



## WIPO Arbitration and Mediation Center

### ADMINISTRATIVE PANEL DECISION

Fall Nummer: D2003-0949

Entscheidung vom 20. Januar 2004

#### 1. The Parties

The Complainant is P.T. Bali Discovery Tours of Bali ... Indonesia.

The Respondent is Mr. M. A. of Phuket, Thailand.

#### 2. The Domain Name and Registrar

The disputed domain name <balidiscovery.org> is registered with Tucows.

#### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 28, 2003. That day, the Center transmitted by email to Tucows a request for registrar verification in connection with the domain name at issue and Tucows 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").

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 December 9, 2003. In accordance with the Rules, paragraph 5(a), the due date for the Response was December 29, 2003. The Response was filed with the Center on December 24, 2003.

The Center appointed Alan L. Limbury as the Sole Panelist in this matter on January 8, 2004. 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. Following the filing of the Response, both parties made several unsolicited submissions to the Center with copies to the panelist, once appointed.

The Complaint did not annex copies of the trademark registrations on which the Complainant relies, contrary to the requirements of Rule 3(xv). Instead, the Complainant indicated its willingness to provide certified translations of its Indonesian trademark registrations. On January 14, 2004, in the interests of ensuring that this proceeding would be determined on the merits as between the parties and not on a failure by the Complainant to comply with the procedural Rules, the Panel, in accordance with Rule 12, issued Procedural Order No. 1 requesting the Complainant to provide to the Center and the Respondent by January 22, 2004, translated and independently certified copies of those trademark registrations. The Respondent was given until January 27, 2004, to provide to the Center its comments on those documents and the due date for a decision was extended to a date to be fixed following compliance by the parties with the procedural order. The Complainant filed documents in response to the Procedural Order on January 16, 2004, and the Respondent filed comments next day. The Panel indicated a decision within the original timetable of

January 22, 2004, was likely.

The language of the proceeding was English but some documents in Indonesian were translated. Issues arose as to whether some translations were accurate. It has not been necessary to resolve those issues.

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

The Complainant is a limited liability company based in Denpasar, Bali, Indonesia. Its Indonesian name is "PT Biro Perjalanan Wisata Bali Discovery," in English: "Bali Discovery Tour and Travel Company." It operates under the name "Bali Discovery Tours" and has sold Bali-based travel products since 1999, including from its website "www.balidiscovery.com." The domain name <balidiscovery.com> was registered on July 29, 1999.

On September 12, 2002, the Complainant's Lawyer and Patent Consultant, Pacific Patent, filed with the Indonesian Directorate General of Intellectual Property, Justice and Human Rights, on behalf of the Complainant as "applicant," a "Request for Brand Registration" in relation to a green and brown logo depicting a female face above the words "Bali Discovery Tours" in class 39 in respect of various services, including "tour and travel, arrangement of trips for tourists, guides services."

The disputed domain name was registered on January 7, 2003, in the name of the Respondent as registrant and giving as the name of the registrant organization and of the administration and billing organization "Jack Daniels Fan Club." Apart from being the brand name of a famous alcoholic beverage, Jack Daniels is the nickname of Mr. J.M.D., President Director of the Complainant.

The website operated by the Respondent at "www.balidiscovery.org" bore the headline: "Please do not do business with Bali Discovery Tours (balidiscovery.com)." It contained a photograph of Mr. D. and made extensive allegations against him and the Complainant, which it is unnecessary to summarize.

#### **5. Parties' Contentions**

##### **A. Complainant**

In response to Procedural Order No. 1, the Complainant provided a copy of the original Indonesian version and a copy of a translation by a sworn and registered translator of Trademark Registration (JASA 2002-20812-2140) for PT Bali Discovery Tours dated September 12, 2002, and a letter from Pacific Patent, Lawyers and Patent Consultants, verifying the registration of the trademark and name effective September 12, 2002, explaining the procedure for trade [mark] registration in Indonesia and affirming the Complainant's rights over the subject name, barring any registration of the same or similar trade [name] pre-dating the registration date. There is also an explanation of Indonesian trademark law which includes the statement: "registration creates or constitutes the right on the trademark."

The disputed domain name is identical or confusingly similar to the trade name of Bali Discovery Tours and the established website domain "www.balidiscovery.com" that has been in active use by the Complainant since 1999. The Respondent irrefutably had prior knowledge of the Complainant's existing interest in both the trade name and the domain name since he used both the trade name and the name Jack Daniels when registering the disputed domain name. Also, the Respondent sent Mr. Daniels an email on January 8, 2003, the day after registration of the disputed domain name, which stated: "I am going to feature you on a very special domain."

Intentional registration of a domain name while knowing that the second-level domain contains another's valuable trademark weighs in favour of a likelihood of confusion: *Savin Corporation v. savinsucks.com*, NAF Case No. FA0201000103982. The content of the Respondent's website confirms his continuing intentions to discredit both the brand and the Company associated with the Complainant's established brand. Free speech arguments are not sufficient grounds for intentionally registering a domain with a confusingly similar name: *Savin Corporation case*.

The Respondent has no rights or legitimate interests in respect of the disputed domain name, which was registered and is being used in bad faith. [It is unnecessary for the Panel to summarize these contentions].

##### **B. Respondent**

The Complaint should be dismissed out of hand. The Complainant falsely claims to have a trademark and is harassing the Respondent. The actual registration document confirms this. The registration request is solely for brand registration of the graphic that appears on the complainant's website. Nowhere in the registration document does it claim to be a registration for the trademark "Bali Discovery Tours." The trademark is not yet enforceable even within Indonesia, as the trademark has clearly not yet been approved.

The disputed domain name is not identical nor confusingly similar to the trade name Bali Discovery Tours. A Google search reveals the phrases Bali Discovery and Bali Discovery Tours are widely used by others. The claimed mark is generic and therefore unregistrable.

The Respondent has rights and a legitimate interest in the disputed domain name, which was not registered and is not being used in bad faith. [It is unnecessary for the Panel to summarize these contentions].

In dismissing the Complaint out of hand the Panel should note that the Complainant has used clear multiple falsehoods and harassment against the Respondent.

## **6. Discussion and Findings**

### **Procedural issues**

After the filing of the Complaint and the Response, no party has the right to insist upon the admission of additional evidence: *SembCorp Industries Limited v. Hu Huan Xin*, [WIPO Case No. D2001-1092](#). Rule 12 provides that the Panel may in its sole discretion request further statements or documents from either of the parties. It is appropriate to consider the circumstances of each case before deciding whether to admit unsolicited additional submissions: *Toyota Jidosha Kabushiki Kaisha d/b/a Toyota Motor Corporation v. S&S Enterprises Ltd.*, [WIPO Case No. D2000-0802](#). Nevertheless, the clear intention of ICANN in adopting the Policy and Rules in their present form was that supplementary submissions should be requested by a Panel in exceptional cases only: *Gordon Sumner, p/k/a Sting v. Michael Urvan*, [WIPO Case No. D2000-0596](#).

This is not a case of discovery of evidence not reasonably available to the parties at the time of their initial submissions nor of arguments by one that the other could not reasonably have anticipated: see *Goldline International, Inc. v. Gold Line*, [WIPO Case No. D2000-1151](#). Accordingly the Panel does not admit any of the parties' unsolicited submissions.

### **Substantive issues**

Paragraph 15(a) of the Rules requires the Panel to decide a Complaint on the basis of the statements and documents submitted in accordance with the Policy, these rules and any rules and principles of law that it deems applicable. The Panel had had regard to the Trademark Law of Indonesia in determining this Complaint.

Under paragraph 4(a) of the Policy, the Complainant bears the burden of showing:

- that the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- that the Respondent has no rights or legitimate interests in respect of the domain name; and
- that the domain name has been registered and is being used by the Respondent in bad faith.

### **Rights in a trademark or service mark**

A consideration of the documents provided by the Complainant in response to Procedural Order No. 1 reveals that on September 12, 2002, an application ("registration request") was filed on behalf of the Complainant with the Indonesian Directorate General of Intellectual Property of the Department of Justice and Human Rights to register as a service mark a logo of a female face with the words "Bali Discovery Tours" and that, according to the Complainant's Lawyers and Patent Consultants, Pacific Patent, a Trademark Certificate is expected to issue between 18-24 months after the application, that is between March and September 2004.

Under Indonesian trademark law, no rights in a registered trademark arise until registration, whereupon a Trademark Certificate is issued and the rights flowing from registration are retrospective to the date of the application. No copy of a Trademark Certificate has been placed before the Panel.

It is not at all clear whether Indonesian law recognizes common law trademarks. In any event, the Complainant has not produced evidence in support of any claim it might have to such a mark, in Indonesia or elsewhere. Having regard to the form of the mark for which it has made application for registration, which includes as an important feature a female face, and having regard to the descriptive nature of the words Bali Discovery Tours, the Complainant has failed to establish that those words, whether as part of a logo or standing alone, have become distinctive of the Complainant's services in Indonesia or elsewhere.

Accordingly the Complainant has failed to establish that it has rights, registered or otherwise, in a trademark or service mark.

It follows that it is unnecessary to consider the issues of identity/confusing similarity, rights/ legitimate

interests and bad faith.

### **Alleged harassment**

The Respondent, in response to Procedural Order No.1, has asserted that the Complaint was brought in order to harass him and has asked the Panel to make a declaration to that effect. Rule 15(e) identifies the bringing of a complaint primarily to harass the domain-name holder as an example of the bringing of a complaint in bad faith, attempted reverse domain name hijacking being another. It is clear from the content of their respective websites that the parties have some history of conflict between them. Proceedings of this kind, on the documents and without the benefit of oral evidence from the parties, tested by cross examination, are unsuited to the determination of who is right and who is wrong. The Panel is not in a position to find that the Complainant brought this complaint primarily to harass the Respondent.

### **7. Decision**

For all the foregoing reasons, the Complaint is denied.

(Sole Panelist)