



दिल्ली DELHI ARBITRATION PROCEEDINGS OF DOMAIN NAME F 717555  
"acomplia.in"

**SANOFI-AVENTIS**

**..COMPLAINANT**

**AND**

**BORIS SCHULMEISTER**

**...RESPONDENTS**

### **AWARD**

The undersigned was appointed as an Arbitrator on 4<sup>th</sup> July, 2008 by National Internet Exchange of India (hereinafter referred to as 'NIXI') and the present Tribunal conveyed his statement of impartiality to NIXI under the Sec.12 of the Arbitration and Conciliation Act, 1996.

2. That on July, 5, 2008 notice was issued calling both the parties to appear before this Tribunal on 8.7.08 for preliminary meeting and vide the said order this Tribunal had directed the complainant to send hard copy of the complaint to the opposite party. That the copy of the order dated 5.7.08 was sent to the parties by email and also by courier, a copy was also sent by airmail to the respondents at their address.
  
3. That on July 7,2008 this Tribunal received an email from Ms. Dhalia Sen Oberoi, Learned Counsel for the complainant stating *interalia*, that she had already sent a copy of the complaint to NIXI to be sent to the respondents.
  
4. On July 8<sup>th</sup> 2008 this Tribunal held the preliminary meeting and the complainants were represented by Mrs. Aparjita Asthana Rao who was holding the brief for Ms. Dhalia Sen Oberoi the Ld. Counsel for the complainant. As stated above the time fixed for the preliminary meeting was 8<sup>th</sup> July, 2008 at 5,00 pm. Since there was no communication from the side of the respondents this Tribunal in the interest of justice adjourned the proceedings



for 30 minutes so as to enable any person representing the respondents to appear before the Tribunal. However, even at 5.30 pm no one appeared from the side of the respondents. This Tribunal also noted with concern that the email sent at the address of the respondents as given in "WHOIS" also bounced back.

5. That Mrs. Aparjita Asthana proxy for Ms. Dhalia Sen Oberoi, Ld. Counsel for the complainant stated that they had sent a copy of the complaint to the NIXI who as per the rules were required to send the same to the respondent and that she will procure a copy of the original receipt and a written communication from NIXI to establish that the respondents have been served. Accordingly, this Tribunal gave the complainant time till Friday the 11<sup>th</sup> July, 2008 to get communication from NIXI about the service of the complaint on the respondent. It was also made clear that in case this Tribunal found that the service on the respondents is lacking then a copy of the order passed by Tribunal together with a copy of the Complaint together with a DHL courier receipt was

A handwritten signature in black ink, appearing to read 'Aparjita', with a long horizontal stroke extending to the right.

to be furnished. This Tribunal accordingly fixed the next date of sitting as 16<sup>th</sup> July, 2008.

6. The copy of the Order passed on 8<sup>th</sup> of July,2008 was communicated to the parties, to NIXI and to the Ld. Counsel for the complainant by courier and to the respondents by air mail and the same was also copied by as per procedure by email.
7. On July 15,2008 a communication was received from NIXI annexing the copy of the track record Fedex courier service dated July 4, 2008 and photo copy of the courier receipt of Blaze Flash Couriers. The copy of the track record of Fedex showed the address of the respondents as incorrect.
8. Vide orders passed in the meeting of this Tribunal dated 16/07/08 wherein this Tribunal also directed the complainants to deposit Rs.1230.00 as courier charges so as to enable the Tribunal to dispatch the copy of the complaint alongwith its order to the respondents. Accordingly, the matter was fixed for 7.8.08. The respondents were directed to send their reply. It



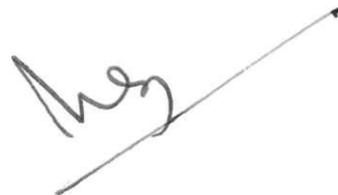
was also directed that along with the reply the party(s) should file their evidence by way of affidavit by sending copy to each other.

9. The copy of order of 16<sup>th</sup> July,2008 as well as the notice was duly dispatched to the parties vide internet as well as to the respondents by the courier service. The Tribunal vide its order dated 16/7/08 passed an order directing the respondents to file their evidence by way of affidavit by the next date of hearing i.e., 7<sup>th</sup> August 2008.
  
10. In the meanwhile this Tribunal got the tracking results from DHL stating that the address of the Respondents is incomplete. This Tribunal checked up the address from the record and found that the address given by the Respondent was the same and it was found to be incomplete. This Tribunal was in receipt of an invoice of Rs.2146 sent to it by the Courier Company, hence this Tribunal was pleased to direct the complainant to deposit balance amount of Rs.916/-. In view of the above this Tribunal passed order dated 31/07/08. That the above exercise was



carried out as per the provision under Section 3 of the Arbitration & Conciliation Act wherein communication is to be sent to the last known address of the parties.

11. A copy of the order dated 31.7.2008 was also copied to all the parties by email and as hard copy was also sent to all the parties by courier and to respondent by airmail.
12. On 2.8.08 this Tribunal was in receipt of a communication from Ms. Dhalia Sen Oberoi, Ld. Counsel for the complainants expressing her inability to present affidavit of the complainant as the complainant were located in France and they would require some time.
13. This Tribunal accordingly passed its order dated 02/08/08 granting the complainant time till 27<sup>th</sup> of August,2008 to file their affidavit by way of affidavit and fixing the date as 28<sup>th</sup> August, 2008. A copy of this order was sent by email as well as to the respondents and a hard copy was also sent by airmail as well as by email.

A handwritten signature in black ink, appearing to be 'Dhalia Sen Oberoi', is written over a diagonal line that extends from the bottom left towards the top right.

14. On 28<sup>th</sup> August 2008 Ms. Aparjita Asthana Rao appeared for the complainant and filed the affidavit of their clients by way of evidence in compliance of the directions of this Tribunal.
  
15. However, the Tribunal noted that though the copy of the affidavit has been filed there is no proof of dispatch of the same to the opposite party. Hence, this Tribunal passed the order directing the respondents to supply a copy of the affidavit at the last known address of the respondents and Ms. Aparjita Asthana Rao undertook to send the same and supply the copy of the postal receipt to the Tribunal by 2<sup>nd</sup> of September,2008. This Tribunal reminded the counsel for the complainant that it is duty bound to publish its award within 60 days and during this time the Tribunal is duty bound to see that best possible efforts have been made to effect the delivery of all the notices, communications etc. to the opposite party.
  
16. At this juncture, Ms. Aparjita Asthana Rao, Ld. Counsel for the complainant sought an extension of time for publication of the award till 25<sup>th</sup> September, 2008. Looking into the situation the



Tribunal extended the time of 25th September, 2008 for publication of award and giving the respondents time till 25<sup>th</sup> September, 2008 to give their reply subject to the proof of dispatch of the affidavit was given to this Tribunal by the complainant evidencing they have dispatched a copy of their affidavit to the respondent.

17. On 1<sup>st</sup> September, 2008 the Ld. Counsel for the complainant by way of email as well as by hand sent a copy of the courier receipt evidencing that they have dispatched a copy of their affidavit by courier to the opposite party.

18. Accordingly by its order dated 1<sup>st</sup> September, 2008 the Tribunal took the same on record and passed directions that in case Tribunal receives any response from the respondents it shall convey the same to the complainant and fixed the date of 25<sup>th</sup> September 2008 for publication of award. This communication dated 28<sup>th</sup> August 2008 and 1<sup>st</sup> September 2008 was sent to the respondent and couriered to the parties including NIXI. In this duration an email dated 11.9.08 was received from Ld. Counsel



for the complainant stating, inter alia, that the courier service has reported that parcel containing the affidavit in evidence of the complainant have given the report of incorrect address and also stated that in case the consigner i.e., Ms. Dhalia Sen Oberoi wants the parcel back they will be required to pay Rs.3500/- or else the packet will be destroyed. The Ld. Counsel for the complainant wanted a decision from this Tribunal. In the said email dated 11.9.08 it was stated that since there is unnecessary burden on the clients of the Ld. Counsel of the Complainants are instructing Blue Dart to destroy and therefore, this Tribunal vide its order passed on 11.9.08 copied to all the parties stated that Tribunal cannot be made a party to the internal dealings between courier company and the complainant counsel about what is to be done with the consignment. Moreover, this Tribunal also noted that vide communication dated September 11, 2008 it is on record that the Counsel of the Complainants have issued instruction to destroy the consignment this Tribunal refrains from passing any order.

A handwritten signature in black ink, appearing to be 'Sen', is written over the end of the text.

19. That this Tribunal has tried repeatedly to serve/notify the respondents about the present proceedings and repeated efforts were made to serve the respondents. This Tribunal also has copied the orders by it to the respondents and has also tried to serve through airmail but despite the same, all the emails as per the email address notified in the WHOIS have been returned back and so was the case of the repeated efforts to serve the opposite party by courier company like DHL, Fedex which too have been unsuccessful in serving the same on the respondents and hence this Tribunal now finds that even during the extended time till 25<sup>th</sup> September, 2008 for publication of an award it did not receive any communication from the respondents.

20. Now this Tribunal proceeds to decide the case on merits. This dispute concerns the domain ACOMPLIA.IN (the "Domain Name").

The Registrar with which the Domain name is registered is: Key Systems GmbH (R48-AFIN) as per **Annex [1]** of the Complaint.

21. The dispute is that the respondent had on 24<sup>th</sup> February, 2005 got the domain named "acomplia.in" registered in their name

A handwritten signature in black ink, appearing to be a stylized name, located at the bottom center of the page.

and the complainants are aggrieved by the registration of this domain name as they have a product by the said name and also have applied for the trade mark world over for the said Trade name.

22. The Complainant's case is that they are a reputed, well-known and world-renowned manufacturers and merchants of medicinal and pharmaceutical preparations having a presence in almost all countries of the world, including India. The Complainant states that it is the 3<sup>rd</sup> largest pharmaceutical company in the world and number 1 in Europe. It is stated by the complainants that they rank among the top 60 companies in the Indian pharmaceutical market. The complainants claim to have presence in more than 100 countries throughout the 5 continents.
23. It is also stated that the Complainant's name changed from Sanofi- Synthelabo to Sanofi-Aventis in or around August 2004. Sanofi-Aventis is, therefore, successor-in-title, the world over, to all registrations and goodwill associated with the mark ACOMPLIA and would be deemed to be the Complainant in this matter.
24. The complainants claim that ACOMPLIA is their product and as early as February 16, 2004, during an information meeting, the content of which was dispersed on the Internet, the Complainant announced early results of two Phase III studies



with new Acomplia product (Complainant's trademark), indicating that overweight and obese patients with untreated dyslipidemia lost weight in one year while improving their lipid and glucose profiles, and that smokers who had previously unsuccessfully tried to quit smoking, were able to quit in 10 weeks without post cessation weight gain for this the complainants rely upon **Annex [3] of their complaint.**

25. It is stated that the above results were presented to the scientific community at the American College of Cardiology annual meeting in New Orleans on March 9, 2005 for this the complainants rely upon **Annex [4] of their complaint.**

26. The Complainant, thereafter stated to have launched the product in the UK, sometime in 2006. Copy of the news report from the website of 'PHARMAFOCUS' a publication essentially focusing on the medicinal products around the world, corroborating the launch of ACOMPLIA in 2006 by the Complainant for this the complainants rely upon **Annex [5] of their complaint.** Further it is stated that, ACOMPLIA is sold under prescription only and also through the internet. The complainants rely upon **Annex [6] of their complaint which is** an extract of the Complainant's 2005 Annual Report.

27. Apart from the above the Complainant has also filed a list of their trademark applications for ACOMPLIA in more than 100 countries and copies of certain of the Complainant's worldwide



registration certificates for the trade marks ACOMPLIA for this the complainants rely upon **Annex [7] & [8] of their complaint**

28. The Complainant claim to have also registered numerous domain names worldwide containing the ACOMPLIA trade mark, which include [www.acomplia.co.uk](http://www.acomplia.co.uk), [www.acomplia.fr](http://www.acomplia.fr), [www.acomplia.us](http://www.acomplia.us), [www.acomplia.dk](http://www.acomplia.dk), [www.acornplia.at](http://www.acornplia.at) The complainants rely upon **Annex [9] of their complaint** wherein copies of the WHOIS search results are given.

29. The complainants claim to have fought legal battles for the said trade name under aegis of WIPO for this the complainants rely upon **Annex [10] of their complaint**.

30. The complainants allege that the domain name "acomplia.in" is identical to the ACOMPLIA trademarks in which the Complainant has rights for the following reasons:

*"The Respondent's registration of the domain name 'acomplia.in' is identical to the Complainant's well-known and registered trademark ACOMPLIA, the drug which is termed as a revolution in fighting obesity and its related problems.*

*The Domain Name of the Respondent is visually, conceptually and phonetically identical to the Complainant's well known and highly distinctive trade mark ACOMPLIA.*

*The registration of the Domain Name is likely to falsely lead the public into believing that the Respondent and the website to*



*which the Domain Name directs is sponsored by or affiliated to or associated with the Complainant, and will lead to confusion in the minds of the public.*

*Further, the Respondent's registration and use of the Domain Name is a clear case of cybersquatting, whose intention is to take advantage of the Complainant's substantial reputation and its prominent presence on the Internet in order to deceive the public*

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

31. The complainants also allege that the disputed domain name is used by the Respondent leads to a non-active web site and they place their reliance on **Annex [11] of their complaint.**
  
32. That this Tribunal did not have the benefit of getting the counter arguments/pleadings/evidence filed by the respondents despite as explained *supra* repeated efforts made to effect a service upon them so that the respondents join the present proceedings and all the repeated efforts have not borne fruitful results and hence this Tribunal was constrained to proceed against the respondents under Section 3 of the Arbitration &

A handwritten signature in black ink, appearing to be 'he', with a long arrow pointing upwards and to the right.

Conciliation Act, 1996 wherein the efforts have to be made to serve the respondents at their last known address.

33. That this Tribunal holds that the respondents had registered this domain name on 24<sup>th</sup> February, 2005 and the complainants had been working on this product and have filed trademark applications list of which they have given in Annexure 7 & 8 wherein they have received some registration(s) of trademark "acomplia". Though some of the certificates are not in English but nevertheless this Tribunal sees the word "acomplia" and draws the conclusion that complainant has invested lot of their time, money and resources in developing this product and not only this they have list of the domain names given at Annex.-9 which clearly show that the "acomplia" is their product and any name which if given in similarity is likely to create confusion in the mind of internet users and also the minds of the public.
34. In view of no rebuttal to the assertions of the complainant which is duly supported by an affidavit as well as Annexure gives this

A handwritten signature in black ink, appearing to be 'A. S.', is written over a horizontal line.

Tribunal a plausible ground to presume the same to be genuine documents containing factually correct information.

35. What further creates a doubt in the mind of this Tribunal is that the respondents have given incorrect address at the time of taking the registration and even the email address is inactive which fact is discernible from the fact that emails sent by this Tribunal regarding these proceedings have come back undelivered.
36. All the above facts and events lead this Tribunal to come to a conclusion that the respondents cannot justify having anything to do with the domain name "acomplia". Even the name of the registrant does not cover the word "acomplia" in any manner whatsoever.
37. Moreover the word "acomplia" is being used for a drug/medicine and having any other domain name would always in all probability lead to confusion in the minds of the public and hence the present Tribunal holds that the



respondent do not have any justifiable ground to have this domain name "acomplia.in" with them. Moreover, as per WHOIS Annexure I this Tribunal finds that the expiry date of this domain name is 24/02/08 and the said date has passed and further this matter being referred to arbitration and no response coming from the present registrant lead this Tribunal to comes to an inevitable conclusion that Respondents have no genuine stake in the name "acomplia.in".

38. Hence, this Tribunal sets aside the earlier registration given to the respondent and in its place the complainants are free to apply and take this domain name in their favour.

Pronounced on this 25<sup>th</sup> day of September, 2008 at New Delhi.

Copy of this Award is being sent to the parties and the Original Award and the record of the proceedings are being transmitted to NIXI.

New Delhi  
25/09/2008



V. Shrivastav  
Arbitrator