



## WIPO Arbitration and Mediation Center

### ADMINISTRATIVE PANEL DECISION

Case No. D2004-01711

#### 1. The Parties

The Complainant is Deutsche Telekom AG, ...

The Respondent is W.. L..., Las Vegas, Nevada, United States of America.

#### 2. The Domain Name and Registrar

The disputed domain name <t-mobile-inc.com> is registered with Register.IT SPA.

#### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 8, 2004. On March 8, 2004, the Center transmitted a request by email to Register.IT SPA for registrar verification in connection with the domain name at issue. On March 9, 2004, Register.IT SPA transmitted its verification response by email to the Center, confirming that the Respondent is listed as the registrant and providing the contact details for the administrative, billing, and technical contact. In response to a notification by the Center that the Complaint was administratively deficient, the Complainant filed an amendment to the Complaint on March 26, 2004, thereby submitting itself to the jurisdiction of the court at the location of the domain name holder. The Center verified that the Complaint, together with the amendment to 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 March 29, 2004. In accordance with the Rules, paragraph 5(a), the due date for Response was April 18, 2004. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 22, 2004.

The Center appointed Zbynek Loebel as the sole panelist in this matter on May 3, 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.

#### 4. Factual Background

The Complainant is Europe's largest telecommunications company. The Complainant covers the entire spectrum of modern telecommunications. The Complainant is continuously driving forward the internationalization of the Deutsche Telekom Group with a variety of strategic shareholdings.

The Complainant's subsidiary, T-Mobile International, is one of the largest GSM mobile communications providers in the world, serving customers in more than 65 countries around the globe through regional unit s.

The names "Deutsche Telekom" and "T-Mobile" are universally recognized. "T-Mobile" is the corporate name under which the Complainant's business in the mobile communications sector is concluded.

The Complainant has registered a large number of national and international trademarks reflecting the term "T-Mobile." The trademark upon which the complaint has been specifically based is the registered trademark T-MOBILE with registration number DE39638168, which has been protected in Germany since October 8, 1996.

Furthermore, the Complainant is the owner of the German trademarks T-MOBILE, registration numbers DE30069306 and DE39638169.

Moreover, the Complainant has registered the designation T-MOBILE as a Community trademark in the European Union with the registration number 000485441.

The Complainant has also registered international trademarks T-MOBILE with registration numbers 680034 and 680053.

Finally, the Complainant has registered the US trademarks T MOBILE with the registration numbers 75248964 published July 20, 1999, and 75248964 published July 13, 1999.

The Complainant has registered and uses - among others - the following Internet domain name: <t-mobile.com>.

The Respondent, according to the Whois database of concern, has registered the domain name <t-mobile-inc.com>.

## **5. Parties' Contentions**

### **A. Complainant**

The Complainant contends that the disputed domain name is confusingly similar to its marks T-MOBILE (where the Complainant's whole mark is included in the disputed domain name), that the Respondent has no legal rights or legitimate interests in the disputed domain name, and that the Respondent registered, and is using, the disputed domain name in bad faith.

The Complainant contends that the Respondent has never been a representative or licensee of the Complainant, and that the Respondent has not been otherwise authorized to use the Complainant's marks.

The Respondent does not use the domain name <t-mobile-inc.com> for a bona fide offering of goods or services and is not making a legitimate, noncommercial, or fair use of it. The domain name redirects its users to a webpage of a reseller of the Complainant's subsidiary, T-Mobile UK, although the Respondent is not connected in any way to the Complainant or its subsidiaries.

The Complainant has presented an email from the Complainant's subsidiary T-Mobile UK, which confirmed that his reseller is not connected to the Respondent in any way.

The Complainant establishes that in response to the "cease and desist" letter, the Respondent stated that somebody had misused his address and he had nothing to do with the domain name. However, the Respondent had rejected the Complainant's request for an amicable transfer of the domain name.

The Complainant's subsidiary, T-Mobile International, is one of the largest GSM mobile communications providers in the USA. The Complainant contends that the T-Mobile's USA homepage under "www.t-mobile.com" not only shows goodwill and reputation of the Complainant's trademarks T-MOBILE in the USA, but that it also draws the conclusion that it is very unlikely that the Respondent has not been aware of the Complainant's business in the USA.

## B. Respondent

The Respondent did not reply to the Complainant's contentions. Before the proceedings were initiated, the Respondent replied to the Complainant's informal letter in which the Complainant offered an amicable resolution of the dispute, stating that he, the Respondent, became a victim of identity theft and someone has misused his name and address. The Respondent, however, has not granted authorization for an amicable transfer of the domain name requested by the Complainant.

## 6. Discussions and Findings

Since the Respondent has not filed any response and has not presented any evidence to contest any of the contentions of the Complainant, this case shall be decided based on the allegations and documents submitted by the Complainant.

The Respondent's default does not automatically result in the decision being rendered in favor of the Complainant. In order to have the decision rendered in its favor and obtain the transfer of the domain name, the Complainant must still establish that the case satisfied three conditions required by the Policy.

The requisite conditions are as follows:

- The disputed domain name is identical or confusingly similar to a trademark owned by the Complainant;
- The Respondent does not have any rights or legitimate interests in respect to the disputed domain name; and
- The disputed domain name has been registered and is being used in bad faith. The Respondent has been given the notice of the proceedings in accordance with the Rules.

### A. Identical or Confusingly Similar

The Panelist considers that the disputed domain name is confusingly similar to the trademarks T-MOBILE of the Complainant.

The Complainant contends that the customers can understand the domain name only as a webpage of T-Mobile. The Respondent combines the distinctive designation T-MOBILE, which is protected by the Complainant, with a mere descriptive portion, "INC," which represents a corporate form of establishment.

In the case *Nokia Corporation v. Nick Holmes*, WIPO Case No. D2002-0001, the Panel held that

"This Administrative Panel accepts that Complainant's submission that the domain name <nokiaheaven-uk.com> is confusingly similar to the Complainant's NOKIA trademark. NOKIA is the dominant element of the domain name and the addition of the word "heaven" is a laudatory non-distinctive element that would not reduce any risk of confusion among Internet users. Furthermore, the addition of the letters "uk" will be interpreted as a reference to the activities of the Complainant in the United Kingdom, as these letters are an important element in the ccTLD for the United Kingdom."

Similarly, in the case *Toyota France and Toyota Motor Corporation v. Computer-Brain*, WIPO Case No. D2002-0002, the Administrative Panel decision held

"... the Panel is of the opinion that the domain name is confusingly similar to the Complainant's trademarks, because within the disputed domain name, there is no doubt that the predominant

element is "Toyota," which is distinctive and eligible for protection per se and clearly isolable within the combination <toyota-occasions.com>. It has to be borne in mind that the French name "occasions" means "used" or second-hand."

Hence, "occasions" is a generic term, which in addition to the name "Toyota" does not create new wording with a meaning of its own, within which "Toyota" would no longer be perceived as the trademark of the vehicles of the Complainant."

Indeed, one may reasonably suspect that the public, when reading or hearing the domain name <toyota-occasions.com> will be lead to believe that the said domain name is owned by, or related to, the Complainant and points towards a website where used or second-hand Toyota cars are shown and offered for sale".

As in the two above mentioned cases, the Claimant's trademark is clearly the dominant element and a distinctive sign due to the prefix "T"; arguendo, if it were not, the fact of its trademark registration would suffice as a rebuttable presumption of its distinctiveness. In *EAuto v. Triple S. Auto Parts*, WIPO Case No. D2000-0047, the Panel held that the domain name <eautolamps.com> and the trademark "EAUTO" were confusingly similar, because, although the word "auto" is generic and "the letter `e' preceding it has come to be understood as electronic, the registration of the respective trademark creates a rebuttable presumption that the EAUTO mark is inherently distinctive. When the domain name incorporates, in its entirety, a distinctive mark, this creates similarity between the mark and the domain name sufficient to render it confusingly similar." In this case, the Panel has found presence of similarity, although the entire word "lamps" was added to the trademark.

Further, it has been held in some instances that the suffix - in this case ".com" - does not influence the consideration of similarity. (see, *Deutsche Telekom AG v. Domainsforlife.com*, WIPO Case No. D2002-0164).

The Complainant contends that the disputed domain name would be associated in the mind of the public with the Complainant's trademarks, so that a risk of confusion is likely since the Respondent combines the distinctive element "T-Mobile" with the new descriptive term "Inc". The Panel finds the disputed domain name confusingly similar to the trademarks owned by the Complainant.

## **B. Rights or Legitimate Interests**

The Respondent has not established his rights or legitimate interests in the use of the domain name. In particular, none of the circumstances listed under paragraph 4 (c) of the Policy, which could serve as a proof of rights or legitimate interest in the domain name, have been presented by the Respondent. The domain name does not appear to be in use for any bona fide offerings of goods and services and there is no indication that the Respondent was known by the name "T-Mobile" prior to registration of the disputed domain name. The Respondent is not authorized or licensed to use the Complainant's marks. The Panel has concluded that the Respondent does not have rights or legitimate interests in the disputed domain name.

## **C. Registered and Used in Bad Faith**

There has been no legitimate use of the domain name by the Respondent.

Before the proceedings were initiated, the Respondent replied to the Complainant's informal letter in which the Complainant offered an amicable resolution of the dispute, stating that he, the Respondent, became a victim of identity theft and someone has misused his name and address. The Respondent, however, has not granted authorization for an amicable transfer of the domain name requested by the Complainant. In addition, the Respondent did not submit any response to the Complaint. This by itself may be an indication of bad faith:

"...., it is possible to say that Respondent's inactivity or passive holding of the domain name, may prove that the domain name has been registered and is being used in bad faith." (*Red Bull GmbH v. Harold Gutch*, WIPO Case No. D2000-0766; *eBay, Inc. v. Sunho Hong*, WIPO Case No. D2000-1633).

The Respondent has registered the domain name with the intent of benefiting from the reputation of the famous trademarks and company name contained in the domain name.

Given the fame of the Complainant's trademark in the USA, it is very unlikely that the Respondent had no knowledge of the trademark and the Complainant's business.

Moreover, it has been previously held that the registration of a domain name confusingly similar to a well-known trademark is an indication of bad faith:

"It is highly unlikely that the Respondent has selected the domain name without having knowledge of the Complainant's use of his mark. He must not have had the Complainant's mark in mind when he registered the domain names but he must also have been aware of the deception and confusion that would inevitably follow if he uses the domain. (see, *eBay, Inc. v. Sunho Hong*, WIPO Case No. D2000-1633).

The Respondent must have had knowledge of the trademark, in light of the fame of the trademarks. In any event, the trademarks owned by the Complainant were duly registered. Thus, a simple search in a trademark databases would have shown the registration and ownership of the trademark. Moreover, the fact that he directed the disputed domain name to a homepage of a reseller of the Complainant's subsidiary serves as additional proof of this knowledge. Furthermore, such redirection has apparently been made with the intent to cause deception and confusion among customers. "It is inconceivable that the Respondent could make any active use of the disputed domain name without creating a false impression of association with the Complainant. The Respondent was not authorized by the Complainant to use either its mark or the disputed domain name." (see, *Sony Kabushiki Kaisha v. Inja, Kil*, WIPO Case No. D2000-1409).

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

## 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 <t-mobile-inc.com> be transferred to the Complainant.

(Unterschriften)