

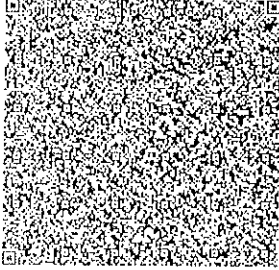
सत्यमेव जयते

INDIA NON JUDICIAL

Government of National Capital Territory of Delhi

e-Stamp

Certificate No. : IN-DL421662214342700
Certificate Issued Date : 26-Apr-2016 02:55 PM
Account Reference : IMPACC (SH)/ dlshimp17/ HIGH COURT/ DL-DLH
Unique Doc. Reference : SUBIN-DLDSLHIMP17833594726888830
Purchased by : SUDARSHAN KUMAR BANSAL
Description of Document : Article 12 Award
Property Description : Not Applicable
Consideration Price (Rs.) : 0
(Zero)
First Party : SUDARSHAN KUMAR BANSAL
Second Party : Not Applicable
Stamp Duty Paid By : SUDARSHAN KUMAR BANSAL
Stamp Duty Amount(Rs.) : 100
(One Hundred only)



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.IN Registry
(NATIONAL INTERNET EXCHANGE OF INDIA)

COMPLAINANT

Vertex Pharmaceuticals Incorporated

Vs.

RESPONDENT

Amanda Davis

ARBITRATION AWARD

S. K. Bansal

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.
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3. In case of any discrepancy please inform the Competent Authority.

.IN Registry
(NATIONAL INTERNET EXCHANGE OF INDIA)

ADMINISTRATIVE PANEL DECISION
SOLE ARBITRATOR: SUDARSHAN KUMAR BANSAL

COMPLAINANT

Vertex Pharmaceuticals Incorporated
50 Northern Avenue
Boston, Massachusetts 02210
USA

Vs.

RESPONDENT

Amanda Davis
2705 Doles Place
Shreveport, LA 71104
United States

ARBITRATION AWARD

1. The Complainant is aggrieved by the Respondents registration of the domain name vertexpharmaceuticals.in registered through the sponsoring Registrar Key-Systems GmbH, Im Oberen Werk 1, 66386 St. Ingbert, Germany and has accordingly made this Complaint seeking the relief that the domain name vertexpharmaceuticals.in (impugned domain name) be transferred to the Complainant with costs.

S. K. Bansal

2. The Complainant has preferred this Complaint on the basis of its claimed proprietorship and ownership rights in the Trade Mark VERTEX, its trade name bearing the word/mark VERTEX as its essential feature as well as on the basis of its numerous domain names bearing the word/mark VERTEX as its essential feature (collectively referred to as the Trademark/Trade Name/Domain Name VERTEX).
3. The Complainant claims to be a globally well-known pharmaceutical company committed to the discovery and development of breakthrough drugs for serious diseases and has been using its aforesaid Trade Mark/Trade Name VERTEX in relation to manufacture and trade of a range of pharmaceutical products in the global markets including in India since the year 1989.
4. The Complainant claims its Trade Mark/Trade name VERTEX to be registered in several jurisdictions of the world including in India. In addition to its rights conferred by Trade Mark registrations under the Trade Marks Act, 1999 the Complainant claims to have acquired a valuable trade, goodwill and reputation under its said Trade Mark/Trade Name/Domain Name VERTEX being used by it in relation to its goods and business. Consequently the Complainant claims to have common law rights in its said Trade Mark/Trade Name/Domain Name VERTEX.

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5. According to the Complainant its said Trade Mark/Trade Name/Domain Name VERTEX in relation to its said goods and business has been and is being well used, well-advertised, is well known, is well established and extremely visible in the market and trade.
6. According to the Complainant its said Trade Mark/Trade Name/Domain Name VERTEX enjoys a very high level of distinctiveness duly identifying its said goods and services in relation to which it is being used as that of the Complainant and from the Complainant's source and origin. The Complainant also claims that its Trademark/Trade name VERTEX enjoys a trans-border reputation. The Complainant further claims products of the Complainant under its Trademark/Trade name VERTEX enjoy a wide reputation and substantial goodwill.
7. The Complainant claims to have registered 2 domain names bearing the word/mark VERTEX namely www.vrtex.com, www.vertexpharmaceuticals.com.
8. The Complainant claims that its rights in the said Trade Mark VERTEX to have been judicially recognized with it by various Arbitral Tribunals and that it has successfully prosecuted and defended its said Trademark in various civil proceedings, opposition proceedings against third party rival use. The Complainant claims to have issued Cease and Desist Letters to various third parties including the Respondent herein. The

S.K. Bhowmik

Complainant claims its Trademark VERTEX to be declared as a well-known Trademark.

9. In support of its rights and use the Complainant has made numerous pleadings and filed numerous documents which would be dealt with in so far as they are relevant, in the course of this award.
10. According to the Complainant, the Respondent's impugned domain name vertexpharmaceuticals.in is identical with and deceptively similar to the Complainant's said Trade Mark/Trade Name/Domain Name VERTEX, being a pirate thereof and is in violation of the Complainant's rights therein. The adoption of the impugned Domain Name is malafide and the same is allegedly being used by Respondent for making illegal gains to trade upon the Complainant's goodwill and reputation attached to the Complainant's said Trade Mark/Trade Name/Domain Name VERTEX resulting in consumer deception and violation and dilution of the Complainant's rights therein. The Respondent's impugned Domain Name and its alleged adoption, use and registration with the sponsoring Registrar is without the leave and license of the Complainant.
11. According to the Complainant the impugned domain name is being intentionally used by the Respondent to establish an association with the Complainant's business under the

S.K. Goyal


mark/name VERTEX by incorporating the name of the Complainant in full in its impugned domain name.

12. The Complainant claims the Respondent to have no rights or legitimate interest in the impugned domain name and the impugned domain name to be registered and/or used in bad faith.
13. The .IN Registry appointed me as an Arbitrator to adjudicate this Complaint in accordance with the Arbitration and Conciliation Act, 1996; .IN Domain Name Dispute Resolution Policy; Rules of Procedure and/or bye-laws, rules and guidelines made therein and notified the factum thereof to the Complainant through its attorneys and authorized representatives, as well as the Respondent vide its email of 31st March, 2016.
14. Thereafter, I issued a notice to the Respondent vide email dated 4th April, 2016 with a copy of the Complaint and documents wherein the Respondent was also notified of me being appointed as an Arbitrator and wherein the Respondent was given an opportunity to submit its written response to the Complaint stating its reply and defense together with documents supporting its position within ten days thereof with copy to the authorized representatives of the Complainant. The Respondent never replied to the said notice and nor submitted its response and documents within the stipulated time. In the interest of justice another opportunity of ten (10) days to file

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the response with documents was given to the Respondent vide my notice dated 14th April, 2016, with copy to the authorized representatives of the Complainant, wherein it was stated that in the event of the Respondent not so filing, the Complaint would be decided on the basis of the material on record filed by the Complainant. The Respondent never filed any response or documents.

15. Consequently I proceed to adjudicate this Complaint on the basis of the material available on the record.
16. The Trade Mark VERTEX is duly registered in India in the name of the Complainant under the Trade Marks Act, 1999 (the Act for short) as per the following:

S.No.	Registration No.	Class	Representation	Date of application
1	1522439	5, 42		18.01.2007
2	1522440	5, 42	VERTEX	18.01.2007

- 16.1 The goods/services covered by said registrations are as under:-

Trade Mark No.	Goods/Services
1522439	Pharmaceutical Research Services in Class 42. Pharmaceutical Preparations in Class 5.

S. K. B. [Signature]

1522440	Pharmaceutical Research Services in Class 42. Pharmaceutical Preparations in Class 5.
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- 16.2 The Trademark Registration under No. 1522440 has been ordered to be associated with Trademark No. 1522439 by the Indian Trademark Office.
- 16.3 The aforesaid registrations, as per the material available on the record, are renewed and subsisting.
17. The Complainant has placed on record copies of Legal Proceeding Certificates issued by Trade Mark Office for the aforesaid Registrations of Trademark VERTEX under Nos. 1522439 and 1522440 under the Trade Marks Act, 1999 as Annexure – H (Colly). Consequently the aforesaid Indian Trade Mark Registrations stand established.
18. These Indian Trade Mark registrations confer valuable rights in the registered Trade Marks upon the Registrant viz. Complainant in this case. These registrations have a presumptive validity attached to them as also they are a presumptive evidence of title in favor of the Registrant [See American Home Products Corporation Vs. Mac Laboratories Pvt. Ltd. & Anr. reported in AIR 1986 SC 137; National Bell Co. Vs. Metal Goods Mfg. Co (P) Ltd. & Anr. reported in AIR 1971 SC 898; Section 2(i) (v), 28 and 29 of the Act].

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19. In my considered view the word/mark VERTEX is a highly arbitrary and fanciful trade mark in relation to the goods/services of the Complainant viz. pharmaceutical products and services as the word/mark VERTEX has no descriptive, suggestive or generic connotation with these products and as such is an inherently strong trade mark and which can be protected and enforced even without evidence of acquired secondary significance. [See McCarthy on Trademarks and Unfair Competition, 3rd Edition, Vol.1, Chapter 11, Para 11.04].
20. The Complainant has placed on record particulars and certificates of its Registration for the Trademark VERTEX in various countries namely Australia, European Union, Germany, Hong Kong, United Kingdom, Israel, Italy, Japan, South Korea, New Zealand, Singapore, Spain, United States, Brazil as Annexure G and some such Registrations are mentioned here as under:

Country	Application No.	Date of Registration	Class
Germany	395	10.01.1995	5, 42
USA	2201590	03.11.1998	5
Australia	834968	12.05.2000	5, 42
New Zealand	690025	12.05.2000	42
	614269	19.08.2003	5

V.K. Gaur

21. As per the search results from the WhoIs database of the .IN Registry pertaining to the impugned domain name vertexpharmaceuticals.in, this domain name is registered in the name of the Respondent with the sponsoring registrar Key-Systems GmbH with the date of creation as 16.03.2015.
22. From the aforesaid registration certificates it can safely be taken that the trademark VERTEX to be in existence at least since the year 2007 in India and since the year 1998 in the USA. In contrast the creation of the impugned domain name as per the aforesaid search results, is only in the year 2015.
23. The Complainant has placed on record documents evidencing Complainant's collaboration with other pharmaceutical companies such as GlaxoSmithKline, Johnson & Johnson and Merck expanding its business under the Trademark/Trading Style VERTEX as Annexure A, these documents are dated 13th December, 2005, 30th June, 2006, 22nd June, 2004; article dated 28th September, 2006 in relation to co-discovery of HIV protease inhibitor, Lexiva by the Complainant with GlaxoSmithKline under its Trademark/Trading Style VERTEX as Annexure B; article dated 20th March, 2014 evidencing the availability of the second book titled "The Antidote: Inside the world of New Pharma" as Annexure F; publications of the year 2015 featured in the Forbes Magazine and New York Times where in the Complainant has been written about as Annexure D. The Complainant has also filed as Annexure K, L, M and N agreements between the Complainant and

J.K. B. [Signature]

companies like Sai Life Sciences Ltd. in the year 2004, GVK Biosciences Private Limited, a leading Contract Research Organization (CRO) in the year 2005, Syngene International Limited in the year 2008 respectively in support of its claim of business interests in India.

24. The Complainant has also filed copies of WhoIs extract as Annexure-P evidencing the Complainant to own 2 (two) domain names containing the trade mark "VERTEX". One such domain name is www.vrtex.com registered with the sponsoring Registrar Ascio Technologies, Inc. with creation date 08.01.2000 which is prior to the date of creation of the impugned domain name as noticed in para 21 above.
25. Many of the aforesaid publications/documents are uploaded on the Complainant's website under the domain name www.vrtx.com which can be accessed to by the general public including the Respondent.
26. Undoubtedly the Complainant's presence on the internet has worldwide reach and access and the aforementioned documents bring out the nature of Complainant's activities and the Complainant to be actively engaged therein under the Trade mark/Trade Name VERTEX. The market and trade in India and in Overseas are well aware of the Complainant and its commercial activity in relation to pharmaceutical products and services under its Trade Mark/Trade Name VERTEX.

J.E. Banerjee

27. The Respondent has not contested the Complainant's aforesaid rights and use including the Complainant's claim of its said Trade Mark/Trade Name/Domain Name VERTEX to be well known, enjoying noticeable distinctiveness goodwill and reputation and presence and visibility in the commercial market and to be in extensive well use world over including in India.
28. The Respondent is conducting unauthorized activities amongst the members of the trade and public by issuing employment offer letters on behalf of the Complainant to create false association between the Complainant and the Respondent. This is apparent from the copy of employment offer letter issued by the Respondent and filed as Annexures S of the Complaint which the Complainant says to be unauthorized and without its consent. In this letter, the Respondent has mentioned its E-mail ID as Amanda@vertexpharmaceuticals.in, where it can be so contacted. According to the Complainant, this activity of the Respondent is without the Complainant's leave and consent. The Complainant has also pleaded that the impugned Domain name and its registration with the sponsoring registrar is without the leave and license of the Complainant.
29. In my considered view there is a complete identity- phonetic, visual, structural and conceptual between the Complainant's Trade Mark/Trade Name/Domain Name VERTEX and the impugned domain name vertexpharmaceuticals.in of the Respondent. The impugned domain name bears the word/mark VERTEX as its essential and memorable feature. The

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impugned Domain name also bears the Complainant's corporate name VERTEX PHARMACEUTICALS. It is with respect to the word/mark VERTEX that the impugned domain name would be remembered and with reference to which the internet user(s) would access the internet services being offered by the Respondent. It is with reference to the word/mark VERTEX that an average consumer exercising average caution would remember the Complainant or the Respondent or would do business with them. VERTEX as noted above is the Trade Mark/Trade Name/Domain Name of the Complainant and in which the Complainant has undisputed proprietary rights. **[K.R. Chinna Krishna Chettiar Vs. Sri Ambal and Co and Anr. AIR 1970 SC 146 ; Ruston & Hornby Ltd., Vs. Zamindara Engineering Co., 1970 (2) SCR 222 ; (B.K. Engineering Company v/s U.B.H.I. Enterprises (Regd). Reported in AIR 1985 Delhi 210 (DB) ; Kirorimal Kashiram Marketing & Agencies Pvt. Ltd., Vs. Shree Sita Chawal Udyog 2010 (44) PTC 293 (Del.) (DB)].**

30. Having regard to the complete similarity/identity between the Complainant's Trade Mark/Trade Name/Domain Name VERTEX and the impugned domain name vertexpharmaceuticals.in of the Respondent, an average consumer with imperfect memory would be led into believing that some nexus association or connection exists between the Complainant and the Respondent or of the impugned domain name to be in fact of the Complainant or sponsored, licensed or affiliated with the Complainant or an extension of the

V. L. Brown

Complainant's business, while in fact it is not so. This is more so as the Respondent is offering false employment offer letters on behalf of the Complainant. This would invariably give rise to consumer deception. [Montari Overseas Ltd., Vs. Montari Industries Ltd., 1996 PTC (16) 142 Del (DB) ; (McCarthy on Trademarks and Unfair Competition, 3rd Edition, Volume 3, Chapter 24, Para-24.03).]

31. Not only that any consumer or internet user seeking access to the Complainant or its products with reference to the Trade Mark VERTEX online, would be misled to the Respondent's website, in case they erroneously or inadvertently suffix the "second level" domain name viz. VERTEX with the cc TLD (country code top-level domain) .in instead of gTLD (generic top-level domain) .com. The user/consumer would be deceived by being led to somewhere else or in not reaching the Complainant.
32. The Complainant would have no control over the Respondent or over the standard or quality of the goods/services being offered by it under the impugned domain name. Any inferior or unauthorized services offered by the Respondent, as in this case unauthorized employment offer letters, would invariably adversely affect the Complainant's business and reputation under the said word/mark VERTEX as any person availing this service will be deceived as these services are not being offered by the Complainant. Not only that any internet user who may erroneously access the Respondent while intending to access

J.C. Brown

the Complainant can be led by the Respondent to a competitor/rival of the Complainant which would invariably cause business and clientele loss to the Complainant. All these activities would invariably and irreparably tarnish the goodwill, reputation and standing of the Complainant and its business; diminish the capacity of the Complainant's said Trade Mark/Trade Name/Domain Name VERTEX to identify and distinguish the Complainant's goods/services and would considerably dilute, eclipse and tarnish the strength and value of the Complainant's said Trade Mark/Trade Name/Domain Name. Not only that even the consumers would suffer as they would not get what they expected and instead would be deceived. Consumer deception and loss and injury being caused to the Complainant as well as to the consuming public is inevitable.

33. As noticed above in para 16 the Trade Marks VERTEX are duly registered in India under the Act. The impugned domain name bearing the identical registered trade mark of the complainant would be in complete violation of the said registered trade-marks of the Complainant (Section 29 of the Act) [See Lt Foods Limited Vs. Sulson Overseas Pvt. Ltd. reported in 2012(51)PTC 283(Del)].

34. Even a close similarity of the domain names can lead to the presumption of association between the two competing entities by the public and qualifies as deception or why else would the Respondent choose such a deceptively similar domain name

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[Marks & Spencer Vs. One-In-A Million reported in 1998 FSR 265].

35. A right in the Trade Mark/Trade Name/Domain Name can be violated even by the use of the Trade Mark/Trade Name/Domain Name as a part of a rival domain name and that a probability/likelihood of consumer deception is the test and not actual consumer deception. A right in the Trade Mark and especially in the registered Trade Mark has to be protected even if it is being used as a material part of a rival domain name. [See Bharti Airtel Limited Vs. Rajiv Kumar-2013 (53) PTC 568(Del); Tata Sons Limited Vs. D. Sharma & Anr.-2011 (47) PTC 65(Del.); Dr. Reddy's Laboratories Limited Vs. Manu Kosuri & Anr.-2001 PTC 859 (Del); Mars Incorporated Vs. Kumar Krishna Mukherjee & Ors.-2003 (26) PTC 60 (Del)]
36. In my considered view, the Respondent's very adoption of the impugned domain name and its registration is in bad faith actuated by malafide and fraud. There is no element of good faith, good intention or honesty involved. The Respondents are guilty of cyber piracy which in itself is a facet of bad faith and that the Respondent has no legitimate right or interest in the impugned domain name. This is for the following reasons :-
- (a) The Respondent has not furnished any explanation or reason on its adoption of an identical prior Trade Mark/Trade Name/Domain Name VERTEX of the Complainant.

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- (b) The Trade Mark/Trade Name/Domain Name VERTEX is an extremely, arbitrary, fanciful, trademark in relation to the nature of the goods/services being offered by the Complainant there under. The said Trade Mark/Trade Name/Domain Name is consequently a highly strong and inherently distinctive trademark.
- (c) The Respondent was well aware of or ought to have been aware of or could have become aware of the Complainant's said Trade Mark/Trade Name/Domain Name. The Respondent who has registered the impugned Domain Name must be an internet user or having knowledge and interest in the internet and awareness of the concepts of E-commerce and online markets actuated through the internet medium triggered through domain names.
- (d) The Respondent's prior knowledge of the Complainant's VERTEX Trade Mark/Trade Name/Domain Name also stand established by the fact that the Respondent is conducting unauthorized activities amongst the members of the trade and public by issuing employment offer letters on behalf of the complainant to create a false association with the Complainant. On the employment offer letter (Annexure S), the Respondent has mentioned the Complainant's Trademark as well as the Company name and has represented itself as the Supervisor. On the employment offer letter, the Respondent has also incorporated the Complainant's Registered Trademark as

S.K. Bani

covered by Indian Trademark Registration Number 1522439. Why else would the Respondent offer employment letters allegedly on behalf of the Complainant had he not been aware of the Complainant, the Complainant's rights and goodwill? Surely, the Respondent was aware thereof and that is why the Respondent is so doing so.

- (e) The Respondent's impugned conduct speaks for itself (*res ipsa loquitur*) and falls short of the standards of acceptable commercial behavior. Obviously the motive of the Respondent was to derive some benefit from the Complainant's Trade Mark/Trade Name/Domain Name VERTEX.
- (f) The Respondent to derive unjust gains can even sell the impugned Domain Name to other people creating a string of assignments and assignees over whom the Complainant would have no hold and would invariably suffer by such unauthorized and inferior activities.
37. The Courts have repeatedly held that the basic principles of Trade Mark law as also the laws of passing off to apply to disputes in respect of internet domain names [See Satyam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd., 2004 (28) PTC 566 (SC)] as also an infringement of registered Trade-marks to be caused by the rival un authorized use thereof in a rival domain name. [See Lt Foods Limited (Supra)].

S. C. Bhowmik

38. "Cyber-piracy" has been defined as "the act of registering a well-known name or mark" (or one that is confusingly similar) as a website's domain name, usually for the purpose of deriving revenue" [See The BLACKS LAW DICTIONARY 444 (9th ed. 2009)]. 1
39. While considering the concept of malafide the Hon'ble Supreme Court in its celebrated case of Parbodh Sagar v/s The Punjab State Electricity Board and Ors reported in 2000 (5) JT 378 has held – ".....that the expression "malafide" is not a meaningless Jargon and it has its proper connotation. Malice or malafide can only be appreciated from the records of the case in the facts of each case. There cannot possibly be any set of guidelines in regard to the proof of malafides. Malafides, where it is alleged, depends upon its own facts and circumstances." In light of the aforesaid pronouncement it can be safely held that the concept of or what amounts to bad faith, malafide or dishonesty is not one that lends itself to an exhaustive definition and for the determination of which there can be no rigid strait jacket formula and nor prescribed hard and fast rules or set guidelines. They have to be judged with reference to the facts and circumstances of each case. The Oxford dictionary of law 6th Edition 2006 defines malafide as - [Latin: bad faith] Describing an act performed fraudulently or dishonestly. In Gramax Plasticure Limited V/s Don & Low Nonwovens Limited 1999 RPC 367 at page 379 bad faith has been defined to include dishonesty and dealings which fall short of the standards of acceptable commercial behavior.

S.C. Bawa

observed by reasonable and experienced men in the particular area being examined. In Road Tech Computer Systems Limited v/s Unison Software (UK) reported in 1996 FSR 805 at page 817 bad faith has been defined to mean dishonest, lack of good faith : not necessarily for a financial motive but still dishonesty.

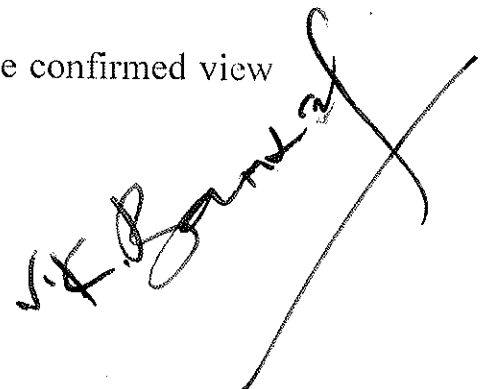
40. The Hon'ble Delhi High Court in its celebrated decision of M/s Hindustan Pencils Pvt. Ltd. v/s M/s India Stationary Products Company & Anr. Reported in 1989 PTC 61 affirmed the observation of Romer J, in the matter of an application brought by J.R. Parkington and Coy. Ltd., 63 R.P.C. 171 at page 181 that "in my judgment, the circumstances which attend the adoption of a trademark in the first instance are of considerable importance when one comes to consider whether the use of that mark has or has not been a honest user. If the user in its inception was tainted it would be difficult in most cases to purify it subsequently". In the same judgment the Hon'ble High Court has held that if a party for no apparent or valid reason adopts the mark of another business it can be assumed that such an adoption was not honest and the Court would be justified in concluding that the defendant/Respondent by such an act wanted to cash upon the name and reputation of the Complainant and that was the sole primary and real motive of the defendant/Respondent in so adopting such a mark. In the same judgment the Hon'ble Court further held that the violator business who uses or adopts someone else marks must be

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aware of the consequence which must follow. The Respondent cannot derive any benefit from its own wrongs.

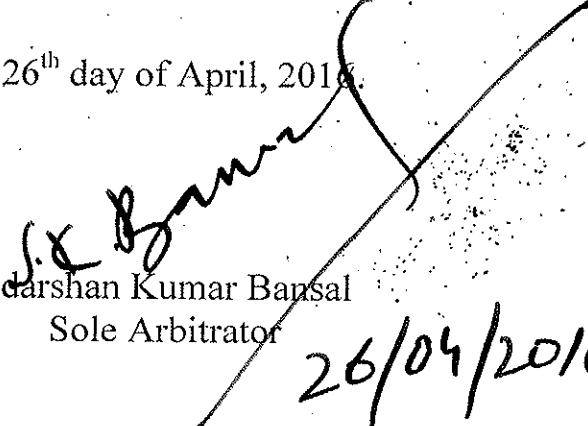
41. Even otherwise lack of fraudulent intent or bonafide good faith on the part of the Respondent [Ruston Case, supra and Laxmikanth V. Patel case, supra] is immaterial and that the respondent can be held liable despite it.
42. In my considered view the Complainant has discharged its onus/burden of proof and has established its proprietary and enforceable rights in its Trade Mark/Trade Name/Domain Name VERTEX. The wrongs of the Respondents are also apparent from the fact that it has not traversed nor challenged the Complaint facts against him. Such a non-traverse has to be taken against the Respondent (Uttam Singh Dugal & Company Limited V/s Union Bank of India & Ors – reported in AIR 2000 SC 2740).
43. Trade Marks/Trade Name/Domain Names have been accepted to be valuable business assets to be protected against their wrongful use even as part of a rival domain name and such violations have to be removed in the interest of the right holder as also of the consumers.

In the aforesaid view of the matter I am of the confirmed view that the Complaint must be allowed.



Accordingly it is decided that the disputed domain name **vertexpharmaceuticals.in** be transferred to the Complainant.

Signed at New Delhi, India on this 26th day of April, 2016.


Sudarshan Kumar Bansal
Sole Arbitrator

26/04/2016