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Sweet domain name victory for M&M's

Mars has successfully fought off a local company's attempt to register a domain name similar to its M&M's trademark. This case, the first decision of Taiwan's newly-established domain dispute resolution panel, will give hope to famous trade mark owners, argues Sylvia Shiue

Taiwan's newly established domain dispute resolution panel made its first decision on August 6 2001. The panel decided in favour of Mars against the respondent, Champion Technology Corp's registration of the domain name, "m-ms.com.tw".

The Domain Dispute Resolution Policy, which went into effect on March 1 2001, is based on ICANN's Uniform Dispute Resolution Policy (UDRP) (see Carol Liu and Robin J Winkler, 'New tool to help domain name owners hold on to their names', *IP Asia*, March 2001). The Taiwan Network Information Center (TWNIC) formulated the policy, but is not involved in the arbitration process itself, instead relying on dispute resolution providers it appointed on March 29 2001:

- The Taipei Bar Association.
- The Science & Technology Law Centre.

These dispute resolution providers are charged with forming panels ranging from one to three members to resolve domain disputes. If either the complainant or the respondent in any case is dissatisfied with the dispute resolution panel's decision, they may bring suit against their counterpart either in court, or through the Fair Trade Commission. Any initiation of litigation within 12 days of the dispute resolution panel's decision is sufficient to stay implementation of such a decision.

The arguments at stake

The M&M's complaint was filed on June 15 2001 with the Science and Technology Centre. In its submission, Mars made the following points:

- The M&M's trade mark was first registered in Taiwan in 1976. The brand is a famous mark in Taiwan and throughout the world. M&M's products are available throughout Taiwan, and Mars has gone to considerable expense to promote and market M&M's in Taiwan.
- By registering the m-ms.com.tw domain (which is similar to the M&M's trade mark) ahead of Mars, the respondent had deprived Mars of its right to register its own domain name in Taiwan. Moreover, the respondent's failure to connect the m-ms.com.tw domain to internet content would lead consumers to the mistaken impression that Mars could not provide comprehensive service for its product in Taiwan, thus seriously damaging the company's corporate image and restricting its business opportunities.
- The respondent's name (Champion Technology in English, Ch'ing P'in K'e Chi Ku Fen You Hsien Kung Sih in Chinese) is not at all similar to the domain name in dispute. Champion Technology's response included the following points:
 - m-ms.com.tw is in no way similar to the name of either Mars, the maker of M&M's, or Effem, its Taiwan subsidiary, thus no confusion could exist in the minds of consumers.

- Champion plans to utilize the disputed domain name at such time as its content would be ready for posting.
- No possibility of confusion between Champion and Mars/Effem could exist as Champion is registered as a maker of electronic fans and heat sinks, whereas Mars/Effem are registered as confectioners.

Famous mark criteria

The panel accepted that M&M's is a famous mark based on considerations that may provide a useful reference for other trademark owners:

- M&M's advertisements consistently rank among the top 10 internet commercials globally.
- Business management books regularly cite Mars as a successful business model.
- Mars's US factory is a well-known tourist attraction.
- Effem (Taiwan) is known for being a prominent philanthropic organization in Taiwan.

The decision states that M&M's and m-ms.com.tw were similar enough to cause confusion in the minds of ordinary users of the internet, ie users would naturally assume that m-ms.com.tw was the domain representing M&M's. The respondent was ruled not to have any rights to the domain name because the company name, Champion Technology, is not similar to the domain name. The respondent was also unable to demonstrate that it owned any trade marks that looked or sounded similar to "m-ms". Finally, the respondent was unable to prove that its use of the domain name was well known to the general public, or that it had made a sincere effort to connect the domain to internet content. These and other facts demonstrated to the panel that the respondent registered the domain name in bad faith.

The decision is a good example of how Taiwan's new Dispute Resolution Policy can be an effective, efficient, and inexpensive alternative to court or FTC actions.

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