



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Kabushiki Kaisha Sangyokeizai Shimbunsha v. Jg Kim

Case No. D2001-0620

1. The Parties

The Complainant is Kabushiki Kaisha Sangyokeizai Shimbunsha (its English name: Sankei Shimbun Co., Ltd.), a company incorporated under the laws of Japan, with its principal place of business at 7-2, Otemachi 1-chome, Chiyoda-ku Tokyo, 100-8077, Japan.

The Respondent is a physical person Jg Kim with his contacting address at Yangduck2dong Hyundai Apt 401 Masan, Kyungnam 645-492, Korea.

2. The Domain Name and Registrar

The domain name in dispute is [<産経新聞.com> (bq--3b2sg7kmmwyiaxq.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 May 1 and 3, 2001, by email and in hard copy respectively, and received the Amendment to the Complaint by email and in hard copy on May 1 and June 11, 2001.

On May 2, 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 May 3 and 31, 2001. On June 1, 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 active.

On May 24, 2001, the Center received the report on non-delivery of the Compliant from Complainant.

On May 29 and 30, 2001, the Center received the communications from the Respondent and made the replies accordingly. And the Center received the communication from the Complainant and the Respondent respectively on May 31 and June 1, 2001, and made its corresponding replies.

The Center completed the formal Requirements Compliance Checklist on June 2, 2001.

On June 13, 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 June 13, 2001.

On June 20 and 21, 2001, The Center received the communications from the Respondent and made the replies accordingly.

The Center received the Response submitted by the Respondent by e-mail on July 3, 2001, and in hard copy on July 9, 2001.

On July 3, 2001, the Center sent to the Respondent the acknowledgement of receipt of the Response.

On July 3, 6 and 9, there are some communications between the Center and the Respondent.

On July 11, 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 and the projected decision date.

4. Factual Background

The Complainant is a Japanese newspaper publishing company established in 1942, with its principal office in Tokyo, the main offices in Osaka and some foreign correspondents in some cities throughout the world.

The Complainant owns trademark rights over the logotype “産経新聞” in Japan. The current version of the Complainant’s logotype “産経新聞” that appeared on the Complainant’s newspapers were registered with Japanese Patent Office as Complainant’s trademark on February 8, 1957, and on July 30, 1990, of which trademark registration expire on February 8, 2007 and on July 30, 2010 respectively. The trademark above-mentioned is in classes 66 and 26 of the classifications of goods and services under Japanese Trademark Law 1959, which included “newspaper”.

The registered trademark of “産経新聞 consists of four Chinese characters.

The domain name [<産経新聞.com> (bq--3b2sg7kmmwyiaxq.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 “産経新聞” (“Sankei Shimbun”) daily newspaper everyday for about two million readers in Japan and uses its trademark “産経新聞” as a logotype on its newspaper which is well known among readers as well as its trademark. The “産経新聞” is appreciated as one of major daily newspapers with a national circulation throughout Japan together with “Asahi Shimbun (朝日新聞),” “Yomiuri Shimbun (読売新聞),” and “Mainichi Shimbun (毎日新聞).” The names of Japanese major newspapers, especially Complainant's newspaper, are also famous in Korea, not only among the intelligentsia but also among ordinary office workers, students and housewives through Korean mass media's news reports with regard to news reports in “Sankei Shimbun”. Moreover, the Complainant associates with a Korean newspaper publishing company the Kyung Hyang Shinmun to provide news in relation to Japan. In Korea, both Hangul alphabets and Chinese characters are used among Korean people. Some educated or aged Koreans can even read Japanese documents that include Chinese characters as well as Hiragana and Katakana letters of Japanese origin. 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 <産経新聞.com> in Chinese characters to reflect its registered trademark “産経新聞” in a corresponding domain name. The Complainant unfortunately failed to acquire the registration of the planned domain name <産経新聞.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 been registered somehow by a person named Pilyun Kim who resides in Korea on November 9, 2000, before the domain name became available by a duly and legitimate procedure in Japan. Pilyun Kim also registered <朝日新聞.com>, <読売新聞.com> and <毎日新聞.com>, all of which reflect the trademarks of “朝日新聞 (Asahi Shimbun)”, “読売新聞 (Yomiuri Shimbun)” and “毎日新聞 (Mainichi Shimbun)” that are three major newspaper publishing companies in Japan on the same date of his/her registration of the disputed domain name through the same Registrar.

It is quite clear that Pilyun Kim intentionally acquired his/her registrations of the disputed domain name and some other domain names that are correspondent to well-known trademarks of Japanese major newspaper publishing companies in order to warehouse those domain names without any specific rights or interests in them. This indicates Pilyun Kim's pattern of conduct aimed at preventing trademark owners, including the Complainant, from registering corresponding domain names that reflect each company's trademark.

- (3) The Respondent in this case is not Pilyun Kim who originally acquired the registration of the disputed domain name. However, the disputed domain name that is currently registered by the Respondent is exactly identical to the registered trademark

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. Moreover, the disputed domain name has never been used for five months since it was registered by Pilyun Kim, which shows that neither Pilyun Kim nor the Respondent has need to use and register the disputed domain name.

The Respondent succeeded to the registrant of the disputed domain name from Pilyun Kim by March 7, 2001, after Pilyun Kim's receipt of the copy of a Complaint that was filed with WIPO's arbitration and mediation center by Kabushiki Kaisha Mainichi Shimbunsha (English name: The Mainichi Newspapers, hereinafter "Mainichi") that claimed for transferring <毎日新聞.com> that reflects its registered trademarks from Pilyun Kim. In the Complaint for the pending case between Mainichi and Pilyun Kim (case number: D2001-0307), Mainichi argues that, the simultaneous registration of four domain names that all reflect the trademarks of Japanese major companies in the same industry (newspaper publishing) by Pilyun Kim clearly shows Pilyun Kim's intention with bad faith to prevent the legitimate trademark holders from registering domain names that reflect their respective trademarks. Therefore, the Complainant believes that by March 7, 2001 when the Respondent succeeded to the registrant of the disputed domain name herein from Pilyun Kim, the Respondent and Pilyun Kim had recognized that the registration of <毎日新聞.com> could be transferred to Mainichi by an Administrative Panel's decision; and the disputed domain name could be also transferred to the holder of the registered trademark corresponding to <産経新聞.com> when the trademark holder would file a Complaint with a dispute-resolution service provider approved by ICANN. Consequently, it is quite likely that the Respondent is another cyber squatter who conspires with Pilyun Kim, or a nominal party who substantially helps a true cyber squatter behind to camouflage the Respondent has a legitimate interests in respect of the disputed domain name. It also supports the above that Pilyun Kim had never used the disputed domain name for four months after his/her registration. However, by March 8, 2001, immediately after s/he received a copy of the Complaint for the case with regard to <毎日新聞.com> from Mainichi, s/he also transferred two other registered domain names (<朝日新聞.com> and <読売新聞.com>) to two different persons.

It can be inferred from the Respondent's succession of the disputed domain name from a registrant who apparently acquired the registration with bad faith that the Respondent has no rights or legitimate interests in respect of the disputed domain name which has been registered by the Respondent in bad faith.

The Respondent's contentions are as follows:

- (1) The disputed domain name <産経新聞.com> consists of four Chinese characters, among which, "新聞" means news/newspapers and "産経" means the industry and economy. Every news / news paper company in Chinese affected countries uses "新聞" after their company names. "産経" is also the widely used initialized generic word which anyone cannot claims to have an exclusive right of it.

(2) The complainant said he uses its trademark “産経新聞” as a logotype on its newspaper which is well known among readers as well as its trademark. The Respondent has never seen the Complainant’s trade mark and can not accept that the graphical type of their trade mark is not only identical and but also similar to the domain name <産経新聞.com>.

The complainant said “産経新聞”(Sankei Shimbun) is appreciated as one of major daily newspapers with a national circulation throughout Japan together. The Respondent never read the Complainant’s newspapers and does not know that it is a major one or not. The Respondent has never heard that the complainant is famous in Korean and even never seen the complainant’s newspapers in Korea, and also never met any guy to read the paper not only in Korea but also outside of Japan. In the site of The Kyung Hyang Shinmun, there is no notice that The Kyung Hyang Shinmun has any relationship with the Japanese complainants.

(3) The Respondent has ordered and made the payment to Pilyun Kim who told the Respondent that he had an account for pre-registration for multilingual domain names at Alldomains.com. Since the Respondent’s ordered domain <産経新聞.com> was successfully registered, the Respondent have asked many times to transfer this domain to a Korean registrar, but Pilyun Kim explained to the Respondent that the domains transfer between registrars have not been approved by Verisign, and he could not transfer this domain to the Respondent. That is the reason why the disputed domain name is still on the Alldomains.com’s serve. Though the Respondent does not like to think that in the case he will be defeated, but, if it happens, the Respondent have made the notice to Pilyun Kim that he will make a big claim to him.

(4) The disputed domain name is surely not identical to the Complainant’s registered trademark and even not similar to its roughly graphicized or painted mark. The complainant’s company is a Japanese local company and the right they insisted should be limited in Japan. The complainant cannot insist their claims in Korea because they do not have any legal right in Korea. The Chinese wording of the disputed domain name <産経新聞> is very widely used generic initials in Korea, Chinese, Japanese and Chinese culturally affected countries, no one cannot insist that the Respondent should not have the right over the wording. Up to now, no one can use the multilingual domain name as an official Internet address. Only for some testing purposes, they can be used a forwarded one.

(5) Based on the domain name <産経新聞.com> was not registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant, as the alleged owner of the trademark or service mark, or to a competitor of Complainant, for valuable consideration in excess of the Respondent’s out-of-pocket costs directly related to the domain name, the Respondent has never tried to sell this domain not only to the complainant but also anybody in the world because the Respondent planed and plans for the use of his business purpose. The domain name was not registered in order to prevent Complainant from reflecting his mark in a corresponding domain name and, in connection therewith, the Respondent has not engaged in a pattern of such conduct. The Respondent did not register the domain name in an intentional attempt to attract for commercial gain. The Respondent has never done any harmful activities to make

the complainant to lose any profits. And also the complainant could not show what they lost from the Respondent's having this domain. The Respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain misleadingly to divert consumers or to tarnish the trademark(s) or service mark(s) at issue. This domain name will be used written in Korean and Chinese Language, and the complainant's customers using Japanese windows will not be confused.

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 [<産経新聞.com> (bq--3b2sg7kmmwyiaxq.com)]. The Panel finds that the characters of this domain name “産経新聞” are confusingly similar to the registered trademark held by the Complainant in Japan. It is true that the characters of the disputed domain name are slightly different in shape with the characters of the trademark of the Complainant, which has been pointed out by the Respondent in his response. However, the panel finds that the difference is not significant. From Chinese users' point of view, the two words have just same meaning and same pronunciation. In fact, they are interchangeable. In addition, the panel does not agree with the Respondent's contention that “産経” is widely used initialized generic word which anyone cannot claims to have an exclusive right of it. The word “産経新聞” is a coined word rather than a generic one. Therefore the Complainant have exclusive right on it. The panel has noticed the Respondent's contention that the complainant's company is a Japanese local company and the right they insisted should be limited in Japan. The complainant cannot insist their claims in Korea because they do not have any legal right in Korea. The panel does not support this contention because 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 based on the Policy. 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. On the other hand, the Complainant clearly declared that he has never licensed anybody to use his registered trademarks in Korea. 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 registration for the Chinese words “產經新聞” in Japan and has begun to use the trademark in Japan before the creation of the disputed domain name. “產經新聞” (Sankei Shimbun), together with “每日新聞” (Mainichi Shimbun), “朝日新聞” (Asahi Shimbun) and “讀賣新聞” (Yomiuri Shimbun), are appreciated as the four major daily newspapers with a national circulation throughout Japan. These 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 former registrant of the disputed domain name Pilyun Kim also registered simultaneously <朝日新聞.com>, <讀賣新聞.com> as well as <每日新聞.com>, all of which are the three famous newspaper publishing companies in Japan. The Panel infers from Pilyun Kim’s behavior that, when making the registration applications, he clearly knew that “產經新聞” was one of the major Japanese newspapers and further believes that Pilyun Kim registered and used the disputed domain name in bad faith.

The Respondent claimed that he obtained the disputed domain name from Pilyun Kim by transfer. However, it is a common sense that, just like the transfer of other kinds of intellectual properties, when getting the domain name by transfer from others, the transferee has been under the risks that his right over the domain name may be of a non-stable nature. The subject matter of the transfer (the disputed domain name) may probably infringe upon the legitimate rights of others. The Respondent should have known this and take the corresponding responsibility arising from the transfer. Moreover, the Respondent could not furnish evidence to prove that he acquired and held the disputed domain name by good reasons. Considering the influence of the newspaper “產經新聞” in Japan and its neighboring countries, it is inferred that the Respondent knew the name of the newspaper company. The Chinese characters of the disputed domain name are confusingly similar to the trademarks “產經新聞” owned by the Complainant. By common knowledge, using the Chinese wording “產經新聞” 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 [<產經新聞.com> (<bq--3b2sg7kmmwyiaxq.com>)] has prevented the Complainant from reflecting its trademark in a corresponding Chinese domain name.

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

7. Decision

The Panel concludes (a) that the domain name [<産経新聞.com> (<bq--3b2sg7kmmwyiaxq.com>)] is identical to the trademark owned by the Complainant, (b) that the Respondent has no rights or legitimate interest in the domain name and (c) that the domain name at issue has registered and used in bad faith. Therefore, pursuant to paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name [<産経新聞.com> (<bq--3b2sg7kmmwyiaxq.com>)] be transferred to the Complainant.

Li Yong
Sole Panelist

Dated: July 25, 2001