



दिल्ली DELHI

R 688872

VISHESHWAR SHRIVASTAV
SOLE ARBITRATOR
IN

ARBITRATION PROCEEDINGS OF DOMAIN NAME
"solidworks.co.in"

Between

DASSAULT SYSTEMES
SOLID WORKS CORPORATION

...COMPLAINANT

AND

WANGYUAN

...RESPONDENTS

AWARD

1. This Arbitral Tribunal was constituted by nomination of undersigned as the Arbitrator in the aforesaid proceeding vide communication by National Internet Exchange of India herein

after called NIXI. This Tribunal while checking the records of the proceedings, found that there was nothing on record to show that a copy of the complaint has been supplied to the Respondents. Accordingly vide its communication dated 19/10/2011 this Tribunal directed the Complainants to send a copy of their complaint to the Respondents by Courier. The Respondents were given time of seven days after receipt of the complaint to send their Statement of Defense.

2. That the Tribunal in response to its communication received email dated 21/10/2011 from the Complainants stating that they have to implead one Wanguan of U.S. and for the purpose sought time. Accordingly this Tribunal gave them time till 30/10/2011 vide order dated 22/10/2011. The Complainants complied with the order and sent the soft copy by email and hard copy of the complaint to the newly added Respondent via DHL Courier and sent copy of DHL receipt. This Tribunal noted that the DHL Courier Waybill No.7045909975 sent to Respondent was duly received by the Respondent on 31/10/2011. Hence, this Tribunal in terms of the orders passed



by this Tribunal on 09/11/2011 waited for the Respondent's Statement of Defense to the Complaint but to no avail and hence was constrained to reserve it's Award after giving one last & final opportunity to the Respondents till 16/11/2011 to file their Statement of Defense if any.

3. This Tribunal finds that the Complainant had duly complied with the directions of this Tribunal and served the Respondent copy of the Complaint. Besides, copy(s) of the order (s) passed by this Tribunal have also been emailed to the Respondent on their email id's hence it cannot be said that the Respondent is unaware of the proceedings.

4. This Tribunal notes that the Respondent has even after receiving the hard copy of the Complaint and being given two opportunities to send their response/ statement of defense, chose to maintain silence to the reason best known to them. Hence in view of such peculiar facts and circumstances and in view of INDRP which makes it incumbent upon this Tribunal to

decide the controversy within 60 days, this Tribunal accordingly proceeds in the matter as per the material available before it.

DISPUTE

This dispute concerns the domain name '***solidworks.co.in***' that is registered with the .IN Registry.

CLAIM

The complainants claim a right in the said name based on the following assertions as given in their complaint which are briefly as under :

FACTS OF THE CASE AS STATED BY THE COMPLAINANT IS AS UNDER:

1. The Complainant is 'Dassault Systèmes SolidWorks Corporation', and is a corporation organized and existing under and by virtue of the General Corporation Law of the State of Delaware, is claimed to be a world leader in the field of Three-dimensional (3D) Computer Aided Design (CAD) solutions. It is averred that the Complainant was originally incorporated as

'Winchester Design Systems, Inc.' and its founder Mr. Jon Hirschtick recruited a team of engineers for making 3D CAD software that was easy-to-use, affordable and available on a desktop computer. That on March 13, 1995, 'Winchester Design Systems, Inc.' changed its name to '**SolidWorks** Corporation' which on July 31, 2008 was further changed to 'Dassault Systèmes **SolidWorks** Corporation'. The copy(s) of the Certificate of Incorporation of 'Winchester Design Systems, Inc.' along with copies of the Certificates of Amendment evidencing the aforementioned change of names certified by the Office of the Secretary of State, State of Delaware, are attached as **Annexure - A (Colly)** with the complaint.

2. It is stated that the Complainant is a 100% subsidiary of 'Dassault Systèmes S.A.' which was established in 1981 and since its inception, 'Dassault Systèmes S.A.' has helped its industrial customers maximize product design and development. It is averred that the Company introduced its first brand and a leading solution for product design and innovation under the trade mark 'CATIA', which initially focused on the

automotive and aerospace industries. It is further averred that in the year 1997, 'Dassault Systèmes S.A.' acquired 'SolidWorks Corporation' and eventually organized its business into two segments, that is the '**PLM**' ('**Product Lifecycle Management**') **Segment**, which supports its customers' end-to-end product development process, and the '**Mainstream 3D**' **Segment**, dedicated to customers seeking to design products in a 3D design environment, thereby targeting the significant market of companies designing their products in two dimensions (2D) and interested in taking advantage of the power of 3D design. It is also stated that 'Dassault Systèmes S.A.' developed a large and expanding base of brands such as 'CATIA', 'SIMULIA', 'DELMIA' and 'ENOVIA' for its PLM segment and promoted the brand '**SolidWorks**' with respect to its Mainstream 3D business. As of today, the PLM segment of 'Dassault Systèmes S.A.' caters to more than 100,000 customers in 80 countries and 'Dassault Systèmes S.A.' generated revenue of EURO 1563.8 million in the year 2010. It is further averred that in the year 1995, the Complainant released its first software product under the trade mark

'SolidWorks' and within two months, the Complainant's product under the trade mark 'SolidWorks' was winning accolades for ease-of-use, allowing more engineers than ever before to take advantage of 3D CAD in bringing their product designs to life. It is stated that the Complainant's product under the trade mark 'SolidWorks' is committed to providing millions of professionals with an intuitive experience in product design, simulation, publishing, data management, communication, and environmental impact assessment, needed to maximize innovation and productivity. It is also stated that the Complainant's applications under the trade mark 'SolidWorks' provide users with a 3D design process, for which a fully detailed solid model is used to quickly produce drawings and perform downstream design functions and that with the Complainant's solutions, one can deliver compelling product details with representations of 3D models, 2D drawings, animations, and photo-realistic renderings before actual manufacture. It is also stated that 'SolidWorks Simulation', introduced in 2001, enables simulations where a user can set up a virtual real-world environment to test product designs



against a broad range of parameters throughout the design process. Further, the product data management (PDM) solutions under the trade mark 'SolidWorks' enable storage and indexing of design data for fast retrieval, and eliminates concerns about version control and data loss, thereby improving the way teams manage and collaborate on design. 'SolidWorks Enterprise PDM' was introduced in 2006. It is stated that the complainant's other offerings include 'SolidWorks Sustainability' and 'SolidWorks SustainabilityXpress' introduced in 2009.

3. The Complainant further vehemently aver that they have revolutionized the 3D CAD industry and as of today, its customer base spans a plethora of sectors viz., aerospace and defense, alternative energy, automotive and transportation, consumer products, design and engineering services, education, electronics, energy, plant and process, engineering and construction, industrial machinery, medical, oil and gas, and packaging machinery and each year a new version of the Complainant's software under the trade mark 'SolidWorks' is

introduced into the market with new innovations to respond to requirements currently not met by industry solutions. Further, the Complainant focuses on 'ease of use' in its product offerings. They submit that the Complainant's most recent commercial release has been of its software under the trade mark 'SolidWorks 2011' which focuses on enhanced support for manufacturing and improved collaboration and visualization. It is further averred that the Complainant's next commercial release under the trade mark 'SolidWorks 2012' is scheduled for October. Known for working closely with its customers, the Complainant's software under the trade mark 'SolidWorks' (as per the statistics cumulative through second quarter of 2011) has about 1,589,600 passionate and active customers worldwide. The Complainant's rely upon their Fact Sheet as downloaded from its website www.solidworks.com which is

Annexure - B. It is further averred that on January 26, 2011, the Complainant announced the sale of one million licenses in respect of its design software under the trade mark 'SolidWorks' to educational institutions worldwide, including to the Indian Institute of Technology (IIT) – Delhi and for the



purpose they place their reliance on a copy of the press release corroborating the said fact is attached as **Annexure - C**. It is stated that owing to the excellent quality of the Complainant's product under the trade mark 'SolidWorks', today, it commands tremendous popularity and has been sold extensively the world over and the revenue generated by the Complainant's product under the trade mark 'SolidWorks' constitutes approximately 20% of the revenue generated by 'Dassault Systèmes S.A.'. The total revenue generated by the Complainant over the last eight years as portrayed in the complaint is as under:

Year	Revenue (in million EURO)
2003	126.1
2004	146.2
2005	181.8
2006	218.1
2007	255.3
2008	276.5
2009	261.1
2010	311.5

As per the Complaint these figures have been derived from the extracts of the Annual Report of 'Dassault Systèmes S.A.' for the years 2004, 2005, 2006, 2007, 2009 and 2010 are attached

herewith and marked as **Annexure - D (Colly)** with the complaint.

4. It is submitted by the complainant that there is a worldwide acclaim of its product under the trade mark 'SolidWorks' as is reflected by the host of awards received by it which include the "2010 NASA Tech Briefs Readers' Choice Product of the Year" award and the "Control Engineering's 2011 Engineers' Choice Award" in the design, simulation and diagnostics category. It is also claimed that the Complainant was also honoured by 'Design News' magazine as a finalist for the "Golden Mousetrap Best Product" award. Some other honours conferred upon the Complainant in respect of its product under the trade mark 'SolidWorks' is as under:

<u>Year</u>	<u>Award</u>	<u>Description</u>
2010	Design News magazine - Golden Mousetrap Award	'SolidWorks Sustainability' software won the Best Product winner in the CAD Software category
	Global Green Awards 2010	'SolidWorks Sustainability' software won the first ever 'Best New Green Product Innovation' honour

2009	Control Engineering - Engineer's Choice Award	'SolidWorks 2009' for Design Simulation category
2008	Control Engineering - Engineer's Choice Award	'SolidWorks' was selected as the winner of the Application and Programming software categories – Applications category for SolidWorks 2008
	Design News magazine - Golden Mousetrap Award	'SolidWorks 2008 3D CAD software' won Best Product Winner in the CAD software category
	START-IT magazine	One of the 'Hottest Companies'
2007	2007 NASA Tech Briefs - Readers' Choice Product of the year	'SolidWorks 2008 3D CAD software' won the award
	Managing Automation	Progressive Manufacturing Awards
2006, 2004 and 2003	START-IT magazine	One of the 'Hottest Companies'

5. It is stated that the Complainant has invested years of time, capital, efforts, and resources in advertising and promoting its software under the trade mark 'SolidWorks' across the globe through media such as the Internet and magazines having circulation throughout the world, besides, the Complainant also

hosts numerous events throughout the world including the industry's largest annual 3D CAD event called 'SolidWorks World'. Further, the Complainant also organizes 'SolidWorks' user group meetings, trade shows, seminars, online screencasts etc. Copies of brochures/catalogues/pamphlets pertaining to promotion of the Complainant's product under the trade mark 'SolidWorks' and the events organized by it are given as **Annexure – E** with the complaint.

6. It is also submitted that the Complainant's parent company 'Dassault Systèmes S.A.' set up a Liaison Office viz., 'Dassault International' in India as far back as the year 1997 and subsequently, 'Dassault Systèmes S.A.' incorporated 'Dassault Systèmes India Private Limited', which is its 100% subsidiary in India and established a joint venture '3D PLM Software Solutions Ltd.' in which 'Dassault Systèmes S.A.' is a 42% owner. Further, in 2007, 'Dassault Systèmes SolidWorks Corporation' incorporated the subsidiary 'SolidWorks Software Private Limited' before which 'Dassault Systèmes SolidWorks Corporation' had a liaison office at least as early as 2001. To

buttress their contention the complainants rely upon **Annexure - F**. The Complainant's further place reliance on **Annexure - G**. The Complainant also aver that they registered the domain 'solidworks.in' on September 12, 2005 and operate a website thereunder.

7. It is claimed that the trade mark 'SolidWorks' also forms an integral part of the Complainant's corporate name and serves as its principal trade mark and domain name and the trade mark 'SolidWorks' being the most valued intellectual property, the Complainant has taken care to secure statutory rights in the same through trade mark registrations in numerous countries of the world including India and for the purpose reliance is placed on **Annexure - H, Annexure - I (Colly) and Annexure - J (Colly)**
8. It is also stated that in India, the Complainant's trade mark 'SolidWorks' is registered under No. 711137 since April 11, 1996 with respect to '*computer software in the field of computer aided design and user manuals sold as a unit therewith included in Class 9*'. Reliance is placed on **Annexure - K** and



Annexure - L (Colly).

9. It is further averred that the Complainant and its subsidiaries have registered numerous top level domain names (TLDs) such as solidworks.com, solidworks.net, solidworks.org, solidworks.biz, solidworks.tel, solidworks2008.com, solidworks2009.com, etc. in addition to country level domain names (ccTLDs) such as **solidworks.com.hk**, solidworks.asia, solidworks.co.uk, solidworks.eu, solidworks.us, solidworks.de, **solidworks.in**, etc. Reliance is placed on **Annexure - M (Colly)**.
10. It is averred that the websites of the Complainant are extremely popular and are a valuable source of knowledge with respect to the Complainant and its software under the trade mark 'SolidWorks' and the website 'www.solidworks.com' records a significant number of hits every month and, therefore, it is apparent that the goodwill and reputation of the Complainant as regards the trade mark 'SolidWorks' pervades both the real world as well as cyber space. Reliance is placed on decisions passed by the 'National Arbitration Forum' (a dispute resolution

service provider appointed by ICANN) and the 'WIPO Arbitration and Mediation Center' (a dispute resolution body for settlement of international commercial disputes) upholding the Complainant's rights in the trade mark/name/domain name 'SolidWorks' and copies of the decisions are attached as **Annexure – N** with the complaint.

11. It is stated that the Complainant wanted extend its rights on the Internet and sought to register the domain name 'solidworks.co.in'. However, it was shocked and dismayed to learn that the said domain was already registered in the name of 'Zhaojian of San'an Superior Food (Holdings) Limited, A511, Seg Technology Park 3, San'an North Road, Hongkong - 999077' and the same was registered on March 14, 2011 and is due to expire on March 14, 2012. Reliance is placed on **Annexure - O** which is the WHOIS Records.

It is alleged that the activities that were being carried out on the impugned website www.solidworks.co.in, were objectionable and the same were designed to profit financially at the expense of the Complainant. Accordingly, on September 21, 2011, the

Complainant filed a Complaint before the .INRegistry. Reliance is placed on **Annexure - O1** and much to the surprise of the Complainant, pending adjudication of the present proceeding, the impugned domain name 'solidworks.co.in' was transferred in favour of 'Wangyuan of Pfister Hotel, 4400, West National Ave., Milwaukee, WI 53214, U.S.A.'. Reliance is placed upon **Annexure - O2**.

12. It is averred that but for the change of the Registrant, there has been no change *vis-à-vis* the illicit activities being conducted on the impugned website www.solidworks.co.in. The said website contains numerous weblinks comprising the Complainant's trade mark 'SolidWorks' as well as links to competitors and other third party websites. It is alleged that the Registrant is using the objectionable domain name to profit financially from consumer confusion inasmuch as, the Registrant directs the domain to a website that is a parked pay-per-click or sponsored search portal. It is pointed out that the website under the objectionable domain name 'solidworks.co.in' also comprises

links of the Complainant's parent company's trade mark 'CATIA'. Reliance is placed on **Annexure - P (Colly.)**.

13. It is alleged that the erstwhile Registrant had registered several other domain names comprising various third party trade marks/names such as 'fourseason.in' (operator of luxury hotels and resorts), 'embraer.in' (a global aerospace company), 'dole.in' (producer for fruits and vegetables), 'hcltech.co.in' (IT and software development company), 'jabil.in' (an electronics solutions company) and 'acnielsen.in' (a global marketing research firm), etc. All the domains resolve into webpages featuring sponsored listings. Reliance is placed on **Annexure - Q (Colly)** and interestingly, all the aforementioned domain names also stand registered in the name of the Registrant herein. WHOIS details are given as **Annexure - Q1 (Colly)**. Additionally, the Registrant, in furtherance of its *mala fide*, has registered other domain names such as 'marni.in' (fashion designer), 'misssixty.in' (fashion brand), etc. and is operating webpages featuring sponsored listings. Further to buttress their allegation the WHOIS details in respect of **Annexure - Q2**

(Colly) has been filed. The Complainants allege that from the above it is evident that the erstwhile Registrant as well as the Registrant are hand in glove and are habitual cyber squatters who have set out at making illicit gains by registering domain names identical to well-known trade/service marks, corporate names/trading styles, domain names, etc.

The Complainants claim that the impugned domain name is identical to the Complainant's trade mark/name/domain names comprising 'SolidWorks' and in the circumstances, the Complainant wants the Registrant's impugned domain name 'solidworks.co.in' be transferred to the Complainant or the same may be cancelled forthwith.

ORDER

This Tribunal has given an anxious consideration to the allegations of the complainants and has seen that the Respondent despite being aware of the present proceedings and despite being called upon by this Tribunal to give their



Statement of Defense chose not to give any and hence the allegations of the complainants remain un rebutted.

In view of the undisputed weighty evidence of the Complainants this Tribunal holds that the respondent did not have any claim on the domain name '**solidworks.co.in**' hence this Tribunal directs the Registry to transfer the domain name '**solidworks.co.in**' to the complainants. The Complainants too are free to approach the Registry and get the same transferred in their name.

The original copy of the Award is being sent along with the records of this proceedings to National Internet Exchange of India (NIXI) for their record and a copy of the Award is being sent to all the parties for their records

Signed this 30th day of November, 2011.

NEW DELHI
30/11/2011



V. SHRIVASTAV
ARBITRATOR