

Decision for dispute CAC-UDRP-104807

Case number	CAC-UDRP-104807
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Time of filing	2022-08-29 08:50:03
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Domain names	marisilicon.com
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Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)
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Complainant

Organization	Guangdong OPPO Mobile Telecommunications Corp., Ltd.
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Complainant representative

Organization	Xue Li (Thomsen Trampedach GmbH)
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Respondent

Name	Dong Pan
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OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of several trademarks including the term "MARISILICON", such as the European trademark registration "MARISILICON" No. 18323467. At the time the Complaint was lodged, the Complainant adduced in evidence a list of some 30 registrations either active or pending of its trademark "MARISILICON" in many countries including the People's Republic of China.

FACTUAL BACKGROUND

The Complainant is a leading Chinese consumer electronics and mobile communication company known for its smartphones, Blu-ray players and other electronic devices.

It is the largest smartphone manufacturer in China and sponsoring some world-wide sports events. The company is well-known and deeply involved in many electronics users' daily life.

In April 2020, the Complainant published a new strategic plan of producing processor chips, software development and cloud service. Producing processor chips became a core project and the Complainant named the project as "Mariana". Multiple medias have reported the Complainant's strategy.

The Complainant generated the term "MARISILICON" to reflect the "Mariana Silicon" products. The Complainant states that the term

"MARISILICON" is not a general term in any language. From Baidu or Google, searching the term "MARISILICON" gives only results connected to the Complainant.

Later from July 2020, the Complainant started its trademark registration process for "Mariana" and "MARISILICON". The Complainant filed the first "MARISILICON" trademark application no. 49687381 in China on September 11, 2020 which was successfully registered.

The Respondent registered the disputed domain name <marisilicon.com> on September 23, 2020, 12 days after the Complainant first applied for the registration of the trademark "MARISILICON".

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

The disputed domain name is identical to the Complainant's registered trademark "MARISILICON". The disputed domain name, however, was registered before the Complainant's trademark was granted registration but after the Complainant had first applied for the registration of the trademark "MARISILICON".

For the purposes of paragraph 4(a)(i) of the Policy, a complainant has standing to maintain a proceeding if it demonstrates that it "has rights" which the Panel construes the requirement to mean that the Complainant has "rights at the time of filing the complaint" rather than having had them prior to the registration of the disputed domain name. The use of the phrase "has rights" is used in paragraph 4(a)(i) in the present tense. Accordingly, the Panel considers that the right will accrue for registered trademarks and will not be an issue for standing. See WIPO Jurisprudential Overview 3.0, Paragraph 1.1.3.

In any event, the evidence shows that the Complainant's first application for registration of its trademark was made prior to the registration of the disputed domain name. Upon the Complainant's successful registration of its trademark "MARISILICON", the priority date of registration is in the Panel's view to commence from the date of filing of its application for trademark registration, i.e. before the registration date of the disputed domain name. This fact alone distinguishes this proceeding from those cases that involves owners of later acquired trademarks.

When part of a domain name is identical to a well-known trademark, it increases the likelihood of confusion or association between the domain name holder and the trademark owner. It is, therefore, sufficient to establish identity or confusing similarity for the purposes of the Policy. See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0902; *Dr. Ing. h.c. F. Porsche AG v Vasily Terkin*, WIPO Case No D2003-003-0888.

The Complainant contends that the term "MARISILICON" is not a general term in any language. It is a unique, self-created term made by the Complainant and served only for the Complainant's processor chips production. The Panel accepts the Complainant's uncontradicted evidence of its rights in the registered trademark "MARISILICON" in many jurisdictions throughout the world.

It is now a well-established principle in the domain name space that generic top-level domains such as ".com", ".org" or ".net" do not affect the domain name for the purpose of determining whether it is identical or confusingly similar. See, for example, WIPO Case No. D2006-0451, *F. Hoffmann-La Roche AG v. Macalve e-dominios S.A.* It is also not in contention that the addition of the gTLD ".COM" does not change the overall impression of the designation as being connected to the Complainant's trademark. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and its domain names associated.

Accordingly, the Panel finds that the disputed domain name is identical to the Complainant's trademark in which the Complainant has rights and that paragraph 4(a)(i) of the Policy is satisfied.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

A complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP. See WIPO Case No. D2003-0455, *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*

The Complainant makes the following contentions and/or assertions that:

- the Respondent is not a licensee of the Complainant, nor has he been otherwise allowed by the Complainant to make any use of its “MARISILICON” trademark, in a domain name or otherwise;
- the Respondent cannot assert that, prior to having notice of this dispute, he was using, or had made demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services in accordance with paragraph 4(c)(i) of the Policy;
- the Respondent cannot conceivably claim that he is commonly known by the name “MARISILICON” neither can the Respondent assert that he has made or is currently making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue;
- in April 2022, the disputed domain name was redirected to a webpage which only showed a Chinese sentence from a famous Chinese author stating: “Hope is attached to existence, and if there is existence, there is hope. There is hope, there is light. -- Lu Xun”. At the same time, the disputed domain name was listed for sale on Aliyun for 416,802.00 CNY (over 60,000 EUR), and now it is re-directed to a selling page asking for price offering;
- the fact of the sale of the disputed domain name itself is not recognized as a bona fide offering of goods or services.

The Respondent has not filed any administrative compliant response and as such the Complainant's evidence is uncontradicted.

The Complainant's evidence show that the Respondent is seeking to sell for profit the disputed domain name that is identical to the Complainant's trademark “MARISILICON”. There is no evidence that the Respondent has a legitimate business in commercial trading of domain names or otherwise involved in a legitimate business using the disputed domain name.

The Panel is prepared to draw the inference from the Respondent's non-response that he has no right or legitimate interests in the disputed domain name.

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

There are two elements that must be satisfied – registration and use in bad faith.

Registration in bad faith

The disputed domain name was registered on September 23, 2020, which is 12 days after the Complainant first applied for trademark registration in China.

The Complainant asserts that the term “MARISILICON” was generated by it to reflect the “Mariana Silicon” products and is not a general term of language. The Complainant asserts that due to the nature of trademark registration in China, it is not as fast as domain name registration. It asserts that anyone can see the Complainant was applying for the trademark only one week after the submission.

The Complainant asserts the evidence show that it had already been advertising and generating publicity prior to registration of the trademark “MARISILICON” and prior to the registration of the disputed domain name. The Panel accepts that there has been some use “MARISILICON” prior to the registration of the disputed domain name although the extent of the use is less clear.

The Panel, however, accepts that the uncontradicted evidence of the Complainant's success of its processor chips in the electronics industry as well as the Complainant's role and market share to support the Complainant's contention that it is inconceivable that the Respondent did not have knowledge of Complainant's use or intended use of the term “MARISILICON” prior to the Respondent registering the disputed domain name.

Further, the Panel is prepared to draw the inference that the disputed domain name was not randomly chosen by the Respondent given that it is a term that the Complainant asserts that it generated by the combination of the words “Mariana” and “Silicon”.

Accordingly, the logical inference here is that the Respondent has deliberately chosen the disputed domain name to target the Complainant for economic benefit or to obstruct the Complainant from using the disputed domain name to communicate with its customers.

Finally, the Czech Arbitration Court provided written notice of the Amended Complaint to the Respondent (both in the English language and the Chinese language) with no administratively compliant response made in respect to any good faith use of the disputed domain name. The communications also appear to have been returned back undelivered or undeliverable. This conduct, the bona fides of which are clearly left unexplained by the Respondent, is in the Panel's view evidence of bad faith. See WIPO Case No. D2018-0497, StudioCanal v. Registration Private, Domains By Proxy, LLC / Sudjam Admin, Sudjam LLC; Forum Case No. FA 1623939, Citigroup Inc. v. Kevin Goodman.

Accordingly, the Panel finds it is inconceivable that the Respondent would have registered the disputed domain name without being aware of the Complainant's legal rights.

Use in bad faith

The Panel has already referred to the uncontradicted facts set out in the Amended Complaint and accepts the evidence and contention that in April 2022 the disputed domain name was being redirected to a webpage which shows a Chinese sentence from a famous

Chinese author stating: “Hope is attached to existence, and if there is existence, there is hope. There is hope, there is light. -- Lu Xun”.

Further, the Panel accepts the uncontradicted evidence that the disputed domain name was listed for sale on Aliyun for 416,802.00 CNY (over 60,000 EUR) and since July 2022, the disputed domain name was redirected to a selling page requesting a quote.

The Panel observes that the Respondent has not demonstrated any activity in respect of the disputed domain name. Accordingly, it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would be lawful and legitimate.

The Panel finds in this case, from the uncontradicted evidence, that the Respondent's incorporation of the Complainant's trademark “MARISILICON” into the disputed domain name coupled with a webpage with commercial links of sale of the disputed domain name supports the Complainant's contention of registration and use in bad faith.

The Panel, therefore, concludes that the Respondent's holding of the disputed domain name in this case satisfies the requirement that the disputed domain name is being used in bad faith by the Respondent.

Accordingly, the Panel finds that the registration of the disputed domain name and its use was in bad faith.

PROCEDURAL FACTORS

Notification of proceedings to the Respondent

When forwarding a Complaint, including any annexes, electronically to the Respondent, paragraph 2 of the Rules states that CAC shall employ reasonably available means calculated to achieve actual notice to the Respondent.

Paragraphs 2(a)(i) to (iii) set out the sort of measures to be employed to discharge CAC's responsibility to achieve actual notice to the Respondent.

On October 5, 2022 the CAC by its non-standard communication stated as follows (omitting irrelevant parts):

As far as the e-mail notice is concerned, CAC received a notification that the e-mail sent (both in English and Chinese) to postmaster@marisilicon.com was returned back as undelivered. The e-mail notice was also sent to domain@univc.com.

The Panel notes that CAC has been contacted by the Respondent via e-mail messages, but the Respondent never filed administratively compliant response.

The Panel further notes that the proceeding was commenced in the English language and to be determined in the English language. But as the language of the Registration Agreement is in the Chinese language, the Complainant translated the English language Complaint into the Chinese language and filed the same. The Panel, however, observes that the Chinese language version of the English Complaint contains additional matters that do not appear in the English language Complaint. The Panel determined, however, that the English language Complaint contained sufficient information together with the evidence adduced in support for a decision to be made and accordingly proceeded to make the determination on that basis.

Given the reasonable measures employed by CAC as set out in the above non-standard communication, the Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

The Complainant owns the registered trademark “MARISILICON” in several countries which trademark is used in connection with its goods or services. The Complainant first applied for registration of the trademark “MARISILICON” on September 11, 2020 which was subsequently registered but after the registration date of the disputed domain name.

The Respondent registered the disputed domain name on September 23, 2020, 12 days after the Complainant had filed its application to register the trademark “MARISILICON”. The disputed domain name incorporates the Complainant's trademark “MARISILICON” in its entirety.

The Complainant challenges the Respondent's registration of the disputed domain name under paragraph 4(a)(i) of the Policy and seeks relief that the disputed domain name be transferred to the Complainant.

The Respondent has failed to file any administratively compliant response.

For the reasons articulated in the Panel's reasons above, the Complainant has satisfied the Panel of the following:

(a) The Complainant has standing to maintain a proceeding for the purpose of paragraph 4(a)(i) of the Policy as it has rights to the trademark “MARISILICON” as the priority date of its registered trademark precedes the registration date of the disputed domain name. The disputed domain name is identical to the Complainant's trademark “MARISILICON”;

(b) The Respondent has no rights or legitimate interests in respect of the disputed domain name;

(c) The disputed domain name has been registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **marisilicon.com**: Transferred

PANELLISTS

Name	William Lye OAM KC
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DATE OF PANEL DECISION	2022-10-20
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Publish the Decision
