



महाराष्ट्र MAHARASHTRA

© 2018 ©

AP 437588

अनु. क्र. ३०५२ दि. २६/६/१९ पु.शु.रक्ष. पुणे-२

दस्तावा प्रकार डिजिटल कॉपी

दस्त नोंदणी करणार आहेत का ? होय/नाही.

मिळवणीचे वर्णन

मुद्रांक विवरण केवळ मुद्रांक फॉर्म वर

पत्ता २६/६/१९, शनिवार, पुणे-२

मुद्रांक नोंदणी करणार नाहीत

हस्त नोंदणी करणार नाहीत

हस्त नोंदणी करणार नाहीत

हस्त नोंदणी करणार नाहीत

हस्त नोंदणी करणार नाहीत

हस्त नोंदणी करणार नाहीत

हस्त नोंदणी करणार नाहीत

हस्त नोंदणी करणार नाहीत

हस्त नोंदणी करणार नाहीत

हस्त नोंदणी करणार नाहीत

हस्त नोंदणी करणार नाहीत

हस्त नोंदणी करणार नाहीत

हस्त नोंदणी करणार नाहीत

हस्त नोंदणी करणार नाहीत

हस्त नोंदणी करणार नाहीत

हस्त नोंदणी करणार नाहीत

हस्त नोंदणी करणार नाहीत

हस्त नोंदणी करणार नाहीत

हस्त नोंदणी करणार नाहीत

हस्त नोंदणी करणार नाहीत



AWARD

IN ARBITRATION IN INDRP CASE NO.1103

WWW.5AMVENTURES.IN

5am Venture Management, LLC
501, Second Street, Suite 350
San Francisco, California, 94107
United States of America

THE COMPLAINANT

Altat
Pune.411 014. India

V/S

**THE RESPONDENT /
THE REGISTRANT**

IN THE MATTER OF DISPUTED DOMAIN NAME: - '5AMVENTURES.IN'

ARBITRATION PANEL: - MR.S.C.INAMDAR, B.COM. LL.B., F.C.S.
SOLE ARBITRATOR

DELIVERED ON THIS 26th DAY OF JUNE TWO THOUSAND NINETEEN
AT PUNE, INDIA.

I] SUMMARISED INFORMATION ABOUT THE DISPUTE: -

Sr. NO.	PARTY TO THE DISPUTE	NAME	ADDRESS
01	COMPLAINANT	5am Venture Management, LLC	501, Second Street, Suite 350, San Francisco, California. 94107. United States of America
02	AUTHORISED REPRESENTATIVE OF THE COMPLAINANT	Raja Pannir Selvam	Selvam and Selvam Old No.9, Valliammal Street, Kilpauk, Chennai. 600 010. Tamil Nadu. India.
03	RESPONDENT / RESPONDENT	Altaf	Pune. 411014. Maharashtra. India
04	DOMAIN NAME REGISTRAR	Endurance Domains Technology LLP	Mumbai. India

II] CALENDER OF MAJOR EVENTS:-

Sr. No.	Particulars	Date (All communications in electronic mode)
01	Arbitration case referred to me by NIXI	27.05.2019
02	Acceptance given by me	27.05.2019
03	Hard copy of complaint received	03.06.2019
04	Notice of Arbitration issued, with the period to file reply, if any, latest by 13.06.2019	03.06.2019
05	Period to file say by Respondent extended with instruction to file his say if any, latest by 16.06.2019	13.06.2019
06	Reply filed by Registrant / Respondent	14.06.2019
07	Complainant instructed to file rejoinder, if any, latest by 20.06.2019	15.06.2019
08	Rejoinder filed by the Complainant	18.06.2019
09	Registrant / Respondent instructed to file rejoinder, if any latest by 21.06.2019	18.06.2019
10	Notice of closure of arbitration issued	24.06.2019
11	Award passed	26.06.2019

III] PARTICULARS OF DISPUTED DOMAIN NAME & REGISTRATION:

1. Disputed domain name is '5AMVENTURES.IN'.
2. Date of registration of disputed domain name by Respondent is 14.09.2015
3. Registrar is Endurance Domains Technology LLP

IV] PROCEDURE FOLLOWED IN ARBITRAION PROCEEDINGS: -

- 1) Arbitration proceedings were carried out as per .In Domain Name Dispute Resolution Policy (INDRP) read with INDRP Rules of Procedure, Indian Arbitration Act, 1996 (including amendments thereto) and Code of Civil Procedure, wherever necessary.
- 2) The parties were requested to expedite their submissions so as to enable this panel to pass award within the prescribed time frame of 60 days.
- 3) Copies of all communications were marked to both the parties and NIXI.
- 4) No personal hearing was requested / granted / held.

V] BRIEF INFORMATION OF THE COMPLAINANT: -

The Complainant in these arbitration proceedings is 5am Venture Management LLC. According to the Complainant it owns 5am Ventures brand. The Complainant is a leading venture capital firm based in the United States of America, which is mainly engaged in building next-generation life science companies capable of delivering outstanding returns to their investors. It was founded in the year 2002 and since then it has been providing specialized services for seed, early-stage, growth capital, startup investments and spin outs.

The Complainant claims that it is owner of trademark '5am ventures' in numerous countries like India, Canada, European Union, Switzerland and United States of America. Among them the first was registered in 2008. In India it has registered the said trade mark on 18.08.2017.

The Complainant claims that the Respondent has registered disputed domain name on 14.09.2015 which is fraudulent, misleading public and mala fide act on his part.

VI] SUMMARY OF THE COMPLAINT: -

The Complaint is, inter-alia, based on the following points, issues, representations or claims in brief:-

(A) CONTRAVENTION OF THE REGISTERED TRADEMARKS AND DOMAIN NAMES OF THE COMPLAINANT (CONTRAVENTION OF POLICY PARA 4(i) OF THE .IN DOMAIN NAME DISPUTE RESOLUTION POLICY) (INDRP) : -

- i. The Complainant has furnished a list of registered marks in India and other countries comprising the word and formative marks '5amventures '. Out of

these, trademark is registered in India on 18.08.2017 in class 36 under No.3615299.

ii. The disputed domain name contains the entire registered trademark '5amventures' which itself proves that it is identical, or confusingly similar to the Complainant's registered trademark.

iii. Mala fide intention of the Respondent is evident from the fact that the disputed domain name is identical to the Complainant's trademark. It also leads to the inevitable conclusion that the disputed domain name is confusingly similar to the 5AM VENTURES trademark. (*Reliance upon – Satyam Infoway Ltd. Vs Sifynet Solution P. Ltd. - JT(2004(5) SC 541)*)

iv. It is well recognised that incorporating a trademark in its entirety, particularly if the mark is an internationally well known mark, is sufficient to establish that the domain name is identical or confusingly similar to the Complainant's registered mark. (*Reliance upon – Lego Juris A/s Vs Robert Martin, INDRP 125 (2010) & Starbucks Corporation vs Mohanraj – INDRP 118, (2009), Google Inc. vs Mr. Gulshan Khatri INDRP 189(2011)*)

(B) NO RIGHT OR LEGITIMATE INTEREST IN DISPUTED DOMAIN NAME (PARA 4(ii) OF INDRP): -

i. The Respondent has no proprietary or contractual rights in any registered or common law trademark including '5AMVENTURES', nor has he applied for registration of the same.

ii. There is no indication that the Registrant as an individual, business or other organization has been commonly known by or associated with the disputed domain name. (*Reliance upon - Morgan Stanley vs Keep Guessing – INDRP 24 (2007) & Kennametal Inc. Vs Guechi Raouf, INDRP 582 (2014)*)

iv. The Respondent is not making any legitimate non-commercial or fair use of the disputed domain name. The Respondent is not authorised by the Complainant to use the 5AM VENTURES trademark. (*Reliance upon – Demco Inc. Vs Adminprivateregcontact a/k/a Demco USA, Case NO. D2011-1516 (WIPO)*)

(C) REGISTRATION AND USE IN BAD FAITH (PARA 4(iii)) OF INDRP: -

i. By registering the disputed domain name, the Respondent has intentionally attempted to attract for commercial gain, internet users to the disputed domain website by creating likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the disputed domain name.

ii. Due to the Complainant's well prior use of 5amventures mark, prior to the registration of the disputed domain name, makes it extremely unlikely that the Respondent created the said domain independently without any knowledge of the Complainant's trademark. (*Reliance upon- Google Inc. vs Sunil K Support*

Solution Aditi Sawant, Support Solution and others FA 1501001599162 – National Arbitration Forum, Lego Juris A/S vs Martin – INDRP 125, Google Inc. Vs Chen Zhaoyang INDRP 23)

iii. The registration of disputed domain name appears to be fraudulent act in which the Respondent purports to offer services under the Complainant's trademark when factually he has no connection with the Complainant whatsoever.

iv. The fact that the URL in the Copyright Notice of the Respondent's website directs the users to the Complainant's website, is prima facie proof that the Respondent is aware of the Complainant, its website and its well known trademark and the act of the Respondent Constitutes opportunistic bad faith. *(Reliance upon – Microsoft Corporation vs Montrose Corporation (WIPO D2000-1568)*

v. The Respondent has failed to comply with Para 3 of the INDRP which requires that it is the responsibility of the Respondent to ensure before the registration of the impugned domain name by him that the proposed domain name registration will not infringe or violate someone else's rights. *(Reliance upon – AB Electrolux vs Liheng – INDRP 700 (2015)*

(D) REMEDIES SOUGHT BY THE COMPLAINANT: -

On the above background of the Complaint and reasons described therein the Complainant has requested for TRANSFER OF DISPUTED DOMAIN to the Complainant.

VII] RESPONDENT'S DEFENSE: -

The Respondent did not respond to the Notice of Arbitration within the prescribed time. However he chose to file his reply within the extended period, which reads as follows: -

Most humbly we state that Respondent had registered the disputed domain name www.5amventures.in on September 14, 2015. Respondent humbly state that Respondent was not aware of the fact that domain "5amventures" is registered trademark of the complainant. Respondent humbly state that the respondent doesn't intent to use the trademark 5AM VENTURES trademark on the disputed domain name. Respondent humbly state that the respondent never had mala fide intention to use the domain name. Respondent humbly state that the respondent purchased the domain since domain "www.5amventures.in" was available for purchase and respondent was not aware of the existence of similar trademark at the time of purchase till respondent received notice from the arbitrator. The use of domain "www.5amventures.in" is purely unintentional.

Respondent humbly state that the respondent is willing to withdraw/ transfer the domain name to the complainant with all goodwill that complainant already.

1. Mostly humbly respondent request deadline of response and submission of supporting documents if any.

2. Mostly humbly respondent request the extension of deadline of response and submission of supporting documents if any.

3. Mostly humbly respondent request list of documents to be submitted if any.

Thanks and Regards,
Altat Rehmani

VIII] REJOINDERS OF THE PARTIES: -

In view of the response by the Respondent, this panel called for rejoinder from the Complainant. The Complainant filed his rejoinder saying as follows: -

'The Complainant hereby submits its rejoinder in the subject matter.

The Complainant submits that the contentions made by the Respondent are false. The Complainant further submits that the Respondent was well aware about the existence of the Complainant's business and registered the domain name www.5amventures.in in bad faith and with the intention to ride upon the reputation of the Complainant. The mala fide intention of the Respondent is prima facie clear by the fact that the link in the Copyright notice of the Respondent's website directs the users to the Complainant's website, evidence of which was filed as Annexure D of the complaint.

For the foregoing reasons, the Complainant respectfully submits that the registration of the disputed domain name www.5amventures.in is confusingly identical to the 5AM VENTURES trademark of the Complainant, and that the Respondent has no rights or legitimate interest in and to the disputed domain name, and that the Respondent has registered and used the disputed domain name in bad faith.

Thereby Complainant humbly prays that the disputed domain name www.5amventures.in be transferred to the Complainant.

Best regards,

Prachi Jain

Associate
prachi@selvams.com

The Respondent / Registrant did not file rejoinder subsequent to the submission of rejoinder by the Complainant. Therefore arbitration proceedings were closed.

IX] EVIDENCE RELIED UPON: -

This panel has, *inter-alia*, placed reliance upon the following evidences / details thereof, submitted by the Complainant: -

1. Copies of trademarks registered in India and in other countries in the name of the Complainant
2. Copy of printout of the *whois* details
3. Say filed by the Respondent
4. Rejoinder filed by the Complainant

X] FINDINGS: -

Based on the complaint, contentions and annexures attached to it, this panel makes following observations: -

1. The Complainant is an owner of registered trade / service marks incorporating the word 5amventures in which it has legitimate interests and rights.
2. The registration of these marks is prior to the registration of the disputed domain name by the Respondent.
3. The Complainant has not authorised / licensed to the Respondent to use the word '5amventures' in any manner, nor the Respondent has claimed such authority having issued by the Complainant in his say.
4. The Complainant has pointed out that the Respondent is also engaged in the same business of venture capital, growth fund etc. in which the Complainant has been since last several years.
5. The Complainant has also pointed out that the disputed website of the Respondent contains copyright notice which when clicked, leads to the Complainant. This fact leads to the conclusion that the Respondent was well aware of the Complainant, its registered trademark and nature of his business, before registration of the disputed domain name.
6. The Respondent is not known by the word 5amventures or any resembling word to it.
7. The Respondent is not making use of disputed domain name for non-commercial or charitable purposes.
8. The contentions of the Respondent that he was not aware of the Complainant's registered trademark, that he has innocently purchased the domain since it was available for purchase and that he never had mala fide intention to use the domain name, can not be relied upon since the Complainant has already proved them to be incorrect.
9. The Respondent has also confirmed that he is ready and willing to transfer the disputed domain name in favour of the Complainant. This readiness to transfer the disputed domain name by the Respondent to the Complainant, in itself establishes the mala fides of the Respondent, in registration of disputed domain name.
10. This panel agrees with the Complainant that the Respondent has registered the domain name and that he has been using it for mala fide intentions and purposes, and that he was fully aware of the previous rights and legitimate interests of the Complainant.

11. Having considered the year of trademark registration by the Complainant and the year of registration of domain name by the Respondent, in addition to the fact that the Respondent has placed a link to the Complainant's website on the disputed domain, this panel holds a view that registration and use of disputed domain name by the Respondent is a doctored and planned activity on his part to reap the benefits of trading on goodwill of the Complainant. This is further corroborated by the fact that the Respondent has undertaken the same business activity as that of the Complainant. This panel therefore rejects his pleas of innocence and absence of mala fides.

XII] CONCLUSION: -

On the basis of the averments in the Complaint, Respondent's say, rejoinder of the Complainant, citations, documentary evidence and other substantiating points, this Arbitration Panel has come to the following conclusions: -

- a. the disputed domain name contains registered trade / service mark of the Complainant in its entirety and is totally identical or confusingly similar to a name, trademark in which the Complainant has legitimate rights and interests.*
- b. providing of link under copyright notice to the website of the Complainant on the disputed domain name by the Respondent, clearly indicates that the Respondent was well aware of the Complainant, his business, and his registered trademark before registration of disputed domain name and hence this has to be treated as mala fide registration*
- c. the Respondent has no rights or legitimate interests in respect of the domain name. He has not been authorised, licensed / permitted to use the said domain name, nor has he been known individually or by his business by the name of disputed domain name or any closely resembling term to it.*
- d. the disputed domain name is registered in bad faith by the Respondent and allowing him to continue to own the same would make injustice and loss to the Complainant.*

XII] AWARD: -

On the basis of above findings on issues, foregoing discussion, conclusion and as per the remedies requested by the Complainant, this panel passes the following award: -

a. The disputed domain name '5amventures.in' be transferred to the Complainant.

b. No order as to the costs.

Date: - 26.06.2019

Place: - Pune, India



**(S.C.INAMDAR)
SOLE ARBITRATOR
NATIONAL INTERNET
EXCHANGE OF INDIA**