



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

— ADNDRC is a charitable institution limited by guarantee registered in Hong Kong

Decision Submission

English Print

Decision ID	DE-0600080
Case ID	HK-0600083
Disputed Domain Name	www.chipmos.com
Case Administrator	Dennis CAI
Submitted By	Edward Charles Chiasson QC
Participated Panelist	Edward Charles Chiasson QC
Date of Decision	03-07-2006

The Parties Information

Claimant	ChipMOS TECHNOLOGIES INC.
Respondent	Charles Yeh

Procedural History

On April 4, 2006, the Complainant submitted its Complaint to the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (the "ADNDRC" or the "Centre"), in accordance with the Uniform Domain Name Dispute Resolution Policy (the "Policy") adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN") on August 26, 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 sought a sole Panelist.

On April 20, 2006, the Centre received the required filing fee from the Complainant and confirmed the receipt of the Complaint and on the same day the Centre forwarded a copy of the Complaint to the Respondent by on-line system and e-mail as well as a copy of the Complaint by on-line system and e-mail to the Registrar of the domain name in dispute, Register.Com, Inc. 575-8th Ave - 11th Floor, New York, NY 10018, United States of America.

The Respondent filed a Response with the Centre on April 26, 2006.

Having received on May 17, 2006, a Declaration of Impartiality and Independence and a Statement of Acceptance from Edward C. Chiasson, Q.C., on May 19, 2006 the Centre informed the Complainant and the Respondent that Edward C. Chiasson, Q.C. was appointed as Panellist in this matter.

On May 19, 2006, the Centre transferred the case file to the Panellist by post.

The Panellist finds that the Administrative Panel was properly constituted and appointed in accordance with the Rules and the ADNDRC Supplemental Rules.

Subsequently, the Administrative Panel invited the Complainant to provide supplementary comments and the Complainant did so. The Respondent then requested an opportunity to respond, was allowed to and did so. The Administrative Panel has considered all submissions and material submitted by the parties.

There is no need, as an exceptional matter, to hold any in-person hearings as necessary for deciding the Complaint, as provided for in Paragraphs 12 and 13 of the Rules.

The language of the proceeding is English, it being the language of the Domain Name Registration and Service Agreement, pursuant to Paragraph 11(a) of the Rules and there is no express agreement to the contrary by the parties.

Factual Background

For Claimant

The following information derives from the Complaint and the material delivered with it. The Complainant was incorporated on July 28, 1997.

“ChipMOS” has been the corporate name of the Complainant since it was incorporated. The Complainant registered the domain name "chipmos.com.tw" on August 20, 1997. The competent authority of the Taiwan government also granted to the Complainant the "ChipMOS" logo as its service mark and trademark for semiconductor chip business as early as September 1, 1998.

The Complainant is engaged in wafer sorting, assembly and testing of semiconductor chips. The Complainant was ranked the fifth largest IC assembly company in Taiwan in 2003 and the fourth in 2004; the third largest testing company in Taiwan in 2003 and 2004. In terms of revenue, the Complainant is the fifth ranked IC testing and packaging company in the world. As of the end of year 2004, the Complainant had assets more than US\$890 million and revenue of US\$500 million.

The Complainant's corporate name, service marks, trademarks and domain name, "chipmos", has been well known in Taiwan and throughout the world.

The first half part of the Complainant's corporate name as well as its trademark and service marks - “Chip” symbolizes its main products of semiconductor chips and the later part- “MOS” comes from the abbreviation of the Complainant's major shareholder “Mosel Vitelic, Inc.” (“Mosel”). Mosel is a Taiwanese semiconductor manufacturer listed at the Taiwan Stock Exchange (“TSE”). Mosel once became the “stock king” of the Taiwan Stock Exchange in 1995, that is, the highest stock price on the TSE, and also ranked among the most profitable companies in Taiwan in 1996 (ranked fourth), 1997 (ranked tenth) and 1998 (ranked 47th). In addition to the Complainant, Mosel also incorporated ProMOS Technologies Inc. ("ProMOS"), a leading DRAM fabrication company in Taiwan listed at the Gre Tai (OTC) Securities Exchange in Taiwan and a major customer of the Complainant.

The Complainant has registered with the Intellectual Property Office in Taiwan and enjoys the exclusive right to the service mark "ChipMOS" on design and testing of semiconductor chips since September 1, 1998, as well as on dicing and assembly of semiconductor chips from May 1, 1999. The Complainant also holds the trademark "ChipMOS" on semiconductor chips and memory.

For the purpose of an initial public offering in the United States of America, the Complainant was restructured in 2000. As a result, the Complainant is majority-owned by ChipMOS TECHNOLOGIES (Bermuda) LTD. (“ChipMOS Bermuda”), a holding company listed on the NASDAQ, in the United States. ChipMOS Bermuda has exclusive rights to “ChipMOS” as a service mark and trademark in People Republic of China, Singapore, the United States, Japan, and Hong Kong.

The Respondent registered the subject domain name in 1999, but has not used, or demonstrated any preparation to use it to offer any goods or services based on the following facts: (i) as of March 3, 2006, the webpage of the subject domain name contained only one page, the only content of which was that “the enterprise portal were being rebuilt to serve our customers, partners, and employees, and the new website will serve all users all over the world” ; (ii) in addition, counsel for the Complainant visited Google and found that the cache of Google database indicated that the webpage to which the subject domain name resolves existed as early as December 8, 2005; (iii) furthermore, the webpage states "Copyright (c) 2003 Chipmos.com, All rights reserved." That is, the webpage has existed without use for over two years.

The Complainant contacted the Respondent by e-mail (as his telephone number at the domain name registrar had not worked) on February 22, 2006 for the possibility of transfer of the subject domain name to the Complainant. The Respondent confirmed his ownership of the disputed domain name, refused to disclose his telephone number or other contact information and requested 2 million NT Dollars (approximately US\$67,000) for an immediate transfer. The Respondent stated clearly that the subject domain name could be transferred "immediately" if the Complainant agreed to the transfer price of 2 million NT Dollars.

Although the Respondent stated that he registered the subject domain initially for his own use, and the Complainant's offer to buy inspired him to sell the subject domain name since the Respondent could decide to sell the subject domain name within two weeks, it appears that he never had plans for the website and never used the disputed domain name to provide products or services.

The Complainant rejected the Respondent's offer to transfer the subject domain name for 2 million NT Dollars and informed the Respondent of the possible resort to the dispute resolution mechanism.

In order to circumvent the Policy and the Rules, the Respondent replaced the previous webpage with a new webpage around mid-March, 2006.

The content of the new one-page website refers to “more” potato “chips” and links to one unrelated website in an attempt to justify the use of “chipmos” in a domain name. It is clear that such change is not justifiable at all.

Both the previous webpage and the new webpage are merely sham arrangements to circumvent the Policy and the Rules: based on the previous webpage. Initially it appeared that the Respondent was engaged in the business related to certain products requiring technical services and had certain business establishments in the USA, Taiwan, China, Japan, Korea, Singapore and Europe; now it seems that the Respondent has changed his business to the food industry or his interest to non-commercial activities as a potato chips lover. It is self-explanatory that the Respondent has never used or prepared to use the disputed domain name with a bona fide offering of goods or services.

The new website shows that it is owned by a potato chip fan, and contains only one page with five icons on it: “History”, “Member Login”, “Related links”, and “Search on Google”. When clicking on the “History” icon of the page, it is automatically linked to another website (www.kitchenproject.com) built and owned by an unrelated third party; when clicking on member login, it shows user name and password, while there is no instruction to become a member; when clicking on “Related links”, it was a blank page; when clicking on “Search on Google”, it was linked to Google.com. It is clear that this website is not actually operating, and the only purpose for the current website is to appear to comply with the Policy and Rules.

ChipMOS is a created name and the Respondent has no connection with it.

The Respondent registered and used the disputed domain name primarily for the purpose of selling the disputed domain name to the Complainant, the owner of the corporate name, domain name, trademark and service mark “ChipMOS”, for excessive consideration.

The Respondent contended in his e-mail to the Complainant that he was not aware of the Complainant’s business when he registered the disputed domain name. Given the excellent performance of Mosel, the high profile of the Complainant and ProMOS and the strong support by Mosel and ProMOS to the Complainant, it is reasonable to believe that the Respondent found that the Complainant, a rising star in this industry, did not register the disputed domain name and then registered the disputed domain name so as to take advantage of the Complainant.

ChipMos is a created name and the Respondent is not known by it.

The Respondent sent rude and offensive e-mails to customers of the Complainant who inadvertently contacted the Respondent through the website to which the subject domain name resolves.

For Respondent

The following derives from the Response and the material delivered with it.
The Respondent asserts that the Complainant is attempting a reverse domain name hijacking.

In 1999, several friends who like potato chips wanted to build a website for chips lovers to share information and experience and planned for e-commerce in the future. They liked the slogan “More Chips”, that is, it is pleasant to eat “more chips.” They tried the domain names “morechips.com”, “mochips.com” and “chipsmo.com”, but the first one is not neat, the spelling and pronunciation of the last two are not fluent. Finally, “chipmos.com” came out, the spelling and pronunciation of which are good.

“Chip” means potato chip, and “mos” is the singular of “mores” in Latin. The Respondent registered the subject domain name on October 11, 1999.

Four days after the registration, the Respondent registered the service “Virtual URL Domain Transfer” provided by Yahoo!Geocities at October 15, 1999. Using this function, the URL www.chipmos.com can be mapped virtually to a homepage at www.geocities.com/[your-Yahoo!-ID].

Around 2003, the Respondent switched to a new ISP (Hinet in Taiwan) to build a new website and mail server. The Respondent also enhanced the scope of the discussion forum to food related and changed it to “email-based.” This idea is also adopted by Yahoo! GROUPS (<http://groups.yahoo.com>).

If a “potato_lover” group is created in Yahoo! Groups, then all the e-mails sent to potato_lover@yahoogroups.com will go automatically to the e-mail addresses of the members.

Members can initiate a new discussion topic by sending mail to the group. For example, if alan_chen@chipmos.com and mary_chou@chipmos.com join the “area_usa” group of Chipmos.com, then e-mails sent to

“area_usa@chipmos.com” will go to alan_chen and mary_chou.

The current website does not need advertisement to obtain income, so POP3(SMTP) e-mails was chosen instead of web-based mails (like Yahoo! Mail and Google Mail). Members can use Microsoft Outlook or Outlook Express to download and send e-mails.

To avoid indifferent users to consume the resource of the e-mail server, the “email-based” discussion forum only allows people to join by “invitation.” This idea is also adopted by Google Mail(<http://www.gmail.com>). Members can initiate an invitation e-mail to a friend, so the friend can join specific groups.

Around February 2006, the Respondent received several e-mails from the Complainant which raised the question whether the Respondent was prepared to sell the subject domain name.

The parties delivered supplemental submissions addressing a number of difficult issues including: whether the fact the Complainant’s mark was registered only in Taiwan at the time the subject domain name was registered is fatal to the Complainant and the veracity of the Respondent’s assertion that it registered and has used the subject domain name to host lovers of potato chips.

Parties' Contentions

Claimant

See Factual Background above.

Respondent

See Factual Background above.

Findings

Identical / Confusingly Similar

Article 4(a) of the Uniform Domain Name Dispute Resolution Policy (the “Policy”) sets out the criteria upon which the findings of the Panel shall be based.

Article 4(a)(i) of the Policy provides that the Complainant must show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Respondent contends that because the Complainant’s mark was registered only in Taiwan at the time the subject domain name was registered, the Complainant does not have the requisite legal interest to sustain its position.

Considerable reliance is placed on authorities and publications that limit the effect of a trademark registration to the jurisdiction or jurisdictions in which a mark is registered. For example, it is noted that Taiwan is not a member of the World Intellectual Property Organization (“WIPO”) and reference is made to WIPO’s published information concerning the reach of protection afforded to a trademark owner:

“A trademark provides protection to the owner of the mark by ensuring the exclusive right to use it to identify goods or services...The effects of...registration are...limited to the country...concerned. (emphasis in original)

The Respondent asserts:

“The trademarks registered in Taiwan have effects only in the territory of Taiwan. Respondent’s registration and use of [the subject] domain name occurred in the USA...which is outside the territory of Taiwan. Respondent’s users spread among many countries, which are also outside Taiwan. According to the Paragraph 4.a(i) of the Policy, the requirement “has rights”, not only “has trademarks”. Since Complainant’s trademarks have no effects outside Taiwan, Complainant...has not “rights against [the subject] domain name...”

A domain name dispute is not geographically centred. Domain names operate in cyberspace. The users of websites to which domain names resolve may be international. As noted by the Respondent, the users of the domain name to which the subject domain name resolves are “spread among many countries”.

To meet the requirements of paragraph 4(a)(i) of the Policy, a Complainant does not have to establish a trademark registration in a specific country. It must show that it has rights in a trademark. The inquiry pursuant to paragraph 4(a)(i) is whether a domain name is identical or confusingly similar to a mark in which a complainant has rights. Questions of geography are subsumed in the other inquires under paragraph 4(a) of the Policy. That is, if a complainant's mark is registered only in one country, it may not have the notoriety to sustain the allegation that a respondent does not have a legitimate interest in a domain name that meets the requirements of paragraph 4(a)(i) of the Policy or the assertion that the domain name was registered and is being used in bad faith.

Domain name dispute proceedings generally are not concerned with infringement per se. The comments in the WIPO publication and other material referred to by the Respondent, address that issue. They are not relevant to the present inquiry.

It is clear that the Complainant has rights to “chipmos”. The subject domain name differs from it only by the addition of .com, which is of no significance.

The Administrative Panel is satisfied that the Complainant has met the requirements of paragraph 4(a)(i) of the Policy.

Rights and Legitimate Interests

Article 4(a)(ii) provides that the Complainant must show that the Respondent does not have rights or legitimate interests in respect of the disputed domain name. Article 4(c) provides that the Respondent can demonstrate his rights to and legitimate interests in the disputed domain name: “Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

- (i) before any notice to you 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; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

Each of the elements of a domain name proceeding must be considered separately, but facts relevant to one may be relevant to another. In this case, the Administrative Panel reviews a number of factors under the heading, “Bad Faith”, which are relevant to the rights and legitimate interests of the Respondent.

The Complainant relies on its use of “chipmos” and its business success in contrast to the apparent lack of use of the subject domain name by the Respondent. The Respondent contends that it registered and has used the subject domain name to host lovers of potato chips. It provides explanations for its apparent lack of use and asserts that the interests of the Complainant and those of the Respondent differ, each being legitimate on its own.

These and all positions of the parties concerning the legitimate interest inquiry are considered. Many are discussed at length in the next section.

Based on all of the information and submissions of the parties, the Administrative Panel is satisfied that the Complainant has met the requirements of paragraph 4(a)(ii) of the Policy.

Bad Faith

There were communications between the parties concerning the sale of the subject domain name to the Respondent. The Complainant asserts that the Respondent “...offered a transfer consideration of 2 million NT Dollars for an immediate transfer”. It is contended that the Respondent's willingness to transfer immediately is evidence that its assertion that the subject domain name serves the interests of a large group is fictitious.

The Respondent says that the Complainant is misquoting the Respondent's communication and that its communication proposed a “deal” immediately with transfer of the subject domain name “as soon as possible”. The Administrative Panel agrees.

The Respondent stated, “...if your company agrees to the reasonable price I proposed, we transfer the domain name as soon as possible...” In the following paragraph, the Respondent wrote: “[w]e will have a deal immediately if your company is willing to pay NTD 2 million”.

The Respondent asserts that it required some time to inform the users of the website to which the subject domain name resolves and to make alternative arrangements.

The proposal to sell the subject domain name evolved from a number of communications. The Complainant initiated the process. It did not provide a complete package of the communications.

In February 2006, the Complainant contacted the Respondent by e-mail and stated that it wanted to discuss in detail with the Respondent the “issue” concerning the fact that he had registered the subject domain name. The Respondent replied confirming that he was the registrant stating, “...I am not clear what’s ‘this issue’ ”.

The Complainant asked whether the subject domain name, “...is used for company usage, or just been registered and isn’t used at all. Do you want to sell it”. The Respondent replied stating, “[w]e plan to build a website using it”.

The parties then danced around each other as to who would make the first offer. The Complainant proposed NTD 120,000 and the Respondent sought NTD 2 million.

The Administrative Panel reaches no conclusion as a result of the communications concerning a sale of the subject domain name. Although the Complainant states that the Respondent provoked the Complainant into initiating contact by sending rude communications to the Complainant’s business contacts, it is difficult to draw that link on the material presented to the Administrative Panel. No reference is made to it in the communications and the Respondent proffered an explanation for the tone and content of its communications to those who mistakenly contacted the website to which the subject domain resolves.

A disturbing feature in the communications is the absence of any reference by the Respondent to the registration and use of the subject domain name to host people interested in potato chips.

The Complainant asserts that the website to which the subject domain name resolves has been inactive. The Respondent says that it was a test site and that he is using other methods of communication concentrated on the use of e-mail. In this respect, the information provided by the parties is contradictory or charged with innuendo and inferences. A domain name dispute is ill-suited to resolve such matters.

Objectively, it is a fact that the website has remained inactive. The Respondent’s February 24, 2006 communication in the context of the potential sale of the subject domain name stated the he was planning to build a website to use the subject domain name.

On balance, considering all of the information provided by the parties, the Administrative Panel concludes that the Respondent has not been using the subject domain name to host people interested in potato chips. Whether its “use”, which is passive, is in bad faith relates, in part, to the bona fides of its registration.

Again, the information provided by the parties that is relevant to the registration of the subject domain name is contradictory or charged with innuendo and inferences.

The Complainant asserts that its name is unique and is derived from the business it does – microchips – and the first name of its parent – Mosel. The Respondent contends that “chip” refers to potato chips and “mos” derives from the Latin word for more, “mores”.

The Complainant provides statistics to support its contention that it is a well-known and very successful company. The Respondent says that, while the Complainant’s parent may be well-known, the Complainant is known only to those who function in the Complainant’s industry and that they are relatively few in number.

The Respondent says that the subject domain name was selected by him in consultation with other potato-chip lovers, but the Complainant says that, “...the original website built by Respondent appeared to be a commercial service provider’s web page”. The Respondent states that the site was a test-site, but the absence of any reference to potato chips is telling. The Complainant quotes from the Respondent’s homepage: “[w]e are rebuilding our enterprise portal to serve our customers, partners and employees...If you don’t get satisfied service in three days, please call our service center in headquarters”. The Complainant also notes, “...the contact e-mails provided on the web page are titled with “Technical Service” and “Product Info”.

The Administrative Panel has considered and taken into account the fact that the Respondent did not contact or seek to sell the subject domain name to the Complainant prior to the exchange concerning a sale noted above. It is a relevant, but not determinative factor.

It is the conclusion of the Administrative Panel that considering all of the information provided by the parties and their submissions, the registration of the subject domain name was not for the purpose of providing a forum for potato-chip lovers.

Although the Complainant operates in a narrow field of commercial activity, it is very successful and is linked to a parent that appears to be well known. The Complainant and the Respondent both are in Taiwan. The subject domain name is

identical to the relevant part of the Complainant's corporate name.

The Administrative Panel is satisfied that the Complainant has met the requirements of paragraph 4(a)(iii) of the Policy.

Status

www.chipmos.com

Domain Name Transfer

Decision

Based on the information provided to it by the parties and on its findings of fact, the Administrative Panel concludes that the Complainant has established its case.

The Complainant asks that the subject domain name be transferred to it. The Administrative Panel so orders.

Because this case raised many difficult issues of fact and law and involved additional submissions, the Administrative Panel has required more time than is usual to reach a decision. The time for the delivery of the decision is extended to June 22, 2006.

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