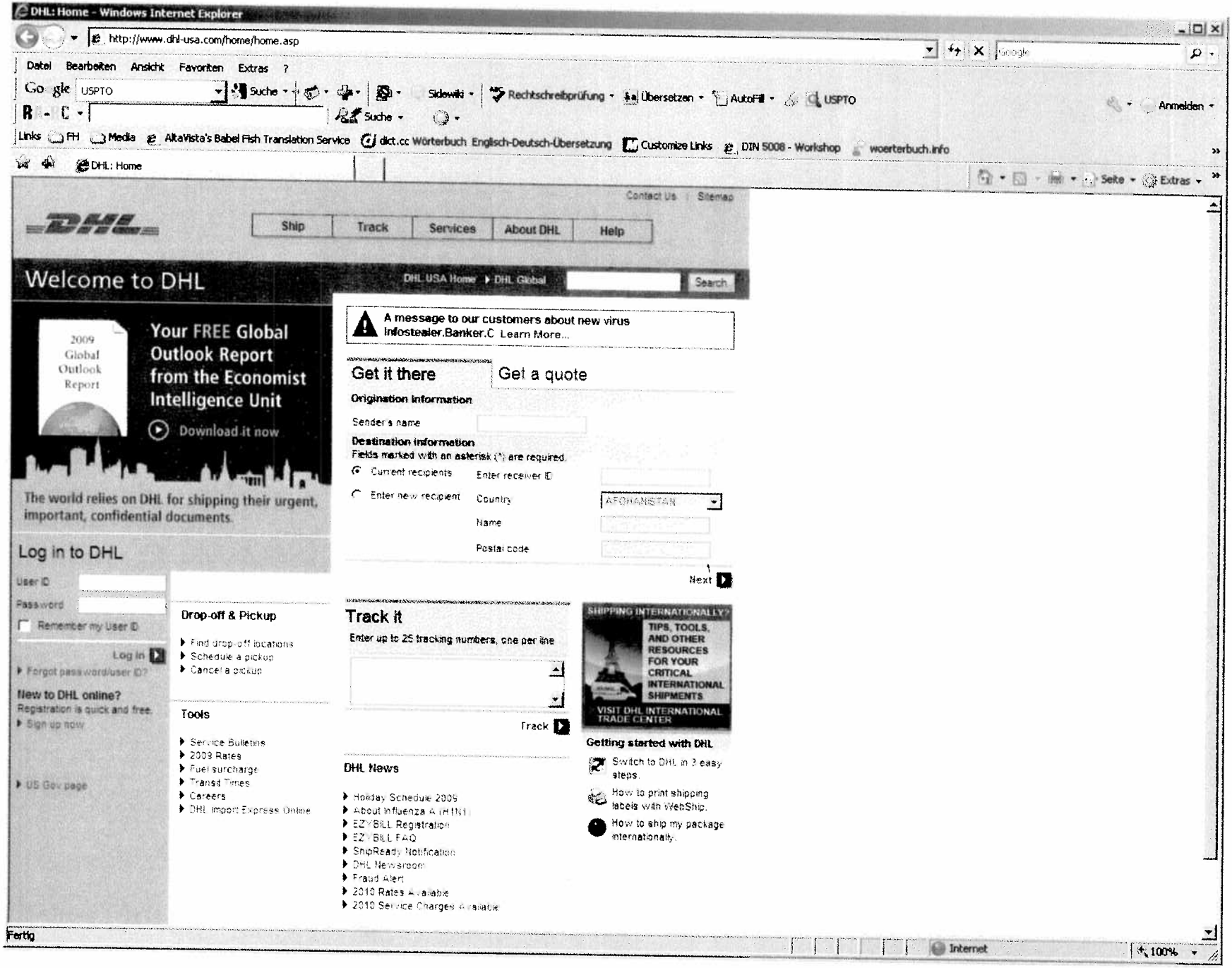
ANNEX 4


DHL: Home - Windows Internet Explorer
http://www.dhl-usa.com/home/home.asp
Datei Bearbeiten Ansicht Favoriten Extras ?
Links FH Media AltaVista's Babel Fish Translation Service dict.cc Wörterbuch Englisch-Deutsch-Übersetzung Customize Links DIN 5008 - Workshop woerterbuch.info
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Get a quote
Origination information
Sender's name
Destination information
Fields marked with an asterisk (*) are required.
Current recipients
Enter new recipient
Enter receiver ID
Country
AFGHANISTAN
Name
Postal code
Next
Log in to DHL
User ID
Password
Remember my User ID
Log in
Forgot password/user ID?
New to DHL online?
Registration is quick and free.
Sign up now
US Gov page
Drop-off & Pickup
Find drop-off locations
Schedule a pickup
Cancel a pickup
Tools
Service Bulletins
2009 Rates
Fuel surcharge
Transit Times
Careers
DHL Import Express Online
Track it
Enter up to 25 tracking numbers, one per line
Track
DHL News
Holiday Schedule 2009
About Influenza A (H1N1)
EZ-BILL Registration
EZ-BILL FAQ
ShipReady Notification
DHL Newsroom
Fraud Alert
2010 Rates Available
2010 Service Charges Available
SHIPPING INTERNATIONALLY?
TIPS, TOOLS, AND OTHER RESOURCES FOR YOUR CRITICAL INTERNATIONAL SHIPMENTS
VISIT DHL INTERNATIONAL TRADE CENTER
Getting started with DHL
Switch to DHL in 3 easy steps.
How to print shipping labels with WebShip.
How to ship my package internationally.
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http://www.dhl-usa.com/solutions/serviceshome.asp?nav=Services

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Suche

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DHL: Services

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» DHL Same Day
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WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

DHL Operations B.V. v. Ali Kazempour

Case No. D2004-1094

1. The Parties

The Complainant is DHL Operations B.V., Amsterdam, Netherlands, represented by Linklaters Oppenhoff & Rädler, Germany.

The Respondent is Ali Kazempour, Ahwaz, Khouzestan, Islamic Republic of Iran.

2. The Domain Name and Registrar

The disputed domain name <dhlmail.com> is registered with OnlineNic, Inc. d/b/a China-Channel.com.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on December 23, 2004. On December 28, 2004, the Center transmitted by email to OnlineNic, Inc. d/b/a China-Channel.com a request for registrar verification in connection with the domain name at issue. On December 29, 2004, OnlineNic, Inc. d/b/a China-Channel.com transmitted by email to the Center its verification Response. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on January 10, 2005. In accordance with the Rules, paragraph 5(a), the due date for Response was January 30, 2005.

On January 26, 2005, the Respondent requested the Center grant an extension of time to file a Response in order to gather, translate and send the documents to the Center from Iran. The Center transferred the request to the Complainant by email asking it to forward its comments by January 27, 2005. The Complainant suggested the Center to refuse such extension arguing that Section 5 of the Rules does not allow an extension of deadline to file a Response. On January 28, 2005, the Center set February 6, 2005, as the date for the submission of a Response by Respondent. The Response was filed with the Center on February 2, 2005.

The Center appointed Nathalie Dreyfus as the sole panelist in this matter on February 10, 2005. 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 Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The disputed domain name <dhlmail.com> was registered on November 21, 2003, with OnlineNic and is currently being held by the Respondent.

The Complainant is DHL Operation B.V., having its place of business in Amsterdam, Netherlands. The Complainant's core business is international transportation of documents and goods. DHL is one of the major logistics brands worldwide as well as the world's largest express provider and involves supply logistics, warehousing, distribution logistics, global airfreight and ocean freight forwarding and European overland transport service. It has business locations all over the world including in the Islamic Republic of Iran, country of the Respondent.

The Complainant is the holder of numerous trademarks worldwide which contain the designation DHL alone or contain this designation as a significant component. The Complainant has filed a representative selection of the details of these registrations from online database searches.

The Complainant and its major subsidiaries own numerous domain names including the trademark DHL such as inter alia <dhl.com>, <dhl.co.uk>, <dhl.de>.

5. Parties' Contentions

A. Complainant

The Complainant has put forth the following legal and factual contentions.

Identical or confusing similarity:

The Complainant considers that the domain name <dhlmail.com> is confusingly similar to the trademark "DHL", to its Company name "DHL" and to the domain names <dhl.com> and <dhl.co.uk>. The Complainant further argues that the suffix ".com" is a technical necessity which lacks any distinctiveness.

The addition of the term "mail" is not appropriate to debar the likelihood of confusion between the domain name in dispute and Complainant's trademark as it is a descriptive term which designates exactly the scope of business of the Complainant.

In addition, on seeing the domain name <dhlmail.com> the public will automatically assume that it belongs to the Complainant. The conjunction of both signs "DHL" and "mail" will accentuate this phenomenon.

Rights and legitimate interests:

The Complainant contends that before the dispute, the Respondent had not been using the domain name in connection with a bona fide offering of goods and services in good faith.

The Respondent was not known under the name <dhlmail.com>.

Besides, the Respondent does not own rights in the name or mark DHL or DHLMAIL. No license has been granted to the Respondent by the Complainant.

Registration and use in bad faith:

At the time of the registration, the Respondent had no legitimate interest in registering the term and there was no business relation between the Complainant and the Respondent. The purpose of the website offering the disputed domain name for sale is clearly to gain a profit. The fact that the website's content has been changed after the cease and desist letter sent by the Complainant asking the Respondent to stop trademark infringement is not relevant (as ascertained in *Harvey Norman Retailing Pty V. gghome.com Pty Ltd.*, WIPO Case No. D2000-0945).

The only reason of the choice of the domain name <dhlmail.com> must have been to force the Complainant to send a purchase offer to Respondent.

The previous and current contents of the website connecting to the domain name have no relation to the meaning of the domain name or the Respondent's name.

B. Respondent

The Respondent replied to the Complainant's contentions by filing a Response on February 2, 2005.

Identical or confusingly similar:

The Respondent argues that the registration of the domain name <dhlmail.com> has been made in accordance with all legal regulations and is in compliance with all ICANN rules.

According to the Respondent, the letters DHL are the abbreviation for Dar Har Lazheh in Persian language. The Respondent intends to establish a non-commercial multilingual website with free service. The website is dedicated to educational issues and teaching letter writing. Thus, the Respondent contends that nobody can claim a right on such abbreviation.

The Respondent also contends that the disputed domain name has never been active for the goods or services designated by the Complainant.

Rights or legitimate interests:

<dhlmail.com> was selected according to Farsi words "Dar Har Lazheh Mail" and therefore declares the Domain Name's non commercial identity and independence from the Complainant.

Registration and use in bad faith

The Respondent never tried to provide commercial services in hosting domain names. The content of the website that Complainant refers to was caused by a problem with its web-hosting provider.

6. Discussion and Findings

According to Paragraph 4(a) of the Policy, the Complainant must prove that:

(i) The domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and

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

(iii) The domain name has been registered and is used in bad faith.

A. Identical or Confusingly Similar

The Panel finds that Complainant has demonstrated that it owns worldwide mark rights to DHL.

The first element that the Complainant must establish is that the domain name is identical or confusingly similar to Complainant's trademark(s). The contested domain name fully incorporates the mark DHL with the addition of the descriptive term "mail".

It is well established that when a domain name incorporates entirely a Complainant's registered mark, with the addition of a descriptive term, this is sufficient to establish that the domain name is identical or confusingly similar for the purposes of the Policy *(Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr.*, WIPO Case No. D2000-1525).

The most distinctive feature of the Complainant's registered mark is the combination of the three letters `DHL', and this distinctive combination of letters is incorporated in its entirety in the disputed domain name.

There have been many UDRP decisions involving domain names where a suffix has been added to a mark, or a name closely resembling a trademark. These suffixes have included the name of a product associated with the trademark (for example, <guinessbeer.com>, *Arthur Guinness Son & Co. (Dublin) Ltd v. Steel Vertigogo*, WIPO Case No. D2001-0020 (March 22, 2001)), a service associated with the trademark (for example, <christiesauction.com>, *Christie's Inc. v. Tiffany's Jewelry Auction Inc.*, WIPO Case No. D2001-0075 (March 6, 2001)), complementary qualities to those associated with the trademark (for example, <viagraconfidential.com>, *Pfizer Inc v. The Magic Islands*, WIPO Case No. D2003-0870 (December 31, 2003)), and many examples of descriptive terms of business organization or modes of distribution (for example, <harrodsdepartmentstores.com> and <harrodsstores.com>, *Harrods Limited v. Peter Pierre*, WIPO Case No. D2001-0456 (June 6, 2001); <armaniboutique.com>, *GA Modefine S.A. v. Mark O'Flynn*, WIPO Case No. D2000-1424 (February 27, 2001)).

The comparison between the disputed domain name and the Complainant's mark reveals the following:

- <dhlmail.com> is composed of the mark "dhl" combined with the generic term "mail".

- The domain name includes the ".com" suffix.

Considering the first point, the Panel finds that the domain name clearly relates to the "DHL" mark, as in the disputed domain name the generic term "mail" is just an addition to the mark DHL.

Moreover, such a generic term is clearly related to the Complainant's activities. Thus, consumers and Internet users will be confused and misled into thinking that the domain name at issue belongs to the Complainant, due to the inclusion of a well-known mark combined with a generic term clearly linked with the Complainant's activities. The abovementioned approach has been taken in many UDRP decisions such as *Dell Computer Corporation v. MTO C.A. and Diabetes Education Long Life*, WIPO Case No. D2002-0363.

Furthermore, such test of confusion must be especially strict when Complainant is the owner of well-known marks. Said risk of confusion does increase in the present case as, according to what has been stated above, the "DHL" marks are notorious all over the world, also where the Respondent resides.

The second difference between the mark "DHL" and the domain name is the inclusion of the ".com" suffix. Such an inclusion is due to the current technical specificities of the domain name system. Therefore, this inclusion should not be taken into account in evaluating the identity or similarity between the disputed domain name and the Complainants' mark (*New York Insurance Company v. Arunesh C. Puthiyoth*, WIPO Case No. D2000-0812 or *A & F Trademark, Inc., Abercrombie & Fitch Store, Inc., Abercrombie & Fitch Trading Co., Inc. v. Party Night, Inc. et al.*, WIPO Case No. D2003-0172).

As a consequence, the Panel considers that the domain name is confusingly similar to the mark "DHL" owned by the Complainant. Therefore, the Panel considers that the condition set out by Paragraph 4(a)(i) of the Policy has been met by the Complainant.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out examples of what a respondent may demonstrate to show that it has rights or legitimate interests in respect of a 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."

The Respondent has demonstrated to the satisfaction of the Panel that its initials are DHL and that he acquired the domain name for letter writing teaching.

Respondent claims to be using "dhlmail" as an acronym for "Dar Har Lahzez Mail". However, when Complainant printed the content found at "www.dhlmail.com" on August 18 and December 14, 2004, no information related to letter

writing as argued by the Respondent in its Response was shown. In its Response, the Respondent provided no evidence of its intention to use the domain name for a bona fide offering of goods and services.

Based on what was submitted by both parties, the Panel finds it improbable that Respondent is using the well-known mark DHL to make a *bona fide* offer for letter writing teaching services. Besides, it is unlikely that Internet users looking for such services would enter 'dhlmail' to find them. It is much more likely that DHL is a target mark for redirecting traffic to Respondent's site.

The Respondent has not used the domain name in connection with a *bona fide* offering of goods or services or in a legitimate non commercial or fair use. Simply copying and pasting a page from another site is not enough to show a *bona fide* offering (*Computer Doctor Franchise Systems v. The Computer Doctor,* FA 95396 (NAF, September 8, 2000), finding that respondent's website, which is blank but for links to other websites, was not a legitimate use of the domain name and *Bank of America Corporation v. Northwest Free Community Access*, FA 180704, NAF, September 30, 2003, stating "Respondent's demonstrated intent to divert Internet users seeking Complainant's website to a website of Respondent and for Respondent's benefit is not a *bona fide* offering of goods or services".

Furthermore, the fact that the Respondent is not currently making any legitimate non commercial or fair use of the domain name as there is no active website but only a page indicating that the web hosting provider encounters problems (Accor v. Accors), WIPO Case No. D2004-0998, leads the Panel to think that Respondent has no legitimate interest in the name. The Panel also notes that the domain name still directs to a webpage both in English and in Persian informing Internet users that Respondent is changing its web hosting provider. There is still no evidence that the Respondent intended to use the above mentioned domain name.

The Panel is of the opinion that there is no relationship between the Respondent and the Complainant and that the Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use Complainant's mark under any circumstance.

The fact that the letters DHL constitute a letter-mark consisting of three letters does not mean that it should be considered as a generic word. It is in line with established international trademark practice to grant protection to trademarks consisting only of non-pronounceable letter combinations.

The acronym "dhl" has no particular connotation which would be generic or descriptive in relation to the business activities or goods and services applied to the above trademark registrations.

The existence of other trademarks consisting of three letter combinations (such as those cited by the Respondent: DHL Analytical and TNT) owned by parties unrelated to the Complainant has no relevance in this case since parallel marks can exist if they cover different goods and services without any risk of confusion, dilution or degeneration. This argument is all the more irrelevant as the domain names cited by the Respondent all correspond to a previous mark.

Consequently, these references do not constitute evidence of any rights or legitimate interests of the Respondent in respect of the domain name.

It is the Panel's opinion that, as in the *Société Française du Radiotéléphone-SFR v. Modern Limited - Cayman Web Development (sfr.org),* WIPO Case No. D2004-0385, "it cannot be argued that the Policy states that "anyone is entitled to register a 3-letter combination" and that Respondent's "legitimate interest" would be "established *per se* at the point of registration since no other party can claim exclusive rights to it". Rather, the Panels should seek (as in these cases cited by the Respondent) whether the effective use of the disputed domain name is a *bona fide* use".

Therefore, the Panel finds that the conditions set out by Paragraph 4(a)(ii) of the Policy has been met by the Complainant.

C. Registered and Used in Bad Faith

For the purpose of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of the domain name in bad faith:

(i) circumstances indicating that the holder has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of the holder's documented out-of-pocket costs directly related to the domain name; or

(ii) the holder has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the holder has engaged in a pattern of such conduct; or

(iii) the holder has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the holder has intentionally attempted to attract, for commercial gain, Internet users to the holder's website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the holder's website or location or of a product or service on the holder's website or location.

It should be noted that the circumstances of bad faith are not limited to the above.

As previously stated by the Panel, the Respondent appears to have no legitimate interest in the domain name.

Besides, the Respondent is aware of the existence of the Complainant as shown by the content of its Response and the particular interest it seems to show in the Complainant's activities and especially regarding the Complainant's merger with Smart Mail & Services and Quik Pak.

Consequently, the Panel is of the opinion that the Respondent registered the domain name <dhlmail.com> with the intent for commercial gain, to divert Internet users and tarnish the mark and the Company's reputation.

It is unlikely that the domain name has been chosen only by chance, without having in mind the well known mark and the trade name of the Company. Other panels have concluded that bad faith may be inferred if the Respondent had actual knowledge of the complainant's mark *TRW Inc. v. Autoscan, Inc.*, WIPO Case No. D2000-0156 (April 24, 2000). Here, it is clear that Respondent had knowledge of Complainant's mark, if only regarding its activities.

Besides, it has been established in certain circumstances that when a domain name incorporates a famous mark comprised of a coined or fanciful term (which is the case for DHL), no other action, aside from registering the domain name, is required for demonstrating bad faith. This is based upon the premise that "it would be difficult, perhaps impossible, for Respondent to use the domain name as the name of any business, product or service for which it would be commercially useful without violating Complainant's rights." *Cellular One Group v. Paul Brien*, WIPO Case No. D2000-0028 (March 10, 2000). The Panel finds an analogous situation in the circumstances of this case, considering that Complainant's name is well known and that Respondent, at the time he registered Complainant's name as a domain name, knew Complainant and was familiar with the commercial potential of Complainant's personal name.

As stated in a previous UDRP cases, the insertion of a disclaimer on the Respondent's website will not prevent it from considering that the disputed domain name is dedicated to attracting Internet users to online pharmacies in the belief that they have some connection with the Complainant's trademark as to source, affiliation or endorsement *Lilly ICOS LLC v. Anwarul Alam / "- -"*, WIPO Case No. D2004-0793.

Therefore, the Panel finds that the conditions set out by Paragraph 4(a)(iii) of the Policy has been met by the Complainant.

7. Decision

For all the foregoing reasons, in accordance with Paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name, <dhlmail.com>, be transferred to the Complainant.

Nathalie Dreyfus
Sole Panelist

Dated: February, 24, 2005

ANNEX 9

WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

DHL Operations B.V. v. zhangyl

Case No. D2007-1653

1. The Parties

The Complainant is DHL Operations B.V., Amsterdam, Netherlands, represented by Jonas Rechtsanwaltsgesellschaft mbH, Germany.

The Respondent is zhangyl, Dongguan, Guangdong, China.

2. The Domain Name and Registrar

The disputed domain name <dhl.name> is registered with OnlineNic, Inc. d/b/a China-Channel.com.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 9, 2007. On November 12, 2007, the Center transmitted by email to OnlineNic, Inc. d/b/a China-Channel.com a request for registrar verification in connection with the domain name at issue. Following a couple of reminders which the Center sent to OnlineNic, Inc. d/b/a/ China-Channel.com, on November 19, 2007, the latter transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 20, 2007. In accordance with the Rules, paragraph 5(a), the due date for Response was December 10, 2007. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 11, 2007.

The Center appointed Francine Tan as the sole panelist in this matter on December 21, 2007. 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 Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is involved in the supply of logistics, warehousing, distribution logistics, global airfreight and ocean freight, project freight forwarding and overland transport services. The Complainant's trading name in short is "DHL". In 2003, the Complainant merged with one of the largest companies in Germany, Deutsche Post AG. The latter was privatized in 1995 after it had held the monopoly in postal services. The DHL brand was further strengthened by Deutsche Post World Net's acquisition in 2005 of Exel, a company which primarily offers transport and logistics solutions for key customers. The Complainant is therefore a recognized global market leader in international express, overland transport, ocean and air freight, and DHL is now one of the major logistics brands worldwide.

One of the Complainant's core business areas is in the international transportation of documents and goods. The Complainant has a business presence in nearly every country worldwide and is widely recognized by the public by the use of its prominent yellow-coloured trucks and airplanes bearing the sign "DHL".

The Complainant and its affiliated companies own numerous trademarks worldwide (including China in which the Respondent is located) which consist of or contain the designation "DHL". These trademarks relate, *inter alia,* to the provision of various services, namely transportation of documents, goods and parcels by land, sea and air, express courier services, packaging, storage of goods in depots, delivery of goods, freighting, shipping, customs brokerage services and the forwarding of cargo. The marks are also registered in respect of goods such as sacks for transporting packages and documents, cardboard and paper boxes used for packaging, adhesive labels, stationery, cardboard tubes and envelopes, wall hangings such as maps, posters and calendars, and promotional clothing.

The Complainant's affiliate companies also own various domain names which include the mark "DHL". The domain <dhl.com> is registered by the Complainant's parent company, Deutsche Post AG. This website has links to the different DHL country sites. In China, the Complainant operates in various business locations which can be seen on its official website at "www.cn.dhl.com".

The Complainant sent the Respondent a cease and desist letter on June 20, 2007 but the latter did not respond.

5. Parties' Contentions

A. Complainant

The Complaint is based on the following:

(1) The domain name is identical and/or confusingly similar to the Complainant's trademarks, domain names and company names.

It is commonly accepted that generic top level domains such as ".name" or ".com" do not add any distinctiveness to the domain name as they are required simply for the registration of the domain name. Therefore, the generic top level domains should not be taken into account in assessing the identity or similarity between the disputed domain name and the Complainant's marks. The disputed domain name consists entirely of the Complainant's trademark "DHL" and Internet users would be confused and misled into thinking that the domain name <dhl.name> belongs to the Complainant.

(2) The Respondent has no rights or legitimate interests in respect of the disputed domain name, and this is supported by the following facts:

(a) Before the Complainant became aware of the Respondent's registration of the disputed domain name, the Respondent had not been using either the domain name or any similar name in connection with a *bona fide* offering of goods or services.

(b) At that time, neither the Respondent nor any other entity unconnected to the Complainant was generally known by the domain name <dhl.name>.

(c) Neither the Respondent nor any other entity unconnected to the Complainant used the disputed domain name for any legitimate, non-commercial or fair purpose.

(d) The Respondent does not own any rights in the name or mark "DHL". The Complainant has not licensed or otherwise permitted the Respondent to use its company name or trademark to apply for the registration of the domain name in dispute. The Respondent cannot therefore be considered to have any legitimate interest in the name "dhl".

(3) The domain name was registered and is being used in bad faith, as evidenced by the following:

(a) Neither the Respondent nor any other person unconnected to the Complainant had a legitimate interest in

registering the domain name <dhl.name>.

(b) The Complainant's trademarks, domain names and company name "DHL" have been widely used by the Complainant for many years and are thus well known throughout the world. It is therefore inconceivable that the registration for the disputed domain name was made without the knowledge of the existence of the Complainant and its trademarks. Several UDRP panel decisions have stated that bad faith may be inferred from the registration of a well-known mark. (See *The Caravan Club v. Mrgsale*, NAF Case No. FA95314; *DHL Operations B.V. v. Ali Kazempour*, WIPO Case No. D2004-1094; *Axel Springer AG v. AUTOBILD.COM*, WIPO Case No. D2005-0554.)

(c) The Respondent failed to respond to the Complainant's cease and desist letter. An inference can be made from this that the registration and use of the domain name has been in bad faith. (See NFL *Properties, Inc. et al. v. BBC Ab*, WIPO Case No. D2000-0147.)

(d) The Respondent's use of the disputed domain name with the intention to attract Internet users to his website by creating a likelihood of confusion with the Complainant's "DHL" trademarks.

The most obvious evidence of bad faith registration and use can be found in the fact that the website at "www.dhl.name" is an imitation and virtual copy of the Complainant's official website. The colours, logos, style, design and pictures on the Respondent's website are identical to those used on the Complainant's website.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy stipulates that the Complainant has to prove that:

(i) The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

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

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

The Respondent has in this case failed to submit a Response. The Panel shall therefore decide this case on the basis of the Complainant's assertions and draw such inferences as it considers apt pursuant to paragraph 14(b) of the Rules.

A. Identical or Confusingly Similar

In this case, the Complainant has indeed shown that it owns rights in the mark "DHL".

The only difference between the domain name and the mark "DHL" is the inclusion of the ".name" suffix. It is well-established in many panel decisions that suffixes such as ".com", ".org" or ".net" should not be taken into account when considering the issue whether a domain name is identical or confusingly similar to a trademark. The relevant portion of the domain name to be considered is therefore only "dhl".

Accordingly, the Panel finds that the domain name is identical to the Complainant's mark "DHL".

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out how one may demonstrate one's rights or legitimate interests in a domain name, namely, as follows:

(i) before any notice of this dispute, the Respondent used, or demonstrably prepared to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services;

(ii) the Respondent has been commonly known by the domain name, even if it has not acquired any trademark or service mark rights; or

(iii) the Respondent is making a legitimate non-commercial or fair use of the domain name, without intent for

commercial gain to misleadingly divert customers or to tarnish the trademark.

For the purposes of paragraph 4(a)(ii) of the Policy, it is sufficient for the Complainant to show a *prima facie* case, after which the burden of proof is shifted onto the Respondent. However, in this case, the Respondent failed to respond to the Complaint or participate in these proceedings. The Respondent would presumably be in the best position to prove that it has a legitimate interest in the domain name, but has failed not only to refute the Complainant's assertions but has also failed to respond to the Complainant's cease and desist letter.

On the other hand, what has been submitted by the Complainant indicates that the Respondent's website is an imitation of the Complainant's website. It can be inferred therefore that the Respondent had knowledge of the Complainant's trademarks when it registered the domain name. The Panel is of the view that the choice of the domain name cannot be easily explained away and therefore finds that this is a case of misappropriation of the Complainant's trademark. The circumstances are such that the Panel cannot but conclude that the Respondent has no right or legitimate interest in the domain name; the Respondent's website is misleading and Internet users would be led to believe that the website is that of the Complainant.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy identifies a list of circumstances which, if found to be present, shall be evidence of bad faith registration and use. Of these, the Panel considers that the following are present in this case:

(i) the Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(ii) by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location.

The Panel agrees with the position taken in earlier panel decisions that the registration of a domain name that is obviously connected with a well-known trademark by someone who has no connection whatsoever with the trademark suggests opportunistic bad faith. (See, for instance, *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.,* WIPO Case No. D2000-0163.)

In this case, the Respondent very likely knew of the Complainant's trademark and reputation in the relevant industry and took advantage of this with a view to disrupt the Complainant's business and/or to attract Internet users to its website for commercial gain. There can be no plausible explanation whatsoever for the Respondent's choice of domain name and manner in which the website at "www.dhl.name" was presented.

The actions of the Respondent appear clearly to be deliberate and the Panel therefore has no difficulty in concluding that the domain name was registered and is being used in bad faith.

7. Decision

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name, <dhl.name> be transferred to the Complainant.

Francine Tan
Sole Panelist

Dated: January 10, 2008

ANNEX 10

WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Ferrero S.p.A. v. Mr. Jean-François Legendre

Case No. D2000-1534

1. The Parties

The complainant in this administrative proceeding is Ferrero S.p.A. ("Complainant"), a joint-stock company, incorporated under the laws of Italy with its registered office at Via Maria Cristina 41, 10025 Pino Torinese, Turin, Italy.

The respondent is Mr. Jean-François Legendre ("Respondent"), an individual having its address at 32 rue de Lappe, 75011 Paris, France.

2. The Domain Name and Registrar

The domain names at issue are <mynutella.org> and <mynutella.net> ("Domain Names"), registered with Network Solutions, Inc. ("Registrar" or "NSI") of 505 Huntmar Park Drive, Herndon, VA 20170, USA.

3. Procedural History

A complaint, pursuant to the Uniform Domain Name Dispute Resolution Policy implemented by the Internet Corporation for Assigned Names and Numbers ("ICANN") on October 24, 1999, ("Policy") and under the Rules for Uniform Domain Name Dispute Resolution Policy implemented by ICANN on the same date ("Rules"), was submitted to the World Intellectual Property Organization Arbitration and Mediation Center ("WIPO Center") on November 8, 2000, by e-mail and was received on November 13, 2000, in hardcopy.

The Acknowledgement of Receipt of Complaint was submitted to the Complainant by the WIPO Center on December 14, 2000.

On November 27, 2000, a Request for Registrar Verification was transmitted to the Registrar, which confirmed with its Verification Response of December 1, 2000, that the disputed Domain Name was registered with NSI, that Respondent was the current registrant of the name, that NSI's Service Agreement

Version 5.0 was in effect and that the registration was in active status.

The assigned WIPO Center Case Administrator completed a Formal Requirements Compliance Checklist without recording any formal deficiencies.

A Notification of Complaint and Commencement of Administrative Proceeding ("Commencement Notification") was transmitted to the Respondent on December 14, 2000, setting a deadline as of January 2, 2001, by which the Respondent could file a Response to the Complaint.

On January 2, 2001, the WIPO Center received a Response by e-mail and the hard copy was received on January 10, 2001. On January 10, 2001 the WIPO Center confirmed the receipt with an Acknowledgement of Receipt (Response).

Both, Complainant and Respondent had requested a one-member panel. Consequently, the WIPO Center invited Bernhard F. Meyer-Hauser to serve as Sole Panelist in this proceeding, and transmitted to him a Statement of Acceptance and Request for Declaration of Impartiality and Independence.

Having received the Statements of Acceptance and Declarations of Impartiality and Independence from the Panelist, the WIPO Center transmitted to the parties on February 8, 2001 a Notification of Appointment of Administrative Panel and Projected Decision Date. The projected decision date was February 22, 2001. On February 14, 2001 the WIPO Center informed the parties by e-mail that the Panel decided not to consider further submissions in the present case.

The Panel finds it was properly constituted and appointed in accordance with the Policy, the Rules and the WIPO Supplemental Rules.

4. Factual Background

Complainant is the holder of the trademark "Nutella" in numerous countries all over the world. As examples, Complainant supplied the following registration details:

- US trademark registration no. 855,647, registered on August 27, 1968, (renewed on August 27, 1988);

- UK trademark registration no. 864485, renewed on March 11, 1999;

- Canadian trademark registration no. TMA157,098, registered on February 13, 1998;

- Italian trademark registration no. 794464 renewed on November 29, 1999;

Respondent is the registered owner of the Domain Names <mynutella.org> and <mynutella.net>, which are at the center of this dispute.

5. Parties' Contentions

A. Complainant

Complainant contends:

- that the Domain Names are confusingly similar to the trademark "Nutella";

- that in no way Respondent may not have been aware of the famous trademark "Nutella", and registration may only have occurred in bad faith;

- that Respondent's project of a real-time yearbook and the use of the software Gnutella cannot be a justification or a legitimate interest for using the Domain Names;

- that the alleged assignment of the Domain Names to a company called Jeff Consulting, Inc., controlled by Respondent, has not been recorded with Network Solutions;

- that Respondent has no connection with the Gnutella software and that he registered at any rate "mynutella" not "mygnutella";

- that Respondent's lawyers informed Complainant, that each Domain Name is on sale for approx. one million dollar;

- that the request of one million dollars for each Domain Name is the core message of the letter and is evidence of bad faith. The very first WIPO decision under the Policy (D99-0001 *World Wrestling Federation v. Bosman*, January 14, 2000), found that "attempts to sell the domain name for consideration in excess of [Respondent's] investment of time and money relative to the domain name constitutes "use" of the domain name in bad faith".

Consequently, Complainant requires the transfer of the Domain Names registrations to Complainant.

B. Respondent

Respondent contents:

- that Complainant failed to mention all evidence in support of its Complaint (e.g. a letter dated September 18, 2000, e-mails dated September 27, 2000, and phone messages of various telephone conversations).

- there is a flagrant difference between Complainant's trademark and the Domain Names and, therefore, Respondent's Domain Names are not identical or confusingly similar to Complainant's trademark

- that Complainant has already registered more than 20 domain names for the trademark Nutella according to the pattern www.nutella-....(something), which is directly and easily to find for Internet users looking for Complainant's web site.

- that Respondent filed the disputed Domain Names in order to use them for the development of his real-time directory which is based on the Gnutella protocol. Gnutella is a name for a technology and is neither a company nor a particular application. As the Gnutella protocol is openly published, there are many interoperable "servants" to choose, for example the Gnutella protocol is called Newtella, Gnotella, Gutella, Ntella, Mtella. Gnutella protocol has tremendous potential for free exchange of information and it is considered as a possible successor to Napster.

- that Respondent is developing a real time yearbook (works on a peer to peer network) using Gnutella protocol and therefore has a legitimate interest in using the Domain Name.

- that the Domain Names were not filed to prevent the Complainant from using its name (Nutella) as a domain name. The Complainant has many sites with this name, in consequence the registration of the Domain Names cannot prevent the Complainant from reflecting the trademark in a corresponding domain name.

- that Complainant has not demonstrated the existence of any hindrance to its activities and so a legitimate

right in the disputed Domain Names.

- that the filing and use of the Domain Names cannot disturb the Complainant's commercial operations under any circumstances since it operates in the food sector, specifically marketing food products, while the Respondent is developing a real-time directory.

- that at no time Respondent has attempted to attract Internet users to his site for profitable purposes.

- that Respondent did not make any approach to sell or hire to third parties the Domain Names.

- that the amount requested for the Domain Names was justified based on the investments of time and money of Respondent to develop his real time yearbook.

- that Complainant and its advisers have never replied to the Respondent's letters, telephone calls or e-mails.

- that Complainant has challenged the existence of Jeff Consulting Inc., an American company created the Respondent. These doubts and allegations are unjustified.

- that - if the Gnutella protocol and all the interoperable servants harm Complainant's business, it would be impossible to use or file a domain name containing a name that has already been filed.

All the above points demonstrate that the Domain Name is not identical or similar to Complainant's marks and Respondent has a legitimate interest in the Domain Name and that Respondent has acted in good faith.

6. Discussion and Findings

In a letter dated September 27, 2000, to Complainant, Respondent's lawyers contended that the Domain Names have been assigned to Jeff Consulting Inc. and that Respondent is not anymore the holder of the Domain Names. Implicitly, he raises the question of Respondent's standing.

However, the contention that the Domain Names have been assigned to Jeff Consulting, Inc., a company allegedly controlled by Respondent, is in no way proven by Respondent. Moreover, Respondent's allegation of an assignment is not supported by the facts. Quite to contrary, the Verification Response of NSI dated December 1, 2000, confirmed that Respondent is and at that time was the actual holder of the Domain Names. Furthermore, while mentioning the alleged assignment in its Response in early January, Respondent failed to explicitly deny standing to be sued. Thus, the Panel finds that the alleged transfer of the Domain Names from Respondent to Jeff Consulting, Inc. does not have any impact on these proceedings whatsoever.

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

(i) 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*

(ii) that the Respondent has no rights or legitimate interests in respect of the Domain Name; *and*

(iii) that the Domain Name has been registered and used in bad faith."

Identical or confusingly similar Domain Name: Policy 4(a)(i)

The Domain Names at issue are <mynutella.org> and <mynutella.net>. These Domain Names are composed by the words "my" and "Nutella". "Nutella" is - uncontested by the parties - a famous, widespread, well-known trademark, held by Complainant. The word "Nutella" has a strong significance as a trademark and a considerably important force of identification of the corresponding products.

The combination of an existing name (i.e. a trademark) with a possessive pronoun (such as "my" or "your") does not basically change the significance of the existing name as such in the combined expression. The added prefix "my" has, both grammatically and phonetically, an inferior distinctive importance compared to the principal component of the word; the term "my-Nutella" is clearly dominated by its principal component "Nutella".

In addition, it is a popular marketing strategy to combine the name of a product or service with the add-on formative "my..." or "your...", to create a personal identification of consumers with the product or service involved. This is especially common for Internet sites which can be personalized by the users according to their own interest and desire (e.g. "my.yahoo.com", my.netscape.com", "My Excite"). The prefix "my" plus a famous trademark in a domain name refers evidently to a special service in connection with that trademark.

The Panel therefore cannot support the contention that there is a "flagrant difference" between the Domain Names and the trademark "Nutella", as maintained by Respondent. From the point of view of ordinary consumers and Internet users - as well as from an objective viewpoint -, the Domain Names are *confusingly similar* to Complainant's trademark and the distinctive element of the Domain Names and Complainant's trademark are *identical*.

Respondent's Rights or Legitimate Interests in the Domain Name: Policy 4(a)(ii)

Respondent claims to have a legitimate right or interest in the Domain Names because he is allegedly developing a real-time directory using the Gnutella protocol.

Gnutella is an open, decentralized peer-to-peer file sharing application which functions both as a search engine and a file server. By this technology, users can search for and share files of all types by interacting directly with one another.

Obviously, Gnutella and Nutella are not the same words (even if they might be pronounced similarly in certain languages). Each of these words has a different individualizing meaning for different products. Since words are not generally verbalized on the Internet, the written form of a domain name is relevant as to the impression and perception of Internet users. In the written form, "Gnutella" and "mynutella" are clearly different."

Computer programmers may have a factual interest in identifying their programs as Gnutella-based programs. However, in order to characterize his project, Respondent could either use the word "Gnutella" or another distinctive modification of that word (such as the examples enumerated by Respondent). But it is not justified or legitimate to associate the name and trademark "Nutella" which is a famous product with a similar name instead. The use of the Gnutella technology does not create a *legitimate interest* in respect of the Domain Names in the sense of the Policy.

As Respondent agrees, Gnutella is not a trademark nor a company name, but a designation of a technology. It has, therefore, a lower level of legal protection than a registered trademark.

In addition, the Panel notes that Respondent's contention that the Gnutella technology may be the successor of Napster is not a very convincing argument to support Respondent's position. Using Gnutella technology does neither create a *right* nor a *legitimate interest* of Respondent in the use of the trademark "Nutella".

Domain Name Registered and Used in Bad Faith: Policy 4(a)(iii)

a. Offer to sale the Domain Names

According to the Policy Paragraph 4(b)(i), the following circumstance (among others) is deemed to provide evidence of bad faith in registering and using the Domain Names:

"(i) circumstances indicating that you [Respondent] have registered or you [Respondent] have acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to the Complainant who is the owner of the trade mark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of your documented out-of-pocket costs directly

related to the Domain Name.

In the letter dated September 27, 2000, Respondent's representatives wrote:

"Mon client semble cependant prêt à vendre ces deux noms de domaines dans le cadre d'une valorisation équitable qui devra tenir compte du travail déjà opéré, des investissements, de l'utilisation, de l'usage de ces noms deux noms domaine. Compte tenu de l'ensemble de ces éléments, nous estimons le prix de chacun des noms de domaine à environ un million de dollars."

Which may be translated as follows:

"However, my client seem ready to sell the two domain names if fairly valued, taking into account the work already performed, the investments, the utilization, the use of the two domain names. Considering all these elements we estimate the prize for each of the domain names to approximately one million dollars.""

This is a clear indication of an intent to sell the two Domain Names for approximately USD one million each.

In connection with the adequacy of this sales prize both parties have quoted the Administrative Panel Decision *World Wrestling Federation v. Bosnan* (WIPO Case No. D1999-0001). The Panel of that decision found, in accordance with the Policy, that the offer to sell a Domain Name "for valuable consideration in excess of any out-of-pocket costs directly related to the domain name" constitutes a bad faith use. The consideration of the "investment of time and money" for determination of the value of a domain name was not mentioned in the Panel's considerations, and even if it were, the Panel sees no evidence for the alleged equivalent costs of Respondent. The amount of USD 1 Million seems clearly exaggerated.

Respondent's contention that he did not offer the Domain Names to third parties is not relevant in this context. He made an offer to Complainant, which is sufficient evidence for bad faith according to the Policy.

b. Attracting Internet users by creating a likelihood of confusion

Paragraph 4(b)(iv) sets forth another circumstance, which is to be considered as evidence of a registration and use of a domain name in bad faith:

"(iv) by using the Domain Name, you [Respondent] have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or your location."

The Panel concurs with Complainant's statement that it is inconceivable Respondent was not aware of the trademark "Nutella" when registering the Domain Names. By intentionally choosing the famous name and trademark "Nutella" (plus the prefix "my") to denominate his real-time yearbook project, he at least accepted the result that the Domain Names are associated with Complainant's marks. He also accepted the risk that *Internet users will be attracted* to Respondent's site by Complainant's famous name.

It is irrelevant for the Panel that Complainant and Respondent seem to operate in different fields of business. An Internet user, clicking on a link to the Internet site "mynutella.org /.net" expects a web Site of Complainant and not a site relating to Respondent's real-time yearbook.

In the light of the above, the Panel finds that the registration and the use of the Domain Names by Respondent was not carried out in good faith.

7. Decision

In view of the circumstances and facts discussed above, the Panelist decides that the disputed Domain Names are confusingly similar to the registered trade mark in which the Complainant has rights, that the

Respondent has no rights or legitimate interests in respect of the Domain Names, and that the Respondent's Domain Names has been registered and are being used in bad faith.

Accordingly, pursuant to paragraph 4(i) of the Policy, the Panelist requires that the disputed Domain Names:

<mynutella.org>

and

<mynutella.net>

shall be transferred to the Complainant.

Bernhard F. Meyer-Hauser
Sole Panelist

Dated: February 22, 2001

ANNEX 11

WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Axel Springer AG v. AUTOBILD.COM

Case No. D2005-0554

1. The Parties

The Complainant is Axel Springer AG, Berlin, Germany, represented by Linklaters Oppenhoff & Rädler, Germany.

The Respondent is AUTOBILD.COM, Jack Tubul, Gdynsk, Poland.

2. The Domain Name and Registrar

The disputed domain name <autobild.com> is registered with Tucows.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 25, 2005. On May 26, 2005, the Center transmitted by email to Tucows a request for registrar verification in connection with the domain name at issue. On May 26, 2005, Tucows transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the administrative, billing, and technical contact. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on June 2, 2005. In accordance with the Rules, paragraph 5(a), the due date for Response was June 22, 2005. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 23, 2005.

The Center appointed Massimo Introvigne as the Sole Panelist in this matter on July 4, 2005. 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 Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

Complainant is one of the largest European publishing houses. It publishes, *inter alia*, the daily German newspaper *Bild*, with a circulation of more than 3 million copies, and a whole line of magazines whose names include the word "Bild", including *AutoBild*, a well-known magazine specialized in cars. AUTO BILD is registered as a trademark by Complainant in several jurisdictions, including as a European Community trademark (No. 00092411) and in Poland (No. 92626). All these trademark registrations pre-date the registration of the domain name <autobild.com> by Respondent. The domain name <autobild.com> is being used for redirecting Web users to MegaGo.com, a Web directory (which may or may not pay Respondent for the redirection).

5. Parties' Contentions

A. Complainant

Complainant argues that:

(a) The domain name <autobild.com> is virtually identical to the name of Complainant's magazine *AutoBild* and to Complainant's trademark registrations for AUTO BILD.

(b) Respondent has no rights or legitimate interests in respect of the domain name. Its only activity carried out under the domain name is the redirection to MegaGo.com.

(c) The domain name has been registered in bad faith. *AutoBild* is a well-known magazine and Respondent may not have happened to pick the name by coincidence. The re-direction to MegaGo.com shows that Respondent "makes no sensible use" of the domain. The Respondent, however, requested 85,000 euros for selling the domain name, and this is evidence enough of bad faith under the Policy.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

There is no question that the domain name <autobild.com> is identical to the name of Complainant's magazine *AutoBild* (which, in this Panel's opinion, would be entitled to protection even in the absence of trademark registrations), and virtually identical to Complainant's registered trademarks AUTO BILD.

B. Rights or Legitimate Interests

Respondent has not answered Complainant's claim that he has no rights or legitimate interests in the domain name. Even if MegaGo.com pays Respondent for the linking, which is not impossible, such activity would not create a "legitimate interest" in the domain name. Respondent may have an "interest" at stake, but this would not be "legitimate", since it would simply take advantage of the fact that Internet users looking for a website connected with Complainant's magazine are "captured" by Respondent and redirected to a commercial Web directory. On this point as well, Complainant prevails.

C. Registered and Used in Bad Faith

That the domain name was registered in bad faith may be argued from the fact that *AutoBild* is an internationally well-known magazine and it is extremely unlikely that Respondent has just selected the name by mere chance. On use, Complainant argues that Respondent "makes no sensible use" of the domain name, and relies almost exclusively on the alleged request of 85,000 euros, indeed an "outstanding" sum, for claiming bad faith. A request of 85,000 euros may perhaps be enough to find in favor of Complainant, but the context of the correspondence is not completely clear, nor does Annex 6 to the Complaint clearly confirms the Complainant's version of the facts. However, this Panel does not believe that there is no actual use of the domain name. Redirection to a commercial directory is a form of use, which as mentioned earlier, occasionally allows the domain name owner to make some money. MegaGo.com is a large operation which offers research services and sponsored links in a wide variety of fields, including gambling, pornography and escort services. The redirection to MegaGo.com is, in view of this Panel, a form of use in bad faith. It is a use Respondent cannot control, it is a form of commercial use, and at any rate it is likely to direct users attracted by the domain name and by the fame of Complainant's magazines to a variety of websites and services, some of them

in fields they may have objections to and/or likely to disparage the reputation of Complainant's trademark. Complainant, accordingly, prevails on the bad faith issue.

7. Decision

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name, <autobild.com>, be transferred to the Complainant.

Massimo Introvigne
Sole Panelist

Dated: July 6, 2005

ANNEX 12

WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Robert Bosch GmbH v. Gurol Yardimci

Case No. D2005-0147

1. The Parties

The Complainant is Robert Bosch GmbH, Germany, Gerlingen-Schillerhöhe, Germany, represented by Matthias Mann, Verl, Germany.

The Respondent is Gurol Yardimci, Derence-Kocaeli, Turkey.

2. The Domain Name and Registrar

The disputed domain name <mybosch.com> is registered with Tucows.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on February 9, 2005. On February 9, 2005, the Center transmitted by email to Tucows a request for registrar verification in connection with the domain name at issue. On February 10, 2005, Tucows transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the administrative, billing, and technical contact. In response to a notification by the Center that the Complaint was administratively deficient on February 16, 2005, the Complainant filed an amendment to the Complaint on March 3, 2005. The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 16, 2005. In accordance with the Rules, paragraph 5(a), the due date for Response was April 5, 2005. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 6, 2005.

The Center appointed Peter Burgstaller as the sole panelist in this matter on May 2, 2005. 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 Center to ensure compliance with the Rules, paragraph 7.

The language of the administrative proceeding is English.

4. Factual Background

The Complainant asserted, and provided evidence (Annexes 2 – 9) in support of, and the Panel finds established, the following facts:

The domain name at issue was registered on October 21, 2003, by the Respondent with Tucows.

The Complainant is an international well-known company with its focus amongst other things on automotive technology, industrial technology as well as technique for durable goods and buildings.

The Complainant is the owner of the community trademark "BOSCH", registered for the classes 7, 9, 11, 12, 20, 35, 36, 38, 39, 41 and 42 on June 26, 2000. The Complainant has also registered the sign "BOSCH" as trademark with the Turkish patent office.

The Complainant sent a warning letter on November 3, 2004, to the Respondent, requesting that it transfer amicably the domain name at issue to the Complainant – without success.

5. Parties' Contentions

A. Complainant

The disputed domain name <mybosch.com> is confusingly similar to the trademark "BOSCH" in which the Complainant has rights, the mere prefix "my" not being a distinguishing feature.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has not authorized the Respondent, granted any license or otherwise permitted the Respondent to use its trademarks for any domain name incorporating the registered trademarks. The Respondent has moreover no prior rights or legitimate interests in the disputed domain name.

The disputed domain name was registered and is being used in bad faith by the Respondent. There are circumstances indicating that the disputed domain name was registered primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the owner of the trademark or service mark, for valuable consideration in excess of the domain name registrant's out-of pocket costs directly related to the Domain Name. The Respondent's email of November 24, 2004 (Annex 7) leads to the conclusion that the Respondent waits for an offer made by the Complainant to buy the Domain Name.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

To make out a successful Complaint, it is the Complainant's burden to prove under paragraph 4(a) of the Policy that:

(i) the domain name at issue is identical or confusingly similar to a trade mark or a service mark in which Complainant has rights; and

(ii) Respondent has no rights or legitimate interests in respect of the domain name; and

(iii) the domain name has been registered and is being used in bad faith.

The Complainant must prove that each of these three elements is present, even though the Respondent did not reply.

A. Identical or Confusingly Similar

The letters "my", to an English language reader, introduce the concept of possessiveness. That which is possessed is the letters that follow, namely "Bosch", which is the Complainant's trademark. The addition of the letters "my" has the effect of focusing the reader's attention on the Complainant's trademark. Accordingly, the Panel considers that a reader of the Domain Name would be confused into thinking that the Domain Name is associated with the Complainant; the prefix "my" even tends to compound the confusion (see e.g. *Sony Kabushiki Kaisha also trading as Sony Corporation v. Sin, Eonmok*, WIPO Case No. D2000-1007; *Ferrero S.p.A. v. Mr. Jean-Francois Legendre*, WIPO Case No. D2000-1534).

Regarding the top level domain ".com", this Panel follows the principle which applies to UDRP cases, that the addition of a gTLD does not affect the confusing similarity or identity between the domain name and the trademark.

The Panel therefore finds that the Complainant fulfills paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

As mentioned above, no response has been filed and the Respondent has not alleged any facts or elements to justify prior rights and/or legitimate interests in the disputed domain name.

Proper analysis of paragraph 4(a)(ii) involves a shifting of the burden of proof from the Complainant to the Respondent. Although the Complainant first has the burden to make a *prima facie* case that Respondent has no rights or interests in the domain name, if it does so, the burden of proof then shifts to the Respondent to offer demonstrative evidence of his rights or legitimate interests; however the burden of proof first remains on the Complainant (see e.g. *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. D2000-0270). This "burden shifting" is appropriate given that paragraph 4(c) of the Policy, which is entitled "How to Demonstrate Your Rights to and Legitimate Interests in the Domain Name in Responding to a Complaint," discusses the kind of evidence a Respondent should provide to show that it has rights to or legitimate interests in the domain name. The burden of proof, however, does not shift as the Policy makes clear that "the complainant must prove that each of these three elements are [sic] present." Policy, paragraph 4(a).

The statements/contentions of the Complainant along with the rest of the evidence in the record, are for this Panel sufficient to make out a *prima facie* showing of Respondent's lack of rights or legitimate interests in the disputed domain name. The Panel, therefore, follows the Complainant's contentions that the Respondent is not in any way related to the Complainant's business, that the Respondent is not one of the Complainant's agents and does not carry out any activity for, or has any business with it. Moreover, it does not appear that the Respondent has any other connection or affiliation with the Complainant; for example, the Complainant has never given any authorization to the Respondent to make any use of its trademark in order to acquire the domain name at issue.

Furthermore, the Respondent has not been known under the disputed domain name.

Accordingly, the Panel finds that the Complainant has satisfied the burden of proof with respect to paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists certain factors which, if found by the Panel to be present, shall be evidence of registration and use of a domain name in bad faith. This is not an exclusive list, and includes:

"(i) circumstances indicating that you [the Respondent] have registered or you have acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location."

The Respondent is the Registrant of the domain name in dispute, registered with Tucows in 2003. Because of the fame of the trademark BOSCH and the Complainant's worldwide activities, it is the Panel's conviction that, when registering the domain name at issue, the Respondent knew of the existence of the Complainant's trademarks. This conviction is supported by Annex 7, where the Respondent states: "Yes, I know much about Robert Bosch GmbH as most people do".

Moreover, it is a popular and well-known marketing strategy to combine the name of a product or service with the add-on formative "my..." or "your..." to create a personal identification of consumers with the product or service involved. This is especially common for Internet sites; the prefix "my" plus a famous trademark in a domain name refers evidently to a special service in connection with that trademark (see e.g. *Ferrero S.p.A. v. Mr. Jean-Francois Legendre*, WIPO Case No. D2000-1534; *Sony Kabushiki Kaisha also trading as Sony Corporation v. Sin, Eonmok*, WIPO Case No. D2000-1007).

The Panel, therefore, believes that the disputed domain name was registered in bad faith, because the domain name, which is composed of the Complainant's famous trademark with the prefix "my" evokes an association with the Complainant and its products/services. It is reasonable to conclude that only someone who was familiar with the mark and what it stands for would register the domain name at issue.

The Panel moreover concludes, from the information given in Annex 7 by the Respondent, that it has registered and is using the domain name at issue for the purpose of selling, renting or otherwise transferring the domain name registration to the Complainant for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name. Even though the Respondent states "Not For Sale" regarding the domain name at issue (Annex 9), the following facts nonetheless lead the Panel to that conclusion:

- The Respondent explains its bad (especially) financial situation without any reason to do so (Annex 7).

- The Respondent states: "...I will not sell it someone else who has no right to use it although I need money so much" and "Now, it is so valuable for me and as I see for Robert Bosch GmbH." (Annex 7)

- The Respondent asks for contacts on its website under the headline "MYBOSCH.COM", although the Respondent does not inform about anything else than the domain name at issue (Annex 9).

Given the widespread use and notoriety of the trademark BOSCH and taking into account that the Respondent has given no evidence, whatsoever, of any actual or contemplated good faith use by it of the disputed domain name (it even failed to submit a response), and that the Complainant sought an amicable solution of this matter (without success), and given the facts set out in Annexes 7 and 9 to the Complaint, it is fairly difficult to conceive of any plausible actual or contemplated use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law.

Taken together, these facts are compelling enough for the Panel to find that the domain name <mybosch.com> was registered and is being used by the Respondent in bad faith according to paragraph 4(a)(iii) of the Policy.

7. Decision

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name <mybosch.com> be transferred to the Complainant.

Peter Burgstaller
Sole Panelist

Date: May 5, 2005

ANNEX 13

JONAS

RECHTSANWALTSGESELLSCHAFT MBH
JONAS VIEFHUES HAMACHER WEBER

By E-mail: ejwhite@inetconnect.com
and Facsimile: 001 717 417 3344

Mr.
Eric White
108 N 2ND ST,
Wrightsville, Pennsylvania 17368
USA

Hohenstaufenring 62
50674 Cologne, Germany
P. O. Box 26 01 20
50514 Cologne, Germany
Telephone +49 (0)221 27758-0
Direct Line +49 (0)221 27758-223
Facsimile +49 (0)221 27758-1
jonas@jonas-lawyers.com
www.jonas-lawyers.com

Your Ref.

Our Ref. 1682/09 KJ-GE/TT (please always quote)

December 23, 2009

Dear Mr. White

Domain Name Registration "mydhl.com"

We herewith inform you that we advise and represent DHL Operations B. V., The Netherlands, and its parent company Deutsche Post AG, Germany, in trademark and competition law matters.

As your are certainly aware, our client's DHL group is the global market leader in international express, overland transport and air freight. It is also the world's no. 1 on ocean freight and contract logistics. Our clients and their subsidiary companies are owners of worldwide trademark registrations for "DHL", registered for several goods and services in international classes 06, 12, 16, 20, 35, 36, 37, 38, 39 and 42. Databank excerpts for several US, UK, Community and International (with extension of protection to USA) trademark registrations for "DHL" are exemplarily enclosed for your information.

Furthermore, our clients are proprietor of the internationally protected company name "DHL" as well as of various domain name registration including the designation "DHL", such as "dhl.com", "dhl.net", "dhl.info", "dhl.name" or "dhl-usa.com".

The aforementioned trademarks, domain names and company name "DHL" have been widely used by our client throughout the world for many years and are thus well-known to large sectors of the general public.

D21/3310

Accordingly, in UDPR case DHL Operations B.V. v. Ali Kazempour, Case No. D2004-1094 - dhlmail.com - the WIPO panel stated that

> *"the "DHL" marks are notorious all over the world".*

Recently, our clients had to notice that you have registered the domain name

"mydhl.com"

with the registrar GoDaddy.com, Inc., although you have not been granted any authorization or license neither to register nor to use the domain name.

Through the use and registration of the domain name "mydhl.com" you are impairing the exclusive rights of our clients to the aforementioned trademarks and company names. Any unentitled use of the aforementioned designations takes unfair advantage of, and is detrimental to the repute of the well-known trademark as well as of the company name "DHL". Internet users will undoubtedly be misled into thinking that the domain name "mydhl.com" leads to our client's internet presence, in particular, since the further element "my" is merely descriptive.

In this context, we would like to draw your attention to several decisions of the WIPO Arbitration and Mediation Center confirming that our clients are the sole legitimate holders of the well-known marks "DHL" so that the unentitled registration of domain names for "DHL" must be deemed as a registration in bad faith. For example, in WIPO decision case No. D2004-1094 of 24 February 2005, the panel found bad faith arguing that

> *"it has been established in certain circumstances that when a domain name incorporates a famous mark comprised of a coined or fanciful term (which is the case for "DHL"), no other action, aside from registering the domain name is required for demonstrating bad faith".*

Therefore, in the aforementioned case the panel ordered the contested domain name "dhlmail.com" to be transferred to our clients. The same conclusion was drawn in many other decisions such as WIPO case No. D2007-1653 - "dhl.name", No. D2006-0520 - "dhlcorporateship.com" et al., No. D2005-0868 - "wwwdhl.com" or No. D2006-1426 - "dhlgermany.com" where the panel held that

> *"the notoriety of Complainant's trademark shows that Respondent must have been aware of Complainant's trademark at the time of registration and use of the said domain name." [...] The confusion created by the domain name at suit may disrupt the Complainant's business.*

The same applies to the present case. For the reasons set out above, in the name and on behalf of our clients we request you to refrain from using the domain name "mydhl.com" and to transfer the domain name "mydhl.com" to our client DHL Operations B.V. For this purpose, please alter the status of the domain name to "Active" and provide us (by e-mail) with the respective authorization code (AuthCode) for the implementation of the domain name transfer. Your domain name provider can inform you about the AuthCode.

We await your response no later than

30 December 2009, 12.00 CET.

Otherwise, we will have to initiate the necessary legal steps in order to preserve our client's intellectual property rights. Should you be of the opinion that you are for any reasons entitled to the use/registration of the domain name "mydhl.com", please notify us accordingly.

We hope for your understanding and cooperation.

Yours sincerely

Gabriele Engels
Attorney-at-Law

Attachments

Tanja Traude

Von: Tanja Traude
Gesendet: Mittwoch, 23. Dezember 2009 17:08
An: 'ejwhite@inetconnect.com'
Cc: Gabriele Engels
Betreff: Domain Name Registration "mydhl.com"

Wichtigkeit: Hoch

Anlagen: mydhl.com.pdf; DHL trademarks I.pdf; DHL trademarks II.pdf

Dear Mr. White:

mydhl.com.pdf (104 KB)

DHL trademarks I.pdf (1 MB)

DHL trademarks II.pdf (638 KB)...

Yours sincerely

i. A. **Tanja Traude**
Assistant, Intellectual Property

JONAS Rechtsanwaltsgesellschaft mbH
Hohenstaufenring 62
50674 Köln / *Cologne, Germany*
Tel. +49 (0)221 27758-0
Dir. +49 (0)221 27758-220
Fax +49 (0)221 27758-1
traude@jonas-lawyers.com
www.jonas-lawyers.com

Amtsgericht Köln, HRB 59300
Geschäftsführer: Kay Uwe Jonas, Dr. Martin Viefhues, Karl Hamacher, Dr. Nils Weber

********** -KOMM.BERICHT- ********** DATUM 23-DEZ-2009 ** UHRZEIT 17:39 ********

MODUS = SPEICHER-ÜBERTRAGUNG START=23-DEZ 16:43 ENDE=23-DEZ 17:39

DATEI-NR.=137

STN NR.	KOMM.	ZIELWAHL / KURZWAHL	NAME/ E-MAIL-ADRESSE/ RUFNUMMER	SEITEN	DAUER
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-JONAS RA GMBH -

***** UF-8100 v2 ********** -BUERO KOELN - ***** - +49 221 27758 1- *********

JONAS

RECHTSANWALTSGESELLSCHAFT MBH
JONAS VIEFHUES HAMACHER WEBER

By E-mail: ejwhite@inetconnect.com
and Facsimile: 001 717 417 3344

Mr.
Eric White
108 N 2ND ST,
Wrightsville, Pennsylvania 17368
USA

Hohenstaufenring 62
50674 Cologne, Germany
P. O. Box 26 01 20
50514 Cologne, Germany
Telephone +49 (0)221 27758-0
Direct Line +49 (0)221 27758-223
Facsimile +49 (0)221 27758-1
jonas@jonas-lawyers.com
www.jonas-lawyers.com

Your Ref.

Our Ref. 1682/09 KJ-GE/TT (please always quote)

December 23, 2009

Attorneys-at-Law:

Kay Uwe Jonas * **
Dr. Martin Viefhues * **
Karl Hamacher *
Dr. Nils Weber * **
Katja Grabienski **
Dr. Markus Robak
Hanna Karin Held **
Jana Bogatz
Gabriele Engels, LL.M.

* Managing Director
** Certified Specialist in Intellectual Property Law

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Amtsgericht Köln
HRB 59300

Dresdner Bank AG
Account No.:
0 472 777 000
Bank Code:
370 800 40

SWIFT CODE:
DRESDEFF370
IBAN:
DE58 3708 0040 0472 7770 00

D21/3310