



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

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Decision Submission

[English](#)
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Version
 Decision ID DE-0900220
 Case ID HK-0900240
 Disputed Domain Name www.tsmc.asia
 Case Administrator Dennis CAI
 Submitted By David Kreider
 Participated Panelist

Date of Decision 04-05-2009

Language Version : English

The Parties Information

Claimant Taiwan Semiconductor Manufacturing Co., Ltd.
Respondent David Jeng

Procedural History

On 9 January 2009, 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 one-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 16 January 2009, the ADNDRC sent to the Complainant by email an acknowledgement of the receipt of the Complaint and reviewed the format of the Complaint for compliance with the Policy, the Rules and the ADNDRC Supplemental Rules. All correspondence to and from the HKIAC described herein was in the English language.

On 16 January, and again on 11 February, 13 February and 23 February 2009, the ADNDRC transmitted by email to the Registrar, Mesh Digital Limited, a request for registrar verification in connection with the Disputed Domain Name. On 23 February 2009, the Registrar transmitted by email to the ADNDRC its verification response, confirming that the Respondent is listed as the registrant and providing the Registrant's contact details, as referenced above.

On 24 February 2009, the ADNDRC transmitted the Complaint to the Respondent and notified the Respondent of the commencement of the action by email, advising the Respondent that a Response was required to be filed on or before 16 March 2009.

On 1 March 2009, the Respondent, “大衛” (the Chinese characters pronounced “Da Wei” in the Mandarin dialect, represent the approximate Chinese equivalent of the English language name “David”), using the email address taipei101taipei@gmail.com, wrote to the ADNDRC enquiring whether the Response form could be emailed directly to the ADNDRC. The ADNDRC responded affirmatively by reply email on 2 March 2009.

On 17 March 2009, the Respondent submitted his Response, requesting that the ADNDRC appoint a one-person panel to proceed to render the decision.

Having received a Declaration of Impartiality and Independence and a Statement of Acceptance, the ADNDRC notified the parties that the panel in this case had been selected, with Mr. David KREIDER (“Panel”), acting as the sole panelist. The Panel determines that the appointment was made in accordance with the Rules and the ADNDRC Supplemental Rules.

On 18 April 2009, the Panel received the file from the ADNDRC and should render the Decision within 14 days, i.e., on

or before 4 May 2009.

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.

The Response was submitted one day beyond the 20-day deadline specified by Article 6(1) of the Supplemental Rules. Additionally, the Response bears the typewritten name of the Respondent, David Jeng, but is not signed by him as required by Rule 5(b)(viii).

The Panel considers that Respondent's late and deficient Response has not adversely affected these proceedings or prejudiced the Complainant. Accordingly, the Panel has elected to accept and consider the Response as if the Response had been filed timely, in proper form.

On 21 April, the Respondent communicated with the ADNDRC by email, enquiring whether he would be permitted to update the content of his response. Whereupon, the Panel sent an email to both parties, inviting the Respondent and the Complainant to submit supplemental statements, consisting of 1,000 words or less, not later than 24 April and 27 April, respectively, and informing the parties that no other or further submissions would be accepted or considered. The parties thereafter submitted their respective Supplemental Submissions timely.

Notwithstanding the Panel's clear instructions that further submissions would not be accepted, the Respondent nonetheless sent a further email to the Panel on 27 April 2009, purporting to set out additional grounds and argument. The Panel has ignored the Respondent's uninvited further supplemental submission.

Factual Background

For Claimant

The Complainant is Taiwan Semiconductor Manufacturing Co., Ltd., of No. 8, Li-Hsin Road VI, Hsinchu Science Park, Hsinchu, Taiwan. Complainant owns the TSMC Marks. "TSMC" is not only the acronym for Complainant's corporate name, but has also become a well-recognized synonym for Complainant within the semiconductor industry through its continuous use of the TSMC Marks in connection with its foundry and related services.

For Respondent

The Respondent is David Jeng, of No. 1, Central Street, Taipei, Taiwan. The Respondent is the current Registrant of the Disputed Domain Name. The Registrant Organisation is listed as "International peace organization", and the Registrant Phone appears as +886.800080123, as provided by the Whois information.

Parties' Contentions

Claimant

The Complainant's contentions may be summarized as follows:

I. INTRODUCTION

Taiwan Semiconductor Manufacturing Co., Ltd. was founded in 1987, and is currently the world's largest dedicated semiconductor foundry. As the founder and leader of this industry, Complainant has built its reputation by offering advanced wafer production processes and unparalleled manufacturing efficiency. From its inception, Complainant has consistently offered the foundry industry's leading technologies to its customers.

As the first dedicated foundry, Complainant has experienced strong growth by building solid partnerships with its customers, large and small. Integrated circuit suppliers from around the world trust Complainant with their manufacturing needs, thanks to its unique blend of cutting-edge process technologies, pioneering design services, manufacturing productivity, and product quality.

In 2002, Complainant became the first semiconductor foundry to enter the ranks of the top 10 integrated circuit companies in terms of worldwide sales, claiming the ninth spot. In 2007, Complainant was ranked sixth among integrated circuit companies in terms of worldwide sales, and its revenues represented about 50% of the dedicated foundry segment in the semiconductor industry. The following table shows Complainant's worldwide and Asia sales for the past five years.

Complainant's Sales in the Past Five Years

Year 2007:

Worldwide Sales (NT\$): 319,167,299,051

Asia Sales (NT\$): 87,060,092,051

Year 2006:

Worldwide Sales (NT\$): 319,210,148,458

Asia Sales (NT\$): 90,214,086,791

Year 2005:

Worldwide Sales (NT\$): 270,315,064,017

Asia Sales (NT\$): 88,921,556,405

Year 2004:

Worldwide Sales (NT\$): 260,726,895,560

Asia Sales (NT\$): 88,824,744,056

Year 2003:

Worldwide Sales (NT\$): 206,157,917,864

Asia Sales (NT\$): 69,768,607,061

Complainant's headquarters are located in Taiwan in the Hsinchu Science Park. Complainant has account management and engineering services offices in Hsinchu, Taiwan, Yokohama, Japan, Amsterdam, the Netherlands, and, in the United States, in San Jose, California, Orange County, California, Austin, Texas and Boston, Massachusetts. Complainant's manufacturing facilities are centralized in Taiwan, primarily in the Hsinchu Science Park and the Tainan Science Park. Complainant has additional facilities located in Camas, Washington (USA) (WaferTech), Singapore (SSMC, a joint venture with NXP Semiconductors), and Shanghai, China.

Complainant is listed on the Taiwan Stock Exchange and on the New York Stock Exchange under the trading symbol of TSM.

II. RESPONDENT'S DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO TRADEMARKS IN WHICH COMPLAINANT HAS RIGHTS

A. Complainant Has Strong and Long-Established Global Brand Identity and Rights in the TSMC Marks

Since at least the early 1990s, Complainant's customers, potential customers, industry analysts, and the public have used the TSMC Marks to quickly and easily identify Complainant as the legitimate source of goods and services branded with the TSMC Marks, and to identify a specific level of quality. Through continuous and prominent use of the TSMC Marks on goods and in connection with services, marketing materials, advertising, corporate communications, annual reports, bids, industry publications and at trade fairs, Complainant has established a strong brand identity that is inextricably associated with the distinctive TSMC Marks.

The TSMC Marks have developed substantial public goodwill and a widespread reputation for excellence in semiconductor foundry services. Complainant has made considerable expenditures, including time, money, and experience, to establish the TSMC Marks as identifiers of high quality foundry and related services. In fact, the TSMC Marks are among Complainant's most valuable assets.

Complainant has also registered and used various domain names that contain the term "TSMC" to leverage the value of its brand identity and the TSMC Mark. Through its wholly-owned U.S. subsidiary, Complainant registered the domain name www.tsmc.com with Network Solutions, LLC on or about April 8, 1993, and has been operating Complainant's corporate website using that domain name continuously through the present time. Complainant's website homepage at www.tsmc.com also serves as an entry point for its E-commerce portal, TSMC-Online, which enables customers to conduct business with Complainant around-the-clock.

In addition, Complainant and its subsidiaries own numerous other top level domain names containing the TSMC Mark throughout the world, including tsmc.com.tw, tsmc.tw, tsmc.co.jp, tsmc.biz and tsmc.info, among others.

B. Respondent's Domain Name is Identical or Confusingly Similar to the TSMC Marks

On or about March 26, 2008, Respondent registered the domain name TSMC.ASIA without the knowledge, consent or authority of Complainant. Complainant has never authorized Respondent to use the TSMC Marks in any manner,

including as part of any trademark, service mark, trade name or domain name.

The domain name TSMC.ASIA is identical or confusingly similar to Complainant’ s TSMC Marks. Indeed, the domain name TSMC.ASIA incorporates the TSMC Mark in its entirety. Respondent unabashedly misappropriates the TSMC Mark and uses the exact term “TSMC” in the subject domain name. See *Janus Int’ l Holding Co. v. Scott Rademacher*, Case No. D2002-0201 (WIPO Mar. 5, 2002) (As numerous courts and prior ICANN panels have recognized, the incorporation of a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to the complainant’ s registered mark.)

As noted above, Complainant’ s manufacturing operations are predominantly located in Asia. Thus, internet users seeking to access information about Complainant’ s services would likely believe the website located at TSMC.ASIA is operated by or otherwise affiliated with Complainant. However, as discussed in detail below, Respondent has set up the website located at TSMC.ASIA such that visitors of that website are automatically and wrongfully redirected to the corporate website of Semiconductor Manufacturing International Corp., Ltd. (“SMIC”), a major competitor of Complainant in the foundry industry. Respondent’ s choice of the subject domain name is clearly designed to attract consumers that are interested in Complainant’ s foundry services to visit the website located at TSMC.ASIA, and then – unbeknownst to these consumers – wrongfully redirect them to the website of Complainant’ s competitor who offers the same type of services. This is further evidence that the subject domain name is confusingly similar to the TSMC Marks, because without such confusing similarity Respondent’ s ruse would not work.

III. RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN THE DOMAIN NAME

A. Respondent is Neither Known By the Domain Name Nor Authorized to Use the TSMC Marks

As set forth in detail above, Complainant has exclusive rights in and to the TSMC Marks by virtue of its substantial and continuous use of those marks since at least the early 1990s and its numerous trademark registrations/pending applications for the TSMC Marks worldwide. Notably, as stated above, Complainant’ s exclusive rights in the TSMC Marks extend to numerous jurisdictions in Asia, including Taiwan, the geographic area in which Respondent is purportedly based. Complainant’ s exclusive rights in the TSMC Marks also extend to the People’ s Republic of China, where Complainant’ s competitor SMIC is based. As stated above, Respondent has set up the website at TSMC.ASIA such that visitors of that website are unknowingly redirected to the corporate website of SMIC.

To the best of Complainant’ s knowledge, Respondent is not identified or commonly known by the name “TSMC” or “TSMC.ASIA” and has not established any goodwill in the subject domain name. Complainant’ s use and registration of the TSMC Marks precedes Respondent’ s registration of the domain name TSMC.ASIA by at least 15 years. Respondent is in no way affiliated with Complainant. At no time has Complainant authorized Respondent to use the TSMC Marks anywhere in Asia or in any other territory in connection with any domain name or otherwise. Therefore, Respondent has no rights or legitimate interest in the subject domain name. *Arizona State University v. Value Holdings, Inc.*, Case No. D2001-0445 (WIPO May 31, 2001) (respondent had no rights or legitimate interests in the domain name where respondent is not commonly known as the domain name nor affiliated with the trademark holder).

B. Respondent Has Made No Legitimate Use of the Domain Name

To the best of Complainant’ s knowledge, Respondent has not made a legitimate non-commercial or fair use of the domain name. In fact, Respondent uses the domain name “TSMC.ASIA” solely to redirect visitors of the website located at TSMC.ASIA to the website of Complainant’ s competitor, SMIC, at WWW.SMICS.COM. Such use of the TSMC.ASIA domain name is clearly illegitimate given that Respondent has no affiliation with and no authorization from Complainant to use the TSMC Marks. Complainant has no information as to whether Respondent is affiliated with SMIC or remunerated by SMIC for his actions in connection with the registration and use of the TSMC.ASIA domain name, or whether he is asked by SMIC to engage in such actions. That notwithstanding, Respondent’ s wrongful diversion of Internet users who want to visit Complainant’ s website to the website of a major competitor of Complainant could create the false impression that the website at WWW.SMICS.COM is owned or otherwise affiliated with Complainant.

Respondent’ s attempt to divert traffic intended for Complainant to another website does not constitute a bona fide use or a legitimate non-commercial or fair use of the TSMC Mark. To the contrary, Respondent’ s action not only is an outrageous infringement of Complainant’ s rights in the TSMC Marks but also harms consumers who are confused, misled and deceived as to the source and affiliation of the services being offered by Complainant’ s competitor. *Inter-IKEA Systems B.V. v. Evezon Co. Ltd.*, Case No. D2000-0437 (WIPO Aug. 11, 2000) (finding respondent had no rights or legitimate interests in the domain name because “the mark IKEA is not one that the Respondent would legitimately choose in the context of provision of goods or services via a website unless seeking to create an impression of an association with the Complainant); *Dow Jones & Co., Inc. v. Down Jones Update*, Case No. D2000-0495 (WIPO Aug. 14, 2000) (finding no legitimate non-commercial or fair use of the disputed domain name, “dowjonesonline.com,” where respondent’ s website “is directed to persons who seek information about the stock market and class and advice

on successful investing,” trading on the DOW JONES mark for profit).

Moreover, Complainant’s competitor whose website gets the redirected traffic from TSMC.ASIA will unjustly benefit from the goodwill and commercial value built up by Complainant in the TSMC Marks. At the same time, Complainant will suffer from the permanent loss of substantial revenues should visitors to Complainant’s competitor’s website or purchasers of such competitor’s services be dissatisfied and believe that there is in fact some affiliation between Complainant and the competitor in question. As such, Respondent’s wrongful use of the subject domain name must be stopped to provide effective relief to Complainant.

Complainant’s investigations yielded strong indications that Respondent is not using the “TSMC” name other than online. The address provided by Respondent in his domain name registration is fake and non-existent, i.e., there is no such street address in Taipei. Thus, it is clear that Respondent does not do business under the “TSMC” name. See *Société des Hôtels Méridien v. Modern Ltd. – Cayman Web Dev.*, WIPO Case No. D2004-0321 (June 14, 2004) (domain name transferred where respondent failed to demonstrate it was commonly known by disputed domain name or actively conducted business under such name).

Based on the foregoing, Respondent has no rights or legitimate interest in the TSMC Marks or any domain name using such marks, including without limitation TSMC.ASIA.

IV. RESPONDENT’S DOMAIN NAME HAS BEEN REGISTERED AND IS BEING USED IN BAD FAITH

The TSMC Marks are well-recognized in the industry as source identifiers of quality semiconductor foundry services. Respondent was arguably aware of the TSMC Marks at the time it registered the TSMC.ASIA domain name. Indeed, Complainant contends that Respondent registered the TSMC.ASIA domain name because it was identical or confusingly similar to the TSMC Marks, thus evidencing Respondent’s bad faith. See *Marionnaud Parfumeries v. Balata, Inc.*, WIPO Case No. D2005-0291 (June 9, 2005) (finding that respondent acted in bad faith and had no interest in the subject domain name where respondent had actual or constructive knowledge of complainant’s mark and the disputed domain name diverted traffic to a website offering products identical to those of the complainant).

Respondent registered the domain name at least 15 years after Complainant’s first use of the TSMC Marks. That Respondent registered the subject domain name years after Complainant began using the TSMC Marks is strong evidence of Respondent’s bad faith in registering and using the domain name. *Arizona State University v. Value Holdings, Inc.*, Case No. D2001-0445 (WIPO May 31, 2001) (bad faith registration and use established where, inter alia, domain name registered years after trademark holder’s first use); *eBay Inc. v. Sunho Hong*, Case No. D2000-1633 (WIPO Jan. 18, 2001) (finding bad faith where respondent registered the disputed “ebaykorea.com” domain name well after eBay adopted the EBAY trademark).

Respondent has, without authorization, deliberately chosen the subject domain name TSMC.ASIA, which clearly suggests a connection to Complainant, to attract a target audience interested in Complainant’s foundry services, and then wrongfully redirect them to the website of Complainant’s competitor. Such deliberate misrepresentation on the part of Respondent – without which Respondent’s scheme to mislead visitors of the TSMC.ASIA would not work – is outrageous and clearly demonstrates bad faith in Respondent’s registration and use of the subject domain name. *Dell Inc. v. George Dell and Dell Net Solutions*, Case No. D2004-0512 (WIPO Aug. 24, 2004) ([W]hen a domain name is so obviously connected with a Complainant and its products, its very use by a registrant with no connection to the Complainant suggests ‘opportunistic bad faith.’).

The domain name TSMC.ASIA was registered and used in bad faith by Respondent for the sole purpose of diverting Internet users to the website of a major competitor of Complainant, by creating a likelihood of confusion with Complainant as to the source, sponsorship, affiliation, or endorsement of the SMIC website. As a result of Respondent’s use of the TSMC Mark in the TSMC.ASIA domain name and the intentional redirection of visitors to the SMIC website, consumers are likely to visit SMIC’s website and utilize SMIC’s services advertised there believing them to be the services of or approved by Complainant. Respondent has taken no steps to dispel consumer confusion or to disclaim any relationship between SMIC and Complainant. Consequently, the website owned and operated by a major competitor of Complainant benefits from the goodwill and commercial value created and enjoyed by Complainant in its TSMC Marks, all without authority from or compensation paid to Complainant. See *Cigna Intellectual Property, Inc. v. Yun Sung Lee*, Case No. D2003-1042 (WIPO Mar. 3, 2004) (By advertising products which might be generally associated with the Complainant’s mark, [here, health-related products,] it appears that the Respondent is attempting for commercial gain to attract Internet users by creating a likelihood of confusion with the Complainant’s mark).

V. CONCLUSION

As discussed above, Respondent’s domain name TSMC.ASIA is identical or confusingly similar to the TSMC Marks owned by Complainant. Further, Respondent has no rights or legitimate interests in respect of the TSMC.ASIA domain name. Moreover, Respondent has registered and used the domain name in bad faith. In other words, all three

requirements for Complainant to prevail in this proceeding are met. If Respondent continues to use and infringe upon the TSMC Marks in its domain name, consumers will be confused, misled and deceived as to the source and origin of the services offered at the website of a major competitor of Complainant (to which visitors of the website at TSMC.ASIA are redirected). Such competitor of Complainant will continue to benefit from the goodwill and commercial value enjoyed by Complainant in the TSMC Marks. At the same time, the distinctive value and reputation of the TSMC Marks will be diluted, impairing the value of Complainant's intangible property. Complainant will also suffer from the permanent loss of substantial revenues should visitors to Complainant's competitor's website or purchasers of such competitor's services be dissatisfied and believe that there is in fact some affiliation between Complainant and the competitor in question. As such, Complainant respectfully requests this panel to find in favor of Complainant and order the transfer of the subject domain name to Complainant.

Complainant's Supplemental Statement recites as follows:

 In a one-paragraph reply to the claims leveled by Complainant TSMC, Respondent utterly fails to provide evidence rebutting any of Complainant's claims. So this tribunal must rule in favor of Complainant and order the transfer of the domain name from Respondent to Complainant.

I. Respondent concedes that the tsmc.asia domain name is identical or confusingly similar to a trademark to which Complainant has rights

Complainant demonstrated that it has rights in and uses the TSMC Marks (as defined in the complaint) throughout the world, including numerous jurisdictions in Asia. "TSMC" is not only the acronym for Complainant's corporate name, but has also become a synonym for Complainant in the semiconductor industry, and in the investor community through Complainant's continuous use of the TSMC Marks in connection with its foundry and related services. Respondent does not dispute these facts. In fact, Respondent acknowledges Complainant's trademark rights in his supplemental submission.

Respondent also does not dispute that the domain name tsmc.asia is identical or confusingly similar to the TSMC Marks. In any event, it is undisputable that the domain name incorporates the TSMC Mark (as defined in the complaint) in its entirety.

II. Respondent has utterly failed to show that he has a right or legitimate interests in the tsmc.asia domain name

Respondent asserts that "TSMC" stands for "Teachers Students Meeting Center" whose "users consist the people from a lot of countries in Asia." However, Respondent fails to provide any evidence that he is actively using the tsmc.asia domain name for such a "center" or that such a "center" genuinely exists. He submitted no document showing that he has registered any entity with the name "Teachers Students Meeting Center," or that he has posted substantive content on the "center" website, or that any there has been any visit to his website by his purported users.

Complainant ran several Internet searches and found no references to a "Teachers Students Meeting Center." The lack of coverage by several major search engines shows that the purported "Teachers Students Meeting Center" is virtually unknown. The evidence suggests that Respondent is not commonly known by the name "TSMC" or "tsmc.asia." Coupled with the fact that Complainant has never authorized Respondent to use the TSMC Marks, it is clear that Respondent has no rights or legitimate interest in the domain name.

III. Respondent has registered and used the tsmc.asia domain name in bad faith

As detailed in the complaint, Respondent had set up the website located at tsmc.asia to wrongfully redirect its visitors to the website of Semiconductor Manufacturing International Corp., Ltd. ("SMIC"), a major competitor of Complainant. Significantly, Respondent does not deny having done so. To the best of Complainant's knowledge, the web traffic redirection had been taking place at least until Complainant filed its complaint.

Thereafter, evidently in response to TSMC's complaint, Respondent at least for the moment appears to have modified the website to stop redirecting visitors to SMIC's home page. The site now displays a page having the title "TSMC (Teacher Students Meeting Center)" with no link to any other content. The statement "This website is under building" on the page confirms that the site has no content apart from the home page.

Respondent has failed utterly to show that the so-called "center" is or has ever been operational. Indeed, viewed in the context of its original purpose of redirecting visitors to TSMC's competitors, as well as the fact that Respondent provided a fake, non-existent address in his domain name registration, set out in detail in TSMC's complaint, it should be presumed that this is nothing more than an artifice and a sham, and that Respondent conjured up the term "Teachers Students Meeting Center" after the fact in a crude effort to claim that he has rights to the domain name and to cover up his bad faith registration and use of same. Substituting a sham webpage for one that redirects users to a competitor's webpage neither absolves Respondent of the liability that resulted from his bad faith acts, nor gives him any right to the

domain name. Without the remedy sought by Complainant, there is nothing to prevent Respondent from reverting to its prior intent to redirect users intending to seek information regarding TSMC.

Respondent

The Respondent's contentions may be summarized as follows:

In his Response, the Respondent states: "Most of the descriptions from the Complaint are incorrect. We have the legal right to own this domain name. We think the panelist should see the website. Thank you!!"

Under the heading "Remedies Sought", the Response states: "\$45,000 USD (described after the panelist is elected)".

The Respondent's name "David Jeng" is typewritten beside the word "Signature", but the Response is unsigned. Beside the words "Name and Capacity (in print)" is typed "David Jeng" and the words "CEO of the TSMC (Teacher and student meeting center)".

Respondent's Supplemental Statement recites as follows:

TSMC is the abbreviated word of the "Teachers Students Meeting Center". We provide the platform to let the people find their suitable teachers and students. Our users consist the people from a lot of countries in Asia. So, we have this domain name in good use. And we registered this domain name under the rules of ".ASIA". The company "Taiwan Semiconductor Manufacturing Company Limited" has no right to announce any complaint, because they do not obey the register rules of ".ASIA". Even in the domain name bidding period last year, we would still join the bidding process and challenge with the other competitors. But in the period, the "Taiwan Semiconductor Manufacturing Company Limited" did not join the bid. We think the "Taiwan Semiconductor Manufacturing Company Limited" don't care about the Asia domain name and they will not use it kindly. For the trade mark, they only have the trade mark in electric device. They do not have the trade mark in other areas, i.e. teachers and students meeting service. So, our register and usage of the "TSMC.ASIA" are all legal.

On the other side, the "Taiwan Semiconductor Manufacturing Company Limited" uses the unfriendly way to lock our website for months and causes the large loss of our legal right. We think they should take the responsibility of indemnification.

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:

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

Identical / Confusingly Similar

The evidence shows that the Complainant has rights in and to the TSMC Marks by virtue of its substantial and continuous use of those marks since at least the early 1990s and its numerous trademark registrations and pending applications for the TSMC Marks worldwide. Complainant's rights in the TSMC Marks extend to numerous jurisdictions in Asia, including the People's Republic of China and Taiwan. The Complainant's rights in the TSMC Marks substantially predate the Respondent's registration of the Disputed Domain Name, on March 26, 2008. The Disputed Domain Name, <TSMC.ASIA>, incorporates the TSMC Mark in its entirety and is identical or confusingly similar to Complainant's TSMC Marks. *Janus Int'l Holding Co. v. Scott Rademacher*, Case No. D2002-0201 (WIPO Mar. 5, 2002) (As numerous courts and prior ICANN panels have recognized, the incorporation of a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to the complainant's registered mark.)

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, and that it alone has rights in the TSMC Marks and that “TSMC” is not only the acronym for Complainant’s corporate name, but has also become a synonym for Complainant in the semiconductor industry.

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 interest.

On its part, the Respondent asserts that “TSMC is the abbreviated word of the ‘Teachers Students Meeting Center.’ We provide the platform to let the people find their suitable teachers and students”. Respondent’s unsigned Response included a reference to the Respondent, David Jeng, as the “CEO of the TSMC (Teacher and Student Meeting Center)” .

Respondent further asserts that the Complainant did not bid for the Disputed Domain Name and, accordingly “has no right to announce any complaint, because they do not obey the register rules of ‘.ASIA’ ”.

Respondent’s argument on this issue is misplaced.

As recited above, the Complainant has rights in and to the TSMC Marks by virtue of its substantial and continuous use of those marks since at least the early 1990s and its numerous trademark registrations and pending applications for the TSMC Marks worldwide. Furthermore, as is recited in the Complaint, Complainant and its subsidiaries own numerous top level domain names containing the TSMC Mark, including tsmc.com.tw, tsmc.tw, tsmc.co.jp, tsmc.biz and tsmc.info, among others.

However, the Complainant’s failure to bid to register the Disputed Domain Name at the earliest opportunity does not create or enhance any right or legitimate interest the Respondent might have in the domain name. This is because Rule 2 provides that it was the Respondent’s responsibility to determine whether the Disputed Domain Name registration infringed upon or violated someone else’s (here, the Complainant’s), rights at the time of registration, irrespective of whether Complainant might itself have wished to seek to register the Disputed Domain Name.

Significantly, the Complainant asserts that the Disputed Domain Name resolves to a website that wrongfully redirected visitors to the website of Semiconductor Manufacturing International Corp., Ltd. (“SMIC”), a major competitor of Complainant “at least until Complainant filed its complaint”, and that in response to the filing of the complaint, the Respondent “appears to have modified the website to stop redirecting visitors to SMIC’s home page [and]… now displays a page having the title “TSMC (Teacher Students Meeting Center)” with no link to any other content” .

The Panel finds that, in violation of Rule 2, the Respondent was clearly aware of the Complainant’s reputation and goodwill when he registered the domain name. Furthermore, the fact that the Respondent arranged for the domain name to resolve to the website of the Complainant’s competitor, SMIC, indicates that the Respondent intentionally registered the Disputed Domain Name for the purpose and with the intent of attempting to attract Internet users to his website for commercial gain, by creating a likelihood of confusion with the Complainant’s trademark.

The Complainant asserts “that the Respondent has failed utterly to show that the so-called ‘center’ is or has ever been operational”; that the street address provided by the Respondent in the Registration Agreement is fictitious; and that “it should be presumed that this [the Teacher Student Meeting Center] is nothing more than an artifice and a sham, and … a crude effort to claim that he [Respondent] has rights to the domain name and to cover up his bad faith registration and use of same” .

A search on Google Maps shows no street address in Taiwan of the name “No. 1, Central Street, Taipei”, the address given by Respondent on his Registration Agreement. Moreover, Respondent uses in his email address the name of Taiwan’s iconic skyscraper “Taipei 101”. A Google search by the Panel indicates that the street address of “Taipei 101” is No.45,Shihfu Rd,Sinyi District,Taipei, not “Central Street” .

Additionally, the Registration Agreement describes the registrant organisation as an “international peace organization”. This Panel can find no evidence anywhere in the record, which might tend to show that the Respondent’s purported “Teacher Students Meeting Center” is an “international peace organization” .

Finally, it is noted that the Respondent has produced no documentary evidence whatsoever, which might tend to lend credibility to his purported “Teacher Student Meeting Center”, such as a contract to which the center is a party, or a certificate of incorporation. Whereas, in support of its position, the Complainant has submitted evidence of recent Internet search engine enquiries, which reflect a complete absence of any Internet footprint or similar verification of any record of bona fide activities on the part of the Respondent’s “Teacher Student Meeting Center” .

On balance, therefore, the Panel strongly favors the Complainant's evidence that the Respondent's website to which the Disputed Domain Name resolves was set up by the Respondent for the purpose of wrongfully redirecting visitors to the website of the Complainant's competitor, "SMIC", over the Respondent's unsupported allegations, purporting to show that it is making a legitimate or non-commercial use of the domain name through the "Teacher Student Meeting Center".

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

Bad Faith

Respondent registered the domain name at least 15 years after Complainant's first use of the TSMC Marks. That Respondent registered the subject domain name years after Complainant began using the TSMC Marks is strong evidence of Respondent's bad faith in registering and using the domain name. *Arizona State University v. Value Holdings, Inc.*, Case No. D2001-0445 (WIPO May 31, 2001) (bad faith registration and use established where, inter alia, domain name registered years after trademark holder's first use).

The Respondent's bad faith registration of the Disputed Domain Name is further established by the Respondent's breach of warranty and misrepresentation by providing a fictitious street address and a false description of the Registrant as an "international peace organization" in the Registration Agreement, in breach of Rule 2(a).

The Panel notes the Respondent's demand in the Response for a monetary remedy in these proceedings, in the form of payment by the Complainant of USD\$45,000, an amount which grossly exceeds any conceivable claim for reimbursement of the Respondent's reasonable out-of-pocket expenses related to the domain name.

The Panel considers that the Respondent had in mind at the time of registration and at all at material times thereafter, the possibility of selling it to the Complainant, or of otherwise using the domain name, in bad faith, for financial gain, such as by the instant claim for a monetary "remedy". *Telefonaktiebolaget L.M Ericsson v. iNuntius Inc.*, WIPO Case No. D2005-0732 (October 25, 2005) (The Panel, therefore, rejects the Respondent's arguments and considers that the offer it made [after the filing of the complaint] tends much more to indicate that the Respondent bore in mind when acquiring [the disputed domain name] the possibility of selling it to the Complainant, a well-known company, for a sum far in excess of the usual out-of-pocket expenses related to a domain name.)

Respondent's choice of the subject domain name was clearly designed to attract consumers that are interested in Complainant's foundry services to visit the website located at TSMC.ASIA, and then – unbeknownst to these consumers – wrongfully redirect them to the website of Complainant's competitor, SMIC, who offers the same type of services.

Respondent has, without authorization, deliberately chosen the subject domain name TSMC.ASIA, which clearly suggests a connection to Complainant, to attract a target audience interested in Complainant's foundry services, and then wrongfully redirect them to the website of Complainant's competitor. Such deliberate misrepresentation on the part of Respondent – without which Respondent's scheme to mislead visitors of the TSMC.ASIA would not work – clearly demonstrates bad faith in Respondent's registration and use of the subject domain name. *Dell Inc. v. George Dell and Dell Net Solutions*, Case No. D2004-0512 (WIPO Aug. 24, 2004) ([W]hen a domain name is so obviously connected with a Complainant and its products, its very use by a registrant with no connection to the Complainant suggests 'opportunistic bad faith.').

After being given multiple opportunities in these proceedings to do so, the Panel finds it significant that the Respondent has nowhere denied or refuted Complainant's allegation that the Respondent's website wrongfully redirected visitors to the website of Complainant's competitor, SMIC. *AstraZeneca AB v. Alvaro Collazo*, Case No. D2005-0367 (WIPO May 23, 2005) (Given this lack of candour on the part of the Respondent, the distinctiveness of the Complainant's mark, the fact that the Respondent was clearly aware of the Complainant's reputation and goodwill when he registered the domain names and the fact that he has arranged for these domain names to resolve to a website that offers retail sales of pharmaceutical products, indicates that the Complainant is correct in alleging that the Respondent is intentionally attempting to attract for commercial gain, Internet users to his website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or of a product or service on the Respondent's website).

The relationship between Complainant's competitor, SMIC, and Respondent does not appear from the evidence, and can only be surmised. The Panel finds, however, that the Respondent has taken no steps to dispel consumer confusion or to disclaim any relationship between SMIC and Complainant. Consequently, the website owned and operated by a major competitor of Complainant, through the re-direction of visitors by Respondent's website to it, benefits from the goodwill and commercial value created and enjoyed by Complainant in its TSMC Marks, all without authority from or compensation paid to Complainant. *Cigna Intellectual Property, Inc. v. Yun Sung Lee*, Case No. D2003-1042 (WIPO

Mar. 3, 2004) (By advertising products which might be generally associated with the Complainant' s mark, [here, health-related products,] it appears that the Respondent is attempting for commercial gain to attract Internet users by creating a likelihood of confusion with the Complainant' s mark.).

In conclusion, the Panel finds that the Respondent has registered and used the domain name in bad faith and that the Complaint satisfies the condition provided in Paragraph 4 (a) (iii) of the Policy.

Status

www.tsmc.asia 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 <TSMC.ASIA> domain name should be TRANSFERRED from the Respondent to the Complainant.

David KREIDER
Sole Panelist

Dated: 30 April 2009