

INDRP ARBITRATION CASE No.1828
THE NATIONAL INTERNET EXCHANGE OF INDIA (NIXI)

ADMINISTRATIVE PANEL DECISION
SOLE ARBITRATOR: AJAY GUPTA

Mattel Inc.

Vs.

Huxxe India

DISPUTED DOMAIN NAME: "**barbiegirl.in**"



INDRP ARBITRATION CASE NO.1828
THE NATIONAL INTERNET EXCHANGE OF INDIA (NIXI)

ADMINISTRATIVE PANEL DECISION
SOLE ARBITRATOR: AJAY GUPTA

MATTEL, INC.,
333, Continental Boulevard,
El Segundo,
California 90245-5012,
[United States of America].

... Complainant

VERSUS

HUXXE INDIA
45, East of Kailash, New Delhi,
Delhi-110067 [INDIA].

... Respondent

Disputed Domain Name: "**barbiegirl.in**"



1. **THE PARTIES**

1.1 The Complainant Mattel Inc., in this arbitration proceeding is a leading global toy company engaged in children's and family entertainment business and its contact address is 333, Continental Boulevard, El Segundo, California 90245 – 5012 [United States of America].

1.2 The Complainant's Authorized Representative in this administrative proceeding are:

| |
|------------------------------|
| Saurabh Nandrekar |
| F-12, Sector 8, Noida-201301 |
| 91-120-4847550 |
| 91-120-4847551 |
| saurabh@fiduslawchambers.com |

and

| |
|------------------------------|
| Nikhil Sikka |
| F-12, Sector 8, Noida-201301 |
| 91-120-4847550 |
| 91-120-4847551 |
| nikhil@fiduslawchambers.com |

1.3 In this arbitration proceeding, the Respondent is Huxxe India 45, East of Kailash, New Delhi, India as per the details given by the WHOIS database maintained by the National Internet Exchange of India (NIXI).

2. **THE DOMAIN NAME AND REGISTRAR**

2.1 The disputed domain name is "**barbiegirl.in**" and the Registrar with which the disputed domain name is registered is Hostinger, UAB.

3. **PROCEDURAL HISTORY [ARBITRATION PROCEEDINGS]**

3.1 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 28th 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 under the .IN Dispute Resolution Policy and Rules framed thereunder.

3.2 The history of this proceeding is as follows :

3.2.1 By Rules 2(a) and 4(a), NIXI on 07.03.2024 formally notified the Respondent of the complaint along with a copy of the complaint & annexures/documents, and appointed me as the Sole Arbitrator for adjudicating upon the dispute in accordance with the Arbitration and Conciliation Act, 1996, and the Rules framed thereunder, IN Domain Resolution Policy and the Rules framed thereunder. I submitted the Statement of Acceptance & Declaration of Impartiality and Independence dated 07.03.2024 to NIXI.

3.2.2 That commencing the arbitration proceedings an Arbitration Notice Dated 07.03.2024 was emailed to the Respondent on 07.03.2024 by this panel under Rule 5(c) of INDRP Rules of Procedure with direction to file a reply of the complaint, if any, within 10 days.

3.2.3 This panel vide email dated 07.03.2024 directed the Complainant to serve the copy of the complaint to the Respondent and submit the proof of the same before this panel. The Complainant via email dated 12.03.2024 submitted before this panel, the proof about the service of the copy of the complaint to the respondent through email as well as courier.



3.2.4 This panel vide its Arbitration Notice dated 07.03.2024 had directed the Respondent to file the reply of complaint, if any, within 10 days of the notice. That since the respondent failed to file the reply of the complaint within 10 days i.e. by 16.03.2024 as directed in the arbitration notice dated 07.03.2024, this panel via its email dated 18.03.2024 again in the interest of justice gave one more opportunity to the respondent to file the reply of the complaint if any, within 5 days i.e. by 22.03.24.

3.2.5 The Respondent, despite the receipt of Notice Dated 07.03.2024 and reminder dated 18.03.2024 neither replied to the Arbitration notice nor to the complaint; hence, on 23.03.2024 the Respondent was proceeded ex-parte.

4. **THE RESPONDENT'S DEFAULT**

- 4.1 The Respondent failed to reply to the notice regarding the complaint. It is a well-established principle that once a Complainant makes a prima-facie case showing that a Respondent lacks rights to the domain name at issue; the Respondent must come forward with proof that it has some legitimate interest in the domain name to rebut this presumption. The disputed domain name in question is **"barbiegirl.in"**.
- 4.2 The INDRP Rules of Procedure require under Rule 8(b) that the arbitrator must ensure that each party is given a fair opportunity to present its case. Rule 8(b) reads as follows :

"In all cases, the Arbitrator shall ensure that the parties are treated with equality and that each



party is given a fair opportunity to present its case."

- 4.3 The Respondent was notified of this administrative proceeding per the Rules. The .IN Registry discharged its responsibility under Rules paragraph 2(a) to employ reasonably available means calculated to achieve actual notice to the Respondent of the complaint.
- 4.4 The panel finds that the Respondent has been given a fair opportunity to present his case. The Respondent was given direction to file a reply to the complaint if any, but the Respondent neither gave any reply to notice nor to the complaint despite repeated opportunities. The 'Rules' paragraph 12 states, "In the event, any party breaches the provisions of INDRP rules and/or directions of the Arbitrator, the matter can be decided ex parte by the Arbitrator and such arbitral award shall be binding in accordance to the law." In these circumstances, the panel's decision is based upon the Complainant's assertions, evidence, inferences, and merits only as the Respondent has not replied despite repeated opportunities given in this regard and was proceeded ex parte.
5. **BACKGROUND OF THE COMPLAINANT & ITS SUBMISSIONS ABOUT THE TRADEMARK "BARBIE", ITS STATUTORY AND COMMON LAW RIGHTS ADOPTION :**
- 5.1 The Complainant, in the present arbitration proceedings to support their case, has relied and placed on records documents as Annexures and made the following submissions :
- 5.1.1 The Complainant submits that it is a leading global toy company and owner of one of the strongest

portfolios of children's and family entertainment franchises in the world which includes BARBIE, FISHER-PRICE, HOT WHEELS, AMERICAN GIRL, THOMAS & FRIENDS, UNO and MEGA BLOKS. The Complainant submits, that it employs over 33,000 people in 35 countries and territories and sells products in more than 150 nations.

ABOUT COMPLAINANT'S TRADEMARK BARBIE

- 5.1.2 The Complainant submits that it adopted the trademark **BARBIE** in 1959 after one of the co-founders of the Complainant, Ruth Handler, observed her daughter Barbara playing with paper dolls and went on to create a 3-D doll for girls to play out their dreams. It is further submitted that then in 1959, the first doll under the trademark **BARBIE** named after Ruth's daughter made its debut at the New York Toy Fair , and since then, the brand and character **BARBIE** has grown to become a global icon, inspiring girls everywhere to be anything.
- 5.1.3 The Complainant submits that the brand and character **BARBIE** is one of the most iconic figures in popular culture across the world. The influence of the dolls under the trademark **BARBIE** on young girls can be seen by the fact that the doll has had over 180 careers over the years which includes Presidential Candidate, Astronaut, Goodwill Ambassador for UNICEF, Tennis Player, Baseball Player, Computer Engineer, Doctor, Architect, Entrepreneur and film director etc.
- 5.1.4 The Complainant submits that the trademark **BARBIE** has been licensed across a wide variety of categories,

and the **BARBIE** has thus grown to become an all-encompassing lifestyle brand. It is submitted that there is an official website of the Complainant, <https://creations.mattel.com/pages/barbie-signature>, which caters exclusively to Complainant's collector fans, including **BARBIE** aficionados and collectors.

5.1.5 The Complainant submits that it has several mobile applications under the trademark **BARBIE** which feature games involving the life of the **BARBIE** character. The mobile application "**BARBIE** Fashion Closet" has been downloaded over 50 million times on the Google Play Store.

5.1.6 The Complainant submits that its website <https://shop.mattel.com/pages/barbie> offers products under the trademark **BARBIE** for sale and <https://corporate.mattel.com/brand-portfolio/barbie> provides information about the **BARBIE** brand and its history, and <https://community.creations.mattel.com/news/barbie/public-news-stories> and its upcoming launches etc. The said websites are accessible to people across the world, including in India.

5.1.7 The Complainant submits that complainant's brand **BARBIE** has a strong presence on social media having 14 million likes on the Facebook page of **BARBIE** and the Instagram account of **BARBIE** has 3.5 million followers. It is further submitted that **BARBIE**'s vlog (video blog) on YouTube has over 11.8 million followers. The immense popularity of the trademark **BARBIE** on social media further indicates its global fame and reputation.



- 5.1.8 The Complainant submits that the products under the trademark **BARBIE** have been advertised through television commercials, newspapers, and magazines adding to the reputation and goodwill of the Complainant's trademark **BARBIE**.
- 5.1.9 It is submitted that the Complainant introduced the doll under the trademark **BARBIE** in India at least as early as 1987 and has been continuously, extensively, and uninterruptedly been using the trademark **BARBIE** in India since then for a wide range of goods and services. The Complainant submits that it has an extensive distribution network for its products and services under the trademark **BARBIE** in India and also manufactures in India. It is further submitted that's in the 1990s, the Complainant introduced dolls under the trademark **BARBIE** in an Indian avatar, specifically aimed at the Indian market.
- 5.1.10 It is submitted that the Complainant's products under the **BARBIE** trademark are also available on popular Indian e-commerce marketplaces such as on www.amazon.in ("*Amazon*") and the Complainant has a dedicated store on Amazon.
- 5.1.11 The Complainant submits that it has released the first live-action movie starring Margot Robbie and Ryan Gosling on 21st July 2023 titled **BARBIE**. There has recently been immense international interest and excitement surrounding Complainant's Barbie movie and **BARBIE** brand, including significant consumer association and marketing chatter around Complainant's

coined phrase '**BARBIECORE**', which has become a global viral fashion trend that has the iconic **BARBIE** trade dress and brand visuals at its center.

6. **COMPLAINANT'S SUBMISSIONS ABOUT ITS TRADE MARKS**

6.1 The Complainant submits that it has over 1800 registrations for the trademark **BARBIE** in over 100 countries and has submitted an indicative list of the Complainant's registrations for its trademark **BARBIE**. The Complainant has registered the trademark **BARBIE** in India under The Trade Marks Act, 1999 ("*Act*") in several classes and has also submitted the details of some such registrations.

6.2 The Complainant has also submitted the following list of the domain names which are relevant to Complainant trademark **BARBIE** and owned by complainant :

| Domain name | Registration Date |
|-----------------------|--------------------------------|
| <barbie.com> | 19 th June 1996 |
| <barbie.in> | 2 nd May 2007 |
| <barbiemedia.com> | 20 th October 2008 |
| <barbiedoll.com> | 6 th January 1998 |
| <barbiecollector.com> | 17 th December 1996 |

6.3 The Complainant submits that based on its trademark rights in **BARBIE**, the Complainant has been successful in several domain name disputes under the Uniform Domain Name Dispute Resolution Policy ("*UDRP*") and has submitted the detailed list of the same.

6.4 The Complainant submits that based on its trademark rights in **BARBIE**, the Complainant has been successful in taking action under INDRP and has obtained a favourable order, the details of which are as below :

| Particulars | Case Number | Domain name | Decision Date |
|------------------------------|-------------|---------------|--------------------------------|
| Mattel, Inc. vs. Raja Khan | 1572 | Barbiedoll.in | 15 th July 2022 |
| Mattel, Inc. vs. Ria Sardana | 1780 | Barbieta.in | 26 th December 2023 |

7. **COMPLAINANT'S SUBMISSIONS ABOUT RESPONDENT**

7.1 The Complainant submits that, it recently came across the Respondent's domain name <barbiegirl.in> ("*disputed domain name*") which was registered on 13th August 2023. The disputed domain name subsumes and is confusingly similar to the Complainant's trademark **BARBIE**. This amounts to infringement of the Complainant's rights in the trademark **BARBIE**. It is further submitted that at the time of filing the instant Complaint, the disputed domain name is valid till 13th August 2024.

7.2 The Complainant submits that at the time of filing the instant Complaint, the disputed domain has merely been parked and no commercial use of the domain is being made. It is submitted that the Respondent registered the present domain name with a view to earn profit by selling the domain or defrauding the people using Complainant's trademark **BARBIE** and has incorporated it in the disputed domain name.

8. **THE ISSUES INVOLVED IN THE DISPUTE**

8.1 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:-

The disputed domain name is identical or confusing similar to a trademark in which the Complainant has statutory/common law rights.

The Respondent has no rights or legitimate interests in respect of the disputed domain name.

The disputed domain name has been registered or is/ are being used in bad faith."

- 8.2 The above-mentioned 3 essential elements of a domain name dispute are being discussed hereunder in light of the facts and circumstances of this complaint.

9. **PARTIES' CONTENTIONS**

- 9.1 **The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;**

COMPLAINANT

- 9.2 The Complainant submits that the disputed domain name <barbiegirl.in> subsumes the Complainant's trademark BARBIE in its entirety and hence is confusingly similar to the Complainant's trademarks.
- 9.3 The Complainant submits that it has statutory and common law rights in the trademark BARBIE and such rights predate the registration of the disputed domain name by decades.



- 9.4 The Complainant submits the past INDRP decisions have held that the fact that a domain name wholly incorporates a Complainant's registered trademark is sufficient to establish identity or confusing similarity for the purpose of INDRP and has relied on the decisions in the cases of ITC Limited Vs Travel India (INDRP Case No. 065), Allied DOMEQ Spirits and Wine Limited v. Roberto Ferrari (INDRP Case No. 071), International Business Machines Corporation v. Zhu Xumei (INDRP Case No. 646) and Jaguar Land Rover v. Yitao (INDRP Case No. 641).
- 9.5 The Complainant also relies on past INDRP decisions in Nike Inc. Vs Nike Innovative CV Zhaxia (Case No. INDRP/804); Metropolitan Trading Company Vs. Chandan (Case No. INDRP/811); Lego Juris A/s Vs. Robert Martin (Case No. INDRP/125), where it was held that if a disputed domain name completely incorporates the trademark/service mark of the Complainant, then the mere addition of TLDs, gTLDs, ccTLDs such as ".in" and/or ".co.in" will not distinguish the Respondent's disputed domain name.
- 9.6 The Complainant submits that 'girl' is a generic term, which is commonly associated with the Complainant's trademark BARBIE and does not serve to distinguish the disputed domain name from the trademark BARBIE. Rather, the addition of such a term implies an association with the Complainant as they first adopted and used the trademark BARBIE for dolls.
- 9.7 The Complainant has also relied on the UDRP decision in Khadi & Village Industries Commission v. Ravish Kapila, WIPO Case No. D2022-3816, where the panel held that the



domain name is confusingly similar to the Complainant's trademark KHADI, and the addition of the term "mart" is not in contrast to find confusing similarity.

- 9.8 The Complainant submits that in the present case, the disputed domain name is confusingly similar to the Complainant's trademark BARBIE and the Complaint has successfully satisfied the first requirement set out in clause 4(a) of the INDRP.

RESPONDENT

- 9.9 The Respondent has not replied to Complainant's contentions.

PANEL OBSERVATIONS

- 9.10 This Panel on pursuing the documents and records submitted by Complainant, observes that the complainant is a leading global toy company and owner of one of the strongest portfolios of children's and family entertainment franchises in the world, which includes BARBIE, FISHER-PRICE, HOT WHEELS, AMERICAN GIRL, THOMAS & FRIENDS, UNO and MEGA BLOKS etc.
- 9.11 This panel observes that the Complainant has common law as well as statutory rights in its trade/service mark "**BARBIE**". It is also observed by this panel, that the Complainant has successfully secured registrations globally for the BARBIE mark including in India. The Complainant has proved that it has trademark rights and other rights in the mark "**BARBIE**" by submitting substantial documents in support of it.
- 9.12 It is further observed by this panel that the trademark "**BARBIE**" in the Disputed Domain Name "**barbiegirl.in**"



comprises the Complainant's trademark in its entirety and has the potential to cause consumer confusion and will cause the user to mistakenly believe that it originates from, is associated with or is sponsored by the Complainant. It is further observed by this panel that the word "**girl**" in the disputed name and suffix "**in**" is not sufficient to escape the finding that the domain is confusingly similar to Complainant's trademark. The Complainant has rightly submitted that the '**girl**' is a generic term, which is commonly associated with the Complainant's trademark **BARBIE** and does not serve to distinguish the disputed domain name from the trademark **BARBIE**.

9.13 This panel, therefore, is of the opinion that the disputed domain name "**barbiegirl.in**" being identical/confusingly similar to the trademark of Complainant will mislead the public and will cause an unfair advantage to the Respondent. The Panel is of the view that there is a likelihood of confusion between the disputed domain name and the Complainant, its trademark, and the domain names associated. The disputed domain name registered by the Respondent is confusingly similar to the trademark "**BARBIE**" of the Complainant.

9.14 It is the responsibility of the Respondent to find out before registration that the domain name he is going to register does not violate the rights of any proprietor/brand owner and the Respondent has miserably failed in following this condition.

9.15 This Panel, therefore, in light of the contentions raised by the Complainant concludes that the disputed domain name "**barbiegirl.in**" is confusingly similar to the

Complainant marks. Accordingly, the Panel concludes that the Complainant has satisfied the first element required by Paragraph 4(a) of the INDR Policy.

10. **THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN RESPECT OF THE DISPUTED DOMAIN NAME**

COMPLAINANT

10.1 The Complainant submits that, Under clause 6 of the IN Domain Dispute Resolution Policy (INDRP), any of the following circumstances, if found by the Arbitrator, may demonstrate a Respondent's rights or legitimate interests in a disputed domain name :

- Before any notice to it of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services; or
- The Respondent has been commonly known by the disputed domain name, even if it has acquired no trademark or service mark rights; or
- The Respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

10.2 The Complainant submits that none of the above circumstances are present in the present dispute. The disputed domain name has not been used in connection with bona fide offering of goods or services by the Respondent. It is submitted that the disputed domain name



is merely parked by the Respondent, and it appears that they are preparing to start an online store using Shopify. And the use of the term BARBIE in their domain name would be to attract consumers by portraying itself as an affiliate of the Complainant and making commercial gains by selling goods bearing the Complainant's trademarks and other intellectual property, including Complainant's BARBIE trademark.

- 10.3 The Complainant submits that the Respondent's use of the disputed domain name is mala fide and subsumes the Complainant's intellectual property, including Complainant's trademark BARBIE. It is further submitted that the Respondent's use of Complainant's trademark BARBIE and/or other intellectual property is unauthorized. It is therefore submitted that the Respondent has no legitimate interest in the disputed domain name, rather the sole purpose of its registration is to misleadingly divert consumers and to tarnish the trademark of the Complainant and misappropriate the reputation associated with the Complainant, including Complainant's famous trademark BARBIE.
- 10.4 The Complainant submits that, it has not authorized, licensed, or permitted the Respondent to register or use the disputed domain name or to use the trademark BARBIE or any of Complainant's other intellectual property. The Complainant clearly has prior rights in the trademark BARBIE, which precedes the registration of the disputed domain name.
- 10.5 The Complainant submits that it has therefore established a prima facie case that the Respondent has no rights and legitimate interests in the disputed domain name and

thereby the burden of proof shifts to the Respondent to produce evidence demonstrating rights or legitimate interests in respect of the Domain Name. The Complainant in this regard relies on the decisions in Eurocopter, an EADS Company v. Bruno Kerrien (Case No. INDRP Case No. 116), Voltas Ltd. v. Sergi Avaliani (INDRP Case No, 1257), Hitachi Ltd v. Kuldeep Kumar (INDRP Case No. 1092), Do The Hustle, LLC v. Tropic Web, (WIPO Case No. D2000-0624); and Payoneer, Inc./Payoneer Europe Limited v. Korchia Thibault, Quinv S.A. (WIPO Case No. DEU2019-0013).

- 10.6 The Complainant has also put reliance on Bruyere S.A. v. Online Systems, WIPO Case No. D2016-1686, where UDRP Panel found "Given that there is no active website associated with the Disputed Domain Name, the Panel does not find that the Respondent is making any use of the Disputed Domain Name within the meaning of paragraph 4(c) of the Policy. Rather, given that the Disputed Domain Name is identical to the Complainant's Trademark, it gives the impression that the Respondent is the Complainant or is otherwise affiliated with the Complainant".
- 10.7 The Complainant submits that it is therefore evident that the Respondent's use of the disputed domain name is neither a bona fide offering of services, nor a legitimate non-commercial or fair use pursuant to Policy , and the Complainant has successfully satisfied the second requirement set out in clause 4(b) of the INDRP.

RESPONDENT

- 10.7 The Respondent has not replied to Complainant's contentions.



PANEL OBSERVATIONS

- 10.8 This Panel holds that the second element that the Complainant needs to prove and as is required by paragraph 4(b) of the INDRP is that the Respondent has no legitimate right or interests in the disputed domain name.
- 10.9 This panel observes that the Complainant by placing documents/records and evidence along with the complaint has been able to prove that, the Complainant is doing its children's and family entertainment business under the mark '**BARBIE**' in many countries including India. The Complainant by its priority in adoption, goodwill, and long, continuous and extensive use of the mark, the Complainant has acquired the exclusive right to the use of the '**BARBIE**' mark in respect of its business.
- 10.10 It is observed by this panel that the Respondent has failed to rebut the allegations of the Complainant that the Respondent has no legitimate interest in the disputed domain name, and the sole purpose of its registration is to misleadingly divert consumers and to tarnish the trademark of the Complainant and misappropriate the reputation associated with the Complainant, including Complainant's famous trademark BARBIE.
- 10.11 It is also observed by this panel that the Respondent has failed to rebut the allegations of the Complainant, that the Complainant has not authorized, licensed, or permitted the Respondent to register or use the disputed domain name or to use the trademark BARBIE or any of Complainant's other intellectual property, and the Complainant clearly has prior



rights in the trademark BARBIE, which precedes the registration of the disputed domain name.

10.12 Once the Complainant makes a prima facie case showing that the Respondent does not have any rights or legitimate interest in the domain name, the burden to give evidence shifts to the Respondent to rebut the contention by providing evidence of its rights or interests in the domain name. The Respondent has failed to place any evidence to rebut the allegations of the Complainant.

10.13 It is further observed by this panel that para 6 of the IN Domain Name Dispute Resolution Policy (INDRP) states :

"Any of the following circumstances, in particular, but without limitation, if found by the Arbitrator to be proved based on its evaluation of all evidence presented, shall demonstrate the Registrant's rights to or legitimate interests in the domain name for Clause 4 (b) :

(a) before any notice to the Registrant of the dispute, the Registrant's use of, or demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; (b) the Registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or (c) the Registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

10.14 This panel observe that the Respondent also failed to full fill any of the requirements as mentioned in para 6 of



INDRP Policy which demonstrates the Registrant's rights to or legitimate interests in the domain name for Clause 4 (b): For these reasons, the Panel holds that the Complainant has proved that the Respondent does not have any rights or legitimate interests in the disputed domain name "**barbiegirl.in**".

11. THE DOMAIN NAME WAS REGISTERED OR IS BEING USED IN BAD FAITH.

COMPLAINANT

- 11.1 The Complainant submits that the disputed domain name completely incorporates the Complainant's trademark BARBIE. It is further submitted that the Complainant's trademark BARBIE is a well-reputed and widely recognized trademark, and Complainant's trademark BARBIE has immense goodwill and reputation and is well prior to the registration of the disputed domain name. It is submitted that the Complainant's trademark BARBIE has been used continuously and extensively globally since as early as 1959. Hence, Respondent is bound to have knowledge of the Complainant's trademark BARBIE. It is submitted that the Respondent registered the disputed domain name in full knowledge of the Complainant's trademark rights and, on balance, with the intention of taking advantage of such rights. Even constructive knowledge of a famous trademark like BARBIE is sufficient to establish registration in bad faith.
- 11.2 The Complainant relies on *Fannie May Confections, Inc. v. Domain Contact 2 (FANNIEMAYS-COM-DOM)*, WIPO Case No. D2006-0813 and *Carla Sozzani Editore S.R.L. v. Michael D. Darr* WIPO Case No. D2017-1237 where a similar registration



of a domain name by Respondent several years after the adoption of the Complainant's mark was held to be with the motive to profit from the goodwill that Complainant had built in its mark and was subsequently transferred to the Complainant.

- 11.3 The Complainant submits that the Respondent's bad faith is further evidenced from the fact that the Respondent registered the impugned domain name on 13th August 2023, years after the registration of the Complainant's trademark registrations in India and soon after the launch of movie titled BARBIE starring Margot Robbie and Ryan Gosling.
- 11.4 The Complainant submits that there is a great likelihood that actual or potential visitors to the present website of the Respondent will be induced to :
- (a) believe that the Complainant has licensed its trademark BARBIE to the Respondent or authorized the Respondent to register the disputed domain name; and
 - (b) believe that the Respondent has some connection with the Complainants in terms of a direct nexus or affiliation with the Complainants.
- 11.5 The Complainant relies on past decisions in *Bharti Airtel Limited vs. Rajeev Garg*, (INDRP Case No. 285), *Merck KGaA v. Zeng Wei* (INDRP Case No. 323), *General Motors India Pvt. Ltd. & Anr. v. Anish Sharma* (INDRP Case No. 799), and *Sensient Technologies Corporation v. Katrina Kaif, Corporate Domain* (INDRP Case No. 207), where respondent's bad faith was found from intentionally attempting to attract for gain Internet users to the



respondent's website or other online location by creating a likelihood of confusion with complainant's mark. The Complainant submits that the Respondent is also guilty of trademark infringement and passing off the Complainant's trademark BARBIE.

11.6 The Complainant submits that the Respondent's address reflects the state as Delhi in India. Complainant's trademark BARBIE enjoys tremendous goodwill and reputation in India. Hence, the Respondent is bound to be aware of Complainant's trademarks. It is submitted that the Respondent had constructive knowledge of the Complainant's rights in the trademark BARBIE, as the same is widely used and has become well known due to its extensive use.

11.7 The Complainant submits that the clause 3(d) of the INDRP does not require a registrant to knowingly use the domain name in violation or abuse of any applicable laws or regulations. It is submitted that the obligations imposed by clause 3(d) are an integral part of the INDRP applicable to all registrants and cannot be ignored as was observed by the Ld. Arbitrator in Momondo A/S v. Ijorghe Ghenrimopuzulu, (INDRP Case No. 882). It is further submitted that a search in the online database of Indian Trademarks Office or WIPO would reveal Complainant's rights in its trademark BARBIE. Hence, the Respondent had an onus to ensure that the registration of the disputed domain name did not violate the Complainant's trademark rights in BARBIE. It is therefore submitted by the Complainant that the disputed domain name has been registered and is being used in bad faith.

RESPONDENT

11.8 The Respondent has not replied to Complainant's contentions.

PANEL OBSERVATION

11.9 Paragraph 7 of the INDRP provides that the following circumstances are deemed to be evidence that Respondent has registered and used a domain name in bad faith :

- "(a) Circumstances indicating that the Respondent has registered or has acquired the domain name primarily for selling, renting, or otherwise transferring the domain name registration to the Complainant who bears the name or is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration over the Registrar's documented out of pocket costs directly related to the domain name; or*
- (b) the Respondent has registered the domain name 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*
- (c) by using the domain name, the Respondent has intentionally attempted to attract internet users to its website or other online 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 a product or services on its website or location."*

11.10 This panel while going through the complaint and documents which are placed in the form of annexes has

observed that the Respondent registered the disputed domain name in August 2023, whereas the complainant has been using the mark BARBIE mark for decades. It is observed by this panel that the Complainant has statutory and common law rights in the mark BARBIE worldwide including in India and Complainant is also using the BARBIE mark on the internet, in other domain names, and as a trading name before registration of disputed domain name. It is observed by this panel that given the above-mentioned facts and circumstances, it is impossible to conceive that the Respondent could have registered the disputed domain name in good faith or without knowledge of the Complainant's rights in the mark BARBIE.

11.11 It is further observed by this panel that the Respondent has failed to rebut the allegation of the Complainant that the Respondent is bound to have knowledge of the Complainant's trademark **BARBIE**, and that the Respondent registered the disputed domain name in full knowledge of the Complainant's trademark rights and, on balance, with the intention of taking advantage of such rights.

11.12 It is further observed by this panel that the Respondent has failed to rebut the allegation of the Complainant that the Complainant's trademark BARBIE enjoy tremendous goodwill and reputation in India, hence the Respondent is bound to be aware of Complainant's trademarks, and that the Respondent had constructive knowledge of the Complainant's rights in the trademark BARBIE, as the same is widely used and has become well known due to its extensive use.

11.13 The Complainant has rightly established that the Respondent has registered the disputed domain name in bad faith, and



there is evidence that points to the existence of circumstances as mentioned in clause 7 (c) of the INDRP Policy. The Respondent's domain name registration meets the bad faith elements outlined in para 4 (c) of the INDRP Policy. Therefore the Panel concludes that the registration by Respondent is in bad faith. Consequently, it is established that the disputed domain name was registered in bad faith or used in bad faith and the Respondent has wrongfully acquired/registered the domain name in its favor in bad faith.

12. **REMEDIES REQUESTED**

12.1 The Complainant has prayed to this Administrative Panel for the transfer of domain name **<barbiegirl.in>** to the complainant and award of cost to the complainant.

13. **DECISION**

13.1 The following circumstances are material to the issue in the present case :

13.1.1 Through its contentions based on documents/ records and evidence, the Complainant has been able to establish that the mark "BARBIE" is a well-established name globally including India in children's and family entertainment business. The Complainant has established that the BARBIE is inherently distinctive of the products and business of the Complainant and has secured trademark protection for BARBIE by registering trademarks in many countries including India.

13.1.2 The Respondent, despite repeated opportunities given, has failed to provide any evidence that it has

any rights or legitimate interests in respect of the domain name, and the Respondent is related in any way to the Complainant. The Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the Disputed Domain Name.

13.1.3 The Complainant has rather has been able to establish by its contentions and records in the form of annexures, that the Respondent has registered the Disputed Domain Name "barbiegirl.in" in an attempt to attract Internet users for monetary gains which is evidence of bad faith. It is therefore established by the Complainant that the domain name by itself is being used for attracting internet users rather than any bona fide offering of goods thereunder. While considering the complaint and records in the form of annexures submitted by the Complainant, this panel has concluded that there exist circumstances as stated in para 7(C) of INDRP Policy.

13.1.4 Taking into account the nature of the disputed domain name "**BARBIEGIRL.IN**" and in particular, the ".in" extension alongside the Complainant's marks BARBIE along with generic term "girl" is confusingly similar, and which would inevitably associate the disputed domain name closely with the Complainant's group of domains in the minds of consumers, all plausible actual or contemplated active use of disputed Domain Name by the Respondent is and would be illegitimate.

13.1.5 The Respondent also failed to comply with Para 3 of the INDRP, which requires that it is the

responsibility of the Respondent to ensure before the registration of the impugned domain name by him that the domain name registration does not infringe or violate someone else's rights. The Respondent should have exercised reasonable efforts to ensure there was no encroachment on any third-party rights.

13.1.6 This panel is of the view that it is for the Complainant to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such a prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name but the Respondent has also failed to do that. The Respondent's registration of the domain name **[barbiegirl.in]** is in bad faith for illegal commercial gains by attracting the internet users. The Respondent has no rights or legitimate interests in respect of the domain name and also the domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

RELIEF

Following INDRP Policy and Rules, this Panel directs that the disputed domain name **[barbiegirl.in]** be transferred from the Respondent to the Complainant, requesting NIXI to monitor the transfer.

New Delhi, India
Dated: March 26, 2024


[AJAY GUPTA]
Sole Arbitrator