

ADMINISTRATIVE PANEL DECISION

Firmenich SA v. Bak J-seon

Case No. D2022-2949

1. The Parties

The Complainant is Firmenich SA, Switzerland, represented by Inlex IP Expertise, France.

The Respondent is Bak J-seon, Republic of Korea.

2. The Domain Names and Registrar

The disputed domain names <dsm-firmenich.com> and <dsmfirmenich.com> are registered with HANGANG Systems Inc. dba Doregi.com (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on August 10, 2022. On August 10, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On August 11, August 22, and August 25, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

On August 24, 2022, the Center notified the Parties in both English and Korean that the language of the registration agreement for the disputed domain names is Korean. On August 25, 2022, the Respondent requested for Korean to be the language of the proceeding. On the same day, the Complainant requested for English to be the language of the proceeding.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), 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 and 4, the Center formally notified in English and Korean the Respondent of the Complaint, and the proceedings commenced on August 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 18, 2022. The Respondent did not submit any response. On September 23, 2022, the Center informed the Parties of the Commencement of Panel Appointment Process.

The Center appointed Andrew J. Park as the sole panelist in this matter on October 12, 2022. 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, Firmenich SA, is a private Swiss company in the fragrance and flavor business. It is one of the largest privately owned companies in the field. The Complainant has created perfumes for over 125 years and produced a number of well-known flavors. DSM, a Dutch company specializes in nutritional ingredients for food and feed with proven world-leading bioscience capabilities and an international network of high-quality manufacturing sites. It provides materials that are used across multiple medical specialties and has transformed, during its 150-year history, into one of the global leaders in the areas of health, nutrition, and bioscience. On May 31, 2022, DSM and the Complainant announced that they have entered into a business combination agreement for a leading entity in nutrition, beauty, and well-being.

The Complainant owns various national and International trademark registrations for FIRMENICH worldwide. (e.g. International trademark No. 636881, registered on April 27, 1995). The Complainant promotes its trademarks worldwide with official websites under the domain name <firmenich.com> which was registered on April 23, 1996 and hundreds of other domain names that are identical to the FIRMENICH trademark such as <firmenich.ch>, <firmenich.fr>, and <firmenich.cn>, etc.

On August 25, 2022, the Complainant submitted a request for English to be the language of the administrative proceedings, and on the same day, the Respondent requested for Korean to be the language of the proceedings.

The disputed domain names <dsnfirmenich.com> and <dsm-firmenich.com> were registered on May 31, 2022. Both disputed domain names resolve to similar parking pages, which include the text “Coming Soon” in English and Korean. The website at the disputed domain name <dsm-firmenich.com> includes the Respondent’s email and a disclaimer in English “welcome” and “[t]his site has no relations with such company DSM or Firmenich”.

5. Parties’ Contentions

A. Complainant

1. The Complainant, following the filing of the Complaint with the Center, requested that the language of proceeding be in English, providing three main reasons.

- (a) The content of the parking page to which the two disputed domain names resolve is partially in English, which demonstrates the Respondent’s knowledge of English.
- (b) The Respondent was involved in at least one other UDRP proceeding which was conducted in English.
- (c) Both disputed domain names are in Latin characters and not in Korean.

2. The Complainant contends that the disputed domain name should be transferred to the Complainant because:

- (a) the disputed domain names are confusingly similar to the Complainant’s trademarks in which the Complainant has rights. The Complainant claims that its trademark FIRMENICH is purely descriptive of the type of its business. It is used only in relation to fragrance, cosmetic products, soaps essential oils and flavor. The disputed domain names are confusingly similar to the Complainant’s trademarks, corporate name and domain names that are composed of the Complainant’s trademark. Furthermore, there is a

heightened likelihood that the disputed domain names will cause confusion given the notoriety of the Complainant as one of the largest privately owned companies in the fragrance and flavor business and ranked number two worldwide.

(b) the Respondent has no rights or legitimate interests in the disputed domain names. The Complainant claims that the Respondent who has no connection whatsoever to the Complainant, lacks any rights or legitimate interests in the disputed domain names because (i) the Respondent does not own a trademark including FIRMENICH, (ii) the Respondent is not linked to the Complainant nor its business in any manner nor does it act on its behalf, (iii) the Complainant has not given any authorization to the Respondent to use the trademark FIRMENICH as part of the disputed domain names, and (iv) the Respondent has not been commonly known by the disputed domain names. The Complainant claims that the Respondent is intentionally attempting to use the reputation of the Complainant and therefore has no rights or legitimate interests in the disputed domain names.

(c) the disputed domain names were registered and are being used in bad faith. First, the Complainant claims that the Respondent has acquired and registered the disputed domain names in bad faith. The Complainant officially announced the merger with DSM on May 31, 2022, and the disputed domain names were registered on the same day. The fact that the Respondent, who had no relationship with the Complainant nor DSM at all, registered the disputed domain names on the same day as the Complainant and its partner, DSM, announced its business combination, evidences that the Respondent had full knowledge of the Complainant's business and status in detail and registered the disputed domain names which are confusingly similar to the Complainant's famous and widely known trademarks in bad faith.

Second, the Complainant emphasizes that the Respondent's passive holding of the disputed domain names can constitute a finding of bad faith. The Respondent provides no evidence of any actual or contemplated good faith use with the disputed domain names and took active steps to hide its contact details by registering the disputed domain names using a false address and phone number. There is no doubt that the Respondent registered the disputed domain names with the intent to make a profit by taking advantage of the Complainant's reputable business and its trademarks.

Finally, the Complainant states that the Respondent currently holds approximately 70 domain names which together with the fact that the Respondent lost a prior UDRP proceeding shows that the Respondent of both disputed domain names is a cybersquatter.

B. Respondent

Although the Respondent had requested for Korean to be the language of the proceeding, it did not reply to the Complainant's contentions.

6. Discussion and Findings

A. Language of the Proceeding

The Registration Agreement for the disputed domain name is in Korean. Pursuant to paragraph 11(a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the registration agreement, the language of the proceeding shall be the language of the Registration Agreement, *i.e.*, Korean, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

The Complainant requested for English to be the language of the proceeding because the content of the parking page to which the two disputed domain names resolve is partially in English, the Respondent has already lost at least one prior UDRP proceeding where the decision was rendered in English, and both disputed domain names are in Latin characters.

The Respondent requested for Korean to be the language of the proceeding because the language of the registration agreement is Korean, he is Korean and has very poor English knowledge, and he would not be able to answer the Complaint.

Both disputed domain names resolve to similar parking pages, which include the text “Coming Soon” in English and Korean. The website at the disputed domain name <dsm-firmenich.com> includes a disclaimer in English “welcome” and “[t]his site has no relations with such company DSM or Firmenich”.

Having considered the circumstances of the case, the Panel decides that English be adopted as the language of the proceeding under paragraphs 10 and 11(a) of the Rules. In coming to this decision, the Panel has taken the following into account:

- 1) The content of the websites at the disputed domain names is in English and Korean, which demonstrates the Respondent’s knowledge of English;
- 2) The Respondent chose not to participate in the proceeding even though the Complaint was notified in English and Korean and was informed he could file a Response in Korean;
- 3) The Complaint has been submitted in English and it would cause undue delay and expense if the Complainant were required to translate the Complaint into Korean; and
- 4) The Panel is proficient in both English and Korean, capable of reviewing all the documents and materials in both languages and giving full consideration to the Parties’ respective arguments.

In light of these circumstances, the Panel concludes that it will (1) accept the Complaint in English and the Respondent’s communications in Korean; (2) consider any relevant materials in English and Korean; and (3) issue a decision in English.

B. Identical or Confusingly Similar

This element consists of two parts: first, whether the Complainant has rights in a relevant trademark and, second, whether the disputed domain names are identical or confusingly similar to that trademark.

The Panel finds that the Complainant has established registered rights in the trademark FIRMENICH and that the disputed domain names are confusingly similar to the Complainant’s trademark. The disputed domain names incorporate the Complainant’s trademark in their entirety, with the additional word “DSM”, which is the name of the company the Complainant announced that it had merged with. The addition of the word “DSM” does not prevent the Complainant’s trademark from being recognizable in the disputed domain names (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). The use of the generic Top-Level Domain (“gTLD”) extension “.com” is disregarded when assessing whether a domain name is identical or confusingly similar to a trademark (see *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#)).

For these reasons, pursuant to the Policy, paragraph 4(a)(i), the Panel finds that the disputed domain names are confusingly similar to the Complainant’s trademark.

C. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. Once such a *prima facie* case is made, the Respondent carries the burden of demonstrating its rights or legitimate interests in the disputed domain names. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. See [WIPO Overview 3.0](#), section 2.1.

Here, the Panel finds that the Complainant has made out a *prima facie* case.

The Panel finds that the Respondent has no relationship with nor authorization from the Complainant to use its trademark. The Respondent has shown no actual intention to use the disputed domain names since the registration of the disputed domain names. The disputed domain names resolve to parked pages. There is nothing in the record to suggest that the Respondent has made a legitimate noncommercial or fair use of the disputed domain names or has been commonly known by the disputed domain names. Also, there is no evidence that the Respondent has an intention to use the disputed domain names in connection with a *bona fide* offering of goods or services.

Accordingly, the Panel holds that the Respondent has no rights or legitimate interests in the disputed domain names pursuant to paragraph 4(a)(ii) of the Policy.

D. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

(i) circumstances indicating that the respondent has registered or 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 respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent 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 respondent has engaged in a pattern of such conduct; or

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

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 respondent's website or location or of a product or service on the respondent's website or location.

The Complainant claims that the Respondent registered and is using the disputed domain names in bad faith in violation of the Policy, paragraph 4(a)(iii). Specifically, the Complainant claims that the Respondent violated the Policy, paragraph 4(b)(ii) by registering the disputed domain names in order to prevent the Complainant from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct.

As stated previously, the Respondent did not file any substantive response to the Complaint, failing thereby to rebut the Complainant's allegations of the Respondent's bad faith registration and use of the disputed domain names.

Nevertheless, the Panel still has the responsibility of determining which of the Complainant's assertions are established as facts, and whether the conclusions asserted by the Complainant can be drawn from the established facts (see *Harvey Norman Retailing Pty Ltd v. Oxford-University*, WIPO Case No. [D2000-0944](#)).

The Panel finds the Respondent intentionally registered and is using the disputed domain names - which are confusingly similar to the Complainant's trademarks - in bad faith for the reasons set forth below.

First, the Complainant's commencement of its business, its use of the domain names for the Complainant's official website, and its registration of the trademarks together with more than 125 years of history all far pre-date the registration date of the disputed domain names. It is reasonable to assume that the Respondent had knowledge of the Complainant and its business from the fact that when the Respondent registered the disputed domain names, the Complainant and its trademark already had a worldwide reputation, and said trademark is entirely incorporated into the disputed domain names. Also, the Respondent registered the disputed domain names which are confusingly similar to the Complainant's trademark on the same day on which the Complainant and DSM jointly announced their future merger. The fact that the disputed domain names are composed of the Complainant's trademark in its entirety, together with the name "DSM" clearly demonstrates that the Respondent registered the disputed domain names in bad faith with full knowledge of the Complainant's trademarks and business.

Further, the disputed domain names resolve to parked pages since their registration and there is no evidence whatsoever that the Respondent is currently using or is commonly known by, has used or has been commonly known by, or has a *bona fide* intent to use the disputed domain names. Even though the Respondent included the phrases "Coming soon" and "This site has no relations with such company DSM or Firmenich" in its websites to which the disputed domain names resolve, such simple statements do not sufficiently establish that the Respondent is taking active steps to prepare for any actual business using the disputed domain names.

The Panel also fully considered the Complainant's argument that the Respondent's passive holding of the disputed domain names was indicative of the Respondent's bad faith use of the disputed domain names. The Panel's view is that these facts raised by the Complainant may be taken as true in the circumstances of this case.

Further, the Panel notes that the Respondent has engaged in a pattern of conduct that is consistent with bad faith registration, namely, the Respondent's registrations of around 70 domain names, incorporating famous and well-known registered trademarks or company names owned by others. The Respondent was also involved in a prior UDRP proceeding where its bad faith registration and use of the domain name was confirmed.

Accordingly, the evidence shows that the Respondent knew of and had sought to take unfair advantage of the confusing similarity between the disputed domain names and the Complainant's trademarks and prevented the Complainant from reflecting the mark in a corresponding domain name.

As the conduct described above falls squarely within paragraph 4(b)(ii) of the Policy, the Panel concludes that the Respondent registered and is using the disputed domain names in bad faith pursuant to the Policy, paragraph 4(a)(iii).

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain names <dsmfirmenich.com> and <dsm-firmenich.com> be transferred to the Complainant.

/Andrew J. Park/

Andrew J. Park

Sole Panelist

Date: October 26, 2022