



## ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

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### Decision Submission

English Print

Decision ID	DE-0300013
Case ID	HK-0300028
Disputed Domain Name	www.easterntelecom.com
Case Administrator	Iris Wong
Submitted By	Jeffrey Elkinson
Participated Panelist	Jeffrey Elkinson
Date of Decision	13-08-2003

### The Parties Information

<b>Claimant</b>	Eastern Telecommunications Philippines, Inc.
<b>Respondent</b>	kim kyonghwan

### Procedural History

On the 16th April 2003, the Complainant submitted a Complaint to the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre ("ADNDRC") in accordance with the Uniform Domain Name Dispute Resolution Policy ("the Policy") adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN") on the 26th August 1999, the Rules for Uniform Domain Name Dispute Resolution Policy Disputes ("The Rules") and ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy Disputes ("the ADNDRC Supplemental Rules"). The Complainant elected to have the Complaint decided by one Panelist. On the 16th May 2003, ADNDRC received the required filing fee from the Complainant. The Respondent acknowledged receipt of the Complaint on 2nd May 2003 by email dated the 5th May 2003 addressed to ADNDRC and at the same time requested to receive a copy of the Complaint in the Korean language. The Registrar of the domain name, Seung Suk Kang of Hangang Systems Inc., confirmed by email to ADNDRC on the 26th May 2003 that English was the language of the Registration Agreement between the Registrar and the Respondent. That being the case, ADNDRC properly responded to the Respondent that under the Rules (Paragraph 11(a)) the language of the administrative proceedings would be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise.

The Respondent filed a Response on the 6th June 2003 which Response was in Korean. On the 10th July 2003 the Panel notified ADNDRC that, in accordance with Paragraph 11(a) of the Rules, the language of the Administrative Proceedings was English and that the Panel was prepared to allow the Respondent one further opportunity to provide a translation of its response within 24 hours and made an Order pursuant to Paragraph 11(b) of the Rules. ADNDRC notified the Respondent of the Order and the Respondent, on the 11th July 2003, replied by email repeating that it had replied previously to ADNDRC "that the language of the Registration Agreement for this domain is in Korean because this domain was registered with the Korean language of the Registration Agreement at doreigi.com which is a famous Korean Domain Registrar." The Panel does not find this response acceptable, not least because the Registrar Officer of doreigi.com informed ADNDRC by email on the 26th May 2003 that English was the language of the Registration Agreement between the Registrar and the Respondent. The Panel notes that Seung Suk Kang had sent a previous email on the 20th May 2003 setting out that the language was Korean. On enquiry from ADNDRC, he confirmed that in fact English was the language of the Registration Agreement. The Panelist has received a request from the Respondent that the language of the proceedings should be Korean and to ask the Complainant to submit his Complaint in Korean. The Response has been given in the Korean language in the face of the following:

1. The language of the Registration Agreement is English;
2. The Respondent had communicated with ADNDRC by emails in the English language and had been informed by ADNDRC that the response should be in English;
3. The Complaint was in English, although it is noted that the Respondent had requested that it be translated into Korean;
4. The Response was on a form which sets out instructions and queries in English and certain sections of the form require boxes to be ticked. The Respondent has responded in Korean to the English instructions and questions on the form.
5. The Panel made an Order on the 10th July 2003 that the language of the proceeding was English and that the

Respondent provide an English translation.

Paragraph 11 of the ICANN Rules for Uniform Domain Name Dispute Resolution Policy, adopted on the 26th August 1999 and implemented on the 24th October 1999 states as follows:

"11. Language of Proceedings

(a) Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the Administrative Proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the Administrative Proceeding.

(b) The Panel may order that any documents submitted in languages other than the language of the Administrative Proceeding be accompanied by a translation in whole or in part into the language of the Administrative Proceeding."

The Panel is satisfied that the language of the Registration Agreement is English and, even if it were wrong in this, it has ordered that the language of the proceeding be English and has given the Respondent the opportunity to provide a translation of its Korean language response but the Respondent has failed to take the opportunity to do so. It is clear that the Respondent understands English because the Order requiring the English translation was in English and the Respondent's response was in English. There was no question of any expense being incurred in obtaining an English translation as what was requested was not a certified English translation but simply an English translation. Given the circumstances, the Panel denies the request that the proceedings be in Korean and is left with little alternative but to proceed on the basis as if the Respondent has not provided a Response. The consequence is that the Complainant's contentions go unchallenged.

The Panelist, pursuant to paragraph 12 of the Rules, requested further statements or documents from the Complainant to clarify whether or not the name "easterntelecom.com" was a trade mark or service mark in which the Complainant has rights. On the 23rd July 2003, the Complainant responded indicating that it had registered the domain name "easterntelecom.com.ph" and "easterntelecom.ph." No direct response was given to the inquiry made by the Panel, which inquiry arose because on the Complaint Form, when asked to specify the trade mark or service mark on which the complaint was based, the response given by the Complainant was "N/A."

The Panelist has not received any further request from the Complainant or the Respondent regarding other submissions, waivers or abstention of deadlines. There is no need to hold any in-person hearings for deciding the Complaint, as provided for in Paragraphs 12 and 13 of the Rules, there being no matters of an exceptional nature.

ADNDRC received on the 21st June 2003 a Declaration of Impartiality and Independence from the sole Panelist and thereafter on the 23rd June 2003, ADNDRC confirmed the appointment of Jeffrey Elkinson as the sole Panelist in this matter.

On the 24th June 2003, ADNDRC transferred the case file to the sole Panelist by post.

The Panelist finds that the Panel has been properly constituted and appointed in accordance with the Rules and the ADNDRC Supplemental Rules.

## **Factual Background**

### **For Claimant**

The Complaint sets out that the Complainant utilizes the business name of Eastern Telecom. It sets out that it has been engaged in the international telecommunications business in the Philippines since 1880. The Complainant goes on to state that the business name, Eastern Telecom, is used in its corporate and marketing materials and recites examples of where the name is used – calling cards, letterhead, envelopes, brochures, leaflets, streamers, etc.

### **For Respondent**

N/A

## **Parties' Contentions**

### **Claimant**

It appears from the response given to the Panel on the 23rd July 2003 that the Complainant has the use of two domain

names based on its business name, "easterntelecom.com.ph" and "easterntelecom.ph."

The Complainant sets out that the domain name which was registered by the Respondent "easterntelecom.com" is identical and confusingly similar to its business name. The Complainant says that the Respondent has no right or legitimate interests in respect of the domain name as the Respondent does not own a company named Eastern Telecom nor does he engage in the telecommunications business. The Complainant says that the domain name of "easterntelecom.com" has been registered and used in bad faith by the Respondent and sets out two reasons for that statement. The first reason is that Respondent has simply registered the domain name for the purpose of selling, renting or otherwise transferring it to the Complainant and says that this is evidenced by the 'for sale' sign which appeared on the website, a printed copy of which was provided with the Complaint. The Complainant goes on to state that the Respondent has registered the domain name primarily for the purpose of destroying the good name and business reputation of the Complainant by 'showing dead people on the road.'

The Complainant seeks to cancel the domain name registration of "easterntelecom.com" as it is presently held in the name of the Respondent and requests the transfer to it of the domain name registration.

### Respondent

For the reasons set out above, the Respondent is deemed not to have responded.

### Findings

#### Identical / Confusingly Similar

The Complainant says:-

- (i) The domain name which was registered by the Respondent is identical and confusingly similar to its business name;
- (ii) The Respondent has no right or legitimate interest in respect of the domain name;
- (iii) The domain name has been registered and used in bad faith by the Respondent.

Each and every one of these three elements of the complaint is required to be proved in order for the Complaint to succeed. The failure to prove any one element is fatal to succeeding in the Complaint.

- (i) Identical and confusingly similar

In accordance with the Policy, paragraph 4(a)(i), where a domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights, then there is an applicable dispute. It is for the Complainant to prove that the disputed domain name is identical or confusingly similar to his trademark or service mark. The burden of proof is simply on the balance of probabilities.

The Complainant has not provided any evidence to show that it is the holder of a registered 'Eastern Telecom' trademark, which may have other consequences for the Complainant. The Panelist is satisfied however that Eastern Telecom is the business name utilized by the Complainant and that it has had long use of this name. As stated above the Complainant has asserted that it has utilized the words 'Eastern Telecom' in its corporate business and marketing. In particular the Complainant alleged that the business name, 'Eastern Telecom' is used in its corporate and marketing materials such calling cards, letterhead, envelopes, brochures, leaflets, streamers, etc. and in a number of domain names registered in the Philippines. Although the Complainant has provided evidence of its use of "Eastern Telecom" of the <easterntelecom.com.ph> and <easterntelecom.ph> domain name registration, the Complainant has not provided the any evidence regarding the use of "Eastern Telecom" in its calling cards, letterheads, envelopes, brochures, leaflets streamers, etc. This is unfortunate and indicates to the Panelist that the Complainant has taken a rather casual attitude toward the prosecution of its claim or that the Complainant believes that a mere assertion of a fact is evidence of it. This has made the Panelist's task needlessly much more difficult than it otherwise might have been. Complainants when making claims under the Policy must prove their case. That is, in the ordinary case, they must provide to the Panel actual evidence of those facts that they are required to prove by way of physical evidence, affidavits, or other relevant forms of proof to support their allegations. Bare allegations of fact in most cases will not be sufficient.

This having been said, the Panelist finds that the use of the "Eastern Telecom" name is well known in the markets in which the Complainant operates. It is a leading company in its field with a long history. Its name is recognizable to its customers, suppliers and other business partners. The name is prominently used and displayed on its web-site and the Panelist concludes that it is highly probable that the name "Eastern Telecom" is and has been used extensively in the Complainant's marketing material, calling cards, brochures, etc. On this basis, the Panelist concludes that the Complainant has a common law trade mark right in the words "Eastern Telecom". Moreover, the Panel finds that the disputed domain name is identical to the trade mark in which the Complainant has established rights. Accordingly, the Panelist finds that the Complainant has met the requirements of Paragraph 4(a)(i) of the Policy.

### Rights and Legitimate Interests

The Complainant has alleged that the Respondent has no rights or legitimate interests in respect of domain name and, given the failure of the Respondent to properly respond, as referred to in this Award, there is no contest to that allegation. Further, given the use by the Respondent of the domain name to date as established by the Complainant, the Panel cannot discern any legitimate interest held by the Respondent in respect of the disputed domain name.

### Bad Faith

Complainant's allegation that the Respondent has registered the domain name primarily for the purpose of selling, renting or otherwise transferring it to the Complainant is supported to an extent by the attachment to the Complaint at Annex B. This demonstrates a page with 'Welcome to Easterntelecom.com' on it and a 'for sale' sign, in English, on what appears to be a paper bag. The Complainant says that the Respondent was seeking to sell this to the Complainant. The Panel is satisfied that the domain name has been registered and used in bad faith and refers to paragraph 4(b) of the Policy which provides for some of the circumstances, without limitation, of those matters which evidence bad faith and which includes circumstances indicating an intent to sell to the Complainant for gain which the Panel believes to be the case here.

### Status

www.easterntelecom.com                      Domain Name Transfer

### Decision

From what has been set out above, the Panel concludes that the disputed domain name "Easterntelecom.com" is identical to the mark used by the Complainant in the course of its business, that the Respondent has no rights or legitimate interests in respect of the domain name and that the domain name has been registered and been used in bad faith. Therefore, pursuant to paragraph 4(i) of the Policy and paragraph 15 of the Rules, the Panel orders that the registration of the domain name "Easterntelecom.com" be transferred to the Complainant, namely Eastern Telecommunications Philippines Inc.

[Back](#)[Print](#)