

ADMINISTRATIVE PANEL DECISION

Umicore v. cjm Cheung

Case No. D2023-0439

1. The Parties

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

The Respondent is cjm Cheung, Netherlands.

2. The Domain Name and Registrar

The disputed domain name <umicore.global> is registered with Key-Systems GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 31, 2023. On January 31, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 1, 2023, 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 (Anonymous Party, REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 7, 2023, 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 February 13, 2023.

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 February 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 8, 2023. On February 23, the Center received an email communication from the Technical/Administrative/Billing contact.

The Center appointed Luca Barbero as the sole panelist in this matter on March 21, 2023. 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, originally founded by Jean Dony in 1837 as Société Anonyme des Mines et Fonderies de Zinc de la Vieille Montagne. Following a series of mergers, in 1906 with Union Minière du Haut Katanga (UMHK) – a producer of copper and other metals in Congo – and in 1989 with other subsidiaries such as Metallurgie Hoboken-Overpelt and Mechim, in 2001, to symbolize the trend of moving away from mining and the production of commodities and base metals, the group changed its name to Umicore (the first two letters of the name being the initials to Union Minière, referring to the group’s historical roots).

At present, with more than 10,000 employees and a turnover of EUR 10.4 billion, the Complainant dedicates most of its R&D efforts to clean technologies, such as emission control catalysts, materials for rechargeable batteries and recycling, with activities carried out through offices which are located across Europe, North America (United States of America and Canada), Asia, and Africa.

The Complainant is the owner of various trademark registrations in more than 100 jurisdictions, including the following:

- International trademark registration No. 775794 for UMICORE (word mark), registered on January 22, 2002, in classes 01, 02, 06, 09, 14, 40, and 42;
- United States trademark registration No. 2996277 for UMICORE (word mark), registered on September 20, 2005, in international classes 1, 2, 6, 9, 14, 40, and 42;
- International trademark registration No. 1400844 for UMICORE (figurative mark), registered on November 27, 2017, in international classes 1, 2, 6, 7, 9, 14, and 40.

The Complainant is also the owner of the domain name <umicore.com>, which was registered on May 16, 2001, and is used by the Complainant to promote its products and services under the trademark UMICORE.

The disputed domain name <umicore.global> was registered on November 2, 2022, and resolves to a parking page of a hosting provider.

5. Parties’ Contentions

A. Complainant

The Complainant contends that the disputed domain name <umicore.global> is identical or, at least, confusingly similar to the trademark UMICORE in which the it has rights as it reproduces the trademark in its entirety with the mere addition of the generic Top-Level Domain (“gTLD”) “.global”.

The Complainant believes that the disputed domain name could easily confuse Internet users as being the domain name of the Complainant or could wrongly convince Internet users that the Respondent is somewhat associated with or endorsed by the Complainant and its trademark, when in fact it is not.

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant states that: i) the Respondent is not commonly known by the disputed domain name or by the trademarks UMICORE or UMICORE GLOBAL; ii) has in no way been authorized to register and use the disputed domain name in any way; iii) the Respondent is in no way connected or affiliated to the Complainant; and iv) the Respondent has never received any license or consent, express or implied, to use the trademark UMICORE in a domain name or in any other manner.

The Complainant believes that the Respondent has purposefully registered the disputed domain name incorporating the Complainant’s trademark UMICORE, in an effort to create a direct affiliation with the Complainant and use the Complainant’s name, deliberately attempting to divert Internet users from the Complainant’s legitimate website.

Moreover, the Complainant contends that the use of the disputed domain name cannot be considered a *bona fide* offering of goods or services or a legitimate noncommercial or fair use, as the disputed domain name does not currently resolve to an active website.

With reference to the circumstances evidencing bad faith, the Complainant indicates that the trademark 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. Such behavior, in view of the Complainant, gives rise to presumption of opportunistic bad faith. The Complainant also states that the fact that the disputed domain name currently redirects to an inactive webpage does not prevent a finding of bad faith under the doctrine of passive holding.

In addition, the Complainant highlights that the disputed domain name currently appears to be set up with mail exchanger (MX) records, a circumstance which suggests that the Respondent either is receiving email traffic intended for the Complainant or is using the disputed domain name for fraudulent purposes. The Complainant underlines that the fact that the trademark UMICORE is fully recognizable within the disputed domain name, gives the impression that the disputed domain name or the related email addresses (“@umicore.global”) are controlled by the Complainant or are at least associated with it.

Finally, the Respondent submits that, since the Respondent has control of the disputed domain name, it may decide to alter its use at any point, disrupting the Complainant. The Complainant notes that the Respondent could, for example, decide in the future to activate a website at the disputed domain name or redirect it to a website of a Complainant's competitor, thus misleading Internet users.

B. Respondent

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

6. Discussion and Findings

According to paragraph 15(a) of the Rules: “A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.” Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

- (i) that the disputed domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has provided evidence of ownership of trademark registrations for UMICORE in several countries, as mentioned under Section 4 above.

It is well accepted that the first element functions primarily as a standing requirement, and that the threshold test for confusing similarity involves a reasoned but relatively straightforward comparison between a complainant's trademark and the disputed domain name to assess whether the trademark is recognizable within the disputed domain name (section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#))).

The Panel finds that the disputed domain name is identical to the Complainant's trademark UMICORE as it reproduces the trademark in its entirety. The gTLD “.global” can be disregarded under the first element confusing similarity test.

Therefore, the Panel finds that the Complainant has proven that the disputed domain name is identical to a trademark in which the Complainant has established rights according to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant must show that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent may establish a right or legitimate interest in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

“(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.”

In the case at hand, the Panel finds that the Complainant has made a *prima facie* case and that the Respondent, by not having submitted a Response, has failed to demonstrate rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy for the following reasons.

The Panel notes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainant. The Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant’s trademarks. Moreover, there is no element from which the Panel could infer a Respondent’s right over the disputed domain name, or that the Respondent might be commonly known by the disputed domain name.

There is no evidence of use of the disputed domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant’s trademark. Indeed, the disputed domain name, being pointed to a mere parking page, is passively held. In view of the Respondent’s default, the Panel shares the view held in *Teachers Insurance and Annuity Association of America v. Wreaks Communications Group*, WIPO Case No. [D2006-0483](#), where the panel found that, absent some contrary evidence from a respondent, passive holding of a domain name does not constitute legitimate noncommercial or fair use.

The Panel also notes that the disputed domain name, being identical to the Complainant’s trademark UMICORE, carries a high risk of implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

Therefore, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in the disputed domain name according to paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the Complainant prove that the disputed domain name was registered and is being used by the Respondent in bad faith.

As to bad faith at the time of the registration, the Panel finds that, in light of i) the prior registration and use of the Complainant’s trademark UMICORE in connection with the Complainant’s products and services, including online via the Complainant’s website at <umicore.com>, ii) the fact that UMICORE is a coined mark, and iii) the identity of the disputed domain name with the Complainant’s trademark, the Respondent likely registered the disputed domain name having the Complainant’s trademark in mind.

As to the use of the disputed domain name, the Panel notes that, as mentioned above, it is pointed to a mere parking page of a hosting provider. As indicated in Section 3.3 of the [WIPO Overview 3.0](#), “From 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 case at hand, in view of i) the distinctiveness of the Complainant’s prior trademark UMICORE, ii) the Respondent’s failure to submit a Response and to provide any evidence of good-faith use; and iii) the implausibility of any good faith use to which the disputed domain name, identical to the Complainant’s trademark, may be put, the Panel finds that the Respondent’s passive holding of the disputed domain name does not prevent a finding of bad faith.

Moreover, the presence of MX records in the DNS configuration of the disputed domain name suggests that the disputed domain name might be used for sending and also receiving email messages. Therefore, Internet users communicating via email addresses based on the disputed domain names would certainly be misled into wrongfully believing that they are dealing with the Complainant. As stated in section 3.4 of the [WIPO Overview 3.0](#), prior panels have held that also the use of a domain name for purposes other than to host a website, such as use to send emails, may constitute bad faith.

Therefore, the Panel finds that the Complainant has also proven that the Respondent registered and is using the disputed domain name in bad faith according to paragraph 4(a)(iii) of the Policy.

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 <umicore.global> be transferred to the Complainant.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: April 4, 2023