



## **WIPO Arbitration and Mediation Center**

### **ADMINISTRATIVE PANEL DECISION**

#### **Kabushiki Kaisha Mainichi Shimbunsha v. Pilyun Kim**

**Case No. D2001-0307**

#### **1. The Parties**

The Complainant is Kabushiki Kaisha Mainichi Shimbunsha (its English name: The Mainichi Newspapers), a company incorporated under the laws of Japan, with its principal place of business at 1-1, Hitotsubashi 1-chome, Chiyoda-ku Tokyo, 100-8051, Japan.

The Respondent is a physical person Pilyun Kim with his contacting address at Punghodongwoosung Apt 116-103 Jinhae, Kyungnam 645-320, Korea.

#### **2. The Domain Name and Registrar**

The domain name in dispute is [[毎日新聞.com](http://毎日新聞.com)] (BQ—3BV44ZPFMWYIAXQ.COM)], which is registered with the registrar Alldomains.com of 2261 Morello Ave Suite C Pleasant Hill, CA 94523, USA.

#### **3. Procedural History**

The Center received the Complaint of the Complainant on March 2 and 6, 2001 by email and in hard copy respectively.

On March 7, 2001, the Center sent to the Complainant the acknowledgement of receipt of the Complaint.

The Center sent to the Registrar a request for verification of registration on March 20, 2001. On April 17, 2001, the Registrar confirmed that the domain name in dispute is registered with Alldomains.com and the Respondent is the current registrant of the domain name. The current status of the disputed domain name is on hold awaiting response from Mainichi to expedite the transfer of the ownership.

On April 8, 2001, the Center received the communication from the Respondent.

The Center completed the formal Requirements Compliance Checklist on April 17, 2001.

On April 18, 2001, the Center received the communication from the Respondent and made the reply accordingly at the same day.

On April 20, 2001, the Center sent to the Respondent the Notification of Complaint and Commencement of the Administrative Proceeding. This notification was sent by the methods required under paragraph 2(a) of the Rules. The formal date of the commencement of this administrative proceeding is April 20, 2001.

The Center received the Response submitted by the Respondent by e-mail on May 9, 2001 and in hard copy on May 14 and 21, 2001.

On May 9 and 10, 2001, the Center sent to the Respondent the acknowledgement of receipt of the Response.

On May 22, 2001, after receiving a completed and signed Statement of Acceptance and Declaration of Impartiality and Independence, the Center notified the parties of the appointment of a single-member panel consisting of Mr. Li Yong.

#### **4. Factual Background**

The Complainant is a Japanese newspaper publishing company established in 1872, with its principal office in Tokyo and other main offices and branch offices in other cities of Japan as well as some foreign correspondents in some cities throughout the world.

The Complainant owns trademark rights over the logotype “毎日新聞” in Japan. The current version of the Complainant’s logotypes “毎日新聞” that appeared on the Complainant’s newspapers were registered with Japanese Patent Office as Complainant’s trademarks on June 29, 1994 and on November 30, 1994, of which trademark registrations expire on June 29, 2004 and on November 30, 2004 respectively. The trademarks above-mentioned are in class 26 of the classifications of goods and services under Japanese Trademark Law 1959, which included “newspapers” and “printed matters”.

The registered trademark of “毎日新聞” consists of four Chinese characters, which means “daily newspaper”.

The domain name [<毎日新聞.com> (BQ—3BV44ZPFMWYIAXQ.COM)] was created on November 9, 2000, according to the search result made by the complainant shown in the Annex 1 of the Complaint.

#### **5. Parties’ Contentions**

The Complainant’s contentions are as follows:

- (1) The Complainant publishes and circulates “毎日新聞” (“Mainichi Shimbun”) daily newspaper and uses its trademark “毎日新聞” as a logotype on its newspaper that is well known among readers as well as its trademark. Thus, the “Mainichi Shimbun” is appreciated as one of the three major daily newspapers with a national circulation throughout Japan together with “Asahi Shimbun (朝日新聞)” and “Yomiuri

Shimbun (読売新聞)”. The names of these three newspapers are also famous among Korean people who are familiar with Japan. In Korea, not only Hangul alphabets as their own letters, but also Chinese characters are used among Korean people. Therefore, it is not incomprehensible that a Korean who is familiar with the names of Japanese newspapers plots to prevent Japanese newspaper publishing companies from registering corresponding domain names that reflect each company’s trademark.

- (2) The Complainant plans to acquire the multilingual domain name <毎日新聞.com> in Kanji characters to reflect its registered trademark “毎日新聞” in a corresponding domain name. The Complainant unfortunately failed to acquire the registration of the planned domain name <毎日新聞.com>, though it applied for the domain name on the first day when it became available in Japan. The Complainant’s investigation thereafter revealed that the identical domain name with what the Complainant planned to acquire had registered somehow by the Respondent on November 9, 2000.

Moreover, the Complainant confirmed that the Respondent also registered <朝日新聞.com>, <読売新聞.com> as well as <産経新聞.com>, all of which reflect the trademarks of “朝日新聞 (Asahi Shimbun)” and “読売新聞 (Yomiuri Shimbun),” the two of the three major newspaper publishing companies as well as another well-known newspaper publishing company in Japan “産経新聞 (Sankei Shimbun)” on the same date of his/her registration of the disputed domain name through the same Registrar who handled the registration of the disputed domain name. The Complainant believes that the Respondent has intentionally acquired his registrations of the above domain names, including the disputed domain name, which are correspondent to trademarks of Japanese major newspaper publishing companies so that the Respondent can prevent these companies from registering corresponding domain names that reflect each company’s trademark.

- (3) The Complainant believes that, the disputed domain name that is registered by the Respondent is identical or confusingly similar to registered trademarks in which the Complainant has rights. The Respondent should be considered as having no rights or legitimate interests in respect of the domain name that is subject of the Complaint, because the Respondent resides in Korea where the Complainant has never licensed anybody to use the Complainant’s registered trademark. Furthermore, the disputed domain name should be considered as having been registered in bad faith in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, because (i) the Respondent acquired his registration of the disputed domain name from outside of the country where the Complainant is mainly doing business, before it became available by a duly and legitimate procedure in the same country, and (ii) the Respondent acquired three other registrations of domain names that were correspondent to trademarks of three other business entities of the same industry of the Complainant simultaneously through the same Registrar with the registration of the disputed domain name.

The Respondent’s contentions are as follows:

- (1) The Complainant does not have any legal right for the domain in question. The Chinese word “毎日新聞” is pronounced maeilshinmun in Korean and it is a combination of very widely used generic words. Maeil (毎日) means daily and

shinmun means news or newspapers. Therefore, the Chinese word is translated daily news or daily newspaper in English. The complainant does not have any of the trademarks of Daily, DailyNews and DailyNewsPapers in English and also has no claim to the exclusive right of the Chinese Domain (每日新聞.com) translated into DailyNews in English. Almost all of the newspapers in Asia use one of these Chinese characters, maeil (每日), maeilshinmun (每日新聞) or ilbo (日報) which are synonyms in Chinese and means daily news or daily newspaper. The maeilshinmun (每日新聞) is most widely used. Therefore, maeilshinmun in Chinese is a very widely used, generic word for every newspaper in Korea, China, Japan and so on. The complainant is well aware of this fact and is only trying to take control of this domain for the sole purpose of restricting the business of smaller newspaper corporations. On the other hand, there are many maeilshinmun (Daily newspaper) in Korea and in fact one of them has the trademark in Korean. Also there are many daily newspapers all across China, such as a famous China-daily-news who might have the trademark. Therefore, it is not acceptable that a local Japanese company should have the only exclusive right for this kind of a generic domain.

- (2) The Complainant's trademark is only a local one, which legally can be applied in Japan and not outside. In fact the Complainant only has "mainichi" as a USA federal trademark but it does not have "mainichishimbun" as a USA federal trademark. It is widely recognized that USA federal trademark is widely and officially recognized as a world trademark. And also ".com" is commonly used only for worldwide companies or individuals.
- (3) The official name of the complainant is Kabushiki Kaisha Mainichi Shimbunsha. The domain in question is not identical or even similar to their company name. Although a company can have many trademarks to protect their business, or to prevent their competitors from using those names or marks, in this case, the Complainant couldn't insist that they have the legal right of all the identical or similar domains. This case should be considered as an attempt to act in bad faith or further, a legal attempt at domain hijacking. The complainant only use the name "mainichi" for international business with its trademark, not mainichishimbunsha in Chinese, referring to their site [www.mainichi.co.jp/english](http://www.mainichi.co.jp/english).
- (4) The Complainant's trademark is not identical to the domain. Different from the English character, Chinese character has a meaning of itself but an English character does not have any meaning of itself. As such, each Chinese character can be used as a word. Therefore each character can be used for various purposes such as the names of people, businesses, companies, identification and so on. In order to combat the confusion, a system of seals was created. Within this system, only one seal, where the characters are carved on wood or other hard material, could exist. The owner of the seal is able to identify himself from others by stamping the seal on the document when he needs to identify himself to someone. In this case, the stamped mark is 100% the same as on the document, because there are many people using same Chinese characters in Chinese influenced area such as China, Korea, Japan and so on. Every Korean and company has at least one or more seal in Chinese to identify himself/herself because there are so many of the same names. Therefore, the complaint should be aware that they do not have any rational background for their insistence that their seal type trademark is identical to the generic words "maeilshinmun" (每日新聞) in Chinese.

- (5) The purpose of a domain is to be used as a IP address for an Internet web site , but the complainant does not own and use any of mainichi.com/net/org, any of mainichishimbun.com/net/org, any of mainichishimbunsha.com/net/org, any of dailynews.com/net/org and any of dailynewspaper.com/net/org as its official domain website. 毎日新聞 (bq—3bv44zpfmwyiaxq).cc, tv and ws are available to register now. The Complainant has no reason to make claim on the disputed domain name. There are many “毎日新聞” in Japan such as “信濃毎日新聞”, “宮古毎日新聞”, “八重山毎日新聞”, “八重山毎日新聞社”and so on. It is impossible that they all infringe the trademark of the Complainant. This shows that the complainant should not have any exclusive right for the domain <毎日新聞.com> because it is widely used across the world and even in Japan by several news paper cooperation. This generic domain at hand will not bring any loss of business activity to them. The Respondent also should suppose that the Complainant will not use this domain as their official domain for their site because it is widely known that most of Japanese companies use their own countries domain (.co.jp) and also they are able to obtain and use the multilingual-Japanese domain.co.jp.

With these proofs uncovered and known to all, the complainant obviously has no right to insist that they have any right for this domain and their plot to snatch this generic domain from a weaker party should be dismissed.

- (6) The registration by the Respondent of other Chinese domain names does not show the Respondent’s bad faith, because there are hundreds of initials and different meanings in each Chinese character and also each Chinese character has its own meaning. Therefore, there are many same names used for different purposes in Chinese culturally influenced areas. The Respondent plans to use his domain names for promoting the public interest activities. The Respondent has not been able to use this domain for the planned website because ITEF has not yet approved the multilingual domains to be an official family member of gTDLs. And therefore, anyone who has any multilingual domains can not use any multilingual domains for a website yet.

## 6. Discussion and Findings

In accordance with the Policy, the Complainant asking for transfer of the domain name must prove the following three elements: 1) Respondent's domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; 2) Respondent has no rights or legitimate interests in the domain name; and 3) Respondent has registered the domain name and is using it in bad faith. (ICANN Policy, 4 (a)).

### Identical or Confusingly Similar

The domain name at issue is [<毎日新聞.com> (BQ—3BV44ZPFMWYIAXQ.COM)]. The Panel finds that the characters of this domain name “毎日新聞” is completely identical with the registered trademarks held by the Complainant in Japan. The top level domain designator ".com" is only a necessary portion to form a business-related domain name and cannot function to distinguish that name from the Complainant’s trademarks. When deciding whether the disputed domain name is identical or confusingly similar to a

trademark, the key point is to compare the second level of the disputed domain name with the substantial part of the trademark. The panel has noticed the Respondent's contention that the Complainant's trademark is only a local one, which legally can be applied in Japan and not outside. The panel does not support this contention based on the following reasons: firstly, ICANN Policy does not require any complainants to own "international trademark right" or trademark right of any particular country in order for them to make claims; and secondly, the disputed domain name <毎日新聞.com> is a multilingual domain name, it can be regarded as a Chinese domain name and a Japanese domain name as well because Chinese characters in traditional form are frequently used in Japan. Keeping the above in mind, the Panel believes that the first element of the ICANN Policy, 4(a) is met.

### **Respondent's Rights or Legitimate Interests in the Domain Name**

The Respondent has not provided evidence of circumstances of the type specified in the ICANN Policy, 4(c). There exists no evidence that the Respondent, before receipt any notice of the dispute, has used the domain name or a name corresponding to the domain name in connection with bona fide; or that the Respondent has been commonly known by the domain name; or that the Respondent is making a legitimate noncommercial or fair use of the domain name. Furthermore, the Respondent has not provided evidence of any other circumstances giving rise to a right or legitimate interest in the disputed domain name, though he said he planned to use the disputed domain name to promote the public interest activities. On the other hand, the Complainant clearly declared that he has never licensed anybody to use his registered trademarks. As such, the Panel believes that the Respondent has no rights or legitimate interests with respect to the disputed domain name.

### **Domain Name Registered and Used in Bad Faith**

Paragraph 4(b) of the ICANN Policy specifies four types of circumstances that could be evidence of the registration and use of a domain name in bad faith. According to the ICANN Policy, circumstances of bad faith are not limited to the listed ones.

The Panel finds that the domain name was registered and used in bad faith based upon the following reasons:

The Complainant has trademark registrations for the Chinese words "毎日新聞" in Japan and has begun to use the trademarks in Japan before the creation of the disputed domain name. "毎日新聞" (Mainichi Shimbun), together with "朝日新聞" (Asahi Shimbun) and "読売新聞" (Yomiuri Shimbun), are appreciated as the three major daily newspapers with a national circulation throughout Japan. These three newspapers, to some extent, are also famous in many foreign countries, especially in the Japan's neighboring countries or regions. Besides the domain name at issue, the Respondent also registered simultaneously <朝日新聞.com>, <読売新聞.com> as well as <産経新聞.com>, all of which are the three famous newspaper publishing companies in Japan. The Panel infers from the Respondent's behavior that, when making the registration applications, the Respondent clearly knew that "毎日新聞" was one of the major Japanese newspapers. The Chinese character of the disputed domain name is identical to the trademarks "毎日新聞" owned by the Complainant. By common knowledge, using the Chinese wording "毎日新聞" as the second level of a domain name can be a very direct, exact and preferred way to reflect the Complainant's identity, functions and services offered by the Complainant. In absence of proof that the Respondent possesses the rights or other legitimate interests in the domain

name in dispute, the Panel believes that the Respondent's conduct of acquiring and holding the domain name [<每日新聞.com> (BQ—3BV44ZPFMWYIAXQ.COM)] has prevented the Complainant from reflecting its trademark in a corresponding Chinese domain name. In addition, the situation that names for four famous Japanese newspapers were registered as multilingual domain names by the same Respondent is regarded by the Panel as a fact of bad faith.

For the reasons above, the Panel finds that the Respondent's registration and use of the domain name at issue is in bad faith.

## 7. Decision

The Panel concludes (a) that the domain name [<每日新聞.com> (BQ—3BV44ZPFMWYIAXQ.COM)] is identical to the trademarks owned by the Complainant, (b) that the Respondent has no rights or legitimate interest in the domain name and (c) that the Respondent has registered and used the domain name in bad faith. Therefore, the Panel orders that the domain name [<每日新聞.com> (BQ—3BV44ZPFMWYIAXQ.COM)] be transferred to the Complainant.

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Li Yong  
Sole Panelist

Dated: June 5, 2001