

Annexes



ADNDRC

**Sample
Decisions**

Table of Contents

- I. AIAC-ADNDRC-797-2019 (English)**
- II. AIAC-ADNDRC-937-2021 (English)**
- III. CN-1500909 (Chinese)**
- IV. CN-1600936 (Chinese)**
- V. HK-2001374 (English)**
- VI. HK-2101461 (English)**
- VII. KR-2100232 (Korean)**

**Asian Domain Name Dispute Resolution Centre
(Kuala Lumpur Office)**

ADMINISTRATIVE PANEL DECISION

Case No. AIAC/ADNDRC-797-2019

Complainant: Hitachi, Ltd
Respondent: Privacy Proxy/Privacy Protection Service by VALUE-DOMAIN
Disputed Domain Name: <www.hitachi-idi-holding.com>

1. The Parties and Contested Domain Name

The Complainant is Hitachi, Ltd., of 6-6, Marunouchi 1-chome, Chiyoda-ku, Tokyo, Japan.

The Respondent is Privacy Proxy/Privacy Protection Service by VALUE-DOMAIN, of Chuo-ku Minamisenba 3-1-8, Osaka, Japan, of contact email at info1@hitachi-idi-holding.com.

The domain name at issue is <www.hitachi-idi-holding.com>, registered by the Respondent with Key-Systems GmbH, of contact email at: abuse@key-system.net.

2. Procedural History

On 11 November, 2019, the Complainant's authorized representative, Mike Rodenbaugh of Rodenbaugh Law, 548 Market Street, Box No. 55819 San Francisco, CA 94014, email: mike@rodenbaugh.com, submitted the Complaint with Annexures, in English, against the Respondent's registration of the disputed domain name <www.hitachi-idi-holding.com> to the Kuala Lumpur Office of the Asian Domain Name Dispute Resolution Centre (ADNDRC) (the Kuala Lumpur Office), in accordance with the Uniform Domain Name Dispute Resolution Policy (UDRP) adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on 24 October, 1999, the Rules for UDRP (the Rules) approved by the ICANN Board of Directors on 28 September, 2013, and ADNDRC's Supplemental Rules for UDRP (Supplemental Rules) effective from 31 July, 2015. The Complainant requested a single person panel.

On 17 January, 2020, the Kuala Lumpur Office sent to the Respondent a written notice in English, informing the Respondent, among others, about the commencement of the proceedings and that the Respondent had to submit a Response within 20 days i.e. on or before 6 February, 2020, in accordance with para. 5 (The Response) of the Rules and the Supplemental Rules.

The Kuala Lumpur Office did not receive a Response from the Respondent in respect of the Complaint by the due date.

On 7 February, 2020, the Kuala Lumpur Office appointed Mr. Peter Cheung Kam Fai as the Sole Panelist in the present dispute, who had confirmed that he was available to act impartially and independently between the Parties in this matter. The Panel finds that the Administrative Panel was properly constituted and appointed in accordance with the Rules and the Supplemental Rules.

3. Factual background

A. The Complainant

Hitachi, Ltd. (“Hitachi” or “Complainant”) is a Japanese multinational company that offers innovative, world class consumer, business, government products, and services. Hitachi’s products range from telecommunications and infrastructure solutions to construction machinery and electronic systems and equipment. Hitachi currently employs about 300,000 people worldwide (consolidated data) and provides products and services around the globe, including in Japan, Germany, and the United States. Information about Complainant can be found at the website <hitachi.com> (“Complainant’s Website”). True and correct copies of screenshots of the <hitachi.com> website are attached as Annex 3.

Hitachi was founded in 1910, and has continuously used the HITACHI mark in global commerce since then - for well over 100 years. Hitachi has also registered the HITACHI mark in numerous jurisdictions throughout the world, including but not limited to the United States, Germany, the EU, and Japan, where Respondent is allegedly located:

Trademark	Jurisdiction	Registration No.	Registration Date
HITACHI	USA	0701266	1960-07-19
HITACHI	Japan	433710	1953-10-29
HITACHI	Japan	1492488	1981-12-25
HITACHI	EUTM	000208645	1999-12-21
HITACHI	EUTM	001070192	2000-09-19
HITACHI	EUTM	002364313	2002-11-27
HITACHI	EUTM	002809903	2003-10-03
HITACHI	United Kingdom	UK00000811836	1960-10-11
HITACHI	Germany	772224	1963-04-03
HITACHI	Germany	2079719	1994-10-07

True and correct copies of Hitachi’s trademark registration certificates and/or printouts from the corresponding trademark office websites are attached as Annex 4. Hitachi has invested copious

amounts of time and money to promote the ubiquitous HITACHI brand. As such, consumers around the world have come to associate Hitachi with the HITACHI marks and brand. Through such longstanding and exclusive use by Hitachi, the HITACHI mark is famous in Japan, the United States, Germany, and throughout the world.

B. The Respondent

The Respondent is Privacy Proxy/Privacy Protection Service by VALUE-DOMAIN. The Respondent in this administrative proceeding is unknown as the registrant's information on the Whois record for the disputed domain is redacted.

The Whois information for the <hitachi-idi-holding.com> domain name (the "Disputed Domain") does not reveal any personal or contact information about Respondent. See Annex 1. Nor can Complainant confirm via the Whois record for the Disputed Domain where registrant is located because the relevant contact information has been redacted. *Id.* However, based on the information provided on the website associated with the Disputed Domain (the "Infringing Website"), the registrant is believed to be located in Japan. True and correct copies of screenshots of the website found at <hitachi-idi-holding.com> and their English Google translated versions are attached as Annex 5.

The Infringing Website is a Japanese language website. The Infringing Website contains the text "Hitachi IDI Holding" in the top banner throughout the website, including the 'home', 'about us'/'information' and 'contact' pages. *Id.* Respondent markets itself as a "Financial Services Agency" that offers "asset management and asset formation" services. *Id.* Respondent states in the "Company Profile" that it is registered to do business in the Kanto region in Japan ("Registered as a Second-class Financial Instruments Business Operator, Director of Kanto Local Finance Bureau", "Investment Advisory/ Agent Registration Director of Kanto Local Finance Bureau", "Registered as an investment advisor, Director of Kanto Local Finance Bureau", "Special business for qualified institutional investors (Jupiter Jupiter H21.9.2) Kanto Local Finance Bureau"). *Id.* Users looking for more information and/or to contact Respondent, are directed to a third-party website and prompted to enter their contact information. *Id.*

Despite Respondent's assertions that it is registered to do business as a financial services agency, on July 15, 2015, the Kanto Local Finance Bureau issued a warning concerning Respondent (the "Warning"). The Warning stated: Under the Financial Instruments and Exchange Act, unregistered traders are prohibited from displaying information indicating that they are engaged in the financial instruments business without obtaining registration under the Financial Instruments and Exchange Act. A true and correct copy of a screenshot of the warning issued by the Kanto Local Finance Bureau and English Google translated version of the same is attached as Annex 6. The Warning further stated: **Beware of unregistered suppliers!** There are many troubles with unregistered companies, especially elderly people, regarding transactions of stocks, bonds, funds, etc.

4 Parties' Contentions

A. The Complainant

No Business Relationship Exists Between The Parties

Respondent does not have, and never has had, permission to use the HITACHI trademark.

i) THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS: Complainant Hitachi Has Prior, Valid Trademark Rights In The HITACHI Mark

A complainant may satisfy the threshold requirement for standing under Paragraph 4(a)(i) of the Policy by demonstrating ownership of a valid trademark. *See F. Hoffmann-La Roche AG v. Relish Enterprises*, Case No. D2007-1629 (WIPO December 17, 2007) (quoting “WIPO Decision Overview” at §1.1). Here, Complainant’s United States, Japanese, European, and German trademark registrations for the HITACHI mark establish Hitachi’s prior rights pursuant to paragraph 4(a)(i) of the Policy. Complainant’s trademark rights in the HITACHI mark date back to at least 1953, when the mark registered in Japan, where Respondent is allegedly located; whereas, the <hitachi-idi-holding.com> Disputed Domain was not even created until May 2009, over 55 years after Complainant registered its HITACHI mark in and Japan.

The Disputed Domain Is Confusingly Similar To Complainant’s Trademark

The burden to establish confusing similarity is low, but in this case is extremely obvious. Research in *Motion Limited v. One Star Global LLC*, Case No. D2009-0227 (WIPO Apr, 9, 2009). A showing of confusing similarity only requires a “simple comparison of the mark relied upon with the domain name in issue.” *Id.* Here, a simple comparison of the HITACHI mark and the Disputed Domain demonstrates that the Disputed Domain is not only confusingly similar, but nearly identical to the HITACHI mark. The Disputed Domain <hitachi-idi-holding.com> is comprised of the HITACHI trademark (in its entirety) merely adding the generic term ‘holding’ and acronym ‘idi’.

It is well established that the incorporation of a well-known trademark within a domain name (as is the case here) is alone enough to sustain a finding of confusing similarity. *See, e.g., Hitachi, Ltd. v. Zlatan Irving*, Case No. 102466 (CAC May 29, 2019) (finding <hitachi-hihgtech.com> confusingly similar to HITACHI); *Hitachi, Ltd. v. William Cooper*, Case No. 102603 (CAC July 26, 2019) (finding <hitachifoundation.org> confusingly similar to HITACHI); *Fujitsu Ltd. v. Thomas Ruben*, Case No. 101592 (CAC Jul. 18, 2017) (finding the <fujitsu-global.com> domain name confusingly similar to complainant’s FUJITSU mark); *SoftCom Technology Consulting Inc. v. Olariu Romeo/Orv Fin Group S.L.*, Case No. D2008-0792 (WIPO Jul. 8, 2008) (finding the domain name <myhostingfree.com> to be confusingly similar to complainant’s MYHOSTING mark, stating, “This similarity is established whenever a mark is incorporated in its entirety, regardless of other terms added to the domain name.”).

Moreover, the mere addition of a generic term to a trademark, in this case ‘holding’, does not avoid a finding of confusion. *Sharman License Holdings, Limited v. Mario Dolzer*, Case No. D2004-0935 (WIPO Jan. 31, 2006); *see also, e.g. Fujitsu Ltd. v. Thomas Ruben*, Case No. 101592 (CAC Jul. 18, 2017) (“It is well established that the addition of a generic term to a trademark does not avoid a finding of confusion.”); *Hitachi, Ltd. v. Zlatan Irving*, Case No. 102466; *Hitachi, Ltd. v. William Cooper*, Case No. 102603. Nor does the addition of an acronym allow a Registrant to escape a finding of confusing similarity. The panel in *Pima Federal Credit Union v. Whois Privacy Corp.* stated: The Panel considers

the disputed domain name <pimafcu.com> to be confusingly similar to the PIMA FEDERAL CREDIT UNION trademarks. [T]he disputed domain name contains the most distinctive element of the Complainant's trademark and adds the letters 'fcu', which can be seen as an acronym for 'federal credit union'. Case No. 100979 (CAC July 16, 2015) (finding confusing similarity). Similarly here, the addition of the acronym 'idi' does not create a new mark, as the acronym only abbreviated three similarly generic terms - industrial, development, and international. See Annex 5. Further, the addition of the generic top-level domain ".com" does nothing to distinguish the Disputed Domain from Complainant's mark. See *InfoSpace.com, Inc. v. Ofer*, D2000-0075 (WIPO Apr. 27, 2000) (finding that "[t]he domain name 'info-space.com' is identical to Complainant's INFOSPACE trademark. The addition of a hyphen and .com are not distinguishing features"); *Hitachi, Ltd. v. Zlatan Irving*, Case No. 102466. A simple comparison of the HITACHI mark and the Disputed Domain demonstrates that the two are confusingly similar, and any additions of generic terms, acronyms, and/or top-level domains are negligible. Therefore, Complainant has established the first element of the Policy under paragraph 4(a).

ii) THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DOMAIN NAME:

The second element of a UDRP claim only requires that the complainant make a prima facie showing that respondent lacks a right or legitimate interest in the disputed domain name. *Accor v. Eren Atesmen*, Case No. D2009-0701 (WIPO Jul. 10, 2009). Once a complainant has made such a showing, the burden shifts to the respondent to demonstrate that it has rights or legitimate interest in the disputed domain name. See, e.g., *Mile, Inc. v. Michael Burg*, Case No. D2010-2011 (WIPO Feb. 7, 2011). In this case, it is clear that Respondent has no rights or legitimate interest in the Disputed Domain. See Paragraph 4(c). Respondent not only registered the Disputed Domain many decades after Complainant's rights in the HITACHI mark were registered, but is using the Disputed Domain as a front for an unregistered "financial services agency" and to confuse consumers as to the source of the website, prompting users to potentially reveal sensitive personal information for Respondent's own gain. See Annex 5.

Respondent Does Not Use, And Has Not Used, The Disputed Domains In Connection With A Bona Fide Offering Of Goods Or Services

The use of a domain name that is confusingly similar to a complainant's mark to pose as a "financial services agency" (one that is unregistered and has been publicly warned about its conduct by the local Japanese finance bureau) and/or for the purposes of "phishing" is not a bona fide offering of goods and services. *Blackstone TM L.L.C. v. Mita Ireland Limited c/o Michael Buotenko*, Claim No. FA1003001314998 (Nat. Arb. Forum April 30, 2010). Here, Respondent has created a deliberate false association with Complainant by using Complainant's HITACHI mark, copied in its entirety, within the Disputed Domain to operate a website that is posing as a registered financial services company. Such a deliberate, false association with Complainant's trusted HITACHI mark, means users are likely to reveal highly sensitive and personal, financial information to Respondent, solely for Respondent's own gain, which does not constitute a bona fide offering of goods or services. See, e.g., *Fujitsu Ltd. v. Thomas Ruben*, Case No. 101592 (CAC Aug. 16, 2017) "the use of a domain name to "phish for" or to deceptively gather consumer information, is not a legitimate or noncommercial fair use."); *Blackstone TM L.L.C.*, Claim No. FA1003001314998 (finding no bona fide use when the disputed domain resolved

to the website of a “purported” financial company); *Allianz of America Corporation v. Lane Bond d/b/a Allianzcorp*, Claim No. FA0604000690796 (Nat. Arb. Forum June 12, 2006) (finding that respondent’s use of the disputed domain “to fraudulently acquire the personal and financial information of Internet users” was not a bona fide use.).

Respondent Is Not Commonly Known By The Disputed Domain

There is no evidence that Respondent is commonly known by the Disputed Domain. *See Braun Corp. v. Loney*, Claim No. 699652 (NAF July 7, 2006) (finding respondent was not commonly known by the disputed domain names where neither the Whois record or any other evidence of record indicated such). Respondent’s use of a privacy service to mask its identity only further supports the notion that Respondent is not commonly known by the Disputed Domain. *See LK International AG v. Fundacion Private Whois*, Case No. D2013-0135 (WIPO Mar. 4, 2013) (finding that the respondent was not commonly known by the disputed domain where respondent employed a privacy service and the Whois record gave no indication that respondent was commonly known by the disputed domain); *Pima Fed. Credit Union v. Whois Privacy Corp.*, Case No. 100979 (CAC Aug. 20, 2015) (same).

Respondent Does Not Use The Disputed Domains For Any Legitimate Or Noncommercial Fair Use

The use of a domain name to “phish for” or to deceptively gather consumer information is not a legitimate or noncommercial fair use. *See, e.g., Fujitsu Ltd. v. Thomas Ruben*, Case No. 101592; *Blackstone TM L.L.C.*, Claim No. FA1003001314998; *Allianz of America Corporation v. Lane Bond d/b/a Allianzcorp*, Claim No. FA0604000690796 (Nat. Arb. Forum June 12, 2006) (finding that respondent’s use of the disputed domain “to fraudulently acquire the personal and financial information of Internet users” was not a legitimate noncommercial or fair use.). Here, Respondent is merely using the Disputed Domain to direct Internet users to a “phishing” website, i.e. the Infringing Website, where Respondent seeks (via a third party website contact form) to gather user information, which can, upon information and belief, be used to solicit highly sensitive user information due to the purported nature of Respondent’s business (a “financial services agency”), including highly confidential financial information. Such use of the Disputed Domain cannot, therefore, constitute any legitimate noncommercial or fair use. Hitachi has met its burden to make a prima facie showing that the Respondent has no rights or legitimate interest in the Disputed Domain. As such, the burden shifts to the Respondent to rebut Complainant’s showing. However, the evidence strongly demonstrates that Respondent lacks any rights or legitimate interest in the Disputed Domain and will be unable to meet this burden.

iii) THE DISPUTED DOMAIN NAME HAS BEEN REGISTERED AND IS BEING USED IN BAD FAITH:

Respondent Intentionally Attempted To Divert Internet Users By Creating Likelihood Of Confusion

A respondent has registered and/or used a domain name in bad faith where the purpose of the registration is to confuse consumers as to the source of the website. *See Paragraph 4(b)(iv)*. Here, Respondent is clearly attempting to create a likelihood of confusion as to the source, sponsorship,

affiliation and/or endorsement of the websites associated with the Disputed Domain. Not only does Respondent use Complainant's HITACHI mark without authorization, but Respondent also employs language to lead consumers to believe that the Infringing Website was created by Hitachi. For example, Respondent prominently displays the HITACHI mark at the top of the home page of the Infringing Website. *See* Annex 5; *see also H-D Michigan, Inc. v. Petersons Automobile a/k/a Larry Petersons*, FA 135608 (Nat'l Arb. Forum Jan. 8, 2003) (finding the disputed domain was registered and used in bad faith where "Respondent [] intentionally attempt[ed] to attract Internet users to its fraudulent website by using Complainant's famous marks and likeness"). Moreover, Respondent engages in such activities in connection with the HITACHI mark, and in spite of the Warning it received in 2015. *See* Annexes 5, 6.

Respondent Registered the Disputed Domain Primarily For The Purpose Of Disrupting Complainant's Business

Respondent is using the Disputed Domain for no other reason than to disrupt Complainant's business by using the associated Infringing Website to "phish" for individuals to target and obtain their personal information under the guise of providing purported financial services. *See* Annex 5. Many Panels have ruled that "phishing" activity disrupts business within the provisions of paragraph 4(b)(iii) of the Policy. *See, e.g., Fujitsu Ltd. v. Thomas Ruben*, Case No. 101592 ("The Panel also notes that the Respondent is using the disputed domain name for no other reason than to disrupt Complainant's business by using the associated Infringing Website to "phish" for highly sensitive personal information under the guise of providing purported financial services ..."); *Blackstone TM L.L.C.*, Claim No. FA1003001314998 (finding that respondent had disrupted complainant's business by "using the disputed domain to 'phish' for users' personal information", and that, "[r]espondent presumably profits" from the action). Clearly Respondent is not operating a legitimate business, else it would not need to rely on duping consumers into believing that it was associated with Complainant. Moreover, the fact that Respondent has received a public Warning, yet continues to engage in such activities in connection with the HITACHI mark is further evidence of Respondent's bad faith and intent to trade off the Hitachi name and goodwill therein.

Respondent Was Or Should Have Been Aware Of Complainant's Rights In The HITACHI Mark and Registered The Disputed Domain In Bad Faith

Complainant's trademark rights date back to at least as early as 1953. Since that time Complainant has expended substantial amounts of money and effort to ensure that consumers associate the HITACHI trademark with Hitachi and its services, discussed supra. The Disputed Domain was not created until well over fifty five years after Complainant's trademark rights were first registered, and is confusingly similar to the HITACHI trademark, discussed supra. The fact that Respondent displays the identical HITACHI trademark on the Infringing Website indisputably demonstrates that the Registrant was aware of the HITACHI trademark, and that Respondent registered the Disputed Domain with the bad faith intent to confuse consumers as to the source and/or sponsorship of the Disputed Domain. Even if Respondent did not have actual knowledge of the HITACHI mark (which it clearly did), Respondent had a duty to ensure that the registration of the Disputed Domain would not infringe a third party's rights. *See, e.g., Collegetown Relocation, L.L.C. v. John Mammaing*, FA 95003 (Nat'l Arb. Forum Jul. 20, 2000) (stating that "[w]hen registering domain names, the respondent has a duty to investigate and refrain from using a domain name that infringes on a third-party's rights"). Had Respondent performed a

simple Google search, it would have been presented with numerous search results relating and/or referring to Complainant and the existence of Complainant's rights in the HITACHI mark. A true and correct copy of screenshots of the Google search results (in the U.S. and Japan (with English translation)) for the term "hitachi" performed on September 30, 2019, is attached as Annex 7. It is clear that Respondent knowingly registered and has used the Disputed Domain to not only confuse customers as to the source of the Infringing Website, but also to disrupt Complainant's business, evidencing Respondent's bad faith use and registration of the Disputed Domain.

B. The Respondent

The Respondent is Privacy Proxy/Privacy Protection Service by VALUE-DOMAIN. The respondent in this administrative proceeding is unknown as the registrant's information on the Whois record for the disputed domain is redacted.

The Respondent did not file any Response in reply to the Complainant's contentions.

5. Findings

Applicable principles and rules

Under para. 14 (Default) of the Rules, in the event that a Party does not comply with any of the time periods established by the Rules, the Panel shall proceed to a decision on the complaint and the Panel shall draw such inferences as it considers appropriate. According to para. 15 (Panel Decisions) of the Rules, a Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the UDRP, the Rules, and any principles and rules of law that it deems applicable.

Language of the Proceedings

Under para. 11 (Language of Proceedings) of the Rules, the Panel has the authority to determine the language of the proceedings having regard to the circumstances. Para. 10(b) (General Powers of the Panel) of the Rules provides that the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case.

The general rule is that the parties may agree on the language of the administrative proceeding. In the absence of this agreement, the language of the Registration Agreement shall dictate the language of the proceeding. However, the Panel has the discretion to decide otherwise having regard to the circumstances of the case. The Panel's discretion must be exercised judicially in the spirit of fairness and justice to both parties taking into consideration matters such as command of the language, time and costs. It is important that the language finally decided by the Panel for the proceeding is not prejudicial to either one of the parties in his or her ability to articulate the arguments for the case.

Where a respondent does not respond to the complainant's communications (and thus it was not possible for the complainant to come to an agreement on the issue of the language of the proceeding), and the material facts of the proceeding are generally in English (eg, disputed domain name, the language of the respondent's and the complainant's websites, the services provided in the

websites, etc), the proceedings should be in English. This is so even if the respondent is on record not a native English speaker, if persuasive evidence has been adduced to suggest that the respondent is conversant and proficient in the English language. The objective is to ensure the maintenance of an inexpensive and expeditious avenue for resolving domain name disputes. Language requirements should not lead to undue burdens being placed on the parties and undue delay to the proceeding.

Upon weighing all the relevant and special circumstances of the Parties, the Panel determines that it is appropriate for the Panel to exercise its discretion to conduct the proceeding in English.

As to the main substantive issue of this matter, the UDRP provides, at Paragraph 4(a) (Applicable Disputes), that each of three findings must be made in order for a Complainant to prevail:

- i. the Respondent's domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- ii. the Respondent has no rights or legitimate interests in respect of the domain name; and
- iii. the Respondent's domain name has been registered and is being used in bad faith.

A) Identical / Confusingly Similar

The disputed domain name <www.hitachi-idi-holding.com> (Disputed Domain Name) is comprised of five elements: (1) "www." ie the World Wide Web, (2) "hitachi", (3) "-idi-", (4) "holding" and (5) the generic top-level domain ".com". As to "www.", the subdomain is a non-distinguishing feature. There is no actual need to include "www." in one's website address as it is a Uniform Resource Locator (URL) prefix caught on by old practice. As to ".com", it is trite rule that the generic top-level domain name suffix ".com" is technical in nature, does not have any proprietary significance, cannot confer any distinctiveness and is incapable of differentiating the Disputed Domain Name from others' proprietary rights. Thus both "www." and ".com", are disregarded under the confusing similarity test.

The potential distinctive elements of the Disputed Domain Name are: "hitachi", or "hitachi-idi-", or "hitachi-idi-holding". The Panel accepts that the generic term "holding" is a non-distinguishing feature. As to "idi", the Panel considers that the letters may be associated with an acronym standing for "industrial developments international", and, the hyphens between "hitachi" and "idi", and between "idi" and "holding", are also non-distinctive in the proprietary sense. The Panel takes the view that the dominant part of the Disputed Domain Name are the letters "hitachi" which are identical to the Complainant's trade mark. The addition of "-idi-holding" to the distinctive portion of the Disputed Domain Name does not create any proprietary significance. They do not draw a reasonable Internet user's attention away from the fact that the principal element of the Disputed Domain Name is identical to the Complainant's HITACHI mark, as it only indicates that the Disputed Domain Name is related to "-idi-holding".

It is trite rule that the evidential burden to establish confusing similarity requires a simple comparison of the mark relied upon with the disputed domain name in issue. The incorporation of a well-known trademark within a domain name is alone enough to sustain a finding of confusing similarity ie the

similarity is established whenever a mark is incorporated in its entirety, regardless of other terms added to the domain name. Thus, the Panel accepts that the mere additions of hyphenations, an acronym “idi” and a generic term “holding” to the HITACHI trademark does not avoid a finding of confusion.

The Panel agrees that the Complainant enjoys prior rights in its HITACHI Mark. Trademarks are not case sensitive. The Panel takes the view that considering the Disputed Domain Name as a whole, the addition of the non-distinctive letters “-idi-holding” at the end of “hitachi”, is identical or confusingly similar to the Complainant’s “hitachi” trade mark, does not confer to the whole a new meaning and does not dispel confusing similarity between the Disputed Domain Name as a whole and the Complainant’s proprietary trade mark.

The addition of “-idi-holding” in this case further increases the likelihood of confusion due to the Complainant’s notable presence in Japan, as the general public are likely to believe that the Disputed Domain Name relates to the Complainant’s official website in Japan and would further divert Internet users away from the Complainant’s official website at <hitachi.com>.

The Complainant has demonstrated that it owns the trademark registrations for its HITACHI mark in various jurisdictions, long before the Respondent applied to register the Disputed Domain Name on 17 May, 2009. When a registrant chooses to apply for the registration of a domain name, the registrant must represent and warrant, among other things, neither the registration of the domain name nor the manner in which it is directly or indirectly used infringes the legal rights of a third party. In this case, the Disputed Domain Name is confusingly similar to the Complainant’s registered HITACHI mark.

Given the worldwide renown, long-term use and established registered rights in the HITACHI Mark, and the above facts, the Panel finds that the Disputed Domain Name is confusingly similar to a trade mark in which the Complainant has rights, satisfying Paragraph 4(a) (i) of UDRP.

B) Rights and Legitimate Interests

The most distinctive element in the Disputed Domain Name is “HITACHI”, which is a widely known indicia of the Complainant. The Panel takes notice that the Respondent only registered the Disputed Domain Name over five decades after the Complainant’s rights in the HITACHI mark were registered, is using the Disputed Domain Name as a front for an unregistered “financial services agency” to confuse consumers as to the source of the website, prompting users to potentially reveal sensitive personal information for the Respondent’s own gain.

The Panel accepts that the use of the Disputed Domain Name that is confusingly similar to a Complainant’s mark to pose as a “financial services agency” (one that is unregistered and has been publicly warned about its conduct by the local Japanese finance bureau) and/or for the purposes of “phishing” is not a bona fide offering of goods and services. The Panel takes notice that the Respondent has created a deliberate false association with the Complainant by using the

Complainant's HITACHI mark, copied in its entirety, within the Disputed Domain Name to operate a website that is posing as a registered financial services company. Such a deliberate, false association with the Complainant's trusted HITACHI mark, means users are likely to reveal highly sensitive and personal, financial information to the Respondent, solely for the Respondent's own gain, which does not constitute a bona fide offering of goods or services. It is trite rule that such use of a Disputed Domain Name to "phish for" or to deceptively gather consumer information, is not a legitimate or noncommercial fair use, and is not a bona fide use.

The Panel notes that neither the Whois record nor any other evidence of record indicated the Respondent is commonly known by the Disputed Domain Name. The Panel agrees that the Respondent's use of a privacy service to mask its identity only further supports the notion that the Respondent is not commonly known by the Disputed Domain Name.

It is trite rule that the use of a domain name to "phish for" or to deceptively gather consumer information is not a legitimate or noncommercial fair use. The Panel accepts that the Respondent is merely using the Disputed Domain Name to direct Internet users to a "phishing" website, i.e. the Infringing Website, where the Respondent seeks (via a third party website contact form) to gather user information, which can, upon information and belief, be used to solicit highly sensitive user information due to the purported nature of the Respondent's business (a "financial services agency"), including highly confidential financial information. Such use of the Disputed Domain Name cannot, therefore, constitute any legitimate noncommercial or fair use.

As proving a negative is always difficult, it is a well-established rule that a complainant's burden of proof on this element is light. The Panel rules that there is *prima facie* evidence to prove that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. Since the Complainant satisfies the second requirement stipulated under Paragraph 4(a) of UDRP, it is up to the Respondent to discharge the evidential burden in demonstrating it has rights or legitimate interests in respect of the Disputed Domain Name.

The Respondent did not file any Response in reply to the Complainant's contentions.

It is trite rule that the mere registration of the Disputed Domain Name by the Respondent itself is not sufficient to prove that it owns rights and legitimate interests. The Panel takes the view that passing off the goodwill and reputation of others, which is contrary to the object and purpose of UDRP, cannot derive any rights or legitimate interests.

The Panel takes notice that after decades of commercial use, the "HITACHI" trade mark has acquired the recognition of the relevant sector of the public. The Complainant and the Respondent have no prior connection. The HITACHI mark is not a term commonly used in the English language. Further, the Respondent has submitted no evidence to demonstrate it has been commonly known by the Disputed Domain Name.

Nobody has any right to represent his or her goods or services as the goods or services of somebody else. The Complainant has not licensed or otherwise permitted the Respondent to use the Disputed

Domain Name or use any domain name incorporating the dominant part of the Complainant's registered trade mark.

The Panel considers that there is no evidence that would tend to establish that the Respondent has rights to or legitimate interests in respect of the Disputed Domain Name. The Panel draws the irresistible inference that the Respondent is not using the Disputed Domain Name on a non-commercial or fair use basis without intent to misleadingly divert the relevant sector of the public to its operation. On the contrary, the Respondent is using the Disputed Domain Name to tarnish the goodwill and reputation of the Complainant's trade mark.

The Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name, satisfying Paragraph 4 (a) (ii) of UDRP.

C) Bad Faith

Paragraph 4 (b) (Evidence of Registration and Use in Bad Faith) of UDRP provides that for the purposes of Paragraph 4 (a) (iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or*
- (ii) you have 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 you have engaged in a pattern of such conduct; or*
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor, or*
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site 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 your web site or location or of a product or service on your web site or location.*

The Panel takes notice that the Complainant's trademark rights date back to at least as early as 1953. Since that time the Complainant has expended substantial amounts of money and effort to ensure that consumers associate the HITACHI trademark with Hitachi and its goods and services. The Panel takes the view that the Complainant's HITACHI Mark has become well-known due to its long term and extensive use. The Disputed Domain Name was created on 17 May 2009 and updated on 18 May 2009 containing the HITACHI Mark in its entirety, and is confusingly similar to the HITACHI trademark. As the Respondent displays the Disputed Domain Name on the Infringing Website, the Panel takes the

view that it demonstrates that the Respondent's intent to confuse consumers as to its source and/or sponsorship. Given the goodwill and reputation of the Complainant and the HITACHI Mark globally including Japan, the Panel considers that it is virtually impossible for the Respondent to have selected the Disputed Domain Name without knowing it. The Respondent should have been well aware of the Complainant and the HITACHI Mark prior to registration, and the Panel accepts that the Disputed Domain Name has clearly been registered and is being used in bad faith.

By registering and using the Disputed Domain Name, the Panel accepts that the Respondent has prevented the Complainant from using its marks in a corresponding domain name, and disrupted the business of the Complainant. Worst still, it has also created confusion among the general public in respect of the relationship between the Respondent's Website and the Complainant, increasing the likelihood of confusion.

As no reasonable explanation was offered by the Respondent for its continued registration and use of the Disputed Domain Name, the Panel infers that the Respondent has done so with the intent to pass off the Complainant's goodwill and reputation in its HITACHI Mark, and lead Internet users into believing that the Disputed Domain Name and/or the Respondent's Website or the business and activities referred to therein are associated with, endorsed or sponsored by the Complainant in some way, or that the Respondent's use of the Disputed Domain Name is authorized by the Complainant, or to attract Internet traffic by capitalizing on the association of "HITACHI" with the Complainant's HITACHI Mark, and further keep the Disputed Domain Name from being used by the Complainant. It is well established that use of the Disputed Domain Name merely intended to divert the public to the Respondent's Website cannot be considered as a bona fide offering of goods and services.

The Respondent's use of the Disputed Domain Name might even be attributable to the Complainant, which would tarnish not only the goodwill and reputation accumulated in the HITACHI Mark, but also disrupt the business of HITACHI. The Panel accepts that these are further evidence that the Disputed Domain Name is being used in bad faith.

The Panel notes that the Respondent is using the Disputed Domain Name for no other reason than to disrupt Complainant's business by using the associated Infringing Website to "phish" for users' personal information under the guise of providing purported financial services for gain. The Respondent is not operating a legitimate business, else it would not need to rely on duping consumers into believing that it was associated with the Complainant. The fact that the Respondent has received a public Warning, yet continues to engage in such activities in connection with the HITACHI mark is further evidence of the Respondent's bad faith and intent to pass off the Hitachi's goodwill and reputation.

The Panel takes notice that not only does the Respondent use the Complainant's HITACHI mark without authorization, but the Respondent also employs language to lead consumers to believe that the Infringing Website was created by Hitachi. The Respondent also displays prominently the Disputed Domain Name at the top of the home page of the Infringing Website and continues to engage in such activities in spite of the Warning it received in 2015.

The Panel considers that even if the Respondent did not have actual knowledge of the HITACHI mark, the Respondent had a duty to ensure that the registration of the Disputed Domain Name would not infringe a third party's rights. The Respondent has to investigate and refrain from so doing. A simple Google search would have been presented with numerous search results relating and/or referring to the Complainant and the existence of the Complainant's rights in the HITACHI mark. The Panel agrees that the Respondent's probable breach of the warranty divests it of any and all rights in the Disputed Domain Name.

It is trite rule that use which intentionally passes off the goodwill and reputation of another cannot constitute a "bona fide" offering of goods or services. Further, the Respondent has provided no evidence to demonstrate use of the Disputed Domain Name registered on 17 May, 2009 in good faith. The Panel draws the irresistible inference that the Respondent must have prior knowledge of the Complainant's "HITACHI" trade mark. The Panel takes the view that the Respondent, by registering the Disputed Domain Name, is a dishonest misappropriation of the Complainant's registered trade mark, making the Respondent's cybersquatting an instrument of fraud.

The Panel therefore finds that the Respondent's Disputed Domain Name has been registered and is being used in bad faith, satisfying Paragraph 4 (a) (iii) of UDRP.

6. Decision

For all the foregoing reasons, the Panel concludes that the Complainant has provided sufficient proof of its contentions, has proven each of the three elements of Paragraph 4 of UDRP with respect to the Disputed Domain Name and has established a case upon which the relief sought must be granted. The Panel therefore orders that the registration of the Disputed Domain Name <www.hitachi-idi-holding.com> be transferred to the Complainant.

Sole Panelist: Peter Cheung Kam Fai

6

Date: 19 February, 2020



Asian Domain Name Dispute Resolution Centre
- a charitable institution limited by guarantee registered in Hong Kong

ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE
(Kuala Lumpur Office)

ADMINISTRATIVE PANEL DECISION

Case No.:	ADNDRC-937-2021
Complainant:	GENTING INTELLECTUAL PROPERTY PTE LTD.
Respondent:	YABANI EZE
Disputed Domain Name:	<rwlasvegas.co>

1. The Parties and Contested Domain Name

The Complainant is Genting Intellectual Property Pte Ltd., (hereinafter referred to as the “**Complainant**”), of Singapore. The Complainant is represented by Mr. Lim Zhi Jian of Gan Partnership of Kuala Lumpur, Malaysia.

The Respondent is Yabani Eze (hereinafter referred to as the “**Respondent**”), of Lagos, Nigeria.

The domain name at issue is <rwlasvegas.co> (hereinafter referred to as the “**Disputed Domain Name**”), registered by the Respondent with GoDaddy.com, LLC of 14455N Hayden Rd, Scottsdale, Arizona, AZ 85260, United States of America (hereinafter referred to as the “**Registrar**”).

2. Procedural History

On 31 December 2020, the Complaint was filed with the Kuala Lumpur Office of the Asian Domain Name Dispute Resolution Centre (hereinafter referred to as the “**Centre**”), in accordance with the Uniform Domain Name Dispute Resolution Policy (the “**Policy**”)

approved by the Internet Corporation for Assigned Names and Numbers (“**ICANN**”) on 24 October 1999, the Rules of Procedure under the Policy (the “**Rules**”) approved by ICANN Board of Directors on 28 September 2013, and the Asian Domain Name Dispute Resolution Centre (“**ADNDRC**”) Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “**Supplemental Rules**”) effective from 31 July 2015.

On 8 March 2021, the Centre wrote to the Registrar to request for registrar verification in connection with the Disputed Domain Name.

On 9 March 2021, the Registrar transmitted to the Centre its verification response disclosing registrant information for the Disputed Domain Name.

On 9 March 2021, the Centre verified that the Complaint satisfied the formal requirements in accordance with the Policy, the Rules and the Supplemental Rules. In accordance with the Rules, the Centre formally notified the Respondent of the Complaint and the proceedings commenced on 9 March 2021.

Under Paragraph 5 of the Rules, the due date for the Respondent to file a Response was on or before 29 March 2021.

On 30 March 2021, the Centre wrote to Dr. Christopher To enquiring as to his availability to act as a Sole Panelist (the “**Panelist**”) in relation to the Disputed Domain Name and whether he is in a position to act independently and impartially between the Parties. In the same correspondence, the Centre stated that “[T]he deadline for the Respondent to submit its Response to Domain Name Dispute Complaint was 29th March 2021. No response was received from the Respondent on or before the stipulated deadline”.

The Centre appointed Dr. Christopher To as the Panelist in this matter on 31 March 2021. The Panelist finds that it was properly constituted and has acted impartially in reaching its conclusion.

3. Factual background

Complainant

The Complainant is a subsidiary of Genting Berhad and is part of the Genting group of Companies. The Complainant is a company incorporated within the jurisdiction of Singapore. The Complainant is the registered and/or beneficial and/or common law owner of the marks, “RESORTS WORLD LAS VEGAS” and “RESORTS WORLD” in various classes in various countries and regions throughout the world. The “RW” mark is widely known in the industry as the abbreviation for “RESORTS WORLD”. These registered marks have been registered and used by the Complainant before the Respondent registered the Disputed Domain Name on 26 November 2020.

Respondent

The identity and domicile of the Respondent was not stated in the whois search (www.whois.com) of 22 December 2020, as provided by the Complainant as per Annexure 1 of the Complaint. Upon clarification from the Registrar, the Respondent is Yabani Eze of Lagos, Nigeria.

Disputed Domain Name

The Disputed Domain Name was registered on 26 November 2020.

4. Parties’ Contentions

Complainant

The Complainant made the following submissions in the Complaint:

i. Identical/Confusingly Similar

The Genting Group and/or its members have won numerous awards in the course of their worldwide trade. It was a five-time winner of World’s Leading Casino Resort (2005-2010)

awarded by World Travel Awards and has been voted as Asia's leading casino resort for six consecutive years (2005-2010).

The Complainant contends that the Genting Group and/or its members have acquired substantial reputation and goodwill in the marks for various goods and services. The reputation and goodwill acquired are proprietary rights accorded by statutory and common law rights, which the law permits to guard against all manners of misappropriation and infringement.

The marks, "**RESORTS WORLD LAS VEGAS**", "**RESORTS WORLD**" and/or "**RW & Device**" registered and owned by the Genting Group and/or its members (including the Complainant) are well-known marks, which have acquired substantial good will and reputation.

The words forming the Disputed Domain Name, "**Resort World**", "**RW**" and/or "**Las Vegas**" are a direct reference to the Genting Group's world-class and world-famous resort and casino in Las Vegas, named Resorts World Las Vegas which has been developed since 2015 and is expected to be opened in the summer 2021.

According to the Complainant, this US\$4.3 billion next-generation integrated resort will fuse three premium Hilton brands namely Hilton Hotels & Resorts, LXR Hotels & Resorts and Conrad Hotels & Resorts into 3,500-room resort towers, providing a variety of luxury room products. It also consists of 117,000 square feet of usage space for gaming, restaurants and retail shops.

Not limited to Resorts World Las Vegas, the Complainant uses the marks for its numerous resorts worldwide, which have either been completed or are under construction/planned, which includes Resorts World Catskills (New York City, United States); Resorts World New York City (New York City, United States); Resorts World Genting (Malaysia); Resorts World Awana (Malaysia); Resorts World Sentosa (Singapore); Resorts World Bimini (Bahamas); Resorts World Birmingham (United Kingdom); Resorts World Kijal – (Malaysia); and Resorts World Manila (Philippines).

The Complainant alleges that the Respondent's choice of words forming the Disputed Domain Name is clearly no coincidence and mala fide.

The Complainant asserts that the Disputed Domain Name, which consists of "**RESORTS WORLD**", "**RW**" and "**LAS VEGAS**" amounts to a misrepresentation that the Disputed Domain Name belongs to and/or are associated with the Genting Group, the Complainant, the Resorts World Las Vegas resort and/or any of the Resorts World resorts as a whole, including the hotel and casino business it provides.

The Complainant advocates that this action by the Respondent exacerbates and amplifies the misrepresentation or erroneous claim on the Disputed Domain Name, which in effect damages the Genting Group's and/or the Complainant's business, goodwill and reputation, and above all amounts to false designation of origin and/or false description and/or dilution.

The Complainant further advocates that the Respondent's wrongful usage of the Disputed Domain Name will lead members of the trade and public into believing that the Disputed Domain Name is somehow connected in some way or form with the Genting Group, the Complainant, the Resorts World Las Vegas resort and/or any of the Resorts World resorts when in fact this is not the case.

On this basis the Complainant alleges that the Disputed Domain Name is confusingly similar to the Complainant's trademarks.

ii. Rights and Legitimate Interests

The Genting Group and/or its members (including the Complainant) have used the "**Resorts World**" and/or "**RW**" mark as early as 2006. The earliest registration was registered in Malaysia on 18th October 2006 (Annexure 5 of the Complaint).

The Complainant contends that the Genting Group and/or its members (including the Complainant) have used the marks and have acquired substantial and extensive reputation worldwide.

The Complainant further contends that the Genting Group has prior rights in the marks (since 2006) which precede the registration of the Disputed Domain Name (on 26 November 2020) by 15 years.

The Complainant is of the view that the mere registration of the Disputed Domain Name by the Respondent is not sufficient to establish its rights or legitimate interests in it, and quotes the case of *Educational Testing Service v. TOEFL (Case No. D2000-0044)*, to support its stance. In that case the Panel held that “*if mere registration of the domain name were sufficient to establish rights or legitimate interests...then all registrants would have such rights or interest, and no Complainant could succeed on a claim of abusive registration.*”

The Complainant states that it has not authorized and/or consented to the Respondent to use the marks and/or for the Respondent to use or register the Disputed Domain Name.

The Complainant further states that the use of the marks and the purported registration of the Disputed Domain Name by the Respondent are unlawful, illegal and/or *mala fide*.

According to the Complainant, by registering the Dispute Domain Name, the Respondent has deceived and confused and/or is likely to deceive and confuse members of the trade and public into believing that the Disputed Domain Name is in some way affiliated and/or associated and/or connected to the Genting Group, the Complainant, the Resorts World Las Vegas resort and/or any of the Resorts World resorts when that is not the case. Such misrepresentation or erroneous claim damages the Complainant’s and/or the Genting Group’s business, goodwill and reputation and also amounts to false designation of origin and/or false description and/or dilution of the marks.

iii. Bad Faith

The Complainant submits that by using the Dispute Domain Name, the Respondent has intentionally attempted to prevent the Complainant, the Genting Group and/or its members from using the Disputed Domain Name are clearly tainted with *mala fide* intention, knowing very well (due to its extensive and substantial use) that the Complainant, the Genting Group and/or its members have in the marks.

The Complainant further submits that the Respondent has registered the Disputed Domain Name primarily for the purpose of attracting for commercial gain by creating a likelihood of confusion with the Complainant's marks and business as to the source, sponsorship, affiliation. The coincidence in the Respondent choosing the words “**RESORTS WORLD**”, “**RW**” and/or “**LAS VEGAS**” together in forming the Disputed Domain Name shows that the Respondent must have been fully aware of the Complainant and/or the Genting Group's marks, goodwill and reputation when it decided to register the Disputed Domain Name on 26 November 2021.

The Complainant contends that the Respondent does not have any intellectual property rights in the Disputed Domain Name. The *mala fide* intention and lack of good faith of the Respondent can clearly be inferred as the Respondent would have been aware of the Complainant's and/or Genting Group's marks. According to the Complainant, this is clear evidence of bad faith.

The Complainant has initiated these proceedings to preemptively prevent further damages suffered by the Complainant, the Genting Group and/or the public from being deceived into believing that the Disputed Domain Name provides goods and/or services originating from and/or associated with the Complainant, the Genting Group and/or its members when this is clearly not the case.

The Complainant further contends that in the event the Disputed Domain Name is used to operate online gambling services (which include holding monies belonging to others), there is every risk of fraud and/or misappropriation of the monies which will result in serious and irreparable damage on the Complainant and/or Genting Group as the Disputed Domain Name wrongly represents to the world that it is authorized by the Complainant and/or Genting Group when this is not the case.

Respondent

The Respondent did not reply to the Complainant's contentions as stated in the Complaint.

5. Findings

Having considered all the documentary evidence before me, and the Respondent's non-participation in these proceedings after being afforded every opportunity to do so in accordance with Paragraph 5(f) of the Rules, the Panelist is of the view that it should proceed to decide on the Disputed Domain Name, based upon the Complaint and evidence adduced by the Complainant as contained within the Complaint.

Paragraph 5(f) of the Rules stipulates that:

“If a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint.”

Whereas Paragraph 10(d) of the Rules states that:

“The Panel shall determine the admissibility, relevance, materiality and weight of the evidence.”

Similarly, Paragraph 11(a) of the Rules provides that:

“Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.”

In the present case the Parties had not agreed to use a particular language for these proceedings. As the Registration Agreement is in the English language as confirmed by the Registrar in its correspondence to the Centre of 8 March 2021, then in accordance with Paragraph 11(a) of the Rules, the language of the administrative proceedings shall be in the English language. In these circumstances given that the Complaint is drafted in the English language which is in line with the Registration Agreement and that the Respondent has failed to communicate on the matter, the Panelist considers that it would be appropriate (and without prejudice to any of the parties) for the present proceedings to be conducted in the English language.

The Policy provides, at Paragraph 4(a), that each of three findings must be made for a Complainant to prevail:

- A. Disputed Domain Name is **identical or confusingly similar** to a trademark or service mark in which Complainant has rights; and
- B. The Respondent has no **rights or legitimate interests** in respect of the Disputed Domain Name; and
- C. Disputed Domain Name has been registered and is being used in **bad faith** by the Respondent.

The Panelist would like to state that the Respondent's non-participation (i.e. default) would not by itself mean that the Complainant claims are deemed to have prevailed. In fact, the Respondent's default is not necessarily an admission that the Complainant's claims are true. The burden of proof still rests with the Complainant to establish the three elements contained within Paragraph 4(a) of the Policy as stated above by a preponderance of the evidence for the Panelist to determine in accordance with Paragraph 10(d) of the Rules.

A. Identical / Confusingly Similar

The Complainant contends that the Disputed Domain Name is confusing similar to the Complainant's trademarks.

The threshold test for confusing similarity under the Policy involves a comparison between the relevant marks (i.e., trademark or service mark) belonging to the Complainant and the Disputed Domain Name to ascertain the presence of the trademark in the Disputed Domain Name. In order to satisfy this test, the relevant marks would generally need to be recognizable as such within the Disputed Domain Name, with the addition of merely descriptive, common or geographical wording typically being regarded as insufficient to prevent a finding of confusing similarity.

The Disputed Domain Name contains two elements: (i) "rwlasvegas" and (ii) the country code top-level domain ".co". It is well established that the country code top-level domain ".co" does not have trademark significance, conferring no distinctiveness to the domain name sufficient to avoid user confusion, and should be ignored for identifying the "confusing similarity" element.

On a side-by-side comparison of the Disputed Domain Name and the textual components of the Complainant's trademark, the trademark is recognizable within the Disputed Domain Name. In fact, the Disputed Domain Name incorporates the abbreviation of the trademark "Resorts World" together with Las Vegas, which the Complainant has registered the marks in various jurisdictions around the world (since 18 October 2006).

The distinctive part of the Disputed Domain Name <rwlasvegas.co> is therefore "rwlasvegas", which is confusingly similar to the Complainant's "**RESORTS WORLD LAS VEGAS**" mark.

The Panelist finds that the Complainant has rights in the trademark acquired through use and registration.

The Panelist agrees with the Complainant contentions that the Disputed Domain Name is the same and is a central and distinguishable part of the Complainant's registered trademark "**RESORTS WORLD LAS VEGAS**". In saying so, the Panelist is also of the opinion that the abbreviation "**RW**" does nothing to distinguish it from the Complainant's trademark of "**RESORTS WORLD**" but rather increases the likelihood of confusion. As a result, the Panelist further concurs with the Complainant's stance that the Disputed Domain Name can easily mislead members of the public into believing that the Disputed Domain Name is owed or operated by the Complainant, or that the Respondent has a relationship or association with the Complainant in some way or form.

As stated previously, the Respondent has not contested the allegations of the Complaint and is in default.

For the foregoing reasons, the Panelist concludes that the Complainant has discharged the burden of proof to establish the elements of identical and confusingly similar trademark or service mark in accordance with Paragraph 4(a) (i) of the Policy.

B. Rights and Legitimate interests

The burden of proof shifts to the Respondent once the Complainant provides prima facie evidence showing that the Respondent lacks legitimate rights or interests.

Paragraph 4(c) of the Policy provides a list of non-exhaustive circumstances, any of which is sufficient to demonstrate that a Respondent has rights or legitimate interests in the Disputed Domain Name:

- (i) before any notice to the Respondent of the dispute, the Respondent's use of, or demonstrable preparations to use, the Disputed Domain Name or a name corresponding to the Disputed 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 Disputed 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 Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

There is no evidence that the Complainant has authorized, licensed, or permitted the Respondent to register or use the Disputed Domain Name or to use the trademark. The Complainant has prior rights in the trademark which precede the Respondent's registration of the Disputed Domain Name by fifteen (15) years.

The Panelist finds on record that there is therefore a prima facie case that the Respondent has no rights or legitimate interests in the Disputed Domain Name, and the burden shifts to the Respondent to produce evidence to rebut this presumption.

The Respondent has failed to show that it has acquired any trademark rights in respect of the Disputed Domain Name or that the Disputed Domain Name has been used in connection with a bona fide offering of goods or services. The Complainant has neither authorized nor consented to the Respondent to use the Complainant's trademarks.

There has been no evidence adduced to show that the Respondent has been commonly known by the Disputed Domain Name.

There has been no evidence adduced to show that the Respondent is making a legitimate non-commercial or fair use of the Disputed Domain Name.

The Complainant has in a credible way alleged that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name whereas the Respondent has failed to show that the Respondent has any rights or legitimate interests in respect of the Disputed Domain Name. This ineffectively entitles the Panelist to infer that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name at issue.

To sum up, the Panelist is satisfied on the totality of the evidence before it that the Respondent's use of the Disputed Domain Name is not in connection with a bona fide offering of goods or services. The Respondent has not been authorized or licensed by the Complainant to use its trademarks. Nor is there any evidence that the Respondent has been commonly known by the Disputed Domain Name or similar name. Neither is there evidence that the Respondent has been making a legitimate non-commercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark of the Complainant.

In the circumstances, the Panelist concludes that, on a balance of probabilities, the Complainant has discharged its burden of proof to show that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name pursuant to paragraph 4(a) (ii) of the Policy.

C. Bad Faith

Paragraph 4(b) of the Policy sets out four (4) factors in which the Panelist shall take into consideration in determining whether the Respondent has registered and used the Disputed Domain Name in bad faith. Either one (1) of these four (4) factors are evident would amount to registration and use in bad faith on the part of the Respondent.

Bad faith cannot be presumed, but once the Complainant has presented some evidence to establish a prima facie case, the onus then shifts onto the Respondent to either justify or explain its business conduct.

The Disputed Domain Name is identical in substance to the Complainant's "**RESORTS WORLD LAS VEGAS**" mark (leaving aside the country code top-level domain ".co" as explained above) thus demonstrating that the Respondent's sole purpose is to pass off as the Complainant or to disrupt the business of the Complainant. Through such a behavior the Respondent attempts to confuse/mislead members of the public into believing that the Disputed Domain Name is somewhat associated with and endorsed by the Complainant thus creating a likelihood of confusion with the intention to attract internet users for commercial gain, while depriving the Complainant of its legitimate right to use the Disputed Domain Name. As such the Panelist contends that the Respondent's bad faith is evident by Paragraph 4(b) (iii) of the Policy:

"(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor"

In the present case, the evidence submitted by the Complainant clearly shows that the Respondent has an intention to mislead and/or to deceive internet users into believing that the Disputed Domain Name is that of the Complainant by registering the Disputed Domain Name on 26 November 2020.

The Panelist also notes that the Complainant rights in the trademarks predate the Respondent's registration of the Disputed Domain Name. The Panelist finds that, given the fact that the Complainant's trademark is widely known, it is overwhelmingly likely that the Respondent, at the time of registration of the Disputed Domain Name and thereafter, was aware that it was infringing the Complainant's trademark. Therefore, the Panelist concludes that the Respondent has registered the Disputed Domain Name in order to disrupt the business of the Complainant, thereby creating a likelihood of confusion for the purposes of paragraph 4(b) (iii) of the Policy. The Panelist therefore finds the requisite element of bad faith has been satisfied under paragraph 4(b) (iii) of the Policy.

For the foregoing reasons, the Panel concludes that the Complainant has discharged the burden of proof to establish that the Respondent registered and used the Disputed Domain Name in bad faith in accordance with Paragraph 4(a) (iii) of the Policy.

6. Reverse Domain Name Hijacking

Paragraph 15(e) of the Rules provides that, if “...after considering the submissions the panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding”. Reverse Domain Name Hijacking is defined under the Rules as “...using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name”.

In light of the conflicting decisions as to whether it is necessary for a Complainant to establish both bad faith registration and bad faith use, the Panel does not find this to be a case of Reverse Domain Name Hijacking.

7. Decision

For the foregoing reasons and in accordance with Paragraph 4(a) of the Policy and Paragraph 15 of the Rules, the Panelist is satisfied that the Complainant has sufficiently proved the existence of all three elements pursuant to Paragraph 4(a) of the Policy. The Panel orders that the Disputed Domain Name < **rwlasvegas.co** > be transferred to the Complainant.



Dr. Christopher To
Panelist

Dated: 6 April 2021



Asian Domain Name Dispute Resolution Centre

beijing

北京秘书处

专家组裁决

案件编号: CN-1500909

投 诉 人: 深圳玛丝菲尔时装股份有限公司
被投诉人: 陈鉴荣 (chen jianrong)
争议域名: zhuchongyun.com
注 册 商: HICHINA ZHICHENG TECHNOLOGY LTD.

1、案件程序

2015年8月21日, 投诉人深圳玛丝菲尔时装股份有限公司根据互联网名称与数字地址分配机构 (ICANN) 施行的《统一域名争议解决政策》(以下简称“《政策》”)、《统一域名争议解决政策之规则》(以下简称“《规则》”)及亚洲域名争议解决中心 (ADNDRC) 施行的《统一域名争议解决政策之补充规则》(以下简称“《补充规则》”), 向亚洲域名争议解决中心北京秘书处 (以下简称“中心北京秘书处”) 提交了投诉书, 选择由一人专家组进行审理。

2015年8月24日, 中心北京秘书处向投诉人传送接收确认通知, 确认收到投诉书。同日, 中心北京秘书处向 ICANN 和域名注册商 HICHINA ZHICHENG TECHNOLOGY LTD. 发出注册信息确认函, 要求其确认注册信息。注册商 HICHINA ZHICHENG TECHNOLOGY LTD. 于 2015年9月18日回复确认: (1) 争议域名由其提供注册服务; (2) 被投诉人陈鉴荣 (chen jianrong) 为争议域名注册人; (3) 《政策》适用所涉域名投诉; (4) 争议域名注册协议使用的语言为中文。

2015年9月24日, 中心北京秘书处以电子邮件的形式向投诉人传送投诉书确认及送达通知书, 确认投诉书已经审查合格并送达被投诉人, 本案程序于2015年9月24日正式开始。同日, 中心北京秘书处以电子邮件和邮

政快递向被投诉人发送书面投诉通知，告知被投诉人被投诉的事实，并说明中心北京秘书处已按《规则》和《补充规则》的规定，以电子邮件的形式向被投诉人传送了投诉书及附件。中心北京秘书处并于同日以电子邮件向ICANN及争议域名的注册商HICHINA ZHICHENG TECHNOLOGY LTD. 传送程序开始通知。

被投诉人于 2015 年 10 月 14 日提交答辩，并选择由一人专家组审理本案。中心北京秘书处于 2015 年 10 月 19 日向投诉人转递答辩材料。

2015年11月6日，中心北京秘书处向王范武先生发出列为候选专家通知，请其确认是否接受指定，作为本案专家审理案件，并在当事人间保持独立公正。2015年11月7日，候选专家回复中心北京秘书处，同意接受指定，并保证案件审理的独立性和公正性。

2015年11月10日，中心北京秘书处向双方当事人及上述专家传送专家指定通知，指定王范武先生为本案独任专家，成立一人专家组审理本案。同日，中心北京秘书处将案件移交专家组。

根据《规则》第6(f)条和第15(b)条，专家组应当在成立之日（即2015年11月10日）起14日内即2015年11月24日前（含10月24日）就本案争议作出裁决。

2、基本事实

投诉人：

投诉人为深圳玛丝菲尔时装股份有限公司，地址位于深圳市福田区车公庙天祥大厦 2D。投诉人在本案中的授权代理人为深圳玛丝菲尔时装股份有限公司的罗卡丽。2015 年 1 月 7 日，投诉人的“ZHUCHONGYUN”商标获得注册。

被投诉人：

被投诉人为陈鉴荣（chen jianrong），地址位于 Panyu,Guangzhou, Guangdong, China 510000。被投诉人在本案中的授权代理人为广东国晖（广州）律师事务所的蒋秀丽。2013 年 12 月 5 日，本案争议域名“zhuchongyun.com”通过注册商 HICHINA ZHICHENG TECHNOLOGY LTD.获得注册。

3、当事人主张

投诉人：

(1) 争议域名与投诉人拥有的商标或服务标记相同或极其相似，容易引起混淆；

投诉人第 13076970 号商标“ZHUCHONGYUN”，而争议域名“zhuchongyun.com”的中心词与投诉人享有权利的商标“ZHUCHONGYUN”完全相同，毫无差异。

投诉人深圳玛丝菲尔时装股份有限公司及“ZHUCHONGYUN”品牌在服装行业内具有了较高的知名度。投诉人深圳玛丝菲尔时装股份有限公司成立于 1999 年 11 月，系集设计、生产、销售于一体的高端时装公司，现有约 5000 员工服务其中，每年销售高档时装超过 200 万件，2014 年度营业额近二十一亿人民币，每年向国家缴纳税金近 5.7 亿。企业年盈利达 6.66 亿元。是中国本土高档女装品牌中最声誉卓著的品牌机构之一。投诉人主要经营“ZHUCHONGYUN”、“Marisfrolg”、“MASFER.SU”、“AUM”、国际品牌“Krizia”等女装品牌及“MARISFROLG”男装品牌，其中，“ZHUCHONGYUN”品牌是经过公司十多年来在时装设计，制造，经营这一领域里不断实践，吸收世界时尚文化的精华，积累起丰富的经验后于 2013 年 6 月创立起来的高端女装品牌。设立伊始即赢得了消费者的认同和喜爱。目前，公司的主推品牌“ZHUCHONGYUN”在中国主要大中城市的高端商场中开设专柜，直营店共 8 家。

投诉人注重对“ZHUCHONGYUN”品牌的宣传，每季都举行大型的产品发布会，也引来国内外各大媒体的关注和报道，公司也对产品和品牌制作了大量精美的宣传物料，在各大时尚杂志上进行大量和广泛的宣传。经过较长期和广泛的宣传，“ZHUCHONGYUN”品牌在服装市场上已经确立其至关重要的地位及较广泛的影响力。

(2) 被投诉人不拥有对该域名的权利或合法利益

“ZHUCHONGYUN”商标为投诉人独创的商标，该商标以投诉人首席设计师朱崇辉女士的名字拼音命名，其对“ZHUCHONGYUN”享有无可争辩的在先权利。

朱崇辉女士为投诉人之董事长，并为投诉人旗下全部品牌的创始人、首席设计师。“ZHUCHONGYUN”品牌作为以其名字拼音命名的同名品牌，系具有中国独立价值观的国际时装品牌，是朱崇辉女士对艺术品牌的态度。品牌创立后，投诉人即开始在各大媒体及官方网站宣传推广并首先于 2013 年 8 月 13 日在 25 类申请注册，“ZHUCHONGYUN”及“ZHUCHONGYUN/朱崇辉”商标，并于 2015 年 1 月 7 日取得商标注册证明，商标证号分别为 13076970、13076615。其后，投诉人在第 3、5、8、9、10、14、16、18、20、21、22、23、24、26、27、35、37、40、42、43 类上分别注

册了多个“ZHUCHONGYUN”及“ZHUCHONGYUN/朱崇恽”商标，涵盖了大部分的商品和服务类别，并且全部商标已经取得商标专用权。同时也准备开始在多个国家和地区注册。投诉人对“ZHUCHONGYUN”享有在先的权利。

被投诉人为中国广东省的一个自然人，与投诉人以及“ZHUCHONGYUN”商标所有权人毫无关联。投诉人未将该商标许可给任何第三方使用，因此除了投诉人之外，其他任何个人和企业都无权使用该标志。且实际上，被投诉人也从未被授权以任何形式使用“ZHUCHONGYUN”。此外，被投诉人注册争议域名的时间为2013年12月5日，该日期远晚于投诉人申请注册商标的日期。

总之，投诉人对“ZHUCHONGYUN”享有不容置疑的权利。对“ZHUCHONGYUN”注册在先的商标，其对“ZHUCHONGYUN”享有无可争辩的在先权利。

(3) 被投诉人的域名已被恶意注册并且正被恶意使用

投诉人享有权利的“ZHUCHONGYUN”商标及品牌在服装尤其是女装行业内具有了很高的知名度和影响力，鉴于“ZHUCHONGYUN”所具有的知名度，被投诉人在注册域名时显然已经知道该品牌的价值。

被投诉人注册“zhuchongyun.com”之后，其在转让的网页版面上描述为“这是一个好域名，来自‘Marisfrolg’玛丝菲尔女装品牌”的文字说明，标价五万转让。这表明被投诉人是在明知“ZHUCHONGYUN”品牌为投诉人旗下品牌的情况下，恶意抢先申请注册的域名。

这足以证明了被投诉人是对投诉人及投诉人的“ZHUCHONGYUN”品牌是相当了解和熟知的，并且一直从事该种非法经营以谋求不当利益，而其注册争议域名的也是其中一种不法行为。

其次被投诉人注册该域名后，多次委托第三方代理机构通过电话与投诉人取得联系，要求投诉人高价收购该域名。

基于以上被投诉人的行为，可知其注册域名主要是以商业利益为目的，一方面其并不具备该域名前缀的商标所有权，亦并不以此作为商品或服务的品牌经营，一经注册完成，马上在网站上（万网：<http://www.net.cn/domain/taodomaindetail?domainName=zhuchongyun.com>）标价售卖；另一方面，其也在寻找合适的时机向投诉人出售该域名，以达到额外的利益；再者，被投诉人注册争议域名也是为了阻止享有在先权利的投诉人注册该争议域名。

综上所述，被投诉人注册和使用该域名是明显具有恶意的。

基于以上全部理由，投诉人请求本案专家组裁决：争议域名

“zhuchongyun.com”应转移给投诉人。

被投诉人：

被投诉人对投诉人在 2015 年取得的商标权并无异议，对朱崇恽的姓名权也不否认。被投诉人拥有的域名权是一项合法的民事权益，取得权益的时间为 2013 年 12 月 5 日，域名权的使用，不仅限于商业领域，域名可以使用在自然人的民事领域，可以是艺术的，个人爱好的，可以是公益的，也可以是商业的。域名的获取原则是先注先得。且域名的指向具有唯一性，域名用于投资同样也受法律的保护。

商标权和姓名权并不必然否定域名权，是不同领域的民事权利，完全可以各自合法，各自独立存在。

被投诉人没有恶意注册及恶意使用。被投诉人承认公证书的内容，投诉人投诉书最后一页的网页截图，不具有真实性。被投诉人并未以“这是一个好域名，来自‘Marisfrolg’玛丝菲尔女装品牌”对外公开出售。投诉人以此攻击被投诉人站不住脚。

(1) 被投诉人拥有域名是一项独立的民事权利，是一项合法的民事权利，并未侵犯投诉人的商标权

被投诉人取得域名的时间是 2013 年 12 月 5 日，取得域名“zhuchongyun.com”的顶级域名。域名权与商标权是不同的民事权利。域名是在计算机领域，在世界范围内具有的唯一指向的计算机网址，投诉人的商标权是在中国注册取得的商标权。该项商标权的取得时间在 2015 年 1 月 7 日，商标权取得时间在后，并不当然否定被投诉人合法拥有的域名权。投诉人的品牌名称“ZHUCHONGYUN”在 2013 年底还不是广为人知的品牌，没有注册，更谈不上驰名商标。所以，投诉人所取得的商标权并不当然否定被投诉人取得的域名权。

投诉人所提交的大量资料，是网页拷屏资料，真实性无从考证。且大量的资料，是在 2014 年、2015 年的开店资料，晚于被投诉人取得注册的时间。投诉人在 2013 年底开始做广告宣传这个品牌，但未取得商标权，也不具有知名度。被投诉人此时，已经申请域名，取得注册证书。所以，被投诉人取得的权利是合法的。并未侵犯在先商标权。

“ZHUCHONGYUN”并非投诉人独创，这几个字的拼音组合是各种汉字和英文组合的可能，他不是著作权的创作，不具有独创性，不具有唯一性，而是具有多样性组合。投诉人的独创性否定被投诉人的拼音域名“ZHUCHONGYUN”（竹重云），是站不住脚的。

(2) 被投诉人的域名网址，并没有侵犯投诉人的姓名权，被投诉人的

域名具有合法性

由于汉字拼音重复概率极大，被投诉人的域名与投诉人的姓名重合纯属巧合。朱崇恽的拼音是 ZHU CHONG YUN。被投诉人的域名实际是一个有水墨山水意境的“竹重云”，是被投诉人对这个意境的个人喜好，准备用于艺术或服务领域。对于这个拼音和姓名的重合，会有无数这样类似的词。

(3) 被投诉人在注册域名后，并无持有或使用的恶意。

不可否认，域名的区别性，与姓名、商号、商标均有区别的功能，具有网络的区分功能，具有网络品牌的功能，这使域名注册具有投资的价值。被投诉人也有这样的想法。所以，被投诉人向不特定公众出售域名，并未向 2015 年取得商标权的投诉人公司出售，也未向投诉人的竞争公司出售。我方已注册该域名。其目的更不是防止商标或服务标记的所有者获得与标记相对应的域名，我方取得域名在先，投诉方取得商标权在后。我方作为自然人持有计算机域名的目的，不是为了排挤竞争对手的需要，我方持有不具有恶意。

对于域名持有人，对域名进行转让，并获取转让的对价，是法律不禁止的行为，应当允许。域名的流转，知识产权的活跃，在没有侵犯他人合法在先权的情况下，是可以被鼓励的行为。请专家组依法驳回投诉人的请求，依法维护域名注册的严肃性，在先权利的合法性，域名使用和流转的合理性。

4、专家意见

根据被投诉人与注册商之间的注册协议，被投诉人同意受《政策》的约束。《政策》适用于本项争议解决程序。

《政策》第 4 条规定了强制性域名争议解决程序。根据第 4(a) 条的规定，投诉人必须证明以下三个条件均已满足：

(i) 被投诉人域名与投诉人享有权利的商品商标或服务商标相同或混淆性相似；且

(ii) 被投诉人对该域名并不享有权利或合法利益；且

(iii) 被投诉人对该域名的注册和使用具有恶意。

(1) 关于完全相同或混淆性相似

首先，关于在先权的问题。如果仅从注册的时间上看，争议域名注册时

间确实早于投诉人的商标取得注册的时间。但是专家组注意到投诉人提交的证据表明：投诉人作为时装设计、生产企业成立于1999年11月，虽然“ZHUCHONGYUN”商标注册申请尚未取得核准，但投诉人在2013年11月前已经在多个城市开设“ZHUCHONGYUN”品牌专卖店，而且利用召开时装发布会以及借助网络专业媒体和国内外知名的时装杂志等形式宣传“ZHUCHONGYUN”品牌。这说明投诉人在生产、销售的市场经营活动中已将“ZHUCHONGYUN”作为商业标识广泛的使用，投诉人实际使用这个商业标识的时间早于本案争议域名注册的时间。

应该指出：“使用在先”也是国际上很多国家商标法律通行的基本原则，中国的商标法以及反不正当竞争法在保护注册商标的同时并不排斥对在市场经营活动中诚实信用的使用未注册商标的权利人的保护。基于以上事实和法律原则，专家组认为，投诉人对“ZHUCHONGYUN”商业标识享有在先权利。

其次，关于相同或混淆性相似的问题。将争议域名与投诉人使用在先的“ZHUCHONGYUN”商业标识进行直观比较，很显然争议域名“zhuchongyun.com”中可识别部分“zhuchongyun”与投诉人使用在先的商业标识在字母组合、排列、发音上都完全相同。据此，专家组认定：争议域名与投诉人的商标完全相同。投诉人的投诉满足《政策》第4条(a)第(i)项的条件。

(2) 关于被投诉人权利或合法利益

投诉人称：“ZHUCHONGYUN”品牌是由公司董事长、首席设计师朱崇恽女士的名字的汉语拼音命名的品牌。被投诉人是一个生活在广东的自然人，与投诉人以及“ZHUCHONGYUN”商标毫无关联。投诉人也从未授权被投诉人以任何形式使用“ZHUCHONGYUN”。为此，投诉人提交了证据证明自己在争议域名注册前已经将“ZHUCHONGYUN”作为商标在市场经营活动中实际使用。

被投诉人在答辩中称：争议域名与投诉人的姓名重合纯属巧合。朱崇恽的拼音是 ZHU CHONG YUN。被投诉人的域名实际是一个有水墨山水意境的“竹重云”，是被投诉人对这个意境的个人喜好，准备用于艺术或服务领域。但被投诉人未提交任何证明自己在注册本案争议域名时与该域名有关联性，有权利或合法利益的证据。

专家组认为：在投诉人提交证据证明自己与“ZHUCHONGYUN”商业标识的关联性和合法权益后，被投诉人有责任证明自己与争议域名有何种权利或利益。鉴于被投诉人未提交相关证据，专家组认定：被投诉人不能证明自己对于争议域名享有权利或合法利益，投诉人的投诉满足《政策》第4

条(a)第(ii)项的条件。

(3) 关于恶意

投诉人认为，被投诉人注册“zhuchongyun.com”之后，马上在万网网站上转让，网页版面上将转让的域名描述为“这是一个好域名，来自‘Marisfrolg’玛丝菲尔女装品牌”，标价五万转让。这表明被投诉人是在明知“ZHUCHONGYUN”品牌为投诉人旗下品牌的情况下，恶意抢先注册域名，寻找合适的时机向投诉人出售该域名，以达到额外的利益；这是一种非法经营以谋求不当利益的行为。被投诉人注册争议域名也是为了阻止享有在先权利的投诉人无法注册该争议域名。投诉人提交了相关网页截图。

被投诉人答辩称：被投诉人向不特定公众出售域名，并未向投诉人公司出售，也未向投诉人的竞争公司出售。注册该域名目的不是防止商标或服务标记的所有者获得与标记相对应的域名，不是为了排挤竞争对手，持有该域名不具有恶意。对域名进行转让并获取转让的对价是法律不禁止的行为应当允许。投诉人提交的万网网页截图不具有真实性。

但是，被投诉人的答辩未能解释为什么是在投诉人广泛使用“ZHUCHONGYUN”商业标识开展宣传活动之后，被投诉人注册了完全相同的争议域名；也未说明既然是“准备用于艺术或服务领域”为什么没有建立与“竹”、“云”相关联的高雅的文化艺术网站，却指向了一个与投诉人经营内容相同的服装服饰商业网站的问题。

专家组在认定被投诉人注册的争议域名与投诉人使用在先的“ZHUCHONGYUN”商业标识完全相同；被投诉人对本案争议域名没有权利或合法利益的基础上，结合投诉人提交的证据以及双方的意见进一步认定：被投诉人是在明知投诉人使用“ZHUCHONGYUN”商业标识，且在未经投诉人许可的情形下注册本案争议域名。

理由一是投诉人先将“ZHUCHONGYUN”作为商业标识用于服装、服饰并召开时装发布会以及借助网络专业媒体和国内外知名的时装杂志等形式对“ZHUCHONGYUN”品牌进行宣传。此后被投诉人注册了相同的争议域名，并指向一个与投诉人是同行业的时装、服饰类商业网站。

理由二是投诉人提交的证据表明：被投诉人在注册了争议域名后(2014年3月27日)将该域名挂在万网以5万元的意向价格出售。在“域名简介”中写道：这是一个好域名，来自深圳‘Marisfrolg’玛丝菲尔女装品牌。虽然被投诉人在答辩中否认该证据的真实性，但是万网上载明的出售域名所有人联系电话号码与被本案投诉人陈鉴荣的手持电话号码相同，这用“纯属巧合”或否认是无法令人信服的。该证据直接证明被投诉人完全了解

“ZHUCHONGYUN”商业标识与投诉人的关联性。

综合以上，可以认定被投诉人注册本案争议域名的行为是典型的域名抢注行为。

由于网络域名具有的唯一性的技术特点，被投诉人注册本案争议域名必然阻止投诉人注册和使用该域名开展网上宣传和业务，对投诉人行使正当权利构成妨害。被投诉人的行为不仅侵害了投诉人的合法权利，也会误导相关公众混淆与投诉人的区别。其目的就是获取不正当的商业利益。因此，专家组认定：被投诉人具有恶意，投诉人的投诉满足《政策》第4条(a)第(iii)项的条件。

5、裁决

基于上述事实 and 理由，本专家组裁决：投诉人以被投诉人注册争议域名“zhuchongyun.com”而提起的投诉成立，争议域名“zhuchongyun.com”应转移给投诉人深圳玛丝菲尔时装股份有限公司。

独任专家：



2015年11月19日于北京



Asian Domain Name Dispute Resolution Centre

beijing

北京秘书处

专家组裁决

案件编号: CN-1600936

投诉人: 捷豹路虎有限公司 (JAGUAR LAND ROVER LIMITED)

被投诉人: Kang Xiao Ping

争议域名: landrovervip.com

注册商: 北京万网志成科技有限公司

1、案件程序

2016年2月1日, 投诉人捷豹路虎有限公司 (JAGUAR LAND ROVER LIMITED) 根据互联网名称与数字地址分配机构 (ICANN) 施行的《统一域名争议解决政策》(以下简称“《政策》”)、《统一域名争议解决政策之规则》(以下简称“《规则》”)及亚洲域名争议解决中心 (ADNDRC) 施行的《统一域名争议解决政策之补充规则》(以下简称“《补充规则》”), 向亚洲域名争议解决中心北京秘书处(以下简称“中心北京秘书处”)提交了投诉书, 选择由一人专家组进行审理。

2016年2月2日, 中心北京秘书处向投诉人传送通知, 确认收到投诉书。同日, 中心北京秘书处向ICANN和域名注册商北京万网志成科技有限公司发出注册信息确认函, 要求其确认注册信息。注册商北京万网志成科技有限公司于2016年2月2日回复确认: (1) 争议域名由其提供注册服务; (2) 被投诉人 Kang Xiao Ping为争议域名注册人; (3) 《政策》适用所涉域名投诉; (4) 争议域名注册协议使用的语言为中文。

2016年2月15日, 中心北京秘书处以电子邮件的形式向投诉人传送投诉书确认及送达通知书, 确认投诉书已经审查合格并送达被投诉人, 本案

程序于2016年2月15日正式开始。同日，中心北京秘书处以电子邮件的形式向被投诉人传送书面投诉通知，告知被投诉人被投诉的事实，并说明中心北京秘书处已按《规则》和《补充规则》的规定，以电子邮件的形式向被投诉人传送了投诉书及附件。中心北京秘书处并于同日以电子邮件的形式向ICANN及争议域名的注册商北京万网志成科技有限公司传送程序开始通知。

截至答辩期限届满日2016年3月6日，被投诉人未提交答辩。2016年3月7日，中心北京秘书处向投诉人及被投诉人传送缺席审理通知。

2016年3月7日，中心北京秘书处向廉运泽先生发出列为候选专家通知，请其确认是否接受指定，作为本案专家审理案件，并在当事人间保持独立公正。2016年3月8日，候选专家回复中心北京秘书处，同意接受指定，并保证案件审理的独立性和公正性。

2016年3月8日，中心北京秘书处向双方当事人及上述专家传送专家指定通知，确定指定廉运泽先生为本案独任专家，成立一人专家组审理本案。同日，中心北京秘书处将案件移交专家组。

根据《规则》第6(f)条和第15(b)条，专家组应当在成立之日（即2016年3月8日）起14日内即2016年3月22日前（含3月22日）就本案争议作出裁决。

2、基本事实

投诉人：

本案投诉人为捷豹路虎有限公司（JAGUAR LAND ROVER LIMITED），地址位于英国 CV3 4LF，考文垂，惠特利，阿比大道。投诉人授权上海锦天城（青岛）律师事务所代理本案。

被投诉人：

本案被投诉人为 Kang Xiao Ping，地址不详，电子邮箱为 yaoyumingzhaowo@126.com。

2015年11月9日，本案争议域名“landrovervip.com”通过注册商北京万网志成科技有限公司获得注册。

3、当事人主张

投诉人诉称:

(1) 争议域名与投诉人拥有的商标或服务标记相同或极其相似, 容易引起混淆

① 投诉人对争议域名的有效识别部分“LANDROVER”享有在先合法权益

投诉人在包括英国和中国在内的世界各地注册了“LANDROVER”“LANDROVER 及图形”“路虎”以及包含“LANDROVER”的其他商标。投诉人“LANDROVER”商标自 1957 年即在中国申请注册(商标注册证号为第 29228 号, 经多次续展, 专用权期限自 2008 年 12 月 1 日至 2018 年 11 月 30 日), 其余“LANDROVER”“LANDROVER 及图形”“路虎”以及包含“LANDROVER”的其他商标陆续在中国获得商标注册, 均在有效期内。被投诉人于 2015 年 11 月 9 日注册了争议域名, 所以投诉人的“LANDROVER”商标的注册时间均远早于争议域名的注册日期。投诉人对“LANDROVER”商标拥有优先权和专有的权利。

“LAND ROVER”是投诉人企业名称中显著的部分, 投诉人依法对其享有企业名称权。投诉人在进入中国市场后也一直使用“路虎”(LAND ROVER 的中译) 字号, 并于 2010 年成立捷豹路虎汽车贸易(上海)有限公司。

投诉人是域名“landrover.com”“landrover.cn”“landrover.com.cn”的持有人。投诉人早在 1995 年 3 月 22 日即注册了域名“landrover.com”, 2003 年 3 月 17 日注册了域名“landrover.cn”, 2003 年 6 月 4 日注册了“landrover.com.cn”, 并建立了 www.landrover.com.cn 网站, 以中文对投诉人公司及产品进行介绍。

② 争议域名与投诉人的商标构成混淆性相似

投诉人“LANDROVER”品牌在全球具有巨大的影响力和极高的商业美誉度。投诉人是一家具有 80 余年历史的英国最大的汽车制造商, 是唯一拥有过 4 个英国皇室荣誉证书的汽车制造商。LANDROVER(路虎)自 1948

年诞生之日起始终致力于打造能够卓越应对各种路况的全地形汽车。到 20 世纪 50 年代中期, LANDROVER 已成为耐用性和出色越野性能的代名词, 无论是军方、从事农业的客户, 还是要求苛刻的急救服务行业, 都赞叹路虎的完美品质。当年英国首相温斯顿·丘吉尔驾驶的就是 LANDROVER。到 1959 年, 产量就达到 25 万辆。经过六十余年的发展, 路虎已经成长为拥有全系车型、备受全球尊崇的奢华 SUV 领导者, 成为世界上唯一专门生产顶级全地形汽车的奢华 SUV 品牌, 其轻松驾驭各种路况的强大、全面性能卓尔不群、享誉业界, 销售屡屡刷新历史纪录, 获得了极高的知名度, 成为全球著名豪华汽车品牌。LANDROVER 不断改进产品, 但它始终秉承其纯正、超凡、探险的优良传统, 旗下系列车型丰富, 路虎卫士的纯粹, 路虎发现的全能, 路虎极光的时尚, 路虎揽胜的豪华, 各具特色, 均具有极高的知名度。

2003 年, 投诉人在中国设立办事处, 并一直积极致力于为中国消费者提供最顶级的产品、最专业的品牌体验和最奢华的客户服务, 并立志在中国成为业务运作、客户满意度和企业社会责任等方面最成功的豪华汽车生产商及服务供应商。2009 年, 路虎已先后将旗下路虎揽胜、路虎揽胜运动版、路虎第四代发现和路虎神行者 2 代带入中国, 为广大中国消费者提供丰富、全面的产品选择。2010 年 3 月, 路虎卫士在中国市场正式上市。2010 年 12 月, 路虎极光在中国广州车展首发。至此, 路虎已将旗下全系产品引入中国, 充分显示了路虎对中国市场的重视及信心。同时, 路虎已在中国成立销售公司, 并将继续不断完善授权经销商销售网点, 致力于为中国市场和中国消费者提供顶级产品和便捷、快速、专业的奢华品牌体验及客户服务。目前中国已经成为捷豹路虎全球增长最快的市场, 也是捷豹路虎全球第三大市场。

争议域名与“LANDROVER”商标混淆性相似。争议域名是由“LANDROVER”和“VIP”两部分组成, 其中“VIP”是英文“Very Important Person”的缩写, 译为“贵宾”, 对普通消费者或者相关公众而言, 主要起识别作用的是“LANDROVER”部分, 特别是在“LANDROVER”商标有着巨大影响力和极高的商业美誉度的情况下, 而且所增加的 VIP 单词更加容易使得相关公众认为该域名是与 LANDROVER 相关的更为高级的网站, 具有更

为特殊的联系，若干 UDRP 专家在以往裁定中已经指出，对投诉人的商标添加普通单词或词组并不能使投诉人的标志丧失其独特性。因此，争议域名虽增加了一个单词，与投诉人的“LANDROVER”商标略有不同，但其仍然与“LANDROVER”商标混淆性相似。

综上，争议域名与投诉人的商标构成混淆性相似。

（2）被投诉人不拥有对该域名的权利或合法权益

被投诉人不享有“LANDROVER”“LANDROVERVIP”商标专用权。投诉人在中国商标局官方网站及主要搜索引擎网站上均未发现被投诉人对“LANDROVER”“LANDROVERVIP”标识享有商标专用权以及任何民事权益。

投诉人未授权被投诉人使用“LANDROVER”以及相关商标。投诉人从未许可授权被投诉人用任何语言使用其“LANDROVER”商标。

投诉人的“LANDROVER”商标被认定为驰名商标。投诉人注册的第 808460 号“LANDROVER 及图形”商标在商评字【2015】第 0000047167 号“关于第 7696314 号“ROVER”商标无效宣告请求裁定书”中被国家工商行政管理总局商标评审委员会（以下简称“商评委”）认定为驰名商标。商评委认为，该商标在同行中享有盛誉，在市场上具有较高的知名度，为相关公众熟知。2015 年 10 月 27 日，中国国际贸易仲裁委员会域名争议解决中心第 CND-20015000041 号案专家组在裁决中认定，“LANDROVER”商标经过长期使用和大量的宣传，已经凝聚了投诉人的商誉，从而在业界具有很高的知名度，为广大消费者所熟悉，成为全球著名豪华汽车品牌。2015 年 11 月 2 日，中心北京秘书处第 CN-1500901 号域名争议案专家组在裁决中认定，“LANDROVER”商标经过长期的使用和宣传推广，已在相关消费者群体中广为熟知，具有较高的知名度。由此可见，“LANDROVER”商标是投诉人所持有的在中国受法律保护的驰名商标，同时也是投诉人在全球范围内所为众人熟知的商标，是凝结投诉人商誉的名称。投诉人及“LANDROVER”在中国乃至全世界范围内都享有很高的知名度，应受到广泛的保护。

综上，被投诉人对争议域名不享有任何合法权益。

(3) 被投诉人的域名已被恶意注册并且正被恶意使用

投诉人拥有的“LANDROVER”商标为驰名商标，具有极高的知名度。结合认驰裁定，“LANDROVER”商标在中国乃至全世界都有极高的知名度和良好的声誉，被投诉人注册被投诉域名是明知而为之的恶意行为。根据 UDRP 以往的判例，（见 UDRP 裁决 D2012-2311，D2010-0766，D2010-0765），相关案件的专家组认为，由于投诉人的商标为驰名商标，可以认为，被投诉人显然是意图利用投诉人的良好声誉，使人误以为被投诉人与投诉人存在某种关联，以牟取不正当的利益。被投诉人对被投诉域名的注册和使用具有恶意，符合《政策》第 4(b)(iv)条的规定。

在 UDRP 以往的判例中（见裁决 D2004-1049，D2011-0374，D2012-0769，D2011-0413，D2010-0138，D2000-1563 号），相关案件的专家组认为，被投诉人理应知道投诉人驰名商标的存在，因此其利用驰名商标的影响力吸引消费者在相应网站发生交易的行为不能称之为“善意的”，因此被投诉人对该域名不享有权利或合法利益。

根据《政策》第 4(b)(iv)条，当发生域名注册是为了商业利益而将互联网用户吸引至网站来利用他人的众所周知的商标时，即表明恶意注册和使用。被投诉人通过在争议域名中使用投诉人的“LANDROVER”商标和企业名称作为主要识别标志，故意试图将被投诉人网址与投诉人商标和企业名称混淆，以此吸引互联网用户访问被投诉人网站以牟取商业利益，具有明显恶意。

因此，投诉人请求将争议域名转移给投诉人。

被投诉人：

被投诉人未提交答辩。

4、专家意见

根据被投诉人与注册商之间的注册协议，被投诉人同意受《政策》的约束。《政策》适用于本项争议解决程序。

《政策》第 4 条规定了强制性域名争议解决程序。根据第 4(a)条的规

定，投诉人必须证明以下三个条件均已满足：

(i)被投诉的域名与投诉人享有权利的商品商标或服务商标相同或混淆性相似；且

(ii)被投诉人对该域名并不享有权利或合法利益；且

(iii)被投诉人对该域名的注册和使用具有恶意。

根据《政策》、《规则》及《补充规则》，专家组系根据双方针对争议焦点所作的阐述及提交的相应证据居中判断，作出裁决。本案被投诉人没有针对投诉人提出的主张、事实及理由发表任何意见，故专家组只能基于投诉人所提事实和证据，结合审理域名争议的经验及职业判断力，依据《政策》对投诉人提出的主张作出判断。

投诉人就投诉具备《政策》规定的三个条件发表了详细意见，并提交相应证据支持其主张。专家组仔细分析投诉人的主张及证据后，认为在无相反证据的情况下，没有理由不采信投诉人提交的证据。根据本案当事人提交的投诉书及其所附证据材料，本案专家组意见如下：

关于完全相同或混淆性相似

投诉人提供的证据表明，投诉人的“LANDROVER”商标早在 1957 年即已在中国注册，注册号为 29228，核定使用商品包括各种客车、实用和两用车、救护车、公用事业及各种商业用车辆、市政车、车辆等。该商标经多次续展，专用权期限延至 2018 年 11 月 30 日。其他“LANDROVER”“LANDROVER 及图形”“路虎”以及包含“LANDROVER”的商标陆续在中国获得商标注册，均在有效期内。

投诉人的上述商标的注册日期远远早于争议域名的注册日期，即 2015 年 11 月 9 日。据此，专家组认为，投诉人对“LANDROVER”标识享有在先商标权。

在争议域名“landrovervip.com”中，“.com”为通用顶级域名后缀，不具有显著性，故争议域名中具有识别作用的主体部分为“landrovervip”。“landrovervip”与投诉人的商标“landrover”区别在后三个字母“vip”。去掉“vip”字母，主体部分“landrover”与投诉人的注册商标“LANDROVER”除大小

写外完全相同。“vip”是英文“Very Important Person”的缩写，是一个常用词，缺乏显著性。因此“landrovervip”与“LANDROVER”商标构成混淆性相似。

综上，专家组认为争议域名与投诉人享有在先权利的商标构成混淆性相似，投诉人的投诉满足《政策》第 4(a)条规定的第一个条件。

关于被投诉人权利或合法利益

投诉人主张，被投诉人不享有“LANDROVER”“LANDROVERVIP”商标专用权。投诉人从未授权被投诉人使用其商标。针对投诉人的上述主张，被投诉人没有进行答辩以说明和证明其对争议域名享有任何权利或合法利益。专家组认为，被投诉人未提交答辩书的行为已经构成了《规则》第 14 条所规定的缺席。投诉人已经就其所知所能提供了证据，以说明《政策》第 4(a)(ii)条所规定的情形，举证责任应当转移到被投诉人一方。被投诉人没有提交答辩书和证据材料以说明其对争议域名拥有任何权利或合法利益。专家组也无法基于现有证据认定被投诉人就争议域名享有权利或者合法利益。

因此，专家组认为被投诉人对于争议域名不享有权利或合法利益，投诉人的投诉满足《政策》第 4(a)条规定的第二个条件。

关于恶意

(1) 被投诉人注册争议域名是否具有恶意

投诉人提供的证据显示，投诉人的注册商标“LANDROVER”商标经过长期的使用和宣传推广，已在相关消费者群体中广为熟知，具有很高的知名度。鉴于投诉人及其注册商标的知名度，被投诉人在注册争议域名时知晓或应当知晓投诉人或其注册商标，被投诉人理应避让。而被投诉人在知晓或应当知晓的情况下还去注册争议域名，根据《政策》第 4b(ii)条其对争议域名的注册具有恶意。

(2) 被投诉人使用争议域名是否具有恶意

投诉人在诉称及证据中并未提到被投诉人已将争议域名解析到任何网站或网页。对此被投诉人也没有发表意见。专家组在输入争议域名时发现争议域名处于无法打开的状态。鉴于上述情况，专家组认为被投诉人未使

用争议域名。

被投诉人没有使用争议域名，不把争议域名解析到任何网站或网页是一种不作为行为或消极持有行为。这种行为也是使用争议域名的行为。在 *Telstra Corporation Limited v. Nuclear Marshmallows* 域名争议（WIPO 案号：D2000-0003）的裁决中，该专家组认为消极持有争议域名也是使用争议域名的行为。之后许多专家组做出的裁决均持此观点。上述专家组根据案件的具体情况均认定这种消极持有行为属于恶意使用争议域名的行为。

本案专家组对本案做了认真的研究，考虑到下述情况，专家组认为被投诉人消极持有争议域名的行为构成对争议域名的恶意使用：

（1）鉴于投诉人及其注册商标的知名度，被投诉人在注册争议域名时知晓或应当知晓投诉人或其注册商标，被投诉人理应避让。而被投诉人在知晓或应当知晓的情况下还去注册争议域名，其对争议域名的注册具有恶意。

（2）被投诉人注册争议域名后，一直没有积极使用该域名，没有把争议域名指向任何网站或网页。

（3）在投诉人指控其恶意使用争议域名后，被投诉人没有提交答辩书否认有关指控。

（4）被投诉人没有提出任何善意使用争议域名的证明，或尚未使用争议域名的合理原因。

（5）如果被投诉人积极使用争议域名，把争议域名指向任何网站或网页，很容易误导消费者和网络用户，使他们在商品来源者等方面产生误认，投诉人的正常业务会受到损害。

综上所述，被投诉人使用争议域名的行为（消极持有）具有恶意。

因此，专家组认为被投诉人对于争议域名不享有权利或合法利益，投诉人的投诉满足《政策》第 4(a)条规定的第三个条件。

5、裁决

综上所述，专家组认为，投诉符合《政策》第 4(a)条规定的三个条件，根据《政策》第 4(i)条和《规则》第 15 条的规定，专家组裁决将争议域名“landrovervip.com”转移给投诉人捷豹路虎有限公司（JAGUAR LANDROVER LIMITED）。

独任专家：



2016 年 3 月 22 日于北京



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.:	HK-2001374
Complainant:	Tencent Holdings Limited
Respondents:	Livon Biswas / Shubhankar Ghosh
Disputed Domain Names:	<midasbuy.live> <midasbuy.club>

1. The Parties and Contested Domain Names

The Complainant is Tencent Holdings Limited (“**Complainant**”), of P.O. Box 2681 GT, Century Yard, Cricket Square, Hutchins Drive, George Town, Grand Cayman, Cayman Islands.

The Respondents are Livon Biswas, of Pathuriya, Bangaon, West Bengal, 743297, India and Shubhankar Ghosh, of Parmadan N24PGS, Bongaon, West Bengal, 743297 India (collectively “**Respondents**”).

The domain names at issue are <midasbuy.live> and <midasbuy.club> (“**Disputed Domain Names**”), registered by Respondents with GoDaddy.com, LLC (“**Registrar**”), of 14455 Nosrth Hayden Rd, Suite 219, Scottsdale AZ 85260, United States.

2. Procedural History

On 20 July 2020, the Complainant filed a Complaint involving the Disputed Domain Names <midasbuy.live> and <midasbuy.club> with the Hong Kong Office of Asian Domain Name Dispute Resolution Centre (“**Centre**”), pursuant to the Uniform Domain Name Dispute Resolution Policy (“**Policy**”) approved by the Internet Corporation for Assigned Names and Numbers (“**ICANN**”) on 24 October 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (“**Rules**”), approved by ICANN Board of Directors on 28 September 2013 and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (“**Supplemental Rules**”) effective from 31 July 2015.

On 21 July 2020, the Centre transmitted by email to the Registrar a request for confirmation of the WHOIS records of the Disputed Domain Name and other related information.

On 18 August 2020, the Registrar confirmed by email that it is the registrar of the Disputed Domain Names that were registered by the Respondents; and that the Policy is applicable

to the dispute relating to the Disputed Domain Names and the language of the Registration Agreement of the Disputed Domain Names is English and provided to the Centre the Respondents' email addresses and other WHOIS information of the Disputed Domain Names.

The Centre noted from the Registrar that the Disputed Domain Names were registered by two registrants respectively and informed the Complainant of the same. The Complainant requested the Centre to proceed with the complaint filed against two different Respondents and provided supporting documents to argue that the Disputed Domain Names were under common control. The Centre granted the Complainant's request based on the *prima facie* evidence provided by the Complainant and the Centre invited the Respondents to comment on this matter. The Respondents did not comment on this matter.

On 27 August 2020, in accordance with Articles 2(a) and 4(a) of the Rules, the Centre issued a Written Notice of the Complaint and formally notified the Respondent of the commencement of the proceedings in this dispute. In accordance with Article 5(a) of the Rules, the due date for the Respondents to submit a Response to the Complaint was 16 September 2020.

On 17 September 2020, the Centre issued a notification of the Respondent in Default, confirming that the Centre did not receive response forms from the Respondents in respect of the complaint concerning the Disputed Domain Names within the required time. One of Respondents, Shubhankar Ghosh, responded to the Complaint.

On 21 September 2020, the Centre appointed Ms. Nathalie Dreyfus as the sole panelist of the Panel in this matter. Prior to the appointment, the said sole panelist had submitted to the Centre her Statement of Acceptance and Declaration of Impartiality and Independence in compliance with Article 7 of the Rules.

A URS decision for URS Dispute (No. 7AAFBC12) was issued on July 17, 2020 for one of the Disputed Domain Names, i.e., <midasbuy.live>. Complainant has not commenced any other legal proceedings in respect of the other Disputed Domain Name, i.e., <midasbuy.club>.

3. Factual background

Complainant is Tencent Holdings Limited, a video game company, founded in 1998. It developed MidasBuy, a top-up center for video games, music, videos and other entertainment. Complainant uses the MidasBuy as a platform to develop other services.

Complainant has developed its platform through the website <https://midasbuy.com> that had an average monthly visit of more than 2 million, during the period from January to June 2020, and is the 5,932nd most popular website in India.

Complainant is the owner of the following trademarks:

- Hong-Kong figurative "MIDASBUY" trademark No. 305112053, of November 13, 2019 and registered in classes 35 and 36;
- Hong-Kong figurative "MIDASBUY" trademark No. 305119669, of November 21, 2019 and registered in class 42;

- EU figurative “MIDASBUY” trademark No. 018150428, of March 12, 2020 and registered in classes 35 and 36;
- EU figurative “MIDASBUY” trademark No. 018154572, of March 13, 2020 and registered in class 42;
- Indian figurative “MIDASBUY” trademark No. 4357373, filed on November 25, 2019, that is currently in status “accepted and advertised”, in classes 35 and 36;
- Indian figurative “MIDASBUY” trademark No. 4357374, filed on November 25, 2019, that is currently in status “accepted and advertised”, in class 42.

Complainant also owns several domain names such as <midasbuy.com> registered on June 5, 2018.

Respondents are Shubhankar Ghosh and Livon Biswas, respectfully the owners of the Disputed Domain Names <midasbuy.club> and <midasbuy.live>, respectively registered on June 20, 2020 and June 18, 2020 for a one year-period.

4. Parties’ Contentions

A. Complainant

The Complainant’s contentions can be summarized as follows:

- i. The disputed domain names are identical or confusingly similar to a trademark or a service mark in which the Complainant has rights:

Complainant states that it owned MIDASBUY figurative trademarks. It also argues that a figurative trademark cannot be reproduced in a disputed domain name, besides its figurative trademarks are mainly composed of the “MIDASBUY” sign, which is the textual element exclusively reproduced in the Disputed Domain Names.

Furthermore, Complainant argues that the TLDs should not be taken into consideration to establish the risk of confusion when comparing the Disputed Domain Names with Complainant’s trademark.

In addition, Complainant alleges that the past use of the Disputed Domain Name <midasbuy.live> and the current use of the Disputed Domain Name <midasbuy.club> contribute to the confusion with its trademark. They were or are resolving to a website that reproduce Complainant’s official website, which necessarily increase consumers’ confusion.

Considering the above elements, Complainant argues that the Disputed Domain Names are identical to its prior trademarks.

- ii. Respondent has no rights or legitimate interests in respect of the domain names:

Complainant alleges that since it owned MIDASBUY trademarks, it benefits from an exclusive right to use this sign in connection with the designated goods and services.

Complainant also argues that Respondents are not sponsored by nor affiliated with Complainant in any manner, and that it did not give permission to register the Disputed Domain Names.

In addition, Complainant states that Respondents are not commonly known by the disputed domain names, which shows that they do not benefit from any legitimate interests. Furthermore, Respondents cannot claim that their names are somehow related to the Disputed Domain Names, in order to justify any legitimate interests.

Moreover, Complainant alleges that prior to the suspension of the Disputed Domain Name <midasbuy.live>, it was resolving to a website reproducing Complainant's official website. Once it has been suspended, following the URS decision, it redirected to <midasbuy.club> to the same copy of the official website. These replicas of Complainant's official website were obviously designed to make internet users believe that the Disputed Domain Names were linked to Complainant. Such a use of the Disputed Domain Names could not be seen as a *bona fide* offering of goods and services or a legitimate noncommercial or fair use.

Complainant also indicated that it owned trademarks rights (at least in the European Union and Hong Kong) in the sign MIDASBUY prior to the registration of the Disputed Domain Names, also in its main <midasbuy.com> domain name. It also argues that it filed Indian MIDASBUY trademarks prior to the Disputed Domain Names' registration.

Complainant concludes that Respondents have no rights or legitimate interests in the Disputed Domain Names.

iii. The disputed domain names have been registered and are being used in bad faith:

Complainant first points out that it owned trademark rights in the MIDASBUY sign across the world, prior to the Disputed Domain Names' registration.

Thus, Complainant considers that Respondents registered the Disputed Domain Names with the knowledge of Complainant's business. Respondents registered the Disputed Domain Names that reproduce identically the MIDASBUY trademark and the Complainant's <midasbuy.com> domain name to initially resolve to a website that was reproducing Complainant's official website. Consequently, this action implies bad faith.

Furthermore, Complainant states that Respondents are using the Disputed Domain Names in bad faith. First, both Disputed Domain Names were pointing to a website that was reproducing Complainant's official website, therefore creating a likelihood of confusion and attempting to profit from the latter. Respondents thus use the fame of the Complainant's trademark to improperly increase traffic to the Disputed Domain Names for commercial gain. Such use constitutes bad faith.

Complainant argues that it is not a use in good faith and considers the Disputed Domain Names have only been registered in order to cause confusion among internet users.

Thus, Complainant states that Respondents registered and used the Disputed Domain Names in bad faith.

B. Respondent

The Respondent's contentions can be summarized as follows:

Only one of the Respondents, i.e., Shubhankar Ghosh, answered to the Complaint, namely the Disputed Domain Name <midasbuy.club>'s registrant.

First, it stated that the website did not belong to him, without indicating to which Disputed Domain Name he was referring. However, he indicated that he was the "buy hosting" of the second registrant, i.e., Livon Biswas.

The same Respondent, i.e., Shubhankar Ghosh, then sent another email confirming that it deleted "all websites" and arguing that he was creating websites for the second registrant, i.e., Livon Biswas. He requested to close the file since he deleted "the website". It finally sent another email "*im buy the domain buy web site is not my*" that could be translated as "I bought the domain but the website is not mine".

Finally, on September 22, 2020, Respondent, i.e., Shubhankar Ghosh, sent an email indicating that he wished either to transfer the domain name or to delete it.

The second Respondent, i.e., Livon Biswas, did not respond to Complainant's contentions and is therefore in default.

5. Findings

Preliminary matter: multiple Respondents

"Where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties" (WIPO Case No. D2019-0117, *WhatsApp Inc., Instagram, LLC v. Naim Wekking, Jack Worli*).

In this case, Complainant has duly shown the Respondents were linked and in control of the Disputed Domain Names. The connection between the individuals that have been identified as Respondents in the Whois information is established: the Disputed Domain Names have been registered two days apart; Respondents are located very close to each other; the composition of the Disputed Domain Names is the same; they are registered with the same Registrar; they were pointing to a similar website. Furthermore, once the URS decision has been rendered against the disputed domain name <midasbuy.live>, the litigious website was deleted and the said domain name redirected through the other Disputed Domain Name <midasbuy.club>.

Furthermore, the only Respondent who replied to the Complaint, after Complainant submitted the amended Complaint confirmed that it had the control on the websites since he created the websites for his own domain name and for the other Respondent. The litigious websites linked to the Disputed Domain Names are not controlled by the same person.

Panel considers it is fair to consolidate Respondents, for the following reasons:

- Complainant showed there were close similarities in the Whois information between the Respondents;
- The Disputed Domain Names have been registered few days one after the other;
- The Disputed Domain Names are or were initially pointing to the same websites;
- The Disputed Domain Name <midasbuy.live> started to redirect through the other Disputed Domain Name <midasbuy.club> once the URS decision was rendered;

- One of the Respondents admitted that it was involved with the two websites, even if it was not the registrant of both of them.

Complainant requested the consolidation of the Respondents. Based on the procedural economy and as the consolidation is fair and equitable, the Panel therefore finds that the consolidation of this Complaint is justified.

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

- i. Respondent's domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- ii. Respondent has no rights or legitimate interests in respect of the domain name; and
- iii. Respondent's domain name has been registered and is being used in bad faith.

A) Identical / Confusingly Similar

Panel finds that Complainant has duly shown that he owns trademark rights in the MIDASBUY sign.

Firstly, Complainant showed it owned rights in the MIDASBUY sign, at least in Hong Kong and the European Union, and that it filed Indian trademarks that should be registered soon.

Furthermore, Complainant has also showed he owns the <midasbuy.com> domain name.

All rights of Complainant predate the Disputed Domain Names' registration.

Secondly, it is commonly considered that a Top-Level Domain ("TLD"), such as ".club" or ".live" shall be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark (see section 1.11 of the WIPO Overview 3.0). Previous Panels have considered as a rule that the addition of a TLD do not prevent a finding of confusing similarity (See for example WIPO Case No. D2019-0657, *Sanofi v. Jamey Kirkes* : "*The disputed domain name is identical to the Complainant's trademark SANOFI but for the gTLD ".dev", which is typically to be disregarded for the purpose of comparison.*").

Thirdly, the Disputed Domain Names <midasbuy.live> and <midasbuy.club> reproduce the Complainant's trademark identically and exclusively.

In accordance with Paragraph 4(a)(i) of the Policy, the Panel finds that the Disputed Domain Names are identical to Complainant's trademark.

B) Rights and Legitimate Interests

Complainant must first make a *prima facie* case that Respondents lack the rights and legitimate interests in the disputed domain names under Paragraph 4(a)(ii).

Complainant has duly demonstrated that he did not give any authorization or license to Respondents neither to use the MIDASBUY sign nor to register the Disputed Domain Names and that Respondents are not commonly known under the MIDASBUY sign. None of the information provided in the Whois of the Disputed Domain Names refers to this sign.

Furthermore, the Respondent that answered to the Complaint did not show he has rights or legitimate interests in the MIDASBUY sign, and the other Respondent is in default as he did not answer to the Complaint. Therefore, regarding those elements, Respondents have not demonstrated they have any rights or legitimate interests.

On the other side, Panel finds that there is no *bona fide* offering of goods and services or legitimate noncommercial or fair use. Initially, both Disputed Domain Names were resolving to a website imitating the Complainant's official website. Prior to this Complaint, Complainant filed a URS complaint against the Disputed Domain Name <midasbuy.live>. Following the decision, the website has been deleted and the said Disputed Domain Name started to redirect to the other Disputed Domain Name, <midasbuy.club>, which was still used for the same website.

A previous Panel has already stated that “*The disputed domain name incorporates the Complainant's trademarks and the website associated with the disputed domain name is used to sell products, in the course of commercial activity, under the Complainant's trademarks and imitating the Complainant's original website*” (WIPO Case No. D2019-3201, *BA&SH v. Domain Administrator*, See *PrivacyGuardian.org / Name Redacted*).

The Disputed Domain Names were or are offering paid services when imitating Complainant's official website. Those foregoing elements cannot be indicative of a *bona fide* offering of goods and services or a legitimate non commercial or fair use.

Thus, Panel finds that Complainant has established a *prima facie* case that Respondents lack the rights and legitimate interests in the Disputed Domain Names pursuant to Paragraph 4(a)(ii) of the Policy.

C) Bad Faith

Paragraph 4(a)(iii) of the Policy requires Complainant to demonstrate that the Disputed Domain Names were registered and are being used in bad faith.

Firstly, Complainant has duly shown its rights in the MIDASBUY sign and its reputation in the video games' field of activity.

Furthermore, the Disputed Domain Names were initially both imitating almost identically Complainant's official website. Once the website related to the Disputed Domain Name <midasbuy.live> was deactivated, it started redirecting to the second Disputed Domain Name which was still pointing to a website imitating almost identically Complainant's official website.

Panel considers that the Disputed Domain Names were registered in bad faith. Respondent had necessarily Complainant's business in mind and registered the Disputed Domain Names to benefit from Complainant's reputation and divert Internet users.

Panel therefore finds the Disputed Domain names were registered in bad faith.

Secondly, the Disputed Domain Names are or were pointing to a website imitating Complainant's official website for commercial gain. Indeed, it appears that Internet users were invited to register and to pay for some services. Respondents were therefore benefiting from Complainant's reputation in order to earn money.

Benefiting from Complainant's reputation for commercial gain is mainly considered by previous Panels as a use in bad faith. See for example : WIPO Case No. 2019-2134, *Birdies, Inc. v. Registration Private, Domains By Proxy, LLC / Fu Li* : “the Respondent sought to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's BIRDIES trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website and the products purportedly offered therein, amounting to bad faith within the meaning of paragraph 4(b)(iv) of the Policy”.

Such a use could not be considered as a use in good faith.

Furthermore, Respondents knew about the URS proceedings against the Disputed Domain Name <midasbuy.live> and about Complainant's rights. Once the website deactivated, the second Disputed Domain Name was used for a website imitating Complainant's official one. At this time, Respondents intentionally wished to keep the link to a litigious website.

Such a redirection in full knowledge of Complainant's rights is not a use in good faith.

Finally, neither Respondent tried to justify any rights or use in good faith, nor did Respondent who answered lately to the Complaint tried to proof any use in good faith.

Therefore, Panel finds that the Disputed Domain Names are used in bad faith.

Complainant has, therefore, satisfied the requirements of Paragraph 4(a)(iii) of the Policy.

6. Decision

For the foregoing reasons, in accordance with Paragraph 4(i) of the Policy and Paragraph 15 of the Rules, the Panel orders that the Disputed Domain Names must be transferred to the Complainant.

Nathalie Dreyfus
Panelist

Dated: October 12, 2020





Asian Domain Name Dispute Resolution Centre

hong kong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-2101461
Complainant:	Herbalife (Shanghai) Management Co., Ltd.
Respondent:	Yang Kyung Won
Disputed Domain Name(s):	<kangbaolai.com>

1. The Parties and Contested Domain Name

The Complainant is Herbalife (Shanghai) Management Co., Ltd., Shanghai, China represented by Beijing Chaocheng Law Firm, Beijing, China.

The Respondent is Yang Kyung Won, Seoul, Republic of Korea.

The domain name at issue is <kangbaolai.com>, registered by the Respondent with Megazone Corp., dba HOSTING.KR, at 7th Floor, Megazone Building, 46 Nonhyeon-ro 85-gil, Gangnam-gu, Seoul, Republic of Korea.

2. Procedural History

The Complaint was filed with the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (ADNDRC)[“Centre”] on May 7, 2021, seeking for a transfer of the disputed domain name. On May 10, 2021, the Centre sent an email to the Megazone Corp., dba HOSTING.KR asking for the detailed data of the registrant. On May 17, 2021, the Registrar verified that Yang Kyung Won is the current registrant of the disputed domain name and that the Respondent is bound by the Megazone Corp., dba HOSTING.KR registration agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN’s Uniform Domain Name Dispute Resolution Policy (the “Policy”).

The Centre verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the Centre’s Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

The proceedings commenced on June 1, 2021. In accordance with the Rules, the Centre formally notified the Respondent of the Complaint in both Korean and English, setting a

deadline of June 21, 2021 by which the Respondent could file a Response to the Complaint, via e-mail to all entities and persons listed on the Respondent's registration as technical, administrative, and billing contacts.

A timely Response was received on June 11, 2021.

On June 16, 2021, the Centre appointed Ho-Hyun Nahm, Esq., as the Sole Panelist in the administrative proceeding and with the consent for the appointment, impartiality and independence declared and confirmed by the Panelist, the Centre, in accordance with paragraph 7 of the Rules, organized the Panel of this case in a legitimate way.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the Centre has discharged its responsibility under Paragraph 2(a) of the Rules "to employ reasonably available means calculated to achieve actual notice to Respondent" through submission of Electronic and Written Notices, as defined in the Rules. Therefore, the Panel may issue its decision based on the documents submitted and in accordance with the Policy, the Rules, the Centre's Supplemental Rules and any rules and principles of law that the Panel deems applicable.

3. Preliminary Issue: Language of the Proceedings

The Panel notes that the Registration Agreement is written in Korean, thereby making the language of the proceedings in Korean. The Complainant has requested that the proceeding should be in English because i) the Complainant has done a tremendous job of presenting evidence; ii) the Complainant has translated a lot of evidence from Chinese into English; iii) it would be unfair to the Complainant to have it translated into Korean; iv) the technical terms in the domain name dispute area are difficult to express accurately in Korean; and v) English is the international language. The Respondent rebuts that the proceeding should be in Korean because the Respondent himself is a Korean, and he is not free in communicating in English which would unfairly affect the proceedings.

Paragraph 11(a) of the Rules provides that the language of the proceeding shall be the language of the Registration Agreement, unless otherwise agreed to by the parties, subject to the authority of the panel to determine otherwise. In this case, the language of the Registration Agreement is Korean, and both Parties have had an opportunity to argue their position on this point. In determining the language of the proceeding in the present case, the Panel considers the following points: i) the Response (in Korean) indicates the Respondent's knowledge of the requirements under the UDRP; ii) a good number of UDRP proceedings where the Respondent is a party were conducted in English [e.g., *Renée Blanche S.r.l. v. Yang Kyung Won*, D2018-0541 (WIPO May 13, 2018); *Adapt IT Holdings Limited v. Yang Kyung Won*, D2016-1173 (WIPO September 16, 2016), etc.]; and iii) the Panel is familiar with both languages, capable of reviewing all the documents and materials in both languages, and able to give full consideration to the Parties' respective arguments.

In light of the aforementioned circumstances, the Panel finds that there will be no prejudice against the Respondent as a result of the Complainant's submission in English. Thus, the Panel concludes that it will accept the Complaint as filed in English as well as the Response as filed in Korean, and issue a decision in English.

4. Factual background

The Complainant is the legitimate user of the trademarks "Herbalife" and "康宝莱". The Complainant, Herbalife (Shanghai) Management Co., Ltd. is a member of Herbalife group, which is a branch of Herbalife International, Inc. in China. Herbalife International, Inc. is a global nutrition and weight management company founded in the United States in 1980. Herbalife International Inc. has more than 10,000 employees operating in more than 90 countries. The Complainant, operating in China since 2014, has been authorized exclusively by Herbalife International Inc. for using the trademarks of "Herbalife" and "康宝莱" since 2019.

5. Parties' Contentions

A. Complainant

The Complainant's contentions are summarized as follows:

- i) Herbalife International, Inc., has rights in the 康宝莱 mark based on registrations of the mark with the China National Intellectual Property Administration (CNIPA)(e.g., Reg. No. 5299273 registered on July 28, 2009; Reg.No.5318601 registered on July 21, 2009; Reg.No.5318600 registered on August 14, 2009). Legitimately authorized by Herbalife International Inc., the Complainant has the exclusive right to use the trademark 康宝莱 (hereinafter referred to as 'Complainant's mark'). The disputed domain name is confusingly similar to the Complainant's mark.
- ii) The Respondent has no rights or legitimate interests in respect of the domain name. The Complainant has not authorized the Respondent to use the Complainant's trademark and domain name in any form. The Complainant's investigation has revealed that there is no trace of trademark registration information of "kangbaolai" or "康宝莱" under the name of the Respondent. The Respondent is not commonly known by the disputed domain name. The Respondent does not appear to have operated any *bona fide* or legitimate business under the disputed domain name and is not making a fair use of the disputed domain name. There is no indication that the Respondent has used the disputed domain name in connection with an active website. The disputed domain name was directed to another website which was improvised by the Respondent after the Complainant filed the Complaint. This is merely a means for the Respondent to evade the UDRP policy.
- iii) The Respondent was aware of the existence of the Complainant and its trademark at the time of registering the disputed domain name. As the registration time of the disputed domain name <kangbaolai.com> is August 23, 2010, which is much later than the time when the Complainant used the trademark or operates business in China and in the Republic of Korea. The disputed domain name has been "maliciously registered." The Respondent had directed the disputed domain name to a domain name sales page publicly showing that the purpose of registering the domain name was to sell the domain name. After filing of this Complaint, the Respondent created a temporary website in order to evade the UDRP policy. It does not confer rights on the Respondent, whose actions can establish that his use of the disputed domain name was in bad faith. The Complainant has several squatted domain names under his name (e.g.,< GRKOREA.com>, <labelux.com>). This kind of repeatedly squatting the domain name corresponding to others' brand belongs to malicious use. The Respondent's conduct was consistent with the description in Policy 4B (ii).

B. Respondent

The Respondent's contentions are summarized as follows:

- i) The Complainant does not have a trademark registration related to the disputed domain name in the Republic of Korea. The Complainant's mark is not a well-known or famous mark in Korea or elsewhere in the world.
- ii) The Respondent has rights and legitimate interests in respect of the disputed domain name. The Respondent is conducting an Internet business in Korea. The Respondent has been actively using the disputed domain name for the Respondent's blog address. The Respondent has legitimately registered the disputed domain name. The disputed domain name is the Respondent's beloved nick name.
- iii) Anyone is entitled to register the disputed domain name per the first-to-register rule of Registrars. As the Respondent purchased and owns the disputed domain name which was legitimately registered, the Complainant who is not a legitimate right holder for the disputed domain name has engaged in reverse domain name hijacking. Only the Respondent is entitled to own the disputed domain name exclusively.

6. Findings

- i) Herbalife International, Inc. has rights in the 康宝莱 mark based on registrations of the mark with the China National Intellectual Property Administration (CNIPA) (*e.g.*, Reg. No. 5299273 registered on July 28, 2009; Reg. No. 5318601 registered on July 21, 2009; Reg. No. 5318600 registered on August 14, 2009). Legitimately authorized by Herbalife International, the Complainant has established exclusive rights to use the 康宝莱 mark.
- ii) The disputed domain name was registered on August 23, 2010.
- iii) The Respondent had resolved the disputed domain name to a domain name sales page. The disputed domain name was resolved to a domain name sales page dated February 23, 2021, March 8, 2015, and September 15, 2013. The disputed domain name's resolving website dated March 8, 2015 and September 15, 2013 displays hyperlinks for the Complainant's trademark "康宝莱" and other Chinese character brand products.
- iv) The disputed domain name's present resolving website offers a type of consulting services for furniture.
- v) The Complainant has not engaged in reverse domain name hijacking.

7. Discussions

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (2) Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

A) Identical / Confusingly Similar

Herbalife International, Inc., has rights in the 康宝莱 mark based on registrations of the mark with the China National Intellectual Property Administration (CNIPA) (e.g., Reg. No. 5299273 registered on July 28, 2009; Reg. No. 5318601 registered on July 21, 2009; Reg. No. 5318600 registered on August 14, 2009). Legitimately authorized by Herbalife International, the Complainant has the exclusive right to use the 康宝莱 mark. The disputed domain name is confusingly similar to the Complainant's mark.

The Respondent rebuts that the Complainant does not have a trademark registration relevant to the disputed domain name in the Republic of Korea. The Panel observes that it is not required for the Complainant to have a trademark registration in the country of the Respondent. *See paragraph 1.1.2, WIPO Jurisprudential Overview 3.0* (noting in particular the global nature of the Internet and Domain Name System, the jurisdiction(s) where the trademark is valid is not considered relevant to panel assessment under the first element). The general consensus is that a national or a regional trademark registration is sufficient in conferring rights in a mark under paragraph 4(a)(i) of the Policy. *See paragraph 1.2.1 WIPO Jurisprudential Overview 3.0* (where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case); *see also T-Mobile USA, Inc. dba MetroPCS v. Ryan G Foo / PPA Media Services*, FA1627542 (FORUM Aug. 9, 2015) (finding that Complainant has rights in the METROPCS mark through its registration with the United States Patent and Trademark Office); *see also Samsung Electronics Co., Ltd v. lupie jet, KR-1700157* (CENTRE May 3, 2017) (finding that Complainant has rights in the SAMSUNG mark through its registration with the Korean Intellectual Property Office). The Complainant has provided the Panel with the trademark certificates for 康宝莱 mark in the name of Herbalife International, Inc. as duly registered with the CNIPA. The Complainant has further submitted the Trademark Authorization Certificate authorizing an exclusive right to use 康宝莱 mark and some other marks to the Complainant, along with the power to represent the Herbalife International, Inc. in initiating complaints against any infringement on the Herbalife International, Inc.'s intellectual property rights including trademark infringement. Therefore, the Panel finds the Complainant's evidence of CNIPA registrations for the 康宝莱 mark and the Trademark Authorization Certificate authorizing the Complainant an exclusive right to use 康宝莱 mark sufficient in establishing rights under paragraph 4(a)(i) of the Policy. *See paragraph 1.4.1, WIPO Jurisprudential Overview 3.0* (a trademark owner's affiliate such as a subsidiary of a parent or of a holding company, or an exclusive trademark licensee, is considered to have rights in a trademark under the UDRP for purposes of standing to file a complaint).

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's mark. The main identifying part of the disputed domain name contains all or at least one of the main features of the trademark, which has led to the confusion. Apart from the suffix ".com ", the distinguishing part of the disputed domain name <kangbaolai.com> is "kangbaolai", which is consistent with the Chinese pinyin corresponding to the Complainant's

"康宝莱" trademark. The additional part ".com" does not lessen the inevitable confusion of "kangbaolai" of the disputed domain name with the Complainant's trademark. The Panel finds that the part "kangbaolai" of the disputed domain name is an English transliteration of the Complainant's mark "康宝莱", and thus it is confusingly similar to the Complainant's mark. *See paragraph 1.14, WIPO Jurisprudential Overview 3.0* (a domain name that consists or is comprised of a translation or transliteration of a trademark will normally be found to be identical or confusingly similar to such trademark for purposes of standing under the Policy, where the trademark – or its variant – is incorporated into or otherwise recognizable, through such translation/transliteration, in the domain name). The Panel also agrees that addition of a gTLD '.com' to the English transliteration of the Complainant's mark "康宝莱" in order to form the disputed domain name does not distinguish the disputed domain name from Complainant's mark for the purposes of the analysis of paragraph 4(a)(i) of the Policy. *See Microsoft Corporation v. Thong Tran Thanh*, FA 1653187 (FORUM Jan. 21, 2016) (determining that confusing similarity exist where [a disputed domain name] contains Complainant's entire mark and differs only by the addition of a generic or descriptive phrase and top-level domain, the differences between the domain name and its contained trademark are insufficient to differentiate one from the other for the purposes of the Policy).

The Panel, therefore, finds that the disputed domain name is confusingly similar to Complainant's mark "康宝莱" per paragraph 4(a)(i) of the Policy.

B) Rights and Legitimate Interests

Complainant must first make a *prima facie* case that Respondent lacks rights and legitimate interests in the disputed domain name under paragraph 4(a)(ii) of the Policy, and then the burden shifts to Respondent to show it does have rights or legitimate interests. *See Hanna-Barbera Prods., Inc. v. Entm't Commentaries*, FA741828 (Forum Aug. 18, 2006) (holding that the complainant must first make a prima facie case that the respondent lacks rights and legitimate interests in the disputed domain name under paragraph 4(a)(ii) of the Policy before the burden shifts to the respondent to show that it does have rights or legitimate interests in a domain name); *see also AOL LLC v. Gerberg*, FA780200 (Forum Sept. 25, 2006) ("Complainant must first make a prima facie showing that Respondent does not have rights or legitimate interest in the subject domain names, which burden is light. If Complainant satisfies its burden, then the burden shifts to Respondent to show that it does have rights or legitimate interests in the subject domain names.").

The Complainant has not authorized the Respondent to use the Complainant's trademark and domain name in any form. The Panel finds that a lack of contradicting evidence in the record that the Respondent was authorized to use a complainant's mark in a domain name can be evidence of a lack of rights and legitimate interests. *See Navistar International Corporation v. N Rahmany*, FA1620789 (FORUM June 8, 2015) (finding that the respondent was not commonly known by the disputed domain name where the complainant had never authorized the respondent to incorporate its NAVISTAR mark in any domain name registration).

The Complainant further contends that the Complainant's investigation has revealed that there is no trace of trademark registration information of "kangbaolai" or "康宝莱" under the name of the Respondent. The Respondent is not commonly known by the disputed domain name. The Panel is of the view that WHOIS information can be used to support a finding under paragraph 4(a)(ii) of the Policy that a respondent is not commonly known by a disputed

domain name. See *Chevron Intellectual Property LLC v. Fred Wallace*, FA1626022 (FORUM July 27, 2015) (finding that the respondent was not commonly known by the <chevron-europe.com> domain name under paragraph 4(a)(ii) of the Policy, as the WHOIS information named “Fred Wallace” as registrant of the disputed domain name). The Panel notes that the WHOIS information of the disputed domain name lists “Yang Kyung Won” as registrant of the disputed domain name, and thus finds that the Respondent was not commonly known by the <kangbaolai.com> domain name.

Next, the Complainant submits that the Respondent does not appear to have operated any *bona fide* or legitimate business under the disputed domain name and is not making a fair use of the disputed domain name. There is no indication that the Respondent has used the disputed domain name in connection with an active website. The Complainant contends that the disputed domain name was directed to another website which was improvised by the Respondent after the Complainant filed the Complaint. This is merely a means for the Respondent to evade the UDRP policy.

Given the considerations above, the Panel finds that the Complainant has made out a *prima facie* case. As the onus thus shifts to the Respondent, the Panel must now see if the Respondent has rebutted the *prima facie* case and shown that it has a right or legitimate interest in the disputed domain name. The Respondent rebuts that the Respondent has rights and legitimate interests in respect of the domain name because i)the Respondent is conducting an Internet business in Korea; ii)the Respondent has been actively using the disputed domain name for the Respondent’s blog address; iii)the Respondent has legitimately registered the disputed domain name; and iv)the disputed domain name is the Respondent’s beloved nick name.

The Panel notes that the Respondent failed to provide the Panel with any evidence showing that the disputed domain name is the Respondent’s beloved nick name. According to the screenshot of the WaybackMachine the Complainant submitted, the Panel notes that the Respondent had resolved the disputed domain name to a domain name sales page publicly showing that the purpose of registering the domain name was to sell the domain name. Another Screenshot History which the Complainant has provided to the Panel shows that the disputed domain name was resolved to a domain name sales page dated February 23, 2021, March 8, 2015, and September 15, 2013. The Panel notes that the screenshot of the disputed domain name’s resolving website dated March 8, 2015 and September 15, 2013 displays hyperlinks for the Complainant’s trademark “康宝莱” and other Chinese character brand products. The Panel observes that under Policy paragraph 4(b)(iv), using a disputed domain name to host parked pay-per-click links may be considered bad faith attraction for commercial gain. See *Red Hat, Inc. v. Haecke*, FA 726010 (Forum July 24, 2006) (finding that the respondent engaged in bad faith registration and use pursuant to Policy paragraph 4(b)(iv) by using the disputed domain names to operate a commercial search engine with links to the products of the complainant and to complainant’s competitors, as well as by diverting Internet users to several other domain names). Even the disputed domain name’s present resolving website the Respondent has provided to the Panel indicates a type of consulting services for furniture. However, it is considered that the disputed domain name is currently being used to divert Internet users to its website to promote its own consulting services. Such use does not qualify as a *bona fide* offering of goods or services, nor can it be a legitimate noncommercial or fair use under Policy paragraphs 4(c)(i) and (iii). See *j2 Global Canada, Inc. and Landslide Technologies, Inc. v. VIJAY S KUMAR / STRATEGIC OUTSOURCING SERVICES PVT LTD*, FA 1647718 (Forum Jan. 4, 2016) (finding that the disputed domain purports to offer for sale goods and services in the field of electronic marketing, which directly overlap with the

services covered by Complainant's registrations and offered by Complainant online, and therefore Respondent does not have rights or legitimate interests through its competing use).

As the Panel finds that the Respondent has failed to rebut the *prima facie* case against it, it concludes that the Respondent has no rights or legitimate interests in the disputed domain name.

C) Bad Faith

The Complainant argues that the Respondent registered and used the disputed domain name in bad faith. At the time of registration of the disputed domain name, the Respondent knew, or at least should have known, of the existence of the Complainant's trademark. The Complainant's group, Herbalife Nutrition Ltd. (hereinafter referred to as "Herbalife Nutrition") is a leading nutrition and weight management company in the world. Herbalife Nutrition's products for weight management, nutritional supplements, energy and fitness, and personal care are now available in more than 90 countries and regions. Herbalife Korea Co., Ltd. was founded in 1996, and Herbalife Nutrition officially started its business activities in the Republic of Korea in 1996. Furthermore, after searching through naver.com, a popular search engine in the Republic of Korea, it is found some media have reported Herbalife's early business activities, which could even be traced as early as 2004. Based on the above information, it can be seen that Herbalife Nutrition has accumulated high reputation and influence in China, Republic of Korea, and across the world. Inevitably, the brand "康宝莱" has gained certain popularity as well, since the brand "康宝莱" has formed a unique corresponding relationship with the Complainant. The Complainant has provided the Panel with NAVER search results to confirm this relation.

The Panel is of the view that actual knowledge of a complainant's rights in a mark may be shown by evidence such as the fame of the mark and the use the respondent makes of the mark under paragraph 4(a)(iii) of the Policy. *See Google Inc. v. Ahmed Humood*, FA1411001591796 (FORUM Jan. 7, 2015) ("This Panel makes that inference; Respondent has actual knowledge of Complainant's mark at the time of domain name registration based on the fame of Complainant's GOOGLE mark and Respondent's use of one of the disputed domain names to detail Internet domain name registration and maintenance services related to and in competition with Complainant."). The Panel infers, due to the notoriety of Complainant's mark and the manner of use of the disputed domain name (hosting a website displaying hyperlinks for 康宝莱 products) that the Respondent had actual knowledge of the Complainant's mark before registering the disputed domain name, and it finds that the Respondent registered and uses the disputed domain name in bad faith under paragraph 4(a)(iii) of the Policy.

The Complainant further contends that the Respondent had resolved the disputed domain name to a domain name sales page publicly showing that the purpose of registering the domain name was to sell the domain name. The screenshot which the Complainant has provided to the Panel shows that the disputed domain name was resolved to a domain name sales page dated February 23, 2021, March 8, 2015, and September 15, 2013. The Panel notes that offering a disputed domain name for sale generally can demonstrate bad faith per Policy paragraph 4(b)(i). The Panel finds that the disputed domain name has been offered for sale generally for a sum in excess of likely costs of registration. In light of the notoriety of the Complainant's mark and the manner of use of the disputed domain name (hosting a website displaying hyperlinks for 康宝莱 products), the Panel also finds that the Respondent's

offering the disputed domain name for sale amounts to registration and use in bad faith under the Policy. *See Airbnb, Inc. v. Super Privacy Service LTD c/o Dynadot*, FA 1821386 (Forum Jan. 10, 2019) (“Complainant argues that Respondent registered and uses the <airbnb.com> domain name in bad faith by offering it for sale. The panel agrees and finds that Respondent registered and uses the disputed domain name in bad faith under Policy ¶ 4(b)(i).”); *see also Diners Club Int’l Ltd. v. Domain Admin*****It’s all in the name******, FA 156839 (Forum June 23, 2003) (finding that when the domain name itself notes that it is “available for lease or sale,” evidence that the domain name was registered and used in bad faith pursuant to Policy paragraph 4(b)(i) can be inferred from the fact that “the sole value of the [<www.dinersclub.com] domain name is dictated by its relation to the complainant’s registered DINERS CLUB mark).

The Panel notes that the screenshot of the disputed domain name’s resolving website dated March 8, 2015 and September 15, 2013 displays hyperlinks for the Complainant’s trademark “康宝莱” and other Chinese character brand products. The Panel observes that under Policy paragraph 4(b)(iv), using a disputed domain name to host parked pay-per-click links may be considered bad faith attraction for commercial gain. *See Red Hat, Inc. v. Haecke*, FA 726010 (Forum July 24, 2006) (finding that the respondent engaged in bad faith registration and use pursuant to Policy paragraph 4(b)(iv) by using the disputed domain names to operate a commercial search engine with links to the products of the complainant and to complainant’s competitors, as well as by diverting Internet users to several other domain names).

The disputed domain name’s present resolving website the Respondent has provided to the Panel indicates a type of consulting services for furniture. However, it is considered that the disputed domain name is currently being used to divert Internet users to its website to promote its own consulting services. This website appears to have been improvised by the Respondent after the Complainant filed the Complaint. The Panel finds that such a use of the disputed domain name constitutes bad faith registration and use of the disputed domain name. Such use may qualify as bad faith attraction to commercial gain under Policy paragraph 4(b)(iv). *See CAN Financial Corporation v. William Thomson / CNA Insurance*, FA1401001541484 (Forum Feb. 28, 2014) (finding that the respondent had engaged in bad faith under Policy ¶ 4(b)(iv), by using a confusingly similar domain name to attract Internet users to its own website where it sold competing insurance services).

Taking into account all of the above, the Panel concludes that the Respondent registered and used the disputed domain name in bad faith under paragraph 4(a)(iii) of the Policy.

Reverse Domain Name Hijacking

The Respondent alleges that the Complainant has acted in bad faith and is engaging in reverse domain name hijacking by initiating this dispute. The Respondent contends that the Complainant is attempting to deprive the Respondent, the rightful registered holder of <kangbaolai.com>, of its rights to use the disputed domain name. Aside from a conclusory statement in the Response, the Respondent makes no further contentions as to the Complainant’s reverse domain name hijacking. Since the Panel notes that the Complainant has satisfied all of the elements of Policy paragraph 4(a), it finds that the Complainant has not engaged in reverse domain name hijacking. *See World Wrestling Fed’n Entm’t, Inc. v. Ringside Collectibles*, D2000-1306 (WIPO Jan. 24, 2001) (“Because Complainant has satisfied [all of] the elements of the Policy, Respondent’s allegation of reverse domain name hijacking must fail”); *see also Gallup, Inc. v. PC+s.p.r.l.*, FA 190461 (Forum Dec. 2, 2003) (finding no reverse domain name hijacking where complainant prevailed on the “identical/confusingly similar” prong of the Policy); *see also Securian Financial Group, Inc.*

v. me s / enom, FA1595614 (FORUM Jan. 16, 2015) (denying request for reverse domain name hijacking where Complainant satisfied all elements of Policy paragraph 4(a)).

8. Decision

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the domain name <**kangbaolai.com**> be **TRANSFERRED** from the Respondent to the Complainant.



Ho Hyun Nahm, Esq.
Panelist

Dated: June 21, 2021

결 정 문

사건번호: KR-2100232

신 청 인: 에스케이텔레콤 주식회사

(대리인 : 특허법인 성암)

피신청인: 맹상영

분쟁 도메인이름 : **sktcloud.com**

1. 당사자 및 분쟁 도메인이름

신 청 인: 에스케이텔레콤 주식회사

서울특별시 중구 을지로65 (을지로 2가)

대리인 : 특허법인 성암

서울특별시 강남구 역삼로114 (역삼동, 현죽빌딩 9층)

피신청인: 맹상영

경기 성남시 분당구 대왕판교로644번길 86, 4층

분쟁 도메인이름은 "sktcloud.com"이며, 피신청인에 의해 주식회사 (주)닷네임코리아(경기도 성남시 분당구 대왕판교로 660, B동 4층(삼평동))에 등록되어 있다.

2. 절차의 경과

신청인은 2021. 9. 2. 아시아도메인이름분쟁조정센터(ADNDRC) 서울사무소(이하 '센터'라고 함) 에 분쟁 도메인이름의 이전을 구하는 신청서를 제출하였다.

2021. 9. 7. 센터는 등록기관에게 등록인의 정보를 요청하는 전자우편을 발송하였고, 등록기관은 2021. 9. 7. 센터에 등록인의 확인 등 세부사항을 확인해주었다.

2021. 9. 7. 센터는 분쟁해결신청서 및 관련서류를 전자우편을 통하여 피신청인에게 발송하면서 답변서를 제출할 수 있는 마감기일이 2021. 9. 27.임을 통지하였다. 또한 같은 날 등기우편을 통하여 절차개시 통지 및 신청서 등 서류를 전자우편으로 발송하였음을 통지하였다.

피신청인은 의견서 제출 기일 연장을 두 차례(1차:2021. 10. 6., 2차:2021. 10. 20.) 요청하였고, 2021. 11. 4. 피신청인은 답변서를 제출하였다.

2021. 10. 5. 센터는 보충규칙에 따라 이덕재 위원을 행정패널로 선임요청 하였고, 2021. 10. 5. 행정패널로서의 승낙 및 중립성과 독립성의 선언을 확인 받아 2021. 10. 6. 행정패널을 구성하였다.

3. 사실관계

4. 당사자들의 주장

A. 신청인

신청인의 주장을 요약하면 아래와 같다.

- 1) 신청인은 1984년 설립된 한국이동통신서비스(주)가 1994년 선경그

- 룹(현 SK그룹)에 인수된 후 1997년에 현재의 상호로 변경한 법인이다.
- 2) 신청인의 모회사인 "에스케이 주식회사"는 2003. 7. 15. 대한민국특허청에 "SK Telecom"을 제38류 컴퓨터통신업 등을 지정상품으로 하여 상표등록을 하였고, 2011년부터 "00000"를 제38류, 제7류, 제9류 등 다수의 상품류에 상표등록을 하였다.
 - 3) 신청인은 위 상표권자의 허락을 받아 등록상표를 사용하고 있으며, 1997년부터 "SK텔레콤", "SK Telecom" 및 "SKT"를 상호 또는 상호의 약칭으로 널리 사용해왔다(이하에서 상표권자인 "에스케이 주식회사"와 사용권자인 신청인을 합하여 "신청인측"이라 한다).
 - 4) 신청인측은 2019부터 "SKT"를 제9류, 제12류, 제28류, 제38류 등의 상품류에 상표등록을 하고 사용해 왔다.
 - 5) 이 건 도메인이름은 신청인의 상호의 약칭이자 신청인측 등록상표인 "SKT"와 혼동을 야기할 정도로 유사하다.
 - 6) 피신청인은 이 건 도메인이름을 주소로 하는 웹사이트에 "엔클라우드24 URL 단축 서비스"를 제공한다고 소개하면서, "엔클라우드24는 가장 오래된 클라우드 매니지드 서비스 사업자로 KT Cloud, 아마존 AWS, Naver Cloud Platform, 알리클라우드 등 멀티 클라우드를 지향하며, 고객의 니드에 맞는 클라우드를 제공합니다."라고 설명하고 있다(참고자료 32).
 - 7) 신청인은 2009년 국내 최초로 "클라우드 컴퓨팅 플랫폼"을 구축하였고, 신청인측의 상표등록 제40-1486319호(표장: SKT, 등록일: 2019. 6. 5.)의 지정상품에는 "소프트웨어 등"이, 제40-1394560호(표장: SKT, 등록일: 2018. 9. 5.)의 지정상품에는 "클라우드컴퓨팅업, 서비스형 플랫폼 제공업, 서비스형 소프트웨어업 등"이 포함되어 있다. 피신청인이 이 건 도메인이름의 웹사이트에서 제공하는 클라우드 서비스는 위 신청인측이 상표등록한 서비스와 동일 또는 유사하다.
 - 8) 피신청인은 신청인측과 무관한 제3자이며 이 건 도메인이름의 등록

에 대한 권리 또는 정당한 이익을 가지고 있지 아니한다.

9) 따라서 피신청인은 이 건 도메인이름을 부당한 목적으로 등록하여 사용하고 있다.

B. 피신청인

피신청인의 주장을 요약하면 아래와 같다.

- 1) 이 건 도메인이름 등록일 이전에 신청인측은 제38류 컴퓨터통신업, 핸드폰통신업 등 통신업 분야에만 상표등록을 하였을 뿐 클라우드서비스 분야에는 등록하지 않았다.
- 2) 신청인측에서 2009년에 구축하였다는 클라우드 컴퓨팅 플랫폼은 한국 IBM의 서비스를 대행한 것이며 활발하게 서비스를 제공하지도 않았다.
- 3) 신청인측은 “SKT클라우드” 서비스를 일관성있게 제공하지 않았다.
- 4) 10여년 동안 피신청인이 관리해 온 이 건 도메인이름을 아무런 관리비용도 지불하지 않고 조정절차에 의하여 이전받는 것은 강제약탈이며 대기업의 횡포이다.
- 5) 신청인측은 현재 클라우드 서비스를 하지 않고 있는 반면 피신청인은 신청인측 그룹의 계열사인 “SK C&C”에서 제공하는 CLOUD Z의 협력사로서 클라우드 서비스를 제공하고 있다.
- 6) 따라서 피신청인은 이 사건 도메인이름을 부정한 목적으로 등록 및 사용하는 것이 아니다.

5. 검토 및 판단

규정 제4조 (a)항에 따르면 신청인은 자신의 주장을 관철시키기 위하여 다음과 같은 요건을 모두 입증해야 한다.

- (i) 신청인이 권리를 갖고 있는 상표 또는 서비스표와 등록인의 도메인이름이 동일하거나 혼동을 일으킬 정도로 유사하다는 것,
- (ii) 등록인이 그 도메인이름의 등록에 대한 권리 또는 정당한 이익을 가지고 있지 아니하다는 것, 그리고
- (iii) 등록인의 도메인이름이 부정한 목적으로 등록 및 사용되고 있다는 것.

따라서 상기의 사항과 관련하여 당사자가 주장하는 논점을 판단하면 다음과 같다.

A. 상표·서비스표와 본 건 분쟁 도메인이름의 유사.

이 건 도메인이름에서 “.com”을 제외한 “sktcloud”는 신청인측의 등록상표 및 상호의 약칭인 “skt”와 “데이터를 인터넷과 연결된 중앙컴퓨터에 저장해서 인터넷과 접속하기만 하면 언제 어디서든 그 데이터를 이용할 수 있는 기술”을 뜻하는 “cloud”를 결합한 것임을 쉽게 알 수 있다. 따라서 “cloud”는 식별력이 없고 식별력 있는 요부에 해당하는 “skt”가 신청인측 등록상표인 “SK Telecom”, “0000000” 및 “SKT”와 동일하거나 유사하며, 신청인의 상호의 약칭인 “SKT”와 동일하다. 그러므로 이 건 도메인이름은 신청인측의 등록상표 및 상호의 약칭과 유사하다.

B. 피신청인의 권리 또는 정당한 이익.

피신청인은 피신청인이 신청인측과 아무런 관련이 없다는 신청인의 주장에 대해서 아무런 답변을 하지 않고 있으며, 피신청인이 “skt” 또는 “sktcloud”에 대하여 권리 또는 정당한 이익을 가지고 있다고 볼만 한 근거는 찾을 수 없다.

피신청인이 신청인측 그룹의 계열사인 “SK C&C”에서 제공하는

CLOUD Z의 협력사로서 클라우드 서비스를 제공하고 있다 하더라도 “sktcloud”에 대하여 권리 또는 정당한 이익을 가지고 있다고 볼 수는 없다. 따라서 피신청인이 이 사건 도메인이름을 등록 또는 보유할 권리 또는 정당한 이익은 없다고 판단한다.

C. 피신청인의 부정한 목적

이 사건에 제출된 자료에 의하면 이 건 도메인이름의 등록 이전에 “SKT”는 신청인의 상호의 약칭으로 널리 알려져 있었음이 인정된다. 그리고 이 건 도메인이름의 등록 이전에 신청인측이 등록한 상표 “SK Telecom”과 이 건 도메인이름은 유사하며, 이 건 도메인이름 등록 이후에 신청인측이 등록한 상표 “00000” 및 “SKT”와 이 건 도메인이름도 유사하다.

피신청인이 이와 같이 신청인측의 상표 또는 상호의 약칭과 유사한 이 건 도메인이름을 주소로 하는 웹사이트에서 신청인이 영위하는 사업과 밀접한 관련이 있는 사업분야인 “URL 단축서비스, 클라우드 매지저드 서비스” 등을 제공하고, 위 웹사이트에서 신청인과 경쟁관계에 있는 회사의 클라우드 서비스도 제공하고 있다고 설명하고 있는 바, 이는 신청인측의 상표 또는 상호의 약칭과 유사한 도메인이름을 선점하여 신청인측의 명성에 편승하고자 하는 목적 또는 신청인의 사업을 방해할 목적으로 등록하여 사용하고 있는 것으로 판단한다.

피신청인이 주장하는 바와 같이, 1) 이 건 도메인이름 등록 이전에 신청인측이 등록한 상표의 지정상품에 클라우드 서비스가 포함되어 있지 않은 점, 2) 신청인측에서 2009년에 구축하였다는 클라우드 컴퓨팅 플랫폼은 한국 IBM의 서비스를 대행한 것이며 활발하게

서비스를 제공하지도 않은 점, 3) 신청인측이 “SKT클라우드” 서비스를 일관성있게 제공하지 않은 점, 4) 이 건 도메인이름이 등록된지 10여년이 지난 지금까지 신청인 측에서 아무런 문제제기를 하지 않은 점, 4) 신청인측은 현재 클라우드 서비스를 하지 않고 있는 반면 피신청인은 신청인측 그룹의 계열사인 “SK C&C”에서 제공하는 CLOUD Z의 협력사로서 클라우드 서비스를 제공하고 있는 점 등을 모두 사실로 인정하더라도, 이 건 도메인이름이 그 등록 이전에 널리 알려진 신청인의 상호의 약칭 및 신청인측의 등록상표와 유사하고 이 건 도메인이름의 웹사이트에서 피신청인이 제공하는 서비스가 신청인측이 제공하는 서비스와 밀접한 관련이 있는 이상, 피신청인이 이 건 도메인이름을 선점하여 신청인의 명성에 편승하고자 하는 목적 또는 신청인의 사업을 방해할 목적으로 등록하여 사용하고 있음을 인정하는데 장애가 되기에는 부족하다.

6. 결정

위와 같이 검토한 결과, 본 행정패널은 ‘규정’ 제4조 (a)항 및 ‘절차규칙’ 제15조에 의하여, 신청인의 신청에 따라 피신청인에 대하여 분쟁도메인이름인 <sktcloud.com>을 이전 할 것을 결정한다.



1인 행정패널

이덕재

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For enquiries related to ADNDRC panelist empanelment, events, or other general matters, please contact the ADNDRC Secretariat at secretariat@adndrc.org.

38/F, Two Exchange Square, 8 Connaught Place, Central, Hong Kong

 (852) 2525-2381  (852) 2524-2171

 hkiac@adndrc.org

<https://www.adndrc.org/>