

उत्तर प्रदेश UTTAR PRADESH

EY 245862

INDRP ARBITRATION  
THE NATIONAL INTERNET EXCHANGE OF INDIA [NIXI]

ARBITRATION PANEL DECISION  
SOLE ARBITRATOR: RODNEY D. RYDER

Sproxil, Inc.

v.

Bright Simons

INDRP CASE NUMBER - 1120

ARBITRATION AWARD

Disputed Domain Name: [www.sproxil.in](http://www.sproxil.in)



### **The Parties**

The Complainant in this arbitration proceeding is Sproxil, Inc., having its registered office at 16192 Coastal Highway, Lewes, Delaware 19958, United States of America; represented collectively by Sproxil Brand Protection Solutions Private Limited and Batra Law Offices.

The Respondent in this arbitration proceeding is Bright Simons, mPedigree Network, 1 Rosicrucian Link East Legon, Accra, Ghana as per the details given by the Whois database maintained by the National Internet Exchange of India [NIXI].

### **The Domain Name and Registrar**

The disputed domain name is www.sproxil.in. The said domain name is registered with eNom Inc.

### **Details of the disputed domain name**

The dispute concerns the domain name www.sproxil.in. The said domain name was registered on October 23, 2013. The particulars of the said domain name are as follows:

<u>Registrant:</u>	Bright Simons
<u>Registrant Organisation:</u>	mPedigree Network
<u>Registrant Address:</u>	1 Rosicrucian Link East Legon, Accra, Ghana
<u>Registrant Phone:</u>	+233.549899023
<u>Registrant Email:</u>	bbsimons@gmail.com

### **Procedural History [Arbitration Proceedings]**

This arbitration proceeding is in accordance with the .IN Domain Name Dispute Resolution Policy [INDRP], adopted by the National Internet Exchange of India ["NIXI"]. The INDRP Rules of Procedure [the Rules] were approved by NIXI on 28<sup>th</sup> June, 2005 in accordance with the Indian Arbitration and Conciliation Act, 1996. By registering the disputed domain name with the NIXI accredited Registrar, the Respondent agreed to the resolution of the disputes pursuant to the .IN Dispute Resolution Policy and Rules framed thereunder.

According to the information provided by the National Internet Exchange of India ["NIXI"], the history of this proceeding is as follows:

In accordance with the Rules, 2(a) and 4(a), NIXI formally notified the Respondent of the Complaint, and appointed Rodney D. Ryder as the Sole Arbitrator for adjudicating upon the dispute in accordance with the Arbitration and Conciliation Act, 1996, the Rules framed thereunder, and the .IN Domain Name Dispute Resolution Policy and the Rules framed thereunder. The Arbitrator submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by NIXI.

In this matter, the arbitration proceedings commenced on July 11, 2019. A copy of the complaint with the annexures was sent to the Respondent by NIXI through an e-mail dated July 11, 2019. A complete set of complaint was also dispatched to the Respondent through



courier by NIXI. Thereafter, the Panel sent an e-mail dated July 11, 2019 to the Respondent requesting for submission of a response to the complaint by July 25, 2019.

Thereafter, the Respondent sent an e-mail dated July 16, 2019 to the Panel stating that it did not have a copy of the complaint. The Panel promptly responded to the Respondent's mail on the same day and provided it with a copy of the complaint. In the same e-mail, the Panel reminded the Respondent to submit its response to the complaint by July 25, 2019.

Thereafter, the Panel received an e-mail from the Respondent on July 25, 2019 requesting time until July 29, 2019 to file its response. The Panel agreed to this and extended the deadline to file the response till July 31, 2019.

The Respondent thereafter filed its response to the complaint on July 31, 2019.

### **Grounds for the proceedings**

The Complainant has raised the following grounds for initiating the present proceedings:

1. The disputed domain name is identical to a trademark in which the Complainant has statutory rights.
2. The Respondent has no rights or legitimate interests in respect of the disputed domain name.
3. The disputed domain name has been registered in bad faith.

### **Parties Contentions**

The main contentions made by the Complainant and the Respondent are discussed below:

#### **A. Complainant**


1. The Complainant submitted that the disputed domain name <www.sproxil.in> contains the Complainant's trademark/trade name registered in India and several other countries.
2. The Complainant further submitted that the Respondent had obtained registration for the disputed domain name by making false representations of knowledge under clause 3 of the INDRP which states that a Registrant is solely responsible to ensure before the registration of the impugned domain name that such domain name registration does not violate the rights of any proprietor/brand owner.
3. The Complainant submitted that it has its headquarters in USA and has reinforced its international presence through several additional offices in Ghana, Nigeria, Kenya and India, where the Indian subsidiary was established on June 22, 2011.
4. The Complainant submitted that it coined, conceived and adopted the trademark/trade name 'Sproxil' in and around October 2008 and has been openly, continuously and extensively using the mark worldwide since then. In India, the Complainant's products have been sold under the 'Sproxil' trademark since June 2011.
5. The Complainant further submitted that it is the owner of www.sproxil.com, which is accessible to users globally including those in India. The said website contains extensive





information about the Complainant's products marketed and sold under the 'Sproxil' trademark and corporate name.

6. The Complainant submitted that it has over 25 clients in India and that it has built an admirable reputation worldwide for itself and has invested substantial amounts of resources in promoting its products under the trademark 'Sproxil' in India.
7. The Complainant further stated that the Respondent is engaged in the business of anti-counterfeiting technology and directly conflicts with the Complainant's business activities in India.
8. The Complainant preferred to rely on the following cases:
  - a. In *Alibaba Group Holding Limited v. Rickson Rodricks and Domaen com* [INDRP/073], it was held that the domain name incorporating a Complainant's registered trademark may be sufficient to establish identity or confusing similarity, despite the addition of other words to such marks.
  - b. In *Puneet Vatsayan v. Prajakt Raut* [INDRP/512], it was held that when a disputed domain name contains the trade mark in its entirety, the domain name is identical and confusingly similar.
9. The Complainant further argued that the Respondent does not have legitimate rights in respect of the disputed domain name as is evident from the following circumstances brought up by the Complainant:
  - a. The domain name [www.sproxil.in](http://www.sproxil.in) was not reachable on December 10 2018 as the Respondent was not using the same for any legitimate purpose and had retained the same for harming the business prospects of the complainant in India.
  - b. The Respondent was aware of the Complainant's brand and its global presence in the field of mobile authentication in USA, Africa, India and other places prior to registration of the domain name.
  - c. The Respondent and its company have never been known by the domain name and its name is completely different from the domain name.
  - d. The Respondent is the President of mPedigree Network which is a direct competitor of the Complainant. There is no logical reason for a competitor to get the trademark/ trade name of its competitor registered except to divert its customers and to prevent the owner of the 'Sproxil' trademark from reflecting it in a corresponding domain name.
  - e. The Complainant submitted that it had registered the domain name [www.sproxil.com](http://www.sproxil.com) on October 13, 2008 whereas the disputed domain name [www.sproxil.in](http://www.sproxil.in) was registered by the Respondent on October 23, 2013.
  - f. The Complainant further submitted that the Respondent is neither commonly known in public or has registered its business under the name 'Sproxil' with the Ministry of Corporate Affairs in India.
  - g. Furthermore, the Respondent's impugned domain name was intentionally created for commercial gain and to misleadingly divert the consumers or traders of the Complainant in order to cause irreparable loss, harm and damage to the goodwill and business of the Complainant.





- h. In *Amazon Technologies v. Mr. Harikishore* [INDRP/349], it was observed that the use of domain name consisting of a trademark to divert the users to another commercial website is not a bona fide offering of goods or services and cannot confer any rights or legitimate interest upon the Respondent.
10. The Complainant further submitted that the present case is one in which the registrant itself is a competitor of the Complainant and there is direct evidence that the registration is in bad faith.
  11. The Complainant stated that the Respondent was formally made aware of the Complainant's registrations as the same were put on the email and Cease and Desist notice sent to the Respondent on November 06, 2014 and hence the use of the Complainant's trademark 'Sproxil' by the Respondent is in bad faith.
  12. Furthermore, the Complainant submitted that the Respondent is the Complainant's direct competitor and has indubitable knowledge of the Complainant's trademark rights in 'Sproxil'. In *Pfzier v. NA* [WIPO D2005-007], it was held that knowledge of trademark rights constitutes as evidence of bad faith registration.
  13. The Complainant argues that by using the disputed domain name, the Respondent has intentionally attempted to attract Internet users to its website by creating a likelihood of confusion with the Complainant's name or mark as to the source or sponsorship or affiliation or endorsement of the Respondent's website or the products or services offered/available on the Respondent's website thereby violating Para 6 of the INDRP.
  14. Furthermore, the Complainant asserts that the Respondent has deliberately registered the impugned domain name with the intention of preventing the Complainant who is the owner of the trademark 'Sproxil' from reflecting the said trademark in its domain name in India.

#### **B. Respondent**

The Respondent submitted that the organization [mPedigree Network] founded by it is a highly respected developer and provider of a range of software and platform products in several categories, *inter alia* marketing, brand protection, supply chain, safety regulation enforcement. It further submitted that it has been featured in numerous lists, including the Fortune World's 50 Greatest Leaders 2016.

The Respondent made the following main statements in support of its argument that the Complainant should not succeed in its complaint:

1. The Respondent submitted that it registered the disputed domain name on October 23, 2013. As per the Respondent, the Complainant's Indian trademark registration certificate was issued on February 09, 2018 and the said registration was effective from April 18, 2016, the date of the trademark application. It further submitted that as per Section 23 of the Trade Marks Act, 1999, registration of a trademark is from the date of application. Based on this, the Respondent contended that the Complainant applied for





- a trademark registration for the mark 'Sproxil' nearly three years after the Respondent had registered the domain name.
2. The Complainant has failed to show that it has legitimate rights in the disputed domain name.
  3. The Respondent registered the disputed domain name in 2013, well before the Complainant applied for registration for the trademark 'Sproxil' in India in 2016.
  4. The Respondent submitted that the Complainant has failed to produce any evidence to show that it had been selling its products under the name 'Sproxil' in India since June 2011, or the geographical reach of such products purportedly sold in India.
  5. The Respondent submitted that the Complainant has failed to produce any evidence to show that the consumers in the relevant Indian market associate the word 'Sproxil' with the products of the Complainant.
  6. The Respondent further submitted that the Complainant has failed to produce any evidence to show that the word 'Sproxil' has acquired a transborder reputation and Indian consumers in the relevant market are aware of it.
  7. The Respondent submitted that the Complainant has contended that it is the registered proprietor of the trademark 'Sproxil' under the Madrid International Registration. However, the registration appears to be for a specific mark/logo of Sproxil, and not for the word 'Sproxil' itself. The Complainant's rights are confined to such mark/logo and it does not have far reaching rights over any and every use of the word 'Sproxil'. Moreover, it was contended that the Complainant has not put forward any evidence to show that it has ever used the word 'Sproxil' or its specific mark/logo in the European Union markets, nor does the Complainant claim to have any offices or operations in the EU.
  8. The Respondent contends that the registrations for US, EU and China for the Complainant's mark 'Sproxil' appear to be for a specific logo/mark and not the word mark 'Sproxil'. The Respondent further contents that there is no evidence on record to show that the Complainant is actively using the word 'Sproxil' or its logo in the US or Chinese markets.
  9. The Respondent submitted that there is no evidence to show that the use of the word 'Sproxil' by the Complainant has acquired a distinctive meaning or that it is associated with the Complainant's products only.
  10. The Respondent argued that the Complainant's allegation that the Respondent obtained the registration of the disputed domain name by making false representation is unsubstantiated and baseless.
  11. The Respondent further argued that it has been bona fide using the word 'Sproxil' as an acronym for services in relation to its 'Viprox' invention, services under which have no connection to the anti-counterfeiting market, and relate instead to visual surveillance systems.
  12. The Respondent referred to Paragraph 7 of the INDRP and submitted that its use of the disputed domain name falls squarely within the purview of paragraph 7[iii] of the INDRP. The Respondent further claimed that the use of the website [www.sproxil.in](http://www.sproxil.in) to disseminate information about the Virprox system and its marketing through various





acronyms that correspond to its broad usage, was for a legitimate non-commercial purpose.

13. The Respondent submitted that it is not attempting to market or sell any goods or services through the website. While responding to the contention put forward by the Complainant while relying on *Amazon Technologies v. Mr. Harikshore* [INDRP/349], the Respondent submitted that it is not seeking to provide any goods and services offering to customers through the website. Furthermore, the website [www.sproxil.in](http://www.sproxil.in) does not contain any link directing potential customers to mPedigree's websites.
14. The Respondent further submitted that even if mPedigree and the Complainant are 'direct competitors', as alleged by the Complainant, the website [www.sproxil.in](http://www.sproxil.in) does not disclose any connection with mPedigree, and there would be no reason for any potential visitor to the site to draw any association between the website and mPedigree.
15. The Respondent submitted that it has a personal and prior nexus with the word 'Sproxil'. The Respondent pointed out further that the Complainant had omitted to disclose that the Complainant's founder, Mr Ashifi Gogo, was closely involved with the Respondent from 2005 to 2011, when the Respondent was designing the mPedigree Network.
16. The Respondent also pointed out that he had discussed with Mr Ashifi Gogo several names for associated platforms that were needed to build the right ecosystem to apply to the Respondent's Virprox technology. The names discussed included 'syncrytel', 'sprox', 'authentitxt', 'proxyt' and 'Sproxil'. The Complainant, while still associated with mPedigree, had openly marketed 'Sproxil' as a service offering or marketing extension of mPedigree.
17. The Respondent further submitted that in late 2008, Mr Ashifi Gogo had, while he was still employed by the Respondent in the mPedigree Network, secretly founded a competitor entity called mPedigree Logistics, which has been subsequently renamed and incorporated under the name of Sproxil. The Respondent submitted that both 'Sproxil' and 'mPedigree' are brand names coined by the Respondent, while the Complainant was still an employee of the Respondent, therefore, the Respondent has a legitimate right to utilize these names.
18. The Respondent submitted that up till the year 2012, Sproxil domains were presented worldwide as affiliate mPedigree domains. The Respondent further submitted that while being associated with both the Respondent's company and its competitor, Mr Ashifi Gogo had engaged in various mala fide actions, including changing the registration of mPedigree Network's domain names and listing himself as the new registrant without the Respondent's knowledge or permission. It was submitted that the Respondent has managed to regain some of these domain names through multiple proceedings before WIPO.
19. The Respondent therefore submitted that it has a legitimate right and interest in respect of the disputed domain name, which has been set up and named 'sproxil.in' for specific reasons.
20. The Respondent contended that the allegations of the Complainant that the disputed domain name was registered in bad faith were misconceived and baseless.





21. The Respondent, while quoting Paragraph 6 of the INDRP, claimed that the explanation of the term 'bad faith' in paragraph 6[i] of the INDRP finds no application in the present case, since the Respondent never sought to indulge in cyber-squatting i.e. acquired the disputed domain name with the intent to sell it at a profit to the Complainant or a competitor of the Complainant.
22. The Respondent argued that it is incorrect to allege that the Respondent is a direct competitor of the Complainant. During the time that the Respondent registered the disputed domain name, the Complainant did not provide brand protection services through any e-commerce services, which is a key business growth model of the Respondent's mPedigree Network. The Respondent further claimed that the Complainant still follows a Business-to-Business model where it serves all its customers virtually offline and 98% of the consumers who interact with their services do so by GSM-based text/SMS messaging. Furthermore, the Respondent countered that the Complainant offers very limited services to consumers in India and by its own admission has only 25 clients in India, although it claims to have commenced operations in India as early as 2011.
23. The Respondent submitted that the Respondent's business [i.e. mPedigree Network] is a global leader in the use of mobile and web technologies in securing products against faking, counterfeiting and diversion. The Respondent further submitted that the Respondent's business is not limited to the B2B model and in fact provides direct services to consumers, both individuals as well as stakeholders such as governments, including intergovernmental bodies, in tackling the problem of counterfeit products, particularly in various African countries.
24. The Respondent, while responding to the reliance made by the Complainant in *Pfizer v. NA [WIPO D2005-007]* submitted that the Complainant has mischaracterized the findings of the Administrative Panel in the said case, which was a very different factual scenario where the disputed domain name was being used to redirect customers to the respondent's products. The Respondent further argued that the decision has been rendered in context of 'Pfizer' being a well-known mark throughout the world as opposed to the Complainant's business that operates in three countries in Africa and has meager operations in India. Thus, the Complainant's mark cannot be considered a 'famous mark' [at par with Pfizer or Sony] and thus the cases relied upon by the Complainant do not hold practical relevance in the present case.
25. The Respondent denied receipt of any cease and desist notice from the Complainant and pointed out that the said cease and desist notice dated 6 November 2014 did not refer to any registration of the 'Sproxil' mark by the Complainant in India. The Respondent further submitted that there is no evidence of the Complainant's mark being widely used in US and EU markets. Furthermore, the Respondent pointed out that although the case and desist notice of November 2014 was in respect of the .in and .co.uk domain names, it made no reference to any operations of the Complainant either in India or the UK at the time, even though the Complainant's case is that it had started selling products under the name 'Sproxil' in India in June 2011 itself.





26. The Respondent submitted that the Complainant's contention that the Respondent is using the disputed domain name to attract internet users to its website by creating a likelihood of confusion was not valid due to the following reasons:
- a. Given the nature of the Complainant's customers, it is highly unlikely that they would be confused by the mere use of the word 'Sproxil' in the domain name, since the Complainant sells directly to relatively sophisticated goods manufacturing and marketing companies and its business model involves a long-term relationship with the customer.
  - b. The website [www.sproxil.in](http://www.sproxil.in) is being used purely for non-commercial purposes such as information dissemination. There is absolutely no digital or navigational connection by means of which a visitor to [www.sproxil.in](http://www.sproxil.in) may be redirected to mPedigree, instead of immediately recognizing that they have landed on a website related to an organization that is not even remotely related to the Complainant.
  - c. Moreover, the website [www.sproxil.in](http://www.sproxil.in) does not appear in the top 1000 results in the search for the term 'Sproxil'. The Respondent has not undertaken any advertising or SEO activities with the intent of ensuring that internet users looking for 'Sproxil' by typing the 'Sproxil' term in a search engine would land on [www.sproxil.in](http://www.sproxil.in) by mistake.
27. The Respondent refuted the Complainant's final contention that the Respondent has deliberately registered the disputed domain name with the intention of preventing the Complainant from reflecting the said trademark in its domain name in India as baseless.
28. The Respondent while replying upon paragraph 6[ii] of the INDRP which states that if a 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, it shall be considered evidence of the registration and use of the domain name being in bad faith, submitted that in the present case, the Complainant has not only failed to prove that the Respondent has registered/used the disputed domain name with the intention of preventing the Complainant from reflecting its trademark in its domain name in India, but it has also failed to establish that the Respondent has engaged in a 'pattern' of such conduct.
29. The Respondent also relied on *Manish Vij & Ors. v. Indra Chugh & Ors.* [AIR 2002 Del 243], in which the Hon'ble Delhi High Court has while interpreting the term 'bad faith' in a similarly worded WIPO policy, held that 'bad faith' does not simply mean bad judgment, but implies a conscious doing of a wrong with a dishonest purpose. The Respondent submitted that the Complainant has failed to make out a case of dishonest intention or purpose on part of the Respondent.
30. The Respondent further submitted that the Complainant has failed to prove bad faith on part of the Respondent or show any actual loss, damage or prejudice on account of the Respondent's use of the disputed domain name.





### **Preliminary Observations**

While the domain name <www.sproxil.in> was registered on October 23, 2013 by the Respondent, the Complainant and the Respondent have a past connection dating back several years from the date of registration of the domain name.

The Panel believes that it is important to clearly record details of this connection as put forth by the Respondent in its response to the complaint.

It has been contended by the Respondent that the Complainant's CEO – Mr Ashifi Gogo was an employee at the Respondent's company mPedigree Network. It has also been contended that the Respondent coined the word 'SPROXIL' sometime in 2008 to serve as a subsidiary brand of a technological platform called Viprox. However, no plausible evidence for the same has been submitted by the Respondent.

It is further submitted by the Respondent that the CEO of the Complainant whilst he was employed with the Respondent's company used the 'SPROXIL' brand in his dealings on behalf of the Respondent's company. However, again, no evidence has been submitted by the Respondent in support of this statement.

The Respondent has also referred to a past eUDRP Administrative Panel decision of *mPedigree Network, Ltd. v. Registration Private, Domains By Proxy, LLC / Ashifi Gogo, Undergrad Thesis Case No. D2017-1495* where mPedigree Network Limited – the company of the Respondent in the present proceeding had filed a complaint against Mr Ashifi Gogo, the Complainant in the present proceeding for wrongfully registering/obtaining the domain name

<mpedigree.org>. The domain name was thereafter ordered to be transferred to the complainant – mPedigree Network Limited, that is the Respondent's company in the present proceedings.

In addition to this, the present domain name in question was part of a previous INDRP proceeding as well - *Sproxil Inc vs. Bright Simons; INDRP/656*. The Complainant had first filed an INDRP complaint against the Respondent for this particular domain name in the year 2015. The complaint was accepted by the Panel and it had ordered the transfer of the domain name to the Complainant.

The Respondent had thereafter appealed the said decision before the Hon'ble High Court of Delhi under Section 34 of the Arbitration and Conciliation Act, 1996. The Hon'ble High Court thereafter vide its Order dated May 09, 2018, ruled in favour of the Respondent and set aside the Arbitral Award dated March 31, 2015 owing to the fact that the Respondent was not served a copy of the complaint and that principles of natural justice were violated.





Thereafter, it is the contention of the Respondent that the domain name has remain locked and that it has been trying to take control of the same. The Respondent has submitted a trail mail indicating its communication with NIXI, the .IN Registry and the Registrar in this regard.

**Statutory Rights of the Complainant in the mark 'Sproxil' in India**

In the complaint, the Complainant has referred to a trademark registration for the mark 'SPROXIL' in India. The complaint refers to an Application Number 2215086 dated October 04, 2011 in Class 42 as the said trademark registration. An annexure [Annexure C] is purportedly annexed to the complaint which is the Registration Certificate for the said application.

However, upon review of the details of the trademark registration provided by the Complainant, it came to the Panel's attention that the Complainant has inadvertently provided incorrect information to the Panel.

The Panel thus conducted its own independent research pursuant to Paragraph 8[a] and 12[a] of the Rules. The Complainant has referred to and relied on a trademark application number 2215086 which was marked as abandoned on March 28, 2016 by the Registrar of Trade Marks. Upon perusing the records of the said application, as maintained by the Trade Marks Registry, it came to the attention of the Panel that the said trademark application was never registered as a trademark and was in fact marked abandoned before the registration process could be completed owing to the Complainant's failure to respond to the Examination Report issued by the Registrar of Trade Marks.

Interestingly, the Trademark Registration Certificate submitted by the Complainant in support of this application actually pertains to a different Application Number - 3235517. Upon perusing the records of the said application, as maintained by the Trade Marks Registry, it came to the attention of the Panel that the said trademark application, for the mark 'SPROXIL' was filed on April 18, 2016 in class 42. However, the 'date of use' of the said application is July 01, 2011.


While the Panel has decided to consider these details, including the user date associated with the trademark registration certificate for Application Number 3235517, it takes a strong view of such a critical oversight by the Complainant.

**The issues involved in the dispute**

The Complainant in its complaint has invoked paragraph 4 of the INDRP which reads:

*"Types of Disputes -*

*Any Person who considers that a registered domain name conflicts with his legitimate rights or interests may file a Complaint to the .IN Registry on the following premises:*





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

*The Respondent is required to submit to a mandatory Arbitration proceeding in the event that a Complainant files a complaint to the .IN Registry, in compliance with this Policy and Rules thereunder."*

According to paragraph 4 of the INDRP, there are 3 essential elements of a domain name dispute which are being discussed hereunder in the light of the facts and circumstances of this case.

### **Discussion and Findings**

*The Respondent's domain name is identical and confusingly similar to a name, trademark or service in which the Complainant has rights.*

It has been proved by the Complainant that it has trademark rights in the mark 'SPROXIL' in India and other countries. The disputed domain name contains the Complainant's 'SPROXIL' trademark in its entirety.

It has been previously decided under the INDRP that incorporating a trademark in its entirety is sufficient to establish the identical and confusingly similar nature of the disputed domain name. Moreover, the addition of the top-level domain ".in" is irrelevant in determining whether the disputed domain name is confusingly similar to the Complainant's mark. It is well established that the specific top level domain, such as ".com", ".net", ".in", ".co.in", ".org.in" etc. does not affect the domain name for the purpose of determining whether it is identical or confusingly similar [Relevant Decisions: *Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr.*, WIPO Case No. D2000-1525; *Rollerblade, Inc. v. Chris McCrady*, WIPO Case No. D2000-0429; *Aon PLC and Ors. v. Guanrui*, INDRP/633].

For the purposes of this ground, it is not required for the Panel to dig deeper into the contentions of either the Complainant or Respondent as none of it can change the fact that:  
a] the Complainant is the proprietor of the mark 'SPROXIL' in India and other countries; and  
b] the disputed domain name is identical and confusingly similar to the Complainant's registered trademark 'SPROXIL'.

Objections raised by the Respondent about the date of use of the mark as well as objections related to the fact that the Complainant's trademark registrations in USA, China and other countries, except for Ghana and India, are not for the word-mark 'SPROXIL', but for a logo/device-mark depicting the word 'SPROXIL' and should thus not be considered for the present proceedings is not sustainable. For the specific purpose of this ground, the Panel is inclined to accept the Complainant's trademark registrations and statutory rights in the





trademark 'SPROXIL'.

In light of the foregoing, the Panel has come to the conclusion that the disputed domain name is identical with or deceptively similar to the Complainant's trademark 'SPROXIL'. Accordingly, the Panel concludes that the Complainant has satisfied the first element required by Paragraph 4 of the INDRP.

[Relevant Decisions: *Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr.*, WIPO Case No. D2000-1525; *Aon PLC and Ors. v. Gangadhar Mahesh*, INDRP/632; *Wells Fargo & Co. and Anr. v. DeepDas Kumar*, INDRP/628; *Natures Basket Limited & Ors. v. Dipti Singla*, INDRP/683; *Havells India Limited and Anr. v. Whois Foundation*, WIPO Case No. D2016-1775]

The Respondent has no rights or legitimate interests in respect of the disputed domain name  
The second element that the Complainant needs to prove and as is required by paragraph 4(ii) of the INDRP is that the Respondent has no legitimate rights or interests in the disputed domain name.

The Respondent submits that its use of the domain name comes under paragraph 7[iii] of the Policy as it is using the domain name for a legitimate and non-commercial use.

The Respondent has submitted that it is, or rather was, using the domain name "to disseminate information about the Viprox system and its marketing through various acronyms that correspond to its broad usage in the open-source, non-profit world, particularly in the area of "visual surveillance". The Respondent is thus using the Disputed Domain Name for a legitimate non-commercial purpose."

The Respondent further submits that it did not attempt to market or sell any goods or services through the domain name. In support of this, it points to an undated screenshot of the homepage of the domain name as submitted by the Complainant as part of its complaint. The Respondent specifically points to a statement which appears on the said screenshot:

*"We do not provide services under our brand but work with leading providers around the world to identify best-in class technology and certification."*

This, the Respondent contends, establishes that no commercial gain was received by the Respondent through the domain name. However, a detailed review of the screenshot provided by the Complainant – and relied upon by the Respondent as well – does not reveal any evidence which could beyond doubt establish that the Respondent was/is making a non-commercial use of the domain name.

Moving forward, submissions have been made by the Respondent stating that the Complainant's CEO was an employee at the Respondent's company. It has been further





submitted that the mark 'SPROXIL' was one of several marks which the Respondent discussed with the Complainant's CEO as part of a new service offering which the Respondent was about to launch. However, no evidence has been submitted to support this.

It has been further contended that the Complainant was previously known as mPedigree Logistics, a name similar to the Respondent's company, and that the Complainant's name was thereafter changed to Sproxil Inc. The Respondent further submits that the domain <www.sproxil.com> was presented alongwith the domain <www.mpedigree.org> in atleast the year 2012 thereby indicating that the mark 'SPROXIL' was indeed associated with the Respondent and its company. However, as per additional details submitted by the Respondent in the UDRP WIPO *Case No. D2017-1495*, it is clear that the Complainant's CEO had the domain name <www.mpedigree.org> in his control since 2010. In light of this, it is safe to assume that both these domain names - <www.sproxil.com> and <www.mpedigree.org> as mentioned in Annexure 5 of the Respondent's response were in control of the Complainant. Similarly, while Annexure 6 of the Respondent's response refers to both Sproxil and mPedigree, it is not clear which mPedigree the document refers to – since, as submitted by the Respondent itself, the Complainant was known as mPedigree Logistics before changing its name to Sproxil Inc.

The Panel agrees that while there is indeed an underlying issue of a far greater dispute between both the parties – as is evident from the UDRP WIPO *Case No. D2017-1495*, the Panel at this time is constrained to exclusively rule on the merits [if any] of the complaint put forth by the Complainant under the Policy.

It is pertinent to note here that the Respondent registered the domain name on **October 23, 2013**. Prior to this date, the Respondent has not been able to establish any use of the mark 'SPROXIL', even though it claims that the mark was coined by it.

On the other hand, the Complainant has established the following:

- i. That it incorporated a company 'Sproxil Brand Protection Solutions Private Limited' in India in the year 2011;
- ii. That its corporate name is Sproxil Inc.
- iii. That it is the owner of www.sproxil.com and several other domain names such www.sproxil.org, www.sproxil.net, etc. – all of which were registered between 2008 – 2009.
- iv. That it has trademark registrations for the mark 'SPROXIL' in India and elsewhere, where majority of the trademark applications have been granted registration in 2012.

It is also pertinent to mention here that there is nothing on record which shows that the Respondent has tried to protect its interests and rights in the 'SPROXIL' mark, even though it claims that it has a legitimate right in the said mark. The Panel wonders why then, there is





nothing on record to indicate that the Respondent has ever tried to secure or protect this mark in any manner whatsoever.

The Complainant has never assigned, granted or in any way authorised the Respondent to register or use the 'SPROXIL' trademark or any other related mark. The Complainant has been using the mark 'SPROXIL' for a bonafide purpose in relation to its business and corporate name.

Moreover, the burden of proof on the Complainant regarding this element of the domain name dispute lies most directly within the Respondent's knowledge. Once the Complainant has made a prima facie case showing that the Respondent does not have any rights or legitimate interest in the domain name, the evidentiary burden shifts to the Respondent to rebut the contention by providing evidence of its rights or interests in the domain name. The Respondent has not produced any documents or submissions which could adequately establish its rights or legitimate interests in the domain name or the mark.

For these reasons, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

[Relevant Decisions: *Aon PLC and Ors. v. Guanrui*, INDRP/633; *Wells Fargo & Co. and Anr. v. SreeDas Kumar*, INDRP/666; *QRG Enterprises Limited & Anr. v. Zhang Mi*, INDRP/852; *Havells India Limited and Anr. v. Whois Foundation*, WIPO Case No. D2016-1775]

*The disputed domain name has been registered or is being used in bad faith.*

It has been contended by the Complainant that the Respondent has registered the disputed domain name in bad faith. The language of the INDRP paragraph 4[iii] is clear enough, and requires that either bad faith registration or bad faith use be proved. However, the Complainant has specifically contended that the domain name was registered in bad faith.

Paragraph 6 of the INDRP provides that the following circumstances are deemed to be evidence that a Respondent has registered and/or used a domain name in bad faith:

*"Circumstances indicating that the Respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or*

*the Respondent 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 Respondent has engaged in a pattern of such conduct; or*





*by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its Website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of its Website or location or of a product or service on its Website or location."*

The Complainant's submissions in support of this ground are brief and simple. It states that the Respondent is its competitor and hence the conditions of paragraph 6[i] of the Policy are met. The Respondent on the other hand, clearly denies this and states that it cannot be considered a competitor of the Complainant. The Respondent further states that at the time it registered the domain name the Complainant did not provide brand protection services. However, no further information or documents have been furnished to prove this statement. The Panel is therefore inclined not to consider this submission by the Respondent, as from the records put forth before the Panel, it is clear that the Complainant incorporated a company in India in 2011, which has both 'SPROXIL' and the term 'Brand Protection Solutions' in its name.

In addition to this, the Respondent has provided certain statistics of the Complainant's business model – including the fact that the Complainant serves almost all its customers offline, which in the Panel's opinion are not valid enough points to prove that the Respondent is not a competitor of the Complainant.

Moreover, as stated above, pursuant to Paragraph 8[a] and 12[a] of the Rules, the Panel considers itself competent to conduct limited but independent research of its own if it deems fit. In light of this, the Panel visited the Complainant's website [www.sproxil.com](http://www.sproxil.com) and the Respondent company's website [www.mpedigree.com](http://www.mpedigree.com).

The Complainant's website [[www.sproxil.com](http://www.sproxil.com)] has the following description placed prominently on its home page:

*"Sproxil builds trust across supply chains with mobile technology solutions that emphasize direct engagement from the factory through to the consumer. Our technology solutions allow brand owners to engage with trade partners, influencers and consumers to earn and grow brand loyalty while protecting the brand from supply chain fraud, including counterfeiting and theft."*

Whereas, the Respondent's company website [[www.mpedigree.com](http://www.mpedigree.com)] has the following prominently placed on the 'Who We Are' section of the website:

*"mPedigree is the global leader in the use of mobile and web technologies in securing products against faking, counterfeiting and diversion."*

Upon comparing these two descriptions, the Panel is satisfied that similarities exist between the services offered by both the companies, and that for the purposes of this Policy, the Respondent's company can be considered a competitor to the Complainant.





The Panel is also inclined to accept the Complainant's contention that the Respondent has intentionally attempted to attract users to the domain name by creating a likelihood of confusion. The Respondent's defence that the Complainant's customers will not get confused by the mere use of the mark 'SPROXIL' in the name of the domain name is not tenable. The Panel regularly witnesses such instances, where the mere difference of a domain name extension, just as in this case, confuses hundreds of internet users.

Other contentions made by the Respondent in its defence, including the fact that the domain name does not feature in the top thousand results in a search for the term 'SPROXIL' are irrelevant, as there could be instances where the user simply types the Complainant's brand name or corporate name followed by the '.in' extension in order to reach the Complainant's India business.

The Panel, therefore, is satisfied that the Respondent has intentionally attempted to attract Internet users to its domain name by creating a likelihood of confusion with the Complainant's mark.

Moreover, based on the submissions and evidences put forth before the Panel by both the Parties, the Panel is of the belief that the Respondent would have definitely known about the Complainant's mark 'SPROXIL' and the trademark and domain name registrations that the Complainant had acquired at the time of registering the disputed domain name. Such 'actual knowledge' on part of the Respondent constitutes evidence that the domain name was registered in bad faith. Further, as noted above, while the Respondent throughout the response claims to be the rights owner of the 'SPROXIL' mark, it has failed to furnish any evidence in its support.

In light of the foregoing, the Panel concludes that the domain name was registered by the Respondent in bad faith.

#### **Decision**

All three conditions given in paragraph 6 of the Policy are proved in the circumstances of this case. While the Panel notes that this present matter is an exceptional one owing to the past history of the parties, the Panel has only ruled on the specific aspect of the domain name – and that too within the limited confines of the Policy.

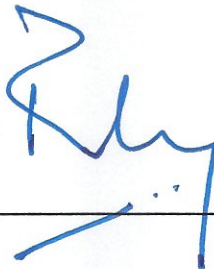
For the purposes of this Policy, and based on the evidences put forth before it, the Panel is satisfied that the Complainant has rights in the domain name and that the Respondent has no rights or legitimate interests which it could prove in the domain name. The domain name was registered in bad faith by the Respondent since it clearly knew about the Complainant's mark 'SPROXIL' at the time of registering the domain name.





[Relevant Decisions: *Lego Juris AS v. Robert Martin* INDRP/125; *Societe Air France v. DNS Admin* INDRP/075; *Kelemata SPA v. Mr Bassarab Dungaciu* WIPO D2003-0849; *Croatia Airlines d.d. v. Modern Empire Internet Ltd.* WIPO D2003-0455; *Uniroyal Engineered Products, Inc. v. Nauga Network Services* WIPO D2000-0503; *Microsoft Corporation v. Chun Man Kam* INDRP/119; *AB Electrolux v. Liheng*, INDRP/700; *Equitas Holding Limited v. Sivadas K P*, INDRP/724; *BearingPoint IP Holdings B.V. v. Deborah R. Heacock*, INDRP/822; *Dell Inc. v. Jack Sun*, INDRP/312; *HID Global Corporation v. Zhaxia*, INDRP/652; *McDonald's Corporation v. Ravinder*, INDRP/746; *MontBlanc-Simplo G.M.B.H. v. M S Mohamed Salihu*, INDRP/678; *Orica Australia Proprietary Limited v. Bev Gran, D N Solutions*, INDRP/237; *Sopra Steria Group v. Xu Xiantao*, INDRP/796; *Panasonic Corporation v. Sun Wei*, INDRP/527; *Wal-Mart Stores, Inc. v. Machang*, INDRP/539; *PJS International S.A. v. Xiangwang*, INDRP/616; *Aon PLC and Ors. v. Gangadhar Mahesh*, INDRP/632; *Aon PLC and Ors. v. Guanrui*, INDRP/633; *Wells Fargo & Co. and Anr. v. Krishna Reddy*, INDRP/581; *Wells Fargo & Co. and Anr. v. SreeDas Kumar*, INDRP/666; *Wells Fargo & Co. and Anr. v. DeepDas Kumar*, INDRP/628; *Natures Basket Limited & Ors. v. Dipti Singla*, INDRP/683; *General Motors India Pvt. Ltd. & Anr. v. Anish Sharma*, INDRP/799; *QRG Enterprises Limited & Anr. v. Zhang Mi*, INDRP/852; *Santa Fe Transport International Limited and Santa Fe Moving Services Private Limited v. Santa fe Packers, Packers Movers* WIPO Case No. D2017-0754; *Santa Fe Transport International Limited and Santa Fe Moving Services Private Limited v. Achyut Khare*, INDRP/886]

In light of the foregoing, and in accordance with the Policy and Rules, the Panel directs that the disputed domain name [www.sproxil.in] be transferred from the Respondent to the Complainant; with a request to NIXI to monitor the transfer.



**Rodney D. Ryder**  
Sole Arbitrator

**Date: September 9, 2019**