

## **ADMINISTRATIVE PANEL DECISION**

### **Compagnie Générale des Etablissements Michelin v. Kiều Công Anh Case No. D2023-5365**

#### **1. The Parties**

The Complainant is Compagnie Générale des Etablissements Michelin, France, represented by Dreyfus & associés, France.

The Respondent is Kiều Công Anh, Viet Nam.

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

The disputed domain name <michelintour.com> is registered with Nhan Hoa Software Company Ltd. (the “Registrar”).

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 27, 2023. On December 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 28, 2023, 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 January 4, 2024, the Center informed the parties in Vietnamese and English, that the language of the registration agreement for the disputed domain name is Vietnamese. The Complainant did not submit additional comments or arguments, but originally submitted arguments and requested in the Complaint that English be the language of the proceeding. The Respondent sent an email communication, in English, on January 9, 2024, but did not submit any comment on the Complainant’s request (in the Complaint) that English be the language of the proceeding or provide arguments for Vietnamese 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 the Respondent of the Complaint, and the proceedings commenced on January 16, 2024. On January 23, 2024, the Respondent sent an email communication in response to the Complaint. On January 24, 2024, the Complainant sent a request to suspend the proceedings for a possible settlement. On January 25, 2024, the Center notified the suspension. The Parties submitted a signed standard settlement form; accordingly, the Center sent a Notice of Settlement on February 5, 2024. On February 8, 2024, the Respondent replied to the notice of settlement and requested the case be continued. On February 14, 2024, the Center sent an email communication to the Parties, requesting them to re-confirm their agreement to settle the proceedings. On February 14, unable to reach an agreement, the Complainant requested the proceedings be reinstated. On February 16, 2024, the proceedings were reinstated. In accordance with the Rules, paragraph 5, the due date for Response was February 27, 2024. The Respondent sent email communications to the Center on February 20 and 28, 2024.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on March 8, 2024. 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 has been operating since 1889. According to the Complaint, it is the “No 1” manufacturer worldwide for tyres. It has over 124,000 employees and operates 117 manufacturing facilities. The Complainant has also established sales agencies in 26 countries. In addition, the Complainant’s products are available in 170 countries around the world.

In addition to its tyre production, the Complainant also produces a number of other goods and services including digital services, maps and guides, and other materials for the travel industry.

These include the *Michelin Guides*, which have for many years provided information for motorists to plan their trips and provided rankings or star ratings of restaurants in many countries. According to the information in Annex 3 to the Complaint, the *Michelin Guide* was first launched in 1920. It rates over 30,000 establishments across 30 territories and more than 30 million copies have been sold. Numerous decisions of prior UDRP panels have recognized that the Complainant’s *Michelin Guides* are well-known or famous. For example, *Compagnie Générale des Etablissements Michelin v. Transure Enterprise Ltd, Host Master / Above.com Domain Privacy*, WIPO Case No. [D2012-0045](#), *Compagnie Générale des Etablissements Michelin v. Jaime Paternina*, WIPO Case No. [D2022-0171](#) and *Compagnie Générale des Etablissements Michelin v. Domain Administrator, Fundacion Privacy Services LTD*, WIPO Case No. [D2023-2522](#).

The Complainant registered the domain name <michelin.com> in 1993. Its LinkedIn account, @Michelin, has more than 740,000 followers.

The Complainant is the owner of a number of registered trademarks for MICHELIN. For present purposes, it is sufficient to note:

(a) International Registration No 771031, which was registered on June 11, 2001, in respect of a wide range of goods and services in International Classes 5, 7, 8, 9, 10, 11, 12, 16, 17, 18, 20, 21, 24, 25, 39 (tourism services), and 42. This International Registration designated numerous countries including Viet Nam; and

(b) Vietnamese Registered Trademark No 4-0302024-000, which was registered on June 18, 2018, in respect of a range of services in International Classes 35, 37, 39, 41, and 42.

The disputed domain name was registered on August 19, 2023.

It resolves to a website which offers Michelin Street Food Tours through the heart of the Old Quarter in Hanoi, Viet Nam. The About Us page of the website promises the reader, under the heading “Savor Michelin-Quality Delights”:

“Experience the flavors of Vietnam through the lens of Michelin Guide-recommended street vendors. Our Michelin Street Food Tour offers an exclusive opportunity to indulge in dishes that have earned the accolades of Michelin inspectors.”

In response to a cease and desist letter from the Complainant’s representatives, the Respondent, after asserting his entitlement to the disputed domain name, offered to transfer it to the Complainant for the sum of USD 50,000, claiming he had built up a valuable goodwill in its use.

## **5. Discussion and Findings**

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (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.

Paragraph 15(a) of the Rules directs the Panel to decide the 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.

### **A. Language of the Proceeding**

Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The language of the Registration Agreement for the disputed domain name is Vietnamese.

The Complaint was filed in English, however, and the Complainant requested that the language of the proceeding be English for several reasons, including the fact that it does not speak Vietnamese and would be greatly inconvenienced if required to translate all the documentation into and from Vietnamese.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to act in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties’ ability to understand and use the proposed language, time and costs (see [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition \(“WIPO Overview 3.0”\)](#), section 4.5.1).

The Respondent has not specifically addressed the Complainant’s request. However, the Panel notes that the website to which the disputed domain name resolves is in English. In addition, the emails sent by the Respondent in the proceeding and, prior to its commencement, in responses to a cease and desist letter from the Complainant’s representatives have all been expressed in English. Although the Respondent apparently signed the Settlement Form in error, it appears that the Respondent is well-versed in English and would not be disadvantaged by the adoption of English as the language of the proceeding.

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

## **B. Identical or Confusingly Similar**

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark rights.

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

The Complainant has proven ownership of the trademark MICHELIN.

In undertaking the comparison between the Complainant's trademark and the disputed domain name, it is permissible in the present circumstances to disregard the generic Top Level Domain (gTLD) component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

Disregarding the ".com" gTLD, the disputed domain name consists of the Complainant's registered trademark and the term "tour". As this requirement under the Policy is essentially a standing requirement, the addition of this term does not preclude a finding of confusing similarity. See e.g., [WIPO Overview 3.0](#), section 1.8. Apart from anything else, the Complainant's trademark remains visually and aurally recognisable within the disputed domain name.

The Respondent does claim that the Complainant is a tyre company and the services he offers are entirely unrelated to that industry "focusing on providing unique culinary experiences for tourists in Hanoi". That argument, however, misunderstands the nature of the inquiry under this requirement of the Policy. The second stage of this inquiry simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of "likelihood of confusion" under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties, the date they were acquired and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See e.g., [WIPO Overview 3.0](#), section 1.7.

Accordingly, the Panel finds that the Complainant has established that the disputed domain name is confusingly similar to the Complainant's trademark and the requirement under the first limb of the Policy is satisfied.

## **C. Rights or Legitimate Interests**

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] 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, even if [the Respondent] has acquired no 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.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

The Respondent registered the disputed domain name well after the Complainant began using its trademark and also well after the Complainant had registered its trademark.

It is not in dispute between the parties that the Complainant has not authorised the Respondent to use the disputed domain name and the Respondent is not affiliated with the Complainant in any way.

The disputed domain name is not derived from the Respondent’s name. Nor is there any suggestion of some other name by which the Respondent is commonly known from which the disputed domain name could be derived. From the available record, the Respondent does not appear to hold any trademarks for the disputed domain name.

The disputed domain name carries a clear risk of implied affiliation.

As noted above, the Respondent claims that he uses the disputed domain name in a very different field to the Complainant which the Respondent characterises as a tyre manufacturer. Thus, apparently contending there is no risk of deception or confusion.

This, however, is rather disingenuous in light of the Complainant’s longstanding publication of its well-known or famous Michelin Guides and in circumstances where the Respondent’s website itself seeks to portray its tours as taking in “Michelin Guide-recommended street vendors”.

The Complainant’s trademark is used so extensively and so prominently on the Respondent’s website that in the Panel’s view the message conveyed is not simply a descriptive message that the Respondent offers tours of street vendors who have been recommended in the Michelin Guide. Also cutting against a claim to fair descriptive use is the fact that the Respondent uses other domain names for its services which do not invoke the Complainant’s mark, e.g., <VietnamTour.top> and <TrainStreetTour.com>.

The nature of the Respondent’s relationship (or lack thereof) is not clearly and prominently disclosed on the website.

Even if the Respondent’s services do not fall directly within the scope of the Complainant’s registered trademarks (which the Panel does not decide), nonetheless there is a very high likelihood that people viewing the disputed domain name will mistakenly think it is held by or in some way associated with the Complainant and its trademark. All the more so when regard is paid to how it is used. The use of a domain name which trades on the Complainant’s trademark in this fashion does not qualify as a good faith offering of goods or services for the purposes of paragraph 4(c)(i).

Accordingly, the Panel finds the Complainant has established the second requirement under the Policy also.

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

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent. These are conjunctive requirements; both must be satisfied for a successful complaint: see e.g., *Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd*, WIPO Case No. [D2010-0470](#).

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant.

There cannot be any doubt that the Respondent was very well aware of the Complainant's trademark when the Respondent adopted the disputed domain name.

The Respondent does not claim any association with the name "Michelin" from which he could derive rights independently of the Complainant; "Michelin" has significance in relation to tours and food and drink establishments only because of its use by the Complainant through services such as the Michelin guide. The registration and use of the name to take advantage of that connection, and convey a false connection or association with the Complainant, constitutes registration and use in bad faith under the Policy.

That conclusion is supported by the Respondent's offer to transfer the disputed domain name to the Complainant for USD 50,000 which does not strike the Panel as supportive of a claim to rights or legitimate interests in the disputed domain name.

As the term in particular is an invented or coined term and not descriptive, it appears that the Respondent has adopted the disputed domain name because of its trademark significance. In circumstances where the Respondent has not sought to claim, let alone establish, that he or she has rights or legitimate interests in the disputed domain name, therefore, the Panel finds the Respondent has registered and used it in bad faith.

Accordingly, the Complainant has established all three requirements under the Policy.

#### **6. 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 <michelintour.com> be transferred to the Complainant.

*/Warwick A. Rothnie/*

**Warwick A. Rothnie**

Sole Panelist

Date: March 25, 2024