



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

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Decision Submission

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Version
 Decision ID DE-0900208
 Case ID HK-0800212
 Disputed Domain Name www.sarome.com
 Case Administrator Dennis CAI
 Submitted By Yun Zhao
 Participated Panelist

Date of Decision 17-03-2009

Language Version : English

The Parties Information

Claimant SAROME Co., Ltd.
Respondent Moniker Privacy Services

Procedural History

On 29 September 2008, the Complainant submitted a Complaint in the English language to the Hong Kong Office of the Asian Domain Name Dispute Resolution Center (the ADNDRC) and elected this case to be dealt with by a three-person panel, in accordance with the Uniform Domain Name Dispute Resolution Policy (the Policy) approved by the Internet Corporation for Assigned Names and Numbers (ICANN), the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules), and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the ADNDRC Supplemental Rules). On 4 October 2008, the ADNDRC sent to the Complainant by email an acknowledgement of the receipt of the complaint. All correspondence to and from the ADNDRC described herein was in the English language.

On 4 October 2008, the ADNDRC transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On 8 October 2008, the Registrar transmitted by email to the ADNDRC its verification response, confirming that the Respondent is listed as the registrant and providing the contact details. On 15 October 2008, the ADNDRC transmitted the Complaint to the Respondent and notified the Respondent of the commencement of the action and requested the Respondent to submit a Response within 20 calendar days. The Respondent failed to submit a Response within the required period of time. The ADNDRC notified the Respondent's default on 5 November 2008.

Having received a Declaration of Impartiality and Independence and a Statement of Acceptance from Dr. Zhao Yun, Mr. Debrett Lyons and Dr. Xue Hong, on 24 February 2009, the ADNDRC notified the parties of the appointment of the panelists, with Dr Zhao Yun acting as the presiding panelist. The Panel determines that the appointment was made in accordance with Rules 6 and Articles 8 and 9 of the Supplemental Rules. On 24 February 2009, the Panel received the file from the ADNDRC and should render the Decision within 14 days.

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 administrative proceeding shall be the language of the

Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding. The language of the current disputed domain name Registration Agreement is English, thus the Panel determines English as the language of the proceedings.

Factual Background

For Claimant

The Complainant in this case is SAROME Co., Ltd., a corporation registered in Japan. The registered address is 8-17-1 Miyama, Funabashi-City, Chiba Pref. 2704-0072 Japan.

For Respondent

The Respondent, Moniker Privacy Services, is the current registrant of the disputed domain name <sarome.com> according to the Whois information. The registered address is 20 SW 27th Ave., Suite 201, Pompano Beach, Florida, 33069, U.S.

Parties' Contentions

Claimant

In 1930, the founder of the Complainant, Kunijiro Segawa, read in a novel about a God of Fire named SAROME who was able to becharm humans in Japanese mythology. He was inspired by the power of the God of Fire and with a simple alteration, he decided to name his company to the one incorporating “SAROME”. In 1940, he founded the Complainant in Japan. While doing tinplate stamping, he was asked to make a tinplate sheet to be put under a table lighter. He took a look at the table lighter to be put on the tinplate sheet he was going to make, and thought that it did not look good. Then he began to make a lighter by himself. Since then, he had been engaged in the manufacture of lighters until the evening of his life, continuing his work as a lighter craftsman.

In 1955, the Complainant was the first manufacturer of gas lighters in Japan and was the second on the international level to produce gas lighters following Ronson International Limited. Around 1960, the Complainant shifted the business line to the production of gas lighters with more elaborated design and “SAROME” became a well-established brand for the made-in-Japan cigarette lighters both locally and abroad. Technical breakthrough brought the development of electronic lighters in 1966 and the battery cigarette lighter in 1974. The battery lighter was designed to emit sparks when the switch was pressed, thereby allowing immediate ignition, and thus it eliminated the need to firmly push a lever as required in typical electronic lighters. The complainant made every possible effort to advertise the battery cigarette lighter and prompted the sales worldwide. Four years later in 1978, the Complainant developed the I.C. cigarette lighter. This lighter featured automatically emitted sparks for ignition in response to the sensor activated simply by hand-touch, for which an electrical circuit was installed in the lighter.

In 1986, the Complainant successfully developed the jet-flame turbo cigarette lighter of catalytic ignition design which was the world’s first success in respect of wind-resistant flames. The “SAROME TURBO” was such a great success worldwide that the world market share of electronic lighters was re-painted and it became a new standard of cigarette lighters. Currently, the Complainant’s products under the mark “SAROME”, including lighters and accessories such as cigarette cases and money clips, are sold to more than 47 countries/places of the world including Japan, United States and Hong Kong.

1. The domain name is identical or confusingly similar to the trademark in which the Complainant has rights, namely “SAROME”

The Complainant is the proprietor of the trademark “SAROME” under which the Complainant has dealt

in lighters and smoker' s articles worldwide for over 65 years. The Complainant owns a large number of registrations and applications in over 65 countries/places around the world for the mark “SAROME” , “沙乐美” (SAROME in Chinese) and other trademarks containing “SAROME” , the earliest date of registration being 8 August 1966 for the United Kingdom mark “SAROME” in Class 34 in relation to “gas lighter for smokers” . The Complainant registered in August 1999 the domain name “sarome.co.jp” which has since then been used as the Complainant' s company website. The disputed domain name is identical and/or confusingly similar to the Complainant' s trade name and trademark “SAROME” and the domain name mentioned above.

2. The Respondent has no rights or legitimate interests in respect of the disputed domain name

The Respondent has no reason to adopt the name “SAROME” and it has no relation with the Complainant. The Complainant has not authorized, licensed, endorsed or otherwise permitted the Respondent to use the Complainant' s trade name/trademark “SAROME” . The Complainant has prior rights in the “SAROME” trademark which precede the Respondent' s registration of the disputed domain name. The word “SAROME” was a name specially chosen by the founder of the Complainant from a novel and the name is not an English dictionary word or of common usage. The Complainant is famous on a worldwide basis under the trademark and trade name of “SAROME” for high-quality lighters and smoker' s articles. The excellent craftsmanship of the Complainant' s products is well recognized by consumers around the world. Although the Complainant is located in Japan, the products under the mark “SAROME” are being sold in more than 47 countries/places of the world through the Complainant' s strong network of distributors, which network covers the United States of America where the Respondent is located. The Respondent is not offering any goods and/or services under the disputed domain name. The disputed domain name is being used as a search engine with links to various kinds of lighters and smoker' s articles, e.g. “Electric Lighters” , “Lighter Gas” , “Flight Lighter” and “butane Lighter” . Accordingly, the Respondent does not have any basis upon which it can assert its rights or legitimate interest in the disputed domain name and there cannot be any possible legitimate connection or interest between the Respondent and the disputed domain name.

3. The domain name was registered and is being used in bad faith

Registration of the disputed domain name by the Respondent was in bad faith as the Respondent has deliberately chosen a domain name which wholly incorporates the famous trade name/trademark of the Complainant. The disputed domain name is being used as a search engine which contains links to various kinds of lighters and smoker' s articles which show that the Respondent has full knowledge that the Complainant, the rightful proprietor of the trade name/mark “SAROME” , is in the business of lighters and smoker' s articles. The Respondent does not conduct any legitimate commercial or non-commercial business activity. Given the Complainant' s worldwide reputation and the numerous registrations it has obtained in many countries including the United States of America, it is not possible to conceive a plausible circumstance in which the Respondent would not have been aware of this fact at the time of registration.

The disputed domain name is being used as a search engine which contains links to various kinds of lighters and smoker' s articles. This clearly demonstrates that the Respondent has used the disputed domain name primarily for the purpose of disrupting the business of the Complainant. Internet users would expect to reach the Complainant' s website through the disputed domain name but instead they are led to various websites through various links in the website of the dispute domain name. The potential customers of the Complainant would be misled into thinking that the Complainant is no longer in business or has withdrawn its online presence, and they may as a result turn to the products of the Complainant' s competitor or other companies.

By using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant' s mark as to the source, sponsorship, affiliation, or endorsement of the products on the website or the links on the website. The website used under the disputed domain name is a search engine for lighters and smoker' s articles. Since the disputed domain name is identical to the trade name/mark of the Complainant, the Internet users expect to reach the Complainant' s products or business by the disputed domain name and they will

be confused by the various links leading to all different kinds of similar products. The Respondent intends to attract Internet users to its website by the confusion and through the use of the search engine to look for the Complainant's products or the "clicking" of sponsored links or advertisements at the website by the Internet users, the Respondent has commercial gain.

The Respondent has registered the disputed domain name "sarome.com" which consists of the Complainant's trade name/trademark "sarome" only, thereby preventing the Complainant from using its trade name/trademark in such corresponding domain name.

In accordance with Paragraph 4(b)(i) of the Policy, the Complainant requests the Panel to issue a decision to transfer the Disputed Domain Name to the Complainant.

Respondent

The Respondent fails to submit a Response within the required period of time.

Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable." Paragraph 4 (a) of the Policy requires that the Complainant should prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

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

Identical / Confusingly Similar

The Complainant, first established in 1940, is a manufacturer of lighters and smoker's articles. The evidence submitted by the Complainant shows that the Complainant has registered the trademark "SAROME" worldwide since 1966. The Panel finds that the Complainant enjoys the prior rights and interests in the trademark "SAROME".

The disputed domain name is "sarome.com". As the suffix ".com" only indicates that the domain name is registered under this gTLD and is not distinctive, the Panel has no problem in finding that the disputed domain name <sarome.com> is identical to the Complainant's trademark "SAROME".

The Panel therefore holds that the Complaint fulfills the condition provided in Paragraph 4 (a)(i) of the Policy

Rights and Legitimate Interests

The Complainant contends that the Respondent does not have rights to or legitimate interests in the disputed domain name. The Complainant's assertion is sufficient to establish a prima facie case under Policy 4 (a) (ii), thereby shifting the burden to the Respondent to present evidence of its rights or legitimate interests. The Respondent fails to submit a Response, neither does it put forward any evidence to show any positive interests that it relies on. No evidence shows that the Respondent has acquired any trademark rights or other proprietary interests relevant to support its claim to the dispute domain name. The registration of a certain domain name does not of itself confer upon the registrant rights or legitimate interests in the domain name or in the subject matter of the domain name. The Respondent does not appear to be using, or preparing to use the disputed domain name in connection with a bona fide offering of goods or services, nor does the Respondent make a legitimate non-commercial or fair use of the domain name. Rather the Respondent is using the disputed domain name to confuse Internet users as to the source, sponsorship or affiliation of the

website. Furthermore, no evidence shows that the Respondent has been commonly known by the disputed domain name.

The Panel therefore finds that the Complaint fulfills the condition provided in Paragraph 4(a)(ii) of the Policy.

Bad Faith

Under Paragraph 4 (b) of the Policy, the following are relevant examples a Panel may take as evidence of registration and use in bad faith:

- (i) Circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or
- (ii) You have 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 you have engaged in a pattern of such conduct; or
- (iii) You have registered the domain name primarily for the purpose disrupting the business of a competitor; or
- (iv) By using the domain name, you have intentionally attempted to attract, for commercial gain, internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.

The Complainant has been continuously using the trademark "SAROME" since its earliest registration in 1966. "SAROME" is not a name commonly used in trade. Through years of use and promotion, the Complainant's trademark "SAROME" has achieved a strong reputation. As such, the public has come to recognize and associate the Complainant's trademark "SAROME" as originating from the Complainant and no other. The evidence shows that the website of the disputed domain name contains links to various lighters and smoker's articles manufactured or sold by third parties, which are exactly the Complainant's main business. Under the circumstance, the Panel cannot but hold that the Respondent is aware of the existence of the Complainant and its trademark. The use of the disputed domain name to redirect Internet users to websites which sell goods in competition to the Complainant's goods is bad faith registration and use under Paragraph 4(b)(iv) of the Policy.

Based on the above finding, the Panel rules that the Complaint satisfies the condition provided in Paragraph 4 (a) (iii) of the Policy.

Status

www.sarome.com Domain Name Transfer

Decision

Having established all three elements required under the ICANN Policy, the Panel concludes that relief should be granted. Accordingly, it is ordered that the <sarome.com> domain name should be TRANSFERRED from the Respondent to the Complainant.

ZHAO Yun
Debrett LYONS
Hong Xue

DATED: 12 March 2009