



Asian Domain Name Dispute Resolution Centre

hong kong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1400647
Complainant:	PT. Kreatif Media Karya (KMK)
Respondent:	Linyu
Disputed Domain Name(s):	<woi.com>

1. The Parties and Contested Domain Name

The Complainant is PT. Kreatif Media Karya (KMK), of SCTV Tower Floor 14, Jl. Asia Afrika Lot. 19, Jakarta 10270, Indonesia.

The Respondent is Linyu, of Zhen Zhu Wan Ruan Jian Yuan, 316000, Xiamen Shi, Fu Jian, China.

The domain name at issue is <woi.com>, registered by Respondent with eName Technology, of Fujian Xiamen Software Park, No. 19, 603 Wanghai, 361005, China ("Registrar").

2. Procedural History

On 18 September 2014, the Complainant filed the Complaint with the Hong Kong office of the Asia Domain Name Dispute Resolution Centre (the "Centre") in accordance with the Uniform Domain Name Dispute Resolution Policy ("Policy") adopted by the Internet Cooperation for Assigned Names and Numbers ("ICANN") on 24 October 1999.

The Panel notes that the Complainant had previously filed a complaint pursuant to the Policy regarding the Disputed Domain Name on or around 2 September 2014. However, the Complainant had terminated those proceedings, and filed the new Complaint on 18 September 2014. Under the old complaint, the Registrar had verified the name and contact details of the Respondent on 2 and 4 September 2014.

On 22 September 2014, the Centre transmitted by email to the Registrar a request for confirmation that the Disputed Domain Name will be prohibited from being transferred to a third party. On 23 September 2014, the Registrar confirmed by email that the Disputed Domain Name was locked.

The Center verified that the Complaint satisfied the formal requirements of the Policy and the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the

In accordance with paragraphs 2(a) and 4(a) of the Rules, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on 7 October 2014. In accordance with paragraph 5(a) of the Rules, the due date for Response was 27 October 2014. The Respondent did not submit any response. Accordingly, the Center notified the parties of the Respondent's default on 28 October 2014.

The Center appointed Gabriela Kennedy as the sole panelist in this matter on 3 November 2014. 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 Centre to ensure compliance with paragraph 7 of the Rules.

3. Language

Pursuant to paragraph 11 of the Rules, the language of the proceedings shall generally be the language of the registration agreement of the Registrar, "subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding". The Panel notes that the registration agreement in this proceedings is in Chinese. However, the Complaint was filed in English. On 29 September 2014, the Complainant requested that the administrative proceedings be conducted in the English language.

The Panel is of the opinion that for the purposes of equity and efficiency the language of the present proceedings should be English, taking into consideration the lack of objection from the Respondent. The Panel therefore determines under paragraph 11(a) of the Rules that the language of these proceedings be English.

3. Factual background

The Complainant was established on 24 May 2012 in Indonesia, and specializes in online media. It is a subsidiary of PT Elang Mahkota Teknologi ("EMTEK"), which is the parent company of several Indonesian TV channels. The Complainant and EMTEK intended to launch a megaportal to incorporate some of EMTEK's media and e-commerce assets, under the name "woi.com".

The Respondent is an individual based in China.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- (a) The Disputed Domain Name was acquired by the Complainant on 23 May 2013, and was illegally and unlawfully transferred to the Respondent on 12 August 2014. On 12 August 2014 at 08.18 pm, the Complainant received an email from its registrar, GoDaddy, informing them that its account had been

accessed and the information details were changed. At 8.20 pm on the same day, the Complainant received a second email from GoDaddy stating that GoDaddy had received a request to change the status of the Disputed Domain Name to ‘unlocked’. At 10.00 pm, the Complainant tried to log onto its account and discovered that the Disputed Domain Name was no longer accessible. The Complainant discovered that the Disputed Domain Name was no longer registered under the Complainant’s name but had been transferred to Respondent and registered with the new Registrar. The Complainant had never consented to the transfer of the Disputed Domain Name to the Respondent, and this was done unlawfully within the short space of 5 minutes. The Complainant raised this issue with GoDaddy who communicated with the new Registrar, but GoDaddy informed the Complainant that there was nothing either of them could do to assist.

- (b) The Disputed Domain Name is identical to the Complainant's unregistered WOI.COM mark. The Complainant applied for registration of its WOI.COM device mark in Indonesia on 18 August 2014. The Complainant's WOI.COM mark has been allegedly used by the Complainant in the course of its business. EMTEK had decided to launch a megaportal through the use of the Disputed Domain Name in September 2013. Under the Policy, the Complainant can rely on unregistered trade mark rights in order to satisfy the first limb.
- (c) The Disputed Domain Name is inactive. The Respondent does not offer any goods or services under or related to the Disputed Domain Name. There is no evidence to suggest that the Respondent has been commonly known by the Disputed Domain Name. The Respondent’s name (Linyu) and his organization (Xia Men Yi Ming Wang Luo You Xian Gong Si) do not reflect or correspond with the Disputed Domain Name or the WOI.COM trade mark. The Complainant's search at the website www.chinatrademarkoffice.com, shows there is no WOI.COM trade mark registered in China.
- (d) The Respondent is not an authorized representative or partner or even related to the Complainant and the Complainant has never authorized the Respondent to use its WOI.COM trade mark or to authorize the access or transfer of the Disputed Domain Name to the Respondent.
- (e) The Respondent transferred the Disputed Domain Name to himself illegally. The Disputed Domain Name is currently inactive, and the Respondent's intention is to sell the Disputed Domain Name.
- (f) On 20 August 2014, a colleague of the Complainant tried to purchase the Disputed Domain Name from the Respondent. The Respondent replied stating that the Disputed Domain Name was available for sale immediately for the price of RMB 300,000.
- (g) The Complainant’s parent company, EMTEK, is allegedly one of Indonesia’s biggest media business group, and its plan to launch the WOI.COM megaportal was published worldwide. The Complainant submits that the Respondent was aware of this business plan and unlawfully acquired the Disputed Domain Name in order to sell it to the Complainant for profit.

B. Respondent

The Respondent did not file a Response.

The fact that the Respondent has not submitted a Response does not automatically result in a decision in favour of the Complainant. However, the Respondents' failure to file a Response may result in the Panel drawing certain inferences from the Complainant's evidence, and the Panel may accept all reasonable and supported allegations and inferences flowing from the Complainant's submissions as true (see *Entertainment Shopping AG v. Nischal Soni, Sonik Technologies*, WIPO Case No. D2009-1437, and *Charles Jourdan Holding AG v. AAIM*, WIPO Case No. D2000 0403).

5. Findings

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

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

A) Identical / Confusingly Similar

The Complainant applied for the trade mark registration of the mark WOI.COM in Indonesia on 18 August 2014. The application is still pending. The Complainant contends that it has unregistered rights in the WOI.COM mark by virtue of its use of the mark since 2013.

It is well established that the Policy protects rights in unregistered marks (see *Seek America Networks Inc. v. Tariq Masood*, WIPO Case No. D2000-0131; *Imperial College v. Christopher Dessimoz*, WIPO Case No. D2004-0322). However, the question remains as to whether or not the Complainant has unregistered trade mark rights in the WOI.COM mark. As stated in *Imperial College v. Christopher Dessimoz*, WIPO Case No. D2004-0322, common law or unregistered trade mark rights will exist "when a party proves that there is enough goodwill and reputation in and to a name and sufficient association of the same with the party itself".

The Disputed Domain Name had been acquired by the Complainant on 24 May 2013. It was decided by the Complainant's parent company in September 2013 that a megaportal would be established under the WOI.COM mark. According to the Complaint, "the Complainant appreciates that the trademark is still pending the process of registration with the Indonesian authority and at the time when the unlawful transfer of the Disputed Domain Name took place, there was no trademark registered with the authority. As clear from Annexures 3 and 6, the trademark has been used by the Complainant in the course of its business. The Complainant refers to the Dracco Company Ltd. v. NJ Tech Solutions Inc. (Annexure 7), in which the Panel establishes that trade names and product names which are sufficiently proven to be used by the Complainant in the course of its business are

accepted as "they are generally known as the source of goods and services of the Complaint and that they thus qualify as trademarks and are so used" [sic]."

Annexure 6, which is relied on in the Complaint as evidence that the WOI.COM mark "*has been used by the Complainant in the course of business*", is actually labelled as a "mock-up design" for the website to which the Disputed Domain Name was to resolve. The Panel therefore infers from this that the website was never actually launched by the Complainant.

The Complainant also provides copies of service agreements relating to the Disputed Domain Name in support of its assertion that the WOI.COM mark has been used in the course of its business (Annexure 3 to the Complaint). However, the Panel notes that these service agreements are actually for the provision of services by third parties to the Complainant in relation to the Disputed Domain Name, rather than for the provision of services by the Complainant under the WOI.COM mark.

The Complainant also relies on its trade mark application for registration of the WOI.COM mark, which was filed in Indonesia one month prior to the filing of the Complaint. However, it is broadly accepted that a trade mark application by itself is not sufficient to establish rights in a mark. The Panel refers to *24Poker AB v. Jim Bim*, WIPO Case No. D2005-1097 ("[t]here is general agreement among panelists that a trademark application does not establish a trademark right within the meaning of paragraph 4(a)(i)") and also *Koninklijke Nederlandse Springsstoffen Fabriel N.V. v. Kim Hyungho GMM*, WIPO Case No. D2002-0707 ("a trademark application does not establish a trademark right").

As stated in paragraph 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition, in order for a complainant to successfully establish common law or unregistered trade mark rights: *"The complainant must show that the name has become a distinctive identifier associated with the complainant or its goods or services. Relevant evidence of such "secondary meaning" includes length and amount of sales under the trademark, the nature and extent of advertising, consumer surveys and media recognition...a conclusory allegation of common law or unregistered rights (even if undisputed) would not normally suffice; specific assertions of relevant use of the claimed mark supported by evidence as appropriate would be required."*

In light of the above, the Complainant has failed to provide sufficient evidence in support of its assertions. There is no evidence that the WOI.COM mark or the Disputed Domain Name has actually been used by the Complainant in relation to the provision of any goods or services, and no evidence has been provided that the WOI.COM mark or its intention to launch a megaportal was widely publicized.

The Panel is therefore unable to find that the Complainant has generated goodwill in the WOI.COM mark so as to amount to unregistered trade mark rights, i.e. it cannot be said that the WOI.COM mark is "*generally known as the source of goods and services of the [Complainant] and thus qualify as [a] trademark*" (*Dracco Company Ltd. v. NJ Tech Solutions Inc.*, ADNDRC Case No. HK-1400577).

The Panel therefore finds that the Complainant has failed to satisfy paragraph 4(a)(i) of the Policy.

B) Rights and Legitimate Interests

As the Complainant has failed to satisfy paragraph 4(a)(i) of the Policy, the Complaint thus fails and the Panel finds that it does not need to consider the second requirement under paragraph 4(a)(ii) of the Policy.

C) Bad Faith

As the Complainant has failed to satisfy paragraph 4(a)(i) of the Policy, the Complaint thus fails and the Panel finds that it does not need to consider the third requirement under paragraph 4(a)(iii) of the Policy.

The Panel believes it prudent to note that whilst the evidence provided by the Complainant does appear to show that the Respondent acquired and used the Disputed Domain Name in bad faith, the Panel is bound by the Policy, and can only determine a case in favour of the Complainant if **all** three elements of paragraph 4(a) of the Policy are satisfied. Unfortunately, in this case, the Complainant has stumbled at the first hurdle. This decision, however, does not preclude the Complainant from bringing court proceedings against the Respondent.

6. Decision

For the foregoing reasons, the Complaint is denied.

Gabriela Kennedy
Panelist

Dated: 24 November 2014