



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1400583
Complainant:	UL LLC and Underwriters Laboratories Inc.
Respondent:	TAKURO ISHIZU
Disputed Domain Name(s):	<ul-china.com>

1. The Parties and Contested Domain Name

Complainant is UL LLC of USA and Underwriters Laboratories Inc. of USA (hereinafter collectively referred to “Complainant.”).

Respondent is TAKURO ISHIZU, of FUNABASHISHI, Japan.

The domain name at issue is <ul-china.com>, registered by Respondent with RESELLERSRS INC., of 9450 SW Gemini Dr. #48732, Beaverton OR 97008, United States.

2. Procedural History

Complainant submitted a Complaint to the Asian Domain Name Dispute Resolution Centre (Hong Kong Office) electronically on March 12, 2014; the ADNDRC Hong Kong Office received payment on March 12, 2014.

On March 17, 2014, RESELLERSRS INC. confirmed by e-mail to the ADNDRC Hong Kong Office that the <ul-china.com> domain name is registered with RESELLERSRS INC. and that Respondent is the current registrant of the name. RESELLERSRS INC. has verified that Respondent is bound by the RESELLERSRS INC. registration agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN’s Uniform Domain Name Dispute Resolution Policy (the “Policy”).

On March 18, 2014, the ADNDRC Hong Kong Office served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of April 7, 2014 by which Respondent could file a Response to the Complaint, via e-mail to all entities and persons listed on Respondent’s registration as technical, administrative, and billing contacts, and : info@will-link.com . Also on March 18, 2014, the Written Notice of the Complaint, notifying Respondent of the e-mail addresses served and the deadline for a Response, was transmitted to Respondent via post and fax, to all entities and persons listed on Respondent’s registration as technical, administrative and billing contacts.

On March 19, 2014, Respondent sent e-mail correspondence in Japanese to the ADNDRC Hong Kong Office to the effect that he was willing to transfer the disputed domain name in a proper way to Complainant under the procedures of ICANN as he registered the disputed domain name legitimately and he requested for the proceedings in Japanese because he is a Japanese person. On March 20, 2014, the ADNDRC Hong Kong Office forwarded this correspondence to Complainant for its comments. Complainant did not submit any comments.

Having received no response from Respondent, on April 9, 2014 the ADNDRC Hong Kong Office transmitted to the parties a Notification of Respondent Default.

On April 28, 2014, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the ADNDRC Hong Kong Office appointed Ho-Hyun Nahm, Esq. as Panelist. The undersigned certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as Panelist in this proceeding.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the ADNDRC Hong Kong Office has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent" through submission of Electronic and Written Notices, as defined in Rule 1 and Rule 2. Therefore, the Panel may issue its decision based on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, the ADNDRC's Supplemental Rules and any rules and principles of law that the Panel deems applicable, without the benefit of any response from Respondent.

3. Factual background

Complainants UL LLC and Underwriters Laboratories Inc., independent safety consulting and certification provider, are originally established in 1894 and headquartered in U.S.A.

Complainant has more than a century of expertise innovating safety solutions from the public adoption of electricity to new breakthroughs in sustainability, renewable energy and nanotechnology. Complainant provides safety-related certification, validation, testing, inspection, auditing, advertising and training services to a diverse array of stakeholders, including manufacturers to optimize their supply chains, retailers on inspections and audits, and industry on standards that create level playing fields. Complainants' key businesses include product safety, verification services, life and health, knowledge services and environment.

Complainant has employees in 40 countries and regions around the world. In 2013, Complainant evaluated 20, 268 types of products and nearly 22 billion UL marks were used on various products, to make the world safer and provide assurance. UL customers appeared in 104 countries and nearly 700 million consumers were reached with safety messages in Asia, Europe and North America.

In Asia, Complainant has offices in Japan, Korea, Mainland China, Hong Kong, Taiwan, Singapore, Bangladesh, India, Sri Lanka and United Arab Emirates. In Japan, Complainant has 8 offices, including Chiba where Respondent resides (Annex 14).

Respondent is a Japanese individual who resides in Japan. The disputed domain name was registered on July 27, 2013.

4. Parties' Contentions

A. Complainant

(i) the disputed domain name is confusingly similar to Complainant's registered trademark UL in which Complainant has rights;

(ii) Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name was registered and is being used in bad faith by the Respondent

B. Respondent

Respondent failed to submit a Response in this proceeding.

5. Preliminary Issues: Language of Proceedings

The Panel notes that Respondent requested for the language of proceedings to be Japanese because he is a Japanese person. However, the Panel observes that the language of the registration agreement is English, and thus determines that language of the proceedings is English.

6. Findings

In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(e), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. *See Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (Nat. Arb. Forum July 31, 2000) (holding that Respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); *see also Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

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

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

A) Identical / Confusingly Similar

Complainant contends that it enjoys rights in a number of UL trademarks in China, Japan, and various other countries covered by the Madrid international trademark registrations. It avers that after over a century's extensive use and continuous advertisement by the Complainant, the UL trademark enjoys very high and broad reputation worldwide, including in Japan where Respondent resides.

Complainant submits that “UL” stands for Complainants’ trade name “UL” or the abbreviation of its trade name “Underwriters Laboratories”. “UL” is a brand name coined by Complainants, and no other third party appears to have used the mark UL in the past commercially except in relation to Complainants.

Complainant asserts that it owns trademark registrations in Japan for the UL logo mark (*e.g.*, Reg. No. 3199674, registered September 30, 1996). *See* Complainant’s Annex 8. Complainant further contends that the mark “UL” is exclusively associated with Complainants, and known primarily as an identifier of Complainants’ products and services. In addition, the mark UL is a coined word and a highly distinctive mark. It also asserts that incorporation of Complainants’ distinctive and famous UL trademark in entirety in the disputed domain name in itself establishes that the disputed domain name is confusingly similar to the UL trademark.

The Panel observes that Respondent lives in Japan. Therefore, the Panel finds that Complainant’s JPO registration of the UL logo mark sufficiently provides rights in the mark under Policy ¶ 4(a)(i). *See Paisley Park Enters. v. Lawson*, FA 384834 (Nat. Arb. Forum Feb. 1, 2005) (concluding that Complainant had established rights in the PAISLEY PARK mark under Policy ¶ 4(a)(i) through registration of the mark with the USPTO).

Complainant asserts that Respondent’s <ul-china.com> domain name is confusingly similar to Complainant’s UL logo mark. The Panel notes that Respondent adds the generic or descriptive term “china” to its disputed domain name. The Panel holds that Respondent’s addition of a generic or descriptive term to Complainant’s UL mark does not distinguish the domain name from the mark under Policy ¶ 4(a)(i). *See Am. Express Co. v. MustNeed.com*, FA 257901 (Nat. Arb. Forum June 7, 2004) (finding Respondent’s <amextravel.com> domain name confusingly similar to Complainant’s AMEX mark because the “mere addition of a generic or descriptive word to a registered mark does not negate” a finding of confusing similarity under Policy ¶ 4(a)(i)).

As such, the Panel concludes that the disputed domain name is confusingly similar to Complainant’s mark.

B) Rights and Legitimate Interests

Complainant must first make a *prima facie* case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy ¶ 4(a)(ii), and then the burden shifts to Respondent to show it does have rights or legitimate interests. *See Hanna-Barbera Prods., Inc. v. Entm’t Commentaries*, FA 741828 (Nat. Arb. Forum Aug. 18, 2006) (holding that Complainant must first make a *prima facie* case that Respondent lacks rights and legitimate interests in the disputed domain name under UDRP ¶ 4(a)(ii) before the burden shifts to Respondent to show that it does have rights or legitimate interests in a domain name); *see also AOL LLC v. Gerberg*, FA 780200 (Nat. Arb. Forum Sept. 25, 2006) (“Complainant must first make a *prima facie* showing that Respondent does not have rights or legitimate interest in the subject domain names, which burden is light. If Complainant satisfies its burden, then the burden shifts to Respondent to show that it does have rights or legitimate interests in the subject domain names.”).

Complainant contends that Respondent has never been licensed or authorized to use the trademark UL or to use it to register the disputed domain name. It also contends that to the best of its knowledge, Respondent does not hold any UL trademarks or trademarks incorporating the

letters “UL”. It asserts that Respondent thus does not have trademark right in respect of the disputed domain name.

Complainant submits that no plausible explanation exists to suggest the possibility of any circumstances of the type specified in paragraph 4(c) of the Policy, or of any other circumstances giving rise to a right to or legitimate interest of Respondent in the disputed domain name. It also argues that Respondent’s use of the disputed domain name is not a *bona fide* use pursuant to paragraph 4(c) of the Policy, and there is no indication that Respondent has been commonly known by the disputed domain name.

The Panel notes that Respondent fails to provide any evidence that it is known by the disputed domain name. Thus, the Panel concludes that Respondent is not commonly known by the disputed domain name pursuant to Policy ¶ 4(c)(ii). See *Coppertown Drive-Thru Sys., LLC v. Snowden*, FA 715089 (Nat. Arb. Forum July 17, 2006) (concluding that Respondent was not commonly known by the <coppertown.com> domain name where there was no evidence in the record, including the WHOIS information, suggesting that Respondent was commonly known by the disputed domain name).

Under the circumstance that Respondent did not reply, the Panel finds that Complainant has proven a *prima facie* case that Respondent has no rights or legitimate interests in the disputed domain name. See *De Agostini S.p.A. v. Marco Cialone*, WIPO Case No. DTV2002-0005; see also *Accor v. Eren Atesmen*, WIPO Case No. D2009-0701.

Given the above circumstances, the Panel concludes that Respondent has no rights or legitimate interests in the disputed domain name, and the second element of the Policy has been established.

C) Bad Faith

Complainant contends that Respondent has been engaging in a pattern of conduct of acquiring expired domain names he believes of high commercial value. It continues to contend that none of the above domain names held by Respondent has been put into actual use. It asserts that they are either inactive or hosting a blog site with similar contents with the disputed domain name. Complainant avers that Respondent deliberately registered domain names in order to prevent the others from registering and using them, and the ultimate purpose of Respondent is not to use them for a *bona fide* offering of goods or services, but to offer to resell them back to the original owners or their competitors, for unjustified commercial gains.

The Panel agrees that re-registration of a domain name by another shortly after its accidental expiration amounts to opportunistic bad faith. See *Bryant Tyson v. Fundacion Private Whois/ Domain IP Holding Corp.*, WIPO Case No. D2013-0529; *Kevin Nealon v. Whois Protection*, WIPO Case No. D2007-1225; *Rug Doctor L.P. v. Domain Strategy, Inc.*, WIPO Case No. D2002-0355. The panel found bad faith registration and use pursuant to Policy ¶ 4(b)(ii) where respondent registered the <ul-china.com> domain name to prevent complainant from reflecting the UL and CHINA mark in a corresponding domain name. Thus, the Panel finds that Respondent’s registration of the disputed domain name shows bad faith use and registration under Policy ¶ 4(b)(ii).

Complainant contends that Respondent, by using the disputed domain name, is trying to profit from the diversion of Internet users by confusion between the disputed domain name and Complainant, and disrupts business of Complainants. It further contends that the purpose of

registering the disputed domain name is to trade on the fame of Complainants' famous trademark UL, in order to attract, for commercial gain, Internet users to visit the corresponding website under the Domain Name, by creating a likelihood of confusion with Complainants and the UL trademark. Complainant argues that the disputed domain name is currently used to misleadingly direct traffic to a website not associated with Complainant, while Internet users are likely to assume that by visiting the disputed domain name, they would access information provided by Complainant about its services in China. Complainant also asserts that Respondent has traded on such confusion to direct traffic to its own site and such use of has caused *de facto* confusion and misidentification as to the affiliation to Complainants.

The Panel observes that Respondent's disputed domain name resolves to web page displaying various menus and articles under the title "How to Become Happy by Solving Agonies in Dating at Work" in Japanese. See Complainant's Annex 3.

As the Panel finds that Respondent is using the disputed domain name to divert Internet users searching for Complainant to Respondent's related website is commercially benefitting, the Panel holds that Respondent has registered and is using the disputed domain name in bad faith under Policy ¶ 4(b)(iv). See *Fossil Inc. v. NAS*, FA 92525 (Nat. Arb. Forum Feb. 23, 2000)

As such, the Panel concludes that the disputed domain name was registered and is being used in bad faith.

7. Decision

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <**ul-china.com**> domain name be **TRANSFERRED** from Respondent to Complainant.

Ho-Hyun Nahm, Esq., Panelist
Dated: May 11, 2014