

ADMINISTRATIVE PANEL DECISION

Google LLC v. Nithin Babu, Cloudmax
Case No. D2024-0165

1. The Parties

The Complainant is Google LLC, United States of America (“United States”), represented by Fidus Law Chambers, India.

The Respondent is Nithin Babu, Cloudmax, India.

2. The Domain Name and Registrar

The disputed domain name <googlerepairkerala.com> is registered with Wix.com Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 16, 2024. On January 16, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 18, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on January 24, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 13, 2024. The Respondent sent an informal email communication on January 22, 2024.

The Center appointed Luca Barbero as the sole panelist in this matter on February 29, 2024. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant, established in 1998, owns and operates one of the most highly recognized and widely used internet search engines in the world, available in 150 languages, under the trademark GOOGLE.

In addition to search technologies and related activities, the Complainant is well-known for a wide range of goods and services, including cloud computing and software, online advertising, web browser software, email services as well as for a range of electronic devices such as laptops, accessories, smartwatches, and smartphones under the mark PIXEL.

Valued at USD 281.3 billion in 2023, over the years the Complainant has been widely recognized in many world rankings, being placed at the 4th position in the Interbrand “Best Global Brands” reports in 2021 and 2022, 4th among the “World’s Best Employers” Forbes study in 2022, and 8th amongst the “Best Places to Work” Glassdoor report in 2022. The GOOGLE brand was ranked the 2nd most valuable brand in the world, being valued at USD 207.5 billion according to the Forbes report in 2020, and the 1st most valuable global brand according to the “Brand Finance Global 500” report in 2023.

In addition, SimilarWeb, a web traffic ranking company, lists the GOOGLE search engine as the most-visited website for many countries, including India, where the Respondent is based.

The Complainant is the owner of several trademark registrations for GOOGLE, including the following, as per trademark registration certificates submitted as annex J and K to the Complaint:

- India trademark registration No. 845641 for GOOGLE (word mark), filed on March 12, 1999, in international class 9;
- India trademark registration No. 1480385 for GOOGLE (semi-figurative mark), filed on August 21, 2006, in international class 38;
- India trademark registration No. 3178084 for GOOGLE (semi-figurative mark), filed on February 05, 2016, in international classes 09, 25, 35, 36, 38, 39 and 42;
- India trademark registration No. 2378924 for GOOGLE (word mark), filed on August 13, 2012, in international class 39.
- European Union trademark registration No. 001104306 for GOOGLE (word mark), filed on March 12, 1999 and registered on October 7, 2005, in classes 9, 35, 38 and 42;
- United States trademark registration n. 2954071 for GOOGLE (word mark), filed on September 18, 2001 and registered on May 24, 2005 in international classes 9, 11, 12, 16, 18, 21, 25, 28 and 35.

The Complainant also owns, amongst others, the India trademark registration No. 3755867 for GOOGLE PIXEL (word mark), filed on February 16, 2018, in international class 9.

The Complainant is also the owner of the domain name <google.com>, which was registered on September 15, 1997, and is used by the Complainant in connection with its well-known search engine accessible on a global scale.

The disputed domain name <googlerepairkerala.com> was registered on January 19, 2021, and does not currently resolve to an active website. However, according to the screenshots provided in Annex Q to the Complaint – which have not been contested by the Respondent -, the disputed domain name was pointed prior to the present proceeding to a website publishing the Complainant’s trademarks and promoting repair services for GOOGLE PIXEL smartphones.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name <googlerepairkerala.com> is confusingly similar to the trademark GOOGLE in which the Complainant has rights as it reproduces the trademark in its entirety with the mere addition of the descriptive term "repair", the geographical indicator "Kerala" (a State of India) and the generic Top-Level Domain ("gTLD") ".com".

The Complainant further submits that the use of the trademark GOOGLE along with a geographical name 'Kerala', does not, in any manner, assist in differentiating the trademark GOOGLE from the disputed domain name and that on the contrary, it suggests falsely that the disputed domain name is an extension of the already existing and well-known trademark GOOGLE.

The Complainant states that the Respondent has no rights or legitimate interests in respect of the disputed domain name because: i) the Respondent is in no way authorized, affiliated with, associated with or otherwise endorsed by the Complainant; ii) the Respondent is not commonly known by the disputed domain name; iii) by using the disputed domain name, incorporating the Complainant's well-known trademark GOOGLE, in connection with a website publishing the Complainant's trademarks and offering repair services for the Complainant's GOOGLE PIXEL mobile phones, the Respondent has clearly intended to attract users to its website, by deliberately attempting to pass off its repair services as those of the Complainant.

With reference to the circumstances evidencing bad faith, the Complainant indicates that, in view of the fact that i) the Complainant has been offering services under the trademark GOOGLE for over two decades gaining strong reputation and goodwill in its brand; ii) the disputed domain name comprises the Complainant's registered and well-known GOOGLE mark; ii) the website to which the disputed domain name redirected published the Complainant's trademarks and promotes a repair service for the Complainant's GOOGLE PIXEL mobile phones, whilst also offering for sale accessories under the GOOGLE PIXEL mark, the Respondent cannot credibly claim to have been unaware of the Complainant at the time of registering the disputed domain name and, indeed, acted in opportunistic bad faith.

The Complainant informs the Panel that it attempted to settle the matter by sending a legal notice to the Respondent, requesting the takedown of the website, to which the Respondent failed to reply.

The Complainant contends that the Respondent is intending to take undue advantage of the Complainant's goodwill and reputation in an attempt to profit from the likelihood of association with the Complainant, as users visiting the Respondent's website may have been induced to believe that the Complainant had licensed its trademarks to the Respondent and/or that the Respondent had some connection with the Complainant in terms of a direct nexus or affiliation.

B. Respondent

The Respondent sent an informal email on January 22, 2024 stating "We have renewed our domain 'www.googlerepairkerala.com' on 20th January 2024. Still now its down. What should i need to activate it?". There were no additional emails from the Respondent.

6. Discussion and Findings

According to paragraph 15(a) of the Rules: "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable." Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

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

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. Indeed, the Complainant has provided extensive evidence of ownership of valid trademark registrations for GOOGLE (Annexes J and K to the Complaint).

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of the descriptive term "repair" and the geographical term "Kerala" (a State of India) may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

In addition, the gTLD ".com" can be disregarded under the first element confusing similarity test, being a standard registration requirement. [WIPO Overview 3.0](#), section 1.11.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

According to the evidence on record, there is no relationship between the Complainant and the Respondent, and the Complainant has not authorized the Respondent to register or use its trademark or the disputed domain name.

Moreover, there is no element from which the Panel could infer a Respondent's right over the disputed domain name, or that the Respondent might be commonly known by the disputed domain name.

The disputed domain name is currently not resolving to an active website. However, prior to the present proceeding, it resolved to a website publishing the Complainant's trademarks and promoting repair services for the Complainant's GOOGLE PIXEL smartphones, without providing any disclaimer of non-affiliation with the Complainant (Annex Q to the Complaint). The Panel finds that such use of the disputed domain name does not amount to a bona fide offering of goods or services or a legitimate non-commercial or fair use without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark.

Indeed, the Respondent's prior use of the disputed domain name did not meet the cumulative requirements set forth in the leading case *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) for a distributor or reseller by making a bona fide offering of goods and thus have a legitimate interest in a domain name. As stated in section [WIPO Overview 3.0](#), section 2.8.1 "(i) the respondent must actually be offering the goods or services at issue; (ii) the respondent must use the site to sell only the trademarked goods or services; (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark". These requirements are not cumulatively fulfilled in the present case since the disputed domain name was used in connection with a website suggesting that it was an official site of the Complainant or of one of its affiliated entities, by reproducing the Complainant's trademarks without providing a clearly visible and prominent disclaimer of association (or lack thereof) with the Complainant.

The Panel also notes that the disputed domain name, incorporating the Complainant's registered and well-known trademark in combination with a term indicating services related to the Complainant and a geographical term, is inherently misleading. Even where a domain name consists of a trademark plus an additional term, UDRP panels have largely held that such composition cannot constitute fair use if it suggests sponsorship or endorsement by the trademark owner. [WIPO Overview 3.0](#), section 2.5.1.

Therefore, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In view of the prior registration and use of the Complainant's trademark GOOGLE in connection with the Complainant's famous search engine and the additional products and services provided by the Complainant under the trademark GOOGLE on a global scale, the Panel finds that the Respondent was or could have been aware of the Complainant and its trademark at the time of registration of the disputed domain name. The mere registration of a domain name that is identical or confusingly similar to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith. [WIPO Overview 3.0](#), section 3.1.4.

Moreover, considering the composition of the disputed domain name, entirely reproducing the trademark GOOGLE, and the Respondent's use of the Complainant's trademarks on the website to which the disputed domain name resolved, promoting repair services for the Complainant's GOOGLE PIXEL products, the Panel finds that the Respondent clearly registered the disputed domain name having the Complainant and its trademark in mind.

Furthermore, in view of the notoriety of the Complainant's trademarks, the Panel finds that the Respondent acted in opportunistic bad faith at the time of registration, since the disputed domain name is so obviously connected with the Complainant that its selection by the Respondent, who has no connection with the Complainant, suggests the disputed domain name was registered with a deliberate intent to create an impression of an association with the Complainant.

The Panel further finds that, in view of the prior use of the disputed domain name in connection with the website described above, publishing the Complainant's trademarks and promoting repair services of the Complainant's products without providing any disclaimer of non-affiliation with the Complainant, the Respondent intentionally attempted to attract internet users to its website for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of its website and the services promoted therein according to paragraph 4(b)(iv) of the Policy.

The disputed domain name is currently not resolving to an active website. Prior Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. In view of the distinctiveness and reputation of the Complainant's trademark, the composition of the disputed domain name, the prior use of the disputed domain name demonstrated by the Complainant and the Respondent's failure to submit a Response to provide any evidence of actual or contemplated good faith use, the Panel finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Therefore, the Panel finds that the Complainant has established the third element of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <googlerepairkerala.com> be transferred to the Complainant.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: March 14, 2024