



Asian Domain Name Dispute Resolution Centre
a charitable institution limited by guarantee registered in Hong Kong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1300506
Complainant:	Shenzhen Yongnuo Photographic Equipment Co. Ltd
Respondent:	jinruihua
Disputed Domain Name(s):	<yongnuostore.com>

1. The Parties and Disputed Domain Name

The Complainant is Shenzhen Yongnuo Photographic Equipment Co. Ltd, of B509 5/F, Building 2, Saige Science and Technology Park, North Huaqiang Road, Futian District, Shenzhen, China.

The Respondent is jinruihua of Nanshan, Shenzhen, Guangdong, China.

The domain name at issue is yongnuostore.com (the “Disputed Domain Name”), registered by the Respondent with Name.com LLC.

2. Procedural History

On 18 June 2013, the Complainant filed a Complaint in relation to the Disputed Domain Name with the Asian Domain Name Dispute Resolution Centre (“ADNDRC”). On 19 June 2013, the ADNDRC confirmed the receipt of the Complaint.

On 19 June 2013, the ADNDRC notified the Registrar of the Disputed Domain Name (“Registrar”) of the proceedings by email and requested the Registrar to provide verification in connection with the Disputed Domain Name. On 20 June 2013, the Registrar confirmed by email to the ADNDRC that, amongst other things, the Respondent is the registered holder of the Disputed Domain Name.

On 2 July 2013, the ANDRC confirmed receipt of the required administrative filing fee.

On 4 July 2013, the ADNDRC notified the Complainant of deficiencies in the Complaint and on 9 July 2013, the Complainant submitted to the ADNDRC a revised Complaint, together with annexures. The Complainant also sent a copy of the Complaint and annexures to the Respondent on the same day at jinruihua@live.cn, the email contact address for the Respondent as recorded in the Whois information for the Disputed Domain Name.

The proceedings commenced on 11 July 2013 and by Written Notice of Complaint, the Respondent was informed that he had 20 days to submit a Response, i.e., on or before 31 July 2013.

The Respondent did not submit a Response within the required period of time.

The Panel, comprised of Matthew Laight as a single panelist, was appointed on 15 August 2013. The papers were delivered to the Panel by email on the same day.

On 17 August 2013 the Respondent sent an email to the Panel stating "*we have ceased to use the domain yongnuostore.com*".

3. Factual background

The Complainant was established on 15 November 2006 in China and set up a Hong Kong branch of its business in December 2007. The Complainant is involved in the product development, manufacturing and retailing of professional photographic equipment. The Complainant has trade mark registrations for YONGNUO as a word trade mark ("**Word Trade Mark**") and also as a composite trade mark ("**Composite Trade Mark**") (collectively "**Trade Marks**") in 37 countries around the world including in the United States, Hong Kong and China and the European Union. The Complainant filed its first application for registration of the Composite Trade Mark in the United States on 29 October 2008 and obtained its first trade mark registration for the Word Trade Mark in China on 29 September 2009.

The Respondent is recorded in the Whois database as jinruihua. The Respondent registered the Disputed Domain Name on 18 February 2012.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. The Respondent has registration for the Trade Marks in 37 countries around the world, including Hong Kong, China, the United States and the European Union. The Disputed Domain Name incorporates the Complainant's Trade Marks and the generic word "store". As a result, the Disputed Domain Name is identical or confusingly similar to the Complainant's Trade Marks.
- ii. The Complainant's company registration and Trade Marks registration predates the Respondent's registration of the Disputed Domain Name by over 2 years. The Complainant is the sole and legal owner of the Trade Marks and never authorized another party to use the Trade Marks in their domain name. Further, the Respondent's behaviour has confused consumers. The Complainant therefore submits that the Respondent does not have any legitimate rights or interests in the Disputed Domain Name.

- iii. The Complainant's Trade Marks are highly distinctive and well known around the world, including in Shenzhen where the Respondent is based. It is inconceivable that the Respondent was unaware of the existence of the Complainant when it registered the Disputed Domain Name. The only plausible explanation for the Respondent's use of the Trade Marks is for the Respondent to fabricate a false association with the Complainant and its business. Samples of emails from confused customers were provided by the Complainant.
- iv. The Respondent makes prominent unauthorized use of the Complainant's Trade Marks and has made extensive use of images taken from the Complainant's website for which the Complainant has exclusive rights. The Respondent's website sells photographic equipment which are direct copies of the Complainant's products. This behaviour confuses consumers and damages the Complainant's goodwill and reputation and is a deliberate attempt by the Respondent to attract commercial users to the site.
- v. Further, the contact number provided by the Respondent recorded in the Whois records does not exist.

B. Respondent

The Respondent did not file a response within the time required. However, on 17 August 2013, the Respondent by email to the Panel indicated that it had ceased to use the Disputed Domain Name.

5. Findings

Language of proceedings

Paragraph 11(a) of the Policy Rules of Procedure provides that:

"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."

In the present case, the registration agreement for the Disputed Domain Name is in English. Further, the Complaint was drafted and filed in English and the Respondent while not filing a formal response has sent the email referred to above in English and has not requested that the proceedings be conducted in a language other than English. In these circumstances, the Panel considers that it would be appropriate for the present proceedings to be conducted in English.

The Policy

The ICANN Uniform Domain Name Dispute Resolution Policy (“the Policy”) provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

- i. the Respondent’s domain name 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 Respondent’s domain name has been registered and is being used in bad faith.

The Panel notes that while a Respondent is not obliged to participate in a proceeding under the Policy, if it fails to do so, asserted facts may be taken as true and reasonable inferences may be drawn from the information provided by the Complainant: *Reuters Limited v Global Net 2000, Inc* D2000-0441 and *Microsoft Corporation v Freak Films Oy* D2003-0109.

A) Identical / Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainant to prove that the Disputed Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights.

The Complainant has established that it is the owner of registrations for the Trade Marks in Hong Kong, PRC, the United States and is the owner of a Community Trade Mark. The evidence before the Panel shows that the earliest date of trade mark registration for the Composite Trade Mark is 29 October 2008, being the United States registration and 29 September 2009 for the Word Trade Mark, being the PRC registration.

The Disputed Domain Name is not identical to the Complainant’s Trade Mark therefore the issue before the Panel is whether the Disputed Domain Name and the Complainant’s Trade Marks are confusingly similar.

In so far as the Composite Trade Mark is concerned, as the design elements of a trade mark cannot be replicated in a domain name, they are not included in comparing the similarity between the alphanumeric sequence portions of the mark and domain name, see *General Machine Prods. Co., v Prime Domains*, Case No. FA0092531. Therefore the Composite Word Trade Mark will be given the same treatment as the Word Trade Mark in determining whether the Disputed Domain Name and the Complainant’s Trade Marks are confusingly similar.

The Disputed Domain Name, in addition to incorporating the Complainant’s Trade Marks in their entirety, contains the word “store”. It has been held in many prior decisions that when a domain name incorporates a registered mark in its entirety, such as is the case here, it will tend to be confusingly similar to that registered trademark, see *Heidelberger*

Druckmaschinen AG v. Wayne Graham (Trading) Limited WIPO Case No. D2006-1131. Further, the Panel finds that the addition of the word “store”, being a generic descriptive term, does not detract from the confusingly similarity, see *Koninklijke Philips Electronics N.V. v. Lewis & Clark, Inc.*, WIPO Case No. D2011-1344, and *Caterpillar Inc. v. Roam the Planet, Ltd.*, Case No. D2000-0275. The Panel finds that the Disputed Domain Name is confusingly similar to the Complainant’s Trade Mark

Accordingly, the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B) Rights and Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires the Complainant to prove that the Respondent has no rights or legitimate interests in the Disputed Domain Name.

For the purposes of Paragraph 4(a)(ii), Paragraph 4(c) of the Policy sets out three specific circumstances (set out below) which can help the Respondent demonstrate it has a right or a legitimate interest in the Disputed Domain Name. Paragraph 4(c) of the Policy provides that if the Panel considers it proven that, based on its evaluation of all evidence presented to it, the Respondent satisfies any of the following circumstances, the Respondent will have shown that it has a right or legitimate interest in the Disputed Domain Name:

- i) before the Respondent has any notice 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 is in connection with a bona fide offering of goods or services; or
- ii) the Respondent (as an individual, business, or other organisation) has been commonly known by the Domain Name, even if the Respondent has acquired no trade mark or service mark; or
- iii) the Respondent is making a legitimate non-commercial or fair use of the Disputed Domain, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.

The onus is on the Complainant to demonstrate that the Respondent has no rights or legitimate interests in the Disputed Domain. Once prima facie evidence has been adduced, the burden shifts to the Respondent to prove otherwise (see *Six Continents Hotels, Inc v Patrick Ory*, WIPO Case No D2003-00098).

The Panel finds that the Complainant has established a prima facie case that the Respondent has no rights or legitimate interest in the Disputed Domain Name, and the Respondent has not satisfied any of the circumstances (i) to (iii) as set out under Paragraph 4(c) of the Policy. The Panel’s reasons are provided below.

In *Okidata, Oki Data Americas, Inc v ASD, Inc* WIPO Case No. D2000-0903, the Panel set out the requirements for there to be a “bona fide” offering of goods or services. Those include, at the minimum, that the Respondent must be offering the goods or services at issue, the Respondent must use the site to sell only the trade marked goods; and the site must accurately disclose the registrant’s relationship with the trade mark owner.

It is not apparent from the Complaint and the evidence provided as to whether the Respondent has been offering genuine goods of the Complainant or copies of those goods for sale on the website at the Disputed Domain Name. However, in any event, the Panel finds that it does not need to determine this issue because it is apparent that the Respondent has not accurately disclosed its relationship with the Complainant.

There is no reference on the screenshot provided that makes clear to consumers that the Respondent is not the Complainant or is not affiliated with the Complainant. Rather the screenshot shows the Respondent's website being conducted under the name "Yongnuo photo equipment online store" together with the device component of the Complainant's Composite Trade Mark.

In the case of *Houghton Mifflin Co v The Weathermen, Inc.* WIPO Case No D2001-0211 it was held that a licensee or reseller using a domain name that consists solely of a trade mark owner's mark must take steps to prevent confusion by making it clear in its use of the domain name that it is not the owner, even if it offers legitimate goods. The Panel considers that these comments equally apply here where the Complainant's Trade Marks have been incorporated into the Disputed Domain Name together with a generic term. Further, the emails from confused customers writing to the Complainant about issues with ordered products not being received or for products that have been purchased and not received in full demonstrate this.

As a result, the Panel finds that the use of the Disputed Domain Name by the Respondent does not correspond with a bona fide offering of goods and paragraph 4(c)(i) of the Policy is not satisfied by the Respondent.

There is no evidence before the Panel to show that the Respondent is commonly known by the Disputed Domain Name. The Complainant contends that it has no relationship with the Respondent and the Respondent has no permission to use the Complainant's Trade Marks. As the Respondent did not provide a substantive response to the Complaint, there is no evidence to the contrary. Accordingly, paragraph 4(c)(ii) of the Policy is not satisfied by the Respondent.

Similarly, given the above, there is no evidence before the Panel to show that the Respondent is making a legitimate non-commercial or fair use of the Disputed Domain Name without intent for commercial gain to misleadingly divert consumers. In fact, the evidence before the Panel shows otherwise as the Respondent has offered for sale goods under the Complainant's Trade Marks and further, that this has resulted in consumers being misled given the emails the Complainant has received from confused consumers. Accordingly, paragraph 4(c)(iii) of the Policy is not satisfied by the Respondent.

On this basis, the Panel finds that the Respondent does not satisfy circumstances (i) to (iii) under Paragraph 4(c) of the Policy and therefore has not answered the prima facie finding that the Respondent has no rights or legitimate interest in the Disputed Domain Name.

The Panel also notes that the email from the Respondent of 17 August 2013 further supports that the Respondent does not have any legitimate rights or interests in the Disputed Domain Name as the Respondent indicated that it will cease to use the Disputed Domain Name.

C) Bad Faith

Paragraph 4(a)(iii) of the Policy requires the Complainant to prove that the Disputed Domain is registered and is being used by the Respondent in bad faith.

For the purposes of Paragraph 4(a)(iii), Paragraph 4(b) of the Policy sets out four non-exclusive criteria which, if satisfied, shall be evidence that the Respondent's registration and use of the Disputed Domain is in bad faith:

- i) the Respondent has registered or acquired the Disputed Domain primarily for the purpose of selling, renting, or otherwise transferring the Disputed Domain registration to the Complainant who is the owner of the trade mark or service mark or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the Disputed Domain; or
- ii) the Respondent has registered the Disputed Domain in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or
- iii) the Respondent has registered the Disputed Domain primarily for the purpose of disrupting the business of a competitor; or
- iv) by using the Disputed Domain, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's web site 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 the Respondent's web site or location or of a product or service on the Respondent's web site or location.

As set out above, the earliest trade mark registration of the Complainant dates back to 29 October 2008. The domain name was registered by the Respondent on February 2012, being some 3 years after the Complainant filed its trade mark application in the United States and over 5 years after the Complainant was established. Further, the Respondent offers (or offered) for sale products under the Complainant's Trade Marks, it is apparent that the Respondent was well aware of the Complainant when it registered the Disputed Domain Name.

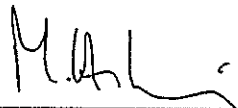
The screenshot provided by the Complainant shows the Respondent trading on the website under the name "Yongnuo photo equipment online store", using the device component of the Complainant's Composite Word Mark and without stating that it is not related to the Complainant. The Panel therefore finds that the Respondent registered the Disputed Domain Name to disrupt the business of the Complainant, being its competitor.

It is also apparent from the emails that the Complainant received from confused consumers that they considered that the Respondent is, or is related to or affiliated with, the Complainant. The Panel further finds given the above that by using the Disputed Domain Name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's web site by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's web site and/or product or service on the Respondent's web site.

Accordingly, the Panel finds that the Disputed Domain Name has been registered and used in bad faith.

6. Decision

For the foregoing reasons, the Panel concludes that the Complainant has sufficiently proven all of the three elements set out in Paragraph 4(a)(i) to (iii) of the Policy. The Complaint is therefore allowed and the Panel orders that the Disputed Domain Name be transferred to the Complainant.

A handwritten signature in black ink, appearing to read 'M. Laight', is written above a horizontal line.

Matthew Laight
Panelist

Dated: 29 August 2013