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BEFORE THE INTERNET EXCHANGE OF INDIA
ARBITRATION AWARD

ARBITRATOR: S. SRIDHARAN

Dated 4th October 2009

CHIESI PHARMACEUTICAL S.P.A

V

Brand Concern B.V.

Sridharan
(S. Sridharan)
Arbitrator

BEFORE THE INTERNET EXCHANGE OF INDIA

ARBITRATION AWARD

ARBITRATOR: S.SRIDHARAN

DATED: 04th October 2009

CHIESI FARMACEUTICI S.p.A

Complainant

Versus

BRANDCONCERN B.V.

Respondent

1. The Parties

- 1.1 The Complainant is Chiesi Farmaceutici S.p.A., at Palermo 26/A - 43122 PARMA (ITALY) represented by its counsel, Dr. Alessio Canova of Giambrocono & C. S.p.A, at Rosolino Pilo 19/B - 20129 MILAN (Italy).
- 1.2 The Respondent is Brandconcern BV, at Herengracht 23-II, NL-1015 BA Amsterdam (Netherlands).

The Domain Name and Registrar

- 1.3 The disputed domain name **<chiesi.in>** is registered with Domain Discount 24.

2. Procedural History

- 2.1 On 7th September 2009, Arbitrator received email from NIXI setting out the details of the parties to the complaint, the disputed domain name and asking him to express his availability and consent to take up the Complaint



for arbitration. By return mail, the Arbitrator confirmed his availability and consent; informed that he had no conflict with either of the parties and he could act impartially and agreed to send a signed hard copy of Statement of Acceptance and Declaration of Impartiality and Independence.

2.2 On 10th September 2009, Arbitrator received hard copy of the Complaint along with annexures.

2.3 On 10th September 2009, Arbitrator issued by email 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. Arbitrator also sent an email about his appointment to arbitrate the complaint to the Complainant and asking him to transmit a soft copy of the Complaint.

2.4 On 10th September 2009, Arbitrator received soft copy of the complaint from the Complainant. The Complainant also informed the Arbitrator certain events subsequent to the filing of the Complaint. It will be discussed appropriately herein below.

2.5 On 28th September 2009, Arbitrator informed all by email that Respondent had not filed any response till that date. However, as a matter of natural justice, Respondent was given extended time till 2nd October 2009 to file his response. Complainant was also informed that the facts stated in the complaint might not be sufficient to pass an award on merits and was directed to file additional submissions on the activities of the complaint, his presence in India, Indian trade marks applications/ registrations etc.



- 2.6 On 2nd October 2009, the Complainant filed his additional submissions.
- 2.7 The Respondent has not entered appearance. He has not filed any reply to the Complaint of the Complainant.
- 2.8 Email is the medium of communication of this arbitration and each email is copied to all, Complainant, Respondent and NIXI.

3. **Factual Background**

A **Complainant**

3.1 The Complainant has set out only the legal grounds in his complaint and there is virtually nothing about the Complainant in Italy and India.

3.2 A perusal of the legal grounds reveals the following facts:

(a) The Complainant is the current owner of more than 500 trademark registrations and applications worldwide; moreover, the Complainant holds more than 60 trademark registrations and applications worldwide consisting of or comprising the word CHIESI.

(b) In particular, Complainant is the present owner of the following exclusive rights having effect in Netherlands, the country where the Respondent resides:

- (1) Community trademark registration no. 1224542 "CHIESI", filed on June 28th, 1999 (Annex02);
- (2) community trademark registration no. 6234363 "CHIESI in neonatology for life", filed on August 26 , 2009 (Annex03);



- (3) community trademark registration no. 7216286 "CHIESI",
filed on September 05th, 2008 (Annex04);
- (4) international trademark registration no. 544391 "CHIESI",
registered on October 23rd, 1989 (Annex05), also
designating Benelux
- (c) The Respondent is the current owner of nearly 800 domain names,
just considering the generic TLD (Annex08), most of which are
"parked" or explicitly on sale. Some example are:
- pornstar.pl (Annex09 - parked)
 - dating.info (Annexes 10 and 11 - on sale)
 - woman.info (Annex12 - parked)
 - homo.info (Annex 13 and 14 - on sale)
- (d) The unusual number of domain names owned by the Respondent
the peculiar words associated to such registrations, the fact that
most of them are not actually used and the fact that some of them
are explicitly on sale, may mean that Respondent's business is to
trade domain names.
- (e) Respondent registered at least 3 other domain names identical to
CHIESI's trademarks and Company name: CHIESI.CO.UK
(Annex15), CHIESI.AT (Annex16) and CHIESI.CH (Annex17),
which are now also being disputed before the correspondent
authorities.
- (f) When contacted to explore the possibility of an acquisition by the
Complainant's Registrar, Respondent asked as much as €10000

Indicazioni

(Annex18), for transferring the domain name registration to the owner of the trademark.

3.3 Complainant while sending soft copy of the complaint to the Arbitrator submitted the following facts.

- (a) the disputed domain name was transferred to a "straw man" in Netherland Antilles, Mr William Roadster
- (b) the disputed domain name CHIESI.IN, which at the time of the complaint was not used, now is connected to a web site which apparently sells "CHI ESI" branded goods
- (c) this "fake" web site was actually created using a tool provided by the site www.spreadshirt.net and the products do not really exist.
- (d) Respondent, meanwhile, on August 20th, 2009 (ie 15 day after our Complaint), filed a community trademark application claiming products in classes 14, 18 and 25.
- (e) On August 26th, 2009, the domain was transferred back from William Roadster to Respondent.

3.4 Complainant in his additional submissions reiterated his earlier averments and further submitted that that the Complainant's main product in India is CUROSURF (<http://www.drugs.com/pro/curosurf.html>) for the treatment of Respiratory Distress Syndrome (RDS) in premature infants, which was sold in the country for a total of nearly 1,000,000 USD during the last 5 years (Annex28). CUROSURF packages display the CHIESI logo on all their sides (Annex29).

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3.5 The Complainant is also the current owner of the following trademark registrations in India:

(a) INNOVAIR (no. 933848, registered on May 23, 2006)

(b) VENTMAX (no. 979682, registered on March 09, 2005)

(c) INNUVAIR (no. 975706, registered on December 07, 2007).

B Respondent

3.6 The Respondent has not filed any reply to the Complainant's Compliant in this arbitration.

4. Parties Contentions

A Complainant

4.1 The disputed domain name <chiesi.in> is just composed by "CHIESI" trade mark of the Complainant, followed by the CCTLD .IN.

4.2 The disputed domain name <chiesi.in> is not only absolutely identical to the mentioned trademarks, but also to the Company name, to the surname of the founder and the current president and CEO and to many domain names presently owned by Complainant (among the others: CHIESI.COM and CHIESI.IT)

4.3 The Respondent has never been, and is not currently, commonly known by the disputed domain name, nor its name (BRANDCONCERN) consists in whole or in part in the denomination CHIESI or its business is somehow connected with CHIESI's products.

Sudhanshu

- 4.4 The Respondent does not hold any trademark or other right consisting in whole or in part in the denomination CHIESI (Annex06), which is the only word of the disputed domain name.
- 4.5 CHIESI is neither a common noun nor a common name. The disputed domain name <chiesi.in> currently displays the standard page of its Registrar DomainDiscount24 (Annex07). Thus, the Respondent is not making a legitimate non-commercial or fair use of the domain name, because the domain name is not being used at all.
- 4.6 The Respondent is the current owner of nearly 800 domain names, just considering the generic TLD (Annex08), most of which are "parked" or explicitly on sale.
- 4.7 The unusual number of domain names owned by the Respondent (which moreover appears to be a very small company), the peculiar words associated to such registrations, the fact that most of them are not actually used and the fact that some of them are explicitly on sale, may mean that Respondent's business is to trade domain names.
- 4.8 Respondent registered at least 3 other domain names identical to CHIESI's trademarks and Company name: CHIESI.CO.UK (Annex15), CHIESI.AT (Annex16) and CHIESI.CH (Annex17), which are now also being disputed before the correspondent authorities. Besides, when contacted to explore the possibility of an acquisition by the Complainant's Registrar, Respondent asked as much as €10000 (Annex18), clearly demonstrating that the domains were registered or acquired primarily for

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the purpose of selling, renting, or otherwise transferring the domain name registration to the owner of the trademark.

- 4.9 The Respondent is now seizing the disputed domain name **<chiesi.in>** together with the other CHIESI domain names still owned, in a manner which prevents the owner of the trademark or service mark from reflecting the mark in a corresponding domain name.

B. Respondent

- 4.10 Respondent has not filed any reply to the Complainant's Complaint in this arbitration.

5. Discussion and Findings

- 5.1 I have gone through the Complaint. The Complaint lacks basic and necessary facts that must be pleaded and established by the Complainant to sustain its action.

- 5.2 The disputed domain name **<chiesi.in>** is an intellectual property in India and it is established that this kind of intellectual property is territorial in nature. It is common knowledge that a single domain name may be registered in different countries by different persons, each distinguished by appropriate country codes such as .in, .us, .ca etc.

- 5.3 Therefore, Complainant has to plead and establish that:

- (a) Complainant is the proprietor of a trade mark or a domain name; he is using his trade mark or domain name in India and the disputed domain name violates his proprietary rights in India; or



(b) Complainant has proprietary rights in a trade mark or a domain name in a country other than India, such trade mark or domain name has gained enormous reputation in that country, such reputation spreads into India and the trade mark or domain name is well known in India, and the disputed domain name violates his well known reputation in India and its proprietary rights in his trade mark or domain name.

5.4 Complainant was informed that the facts stated in the complaint might not be sufficient to pass an award on merits and was directed to file additional submissions. Even the additional submissions will not help the case of the Complainant. I visited the web site at <http://www.drugs.com/pro/curosulf.html> and it gives details of the product CUROSURF. It contains the name of the Applicant. As regards sales figures, it is related to the sale of the products under the mark CUROSURF. The label contains Chiesi logo. But it is not supported by pleadings.

5.5 Therefore, the Complainant has failed to plead and establish what his right (statutory and/or common law) in India that is violated by the registration of the disputed domain name **<chiesi.in>**.

5.6 Therefore I refuse the Complaint for want of pleadings.

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6. **Decision**

6.1 The Complaint is refused for want of pleadings. There is no order as to costs.

A handwritten signature in black ink, appearing to read "Sridharan", written in a cursive style.

S.Sridharan
Arbitrator