

SINGAPORE DOMAIN NAME DISPUTE RESOLUTION SERVICE

Administrative Panel Decision

Case No. SDRP-2009/0003(F)

PM-INTERNATIONAL AG v LHT

1. The Parties

1.1 The Complainant is PM-International AG, a corporation, incorporated in Luxembourg, having its principal place of business at 17 rue des Gaulois, 1618 Luxembourg. It was represented by Dr Albrecht Rau of M/s Rau Schneck & Hübner of Königstrasse 2, 90402 Nürnberg, Germany.

1.2 The Respondent is LHT.

1.3 In this decision, the Complainant and the Respondent will be referred to collectively as “the Parties”.

2. The Domain Name and Registrar

2.1 The domain name in issue is “swissfitline.sg” (“the Domain Name”).

2.2 The Registrar for the Domain Name is Web Commerce Communications (Singapore) Pte Ltd. (“Web Commerce”), of 67, Tanjong Pagar Road, Singapore 088488. Web Commerce is one of the accredited Registrars of the Singapore Network Information Centre (SGNIC) Private Limited (“SGNIC”). SGNIC, whose address is 8 Temasek Boulevard, #14-00 Suntec City Tower Three, Singapore 038988, is the registration authority for the Singapore country code top level domain.

3. Procedural History

3.1 The Complainant submitted this complaint (“the Complaint”) pursuant to the Singapore Domain Name Dispute Resolution Policy (“the Policy”), the Rules of the Singapore Domain Name Dispute Resolution Policy (“the Rules”) and the Supplemental Rules for the Singapore Domain Name Dispute Resolution Policy (“the Supplemental Rules”).

3.2 The Secretariat for the Singapore Domain Name Dispute Resolution Service (“the Secretariat”) received the Complaint dated 23 February 2009 via email on 24 February 2009 and in hard copy on 2 April 2009. The Secretariat checked the Complaint for administrative compliance and notified the Complainant of administrative deficiencies by email on 6 April 2009. Pursuant to the Rules, the Complainant was obliged to correct the administrative deficiencies and to resubmit the complaint to the Secretariat. The Complainant submitted a letter to address the highlighted administrative deficiencies on 16 April 2009.

- 3.3 However, the letter of 16 April 2009 did not fully fulfil the requirement under paragraph 4(b) of the Rules to resubmit the complaint. The Secretariat thus wrote to the Complainant on 20 April 2009 to correct the highlighted administrative deficiencies and to resubmit the Complaint by 27 April 2009. A fresh Complaint was resubmitted by email on 21 April 2009.
- 3.4 The Secretariat then checked the Complaint and, upon being satisfied that the Complaint was in compliance with the Policy and the Rules, it forwarded the Complaint, together with a covering minute and the prescribed Complaint Notification Instructions, to the Respondent on 22 April 2009.
- 3.5 The Respondent did not submit a Response, the deadline for which expired on 14 May 2009.
- 3.6 The Secretariat notified the Parties on 20 May 2009 of the appointment of Mr Tan Tee Jim S.C. as the sole panellist (“the Panel”).

4. Factual Background

- 4.1 The Complainant is the owner of international trademark registration 822 325 for FITLINE (stylized) (“the Complainant’s Mark”) which is registered in Singapore in Classes 5, 18, 25, 29, 30 and 32 in respect of the following goods:

TM No. T0406571C in Class 05:

Sanitary preparations for medical use; nutritional supplements for medical use; vitamins; mineral or vegetable preparations for medical use; medicinal herbs; cellulose for pharmaceutical use; protein preparations for medical use; aforementioned goods in the form of tablets, capsules, powder or liquid.

TM No. T0406572A in Class 18:

Leather, imitations of leather and goods made of these materials and not included in other classes; trunks and travelling bags; umbrellas, parasols and walking sticks; bags not included in other classes; rucksacks; vanity cases [not fitted].

TM No. T0406573Z in Class 25:

Clothing, including T-shirts and jackets, footwear, headgear.

TM No. T0406574H in Class 29:

Dietetic foods and food supplements not included in other classes and not for medical use, in the form of powder, capsules, tablets or liquid; beverages in powder form on the basis of milk or predominantly on the basis of milk; protein preparations for consumption not included in other classes.

TM No. T0406575F in Class 30

Dietetic foods and food supplements not included in other classes and not for medical use, in the form of powder, capsules, tablets or liquid.

TM No. 0406576D in Class 32

Mineral waters with vitamins and other nutrients, not for medical use; non-alcoholic drinks; syrups and other preparations for making beverages.

- 4.2 A copy of the printout from the official World Intellectual Property Organisation (WIPO) ROMARIN database as well as the notification of the grant of protection by the Singapore Registry of Trade Marks was annexed to the Complaint to evidence the registrations. All the marks above bear the same date of international registration on 18 February 2004.
- 4.3 The Complainant states that it uses the mark all over the world for nutritional supplements of all kinds as well as for merchandising products like T-shirts and bags.
- 4.4 The Complainant further states that the FITLINE mark is well known worldwide. Copies of the result of an internet search engine, Google, were annexed to show that there were 525,000 English internet pages for FITLINE of which the first 10 results showed several connections to the Complainant.

5. Parties' Contentions

A. Complainant

- 5.1 The Complainant contends that:
 - (1) the Domain Name is highly similar to the Complainant's mark, as it contains the mark "fitline" completely. The further element "swiss" within the Domain Name hints of a connection of the term "fitline" to Switzerland. Therefore, there might be confusion between the Domain Name and the Complainant's mark FITLINE for consumers who are unfamiliar with the details of the goods.
 - (2) The Respondent does not seem to be offering any goods or services under the Domain Name. No sites can be assessed through the internet under the Domain Name. Therefore, it is unlikely that the Respondent has any legitimate interest with regard to the Domain Name.
 - (3) Due to the large number of internet pages on the internet search engine, it is highly likely that the Respondent knew about the Complainant and its trade marks. Therefore, the Domain Name was registered in bad faith.

B. Respondent

5.2 The Respondent did not file, send or submit any response within the period required under Paragraph 5(a) of the Rules, which expired on 14 May 2009.

6. Discussion and Findings

6.1 Although no response was submitted by the Respondent, the Panel may proceed to decide the dispute. Paragraph 5(f) of the Rules provides that:

“If the Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint.”

6.2 The Panel also takes cognizance of paragraph 15(a) which instructs 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 the law of Singapore that it deems applicable”.

6.3 Paragraph 4(a) of the Policy requires the Complainant to prove each of the following conjunctive elements:

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

6.4 The Complainant must prove all three elements on a balance of probabilities before the Panel will grant any of the remedies provided at Paragraph 4(i) of the Rules, namely, to require the cancellation of the Domain Name or to transfer the Domain Name to the Complainant. The Panel notes that the Complainant has requested for the latter remedy *i.e.* to transfer the Domain Name to the Complainant.

A. Identical or Confusingly Similar

6.5 The Complainant must establish its rights in the name or trade mark FITLINE and that the Domain Name is identical with or confusingly similar to the said name or mark. The Complainant must also establish that it has the rights as at the date of the commencement of the administrative proceeding (“the Administrative Proceeding”), if not earlier. This is clear from the language of paragraph 4(a)(i) of the Policy (“in which the Complainant has rights” (emphasis added)).

- 6.6 According to paragraph 2(a) of the Rules, the date of commencement of the Administrative Proceeding is taken as the date when the Complaint is forwarded by the Secretariat to the Respondent, thus discharging its responsibility of employing available means to achieve actual notice to the Respondent. In the present case, that date is 22 April 2009.
- 6.7 Under Section 26 of the Singapore Trade Marks Act (Cap. 332, 2005 Rev Ed.), trade mark registration in Singapore confers upon the proprietor the exclusive right to use and authorise other persons to use the registered trade mark, in relation to the goods or services in respect of which the trade mark is registered. These rights conferred by registered trade mark shall accrue to the proprietor as from the date of registration of the trade mark.
- 6.8 The Complainant's Mark is the subject of international registrations designating Singapore in relation to 6 classes. The international registrations are dated 18 February 2004, which clearly pre-dates the commencement of the Administrative Proceeding on 22 April 2009.
- 6.9 In addition, the "SGNIC Online Whois Results" sheet tendered at Annex 1 of the Complaint shows that the "creation date" of the Domain Name is 31 August 2008, which is clearly later than the date of registration of the Complainant's Mark.
- 6.10 The Complainant asserts that its mark is used "*all over the world and amongst others in Singapore for nutritional supplements of all kinds as well as for merchandising products like T-shirts and bags*". This assertion is not challenged.
- 6.11 The Complainant also asserts that its mark is well-known and attaches at Annex 4 to the Complaint evidence pertaining to the results from an internet search engine (Google) relating to "FITLINE". Whilst the results are not sufficient to establish that the Complainant's Mark comprising the word "FITLINE" is well known, the Panel accepts that they establish that the Complainant has rights in the mark and in the word.
- 6.12 In the premises, the Panel is satisfied that the Complainant has rights in the name or trade mark, FITLINE.
- 6.13 Turning to the issue of whether the Domain Name is identical with or confusingly similar to the name or trade mark, FITLINE, it is noted that the Domain Name comprises the prefix "swiss" and an exact reproduction of the name or trade mark, FITLINE, in the Complainant's Mark.
- 6.14 The Panel notes that many cases concerning domain names have held that the element ".com" in a domain name should be ignored and the comparison is to be with the characterising part of the domain name: see, for example, *Sony Ericsson Mobile Communications AB & Ors v Zheng Zhongxing* [2008] SDRP 1; *VAT Holding AG v VAT.com*, WIPO Case No. 2000-0607; *Croatia Airlines*

d.d. v Modern Empire Internet Ltd, WIPO Case No. D2003-0455. In the present case, the Panel is of the opinion that the element “.sg” is also to be disregarded when assessing identity and similarity between the Complainant’s Mark and the Domain Name.

- 6.15 Cases have also indicated that the word “swiss” is a mere geographic description which “does not provide additional specification or sufficient distinction from the complainant”: see, e.g., *Finter Bank Zurich v WangDaShi*, WIPO Case No. D2006-0044. In the case of *Playboy Enterprises International, Inc v Domain Active Pty Limited*, WIPO Case No. D2002-1156, the domain name “swiss-playboy.com” was held to be similar to PLAYBOY. In the present case, the Panel also finds that the word “swiss” does not add any distinction to the word or mark FITLINE in the Domain Name.
- 6.16 In the circumstances, what is left for comparison is the word FITLINE in the Domain Name. In the Panel’s view, this word is the dominant element in the name. It is also the same word used in the Complainant’s Mark.
- 6.17 The Panel is thus of the view that the Complainant has satisfied the requirements of Paragraph 4(a)(i) of the Policy that the Domain Name is identical with or confusingly similar to a name, trade mark or service mark in which the Complainant has rights.

B. Rights or Legitimate Interests of the Respondent

- 6.18 Paragraph 4(a)(ii) of the Policy requires the establishment of the fact that the Respondent has no rights or legitimate interests in respect of the Domain Name. Paragraph 4(c) of the Policy is instructive as regards the determination of the rights to and legitimate interests in the Domain Name:

Any of the following circumstances, in particular but without limitation, if found by the Administrative Panel to be proved based on its evaluation of all evidence presented, shall demonstrate the Registrant's rights to or legitimate interests in the domain name for the purposes of Paragraph 4(a)(ii):

(i) before any notice to the Registrant of the dispute, the Registrant's 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;

(ii) the Registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or

(iii) the Registrant is 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.

- 6.19 The Complainant asserts that the Respondent “*does not seem to be offering any goods or services under the Domain Name as no sites can be accessed through the internet under this domain (name)*”. This assertion was not challenged.
- 6.20 There is also no evidence concerning the Respondent’s use or demonstrable preparations to use the Domain Name in connection with a *bona fide* offering of goods or services since its creation on 31 August 2008. Nor is there evidence showing that the Respondent is in some way legitimately entitled to use the Domain Name. Also, the Respondent is not known by the name or mark FITLINE.
- 6.21 In the circumstances, the Panel is satisfied that Respondent has no rights or legitimate interests with respect to the Domain Name at issue.

C. Registered or Being Used in Bad faith

- 6.22 Paragraph 4(a)(iii) requires the establishment of the fact that the Domain Name has been registered or is being used in bad faith. Paragraph 4(b) of the Policy is instructive in this regard:

For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Administrative Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the Registrant 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 bears the name or is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented out-of-pocket costs directly related to the domain name;

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

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

(iv) by using the domain name, the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or

location or of a product or service on the Registrant's website or location.

- 6.23 It is important to note that paragraph 4(a)(iii) of the Policy only requires the establishment that *either* the Respondent's Domain Name has been registered in bad faith *or* that the Domain Name was used in bad faith, but not both. The Panel also notes that paragraph 4(b) of the Policy refers to "circumstances, in particular but without limitation". This means that the Panel is free to conclude that there is bad faith in circumstances outside of those set out in Paragraph 4(b).
- 6.24 As mentioned, the Respondent has not submitted a Response. This, coupled with the fact that there is no active site and there are no goods and services offered under the Domain Name, indicates a passive holding of the Domain Name on the part of the Respondent. It has been held that "passive holding of the domain name amounts to bad faith use of the domain name in certain circumstances": see *Ingram Micro Inc. v RJ, Inc. and Rick Juarez*, WIPO Case No. D2001-0948; *Telstra Corporation Limited v Nuclear Marshmallows*, WIPO Case D2000-0003; and *Compagnie Gervais Danone v Dann Shin*, WIPO Case No. D2008-1041.
- 6.25 In the present case, the circumstances are the following:
- (1) The Complainant registered the Complainant's Mark which comprises or contains the word FITLINE since February 2004 in respect of 6 classes of goods.
 - (2) There is undisputed evidence that the Complainant has used the Complainant's Mark in Singapore and elsewhere.
 - (3) The Respondent does not have any active website under the Domain Name to market any goods or services.
 - (4) There is no evidence of any registration or use of the word or mark FITLINE by the Respondent.
 - (5) The Respondent was given ample opportunity to file a Response. Its failure to file the Response and provide its reasons for registering the Domain Name indicates that it has no or no legitimate reason to register the name. In this regard, the failure to respond has been held to be indicative of bad faith (see, e.g., *Google, Inc v Googles Entertainment* [2002] SDRP 3).
 - (6) A search for FITLINE on the internet search engine, Google, yields websites which relate to the Complainant. It is thus inconceivable that the Respondent did not know or would not have known of the Complainant's web presence.

- (7) The Domain Name uses a prefix, "swiss" but there is no evidence as to why this prefix was chosen. In particular, there is no evidence of any connection between the Respondent on the one hand and Switzerland and Swiss-made products on the other.
- 6.26 In the light of these circumstances, the Panel finds that the Domain Name has been registered in bad faith or is being used in bad faith.

7. Conclusion

- 7.1 The Panel therefore concludes that the Complainant has discharged the burden of proving all the elements in Paragraph 4(a) of the Policy and orders that the Domain Name be transferred to the Complainant, PM-International AG.

Tan Tee Jim S.C.
Sole Panellist

1 June 2009