



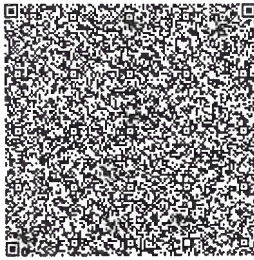
सत्यमेव जयते

INDIA NON JUDICIAL

Government of National Capital Territory of Delhi

e-Stamp

Certificate No. : IN-DL84865842789268Q
Certificate Issued Date : 01-Oct-2018 10:49 AM-
Account Reference : IMPACC (IV)/ dl916803/ DELHI/ DL-DLH
Unique Doc. Reference : SUBIN-DL91680374261953123789Q
Purchased by : LUCY RANA
Description of Document : Article Others
Property Description : Not Applicable
Consideration Price (Rs.) : 0
(Zero)
First Party : LUCY RANA
Second Party : Not Applicable
Stamp Duty Paid By : LUCY RANA
Stamp Duty Amount(Rs.) : 100
(One Hundred only)



Please write or type below this line

BEFORE THE SOLE ARBITRATOR UNDER .IN DISPUTE RESOLUTION POLICY
(Appointed by .IN Registry- National Internet Exchange of India)

ARBITRATION AWARD

Disputed Domain Name: <STARPOKER.IN>

IN THE MATTER OF:
Rational Intellectual Holdings Ltd.
Douglas Bay Complex,
King Edward Road,
Onchan,
Isle of Man, IM3 1DZ,
British Isles.

....Complainant

-----versus-----

Sunny Karira
2/7 Sarat Bose Road,
Vasundhara Building 705,
Kolkata-700020.
West Bengal, India.

.....Respondent

Statutory Alert:

1. The authenticity of this Stamp Certificate should be verified at "www.shcilestamp.com". Any discrepancy in the details on this Certificate and as available on the website renders it invalid.
2. The onus of checking the legitimacy is on the users of the certificate.
3. In case of any discrepancy please inform the Competent Authority.

Lucy Rana

1. The Parties

The **Complainant** in this arbitration proceeding is **Rational intellectual Holdings Ltd.**, of the address Douglas Bay Complex, King Edward Road, Onchan, Isle of Man, IM3 1DZ, British Isles.

The **Respondent** in this arbitration proceeding is **Sunny Karira**, an individual, having address at 2/7 Sarat Bose Road, Vasundhara Building 705, Kolkata-700020, West Bengal, India.

However, the Respondent has informed vide his email to NIXI dated March 20, 2018 that his present address is: **KD Gaming Solutions Pvt. Ltd.**, 3rd Floor, Room No. 311, 1, R.N. Mukherjee Road, Kolkata-700001, West Bengal, India.

2. The Domain Name, Registrar and Registrant

The present arbitration proceeding pertains to a dispute concerning the registration of domain name <starpoker.in> with the .IN Registry. The Registrant in the present matter is **Sunny Karira**, and the Registrar is **GoDaddy.com, LLC**.

3. Procedural History

The arbitration proceeding is in accordance with the .IN Domain Name Dispute Resolution Policy (INDRP), adopted by the National Internet Exchange of India (NIXI).

NIXI vide its email dated July 25, 2018, sought consent of Mrs. Lucy Rana to act as the Sole Arbitrator in the matter. The Arbitrator informed of her availability and gave her consent vide Statement of Acceptance and Declaration of Impartiality and Independence in compliance with the INDRP Rules of Procedure vide email on the same day.

NIXI vide its email dated August 02, 2018 thereafter informed that the Respondent had informed them of his updated address vide correspondence dated March 20, 2018. NIXI further informed that the Complainant counsel had also been apprised of the same and accordingly called upon to modify the Complaint which revised Complaint had now been submitted.

Thereafter, NIXI forwarded soft copy of the Complaint, along with Annexures, as filed by the Complainant in the matter, to all Parties, including the Arbitrator vide email dated August 02, 2018 and made the pronouncement that Mrs. Lucy Rana, in her capacity as Arbitrator, would be handling the matter.

The Arbitrator confirmed receipt of the soft copy of the Complaint along with Annexures as filed and further sought confirmation of service of the same in soft as well as hard copies upon the Respondent vide email dated August 03, 2018. The hard copies of the Domain Complaint along with Annexures as filed by the Complainant were also received by the Arbitrator on the same day.

Lucy Rana

The emails annexing the soft copy of the Complaint along with Annexures as sent to the Respondent was acknowledged vide email dated August 03, 2018.

Thereafter, NIXI, vide its email dated August 06, 2018 confirmed that the hard copies of the domain complaint along with annexures had been sent by courier to both addresses as provided by the Respondent and both sets had been duly delivered.

Receipt of the hard copy of the Complaint along with Annexures as filed by the Complainant in the matter was acknowledged by the Respondent vide email dated August 06, 2018.

Thereafter, the Arbitrator, vide email dated August 06, 2018, informed the Respondent that as he has been duly served with the Complaint and Annexures thereto, as confirmed vide email dated August 06, 2018, he is granted a period of **fourteen (14) days** from the date of receipt of the email in which to file a response to the Complaint in hard as well as soft copy and forward copies of the same to the Complainant, the Arbitrator and the .IN Registry, failing which, the matter will be decided on the basis of material already available on record and on the basis of applicable law.

On August 16, 2018, the Respondent's counsel sent an email inter alia intimating that the Respondent has engaged Mr. Dutta to represent him and that although drafting of a suitable reply to the Complaint had started, it was taking longer than expected and he requested for grant of two (2) additional weeks for submission of the reply.

Thereafter the counsel on behalf of the Complainant, vide email dated August 17, 2018, objected to the grant of additional time to the Respondent for submission of his reply.

Counsel for the Respondent responded to the Complainant's objections to grant of additional time and reiterated his request vide return email on the same day.

In consideration of both parties' contentions, the Arbitrator, vide email dated August 17, 2018, brought it on the record that, in the interests of justice the Respondent was being granted an additional but final and non-extendable period of **seven (7) days** within which to submit his reply in the matter.

Thereafter, on August 24, 2018, the counsel for the Respondent, submitted a reply to the Complainant's domain complaint as filed in both hard and soft copies for the attention of the Arbitrator. However, as the soft copy of the same as submitted was not accessible by the Arbitrator, PDF versions of the same were requested from the counsel for the Respondent which were thereafter provided on August 27, 2018. The Arbitrator as well as the Complainant confirmed receipt of the reply vide emails of August 27, 2018 and the Complainant requested and was granted **seven (7) days** therefrom within which to submit a suitable rejoinder thereto (if any).

Counsel for the Complainant, vide email dated September 03, 2018, assured to submit the rejoinder in soft copy by the end of the day however sought leave to submit the same in hard copy after some time as they were still awaiting receipt of duly executed originals from their client who is based abroad. The Arbitrator, upon consideration of the circumstances informed by the counsel for the Complainant, allowed time till the

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end of the day on September 03, 2018 for submission of the rejoinder in soft copy and a further seven (7) days to submit the same in hard copy.

The soft copy of the rejoinder was submitted by Complainant's counsel on September 04, 2018 receipt of which was confirmed by the Arbitrator on the same day whereby the Respondent was granted a period of seven (7) days therefrom to submit his rebuttal thereto (if any). Further, the parties were informed vide the same email that no further submissions would be entertained from either party thereafter.

The Arbitrator vide email dated September 07, 2018, confirmed receipt of the hard copy of the Complainant's rejoinder and supporting annexures.

Thereafter, the counsel on behalf of the Respondent, vide email dated September 11, 2018 sought an additional three (3) days to submit their rebuttal which was granted as a final and non-extendable grant of time by the Arbitrator vide email of September 12, 2018.

The Respondent vide email dated September 13, 2018 submitted the rebuttal to the Complainant's rejoinder in soft copy receipt of which was duly acknowledged by the Arbitrator vide email dated September 17, 2018. The Arbitrator concluded the stage for submissions by the parties vide the same email and reserved the arbitral award to be passed on the basis of facts and documents available on the record.

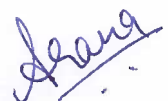
4. Factual Background-Complainant

The Complainant has submitted that it is a part of **The Stars Group Inc.** group of companies, (earlier known as the Amaya Inc. group of companies, whose name was subsequently in August 2017 changed to The Stars Group Inc.) which is listed on the NASDAQ and the Toronto Stock Exchange. That it is engaged in the business of offering online services such as poker rooms and platforms for hosting poker card games for players across numerous jurisdictions under, among others, the trademark "**PokerStars**". That the Complainant Group is also the owner of other industry leading gaming brands such as **BetStars, Full Tilt**, etc.

The Complainant has submitted that it enjoys worldwide reputation as the market leader in the field of online poker and further claims that its online poker card room platform operated under the **PokerStars marks** is the world's largest and best known. That the Complainant Group also operates its own mobile application for provision of an online poker card platform.

The Complainant has submitted that it entered into the online poker market and commenced use of the **PokerStars marks** in 2001 when it launched its website at www.pokerstars.com, which domain was registered on March 11, 2001. The Complainant has further submitted that it also obtained the domain **<pokerstars.net>** in 2001 where it launched its play money website in 2004.

The Complainant has annexed relevant WHOIS extracts evidencing its registrations and ownership of the two domains **<pokerstars.com>** and **<pokerstars.net>** collectively as **Annexure B**.



The Complainant has submitted that in 2002, it launched its first major online poker tournament- the World Championship of Online Poker. The Complainant has further submitted that it was catapulted to international fame in 2003 when Chris Moneymaker, an accountant from North America, won USD 2.5 million at the World Series of Poker by qualifying online in a USD39 game at the Complainant's website, i.e. www.pokerstars.com.

The Complainant has submitted that it currently provides its services via websites like www.pokerstars.be; www.pokerstars.dk; www.pokerstars.it; www.pokerstars.fr; www.pokerstars.es and www.pokerstars.ee. Further, the Complainant has obtained numerous country code top level domain name registrations to redirect users searching for its websites in these countries to its **PokerStars websites** and to provide online poker services to those countries where it holds a local license issued to one of the entities under the Complainant Group.

The Complainant has annexed a list of its ccTLD domain name registrations as **Annexure C**.

The Complainant has submitted that its **PokerStars websites** have remained the world's largest and best-known online poker websites and handle huge volumes of traffic every day with over 65 million registered users (including Indians) worldwide and over 165 billion hands dealt since 2001. That the **PokerStars websites** offer their various games in 16 different languages.

The Complainant has submitted that it itself or through its group companies, promotes its **PokerStars marks** vide various activities including:

- Organizing the biggest weekly online poker tournament- the Sunday Million; and also the annual World Championship of Online Poker from its **PokerStars websites**.
The Complainant has annexed copies of statistics and promotional material relating to the said events as **Annexure D**.
- Sponsoring the live poker championships in the Casino Royale Goa cruise ship in India.
The Complainant has annexed copies of promotional material relating to the said event as **Annexure E**.
- Recording and broadcasting television programs around the world featuring the **PokerStars marks**.
- Operating websites which teach players the rules and nuances of the game of poker and feature the **PokerStars marks**.
- Making available promotional and marketing material and information on several social media platforms such as Facebook, Twitter, Instagram, YouTube and LinkedIn to the Indian public at large.
- Engaging in tie-ups with various third party online portals who advertise the Complainant's services and re-direct users and players to the Complainant's **PokerStars websites** through a one-click model.

The Complainant has submitted that, in addition to its online presence, it also provides a platform through its **PokerStars websites** where the customers can qualify for live poker events in various countries around the globe.

The Complainant has submitted that it also offers its services through its desktop and mobile applications which are available on various online, mobile and social platforms such as Facebook, Apple iOS and Apple TV, Google Android and Amazon Kindle.

The Complainant has submitted that its services offered under the **PokerStars mark** have always been promoted through famous celebrities such as Rafael Nadal, Cristiano Ronaldo, Neymar Jr. and Dwayne Wade in the past, and presently by Kevin Hart and Usain Bolt, all of whom have global mass appeal among the public.

The Complainant has submitted that it has spent and continues to spend substantial time, efforts and resources (including money) in developing the trademark and brand name "**PokerStars**" along with its variants. To secure statutory protection to its **PokerStars mark**, the Complainant has submitted that it has applied for/obtained registrations for its marks containing "**PokerStars**" in over 30 jurisdictions worldwide, including India. The Complainant has submitted that it applied for the **PokerStars mark** in India in 2012 claiming use since 2010.

The Complainant has annexed a list of its applications/registrations for the **PokerStars marks** in India as **Annexure F** and a list of its worldwide registrations for the same as **Annexure G** in support of its submissions.

The Complainant has further submitted that it has licensed its **PokerStars mark** in India to an entity named **Sachiko Gaming Private Limited**. The said entity is presently operating the **PokerStars website** at www.pokerstars.in and is offering skill based card games of poker to players in India.

The Complainant has submitted that it has acquired trans-border reputation and goodwill in several jurisdictions, including India, by virtue of its activities, continuous and extensive use of the **PokerStars mark** over the years. In fact, the Complainant has submitted that the relevant customer base, engaged in playing poker in any form is aware of the **PokerStars** brand and its marks and associates such marks and the unique combination of the words "poker" and "stars" exclusively with the Complainant.

The Complainant has submitted that the extent of popularity of the Complainant, its services and the **PokerStars marks** can be gauged by the fact that upon conducting a public domain search on the internet of the terms: 'online poker' or 'play online poker', the Complainant's **PokerStars websites** appear among the top results, allegedly evidencing the fact that the Complainant's **PokerStars** brand is listed at several webpages as being a top site for playing online poker games and that the public at large exclusively associates the words "Poker" and "Star" when used in conjunction with the Complainant's **PokerStars** brand and the websites operated thereunder.

The Complainant has annexed copies of the webpages evidencing the results of the above-mentioned search strings as **Annexure H**.

The Complainant has submitted that it has won several awards over the course of years under its **PokerStars** brand and has also set a number of records.

The Complainant has submitted that due to its efforts in promotion and marketing, its **PokerStars** brand and marks and services offered thereunder have garnered substantial goodwill and reputation in the market in general and in the gaming industry

in particular, enough to be considered a famous and well-known mark as provided for under the Paris Convention. The Complainant has additionally submitted that in a number of UDRP decisions in its favour, the WIPO arbitration panels have agreed that the **PokerStars mark** enjoys a significant degree of recognition throughout the world.

The Complainant has submitted that it has well-established rights in its **PokerStars marks** through its long term, continuous and exclusive use of the same.

Legal History (Complainant)

The Complainant has submitted that in or about early 2016, the Complainant became aware of the unauthorized use of the impugned website (i.e. at www.starpoker.in). That on gaining knowledge of the usage and conduct of business on the impugned website, and in order to protect its rights in respect thereto, it served legal notices dated February 26 and March 30, 2016 on the company **KD Gaming Solutions Private Limited**, as the said entity was designated to be the operator of the impugned website per the terms of its End User License Agreement as hosted thereon. That the said notices called upon the entity to cease and desist from infringing the Complainant's **PokerStars marks** by using any mark similar thereto (such as **Starpoker**). That after service of the letter dated March 30, 2016, the entity **KD Gaming Solutions** responded to the Complainant's afore-mentioned notices. That upon receipt of the reply, the Complainant attempted to set up settlement discussions, however the entity, after some initial correspondence, did not reply to the Complainant. The Complainant has further submitted that till date, the said entity has failed to comply and cease and desist from using its impugned infringing material thereby causing irreparable harm and unquantifiable damage to the Complainant. The Complainant has also reserved its rights to proceed against the said entity.

The Complainant has submitted that it had filed a previous domain complaint in the matter of the domain **<starpoker.in>** before NIXI on June 12, 2017 for which procedural objections had been duly cleared on July 13, 2017, under **INDRP Case No. 901** in which, according to the Complainant, the 3 premises as required under Paragraph 4 of the INDRP had been duly satisfied. That the Complainant had prayed therein that the Registrant of the disputed domain be ordered to transfer the same to the Complainant. That on July 04, 2017, Dr. Sudhir Raja Ravindran was appointed as the sole arbitrator in the matter by NIXI. That thereafter, on July 10, 2017 the said Complaint had been served upon the Respondent. That the Respondent failed to file its response thereto, despite having been duly served with the Complaint (which fact was allegedly acknowledged by the Respondent in subsequent proceedings).

The Complainant has submitted that post filing of the afore-mentioned (first) domain complaint in respect of **<starpoker.in>**, the trade marks agent of the Complainant for application no. 3415037 for the PokerStars logo mark received an examination report dated December 31, 2016 which had however been dispatched by the Trademarks



Registry only on June 21, 2017. The said examination report cited the mark

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as registered by **KD Gaming Solutions Pvt. Ltd.** under registration no. 3001142 in class 41 applied for on July 03, 2015 and claiming use since July 01, 2015 as being conflicting with the Complainant's application. That the Complainant came to know



STAR
POKER

only vide the said examination report that the mark STAR POKER had now attained registration and that they had missed the opportunity to institute an opposition against the said mark allegedly owing to inadvertence of their instructed counsel.

The Complainant has annexed copies of the said examination report as well as copy of the status page of its application evidencing that the said report was dispatched only on June 21, 2017 despite having been issued on December 31, 2016 as **Annexures I and J** respectively.

The Complainant has submitted that thereafter the Complainant instituted rectification proceedings against the said registration so as to cancel the same from the Register of Trade Marks. That upon receipt of the Complainant's rectification application, the same was uploaded in the records of the Trademarks Registry and updated the status of registration no. 3001142 to 'Rectification filed.'

The Complainant has annexed evidence of the same as **Annexure K**.

The Complainant has submitted that no reply to the rectification application was filed by the registered proprietor of registration no. 3001142, i.e. **KD Gaming Solutions Pvt. Ltd.**, even though they had been duly served with a copy of the same on September 27, 2017 with the requirement to file their counter-statement thereto within a period of 2 months from such date. That after completion of the stipulated extended timeline, and in the absence of any reply being filed to the rectification application by the registered proprietor, the Complainant filed its evidence in support of rectification on February 27, 2018 which was duly received by the registered proprietor and its agents by March 03, 2018. That the registered proprietor was required to file its evidence in response by May 04, 2018, however did not do so, nor did it file for extension of time to submit the same. The Complainant has contended that in observance of Rule 46(2) of the Trade Marks Rules, 2017, in the absence of requisite evidence being tendered by the registered proprietor in its defence, registration no.



STAR
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3001142 for STAR POKER is deemed to be abandoned.

The Complainant has annexed a copy of its rectification application against registration no. 3001142 as **Annexure L**.

The Complainant has submitted that the Arbitrator for the domain complaint dated June 12, 2017 passed an allegedly erroneous ex-parte award on August 21, 2017, inter alia dismissing the complaint. The Complainant has further submitted that the impugned award was based on certain erroneous findings by the Arbitrator pursuant to his own independent research. The Complainant has submitted that it was never

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provided an opportunity to respond to the Arbitrator's facts and findings in this regard prior to passing of the impugned award.

The Complainant has submitted that thereafter, it filed a petition bearing no. **O.M.P. (Comm.) 446/2017** before the **Hon'ble High Court of Delhi** on November 17, 2017 under Section 34 of the Arbitration and Conciliation Act, 1996 to set aside the impugned arbitral award.

The Complainant has submitted that the Respondent appeared before the High Court and opposed the Section 34 petition. That the Respondent in these proceedings acknowledged that it had been served with the domain complaint dated June 12, 2018 and had consciously chosen to not file a reply thereto.

The Complainant has submitted that the Hon'ble High Court after hearing the matter set aside the impugned award vide its judgement dated April 11, 2018 wherein it agreed with the submissions of the Complainant and found that the Arbitrator had indeed made erroneous findings without providing an opportunity to the Complainant to respond to such independent findings.

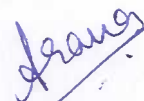
The Complainant has annexed a copy of the text of the said judgement as **Annexure N**.

5. Contentions and Legal Grounds Submitted by the Complainant

The Complainant has submitted the following legal grounds for its complaint:

A. The domain name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights [INDRP, Para 4(i), Rules 3(b)(v), (b)(vi)(1)]

- i. That the present Complaint is based on the **PokerStars marks** and the **PokerStars websites** in which the Complainant has already claimed to have rights and which are being used in connection with the provisions of online marketplace/portal for the provision of skill-based games including poker.
- ii. That the Complainant's **PokerStars marks** have been in use for more than 15 years, are famous, and recognized globally. That the Complainant's earliest trademark application was filed in the USA in January 2005.
- iii. That the disputed domain name was evidently registered in May 2015 which is more than ten (10) years subsequent to the earliest date of the Complainant's rights accruing in its **PokerStars mark** and more than thirteen (13) years after the Complainant adopted the mark and launched its website at www.pokerstars.com.
- iv. That by virtue of the Complainant's extensive use of the **PokerStars marks** and websites around the world, it has accumulated substantial reputation in the brand including in India by virtue of use as well as spill-over trans-border reputation. Further, as the Complainant's services are



provided by means of the internet, Indians across the world have obtained knowledge of its **PokerStars marks** and the websites operated thereunder. In fact, the Complainant has contended that even prior to the launch of its **PokerStars.in** website in India, the **PokerStars marks** and services offered thereunder had already developed a substantial amount of recognition and goodwill in the Indian market.

The Complainant has relied on the tenets of the judgement in *Cadbury U.K. Limited & Anr. v. Lotte India*, 207 (2014) DLT 500 before the Delhi High Court.

- v. That the **PokerStars mark** is a unique coined word formed by the combination of the two words "Poker" and "Stars". That even though the word "Poker" may be construed as generic and descriptive as pertaining to entertainment and games, when combined with a prefix or suffix, it has the potential to be turned into a new, fanciful and inventive word, thereby rendering the mark as a whole to be distinctive.
- vi. That where two marks, each consisting of a generic and a non-generic part, are compared, it is settled law that even where the generic portion is common, the non-generic portion of the marks should also be compared. Thus, the Complainant has contended that the combination of the words "Poker" and "Stars" in any form would be similar to the Complainant's **PokerStars marks** and any such combination would necessarily lead to confusion in the minds of the general public.
- vii. That while the two words "Poker" and "Stars" individually are both dictionary words per se, their combination together is a coined word having a meaning not attributable to the individual words or any dictionary meaning as such.

The Complainant has relied on the Delhi High Court judgement as tendered in the case of *Living Media India Limited v. Jitender V. Jain & Anr.*, 2002 [98 (2002) DLT 430.

- viii. That the Respondent's domain name <**starpoker.in**> is confusingly similar to the **PokerStars mark** in which the Complainant has established rights by virtue of trademark registration and exclusive global use.
- ix. That the Respondent's domain name comprises of the term "**Starpoker**" which, the Complainant asserts is a mere inversion of its mark "**PokerStars**" in order to piggyback on the goodwill and reputation acquired by the Complainant over the years.

The Complainant has cited the judgement tendered by the Delhi High Court in the matter of *Burger King Corporation v. Shameek & Ors.* [2016 (67) PTC 40 (Del.)].

The Complainant has further cited the following decisions delivered by various WIPO arbitration panels and the National Arbitration Forum in domain dispute cases:

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- *Giorgio Armani S.p.A. Milan, Swiss Branch Mendrisio v. Jin Yi*, WIPO Case No. D2013-0158
 - *NCRAS Management LP v. Cupcake City and John Zuccarini*, WIPO Case No. D2000-1803;
 - *Pearl Jam, a General Partnership v. Peter Lyn c/o Jampearl Limited*, National Arbitration Forum Claim Number FA0312000221238.
- x. That since both the Complainant and Respondent provide the same services, i.e. a platform for playing games, including poker, the mere inversion of the term “**PokerStars**” to “**Starpoker**” does not distinguish the mark of the Respondent from that of the Complainant.
- xi. That the Complainant has sought to protect its **PokerStars marks** at numerous instances.
- xii. That the Complainant has registered several domain names containing the **PokerStars mark** and the Respondent has registered the domain name <starpoker.in>. which is confusingly similar except for the generic country code “.in”. That addition of a generic country code is insufficient to distinguish the Respondent’s domain name from the Complainant’s trademark. It is a settled principle of law that the addition of a country code top level domain name in the disputed domain name does not avoid a determination that the domain name is confusingly similar to the Complainant’s mark as country code top level domains are descriptive by nature.
- xiii. Accordingly, the Complainant has asserted that the Respondent’s domain name <starpoker.in> is confusingly similar to the Complainant’s **PokerStars mark** and submitted that the conditions as laid down under Paragraph 4(i) and Rules 3(b)(v) and 3(b)(vi)(1) read with Paragraph 7 of the INDRP and Rules, are hereby satisfied.

B. The Respondent has no rights or legitimate interests in the domain name <uni-assist.in> [INDRP, Para 4(ii) and Rules 3(b)(vi)(2)]

- i. The Complainant has, with the support of the ruling in the cases: *Altria Group Inc. v. Steven Company*, WIPO Case No. D2010-1762 and *Zingametall BVBA v. Alexey Navalny*, INDRP Case No. 639, submitted that it is sufficient for the Complainant to make a prima facie case showing that the Respondent has no right or legitimate interest in the disputed domain name in order to shift the burden of proof onto the Respondent.
- ii. The Complainant has further cited the case *Charles Jourdan Holding AG v. AAIM*, WIPO Case No. D2000-0403 wherein there was a finding that there can be no claim of rights or legitimate interests where (1) the Respondent is not a licensee of the Complainant, (2) the Complainant’s prior rights in the domain names precede the Respondent’s registration, and (3) the Respondent is not commonly known by the domain name in question.

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- iii. The Complainant has contended that the website at the disputed domain is being operated by one **KD Gaming Solutions Pvt. Ltd.** as per the information contained in the end-user license agreement. That there is no explanation about the relationship between **KD Gaming Solutions** and the Respondent.
- iv. The Complainant has contended that there is no relationship between the Complainant and Respondent such as would entitle the Respondent to the use of the Complainant's mark, nor has there ever been any agreement, in the form of license or any other authorization, allowing the Respondent to use the Complainant's **PokerStars mark** or any mark similar thereto. That to the contrary, the Respondent has registered the disputed domain name to trade on the fame of the Complainant's **PokerStars mark** and increase traffic to its website and thereby profit financially therefrom.
- v. The Complainant has contended that its prior rights in the **PokerStars mark** precede the Respondent's registration of the confusingly similar domain <**starpoker.in**> as the Complainant has been continuously using its **PokerStars marks** since 2001 and had filed the first international application for registration thereof in the USA in January 2005. That the Respondent has registered the disputed domain name only in May 2015.
- vi. The Complainant has contended that neither the Respondent nor **KD Gaming Solutions** is commonly known by the name "**Starpoker**" as the same is not reflected in their names as provided in the contact information for the disputed domain in its WhoIs records.
- vii. The Complainant has contended that there exist certain striking similarities between the Respondent's website as hosted at the disputed domain when compared to the Complainant's **PokerStars websites** such as in the look and feel of the Respondent's website as well as in the representation of the Starpoker logo thereon.
- viii. The Complainant has contended that at the time of registering the disputed domain name, the Respondent knowingly misrepresented to the domain registrar that the same did not infringe upon the rights of a third party as it is inconceivable that the Respondent, being engaged in the same industry, was not aware of the Complainant's services under the name **PokerStars** at the time of registering the disputed domain in 2015 when the Complainant had been active in the market since 2001.
- ix. The Complainant has contended that there can be no plausible explanation for the Respondent's choice of the name "**Starpoker**" for their website/services except to trade off on the Complainant's goodwill and reputation. That given the strength and fame of the Complainant's **PokerStars mark**, it is highly unlikely that the Respondent could believe that adopting a name having any

combination of the words “Poker” and “Stars” would not result in infringing the rights of the Complainant in its **PokerStars mark**.

- x. The Complainant has contended that instead of using one of multifarious names which would not have resulted in any conflict with their rights, the Respondent intentionally chose a similar name to **PokerStars** with the ultimate objective of diverting internet traffic and profiting therefrom.
 - xi. The Complainant has contended that use of a deceptively similar name to their **PokerStars mark** qualifies as passing off as held in the judgement in *Satyam Infoway Ltd. vs. Siffynet Solutions Pvt. Ltd.* (2004) 6 SCC 145.
 - xii. Accordingly, the Complainant has asserted that the Respondent has no rights or legitimate interests in the disputed domain name <starpoker.in> and submitted that the conditions as laid down under Paragraph 4(ii) and Rule 3(b)(vi)(2) read with Paragraph 7 of the INDRP and Rules, are hereby satisfied.
- C. The Complainant submits that the domain name was registered and is being used by the Respondent in bad faith [INDRP Para 4(iii), Rules 3(b)(vi)(3)]
- i. The Complainant has contended that, by virtue of its long, extensive and continuous use of its **PokerStars marks**, at the time of registering the disputed domain name, it is inconceivable that the Respondent did not have knowledge of the Complainant’s brand in the same field of business, i.e. providing online poker services. Even a simple internet search would have sufficed to alert the Respondent to the existence and prevalence of the Complainant’s brand. In fact, the Complainant has further quoted the judgement in the case *Digi Int’l v. DDI Sys., FA124506* (Nat. Arb. Forum Oct. 24, 2002) wherein it was observed that “...there is a legal presumption of bad faith, when Respondent reasonably should have been aware of Complainant’s trademarks, actually or constructively.”
 - ii. The Complainant has submitted that in the WIPO panel judgement in a previous case concerning the Complainant, the ruling had been passed in its favour and had held that the **PokerStars mark** enjoys a significant degree of fame throughout the world from a time before the disputed domain name was registered. [*Rational Entertainment Enterprises Limited v. Sorin Cristea*, WIPO Case No. DR02011-0005].
 - iii. The Complainant has contended that even the passive holding of the disputed domain name is harmful to the Complainant (for reasons already established) and constitutes use in bad faith.
 - iv. The Complainant has contended that the respondent has previously used identical content including the terms of use, which were taken

down after the legal notice was served on **KD Gaming Solutions Pvt. Ltd.**. The Complainant has in fact annexed examples evidencing such similarities in content present on both the Complainant's and Respondent's websites as **Annexure Q**.

- v. As earlier contended by the Complainant, it has been reiterated that instead of using one of multifarious names which would not have resulted in any conflict with their rights, the Respondent intentionally chose a similar name to **PokerStars** with the ultimate objective of diverting internet traffic and profiting therefrom.
- vi. Accordingly, the Complainant has asserted that the Respondent's use of the disputed domain name constitutes use in bad faith and has submitted that the conditions as laid down under Paragraph 4(iii) and Rule 3(b)(vi)(3) read with Paragraph 7 of the INDRP and Rules, are hereby satisfied.

6. Reliefs claimed by the Complainant (Paragraph 10 of the INDRP read with Paragraph 3(b)(vii) of the INDRP Rules of Procedure)

The Complainant has claimed for the disputed domain name, i.e. <**starpoker.in**> to be transferred to the Complainant by means of the present Complaint, or if the Arbitrator is not inclined the said relief, then the registration for the disputed domain be cancelled.

The Complainant has submitted that the earlier Complaint dated June 12, 2017 in which order was passed on August 21, 2017 and resultant appeal before the Hon'ble Delhi High Court under **O.M.P. (Comm.) 446/2017** wherein the Hon'ble High Court vide its judgement dated April 11, 2018 set aside the arbitral award. That to the Complainant's knowledge, no additional legal proceeding has been commenced and/or terminated with relation to the domain name that is the subject of the present Complaint.

7. Respondent's Submissions/Contentions vide Reply dated August 24, 2018

The Respondent vide its Reply dated August 24, 2018 to the present Domain Complaint has, to begin with, put forward a number of preliminary objections, which are briefly stated as follows:

- A. The Respondent has contended that there is **no scope for confusion between the domain name of the Complainant and that of the Respondent** inter alia, on account of the following:
 - i. That for accessing the services by/on the domain names of either the Complainant or the Respondent, consumers/users have to create accounts protected by user IDs and passwords;
 - ii. That the said consumers/users are consciously choosing their service providers in this regard;

- iii. That the target demographic of consumers/users for online poker services are literate and educated and are able to differentiate between two service providers;
- iv. That the webpages as hosted on the Complainant and Respondent's domains respectively are different with respect to their logos/brands, look-and-feel, registration and payment process, etc.;
- v. That the two domain names, i.e. <starpoker.in> and <pokerstars.com> are phonetically and conceptually dissimilar. Reliance is placed on the judgement of the Gujarat High Court as reported in 2011(3) GLR 1951 and holding that if the marks in question are phonetically and conceptually different from each other, then no case of passing off or consumer confusion is made out.
- vi. That the respective internet searches for the terms "Starpoker" and "Pokerstars" yield specific results pertaining to the respective terms only and not the other.

The Respondent has annexed supporting documents in this regard as **Annexures 1-4.**

- B. The Respondent has contended that the present Complaint is liable to be dismissed because the domain name in dispute, i.e. <starpoker.in> is comprised of the **amalgamation of two generic dictionary words: "star" and "poker"** over which no individual entity may claim exclusivity or monopoly.

The Respondent has contended that the disputed domain name is not a mere inversion of the name/trademark of the Complainant ("PokerStars") and alludes instead to the descriptive ideology of **"sky high quality of poker services in India"**.

The Respondent has further contended that the Complainant's trademark "PokerStars" is similarly descriptive, in that it allegedly alludes to **"very good poker players"** and therefore the Complainant cannot claim exclusive rights thereto.

- C. The Respondent has contended that the Complainant has provided **no evidence of its alleged "trans-border spill-over reputation" in India** and that it entered the Indian market only in April 2018 and cannot claim prior use in India before then.

That per the Hon'ble Supreme Court's judgement in the case of *Toyota Jidosha Kabushiki Kaisha v. Prius Auto Industries Ltd. & Ors.* (2018) 2 SCC 1, a claimant must necessarily establish that their goodwill and reputation had spilled over into the Indian market prior to the date of adoption of the by another entity/person (defendant).

That the Complainant has failed to meet the requirements set out in the above-mentioned case.

- D. The Respondent has contended that they have **never advertised themselves as being associated with the Complainant** in any manner

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and that the Respondent have themselves invested a great deal of money in promoting and marketing their services and has earned sufficient goodwill and reputation of their own in the relevant market and does not have to “piggy-back” on the reputation and goodwill of the Complainant.

- E. The Respondent has contended that the Complainant is engaging in allegedly **anti-competitive and monopolizing practices** by instituting predatory litigation (by way of domain complaints, trademark cancellation proceedings and lawsuits) to unnecessarily harass and drive out local Indian competition and monopolize the Indian online poker market.
- F. The Respondent has contended that the findings of the Learned Arbitrator in the **award dated August 21, 2017** as passed in the earlier domain proceedings had been **rightly held**.
- G. The Respondent has contended that the principles of natural justice have not been followed by the Complainant as the company **KD Gaming Solutions Pvt. Ltd.** has not been arraigned in the present Complaint as the Respondent despite being the entity actually operating the services offered at the domain <starpoker.in> and therefore that the present Complaint suffers from a **non-joinder of necessary parties** and which is a mala fide action on the part of the Complainant.




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- H. The Respondent has contended that their mark **STAR POKER** under **trademark registration no. 3001142 was accepted unconditionally** during examination by the Trademarks Registry and proceeded to registration unopposed by the Complainant or any other third party. The Respondent has further challenged the subsequent rectification proceedings as instituted by the Complainant against the said registration, inter alia as having no bearing on the present arbitral proceedings, being time barred and having been filed without complying with necessary procedural formalities.
- I. The Respondent has contended that the present Complaint suffers from **formal deficiencies** such as having been filed without a copy of a board resolution or power of attorney authorizing the signatory of the Complaint as well as without due verification or affidavit in support of the statements and submissions as made therein.
- J. The Respondent has further provided a (allegedly) **revised timeline of events** in respect of the dispute on-going between them and the present Complainant:
 - i. **May 04, 2015-** Respondent obtained registration of the disputed domain name <starpoker.in>. The Respondent has contended that the said domain had been obtained with the intention of launching a business for providing online poker services in association with one Mr. Ankit Doogar on an equal shareholding basis. However, post registration of the

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disputed domain name, it had been decided that the Respondent's brother, one Mr. Shammi Karira, will enter into business with Mr. Doogar in place of the Respondent.

- ii. **May 27, 2015-** Respondent assigned his rights in the disputed domain name to his brother Mr. Shammi Karira vide an assignment agreement, copy of which has been annexed with the reply as **Annexure 5**.
- iii. **June 03, 2015-** The entity **KD Gaming Solutions Pvt. Ltd.** was incorporated.
- iv. **June 04, 2015-** The aforesaid entity started using the disputed domain name to provide online poker services under the name "**Starpoker**".
- v. **July 03, 2015-** Registration for the trademark  **STAR POKER** applied for.
- vi. **February 25, 2016-** Cease and desist notice issued to the aforesaid entity by the present Complainant, copy annexed as **Annexure 6**.
- vii. **March 30, 2016-** Reminder notice issued to the aforesaid entity by the present Complainant, copy annexed as **Annexure 7**.
- viii. **April 06, 2016-** **KD Gaming Solutions Pvt. Ltd.** issued a response to the aforementioned legal notices, copy annexed as **Annexure 8**.

- ix. **December 13, 2016-** Trademark  **STAR POKER** registered.
- x. **June 12, 2017-** First domain complaint instituted by the present Complainant before NIXI.
- xi. **July 04, 2017-** Dr. Sudhir Raja Ravindran appointed as arbitrator for the proceedings.
- xii. **July 10, 2017-** The Arbitrator commenced the arbitration proceedings.

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- xiii. **August 21, 2017**- Award passed in the INDRP proceedings which was challenged by the Complainant vide appeal in November 2017.
- xiv. **December 15, 2017**- Order passed by the Hon'ble Delhi High Court in the matter **O.M.P. (Comm.) 446/2017** inter alia setting aside the impugned arbitral award.
- xv. **April 11, 2018**- Judgement passed by the Hon'ble Delhi High Court in the matter **O.M.P. (Comm.) 446/2017**.
- xvi. **August, 2018**- Second (present) complaint instituted before NIXI by the Complainant.
- xvii. **August 23, 2018**- Counter statement filed by **KD Gaming Solutions** in response to the trademark rectification (cancellation) proceedings instituted against registration no. 3001142 by the present Complainant.

The Respondent has thereafter provided detailed para-wise reply to the Complainant's submissions which shall be dealt with herein only in respect of salient points/defences as raised by the Respondent therein.

The Respondent has contended that the Complainant has written at length about its reputation worldwide but is silent on its extent of goodwill/reputation in India. The Respondent has therefore contended that insofar as the Complainant has failed to establish its reputation and goodwill in India, the same is irrelevant to the present proceedings. The Respondent has further contended that the Complainant's fears of consumer confusion contradict with their claim of having acquired sufficient trans-border reputation in India. The Respondent has also contended that the Complainant's marks have not been held to be well-known by any authority in India.

The Respondent has contended that the fact that the Complainant had filed for registration of its **PokerStars** marks on a proposed to be used basis as late as 2016 establishes that the said marks of the Complainant were not in use in India even in 2016 (and by when the Respondent had already commenced use of its mark).

The Respondent has challenged the Complainant's actions as being mala fide and amounting to predatory litigation designed to weed out the competition in the Indian market by abusing their worldwide dominant position.



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The Respondent has contended that registration no. 3001142 for the mark has not been "Abandoned" by the Registry as claimed by the Complainant and its status is presently reflected as "Rectification Filed" which indicates that the rectification proceedings are on-going.

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In its para-wise defences, the Respondent has cited the case of *People Interactive (India) Pvt. Ltd. v. Vivek Pahwa & Ors.* 2016 (6) ABR 275 wherein it was held that: “... if both constituent integers are entirely commonplace, and one must only look to the mark or domain name as a whole, then the slightest differentiation must also surely be sufficient.”

The Respondent has contended that till date there has been no complaint raised by any consumer regarding confusion between the two brands, nor has any such instance been cited by the Complainant.

The Respondent has contested the challenge laid by the Complainant vide the present proceedings by stating that they do not need the Complainant’s permission to use a domain name which they have lawfully purchased and registered with no objections being raised by the relevant body at the time of registration.

Reliefs claimed by the Respondent

The Respondent has claimed on the basis of its submissions and contentions as tendered vide its statement in reply that the present Complaint be dismissed and they be allowed to continue to make use of the disputed domain name.

8. Complainant’s Submissions/Contentions vide Rejoinder dated September 03, 2018

The Complainant, vide the above-mentioned rejoinder, has responded to the Respondent’s reply dated August 24, 2018. Facts, submissions and contentions already stated are not being repeated hereunder for the sake of brevity. The salient points in the rejoinder as put forward by the Complainant are summarised as follows:

At the outset, the Complainant has submitted that the conduct of the Respondent in the earlier domain dispute arbitration before NIXI as well as in the proceedings pertaining to **O.M.P. (Comm.) 446/2017** before the Hon’ble Delhi High Court was deplorable. That the Respondent had not responded at all to the first domain complaint as filed by the present Complainant, and further had filed its submissions in the High Court proceedings only at the fag end, after seeking condonation of delay. That the Respondent’s conduct is reflective on a negligent and non-serious attitude on their part towards their rights in the disputed domain. That the present defence is untenable and a complete afterthought.

The Complainant has thereafter provided a detailed rebuttal of the primary four objections as raised by the Respondent vide their statement in reply dated August 24, 2018.

Objection 1: The signatory of the Complaint does not have the power of attorney to file the same.

The Complainant has submitted that the Respondent is treating the present proceedings akin to traditional court litigation and has failed to appreciate the distinction between arbitral and court proceedings. That such formal requirements need to be complied with only if the same are specifically prescribed by the arbitration agreement, arbitral rules of procedure, or specifically required by the Arbitrator. That

in the present circumstances, neither the INDRP nor the Rules formulated thereunder require the authorised representative to provide any power of attorney to prove authorization. That no procedural objections were raised regarding the same by NIXI at the time of filing of the Complaint.

The Complainant has, nevertheless, submitted in original a Vakalatnama evidencing due authorization of its counsel in respect of the present proceedings, and has further submitted an Affidavit duly signed and executed by a Director of the Complainant entity affirming the contents of the Complaint and rejoinder.

Objection 2: No similarity of the domain names and trademarks of the Complainant and Respondent

The Complainant has submitted that the Respondent's arguments as put forward in this regard in the statement in reply are fallacious in view of the fact that the present proceedings pertain solely to the domain <starpoker.in> (and not the Respondent's



trademark STAR POKER). That a domain name while acting as an identifier of an entity and its goods and services differs from a trademark primarily on the ground that there is no logo or colour scheme involved, and it is purely the words that are looked at while identifying a domain name.

The Complainant has submitted that the disputed domain name is a **mere inversion** of the domain name of the Complainant. That the crux of both domain names are a combination of the words "poker" and "star/s". The Complainant has referred to the following cases in support of its contention that inversion of the words in a mark constitutes infringement/passing off thereof:

- *Burger King Corporation v. Shameek & Anr.* CS (Comm.) 181/2016 before the Delhi High Court
- *Giorgio Armani S.p.A. Milan, Swiss Branch Mendrisio v. Jin Yi*; WIPO Case No. D2013-0158
- *NCRAS Management, LP v. Cupcake City and John Zuccarini*; WIPO Case No. D2000-1803
- *Pearl Jam, A General Partnership v. Peter Lyn, c/o Jampearl Limited*; NAF Claim No. FA0312000221238

The Complainant has made submissions regarding the inherent and acquired distinctiveness of its mark **PokerStars** as being an inventive and fancifully coined word combining the two words "Poker" and "Stars" and which has moreover been used by the Complainant in respect of its services for over 15 years. That in comparing the marks of the Complainant and Respondent both the generic and non-generic components are identical.

The Complainant has submitted that an internet search conducted for the term "starpoker" reveals several links referring to the Complainant's **PokerStars** websites,

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thereby evidencing that a consumer may be easily confused vis-à-vis the source of the services provided by the Complainant and Respondent.

Objection 3: Complainant has failed to establish if and what goodwill and reputation they have in the Indian market for the “PokerStars” mark

The Complainant has refuted the above objection put forward by the Respondent by reiterating its sponsorship of the live poker championships in the Casino Royale Goa cruise ship in India in 2012 wherein a fair percentage of the leading players were Indian players, as evidence of its prior use before the Respondent’s adoption of the disputed domain name in 2015.

The Complainant has further submitted that it has also advertised its **PokerStars** brand and marks through various social media platforms, including Facebook, Twitter, Instagram, YouTube, etc. which are accessible in India. That the **PokerStars** brand and marks were cited and advertised in several articles between 2012 and 2015 available on the internet and accessible worldwide including in India. That from the year 2012 to 2015, 59,731 Indians registered on the **PokerStars websites**. That the said facts and figures are testimony that Indians have actually visited the Complainant’s websites and have actually made use of the services offered thereon in India.

The Complainant has also relied on the decision in the case of *Toyota Jidosha Kabushiki Kaisha v. Prius Auto Industries Ltd. & Ors.* (2018) 2 SCC 1 and has submitted as follows:

- Presence of a real market is not required;
- It is not essential for the Complainant to have a physical presence in India;
- Even if the product or service is not directly provided in India, spill over of goodwill and reputation can also be through advertising of the mark in India;
- That the public at large need not know about the mark, but the limited segment of people who actually make use of the services provided (i.e. play poker) should be aware of the Complainant’s brand and websites operated thereunder;
- Advertising over the internet may be used as valid proof for ascertaining knowledge or information in India of a particular brand, especially having regard to the fact that the average consumer of the Complainant or Respondent is consuming the offered services through the internet itself.

The Complainant has once again cited the decision in the case of *Cadbury U.K. Limited & Anr. v. Lotte India* 207 (2014) DLT 500 as pronounced by the Delhi High Court in support of its contention that advertisement over the internet is sufficient to garner reputation in India.

Objection 4: No likelihood of confusion between the Impugned Domain Name and the PokerStars Domain Names

The Complainant has submitted that the relevant test for confusion is not actual confusion but the likelihood of causing confusion. The Complainant has referred once again to the case *Toyota Jidosha Kabushiki Kaisha v. Prius Auto Industries Ltd. & Ors.* in support of its contentions.

The Complainant has further submitted that the Complainant and the Respondent are both providing identical services, i.e. a platform to play poker, through the internet, wherein payments are made in similar fashion and marketing and provision of such services are to the same set of customers. That this fact, coupled with the argument in favour of the Complainant's marks having acquired sufficient reputation especially among the relevant set of customers in India is sufficient to qualify under the test for likelihood of confusion.

The Complainant has also submitted that under the provisions of the INDRP, merely attracting internet traffic by creating the likelihood of confusion in the domain name is sufficient to establish bad faith, and similarity in domain names is sufficient for the purpose of diverting internet traffic from the Complainant's website to that of the Respondent.

The Complainant has thereafter provided detailed para-wise rebuttal to the Respondent's submissions in reply which shall be dealt with herein only in respect of new and salient points/defences as raised by the Complainant therein.

The Complainant has submitted that the Respondent has not registered the disputed domain name with clean hands as the mere intent of seeking to register the disputed domain name which is confusingly similar to the Complainant's domains is mala fide.

The Complainant has submitted that the mere requirement of creating a user account and providing login details for access to a website is insufficient to adduce dissimilarity in the present case.

The Complainant has submitted that it is not claiming exclusivity over the (generic) word "poker", but merely over the combination of the words "star" and "poker" in any form together.

The Complainant has submitted that the Respondent has not till date challenged the Delhi High Court's order in setting aside the award as passed in the first domain complaint proceedings initiated in respect of the present disputed domain name and therefore is estopped from placing any reliance on it at this stage.

The Complainant has submitted that the correct party has been identified as Respondent in the present proceedings as provided for under the INDRP. That since **KD Gaming Solutions** is not the registrant on record of the disputed domain name, it could not have been made party to the present proceedings as the impleadment of a third party is not allowed under the INDRP.

The Complainant has challenged the agreement dated May 27, 2015, inter alia assigning the rights of the Registrant of the disputed domain name, Mr. Sunny Karira, to his brother, Mr. Shammi Karira, by contending that any assignment of rights in a domain name needs to be done through the domain name registrar (which in the present case is **GoDaddy, LLC**). The Complainant has further contended that the said agreement has not been shared with the domain registrar and neither has there been any attempt to change the name of the Registrant for the disputed domain in its WHOIS records to reflect that of Mr. Shammi Karira. The Complainant has also contended that the said agreement is formally deficient and therefore invalid in operation.

The Complainant has thereafter provided a detailed refutation to the Respondent's para-wise reply which is not being reiterated herein for the sake of brevity. In salient part, the Complainant has also challenged the Respondent's registration of the disputed domain name by contending that they had wrongly represented before the domain registrar that the registration would not infringe upon a third party's rights.

The Complainant has prayed for the reliefs as earlier vide its Complaint and further requested an oral hearing in the matter.

9. Respondent's Submissions/Contentions vide Rebuttal dated September 14, 2018

The Respondent, vide the above-mentioned Rebuttal, has responded to the Complainant's rejoinder dated September 03, 2018. Facts, submissions and contentions already stated are not being repeated hereunder for the sake of brevity. The salient points in rebuttal by the Respondent are summarised as follows:

The Respondent has submitted that the Complainant has nowhere stated when it entered the Indian market and whether it had at such time complied with all requisite statutory authorizations.

The Respondent has submitted that the domain name <**pokerstars.com**> is not available to users in India as users are re-directed to the website www.pokerstars.in upon trying to access the same. The Respondent has further submitted that the domain <**pokerstars.in**> is not registered in the name of the present Complainant, but instead in the name of **Sachiko Gaming Private Limited**. That the said website at <**pokerstars.in**> was officially launched in India only in April 2018.

The Respondent has prayed for the Complaint and associated rejoinder to be dismissed with exemplary costs laid on the Complainant, and has further requested oral hearing in the matter.

10. Discussion and Findings

The Respondent has raised contentions with respect to certain formal requirements vide their statement in reply dated August 24, 2018, namely that:

- i. The Complaint as filed on behalf of the Complainant has not been filed by a duly authorized representative. That no document (either board resolution or power of attorney) showing the authorization of the signatory of the present Complaint by the Complainant has been filed on records and as a result thereof, the stated signatory does not have the capacity to file the said Complaint, and that the Complaint is liable to be dismissed on this score alone;
- ii. The Complaint as filed is liable to be dismissed on account of non-joinder of necessary parties as it has not included **M/s KD Gaming Solutions Pvt. Ltd.**, an Indian company incorporated on June 03, 2015, which operates the website as hosted on the disputed domain and provides, inter alia, the disputed services (i.e. online poker services), and which is also the entity to whom the legal

notices dated February 25 and March 30, 2017 were served by the Complainant.

The Arbitrator hereby concludes that the said contentions as raised by the Respondent are untenable due to the reasons elaborated below:

- a. The representative on behalf of the Complainant has submitted a duly-executed Vakalatnama in their favour (including in favour of their advocates) which is hereby accepted by the Arbitrator as authorizing them to act on behalf of the Complainant by virtue of the direction of **Mr. Guy Nigel Lethbridge Templer** being the **Director of Rational Intellectual Holdings Limited**, the present Complainant.

The Respondent's argument that as per Para 3 of the Complaint only Mrs. Gowree Gokhale has been appointed as the Complainant's authorized representative has no merit as the authorized representatives for the Complainant, according to the designation in the mentioned paragraph, are **Nishith Desai Associates**, having attention to Mrs. Gowree Gokhale. The same does not, however, preclude any other of the constituting attorneys of Nishith Desai Associates from signing the Complaint or any other relevant document in their name.

The Arbitrator further accepts the Complainant's defence in respect of point (i) above that the present proceedings being held under the .IN Domain Name Dispute Resolution Policy and the INDRP Rules of Procedure as formulated thereunder, wherein it is not specifically stipulated for authorized representatives acting for either party to tender proof of their authorization, as is in fact statutorily stipulated in the case of formal court proceedings in India. However, for the sake of leaving no doubt as to the authenticity of the Complainant's submissions; and

- b. The disputed domain being registered in the sole name of the Respondent as mentioned in the Complaint as filed and not in the name of **M/s KD Gaming Solutions Pvt. Ltd.**, which is a company incorporated under the Indian Companies Act and admittedly having no relation to the Complainant, the Arbitrator concludes that the sole and suitable Respondent in the present matter has been properly identified in accordance with the .IN Domain Name Dispute Resolution Policy and hereby dismisses the Respondent's contention vide point (ii) above as untenable.

Further, with respect to the Respondent's challenge to the Complainant's institution of the present proceedings as "predatory litigation", solely to abuse its dominant position internationally and exert its monopoly in its field of activity against a bona fide Indian entity, the Arbitrator dismisses the said contention in view of the fact that the rightful proprietor of a trademark is fully within its statutory as well as common law rights to protect its rights in this regard, including by way of proceeding against the alleged infringing domain registrations and the same cannot be said to constitute unfair or anti-competitive practices and, in such a case, it becomes incumbent upon the respondent in such proceedings to establish its asserted honest, bona fide and legitimate rights and interests with respect to the mark/domain name.

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The Arbitrator also finds no merit in the contention of the Respondent that the fact that the Complainant has nowhere mentioned when it entered the Indian market or tendered proof that it complied with relevant statutory regulations or authorizations to do so, and that the same is an example of bad faith on the part of the Complainant. This argument fails primarily considering that the Complainant is not an Indian entity and has not sought to represent itself as such. Further, it has clearly stated in the Complainant itself that it has licensed use of its **PokerStars marks** in India to the entity **Sachiko Gaming Pvt. Ltd.**, which entity is indeed incorporated in India. It is pertinent to keep in mind that not being an entity incorporated in India does not preclude anybody from carrying on business in India and showing use of any assets pertaining to such business (such as trademarks).

As concerns the arbitral award dated August 21, 2017 in the previous complaint under the INDRP as instituted between the present parties as passed by the Arbitrator Dr. Sudhir Raja Ravindran, as the same has been suitably dealt with by the Hon'ble Delhi High Court in the proceedings **O.M.P. (Comm.) 446/2017**, the present Arbitrator states that she is bound by the ruling of the superior body and the present forum is not the proper forum to debate the same.

In a domain complaint, the Complainant is required to satisfy three conditions as outlined in Paragraph 4 of the .IN Domain Name Dispute Resolution Policy, i.e.:-

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

i. **The Registrant's domain name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights**
(Paragraph 4(i) of the .IN Domain Name Dispute Resolution Policy)

It has been held by the Hon'ble Supreme Court of India in the the case of *M/s Satyam Infoway Ltd. v. M/s Sifynet Solutions (P) Ltd.*, JT 2004 (5) SC 541, that a domain name has all the characteristics of a trademark and such principles as are applicable to trademarks are concurrently applicable to domain names as well.

In the opinion of the Arbitrator, the Complainant has been successful in establishing indisputably their rights in their **PokerStars marks** by virtue, inter alia of their bona fide adoption, long and extensive use of the same in their particular sphere of business (i.e. offering poker services) and corresponding (valid and subsisting) trademark registrations in jurisdictions worldwide including in India.

The Arbitrator, in this case, does not find the Respondent's argument that the two names/marks, i.e. "**Starpoker**" and "**PokerStars**" are sufficiently dissimilar to not cause any consumer confusion, to be maintainable.

It is pertinent to mention that a central and long-standing principle in determining the likelihood of consumer confusion when adjudicating cases of trademark infringement has been the test of a person of average intelligence and imperfect recollection. The

same has been upheld in numerous landmark cases including *Corn Products Refining Co. v. Shangrila Food Products Ltd.* AIR 1960 SC 142; *Amritdhara Pharmacy v. Satya Deo Gupta* 1963 AIR 449 ACT; and *Cadila Health Care Ltd. v. Cadila Pharmaceuticals Limited* (2001) 5 SCC 73. When considering the two conflicting marks from the point of view of the said test, it is not unimaginable that a person of average intelligence and imperfect recollection is likely to confuse the two domains, especially considering that the two provide identical services (i.e. relating to online poker). Further, having regard to the fact that the services offered in this case are in essence leisure activities, it is a perfectly logical and reasonable assumption that such a person, of average intelligence and imperfect recollection, in a scenario where s/he may be trying to recall a provider of online poker services having a name comprised of a combination of the words “star” and “poker”, may very well access the domain under the name “**Starpoker**” when actually intending to visit the website under the name “**PokerStars**”, and finding identical services being offered therein, may cost the Complainant her/his custom.

In view thereof, the Respondent’s arguments that the target demographic of the audience for online poker services is literate and educated and further, that accessing either website requires creation of specific login IDs, fails to alleviate this eventuality.

It is also relevant to note that the Respondent has asserted that internet searches conducted for the terms “**starpoker**” and “**pokerstars**” yield results referring specifically to the Respondent’s website and the Complainant’s website respectively, however having regard to the documents tendered by the Complainant that a search for the term “**star poker**”, differing only in the inclusion of a space between the words, yields results referring to both the entities and thereby clearly establishing a likelihood of confusion for the average consumer.

In this regard, it is important to keep in mind that what is required to be established under Paragraph 4(i) of the INDRP is a **likelihood of confusion**, and not the extent of actual confusion per se. Even if not a single case of consumer confusion is reported, as long as a plausible likelihood of confusion of a consumer having average intelligence and imperfect recollection remains, the matter is actionable.

The aforesaid, the Arbitrator believes, also lends credence to the argument put forward by the Complainant that the Respondent’s name/mark “**Starpoker**” is a mere inversion of their prior and established mark “**PokerStars**” and the same is insufficient to constitute dissimilarity obviating the likelihood of consumer confusion. The Arbitrator defers to the following decisions by prior adjudicating forums in all of which it was conclusively held that mere inversion of the component parts of a trademark/domain name cannot protect another party’s trademark/domain name from being considered as infringement of the original trademark/domain name:

- *Burger King Corporation v. Shameek & Anr.* CS (Comm.) 181/2016 before the Delhi High Court <“BURGER KING” v. “KING BURGER”>
- *Giorgio Armani S.p.A. Milan, Swiss Branch Mendrisio v. Jin Yi*; WIPO Case No. D2013-0158 <“EMPORIO ARMANI” v. armaniemporiowatches.net>
- *NCRAS Management, LP v. Cupcake City and John Zuccarini*; WIPO Case No. D2000-1803 <“NATIONAL CAR RENTAL”/nationalcarrental.com v. nationalrentalcar.com>

- *Pearl Jam, A General Partnership v. Peter Lyn, c/o JamPearl Limited*; NAF Claim No. FA0312000221238 <"PEARL JAM"/pearljam.com v. "JamPearl"/jampearl.com>
- *Citibank Privatkunden AG & Co. KgaA v. PrivacyProtect.org*; WIPO Case No. D2010-1147 <"TARGO BANK"/targobank.com v. banktargo.com/banktargo.com>
- *Novartis AG v. Seedy Loveth, ArtisNov Medical Chemical / Privacy Protection Service INC d/b/a PrivacyProtect.org, Domain Admin*; WIPO Case No. D2015-1951 <"NOVARTIS" v. artisnov.com>

The Arbitrator is further of the view that the Respondent's argument that the Complainant cannot predicate its claim on its ownership of the <**pokerstars.com**> domain as the same is not accessible in India due to the same automatically re-directing to the India-specific website, i.e. www.pokerstars.in which is registered in the name of **Sachiko Gaming Private Limited**, is untenable and frivolous.

Re-directing users from one domain to another is a common practice on the internet, especially when both domains belong to the same entity, due to a number of reasons which may be purely technical, statutory or commercial and need not necessarily be mala fide. It is additionally pertinent to mention that using a domain even for the purpose of re-directing internet traffic, nevertheless amounts to use thereof.

The Respondent has not been able to establish the Complainant's prima facie mala fide intentions in so re-directing its Indian users, if any. Further, the Respondent has not been able to suitably challenge the claim of the Complainant of maintaining a licensor-licensee relationship with the entity **Sachiko Gaming**.

In view of the aforesaid, the Arbitrator accepts that the Complainant's rights in its **PokerStars** marks under Paragraph 4(i) of the INDRP has been established.

ii. **The Registrant has no rights and legitimate interest in respect of the domain name (Paragraph 4(ii) and Paragraph 7 of the .IN Domain Name Dispute Resolution Policy)**

The Complainant has established rights in their **PokerStars** marks by virtue of prior adoption, use and registration worldwide, including in India. The Respondent gained registration of the disputed domain name, i.e. <**starpoker.in**> on May 04, 2015 and



STAR
POKER

allegedly applied for registration of the mark **STAR POKER** in the name of the entity **KD Gaming Solutions Pvt. Ltd.** on July 03, 2015.

In this regard, it is relevant to point out that the copy of the Agreement dated May 27, 2015 between Messrs. Sunny and Shammi Karira in respect of rights in the domain <**starpoker.in**> as tendered in evidence by the Respondent is prima facie insufficient to be considered as a binding legal document as the same lacks significant formal requirements such as dating and notarization of signatures of parties and witnesses, verification of contents, registration of the document (as a Memorandum of Understanding pertaining to an intangible asset).

Arora



STAR
POKER


In respect of the registration no. 3001142 for the mark STAR POKER, as the same is owned by an entity not a party to the present proceedings and which is further the subject of separate proceedings before a separate independent adjudicating authority, the Arbitrator herein is not inclined to comment regarding the same.

The Arbitrator is inclined to dismiss the argument that no entity may claim exclusive rights in a composite word combined in any formation of two otherwise generic dictionary words, i.e. "star" and "poker". It is pertinent to point out that such an argument in fact serves to undermine the distinctiveness of the Respondent's alleged



mark STAR POKER.

The Complainant, on the other hand, has evidenced first adoption of the name/mark "**PokerStars**" by virtue of its domain registration for <**pokerstars.com**> as early as March 11, 2001. Further, the Complainant has shown that it owns trademark registrations in India for their PokerStars marks (word and composite logo marks) wherein use is claimed since at least February 15, 2010 (in respect of registration nos.

2446933, 2446934 for the composite mark ) . The Complainant also owns a word mark (registration no. 2446932) for **POKERSTARS** in India since atleast its date of application, i.e. December 21, 2012. The earliest international registration as submitted by the Complainant is US Regn. No. 3381727 dated January 05, 2005 and claiming use in commerce since January, 2005. The Complainant has provided evidence that it sponsored a live poker championship tournament on June 21-24, 2012 on the Casino Royale Cruise Ship at Miramar Beach, Goa, which even pre-dates the Complainant's trademark applications in India.

Notable judgements delivered by the highest courts of the land, including the Hon'ble Supreme Court of India, inter alia in *N.R. Dongre v. Whirlpool Corporation* (1996) 5 SCC 714; *Milmet Oftho Industries v. Allergan Inc.* (2004) 12 SCC 624; and *Neon Laboratories Ltd. v. Medical Technologies Ltd.* 2015 (64) PTC 225, have upheld the preference given to prior users of a trademark. In fact, in the judgement delivered in the afore-mentioned case of *Neon Laboratories Ltd. v. Medical Technologies Ltd.*, Hon'ble Vikramajit Sen, J. held that: "*The 'first in the market test' has always enjoyed pre-eminence.*"

In view of the aforesaid, the Arbitrator is of the view that the Complainant has sufficiently established that its rights in the name/mark "**PokerStars**" significantly pre-date the earliest date from which the Respondent can claim rights in the name/mark "**Starpoker**."

The Arbitrator is also inclined to dismiss the Respondent's argument that the Complainant has been unable to establish sufficient trans-border spill-over reputation in India as on the date when the Respondent had adopted their name/mark "Starpoker" in accordance with the ruling laid down by the apex court in the case of *Toyota Jidosha Kabushiki Kaisha v. Prius Auto Industries Ltd. & Ors.* (2018) 2 SCC 1. The Complainant has already put forward evidence of their long-standing adoption and use of their **PokerStars marks** in respect of offering poker services worldwide, including through the internet as well as events in India, significantly prior to the Respondent's earliest claim of adoption of their name/mark "**Starpoker**".

It is pertinent to mention in this regard that the Respondent has not tendered evidence in support of its contention that the Complainant entered the online poker market only in April, 2018. In view of the absence of adequate refutation from the Respondent thereof, the Arbitrator is inclined to accept the Complainant's claims of prior use of their **PokerStars marks** in India as dating back to February 15, 2010 and actual use as of June 2012.

In light thereof, the Arbitrator concludes that the Respondent's reliance on the tenets of the judgement in the case of *Toyota Jidosha Kabushiki Kaisha v. Prius Auto Industries Ltd. & Ors* is erroneous and unsubstantiated, therefore not maintainable.

The Complainant has contended, with substantiating arguments, that there is no credible or legitimate reason for the Respondent to have adopted a domain name confusingly similar to the Complainant's **PokerStars marks** other than to ride on the goodwill and reputation accumulated by the Complainant's mark by the time of the Respondent's registering the disputed domain name, and to derive unjust enrichment therefrom by causing consumer confusion.

The Complainant has established a prima facie case of its rights in their **PokerStars marks**, as has been mentioned above. Therefore, in accordance with the holding of previous panels under the INDRP, the evidentiary burden shifted to the Registrant (Respondent) to rebut the showing by providing evidence of its rights or legitimate interests in the domain name, which it has failed to do in the current proceedings.

As referred above, the Respondent has also failed to provide a credible nexus between himself and the entity **KD Gaming Solutions Pvt. Ltd.** as the Agreement tendered as evidence therefor is ex facie insufficient to be considered as a valid legal document.

Additionally, the Respondent has not been able to establish any of the conditions pre-requisite for considering a registrant's rights and legitimate interests in a domain name as set out under Paragraph 7 of the INDRP. In fact, the Respondent's contentions as exhibited in the rebuttal dated September 14, 2018 are predicated on flimsy and frivolous technical grounds and do not serve to establish their rights or any bona fide intentions regarding the disputed domain name.

Use of a confusingly similar domain name by the Respondent is likely to mislead and misrepresent to the general public and members of the trade as to the source, sponsorship, affiliation or association of the activity being carried on through the website.

In view of the aforesaid, the Arbitrator accepts the Complainant's claim that the Respondent has no rights or legitimate interests in the disputed domain name in accordance with Paragraph 4(ii) and 7 of the INDRP.

iii. The Registrant's domain name has been registered or is being used in bad faith (Paragraph 4(iii) and Paragraph 6 of the INDRP)

The website hosted at the impugned domain <starpoker.in> offers internet users services in the nature of skill-based games including poker. The services offered vide the afore-mentioned website are identical to those offered by the Complainant on its **PokerStars** websites. Therefore, and further in light that "**Starpoker**" has been established as being confusingly similar to "**PokerStars**", the Respondent has not been able to dispel the argument that their adoption of the same is in bad faith and intended to "piggy-back" on the Complainant's reputation and goodwill and derive unjust enrichment therefrom.


Nowhere in his submissions throughout the proceedings has it been denied that the object of registering the disputed domain by the Respondent was for the purpose of deriving monetary gain therefrom by way of providing services identical to those offered by the Complainant. While this may ordinarily be a perfectly legitimate practice, under the present facts and circumstances, where it has been established that the disputed domain is confusingly similar to trademarks in which the Complainant holds prior and exclusive rights, the activities of the Respondent with regard to the disputed domain cannot be given the benefit of doubt.

Further, the Complainant has sufficiently established vide its submissions that it possessed sufficient reputation and goodwill in the online poker market under its **PokerStars** marks as on the date of registration of the disputed domain name by the Respondent to render it highly unlikely that the Respondent would not be aware of the said marks. Therefore, the Respondent has failed to satisfy the Arbitrator that its adoption and registration of the disputed domain was honest and bona fide.

In view of the aforesaid discussion, the Arbitrator is inclined to agree with the contentions of the Complainant as the Respondent has not been able to adduce sufficient reason or evidence either vide its statement in reply dated August 24, 2018 or its rebuttal dated September 14, 2018 to preclude allegations of bad faith/ mala fide intent around the registration of the disputed domain name to the satisfaction of the Arbitrator.

The facts of the Respondent's adoption and use of the confusingly similar name/mark "**Starpoker**" in respect of identical services as offered by the Complainant under its established trademark since 2001 and his unsubstantiated claim of entering into a lawful agreement for assignment of his rights in the disputed domain <starpoker.in> to his brother for the purpose of providing such services for monetary gain, all contribute towards exhibiting the mala fide intent of the Respondent in this regard.

In view of the aforesaid, the Arbitrator concludes that the Complainant has satisfactorily proved the requirements of Paragraph 4(iii) and Paragraph 6 of the INDRP.



The Arbitrator would also like to mention that as the submissions presented by both the Complainant and the Respondent in the present proceedings were considered comprehensive enough, the Arbitrator did not feel the need for conducting oral hearings in respect thereto.

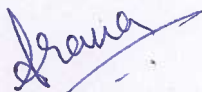
11. Decision

Based upon the facts and circumstances and further relying on the materials as available on the record, the Arbitrator is of the view that the Complainant has herein been able to prove conclusively that:

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

The Arbitrator therefore allows the prayer of the Complainant and directs the .IN Registry to transfer the domain <starpoker.in> to the Complainant.

The Award is accordingly passed and the parties are directed to bear their own costs.



Lucy Rana

Sole Arbitrator

Date: October 01, 2018

Place: New Delhi, India.