



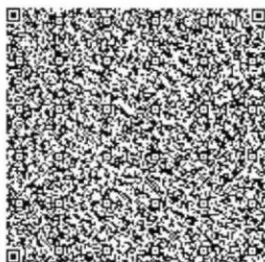
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INDIA NON JUDICIAL

Government of National Capital Territory of Delhi

e-Stamp

Certificate No. : IN-DL17303887639489N
Certificate Issued Date : 18-Jun-2015 11:10 AM
Account Reference : IMPACC (IV)/ dl839103/ DELHI/ DL-DLH
Unique Doc. Reference : SUBIN-DL83910331631493157306N
Purchased by : V K AGARWAL
Description of Document : Article 12 Award
Property Description : Not Applicable
Consideration Price (Rs.) : 0
(Zero)
First Party : V K AGARWAL
Second Party : Not Applicable
Stamp Duty Paid By : V K AGARWAL
Stamp Duty Amount(Rs.) : 100
(One Hundred only)



.....Please write or type below this line.....

NATIONAL INTERNET EXCHANGE OF INDIA
Flat No. 6B, 6th Floor, Uppals M6 Plaza,
Jasola District Centre,
New Delhi – 110 025

M/s Thoughtworks Inc., v. M/s Super Software Pvt . Ltd

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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.
2. The onus of checking the legitimacy is on the users of the certificate.
3. In case of any discrepancy please inform the Competent Authority.

AWARD

1. The Parties

The Complainant is M/s Thoughtworks Inc., 25th Floor, 200 East Randolph, Chicago, IL 60661, United States of America

The Respondent is Super Software Pvt . Ltd., AI – 93, 9th Main Road, Anna Nagar, Chennai – 600 040 Tamil Nadu

2. The Domain Name and Registrar

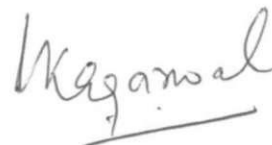
The disputed domain name is <www.thoughtworks.in>. The said domain name is registered with Crazy Domains FZ-LLC (R160-AFIN).

The details of the disputed domain name are as follows:

- (a) Domain ID : D8890081-AFIN
- (b) Date of creation : 31st October 2014
- (c) Expiry date : 31st October 2015

3. Procedural History

- (a) A Complaint dated 05th May 2015 has been filed with the National Internet Exchange of India. The Complainant has made the registrar verification in connection with the domain name at issue. The print outs so received are attached with the Complaint as Exhibit G. It is confirmed that the Respondent is listed as the registrant and provided the contact details for the administrative, billing, and technical contact. The Exchange verified that the Complaint satisfied the formal requirements of the Indian Domain Name Dispute Resolution Policy (INDRP) (the “Policy”) and the Rules framed thereunder.
- (b) The Exchange appointed Dr. Vinod K. Agarwal, Advocate and former Law Secretary to the Government of India as the sole arbitrator in this matter in May 2015 and the Complaint was received by the Sole Arbitrator on 04th June 2015. The arbitrator finds that he was properly appointed. The



Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Exchange.

- (c) In accordance with the Indian Domain Name Dispute Resolution Rules, on 08th June 2015 the Sole Arbitrator notified the Respondent along with a copy of the Complaint through a registered postal letter on the address mentioned in the Complaint and the WHOIS record. The Respondent was required to convey his response to the Complaint within 15 days from the date of receipt of the said letter and in any case latest by 26th June 2015. The Respondent was informed that if his response was not received by the Arbitrator by that date, the Respondent would be considered in default and the Arbitrator would still proceed to decide the dispute.
- (d) On 26th June 2015 the Respondent has submitted his response through e mail to the Arbitrator.

4. Factual Background

From the Complaint and the various annexure to it, the Arbitrator has found the following facts:

Complainant's activities

- (a) About the Complainant's activities, the Complaint states as follows:

“It is imperative to note that the Complainant under its trademark and trading style **THOUGHTWORKS** is also the trading style, which appears on all the services/products of the Complainant.” (Paragraph 6 a)

- (b) The Complaint does not specifically indicate the services and/or products provided by the Complainant. It also does not indicate the year Complainant was incorporated, the State of its incorporation, the location or address of its registered/corporate office and nature of activities of the Complainant. As will be discussed later on, these are vital facts for taking an appropriate decision on the Complaint. The Complaint only states that the Complainant was founded in Chicago over 20 years ago. It is a very vague statement.
- (c) The Complaint further says that the Complainant has “30 offices in 12



countries: Australia, Brazil, Canada, China, Ecuador, Germany, India, Singapore, South Africa, Uganda, the United Kingdom and the United States of America.” However, the nature of activities carried on in these 30 offices in 12 countries has not been clearly mentioned or indicated in the Complaint. However, from various Annexures attached to the Complaint, some activities of the Complainant can be known. It appears that the Complainant is carrying on the business of software development.

Respondent’s Identity and Activities

The Respondent has submitted his response through e mail.

5. Parties Contentions

A. Complainant

The Complainant contends that each of the element specified in the Policy is applicable to this dispute.

In relation to element (i), the Complainant contends that it is one of the leading companies providing various services and products to various customers. Further that,

“The Complainant’s mark **THOUGHTWORKS** is arbitrary in nature as the same does not refer to the nature of goods/services covered under the same. The arbitrary adoption coupled with the long and continuous use has led to the exclusive association of the mark with the Complainant and no one else. Accordingly, the subsequent adoption, use or promotion by any third party, a mark identical with or deceptively similar to the Complainant’s mark would itself be contrary to law of equity. ”

According to the Complaint, the trademark of the Complainant “THOUGHTWORKS” is registered (or registration applications are pending) in many countries, such as, Australia, Brazil, Hong Kong, Canada, Kenya, Singapore, the United Kingdom, and the United States of America.

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It is further stated in the Complaint that so far as India is concerned, the position is as follows:

Trade Mark	Registration/ Application No.	Class	Status
THOUGHTWORKS	1019484	9	Mark registered and valid upto 22 nd June 2021
THOUGHTWORKS	1966240	9	Pending
THOUGHTWORKS	1966239	42	Advertised in TMJ 1662

In other words, according to the aforesaid information, the trademark "THOUGHTWORKS" is already registered in India in Class 9. However, the Complaint only indicates the validity date but has omitted (i) to indicate the date of registration of the said trademark or (ii) to submit a copy of the registration certificate along with the Complaint.

The Complainant is also the owner of one another domain name incorporating the word "THOUGHTWORKS", that is, <www.thoughtworks.com>. Therefore, the disputed domain name is similar or identical to the registered trademark of the Complainant.

The Complaint states that the Respondent's domain name is identical and similar to the trading style and trademark in which the Complainant has prior rights. Further that, "the Complainant already has a domain name as www.thoughtworks.com and thus the consumers and the members of the trade would get confused that the impugned domain name also belongs to the Complaint and is its India specific domain name. The Respondent's domain name incorporates in its entirety the reputed mark **THOUGHTWORKS** of the Complainant in which the Complainant has statutory rights as well as rights under common law.

In relation to element (ii), the Complainant contends that the Respondent has not been commonly known by the mark "thoughtworks". The name of the Registrant/Respondent organization is Super Software Pvt. Ltd. Further, the Respondent registered the domain name for the sole purpose of creating confusion and misleading the general public.

V. K. Agarwal

Regarding the element at (iii), the Complainant contends that the main object of registering the domain name <www.thoughtworks.in> by the Respondent/Registrant is to mislead the general public and the customers of the Complainant. The Complainant contends that there is a great likelihood that an actual or potential visitor to the Respondent's present web page will be induced to:

- "Believe that the Complainant has licensed the trademark **THOUGHTWORKS** to the Respondent or has authorized the Respondent to register the disputed domain name.
- Believe that the Respondent has some connection with the complainant in terms of a direct nexus or affiliation with the Complainant or has been authorized by the Complainant."

The Complainant has stated that the use of a domain name that appropriates a trademark to promote competing or infringing products cannot be considered a "*bona fide offering of goods and services*".

In support of its contentions, the Complainant has relied on the decisions in the cases of *SAS Institute Inc. v. Farzad Bahreini*, FAO207000115038 (Net. Arb. Forum, August 26, 2001) and *Taco Bell Co. v. West Masters Casino*, dated 29th May 2008. In these cases it has been held that the addition of a top level country – domain such as "us" does not create a distinct mark capable of overcoming a claim of identical or confusing similarity.

B. Respondent

The Respondent contends that none of the elements specified in the Policy are satisfied by the Complainant.

In relation to element (i), the Respondent contends that the domain "thoughtworks" was registered by the Respondent in October 2014 with a **corporate objective** to launch a start up incubator under a specific brand which included terms such as, "idea+factory", "brain+works", "launch+pad" etc. One of the domains available after a drop or deletion a few days later in

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the month was “thought+works”, which we secured upon release”.

Further that, the “**generic nature in a combined phrase** was deemed harmless and not infringing on any one’s existing Indian trademark or Copyright at that time. As the Complainant have themselves quoted under section 6(1/c) it is “**arbitrary in nature and does not refer to goods or services offered**” by the Complainant.”

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According to “Whois” history, for well over a decade, the Complainant was not the owner of the domain. That the Complainant never needed to secure this name for this period in order to protect their business is hard to believe and cannot be merely negligence on their part.

The Respondent has further contended that they registered the disputed domain name in the month of October 2014. At that time only the Complainant’s application for registration of the trademark “thoughtworks” was accepted and approved in a specific class i.e. 42 whereas their application in class 41 and an application under class 9 was objected. These facts have been suppressed and have not been mentioned in the Complaint indicating mala fide intention.

Therefore, the Complainant’s claim that the Respondent intended to or has infringed on their rights should be denied as per clause 1 of section 4 of the IN Dispute Resolution Policy.

In relation to element (ii), the Respondent contends that the Complainant is a Technology Service company, which neither transacts any business online nor offers any e - Commerce related services. Further that, the Complainant is simply redirecting its potential clients to the “COM” extension. The Complainant also does not own every ccTLD extension where they have a presence worldwide.

In relation to element (iii), the Respondent contends that the Respondent has never contacted the Complainant with any intent to sell this domain name. The Complainant has also made no effort ever to contact the Respondent to disclose or resolve this matter amicably before proceeding to arbitration. The claim of the Complainant that the potential customers based in India would be lost looking for the Complainant if the Complainant does not have the “IN” extension has no substance and has been falsely claimed by the Complainant.

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The Respondent has further stated as follows:

“f) We also discovered that the Complainant has owned and operated the exact domain using the NIXI administered “**co.in**” extension which has redirected for years to the “com” extension which has only an informal website. This is another fact **the Complainant has suppressed** in their complaint under section 6/II/i) of their complaint.”

In any case, the Respondent has not registered the disputed domain name in bad faith.

6. Discussion and Findings

The Rules instructs this arbitrator as to the principles to be used or adopted in rendering its decision. It says that, “a panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, the Arbitration and Conciliation Act, 1996, the Rules and any rules and principles of law that it deems applicable”.

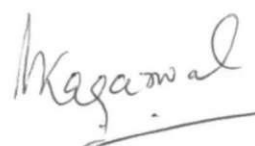
According to the Policy, the Complainant must prove that:

- (i) The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) The Respondent has no rights or legitimate interests in respect of the domain name that is the subject of Complaint; and
- (iii) The domain name in question has been registered and is being used in bad faith and for the purposes of trafficking;

A. Identical or Confusingly Similar

- (a) The **first** aspect that deserves consideration is that according to Q 1 of Annexure E of the Complaint, the trademark “Thoughtworks” is owned by the following company:

“Thoughtworks Inc., (Illinois Corp).
25th Floor, 200 East Randolph,
Chicago, IL 60601,
United States of America



- (b) However, according to Q 2 of Annexure E of the Complaint, the trademark "Thoughtworks" is owned by the following company:

Thoughtworks Inc., **(Delaware Corp)**
25th Floor, 200 East Randolph,
Chicago, IL 60601,
United States of America.

- (c) Further, according to Q 11 of Annexure E of the Complaint, so far as India is concerned, the trademark "Thoughtworks" is owned by the following company:

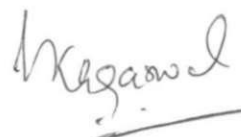
Thoughtworks Inc., (Body Incorporated)
651, W Washington Boulevard,
Chicago, IL **60661,**
United States of America.

In the Complaint there is no explanation available about the aforesaid discrepancies. Copies of the Certificate of Incorporation are not available. Therefore, it is difficult to hold whether, in India, the Complainant having its office at 25th Floor, 200 East Randolph, Chicago, IL 60601 is the owner of the trademark "Thoughtworks".

Further, though it is stated that "THOUGHTWORKS" is registered (or registered applications are pending) as trademark of the Complainant in many countries, such as, Australia, Brazil, Hong Kong, Canada, India, Kenya, Singapore, the United Kingdom, and the United States of America.

However, along with the Complaint not even one single copy of the Certificate of Registration of the trademark of any country, including India, has been submitted or provided. The Complaint does not indicate even the date of registration of the trademark "THOUGHTWORKS" in India.

Therefore, I find it difficult to hold that the trademark "thoughtworks" belongs to the Complainant or, if at all, that the domain name <www.thoughtworks.in> is confusingly similar or identical to the trademark of the Complainant.



B. Rights or Legitimate Interests

The Respondent may demonstrate its rights to or legitimate interest in the domain name by proving any of the following circumstances:

- (i) before any notice to the Respondent of the dispute, the Respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the Respondent (as an individual, business or other organization) has been commonly known by the domain name, even if the Respondent has acquired no trademark or service mark rights; or
- (iii) The Respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent has demonstrated that he is carrying on business very much similar to the business of the Complainant. Further that, the Respondent is making a legitimate and fair use of the domain name. Therefore, it is concluded that the above circumstances exist in this case and that the Registrant/Respondent has rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

Any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration or use of the domain name in bad faith:

- (i) Circumstances indicating that the Respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of documented out of pocket costs directly related to the domain name; or

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- (ii) The Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that it has engaged in a pattern of such conduct; or
- (iii) The Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) By using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, internet users to its website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on its website or location.

The contention of the Complainant is that the present case is covered by the above circumstances. The Respondent has intentionally attempted to attract, for commercial gain, internet users to its web site, by creating a likelihood of confusion with the Complainant's trademark.

The important aspect which deserves consideration is that, according to Annexure A to the Response dated 28th June 2015 submitted by the Respondent, the domain name "Thoughtworks" was created/registered earlier also. The details are as follows:

(a) Domain name	:	THOUGHTWORKS.IN
(b) Domain ID	:	D2094894-AFIN.
(c) Created on	:	18 th August 2005
(d) Expired on	:	18 th August 2011
(e) Registrar	:	Net4Indiaq (R7-AFIN)
(f) Registrant	:	Catakam, Emantras, #35/1, 3 rd Street, Abiramapuram, Alwarpet, Chennai 600 018

In the present Complaint the Complainant has not mentioned the aforesaid information either ignorantly or deliberately.

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Another aspect is that Catakam, Emantras, #35/1,3rd Street, Abirama - puram, Alwarpet, Chennai 600 018, India has owned/possessed the disputed domain name "Thoughtworks.in" for almost 6 years. For the reasons best known to the Complainant, the Complainant has not claimed the said disputed domain name during the aforesaid period of 6 years.

Further, the said domain name remained unregistered and freely available between the period from 18th August 2011 till the Respondent registered the same on 31st October 2014.

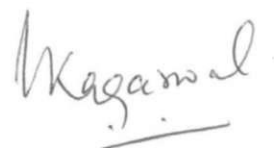
The Complainant has not claimed the said disputed domain name even during the aforesaid period of almost 3 years. According to the Annexure A to the Complaint, the Complainant has established an office in Bangalore, India in May, 2011. Further, according to Annexure E (The Annexure pages are serially not numbered by the Complainant. Hence, the specific page cannot be referred) the Application for the registration of the trademark was filed on June 22, 2001 and it was published on October 14, 2003.

The Complainant has not offered any explanation as to why any action was not taken for all these years.

Additionally, the Respondent has stated that they had no knowledge of the Complainant's claimed trademark when they registered the disputed domain name <www.thoughtworks.in>.

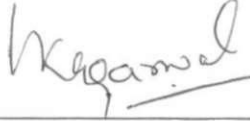
It is neither the case of the Complainant nor there is any evidence on record to establish the fact that the Respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or to a competitor of that Complainant, for valuable consideration.

Therefore, I conclude that the Complaint fails to establish the elements (i) to (iv) mentioned above. The Complainant has also failed to establish the fact that the disputed domain name was registered and used by the Respondent in bad faith.



7. Decision

In light of the foregoing findings, there is no merit in the Complaint and is dismissed.



Vinod K. Agarwal
Sole Arbitrator

Date: 12th July 2015