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BEFORE THE INTERNET EXCHANGE OF INDIA

ARBITRATION AWARD

ARBITRATOR: S.SRIDHARAN

DATED: 27<sup>th</sup> September 2007

NOKIA Corporation, Finland

: Complainant

Versus

Wang Shaohui, China

: Respondent

*Sridharan*

*Arbitration for*

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**NOKIA Corporation, Finland : Complainant**

**Versus**

**Wang Shaohui, China : Respondent**

**1. The Parties**

1.1 The Complainant is NOKIA Corporation, a corporation organized and existing under the laws of Finland, having its registered office at Keilalahdentie 4, 02150 Espoo, Finland, represented by its counsel, Mrs. Dahlia Sen Oberoi of Sen - Oberoi, Attorneys-at-Law, A-18, Chittaranjan Park, New Delhi -110 019.

1.2 Respondent is Wang Shaohui of Shanghai, a resident of Room 102 ,No 19, Keyuan Village, Guangshengyuan Road, Shanghai, China (CN).

**2. The Domain Name and Registrar**

2.1 The disputed domain name <vertu.in> is registered with Direct Information Pvt. Ltd.

**3. Procedural History**

*Sridharan S*

*Arbitrator*

- 3.1 On 14<sup>th</sup> August 2007, the Arbitrator sent a signed statement of acceptance and Declaration of Impartiality and Independence. On 17<sup>th</sup> August 2007, the Arbitrator received hardcopy of the Complaint along with Annexures.
- 3.2 On 20<sup>th</sup> August 2007, the Arbitrator issued by mail a Notice to the Respondent setting forth the relief claimed in the Complaint and directing him to file his reply to the Complaint within 15 days.
- 3.3 On 20<sup>th</sup> August 2007, the arbitrator sent a mail to the Complainant to send an electronic version of the Complaint, preferably as a word document to the Arbitrator at the earliest.
- 3.4 On 21<sup>st</sup> August 2007, the Complainant sent an electronic version in a word file of the Complaint to the Arbitrator.
- 3.5 On 27<sup>th</sup> August 2007, the Respondent sent his reply to the Complainant. The reply was not in English except a table of information made available by the United States Patents and Trade Marks Office. On the same day, the Arbitrator advised, by mail, the Respondent to send a reply in English.
- 3.6 On 31<sup>st</sup> August 2007, the Respondent sent a mail stating that he was not so good in English and therefore he could not sent a reply in English.
- 3.7 On 1<sup>st</sup> September 2007, the Arbitrator sent a mail advising the Respondent that he was entitled to contest the complaint. But representations in a language other than English would not be considered. The Arbitrator had taken note of his reply submissions in English. Respondent might seek further time to send a translated copy of his reply.

*Sudharans*

The Arbitrator would consider such request and might grant him additional time to fully and effectively represent his case.

3.8 On 1<sup>st</sup> September 2007, the Arbitrator sent a mail advising the Complainant to send her submissions to the contents of the reply in English within 10 days.

3.9 On 3<sup>rd</sup> September 2007, the Respondent sent a translated copy of his reply to the Complaint. On the same day, the Arbitrator sent a mail advising the Complainant to send her submissions, if any, to the reply of the Respondent, within 10 days.

3.10 The Complainant has sent a reply to the Respondent's response.

3.11 The Respondent informed the Arbitrator that he was not any more willing to negotiate with the Complainant.

#### 4. **Factual Background**

##### A **Complainant**

4.1 The Complainant is a leading manufacturer of mobile phones and accessories. The products are available for sale in nearly all countries of the world. The Complainant has one-third of the world's market share for mobile phones.

The Complainant is famous and well known in most of the countries of the world, including India.

*Sudhakarans*  
*Arbitrator*

- 4.3 In 2002, the Complainant formed a fully owned subsidiary VERTU Ltd., as a part of its fashion luxury initiative, and launched mobile phones under the trade name VERTU.
- 4.4 In 2006, VERTU Ltd. merged into the Complainant.
- 4.5 As a result of such long and continuous use, members of the public associate the mark VERTU exclusively with the Complainant. The famous mark VERTU not only makes an immediate association with the product / services of the Complainant but also assures the consumer that each product / service bearing this mark is of the utmost quality and would guarantee complete consumer satisfaction.
- 4.6 People across the globe associate the name VERTU exclusively with the Complainant and the goods, services and activities of the companies belonging to it.
- 4.7 The Complainant has several registrations and applications for the mark VERTU, VERTU ASCENT COLLECTION, VERTU (in Chinese characters) and VERTU figure, in many countries around the globe.
- 4.8 Complainant's VERTU marks under the Madrid Protocol are attached at Annexure 4. A list of Complainant's international trademark registrations/applications around the world is attached at **Annexure 5**. A copy of the duly executed Deed of Assignment is attached at **Annexure 6**. The Complainant has also registered numerous domain names worldwide containing the VERTU trademarks such as [www.vertu.com](http://www.vertu.com).

*Sudhanshu*  
*Arbitrator*

www.vertu.com.es, www.vertu.fi, www.vertu.ro etc. Copies of the WHOIS search results for a selection of those domain names, along with a list of domain name registrations in the name of the Complainant, are attached at **Annexure 7**.

The present Complaint is instituted on account of misappropriation of the trademark **VERTU** as part of its domain name by the Respondent.

**B. Respondent**

4.11 Respondent has said nothing about the background leading to the adoption of the disputed domain name <vertu.in> in his reply to the Complaint.

**5. Parties Contentions**

**A Complainant**

5.1 The Complainant has prior rights in the VERTU trademarks, which precede the Respondent's registration of the disputed domain name.

5.2 The Complainant's trademarks are present in many countries around the globe for VERTU including China, where the Respondent is located and are well-known throughout the world.

5.3 The disputed domain name <vertu.in> is visually, conceptually and phonetically identical to the Complainant's well known and highly distinctive trade mark VERTU.

5.4 The registration of the disputed domain name <vertu.in> is likely to falsely lead the public into believing that the Respondent and the website under



the disputed domain name is sponsored by or affiliated to or associated with the Complainant, and will lead to confusion and deception.

5.5 The Respondent's registration and use of the disputed domain name is a clear case of cyber-squatting, whose intention is to take advantage of the Complainant's substantial reputation and its prominent presence on the Internet.

5.6 The Respondent has not entered into any sort of business activity till date, under the website bearing the disputed domain name. The disputed domain name leads to a non-active web site displaying an offer for sale of the said domain name. The Complainant has attached the print out of the offer of the Respondent for sale of the disputed domain name at Annexure 8.

5.7 Therefore, the Respondent's use of the disputed domain name is not bona fide. The Respondent does not use the domain name in connection with the *bona fide* offering of goods or services.

5.8 The Respondent is aware that VERTU corresponds to a trademark. There is no license, consent or other right by which the Respondent would have *been* entitled to register or use identical domain name as that of the Complainant's trademark VERTU.

5.9 The Respondent has no legitimate interest in respect of the domain name <vertu.in> and has registered this domain name with the intention to

Sridharan  
Assistant

divert consumers and to prevent the Complainant from reflecting the mark in a corresponding domain name.

5.10 Any Internet user who will try to connect to the above mentioned web site will believe that since the Complainant has presence in many countries of the world and is the proprietor of various domain names, the disputed domain name will signify the presence of the product in India through the Respondent. This will dodge the customer's mind into believing that there is a trade connection between the Respondent and the Complainant. The registration of the disputed domain name is likely to falsely lead the public to believe that the Respondent to which the Domain Name directs is sponsored by or affiliated to or associated with the Complainant.

**B. Respondent**

5.11 The Respondent admitted that VERTU is the trademark of the Complainant. The Respondent admitted that the trademark of the complainant is as same as the Respondent's domain <vertu.in>

5.12 The Respondent has the legal ownership in the disputed domain name and it will not offend against the trademark of the Complainant.

5.13 Respondent regarded the word VERTU as a generic word. "VERTU" in Latin refers to the love and knowledge of beautiful objects of art and antiquities.

5.14 In US, the word VERTU is registered in class 25 in the name of a person other than the Complainant.

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Arbitrator



5.15 As a generic word, the trademark VERTU is not fully owned by the Complainant. Even though the Complainant have the trademark VERTU it does not have the exclusive right of owning a generic word

5.16 Some top TLD and ccTLD domains like Vertu.net, Vertu.org are not owned by the Complainant.

5.17 Since the word VERTU is generic, the Respondent's registration of the disputed domain name Vertu.in cannot be a violation of the trademark of the Complainant.

5.18 The .IN extension stands for India and the IN domain registration are open to all over the world. The Respondent surely has the freedom and right to register the .IN domain name. This right should be free from the Respondent's Chinese background. So the Respondent thinks it is unfair and offensive that the Complainant aimed the Respondent's Chinese background.

5.19 The domain parking is a new business provided by many internet service providers such as Sedo.com, Parked.com, Google & etc. Domains like vertu.co.uk , Vertu.net which are not owned by the complainant have been parked or built for a website. So it is unfair and unjust to judge the Respondent in bad faith of parking the domain <vertu.in>

5.20 The Respondent is willing to negotiate with the Complainant.

## 6. Discussion and Findings

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Arbitrator

6.1 The Complainant in order to succeed in the Complaint must establish under Para 4 of .IN Domain Name Dispute Resolution Policy (INDRP) the following elements:

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

6.2 Each of the aforesaid three elements must be proved by a complainant to warrant relief.

***Disputed domain name is identical or confusingly similar to a trade mark of the Complainant***

6.3 The Complainant is the registered proprietor of the mark Vertu in many countries across the world, including India and China. The earliest of the registrations is of the year 2001. The Disputed Domain Name was registered on 5<sup>th</sup> April 2007. The Complainant is the prior adopter of the mark Vertu. The above facts have established that the Complainant has both common law and statutory rights in respect of its trade mark Vertu.

6.4 The Complainant's mark Vertu is a well known trade mark in India. It is clearly seen that the Disputed Domain Name <vertu.in> wholly

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Arbitrator

incorporates the mark Vertu of the Complainant. The suffix <in> does not distinguish the Disputed Domain Name from the Complainant's trade mark Vertu. Further, the Respondent in his reply categorically admitted that the trademark of the Complainant is as same as the Respondent's domain name <vertu.in>

6.5 I, therefore, find that:

- (a) The Complaint has both common law and statutory rights in respect of its trade mark Vertu.
- (b) The disputed domain name <vertu.in> is visually, conceptually and phonetically identical to the Complainant's prior registered trade mark Vertu.

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

6.6 It is seen that:

- (a) The Complainant is the prior registered proprietor of the mark Vertu and the mark is well known in many countries in the world, including China.
- (b) Respondent is aware that VERTU corresponds to high-end mobile phones;

6.7 The Respondent admitted that VERTU is the trademark of the Complainant.

*Sudhanshu  
Arbitrator*

6.8 The Respondent has not entered into any sort of business activity till date, under the website <vertu.in>. The disputed domain name <vertu.in> lead to a non-active web site. '

6.9 I find that the Respondent had made no bonafide / fair use of the disputed domain name. Further, the Respondent's registration of the disputed domain diverted consumers and prevented the Complainant from reflecting its mark in a corresponding domain name.

6.10 At no point of time the Respondent came forward with the reason for adopting the disputed domain name. Further, the Respondent offered the disputed domain name for sale. It is clearly found that the Respondent adopted the disputed domain name only with an intention to get substantial money from the Complainant for transferring the same.

6.11 Therefore, I conclude that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

***Respondent's domain name has been registered or is being used in bad faith.***

6.12 The Respondent has filed his response. This element will be determined on the basis of the response of the Respondent.

6.13 The Respondent contented that the word VERTU in Latin refers to love and knowledge of beautiful objects of art and antiquities. Therefore, the word VERTU is generic and no one, including the Complainant, can claim monopoly over such a generic word.

*Indharans*  
*Agitator*

- 6.14 Since the word VERTU is generic, the Respondent's adoption of the disputed domain name <vertu.in> cannot be a violation of the trademark of the Complainant.
- 6.15 The Respondent further contended that the word VERTU is registered in class 25 in the United State of America in the name of a third person. It may be noted that the Complainant's business exists in the United State of America also.
- 6.16 Respondent further contended that the domain parking is a new business provided by many internet service providers such as Sedo.com, Parked.com, Google & etc. Even some top TLD and ccTLD domains like Vertu.net, Vertu.org are not owned by the Complainant. Domains like vertu.co.uk , Vertu.net are not owned by the complainant and have been parked or built for a website. So it is unfair and unjust to judge the Respondent in bad faith of parking the domain <vertu.in>.
- 6.17 It is not in dispute that the Respondent offered the disputed domain for sale. It is worth to note that the Respondent initially filed his response in Chinese language. He, however, reproduced in English the registration details of the trade mark Vertu in class 25 in US from the web site of the United States Patent and Trade Marks Office. I had taken note of the English material found in the response and informed the Respondent to sent a translated response so that I would be able to consider his other submissions.

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Arbitrator

- 6.18 The Respondent also sent a translated version of his response. In his response also he repeated his offer of negotiating with the Complainant. But subsequently, he deleted the offer for sale appeared in his web site and declined to extend the offer to negotiate with the Complainant.
- 6.19 The Respondent's last contention is that the .IN extension stands for India and the IN domain registration are open to all over the world. The Respondent surely had the freedom and right to register the .IN domain name. The action of the Complainant is nothing but unfair and offensive and is directed against the Respondent's Chinese background.
- 6.20 But I find no force in any of the Respondent's contentions. The generic or otherwise of the word VERTU is irrelevant so long as there exists registrations for the word VERTU. I find that the existence of registration in favour of a third party for the word VERTU in US, and parking of certain domain names involving the word VERTU are not relevant to the determination of this Complaint. The Respondent, however, is free to agitate these matters, if he wishes, before appropriate forums.
- 6.21 The Respondent failed to come forward with the reason for adopting the domain name <vertu.in>. The very adoption of the domain <vertu.tn> by the Respondent is malafide and is solely influenced by the future sale for a substantial amount of money.
- 6.22 By adopting the disputed domain name <vertu.in> the Respondent denied the Complainant from bona fide using a domain name reflecting his well known trade mark VERTU. It diverted the consumers of the

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Arbitrator

Complainant. It is an opportunistic act and disrupting the Complainant's business.

6.23 The actions of the Respondent should not be encouraged and should not be allowed to continue.

6.24 I do not find that any discrimination is directed against the Respondent's Chinese background. The Complaint is dealt with in accordance with the rule of law enunciated under the Constitution of India and the principles of natural justice. Therefore the Respondent's allegation that he is discriminated against his Chinese background is unfounded.

6.25 The conduct of the Respondent has necessitated me to award costs of the Complaint to and in favour of the Complainant, including the attorney's fee.

## **7. Decision**

7.1 For all the foregoing reasons, the Complaint is allowed as prayed for in the Complaint.

7.2 It is hereby ordered that the disputed domain name <vertu.in> be transferred to the Complainant.

7.3 A sum of US\$10,000/- (US Dollars ten thousand only) is awarded to the Complainant towards the costs of the Complaint, including the attorney's fee.

*Indharam*  
*Arbitrator*