

ADMINISTRATIVE PANEL DECISION

Compagnie Générale des Etablissements Michelin v. hong xiao, xiaohong
Case No. D2023-3202

1. The Parties

The Complainant is Compagnie Générale des Etablissements Michelin, France, represented by Dreyfus & associés, France.

The Respondent is hong xiao, xiaohong, China.

2. The Domain Name and Registrar

The disputed domain name <michelinewipers.com> is registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on July 25, 2023. On July 25, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 26, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Whois Privacy Protection Service by onamae.com) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 26, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint in English on July 27, 2023.

On July 26, 2023, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. On July 27, 2023, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent in English and Japanese of the Complaint, and the proceedings commenced on August 4, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 24, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 25, 2023.

The Center appointed Keiji Kondo as the sole panelist in this matter on September 8, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant, Compagnie Générale des Etablissements Michelin, is a leading tire company. Headquartered in Clermont-Ferrand, France, the Complainant is present in 171 countries, including Japan, and has more than 114,000 employees and operates 69 tire manufacturing facilities and sales agencies in 17 countries (Annex 3 to the Complaint).

The tire sales business in Japan began in 1964. The first step for the Complainant in Japan is the adoption of Michelin steel radial "X" tires on the new monorail between Hamamatsucho and Haneda Airport. The Complainant established Nihon Michelin Tire Co., Ltd. in 1975 and has steadily increased its presence in the Japanese market. In 1991, Michelin Research Asia was established as an R&D center for research, development and testing of tires for the Japanese and Asian markets (Annex 3 to the Complaint).

In November 2007, the Complainant published "Michelin Guide Tokyo 2008", the first Michelin Guide in Asia. Today, the Michelin Guide Tokyo has been updated and the guide has now reached its 13th edition (Annex 3 to the Complaint).

The Complainant is continuing to develop its operations and expand its presence in Japan and the Asia Pacific region, notably through its research and development programs in Ota, its sales operations throughout the country and its activities at Nihon Michelin Tire Co Ltd. headquarters in Tokyo.

The Complainant is the owner of the following trademark registrations (Annex 4 to the Complaint):

- Japanese trademark MICHELIN No. 5620241, dated October 4, 2013, covering goods and services in classes 9, 35, 37, 38, 39, 41, 42, and 43;
- China trademark MICHELIN No. 15961294, dated March 7, 2016 and covering services in class 42;
- International trademark MICHELIN No. 1245891, dated on December 10, 2014, designating *inter alia* Australia, Japan, the Russian Federation, covering services in classes 35, 36, 39, 40, 41, 42, 44, and 45; and
- International MICHELIN Trademark No. 771031, dated June 11, 2001, duly renewed and covering goods and services in classes 5, 7, 8, 9, 10, 11, 12, 16, 17, 18, 20, 21, 24, 25, 39, and 42, and designating among others China, Romania, the Russian Federation, Spain, the United Kingdom, and Viet Nam.

The disputed domain name <michelinewipers.com> was registered on May 20, 2023. The disputed domain name resolved to a webpage in Chinese relating to adult content with gambling links at the time of filing of the Complaint (Annex 1 to the Complaint). The disputed domain name is currently inactive.

5. Parties' Contentions

A. Complainant

The disputed domain name is virtually identical, or at least confusingly similar to the Complainant's trademark MICHELIN. The disputed domain name incorporates the Complainant's trademark MICHELIN in its entirety.

In many UDRP decisions, it is well established that “Where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark”. The full inclusion of a confusingly similar approximation of the Complainant’s MICHELIN trademark enhances the false impression that the disputed domain name is somehow officially related to the Complainant and does not dispel any likelihood of confusion. In fact, the unsuspecting Internet users could assume that the website is related to the Complainant and its various fields of activity, only to find oneself on a page containing adult content, which defames and damages the Complainant’s image and infringes its prior rights.

Finally, the generic Top-Level Domain (“gTLD”) extension “.com” is not to be taken into consideration when examining the identity or similarity between the Complainant’s trademark and the disputed domain name, as it is viewed as a standard registration requirement. Indeed, the mere adjunction of a gTLD such as “.com” is irrelevant as it is well established that the gTLD is insufficient to avoid a finding of confusing similarity.

Accordingly, by registering the disputed domain name, the Respondent created a likelihood of confusion with the Complainant’s trademark. It is likely that the disputed domain name could mislead Internet users into thinking that it is, in some ways, associated with the Complainant and its activities.

For all of the above-mentioned reasons, the disputed domain name is confusingly similar to the Complainant’s trademark.

Therefore, the condition of paragraph 4(a)(i) of the Policy is fulfilled.

The Respondent is neither affiliated with the Complainant in any way nor has been authorized by the Complainant to use and register its trademark, or to seek registration of any domain name incorporating the said trademark. Furthermore, the Respondent cannot claim prior rights or legitimate interest in the disputed domain name as the Complainant’s trademark precedes the registration of the disputed domain name for years (Annexes 1 and 4 to the Complaint).

The Respondent is not commonly known by the disputed domain name or the Complainant’s trademark or its trade name. There is no evidence that the Respondent may be commonly known by the name “Michelin”.

Moreover, the Respondent cannot assert that, before any notice of this dispute, it was using, or had made demonstrable preparations to use, the domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services, in accordance with paragraph 4(c)(i) of the Policy. Even more so considering the fact that the disputed domain name resolves to a page that is extremely prejudicial to the Complainant’s renown. As mentioned, the disputed domain name, which incorporates the Complainant’s trademark, resolves to a webpage in Chinese relating to adult content. This cannot be considered as the use of the disputed domain name in connection with a *bona fide* offering of goods and services. Consequently, the Respondent fails to show any intention of noncommercial or fair use of the disputed domain name.

For all of the above-cited reasons, it is undoubtedly established that the Respondent has no rights or legitimate interests in respect to paragraph 4(a)(ii) of the Policy.

The Respondent “knew or should have known” of the Complainant’s trademark rights and, nevertheless registered the disputed domain name. It is implausible that the Respondent was unaware of the Complainant when it registered the disputed domain name.

Firstly, the Complainant is well known throughout the world, including Japan where its manufacturing facilities are located (Annex 3 to the Complaint). In this regard, many UDRP panels have previously acknowledged the Complainant’s reputation worldwide, making it unlikely that the Respondent was not aware of the Complainant’s rights in its trademark MICHELIN.

Secondly, the composition of the disputed domain name, which incorporates the Complainant's trademark entirely, confirms that the Respondent was aware of the Complainant and its trademark and that it registered the disputed domain name based on the attractiveness of the Complainant's trademark. Prior UDRP panels have held that bad faith can be found where a domain name is so obviously connected with a well-known trademark that its very use by someone with no connection to the trademark suggests opportunistic bad faith. Given the reputation of the Complainant's trademark, registration in bad faith can be inferred.

Thirdly, the Complainant's trademark registrations significantly predate the registration date of the disputed domain name. In this regard, previous UDRP panels have established that the knowledge of the Complainant's intellectual property rights, including trademarks, at the time of registration of the disputed domain name proves bad faith registration. A quick "MICHELIN" trademark search would have revealed to the Respondent the existence of the Complainant and its trademark. The Respondent's failure to do so is a contributory factor to its bad faith.

The Complainant submits that given the Complainant's goodwill and renown, and the nature of the disputed domain name, the Respondent could simply not have chosen the disputed domain name for any reason other than to deliberately cause confusion amongst Internet users as to its source in order to take unfair advantage of the Complainant's goodwill and reputation, which clearly constitutes bad faith.

Hence, in view of the above-mentioned circumstances, it is inconceivable that the Respondents did not have the Complainant's trademark in mind at the time of registration of the disputed domain name.

Consequently, it is established that the Respondent registered the disputed domain name in bad faith.

Some elements may be put forward to support the finding that the Respondent also uses the disputed domain name in bad faith. It is submitted that the Respondent is using the disputed domain name to intentionally attract Internet users to his website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of the services offered on the Respondent's website, in accordance with paragraph 4(b)(iv) of the Policy.

Previous UDRP panels have considered that in the absence of any license or permission from the Complainant to use such widely known trademark, no actual or contemplated *bona fide* or legitimate use of the disputed domain name could reasonably be claimed. Neither can the Respondent assert that he has made, or that he is currently making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain and in order to misleadingly divert consumers, or to tarnish the trademark at issue, in accordance with paragraph 4(c)(iii) of the Policy.

On the contrary, the direction of the disputed domain name towards a Chinese webpage relating to adult content evidences an intent to misleadingly divert consumers by taking unfair advantage of the goodwill and reputation of the Complainant's trademark. There is little doubt in this case that, at all times, the Respondent was not aware that the MICHELIN trademark enjoyed a substantial reputation worldwide. The Respondent has used the disputed domain name to direct Internet users and generate more traffic on a Chinese pornographic website. This situation is extremely prejudicial to the Complainant and this website constitutes a serious infringement of its rights. Indeed, the disputed domain name is confusingly similar to the Complainant's trademark and previous UDRP panels have ruled that "a likelihood of confusion is presumed, and such confusion will inevitably result in the diversion of Internet traffic from Complainant's site to Respondent's site".

The clear inference to be drawn from the Respondent's operations is that he is trying to benefit from the fame of the Complainant's trademark. It is more likely than not that the Respondent's primary motive in registering and using the disputed domain name was to capitalize on or otherwise take advantage of the Complainant's trademark rights, through the creation of initial interest of confusion.

Furthermore, the Respondent registered the disputed domain name through a privacy shield service to hide his identity and contact details, thus, preventing the Complainant from contacting him. Prior UDRP panels confirmed that a deliberate concealment of identity and contact information may in itself indicate registration in bad faith.

Finally, given the Complainant's goodwill and renown worldwide, and the nature of the disputed domain name, which is confusingly similar to the Complainant's trademark, it is not possible to conceive a plausible circumstance in which the Respondent could legitimately use the disputed domain name, as it would inevitably result in misleading diversion and taking unfair advantage of the Complainant's rights.

All the aforementioned circumstances confirm that the disputed domain name is being used in bad faith.

Consequently, it is established that the Respondent has both registered and used the disputed domain name in bad faith in accordance with paragraph 4(a)(iii) of the Policy.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

6.1. Preliminary Issue: Language of the Proceeding

The Complaint was filed in English, while the language of the Registration Agreement is Japanese. In the Complaint, the Complainant requests that English be the language of the proceeding, soliciting the Panel to exercise the authority under paragraph 11(a) of the Rules to determine the language of the proceeding.

On July 26, 2023, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. On July 27, 2023, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

Considering the following circumstances, the Panel, exercising its authority to determine the language of the proceeding under paragraph 11(a) of the Rules, has decided English as the language of the proceeding:

- the Complaint was filed in English;
- the Complainant is a company in France, and represented by a French firm;
- the Respondent's address is in China;
- the Complainant has submitted its request that English be the language of the proceeding, but the Respondent did not comment on the language of the proceeding;
- the Respondent did not reply to the Complainant's contentions in any manner; and
- ordering the translation of the Complaint would only result in extra delay of the proceeding and additional cost for the Complainant.

6.2. Substantive Issues

A. Identical or Confusingly Similar

The first element functions primarily as a standing requirement. In this case, the disputed domain name is <michelinewipers.com>. The Complainant has many trademark registrations for the trademark MICHELIN, *inter alia*, the International trademark registration No. 771031 registered on June 11, 2001, the designated countries of which include China.

The Complainant's trademark MICHELIN is incorporated into the disputed domain name in its entirety with the addition of "e", "wipers" and the gTLD ".com". The addition of the letter "e" and the term "wipers" does not prevent a finding of confusing similarity, because the Complainant's trademark is clearly recognizable in the disputed domain name. It is well-established that the gTLD ".com" is not relevant in the appreciation of confusing similarity.

Therefore, the disputed domain name is confusingly similar to the Complainant's trademark MICHELIN.

Accordingly, paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

The Respondent's name, hong xiao, xiaohong, is in no way similar to the disputed domain name, nor is it similar to the Complainant's trademark MICHELIN. In addition, the Respondent uses a privacy shield service to hide his identity. Therefore, it is inconceivable that the Respondent has been commonly known by the disputed domain name.

At the time of filing of the Complaint, the disputed domain name resolved towards a Chinese website with adult content, as well as with links to gambling pages. Such use is not a use in connection with a *bona fide* offering of goods or services, nor is it a legitimate noncommercial or fair use.

Therefore, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Accordingly, paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

The Complainant's trademark MICHELIN is well known around the world. The Complainant's International trademark registration No. 771031 for MICHELIN was registered in 2001, well before the disputed domain name's registration of May 20, 2023. Therefore, it is inconceivable that the Respondent did not know the Complainant and its trademark when he registered the disputed domain name. It is obvious that the Respondent knew and targeted the Complainant at the time of registration of the disputed domain name.

Furthermore, the Respondent, at the time of registration of the disputed domain name, employed a privacy shield service to hide his identity. This fact, combined with the fact that the disputed domain name previously led Internet users to a website which contains adult content with gambling links, evidences that the Respondent registered the disputed domain name intentionally attempting to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. Such use constitutes bad faith under paragraph 4(b)(iv) of the Policy.

The current non-use of the disputed domain name does not change the Panel's finding of the Respondent's bad faith in light of the following facts:

- (i) the Complainant's trademark is well known;
- (ii) the Respondent did not submit a response, or to provide any evidence of actual or contemplated good-faith use;
- (iii) the Respondent concealed his identity using a privacy registration service; and
- (iv) it is implausible that the disputed domain name would be put to any good faith use.

Therefore, the Panel concludes that the disputed domain name has been registered and is being used in bad faith.

Accordingly, paragraph 4(a)(iii) of the Policy is satisfied.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <michelinewipers.com> be transferred to the Complainant.

/Keiji Kondo/

Keiji Kondo

Sole Panelist

Date: September 22, 2023