



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (BEIJING OFFICE)

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Decision Submission

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Decision ID	DE-0800205
Case ID	CN-0800223
Disputed Domain Name	www.YUYANG.com
Case Administrator	lvyan
Submitted By	Shaojie Chi
Participated Panelist	
Date of Decision	26-11-2008

The Parties Information

Claimant	YUYANG.COM
Respondent	George Murhy

Procedural History

On August 15, 2008, the Complainant submitted the Complaint in English to the Beijing Office of the Asian Domain Name Dispute Resolution Centre (the "Centre"), in accordance with the Uniform Domain Name Dispute Resolution Policy (the "Policy") adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN") on August 26, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy Disputes (the "Rules") approved by ICANN on October 24, 1999, and Asian Domain Name Dispute Resolution Centre Supplemental Rules for Uniform Domain Name Dispute Resolution Policy Disputes (the "ADNDRC Supplemental Rules") being effected on February 28, 2002. The Centre confirmed the receipt of the Complaint.

Then, the Center transmitted by email to ENOM, Inc. (the Registrar of the domain name) a request for registrar verification in connection with the domain name at issue. On August 16, 2008, the Centre received from the registrar the confirmation on the registration information with regard to the disputed domain name.

On August 25, 2008, the Centre sent the Complaint to the Respondent and asked for the Response as regulated.

On September 9, 2008, the Centre sent to the parties the notification of the commencement of the proceedings, and of the matter the claims have been confirmed and forwarded; and notified ICANN and registrar of the start of the proceedings.

The Centre received the Response dated September 27, 2008 from the Respondent, and confirmed to the Respondent the receipt of it; and conveyed the Response to the Complainant.

On October 6, 2008, the Centre notified the parties of the selection of panelist; and after, having got the choices by the parties, contacted the candidate sole expert on October 21, 2008.

Having received a Declaration of Impartiality and Independence and a Statement of Acceptance from Mr. Chi Shaojie on October 30, 2008, the Centre informed the Complainant and the Respondent of the appointment of the sole panelist on the same day. The Center transferred all the case materials to the panel on the day, and asked the panel to submit a decision before November 13, 2008.

In accordance with the circumstances of this case, The panel and the Center decide to extend the deadline of the decision to November 23, 2008.

The sole panelist finds that the panel was properly constituted in accordance with the Rules and the ADNDRC Supplemental Rules.

The procedural language is English, as being the language of the Domain Name Registration and Service Agreement, pursuant to Paragraph 11(a) of the Rules, and also in conformity with the language used by both parties in the submitted documents.

Factual Background

For Claimant

The Complainant contends that its business name is 浙江裕阳知识产权代理有限公司 (Zhejiang Yuyang Intellectual Property Agency Co., Ltd.), and it has established reputation by offering clients services in relation to IP matters. It obtained from a third party three registered trademarks, the major parts of them contain the Chinese characters 裕阳 and its Chinese phonetic spelling YUYANG. The disputed domain name is yuynag.com which is almost the same as the Complainant's registered trademark. The Respondent can hardly claim any right or legitimate interest in the disputed domain name; and made the registration with malice. The Complainant thinks its allegations meet the criteria as set forth under the Policy, and thus requesting the panel to make an award on the transfer or cancellation of the registered domain name.

For Respondent

The Respondent argues that the Complainant obtained the trademarks on September 21, 2006 or July 23, 2007, later than the Respondent made the registration of the disputed domain name. The Complainant does not register a trademark in USA. The Respondent registered the domain name because of concern for a Chinese friend whose name is Yu Yang. The Chinese phonetic spelling Yuyang may be in conformity with lots of Chinese characters. The Respondent made the registration without malice, and it is the Complainant who is aiming at the reverse domain name hijacking.

Parties' Contentions

Claimant

The fundamental contentions by the Complainant include:

- 1) It's one of the largest intellectual property agencies in Zhejiang Province and has built up a big name by offering excellent services to the clients.
- 2) It has been using the business name 浙江裕阳知识产权代理有限公司 (Zhejiang Yuyang Intellectual Property Agency Co., Ltd.) ever since its coming into being; and the Chinese phonetic spelling of its trade name 裕阳 is Yuyang.
- 3) It has three trademarks assigned by a third party, which are graphical design, Chinese characters and Chinese phonetic spelling of the word Yuyang. Obviously, the disputed domain name yuyang.com is almost the same as Complainant's registered trademark, and may cause confusion to the consumers.
- 4) The Respondent has no legitimate rights or interests in relation to the disputed domain name.
- 5) The Respondent publicized the notice of selling the domain name and the application form of buying it on its website, to reveal the fact that the Respondent registered and used the disputed domain name with malice.

Based upon the above fundamental reasons, the Complainant thinks all the three conditions set forth under the relevant paragraph of the Policy for the request for transfer or cancellation of the disputed domain name have all been met.

Respondent

The basic arguments by the Respondent are:

- 1) It registered the disputed domain name earlier than the Complainant obtained the alleged trademarks, thus being entitled to the domain name; and this is self-explanatory to the allegation by the Complainant that the Respondent made the registration in order to make use of the Complainant's reputation.
- 2) It uses the word YUYANG as the identifying part of the disputed name is because of concern for his friend by the name of Yu Yang; and is prepared to give the domain name to the friend;
- 3) The word Yuyang may be translated into lots of Chinese characters, instead of just what the Complainant claims to be 裕阳; thus the Complainant has no right to claim for the word Yuyang;

- 4) The Complainant is not as famous as being alleged;
- 5) The main purpose of the Complainant is to reverse hijack the domain name at issue.

Due to the above-cited reasons, the Complainant's request should not be supported.

Findings

One of the Pre-requisites for the Respondent to register the disputed domain name through the Registrar is to accept the Policy as the binding regulations for the registration. As mentioned, the Policy applies to this dispute as the substantive criteria for making the judgment of whether the Complainant's request is to be sustained or rejected. As stipulated in the Paragraph 4(a) of the Policy, when claiming back a domain name registered by the Respondent, the Complainant must prove each of the following:

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

Based itself upon the stipulations under the Policy, what the Panel needs to do is to find out whether all of the above-mentioned facts can be proved by the Complainant. If the answer is yes, the Panel makes an award in the Complainant's favor in accordance with the fact-finding and the relevant stipulations under the Policy, the Rules and the ADNDRC Supplemental Rules. If not, the claims by the Complainant shall be rejected.

The Panel makes comprehensive study of what the Respondent argues, and has a feeling that different conclusions may be made on the dispute by panelists with different cultural and historical backgrounds and the mentalities thereupon. Even for this Panel, it is not easy to make a final decision with regard to whether the Complainant's request should be sustained or rejected. Nevertheless, since a complaint has been filed with the Centre and a panel constituted by the Centre, the Panel has no other choice but to make an award, either in favor of the Complaint or of the Respondent. After many thoughts trying to balance the interests between the disputing parties, the Panel makes the following fact-finding and decision, ONLY BASED UPON THE UNDERSTANDING OF WHAT THE POLICY REQUIRES.

Identical / Confusingly Similar

Pursuant to Paragraph 4(a) (i) of the Policy, the Complainant must prove that the domain name at issue is identical or confusingly similar to a trademark or service mark to which it has rights. To meet the requirement, the Complainant submits three trademark registration certificates to prove the fact that it is entitled to the trademark that contains the word Yuyang; and the identifying part "yuyang" of the disputed domain name is identical to the word. The Respondent claims that it registered the disputed domain name because of concern for a friend by the name of Yu Yang and is prepared to give the domain name to him. The word Yuyang may be translated not only into the Chinese characters that alleged to be the Complainant's trade name, but also into many other Chinese characters and names. After thinking it over and over, the Panel decides to hold that the Complainant meets the first requirement set forth by the Policy, for the transfer or revocation of a registered domain name, due to the following reasoning:

- 1) As stipulated under the relevant paragraph of the Policy, the first finding is WHETHER THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO THE COMPLAINANT'S REGISTERED TRADEMARK. Thus what the Panel needs to do is to compare the domain name at issue with the claimed registered trademark of the Complainant's. As is known to the domain name registrants and web users, the part of ".com" in the registered domain has no much significance in identifying the registrant. Thus, the identifying part of the disputed domain name is "yuyang" which is to be used to compare with the Complainant's registered trademark.
- 2) The complainant claims and proves to own a registered trademark which contains a word yuyang.
- 3) The Respondent argues that the Complainant obtained the registered mark later than the disputed name was registered; and the word may be translated into many Chinese characters. The panel holds the Respondent's argument, but think that it should not be a significant factor in making the judgment on whether the disputed domain name is identical or confusingly similar to a registered trademark by the Complainant.
- 4) As it is, to look at the identifying part of the disputed domain name, i.e. yuyang, and at the word yuyang in the Complainant's registered mark, one can hardly say the two are NOT identical.

5) Since the Panel cannot make a holding that the identifying part yuyang of the disputed domain name is NOT identical to the word yuyang in the trademark the Complaint is currently entitled to, the Panel has no other choice than to say that the Complaint meets the first requirement set forth under Paragraph 4(a)(i) of the Policy.

Rights and Legitimate Interests

Pursuant to Paragraph 4(a)(ii), the second requirement for the Complainant to meet in terms of the request for transfer or revocation of the disputed domain name is to prove that the Respondent does not have any right to or legitimate interest in the domain name. In the present case, both of the disputing parties claim to be entitled to the disputed domain name. Generally speaking, when the Complainant submits that the Respondent does not have any right to or legitimate interest in the disputed domain name, it is difficult for him to prove the alleged fact that he thinks does not exist. As it is, the Panel always pays attention to what the Respondent claims. Paragraph 4(c) of the Policy stipulates how the Respondent can effectively demonstrate rights or legitimate interests in respect of the disputed domain name.

The Respondent submits that he registered the domain name prior to the acquisition of the registered trademark by the Complainant, which the Complainant thinks contains the word yuyang that is alleged to be identical to the disputed domain name. Also, the Respondent submits that the word yuyang in the disputed domain name was created by him because of concern for a friend by the name of Yu Yang; and the word yuyang may be translated into not a few Chinese characters, and the characters 裕阳 in the Complainant's business name is just one of them. Due to those facts, the Respondent regards himself as the right holder of the disputed domain name.

Paragraph 4(c) of the Policy regulates three conditions for the Respondent to prove his rights to or legitimate interests in the disputed domain name, i.e.

- 1) Before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services, or
- 2) You (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- 3) You are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

In comparison of what the Respondent argues in connection to his entitlement to the disputed domain name with what is laid down in Paragraph 4(c) of the Policy, the panel can hardly hold that the Respondent has rights to or legitimate interests in the disputed domain name; especially due to the fact that he does not submit that he has used the disputed domain name in the way as mentioned under Paragraph 4(c) of the Policy. It is true that the Respondent can prove that the date he made the registration of the domain name at issue is earlier than that of the Complainant's acquisition of the trademarks from a third party; but he fails to prove his registration date is earlier than that of the assignor making the registration of those assigned trademarks. In comparison with the assignor of the trademarks at issue, the Panel can hardly say that the Respondent has any right to or legitimate interest in the disputed domain name. Legally speaking, when the third party assigned the trademarks at issue to the Complainant, he has assigned all the rights or interests attached, previously or afterwards, to the assigned trademarks to the Complainant.

The Respondent argues that the word yuyang may be translated into many Chinese characters. The Panel agrees to the argument. Logically speaking, the holding does not deduct to the holding that the Respondent has a right to the word yuyang since he has not proved why and how he has a right to the word yuyang. The Respondent alleges that he has a friend by the name of Yu Yang, but fails to prove the allegation. On the other side, lots of Chinese names may be phonetically spelt into the word yuyang. Thus, how the Panel may make a conclusion that the Respondent should have a right to or legitimate interest in the word yuyang?

In view of the above reasoning, the Panel can hardly support what the Respondent submits and further holds that the Complainant meets the second requirement set forth under Paragraph 4(a)(ii).

Bad Faith

The Complainant also has to establish the fact of bad faith on the part of the Respondent as set forth in the Paragraph 4(a)(iii) of the Policy. Under the Paragraph 4(b)(i) of the Policy, the following circumstances, in particular, shall be considered evidence of the registration and use of a domain name 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, …….” The Complainant submits that the Respondent registered the disputed domain name for sale and proves its allegation by notarized evidence. The Respondent does not argue against and prove what the Complainant's submission is not true. Thus, the Panel cannot help but holds that the Respondent is trying to sell the domain name at issue for whatever consideration.

On the other side, having gone through the whole content of the Respondent's defense, the Panel has got no feeling that the Respondent registered the dispute domain name in good faith. As a natural person with an occidental name, the Respondent makes it difficult for the Panel to believe that he has any cultural or historical linkage to the disputed domain name, especially he has any reasonable connection to the domain name in relation to its fair use. The fact of aimed sale of the domain name by the Respondent reveals, at least to certain extent, his intention for the registration.

Since the Panel comes to see the bad faith of the Respondent in the registration and use of the domain name at issue, the Panel comes to the conclusion that the Complainant meets the requirement set forth under Paragraph 4(a)(iii) of the Policy.

Based upon all the above findings, the Panel rules that the Complaint fulfills the conditions provided in Paragraph 4(a)(i) (ii) (iii) of the Policy. However, the Panel attends to that the Complainant has lodged two alternative requests, i.e. transfer or cancellation of the disputed domain name. For the following reasons, the Panel chooses to adjudicate that the domain name at issue shall be revoked.

- 1) When the Panel holds that the Complainant meets the three requirements under the Policy, it based itself upon three fundamental facts, i.e. the identifying part of the disputed domain name is identical to the word in the Complainant's registered trademark, the Respondent fails to prove its rights to or legitimate interests in the disputed domain name, and the intentional sale of the disputed domain name by the Respondent on the web-site demonstrates his bad faith in the registration and use of the disputed domain name.
- 2) While the Panel does not hold that the Respondent has rights to or legitimate interests in the disputed domain name, it can hardly hold that the Complainant is the right-holder of the domain name, since there are at least certain giant businesses in China using the trade names that may be phonetically spelt into the word yuyang.
- 3) Province-wide speaking, the Complainant may be famous in the field of IP matters. The Complainant fails to establish the fact that it has a big name nation-wide, or even worldwide. Thus, the Panel is not sure that there will be no other parties claiming rights to or legitimate interests in the disputed domain name; this uncertainty makes it impossible for the Panel to make an award on the transfer of the disputed domain name.

Status

www.YUYANG.com Domain Name Cancel

Decision

In light of all the foregoing findings and in accordance with Paragraphs 4(a), 8(a) of the Policy and 5(e) of the Rules, the Panel holds:

- a) That the disputed domain name "yuyang.com" is identical to the trademark "YUYANG" to which the Complainant is entitled, and
- b) That the Respondent has no rights to or legitimate interests in the disputed domain name; and
- c) That the domain name was registered and subsequently used by the Respondent in bad faith.

As such the Panel rules that the registration of the domain name "yuyang.com" should be revoked.

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