



**WIPO Arbitration and Mediation Center**

**ADMINISTRATIVE PANEL DECISION**

Fall Nummer: D2003-0679

Entscheidung vom 13. November 2003

**1. The Parties**

The Complainant is Deutsche Messe AG, Hanover, Germany ....

The Respondent is Kim ..., Gwangju, Republic of Korea.

**2. The Domain Name and Registrar**

The domain name in dispute <cebit.com> is registered with Hangang Systems Inc. dba Doregi.com.

**3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on August 28, 2003. On August 29, 2003, the Center transmitted by email to Hangang Systems Inc. dba Doregi.com a request for registrar verification in connection with the domain name at issue. On September 2, 2003, Hangang Systems Inc. dba Doregi.com transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the Respondent's administrative, billing, and technical contact details. In response to a notification by the Center that the Complaint was administratively deficient, the Complainant filed an amendment to the Complaint on September 5, 2003, correcting the deficiency regarding jurisdiction but requested that the issue of language be decided by the Panel. The Center verified that the Complaint, together with the amendment thereto, 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).

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 September 12, 2003. In accordance with the Rules, paragraph 5(a), the due date for Response was October 2, 2003. The Response was filed with the Center on September 29, 2003.

The Center appointed Boh Young Hwang as the sole panelist in this matter on October 8, 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.

In response to the request by the Complainant for permission to submit a Supplemental Filing, the Panel rendered the Procedural Order No. 1, allowing the Complainant to submit the Supplemental Filing and allowing both parties to submit any further documents within 10 days from Center's notification of the Procedural Order No. 1. The Complainant submitted its Supplemental Filing on October 2, 2003, and other than that, no further documents have been submitted by either party.

The language of the proceeding is English but, in accordance with Paragraph 11 of the Rules and Panel Procedural Order No. 1, the documents submitted by the Respondent in Korean are also accepted.

#### 4. Factual Background

Over the past 25 years, the Complainant has organized and conducted the trade fair and exhibition in the area of computer technology in Hanover, Germany, named CeBIT. Many companies from around the world have been participating in the CeBIT-exhibition and Korean companies are no exception. For example, between 1997 and 2000, the CeBIT exhibition hosted between 30 to 70 exhibitors from Korea.

The Complainant registered the trademarks CEBIT or CeBIT in a number of countries. In Korea, the word mark CeBIT has been used frequently for decades by the Complainant to invite Korean companies to the CeBIT exhibition through newspaper and other mass media.

The domain name in dispute has been registered by the Respondent in December 2000. In February 2001, the Complainant had filed a UDRP Complaint against the Respondent on the domain name in dispute, and the case was opened under the WIPO Case No. D2001-0232. However, the case has been finally closed in May 2001, due to the Complainant's failure to reply to the Complaint Deficiency Notification by the Center. A copy of the Complaint filed in the WIPO Case No. D2001-0232 above with its Annexes was sent to the Respondent's postal address by the Complainant.

The Respondent filed a trademark application on March 6, 2002, regarding the mark CeBIT before the Korean Intellectual Property Office (KIPO) for dust-blocking glasses and certain other products, and the trademark has been duly registered by the KIPO on July 31, 2003.

Meanwhile, with the Complainant's letter dated April 10, 2003, the parties engaged in negotiations in writing exploring the possibility of voluntary transfer of the domain name in dispute by the Respondent. However, the negotiations were not successful due to the parties' failure to agree upon the amount of the consideration for such transfer. The Complainant proposed an amount in the range of US\$7,000 to US\$15,000, while the Respondent in the range of US\$65,000 to US\$85,000.

The domain name in dispute is currently used by the Respondent for a website which contains and displays certain information about eyes and optical products.

#### 5. Parties' Contentions

##### A. Complainant

The domain name in dispute <cebit.com> is identical or confusingly similar to the trademark and service mark CEBIT and CeBIT in which the Complainant has rights.

The Respondent has no rights or legitimate interests in respect of the domain name in dispute. Although the Respondent registered a trademark which includes the word CeBIT, the Respondent filed its trademark application after the Complainant had already acquired trademark rights regarding its CeBIT mark in various countries around the world, and also after the Respondent became aware of the possible conflict with the Complainant's right to use the domain name in dispute because the Complainant had commenced an arbitration proceeding against Respondent in the year of 2001.

The domain name in dispute was registered and is being used in bad faith by the Respondent. The Respondent registered the domain name in dispute for the purpose of selling it to the trademark owner (the Complainant) for an amount, which does not correspond with the cost of registration, and in the meantime, is using the domain name with the intention to attract Internet users to the Respondents website to make commercial gains.

## B. Respondent

The purpose of registration of the domain name in dispute by the Respondent is to maintain a website dealing with various optical products of the Respondent, and the Respondent is currently operating the website using the domain name in dispute.

The Respondent has obtained rights and legitimate interests in respect of the domain name in dispute by registering the trademark CeBIT in Korea on July 2003.

The Respondents proposed amount for a voluntary transfer of the domain name, namely US\$85,000, is based on a fair calculation of the total amount invested or expended by the Respondent during the last 2 years in maintaining the website and related business.

Since the website that is currently operated by the Respondent using the domain name in dispute is dealing with optical products, there is no likelihood of confusion among the general Internet users between the products provided by the Respondent and the services provided by the Complainant.

## 6. Discussion and Findings

### A. Selection of Language

The Complaint was filed in the English language. The Respondent asserts that all documents in the arbitration proceeding should be filed in the Korean language, which is the language of the registration agreement for the domain name in dispute, whereas the Complainant asserts that English should be the language of the proceeding.

According to Paragraph 11 of the Rules, the language of the administrative proceeding shall be the language of the registration agreement unless the Panel decides otherwise. The spirit of Paragraph 11 is to ensure fairness in the selection of language by giving full consideration to the parties level of comfort ability with each language, the expenses to be incurred and possibility of delay in the proceeding in the event translations are required and other relevant factors.

In the present case, it is without question that the registration agreement for the domain name in dispute was made in the Korean language. However, it is also apparent from the written communications exchanged between the parties with respect to a possible voluntary transfer of the domain name in dispute that the Respondent has no difficulties in communicating in the English language. The English used by the Respondent in his letters demonstrates his ability to understand and communicate in English without difficulties.

On the other hand, the Complainant is not able to communicate in Korean and therefore, if the Complainant were to submit all documents in Korean, the arbitration proceeding will be unduly delayed and the Complainant would have to incur substantial expenses for translation. Therefore, in consideration of the above circumstances and in the interest of fairness to both parties, the Panel hereby decides, under Paragraph 11 of the Rules, that (i) English shall be the language of administrative proceeding in this case, but on the condition that (ii) the Respondent shall be permitted to submit any documents or assertions in Korean.

## B. Transfer of the Domain Name in Dispute

To qualify for cancellation or transfer, a Complainant must prove each element of paragraph 4(a) of the Policy, namely:

(i) the domain name in dispute is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) the Respondent has no rights or legitimate interests in respect of the domain name in dispute; and

(iii) the domain name in dispute has been registered and is being used in bad faith.

### B1. Identical or Confusingly Similar

The Complainant has registered and currently owns trademarks and rights on the marks CEBIT and CeBIT, and these registered marks are in fact identical with the domain name in dispute excluding the part .com which merely shows the character of the domain name. Therefore, the Complainant has established this element.

### B2. Rights or Legitimate Interests

Based on the evidence submitted before the Panel, it is recognized that the marks CEBIT and CeBIT owned by the Complainant were widely known and recognized around the world including Korea before the domain name in dispute was registered by the Respondent. It is also clear from the record that the Respondent has registered and currently owns the trademark cebit in Korea. Therefore, the central issue is whether or not the Respondent's registration of the trademark including the word cebit can be construed to give the Respondent rights or legitimate interests in the domain name in dispute.

First of all, it should be stated that the registration of a trademark which is identical with or similar to the domain name in dispute does not always or automatically provide the registrant with rights and legitimate interests in respect of the domain name, although it can be strong evidence of the existence of such rights or legitimate interests. The existence of any right or legitimate interest on the domain name in dispute should be determined by taking in consideration all relevant factors, including without limitation, the registration of a trademark corresponding to the domain name.

As demonstrated in Paragraph 4(c) of the Policy, the use of a domain name or a name corresponding to the domain name can be recognized as giving the user rights and legitimate interests only when such use is made in good faith. In the present case, it is recognized from the evidence submitted by the parties that the Respondent filed its trademark application after the Complainant's filing of the complaint in the WIPO Case No. D2001-0232 case. In this regard, it seems that the Respondent had or could at least have had an ample opportunity to notice the Complainant's desire to file a legal proceeding for transfer of the domain name in dispute.

Moreover, upon observation of the Respondent's website using the domain name in dispute, it is noted that the website consists only of three web-pages in total, and also that although the main page of the website shows ten categories of information including the Company Introduction, Q&A, Eye Info, Company News, Product Introduction, Guestbook, Eye Times, Eyedaq, Color Vision and Eyewearmall, only two of those

categories, namely Eye Info and Eyewearmall, contain information, which is displayed only on one simple webpage. The website does not provide any details about the identity of the entity that operates the website, and no further clicks are allowed regarding all of the twelve products shown in Eyewearmall. Furthermore, apart from the operation of the above website, the Respondent has not submitted any evidence which goes to show that the Respondent has made actual use of the registered trademark or maintained any actual business using the trademark.

Therefore, in consideration of all of the circumstances described above, including, among others, the reputation and wide recognition of the Complainant's trademark which had been firmly established and had existed prior to the Respondent's registration or use of the domain name in dispute and the lack of evidence establishing good faith in the Respondent's use of the domain name in dispute and his registered trademark, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the domain name in dispute.

Therefore, the Complainant has established this element of its case.

### B3. Registered and Used in Bad Faith

The Panel finds that, knowing of the Complainant's well established reputation in the trademark CEBIT and/or CeBIT, the Respondent, by using the domain name in dispute, has intentionally sought to cause confusions among Internet users as to the source, sponsorship, affiliation or endorsement of his website. Further, the evidence submitted before the Panel shows that the Respondent proposed to receive a sum of at least US\$65,000 in exchange for the transfer of the domain name in dispute to the Complainant, which also makes this case fall under Paragraph 4(b)(i) of the Policy. As stated above, the Respondent's registration of the trademark and operating a website using the domain name in dispute do not constitute sufficient evidence to negate the existence of bad faith in the Respondent's use of the domain name in dispute.

Therefore, the Complainant has also established this element of its case.

## 7. Decision

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

(Unterschrift)