , Arbitrator, after examining and considering the pleadings and documentary evidence produced before and having applied mind and considering the facts, documents and other evidence with care, do hereby publish award in accordance with Clause 5,17 and 18 of the INDRP Rules of Procedure and Clause 11 of .IN Domain Name Dispute Resolution Policy (INDRP), as follows:

Arbitral Tribunal orders that the disputed domain name

www. nianticlabs.in

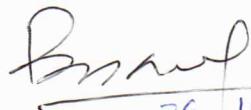
be forthwith TRANSFERRED from Respondent to Complainant.

Further AT takes an adverse view on the bad faith registration of impugned domain by the Respondent and to restrict the act for future misuse, fine of Rs 10000/- (Rs Ten thousand only) is being imposed on the Respondent, as per the provision in clause 11 of .IN Domain Name Dispute Resolution Policy (INDRP) to be paid to .IN Registry for putting the administration unnecessary work.

AT has made and signed this Award at Bhopal (India) on 26.10.2022 (Twenty Sixth Day of October, Two Thousand Twenty Two).

Place: Bhopal (India)

Date: 26.10.2022


26/10/2022
(RAJESH BISARIA)

Arbitrator

