



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Kabushiki Kaisha Toshiba d/b/a Toshiba Corporation v. Liu Xindong

Case No. D2003-0408

1. The Parties

The Complainant is Kabushiki Kaisha Toshiba d/b/a Toshiba Corporation, Tokyo, Japan, represented by Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, United States of America.

The Respondent is Liu Xindong, Shandong, China.

2. The Domain Name and Registrar

The disputed Domain Name <dongzhi.net> is registered with BulkRegister.com.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 28, 2003. On the same day, the Center transmitted by email to BulkRegister.com a request for registrar verification in connection with the domain Name at issue. On May 29, 2003, BulkRegister.com transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the administrative, billing, and technical contact. The Center 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 WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”). Payment in the required amount to the Center has been made by the Complainant.

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on June 5, 2003. In accordance with the Rules, paragraph 5(a), the due date for Response was June 25, 2003. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 26, 2003.

The Center appointed Susanna H.S. Leong as the sole panelist in this matter on July 2, 2003. 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.

This dispute is properly within the scope of the UDRP as the registration agreement for the Domain Name incorporates the UDRP.

The language of this proceeding is English as the BulkRegister.com registration agreement is in English.

4. Factual Background

The Complainant is Kabushiki Kaisha Toshiba d/b/a Toshiba Corporation, a multinational company in the field of electronic, electrical and telecommunications products. The Complainant designs, manufactures, distributes and sells a wide variety of products under the trademark and trade name TOSHIBA. It has used its TOSHIBA trademark and trade name for more than 60 years and it has invested substantial financial resources over the years to advertise and promote the company and its TOSHIBA-branded products and services in countries all over the world.

The Complainant has long maintained a significant presence in China. The name and mark TOSHIBA in Chinese is 东芝. The phonetic spelling of 东芝 in Chinese using Latin characters is “dongzhi.” The Complainant has sold its TOSHIBA-branded and 东芝-branded products in China for decades. Its Chinese website showcasing its products and services, including telephones, is located at the Domain Name TOSHIBA.COM.CN. The Complainant has operated its Chinese website for many years and its 东芝 mark is displayed on its Chinese website in the upper left hand corner as “TOSHIBA 东芝”.

The Complainant has registered its TOSHIBA mark and/or variations of that mark in more than 150 countries around the world and in China, it has registered its marks TOSHIBA, TOSHIBA and Design, and 东芝. The Complainant’s registration for its 东芝 mark in China covers electronic goods in International Class 9, paper goods in International Class 16 and house wares in International Class 21. Its trademarks TOSHIBA and 东芝 have been widely promoted to the general consuming public in China and the rest of the world for many years and therefore, the TOSHIBA and 东芝 marks are widely known and recognized in China and beyond.

The Respondent has registered the Domain Name <dongzhi.net> on February 15, 2001. The Domain Name <dongzhi.net> is the Chinese phonetic equivalent of the Complainant’s 东芝 mark because “东芝” is pronounced “dongzhi” and the phonetic spelling, or Latin transliteration, of 东芝 in China is “dongzhi”. Besides using the transliteration of the Complainant’s 东芝 mark in the Domain Name, the Respondent also displays the 东芝 mark on his website in a trade name that translates into English as “Toshiba Network Online”.

The Respondent’s “www.dongzhi.net” website promotes and/or offers products and services that are directly competitive or closely related to those offered by the Complainant. In addition to advertising the Respondent’s software development, website development, and advertising services, the Respondent also sells directly

competing telecommunications goods (i.e. telephones) on the “www.dongzhi.net” website and promotes a future website regarding the Respondent’s telephone models and pricing. The Respondent’s “www.dongzhi.net” website also advertises the Respondent’s installation services for ADSL, a type of broadband Internet connection that could be used with the Complainant’s computers. The Respondent’s “www.dongzhi.net” website allows Internet users to post questions or comments and at least three Internet users have posted questions regarding the Complainant’s products on the “www.dongzhi.net” website.

5. Parties’ Contentions

A. Complainant

The Complainant contends that the Domain Name <dongzhi.net> is confusingly similar to the Complainant’s 东芝 mark because it is the phonetic equivalent of the Complainant’s 东芝 mark in China and the transliteration of 东芝 mark into Latin script.

It is the Complainant’s contention that the Respondent is not and has not been commonly known by the Domain Name. The Respondent’s use of a trade name that includes 东芝, which directly copies the Complainant’s famous 东芝 mark, in no way demonstrates any legitimate interest of the Respondent in the Domain Name. The Respondent cannot justify its misappropriation of the Complainant’s famous 东芝 trademark in a Domain Name simply by also using the Domain Name as part of a trade name or business name. If that were the case, cybersquatters could freely pirate the trademarks of others as domain names simply by also using the disputed domain name as their trade name. The Respondent is not making legitimate noncommercial or fair use of the Domain Name, without intending to mislead and divert consumers or to tarnish the Complainant’s 东芝 mark for commercial gain. Because the Respondent registered and uses the Domain Name to infringe the Complainant’s rights in its 东芝 mark, to trade off of the Complainant’s goodwill, and to usurp Internet traffic rightly intended for the Complainant, the Respondent’s registration and use of the Domain Name do not and cannot constitute a *bona fide* offering of goods or services pursuant to Section 4(c)(i) of the UDRP.

The Complainant further contends that the Respondent’s registration and use of the Domain Name meet the bad faith element set forth in Section 4(b)(iv) of the UDRP. Specifically, the Respondent uses the Domain Name to intentionally attract, for commercial gain, Internet users to his website by creating a likelihood of confusion with the Complainant’s 东芝 mark as to the source, sponsorship, affiliation, and/or endorsement of the Respondent’s website and the products advertised, promoted, and/or sold on Respondent’s website. The Respondent’s registration and use of the Domain Name also meets the bad faith element set forth in Section 4(b)(iii) of the UDRP. The Respondent registered and uses the Domain Name to sell directly competing products, which disrupts the Complainant’s business in bad faith. Finally, the Respondent acted in bad faith because he was on notice of the Complainant’s rights in its 东芝 mark when he registered the Domain Name and used the Domain Name to trade on the Complainant’s goodwill. This is because the Respondent knew of the Complainant’s 东芝 mark, his unauthorized use of the Domain Name for commercial gain suggests opportunistic bad faith given the widespread use and fame of the Complainant’s 东芝 mark and name.

B. Respondent

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

6. Discussion and Findings

General

According to paragraph 4(a) of the Policy, the Complainant must prove that:

- (i) The Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and
- (ii) The Respondent has no rights or legitimate interest in respect of the Domain Name; and
- (iii) The Domain Name has been registered in bad faith and is being used in bad faith.

Identical or confusingly similar

The Complainant is the registered owner of its TOSHIBA mark and/or variations of that mark in more than 150 countries around the world. The Complainant is also the registered owner of its marks TOSHIBA, TOSHIBA and Design and 东芝 in China. On the evidence adduced before this administrative proceeding, the Panel finds that the Chinese phonetic equivalent of the Complainant's 东芝 mark is "dongzhi" as this is the how the two Chinese characters "东芝" are pronounced in the Chinese language. Furthermore, the Panel also finds that the Latin script transliteration of "东芝" in China is "dongzhi", according to the Han Yu Pin Yin ("汉语拼音") way of transcribing Chinese characters into the Latin script. Since the Complainant is the registered owner of the mark "东芝" in China and this mark is widely known by the general consuming public in the Chinese market for many years, the Panel thus finds that the Complainant also has rights to the transliteration of the mark "东芝" – "dongzhi" in China.

Accordingly, the Panel finds that the Domain Name <dongzhi.net> is confusingly similar to the Complainant's 东芝 mark. This is because (1) the Domain Name in dispute is identical to the transliteration of the mark 东芝, (2) the Domain Name in dispute and the mark 东芝 is phonetically similar in the Chinese language and (3) the Complainant has adduced evidence before this Administrative Proceedings to show that the Complainant's mark TOSHIBA is widely recognized as "东芝" by the public and Internet users in China. See *Bunkasha Publishing Co. Ltd. v. Xman Productions* (WIPO Case No. D2002-0781).

Respondent's Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out a non-exhaustive list of circumstances, any one of which if found by the Panel to have been proved shall demonstrate the Respondent's rights or legitimate interests in respect of the domain names.

However, the need for the Respondent to demonstrate anything only arises once the Complainant has shown a prima facie case, the burden of proof under paragraph 4(a) being on the Complainant.

The essence of the Complainant's case is that the wide spread fame of its TOSHIBA and 东芝 marks in China at the date of registration of the Domain Name was such that the Respondent must have been aware of it. Given this fact, the act of the Respondent registering and using the Domain Name <dongzhi.net> constitutes an infringement of the Complainant's rights in its 东芝 trade mark and cannot constitute a bona fide offering of goods or services pursuant to Section 4(c)(i) of the UDRP. Accordingly, the Respondent had the Complainant in mind at all material times and has done what he has done with a view to trading on the back of the Complainant's goodwill, leading consumers to believe that the website to which the Domain Name is connected is associated with the Complainant in some way. Furthermore, the Respondent is not and has not been commonly known by the Domain Name. The Respondent did not adduce evidence to show or explain his choice in the Domain Name.

The Panel finds the Complainant's case persuasive. The Respondent has a case to answer.

However, the Respondent has failed to submit a Response to the Complaint filed against him. In particular, the Respondent has failed to make submissions to demonstrate that he has rights or legitimate interests to the domain names. In accordance to the Rules for Uniform Domain Name Dispute Resolution Policy, paragraph 14, the Panel thus draws such inferences as she considers appropriate, which are that the Respondent is unable to adduce evidence to show cause that he has rights or legitimate interests to the said Domain Name.

Accordingly, the Panel finds that no evidence has been adduced to demonstrate that the Respondent has rights or legitimate interests to the Domain Name in dispute, particularly in relation to:

- (i) prior use of or demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services by the Respondent;
- (ii) the Respondent having been commonly known by the domain name, even if no trademark or service rights have been acquired;
- (iii) the Respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel thus concludes that the Respondent does not have any rights or legitimate interests in the Domain Name in question.

Registered and Used in Bad Faith

For the same reasons the Panel finds that the overwhelming probability is that the Respondent selected the Domain Name because of its widespread fame in the field of electronic, electrical and telecommunications products in China and specifically to use the Domain Name to attract, for commercial gain, Internet users to his website by creating a likelihood of confusion with the Complainant's 东芝 mark as to the source, sponsorship, affiliation and or endorsement of the Respondent's website and the products advertised, promoted and or sold on the website. This is substantiated by the following:

- (i) The Respondent has notice of the Complainant's rights in its 东芝 mark when he registered the Domain Name and used the Domain Name;
- (ii) The Respondent sells products that are similar and are in direct competition with the Complainant using the Domain Name in question;
- (iii) The Respondent has not offered any plausible explanations on his choice of the Domain Name;
- (iv) There is evidence, adduced by the Complainant before this Administrative Proceeding, which shows Internet users have mistakenly believed that the Respondent's site is affiliated or connected to the Complainant as they have posted questions regarding the Complainant's products on the Respondent's "www.dongzhi.net" website.

Accordingly, the Panel finds that the Respondent registered the Domain Name in bad faith and is using it in bad faith within the meaning of paragraphs 4(b)(iii) and 4(b)(iv) of the Policy.

7. Decision

For all the foregoing reasons, in accordance with Paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name <dongzhi.net> be transferred to the Complainant.

Susanna H.S. Leong
Sole Panelist

Dated: July 11, 2003