

## **ADMINISTRATIVE PANEL DECISION**

Umicore v. Razid Kim, Yty sdn bhd  
Case No. D2022-4355

### **1. The Parties**

The Complainant is Umicore, Belgium, represented by Gevers Legal N.V., Belgium.

The Respondent is Razid Kim, Yty sdn bhd, Malaysia.

### **2. The Domain Name and Registrar**

The disputed domain name <umicores.net> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 16, 2022. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. Also on November 16, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 17, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on November 21, 2022.

The Center verified that the Complaint together with the amended 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 the Respondent of the Complaint, and the proceedings commenced on November 22, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 12, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 13, 2022.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on December 16, 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 is a global materials technology and recycling group with activities across Europe, North America (United States of America and Canada), Asia and Africa.

In addition to its trade name “Umicore”, derived from its company name Umicore N.V., the Complainant is the owner of the domain name <umicore.com>, which it uses in its communications and, amongst others, of the following trademark registrations:

- International Trademark Registration No. 775795 for UMICORE, registered on January 22, 2002, subsequently renewed, in classes 1, 2, 6, 9, 14, 40 and 42;
- United States of America Trademark Registration No. 0692900 for UMICORE, registered on July 23, 2001, subsequently renewed, in classes 1, 2, 6, 9, 14, 40 and 42; and
- International Trademark Registration No. 1400844 for UMICORE and device, registered on November 27, 2017, in classes 1, 2, 6, 7, 9, 14 and 40.

The disputed domain name <umicores.net> was registered on August 7, 2022. Presently, it resolves to a parked webpage that only reads: “Comming (sic) soon”.

#### 5. Parties’ Contentions

##### A. Complainant

The Complainant asserts to be a global materials technology and recycling group, with more than 10,000 employees and a turnover of EUR 10.4 billion. Furthermore, the Complainant asserts to dedicate most of its R&D efforts to clean technologies, such as emission control catalysts, materials for rechargeable batteries and recycling, being the UMICORE a well-know and reputed trademark counting with substantial and widespread reputation throughout Europe and the world.

In the Complainant’s view, the disputed domain name incorporates its UMICORE trademark entirely, the addition of a letter “s” being insufficient to give any distinctiveness thereto or to distinguish the disputed domain name to the Complainant’s trademark.

According to the Complainant, the Respondent has no rights or legitimate interests in the disputed domain name given that:

- (i) the Complainant’s UMICORE trademark is not a generic or descriptive term in which the Respondent might have an interest;
- (ii) the Respondent does not own, to the Complainant’s knowledge, and after having conducted a thorough trademark search in that respect, any valid trademark rights over UMICORE nor over UMICORES (Annex 4 to the Amended Complaint), and the Complainant did not in any way consent to the registration and use of the disputed domain name;
- (iii) the Respondent does not have any connection or affiliation with the Complainant whatsoever nor has it received any license or consent, express or implied, to use the trademark UMICORE in a domain name or in any other manner;
- (iv) the Respondent was never known by any name or tradename that incorporates “Umicore”; and
- (v) the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name since it does not currently resolve to an active website.

The Complainant contends that the disputed domain name was registered in bad faith given that UMICORE is a fanciful and invented sign of which the distinctive character has been enhanced significantly throughout the years, as a result of the extensive use and promotion of the trademark in relation to the Complainant's world-renowned global materials technology and recycling activities, and thus the Respondent's registration of the disputed domain name suggests the existence of opportunistic bad faith. The Complainant believes that the Respondent knew about the Complainant's trademark and business when registering the disputed domain name, being it highly improbable that the Respondent was unaware of the Complainant's trademark at the time of the registration of the disputed domain name. As to the bad faith use of the disputed domain name, the Complainant argues that the Respondent appears to have set up mail exchanger (MX) records in relation to the disputed domain name, being it highly risky that emails emanating from the disputed domain name could not be used for a genuine purpose, and could be used to facilitate potentially fraudulent activity, such as impersonating or passing off. Other than that, the disputed domain name is being passively held, being it safe to assume that the Respondent registered the disputed domain name to profit or detract from or exploit the Complainant's trademark.

## **B. Respondent**

The Respondent did not reply to the Complainants' contentions.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy sets forth the following three requirements which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

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

The Complainant must prove in this administrative proceeding that each of the aforesaid three elements is present in order to obtain the transfer of the disputed domain name.

### **A. Identical or Confusingly Similar**

The Complainant has established rights in the UMICORE trademark, duly registered.

The Panel finds that the disputed domain name reproduces the Complainant's mark in its entirety, being the addition of the letter "s" insufficient to avoid a finding of confusing similarity under the Policy which, as recognized by past UDRP panels involves a "comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name" (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, "[WIPO Overview 3.0](#)", section 1.7).

The first element of the Policy has therefore been established.

### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that indicate a respondent's rights to or legitimate interests in a disputed domain name. These circumstances are:

- (i) before any notice of the dispute, the respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or

(ii) the respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, in spite of not having acquired trademark or service mark rights; or

(iii) the respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent, in not responding to the Complaint, has failed to invoke any of the circumstances which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights to and/or legitimate interests in the disputed domain name. This entitles the Panel to draw any such inferences from such default as it considers appropriate pursuant to paragraph 14(b) of the Rules. Nevertheless, the burden is still on the Complainant to first make a *prima facie* case against the Respondent.

In that sense, the Complainant indeed states that the Respondent does not have any connection or affiliation with the Complainant whatsoever nor has it received any license or consent, express or implied, to use the trademark UMICORE in a domain name or in any other manner.

Also, the absence of any indication that the Respondent has rights in a term corresponding to the disputed domain name, or any possible link between the Respondent and the disputed domain name that could be inferred from the details known of the Respondent or the webpage relating to the disputed domain name, corroborate with the Panel's finding of the absence of rights or legitimate interests.

Another element to consider is the fact that no active use of the disputed domain name appears to have taken place which makes it even more difficult to conceive which rights or legitimate interests the Respondent would have in a domain name that reproduces in its entirety the Complainant's trademark.

Under these circumstances and absent evidence to the contrary, the Panel finds that the Respondent does not have rights or legitimate interests with respect to the disputed domain name.

### **C. Registered and Used in Bad Faith**

The Policy indicates in paragraph 4(b) that bad faith registration and use can be found in view of:

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

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

(iv) by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website or other location, by creating a likelihood of confusion with the Complainants' 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.

Past UDRP panels have already dealt with the question of whether the "passive holding" of a domain name could constitute bad faith. Section 3.3 of the already quoted [WIPO Overview 3.0](#) states that "[f]rom the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or 'coming soon' page) would not prevent a finding of bad faith under the doctrine of passive holding. While

panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put".

In the present case, the passive holding of the disputed domain name by the Respondent amounts to the Respondent acting in bad faith, given that the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the disputed domain name. In addition to that, in the circumstances of this case, it is not possible to conceive of any plausible actual or contemplated active use of the disputed 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.

The registration and use of the disputed domain name in bad faith are further corroborated in the present case in view of the following circumstances:

- (i) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the disputed domain name;
- (ii) the Respondent's choice to retain a privacy protection service so as to conceal its true identity;
- (iii) the Respondent's potential use of the disputed domain name in connection with email addresses; and
- (iv) the use of a false or incomplete contact details in the Whois data and, consequently, the Center not being able to have communications fully delivered to it.

For the reasons stated above, the Respondent's conduct amounts, in this Panel's view, to bad faith registration and use of the disputed domain name.

## **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 name, <umicores.net> be transferred to the Complainant.

*/Wilson Pinheiro Jabur/*

**Wilson Pinheiro Jabur**

Sole Panelist

Date: December 30, 2022