



Brasileiro vence coreano em disputa por domínio na web

13/08/2005

O coreano Neo Jung deve transferir o domínio **www.mangels.com** para a empresa de autopeças brasileira Mangels. A ordem foi expedida pelo Centro de Mediação e Arbitragem da Ompi — Organização Mundial de Propriedade Intelectual, de Genebra, Suíça.

O coreano registrou e usou de má-fé o nome de domínio com marca registrada pela empresa. O objetivo dele era vender, alugar ou transferir o registro do nome de domínio para o titular da marca ou para um concorrente, por um valor superior aos custos relativos ao registro e manutenção do nome de domínio.

O domínio foi registrado pelo coreano em 1º de junho de 2001. Entre junho de 2001 e fevereiro de 2005 tinha como única mensagem que o domínio estaria à venda por US\$ 3 mil. A partir de fevereiro de 2005, a mensagem dizia não ter como recuperar o conteúdo.

A indústria brasileira que já possui a marca registrada Mangels consolidada no mercado contratou o escritório **Newton Silveira, Wilson Silveira e Associados — Advogados** para tentar reaver o domínio no Centro de Mediação e Arbitragem da Ompi, o órgão de arbitragem para questões envolvendo domínio “.com”.

Segundo o advogado **Newton Silveira** foi alegada a ilegitimidade de se utilizar o nome da marca no nome de domínio, já que o coreano não tem autorização das indústrias para usar a marca. E que, o titular do nome do domínio estava agindo de má fé, porque registrou o domínio com o único intuito de vender, alugar ou transferir por um preço elevado.

De acordo com o árbitro da Ompi, Thomas P. Pinansky, é de conhecimento geral que usar a marca de terceiros para registrar domínios sem prévia autorização constitui transgressão. E que, mesmo que ele não tivesse conhecimento da marca, há provas de que o coreano só registrou o domínio com o objetivo de comercializar.

Para Pinansky, se o nome do domínio não tivesse sido registrado com o propósito de vender, alugar ou transferir o registro, o coreano já teria tido tempo de criar seu website. “A manutenção do website vazio e inativo é como uma mancha na reputação da marca da Mangels e constitui a conduta de má fé confirmada.” diz o árbitro.

Para a Ompi, a lei de registro de domínio é clara em dizer que a compra de um nome de domínio com o principal propósito de oferecer para venda, aluguel ou transferência do nome por uma quantia excessiva demonstra a má fé, violando o parágrafo 4º da regulamentação do órgão americano.

Diante dos fatos, o árbitro decidiu que o registro deve ser transferido para a indústria, que possui a marca e que investiu seus negócios na marca registrada, já que o coreano tem provas insuficientes para demonstrar a sua legitimidade à posse do nome do domínio.

**Case No. D2005-0598****Leia a íntegra da decisão**

WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Mangels Indústria e Comércio Ltda., Mangels Industrial S/A v. Eweb

Case No. D2005-0598

1. The Parties

The Complainants are Mangels Indústria e Comércio Ltda. and Mangels Industrial S/A, both of São Paulo, Brazil, represented by Newton Silveira, Wilson Silveira e Associados – Advogados, Brazil.

The Respondent is Eweb, C/O Mr. Neo Jung, Suseong-gu, Daegu, Republic of Korea.

2. The Domain Name and Registrar

The disputed domain name (the “Domain Name”) is registered with Korea Information Certificate Authority Inc. d/b/a DomainCa.com.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 8, 2005. On June 10, 2005, the Center transmitted by email to Korea Information Certificate Authority Inc. d/b/a DomainCa.com a request for registrar verification in connection with the domain name at issue. On June 10, 2005, Korea Information Certificate Authority Inc. d/b/a DomainCa.com 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.

On June 16, 2005, in accordance with the Rules, paragraph 11, the Center informed the Complainants that absent an agreement by the parties regarding language, the administrative proceeding should be in the language of the domain name registration agreement, which here is Korean. The Complainants responded with numerous reasons to accept the Complaint in English on June 17, 2005. The Center decided to accept the Complaint in English. 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 21, 2005. In accordance with the Rules, paragraph 5(a), the due date for the Response was July 11, 2005. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s

default on July 15, 2005.

The Center appointed Thomas P. Pinansky as the sole panelist in this matter on July 22, 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

(a) Mangels Group was founded on October 1, 1928, by German immigrants Max H. H. Mangels Jr. and Heinrich Kreutzberg. Nowadays, Mangels Group employs more than 1,700 people. The Complainants' core businesses are steel, cylinders, wheels and galvanizing. Given its internationally recognized standards of quality, the Complainants' products are exported to Latin America, Middle East, Africa, the Caribbean and Europe.

(b) The Complainants are the original applicants and owners of the trademark "MANGELS" (the "mark") in Brazil and numerous other countries, including the Republic of Korea. The mark is registered in numerous different classes and copies of the Complainants' available registration certificates are provided in Annex G of the Complaint.

(c) Mangels Indústria e Comércio Ltda. is the holder of the ccTLD domain names since August 30, 1996, and since February 23, 2000 (Annex A of the Complaint).

5. Parties' Contentions

A. Complainants

The Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainants have rights (Policy, para. 4(a)(i), Rules, paras. 3(b)(viii), (b)(ix)(1)).

(a) The Domain Name is identical to the Complainants' registered trademarks and to the root of their companies' names.

(b) Internet users may perhaps assume that the owner of is associated or affiliated with or sponsored by the Complainants, which is not true.

The Respondent has no rights or legitimate interests with respect to the Domain Name (Policy, para. 4(a)(ii), Rules, para. 3(b)(ix)(2)).

(a) Despite the fact that the Domain Name has been registered since June 1, 2001, between June, 2001 and February, 2005, the only message that appeared was "The domain is for SALE!".

(b) After February 4, 2005, the message that appeared, when trying to access the Domain Name, is that it could not be retrieved.

(c) The Complainants have never licensed the use of the trademark "MANGELS" to the Respondent or assigned the trademark to the Respondent for any purpose. There was never any involvement and/or relationship between the Respondent and the Complainants.



The Domain Name was registered and is being used in bad faith (Policy, paras. 4(a)(iii), 4(b); Rules, para. 3(b)(ix)(3)).

(a) It is common knowledge that the use of a trademark by third parties without previous authorization constitutes infringement. The Respondent never asked for consent from the Complainants.

(b) The Respondent has registered the Domain Name intentionally in the most common and wanted generic top-level domain.

(c) Mr. Neo Jung, the administrative, technical and billing contact of the Respondent, registered at least one other domain name in bad faith. See *Wild West Domains, Inc. v. Neo Jung*, WIPO Case No. D2004-0243.

(d) At the time of the Domain Name registration, the Respondent knew that such conduct would prevent the Complainants from reflecting the trademark “MANGELS” in a corresponding domain name, in order to persuade the Complainants or any other third party to enter into negotiation for the transfer of the Domain Name for a price.

(e) The printout of Register.com search shows that the Domain Name is for sale.

(f) If the Domain Name had not been registered for the purpose of selling, renting or otherwise transferring the domain name registration, it is obvious that the Respondent would already have used or registered the trademark “MANGELS” and would have a website created prior to the present date, which in fact was not done. See *BellSouth Intellectual Property Corporation v. Jaclyn Thoms*, WIPO Case No. D2001-1409.

(g) The registration and use of the Domain Name with the trademark “MANGELS” was done in bad faith by the Respondent.

(h) The maintenance of an empty and inactive website is likely to tarnish the reputation of the Complainants’ trademark, constituting obstructive conduct done in bad faith, as confirmed in *Telstra Corporation v. Nuclear Marshmallows*, WIPO Case No. D2000-0003.

(i) Considering the facts mentioned above, the Respondent registered the Domain Name for the purpose of selling, renting, or otherwise transferring the Domain Name registration to the Complainants, who are the owners of the trademark, for valuable consideration in excess of his documented out-of-pocket costs.

B. Respondent

The Respondent did not reply to the Complainants’ contentions.

6. Discussion and Findings

A. Selection of Language

The Complaint was filed in the English language. It is noted that the language of the registration agreement for the Domain Name is Korean, however the Complainants assert that

English should be the language of the proceeding.

According to Paragraph 11 of the Rules, the language of the administrative proceeding shall be the language of the registration agreement unless the Panel decides otherwise. The spirit of Paragraph 11 is to ensure fairness in the selection of language by giving full consideration to the parties' level of comfort with each language, the expenses to be incurred and possibility of delay in the proceeding in the event translations are required and other relevant factors.

In the present case, the registration agreement for the Domain Name was made in the Korean language. However, it is apparent from the written communications exchanged between the parties that the Respondent has sufficient ability communicating in the English language.

On the other hand, the Complainants are not able to communicate in Korean and therefore, if the Complainants were to submit all documents in Korean, the proceeding will be unduly delayed and the Complainants would have to incur substantial expenses for translation. Therefore, in consideration of the above circumstances and in the interest of fairness to both parties, the Panel decides, under Paragraph 11 of the Rules, that (i) English shall be the language of the administrative proceeding in this case, but on the condition that (ii) to the extent that the Respondent would have submitted any documents or assertions in Korean, such documents or assertions would have been considered by the Panel. The Respondent did not reply to the Complainants' contentions. See *Groupe Industriel Marcel Dassault, Dassault Aviation v. Mr. Minwoo Park*, WIPO Case No. D2003-0989.

B. Substantive Elements of the Policy

Paragraph 15(a) of the Rules instructs the Panel to decide the Complaint on the grounds of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Moreover, under paragraph 14(b) of the Rules, it is established that: "If a Party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, these Rules or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate."

In light of the above, the Panel may draw such inferences from the Respondent's failure to comply with the Rules as the Panel considers appropriate (see paragraph 14(b) of the Rules; see *Talk City, Inc. v. Michael Robertson*, WIPO Case No. D2000-0009).

Under paragraph 4(a) of the Policy, the Complainants must prove each of the following:

- (i) the Domain Name is identical or confusingly similar to the Complainants' trademark or service mark; 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.

C. Identical or Confusingly Similar

The Complainants' mark "MANGELS" is registered throughout the world. The Domain Name wholly incorporates the Complainants' distinctive mark and as such creates sufficient similarity to be confusingly similar (see paragraph 4(a) of the Policy).

Therefore, the Panel finds that the Domain Name is confusingly similar to the Complainants' mark pursuant to the Policy paragraph 4(a)(i).

D. Rights or Legitimate Interests

According to paragraph 4(a)(ii) of the Policy, the Complainants must prove that the Respondent has no rights or legitimate interests in the Domain Name. In connection with the burden of proof, several past UDRP decisions have held that "once a Complainant establishes prima facie evidence showing that none of the three circumstances establishing legitimate interests or rights applies, the burden of production on this factor shifts to the Respondent to rebut the showing" (see among others, *Universal City Studios, Inc. v. David Burns and Adam-12 Dot Com*, WIPO Case No. D2001-0784; see also *International Hospitality Management-IHM S.p.A. v. Enrico Callegari Ecostudio*, WIPO Case No. D2002-0683).

The Complainants have asserted that the Respondent has no relationship with or authorization from the Complainants to use their mark; the Panel notes that there is nothing in the record to suggest that the Respondent has been commonly known by the Domain Name; the Panel further notes that the Respondent has not, and has never been, commonly known by the Domain Name. The Panel's view is that these facts must be taken as proven provided that they have not been denied by the Respondent.

The Respondent has not submitted a proper response. Therefore, he has failed to invoke any circumstance that could have demonstrated any rights or legitimate interests in the Domain Name under paragraph 4(c) of the Policy. Accordingly the Panel holds that the Respondent has no legitimate interests or rights in the Domain Name pursuant to paragraph 4(b) of the Policy.

E. Registered and Used in Bad Faith

The Complainants contend that the Respondent registered and is using the Domain Name in bad faith in violation of the Policy paragraph 4(a)(iii). The Policy paragraph 4(b) sets forth four nonexclusive criteria for a complainant to show bad faith registration and use of domain names. One such criteria which indicates bad faith, listed under paragraph 4(b)(i), includes "circumstances indicating that you 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". As set forth above, the Complainants contend that the Respondent has violated paragraph 4(b)(i) of the Policy, thus establishing bad faith.

The law is clear that registering a domain name for the primary purpose of offering to sell, rent, or otherwise transfer the domain name for an amount in excess of the registration cost is evidence that a domain name was registered and being used in bad faith. *Adidas-Saloman AG v.*

Vincent Stipo, WIPO Case No. D2001-0372 (May 14, 2001). The Panel finds that the Complainants have adequately supported the inference that the Respondent's actions satisfy the "intent to sell" requirement of Paragraph 4(b)(i). The Respondent advertised the domain as being for sale for a period of time on the website and asked the Complainants for USD 3,000 as compensation for the Domain Name, which is an amount greater than the out-of pocket costs of registering and establishing the Domain Name.

Bad faith can also be presumed based on the fame of the Complainants' marks, such that the Respondent was aware or should have been aware of the Complainants' marks and claims of rights thereto.

The conduct described above falls squarely within paragraph 4(b)(vi) of the Policy and accordingly the Panel concludes that the Respondent registered and used the Domain Name in bad faith.

In light of the above, the Panel concludes that the Complainants have proven bad faith in registration and use of the Domain Name on the part of the Respondent.

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 be transferred to the Complainant, Mangels Indústria e Comércio Ltda.

Thomas P. Pinansky

Sole Panelist

Dated: July 28, 2005

Fonte: https://conjur.jumps.com.br/2005-ago-13/brasileiro_vence_coreano_disputa_dominio_web/