



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (BEIJING OFFICE)

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Decision Submission

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Decision ID	DE-0200006
Case ID	CN-0200004
Disputed Domain Name	www.vitop.com
Case Administrator	anitaw
Submitted By	M Scott Donahey
Participated Panelist	M Scott Donahey
Date of Decision	30-08-2002

The Parties Information

Claimant	Vitop Ltd.
Respondent	Utone Telecom Ltd.

Procedural History

On July 1, 2002, Beijing office of Asian Domain Name Dispute Resolution Centre (“ADNDRC”) received the Complaint form filed by the Complainant Vitop Ltd. (“Complainant”). On July 2, 2002, Beijing Office of ADNDRC received the hard copies of the Complaint. On July 5, 2002, Beijing Office of ADNDRC transmitted the Complaint to the Respondent, Utone Telecom Ltd. (“Respondent”).

Beijing Office of ADNDRC received payment in the correct amount for a single-person panel, but determined that the Complaint was deficient. On July 8, 2002, Beijing Office of ADNDRC notified the Complainant of the deficiencies and requested that the Complaint be amended. Thereafter Beijing Office of ADNDRC received the requested amendments and on July 15, 2002, served a Notification of the Commencement of the Proceedings on Respondent. Service of the Notification of the Commencement of the Proceedings was simultaneously made on ICANN and the Registrar, Directi.

On July 17, 2002, Beijing Office of ADNDRC requested Directi to confirm that the domain name at issue was registered by Respondent and that the registration agreement provides for resolution under the Uniform Domain Name Dispute Resolution Policy (the "UDRP"). On July 19, 2002, Directi confirmed the above. On July 19, 2002, Beijing Office of ADNDRC requested that the parties rank the five candidates for Panelist in order of preference. On July 31, 2002, Respondent indicated a preference for a three-person Panel. On August 2, 2002, Respondent advised Beijing Office of ADNDRC that it intended to proceed with a single-person panel, and withdrew its request for a three-person panel. On August 1 and 2, 2002, Beijing Office of ADNDRC received from the parties the rankings of the five candidates in order of preference.

On August 2, 2002, Beijing Office of ADNDRC received the Response, and on August 5, 2002 it served its Acknowledgment of the Receipt of Response and forwarded the Response to the Complainant. On August 6, 2002, pursuant to Beijing Office of ADNDRC Supplemental Rules, Art. 8(4), Beijing Office of ADNDRC appointed Mr. M. Scott Donahey, as the highest mutually ranked candidate, to serve as Panelist. On August 6, 2002, Beijing Office of ADNDRC received the Panel’ s Confirmation of Acceptance. On August 9, 2002, Beijing Office of ADNDRC notified the parties of the Panel’ s appointment. On August 16, 2002, Beijing Office of ADNDRC confirmed the parties that Mr. M. Scott Donahey is appointed as Panelist of the case. On August 16, 2002, Beijing Office of ADNDRC transferred “Additional Relevant Details of the Complainant” dated August 15, 2002 submitted by Complainant to Respondent. On the same day, Respondent submitted correspondent supplemental documents, which was transferred by Beijing Office of ADNDRC to Complainant on August 16, 2002. All documents submitted by both Complainant and Respondent were sent to Panelist by email, fax and courier.

Factual Background

For Claimant

Complainant is a high technology company in the field of health care and is the holder of trademarks in Hong Kong, the People's Republic of China, Malaysia, Taiwan, Indonesia, Thailand, Singapore, Australia, France, the United Kingdom, Spain, Germany, and the United States of America for the mark VITOP. Complainant's registration with the United States Patent and Trademark Office ("USPTO") shows a first use in commerce of the VITOP mark in 1996.

The marks were issued in connection with articles of medical and athletic use, as well as textiles and clothing.

Complainant has invested substantial time and money in the promotion of the VITOP mark, expending in excess of two hundred million yuan renminbi (RMB), approximately US\$24,096,400.00.

Complainant's parent, Vitop Bioenergy Holdings Limited is a listed company on the Hong Kong Growth Enterprise Market (the "Hong Kong Exchange"). Complainant's franchisees have operated in Hong Kong since 1997, promoting the trademark and advertising it in Hong Kong magazine. On February 1, 2002, Complainant's parent became listed on the Hong Kong Exchange, an event that received much media attention in Hong Kong.

Respondent registered the domain name at issue on May 13, 2002. On June 1, 2002, Complainant contacted Respondent to discuss a purchase of the domain name at issue. Respondent stated that it would not consider any offer lower than RMB one million, approximately US\$120,482.00. Complainant estimates the cost of registering the domain name at issue to be RMB 300 (US\$35.00).

For Respondent

Respondent is a company incorporated under the laws of Hong Kong with its principal place of business in Hong Kong. Respondent is a wholesaler of cellular phones and accessories that does most of its advertising and business over the Internet. In March 2002, Respondent launched a new product line of cellular phone chargers. These products were initially listed in Respondent's catalog without a brand name.

On June 3, 2002, Respondent caused the domain name "vitop.com" to link directly to the web site located at www.utone.com.

Respondent's principal, who registered the domain name at issue on behalf of Respondent, was unaware of Complainant's existence. Respondent's principal does not invest in stocks, so he had no reason to know that Complainant was registered on the Hong Kong exchange.

Respondent's principal "thought up" the fanciful term "vitop" by the following process. Respondent's principal wanted a new product name for his cellular phone chargers. He first came up with "voltop," which name was short for "topping up the voltage." However, he rejected this name, because it did not "sound professional." While drinking a "VITA" drink one day, Respondent's principal came up with the name "vitop" which name represented 'topping up the vitality' of the battery."

Respondent's principal thereafter decided that he wanted to set up a website with the name "vitop" in order to promote the new product line. Unfortunately, at that time <vitop.com> was taken. Fortunately, a short time later, on April 5, 2002, that registration expired, and on May 13, 2002 Respondent registered the domain name at issue.

In early June 2002, Respondent was contacted by someone claiming to be "a friend of the Complainant." That person offered 20,000 RMB for the domain name at issue. Respondent's principal rejected that offer. After rejecting several offers, Respondent's principal became "annoyed, and in an attempt to end the conversation said, in an offhand manner that he would not be prepared to sell the Domain Name for anything less than RMB1,000,000." In Respondent's view, this does not amount to an offer to sell.(1)

On or about June 4, 2002, Respondent's principal instructed Respondent's web master to link the domain name at issue to the web site at www.utone.net.

Parties' Contentions

Claimant

Complainant contends that the domain name at issue is identical to the fanciful mark VITOP in which Complainant has rights. Complainant contends that Respondent has no rights or legitimate interests in respect of the domain name at issue. Complainant contends that Respondent registered and is using the domain name in bad faith.

Respondent

Respondent contends that it does not infringe Complainant's mark and that there is no likelihood of confusion.

Respondent contends it had no knowledge of complainant or its business and that Respondent came up with the same fanciful term serendipitously. Respondent contends that it has rights and legitimate interests in the domain name at issue because it is using the name in conjunction with its cellular phone battery chargers. Respondent contends that it registered and is using the domain name at issue in good faith.

Findings

Identical / Confusingly Similar

Paragraph 15(a) of the Uniform Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: “A Panel shall 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.”

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

- 1) 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
- 2) that the Respondent has no rights or legitimate interests in respect of the domain name; and
- 3) that the domain name has been registered and is being used in bad faith.

The Panel finds that the domain name “vitop.com” is identical to the mark VITOP in which Complainant has rights, since from the very outset of the UDRP, Panels have disregarded the TLD in comparing domain names to marks. *Digitronics Inventioneering Corporation v. @Six.Net Registered*, WIPO Case No. D2000-0008; *Credit Management Solutions, Inc. v. Collex Resource Management*, WIPO Case No. D2000-0029. Where the domain names are identical, the issue of likelihood of confusion is not germane. *Shirmax Retail Ltd./Detaillants/Shirmax LTEE v. CES Marketing Group, Inc.*, eResolution Case No. AF0104.

Rights and Legitimate Interests

Respondent contends that he was unaware of Complainant or its marks until he was contacted by Complainant and, that this contact occurred after Respondent had independently discovered the same fanciful term that Complainant had trademarked and decided to use it as a product name for Complainant’s cellular phone battery charger. The Panel finds that Respondent’s creation story defies all credulity. In any event, in order to show rights or legitimate interests by use or preparation to use, Respondent must show “demonstrable preparations” or actual use occurring “before any notice... of the dispute.” (2) Respondent produced no evidence as to when the name “vitop” first appeared in its catalogs. Respondent did not use the domain name to point to its web site until after it was contacted by Complainant. This is after notice of the dispute.

Accordingly, the Panel finds that Respondent has no rights or legitimate interests in respect of the domain name.

Bad Faith

Respondent contends that it could not have acted in bad faith since it had no knowledge of Complainant’s business name or of its trademarks. From the very beginning Panels have recognized that it may be very difficult, if not impossible, for a Complainant to prove actual knowledge in the face of denial of such knowledge by a Respondent. Thus, Panels have found constructive knowledge where the Respondent is in the same community as Complainant and should be aware of Complainant’s existence and marks. See, e.g., *R & A Bailey & Co. v. WYSIWYG*, WIPO Case No. D2000-0375 (“The fact that the Respondent claimed not to be aware of the Complainant’s trademarks at the time that he registered the name, [sic] does not assist him. First, it strains credulity to accept that Mr. MacNeill a person of Irish nationality, did not understand that Bailey’s, an Irish company with an internationally recognized product, would not have intellectual property rights associated with its name and product in the United States”). This is also the case where Respondent has failed to do even a modicum of research prior to registering the domain name at issue. *Medisite S.A. R.L. v. Intellisolve Limited*, WIPO Case No. D2000-0179 (“The Respondent denies any knowledge of the existence of the Respondent or its business activities prior to the date on which it registered the domain name. This Administrative Panel must conclude that if the Respondent carried out any reasonable amount of research into an internet [sic] project, it would surely have become aware of the existence of the Complainant and of Complainant’s [web] site and its domain names...”). In the present case, where Respondent and Complainant both are residents of Hong Kong, where Complainant has registered trademarks in Hong Kong, where Complainant is listed on the Hong Kong Exchange, and where Complainant has carried out extensive promotion of its business and its trademarks, Respondent is deemed to have

constructive knowledge of Complainant and its marks.

Respondent claimed that it was Complainant who contacted it, and that Respondent's indication that it would not entertain an offer for the domain name of less than RMB1,000,000 was an attempt to terminate the discussion and not an offer to sell the domain name at issue for an amount far in excess of Respondent's out-of-pocket costs. However, offers to sell which come within the ambit of paragraph 4(b)(i) of the UDRP have been found by Panels in similar situations. See, *United States Olympic Committee v. MIC*, WIPO Case No. D2000-0189 (where Complainant contacted respondent and made an offer, and, when it was clear that Respondent would not sell for the offered amount and an amount was requested, Respondent stated, "Oh, it's hard to say, but in other cases such marks have sold for anywhere from \$10,000 to \$3 million." The Panel found a bad faith offer to sell.); *Blue Sky Software Corp. v. Digital Sierra Inc. and Abdullah Khan*, WIPO Case No. D2000-0165 (where, in response to an offer from Complainant, Respondent stated that "\$3000 is not even close to what I'm thinking" The Panel found a bad faith offer to sell.)

Accordingly, the Panel finds that Respondent offered to purchase the domain name at issue for an amount far in excess of the Respondent's out-of-pocket costs, and that this conduct constitutes bad faith registration and use. UDRP, 4(b)(i).

Status

www.vitop.com

Domain Name Transfer

Decision

For all of the foregoing reasons, the Panel decides that the domain name registered by Respondent is identical to the trademarks in which the Complainant has rights, that the Respondent has no rights or legitimate interests in respect of the domain name at issue, and that the Respondent's domain name has been registered and is being used in bad faith.

Accordingly, pursuant to Paragraph 4(i) of the UDRP, the Panel requires that the registration of the domain name "vitop.com" be transferred to the Complainant.

Sole Panelist

M. Scott Donahey

August 30, 2002

Notes:

(1) Complainant apparently made a tape recording of this conversation, and Respondent objects to its introduction. No tape recording was included among the annexes delivered to the Panel.

(2) "Any of the following circumstances . . . if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate . . . rights or legitimate interests to the domain name, . . . (i) before any notice . . . of the dispute, your 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" UDRP, 4(c)(i).

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