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S. No. 68548 Dt. 11/9/2008 Rs. 100/-
Sold To Harini
S/o/W/o/D/o R. Narayana swamy Pro tyd.
To Whom

P 384870
K. RAMA CHANDRAVATHI
STAMP VENDOR (L. No:27/99, RL.No.16/2008),
6-3-387, Beside Banjara Durbar Hotel, Panjagutta,
HYDERABAD - 500 082. Phone. No. 23351799

BEFORE THE NATIONAL INTERNET EXCHANGE OF INDIA
ARBITRATION AWARD

Case No. L-2/5/R 5 OF 2008

In The Matter Between

Google Inc.

Complainant

Versus.

R.Jain

Respondent

I

Harini Narayana swamy

1. The Parties

The Complainant In this arbitration is Google Inc., a company based in the United States of America with its corporate office at 1600 Ampitheatre Parkway, Mountain View, California, 94043 USA. The Complainant is represented here by Mr. Ranjan Narula of M/s Ranjan Narula Associates of Gurgaon India.

The Respondent is R. Jain 1-12, 98 Street, Richmond Hill, New York, 11418 USA.

2. The Domain name, Registrar and Policy

The Arbitration pertains to a dispute regarding the domain name < orkut.in> which is registered with Business Solutions.

The Arbitration Proceeding is conducted in accordance with the Arbitration and Conciliation Act of 1996, the .IN Domain Name Dispute Resolution Policy (the "INDRP Policy"), and the INDRP Rules of Procedure (the "Rules").

3. Procedural History

The Arbitrator received the hard copy of the Complaint along with the Annexures on August 12, 2008. On August 14, 2008, the Arbitrator send by email a notification of commencement of the arbitration regarding the disputed domain name< orkut.in> under paragraph 5 (c) of the INDRP Rules.

The Arbitrator called for the response to be filed within fifteen days of the date of the notification by the Respondent. There was no response from the Respondent. The Arbitrator proceeds under paragraph 11 of the Rules, to determine the case based on the submissions made by the Complainant and the materials on record.



Factual Back ground

The Complainant, Google Inc., contends that it is the owner of the ORKUT mark. The Complainant states that ORKUT is a social networking website which is popular for its video sharing feature. Users can upload, view and share video clips through this site, which is accessible to users worldwide including users in India. Video clips on the site can be uploaded and shared through mobile devices, blogs and emails.

The Complainant states it is the registered proprietor of the ORKUT mark and has filed a number of applications for the mark in numerous countries including United States of America, Argentina, Austria, Brazil, Canada, China and European Union, Hong Kong, Israel. Norway, Singapore, South Korea, Switzerland, Taiwan, Venezuela, Japan, Mexico and India. A list showing the status of the trademark applications for ORKUT and its trademark registrations in several countries including India is furnished by the Complainant.

The Complainant submits that the Orkut service has a large user base, particularly in Brazil where the number is stated to be 11 million users. Next to Brazil, the second largest user base is in India , where it is stated to be popular among the youth in India. People use their Orkut accounts, according to the Complainant to communicate with each other, post their pictures online, view current events, and link up with groups relating to their hobbies and interests.

The Complainant is the registered owner of the domain name www.orkut.com , which is its main website. The Complainant also owns several domain names in different countries including England www.orkut.co.uk, Australia www.orkut.com.au, Canada www.orkut.ca, Germany www.orkut.de , Portugal www.orkut.pt, Israel www.orkut.co.il and New Zealand www.orkut.nz.

4. Parties contentions

Hairi Narayanan 3

4. Parties contentions

A. Complainant

The Complainant claims it is one of the largest Internet search providers in the world and is also the world's favorite search engine. Its reputation in the field of Information Technology has not only given it popularity and world wide recognition, but also provided popularity to its social networking site ORKUT. The Complainant alleges that users of the ORKUT services and general trade associate the ORKUT mark with the Complainant. The use of the disputed domain name <orkut.in> by the Respondent is therefore unauthorized use, states the Complainant.

The Complainant provides a short history of ORKUT and has furnished a printout from Wikipedia which contains information about its history and its other miscellaneous features. The name ORKUT, the Complainant states, is based on the name of a Google employee Orkut Buyukokten , who helped develop the product. The ORKUT site was launched in January 2004, and the Complainant alleges that it gained popularity within a short span of a few months. Presently, ORKUT services are available in twelve languages. The Complainant provides articles and printouts of its websites to demonstrate the popularity of the ORKUT services and to show the goodwill and reputation the mark enjoys world- wide.

The Complainant states that on account of its popularity, the ORKUT mark has achieved the status of a well known mark. The Complainant argues that the Respondent can have no plausible reason to register a domain name using the distinctive ORKUT mark, except to take advantage of the goodwill and reputation of the ORKUT mark and domain name. The Complainant states the Respondent's use of the domain name <orkut.in> will lead to incalculable injury to Complainant's goodwill and reputation. Additionally, it will also result in confusion and deception to the public who may subscribe to the Respondent's services assuming that it is sponsored, affiliated or endorsed by the Complainant.

Havini Narayanan

The Complainant further states that the Respondent's intention in registering the domain name is to sell it to a third party. Given the world wide publicity of the ORKUT mark and the distinctive nature of its business, the adoption of the name by the Respondent cannot be considered a coincidence. Copying the mark is a dishonest act by the Respondent, according to the Complainant as it seeks to usurp the goodwill attached to the Complainant's service to derive monetary gain. The present case is clearly one of cyber squatting, according to the Complainant, due to the use of an identical domain name, and will likely mislead, divert consumers and further lead to tarnishing the Complainant's reputation.

According to the Complainant the Respondent's dishonest conduct is apparent, as no *bonafide* activity is being undertaken using the domain name. The Complainant has furnished a printout of the Respondent's website which shows that the Respondent has merely provided links to other sites. This lack of bonafide activity, emphasizes the Complainant, shows the Respondent has registered the domain name with an intention of taking advantage of the Complainant's reputation.

The Complainant argues that the Respondent has no rights and legitimate interests in the domain name for the reason that the domain name was registered in May 7, 2007, which is after the Complainant had acquired considerable good will and reputation in the ORKUT mark. The Respondent therefore, ought to have been aware of the Complainant's rights in ORKUT trademark. Further, the Respondent is not known and has never been known by the ORKUT name or other similar name, nor appears to have conducted any active business under the name ORKUT.

As the Respondent's website does not have active content, the Complainant states that the domain name has been registered to benefit from the sale of its famous name. The Complainant further argues that the Respondent's contact address shows he is based in the United States of America and not in India, therefore the Respondent has no legitimate business interest in registering the domain name in the .IN Registry.



Finally, the Complainant contends that the domain name was registered and is being used in bad faith. The reasons given are: firstly, the name ORKUT was already well known when it was registered by the Respondent; Secondly, the term ORKUT is a coined word and is a distinctive mark; and lastly, the Respondent is not carrying on business activity through the domain name but has registered the name to merely resell it.

The Complainant requests for the transfer the domain name<orkut.in> for the above stated reasons.

B. Respondent

The Respondent did not respond or file a response to the notification sent by the Arbitrator. Neither has the Respondent otherwise replied or contradicted the contentions made by the Complainant.

5, Discussion and **Findings**

Under the .IN Policy the Registrant of the domain name is required to submit to a mandatory Arbitration proceeding in the event that a Complaint is filed in the .IN Registry, in compliance with the .IN Policy and the INDRP Rules.

The .IN Policy, Paragraph 4 requires the Complainant, to establish the following three elements:

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

Hanni Narayanan

The following are the findings of the Arbitrator based on all the material on record.

Identical or Confusingly Similar

The Complainant is required to prove that the domain name registered by the Respondent is identical or confusingly similar to a mark in which it has rights.

The Complainant has demonstrated its ownership in the ORKUT mark by providing evidence of its trademark registrations in numerous jurisdictions including India. Secondly, it has provided evidence of use of the mark as a business identifier. Finally, the Complainant has demonstrated its prior adoption of the ORKUT mark and its sustained use over a period of time. These factors establish the Complainant's ownership in the mark as a distinct identifier of the its services offered under the name ORKUT.

The Arbitrator notes that the Complainant's ORKUT site has a reputation of being a forum used by several hate groups and it has been censored or banned in many countries. The manner the site is used or misused, or the fact that the authorities had intervened to monitor the activities of this site is beyond the scope of this proceeding. It is sufficient for the purposes of this dispute that the Complainant has demonstrated its strong online presence and a wide user awareness of its mark. The Arbitrator is satisfied that the Complainant has rights in the name ORKUT and that it is a distinct identifier of its services.

In the absence of a response from the Respondent there is no valid explanation as to why the Respondent has adopted a domain name which is identical to the Complainant's mark. It is well established that a domain name that entirely incorporates a mark is found to be either identical or confusingly similar to the mark. The Arbitrator finds in the present case the name is identical except for the ".in" domain identifier.

The Arbitrator finds, for all the reasons discussed above that the domain name is identical to a mark ORKUT in which the Complainant has rights.

Havini Narayanan

Rights and Legitimate Interests

The Complainant has to show that the Respondent has no rights and legitimate interests in the domain name.

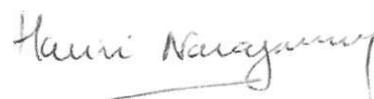
The Complainant has alleged that the Respondent is not known and has never been known by the ORKUT name nor conducted any active business under the name ORKUT or other similar name. The Arbitrator finds there is nothing on record to show the Respondent has been commonly known by the domain name or that it has made a *bona fide* offering of goods and services to give the Respondent any legitimate rights. The Respondent having failed to file a response leaves the contentions of the Complainant unchallenged.

The Arbitrator finds the Complainant's argument tenable that the Respondent ought to have been aware of the Complainant's rights in ORKUT trademark. It is further observed by the Arbitrator that the domain name is placed on SEDOPARKING.COM, which is a parking site. A domain name which incorporates a trademark and is placed on a parking site has been held in previous cases as not a legitimate use in several domain name disputes. See for instance *Grundfos A/S v. Texas International Property Associates*, WIPO Case No.D2007-1 448, for a detailed discussion on domain names that incorporate trademarks which are put on parking sites.

The Arbitrator therefore holds that the Respondent has no rights or legitimate interests in the domain name.

Bad Faith

Under the INDRP Policy the Complainant is required to prove that the domain name is being used in bad faith. The .IN Policy provides a non-exhaustive list, of circumstances if



found present, indicate bad faith registration and use of a domain name under Paragraph 5 (iii) of the Policy.

The Arbitrator finds the Complainant's arguments are convincing regarding the registration and use of the domain name in bad faith. As discussed above, there are reasonable grounds in the present case to show the domain name is identical to the Complainant's mark which is likely to mislead Internet users to the Respondent's website. This is likely to have a disruptive effect on the Complainant's business.

The Arbitrator finds that the Respondent ought of have know,the about the Complainant's mark and its strong online presence at the time of registration of the disputed domain name. It is evident from the materials on record that in registering and using the domain name the Respondent has intentionally attempted to attract internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark. Numerous domain name cases have found that use of a trademark with the intention to divert Internet users to its website constitutes bad faith registration and use. *AT&T Corp. v. Amjad Kauser* WIPO Case No. D 2000 -0327.

For all the reasons discussed, the Arbitrator finds the domain name has been registered and used in bad faith under paragraphs 4 and 5 (iii) of the Policy.

6. Decision

For all the reasons discussed above the Arbitrator orders that the Domain Name <orkut.in> be transferred to the Complainant.



Harini Narayanswamy

Arbitrator

Date: September 11, 2008