

ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE
(Beijing Office)
ADMINISTRATIVE PANEL DECISION
Case No. CN-1000404

Complainant: Dell Inc.
Respondent: Honest Wisdom SinoDNS
Domain Name: dell-and-hp.com
Registrar: ENOM, INC.

1. Procedural History

On 26 August 2009, the Complainant submitted its Complaint to the Beijing Office of the Asian Domain Name Dispute Resolution Centre (the "ADNDRC Beijing Office"), 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"), and ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy Disputes (the "ADNDRC Supplemental Rules"). The Complainant requested for one member panel to hear the case.

On 28 August 2009, the ADNDRC Beijing Office confirmed the receipt of the Complaint and transmitted by email to ICANN and the Registrar of the domain name in dispute, ENOM, INC., a request for registration verification of the disputed domain name.

On 23 April 2010, the Registrar transmitted by email to the ADNDRC Beijing Office its verification response, confirming that the Respondent is listed as the registrant and providing the contact details.

On 27 October 2010, the ADNDRC Beijing Office transmitted the Complaint to the Respondent.

On 26 November 2010, the ADNDRC Beijing Office notified the Complainant that the Complaint had been confirmed and forwarded, and the ADNDRC Beijing Office notified the Respondent, the Registrar and

the ICANN of the commencement of the case proceeding.

The Respondent failed to submit a Response within the specified time period. On 28 December 2010, the ADNDRC notified both parties of the Respondent's default.

Having received a Declaration of Impartiality and Independence and a Statement of Acceptance on 28 December 2010, the ADNDRC notified the parties on 29 December 2010 that the Panel in this case had been selected, with Mr ZHAO Yun acting as the sole panelist. The Panel determines that the appointment was made in accordance with Rules 6 and Articles 8 and 9 of the Supplemental Rules.

On 29 December 2010, the Panel received the file from the ADNDRC and should render the Decision within 14 days, i.e., on or before 12 January 2011.

2、 Factual Background

For the Complainant

The Complainant in this case is Dell Inc. The registered address is 1 Dell Way, Round Rock, TX 78682-2222, USA. The Complainant is the owner of the trademark "DELL". The authorized representative of the Complainant in this case is Jingyan Wei.

For the Respondent

The Respondent in this case is Honest Wisdom SinoDNS. According to the record in the Whois database, the Respondent's domain name "dell-and-hp.com" was registered on 16 May 2009 through ENOM, INC..

3、 Parties' Contentions

Complainant

The Complainant enjoys rights in the registered trademark, "DELL/戴尔". At the same time, the Complainant has registered a number of domain names, all of which the distinctive element is "DELL". As a result, the

Complainant's rights in the trade mark "DELL" and "戴尔" are protected by PRC Law.

(1) The domain name in dispute and the Complainant's trade mark and trade name are confusingly similar

The Complainant, with its headquarters located in Austin, Texas, is a global leader in technology and computer products and services. Through direct contact with consumers, the Complainant also provides a range of technological products and services. The Complainant strives to provide the best customer experience and to become the leader in its market, through producing computers that are tailored for customer's needs. Because the Complainant directly dispatches its products to customers, this has enabled it to effectively understand and respond to its customers' needs and wants. Through many years of continuous development, the Complainant currently employs over 47,800 employees, the Complainant's revenues have reached US\$435 million in the past four financial quarters.

The reason behind the Complainant's rapid development is its innovative way of utilizing the internet. The Complainant's use of the internet has allowed it to surpass the direct-sales method, which has given it a competitive advantage over its competitors. In 1994, the Complainant launched its website, www.dell.com, with an online retailing function being added in 1996, which encouraged its retail business to develop via the internet. In 2005, the Complainant became the first company to have online sales reach US\$1 million. Today, with the help of the Microsoft Windows operating system, the Complainant operates the world's largest internet commerce site. Currently, the Complainant's PowerEdge server runs the website www.dell.com, which serves 84 countries with 28 languages/dialects and 29 currencies. Every year, there are over 10 million visitors on the website. Furthermore, according to the 2002, Volume 9 Chinese edition of "Business Weekly", "DELL" was ranked 31st out of "100 of the world's most valuable brands". As can be seen from the amount of online traffic the Complainant's website has and the external rankings of the brand, the Complainant is favored amongst the world's consumers.

The Complainant is aware of the growing importance of the internet throughout its entire business, including information gathering, customer support and the management of customer relations. Hence, www.dell.com provides a forum for its customers to obtain software peripherals, obtain price quotes and to rate and review its full range of products, including desktops, laptops, monitors, servers, storage products “Dell | EMC”, “Dell PowerVault™”, workstations and network products. Furthermore, users can order products online at any time and also monitor the production process and delivery status of their goods. Through perseverance, the Complainant has maintained its growth, profit margins and stability in its liquidity, enabling the company to have high returns. The Complainant has always been a major competitor within its industry.

The Complainant is a truly renowned business in the world. It is one of the best within the computer industry and occupies a respected position. As such, anyone who, without authorization, uses an identical or similar mark to “DELL”, as a dominant part of their domain name and sells related products, will be likely to lead a large proportion of consumers to either mistakenly associate the website with the Complainant or be under the impression that the site is authorized or supported by the Complainant in any way.

The Respondent’s registered domain name, “dell-and-hp.com”, excluding the generic domain name ending “.com”, is basically comprised of the words “dell-and-hp”. The domain name “dell-and-hp” is composed of “dell”, a hyphen and “and-hp”. The Disputed Domain Name is therefore essentially composed of the Complainant’s trade mark, “DELL”, combined with another reputable computer trade mark “hp” (Hewlett Packard). Taking into account that the Complainant’s trade mark is widely known, when consumers see the trade marks DELL and hp forming the Disputed Domain Name, they will be easily misled into thinking that the domain name either belongs to the Complainant, that the website is an online retail site jointly run by both the Complainant and HP, or that the website is somehow associated with the Complainant. Therefore, the Complainant believes that the Disputed Domain Name

and its trade mark are confusingly similar, which fulfills Regulation 4(a)(i) of the UDRP.

According to previous domain name arbitration decisions, where a reputable trade mark is placed with a word that is descriptive of the industry, the registered domain name will be taken as confusingly similar to the reputable trade mark.

(2) The Respondent enjoys no legal rights in the Disputed Domain Name

Through investigations, the Complainant has discovered that the majority of goods offered for selling on the Disputed Domain Name's website are unauthorized Dell products. The Complainant has downloaded a copy of the website. On numerous occasions, the Complainant has written warning letters to the Respondent informing the Respondent that its actions of selling unauthorized Dell products constituted trade mark infringement and unfair competition. However, the Respondent not only has failed to provide any evidence of authorization from the Complainant, but has refused to remove the infringing content on its website and has therefore continued to violate the Complainant's intellectual property rights. At the same time, the Respondent is using another trade mark in the computer industry, "hp", in the same domain name. The facts thus indicate that the Respondent is fully aware of Dell's reputation. Despite this, the Respondent still proceeded to register the Disputed Domain Name and to use the Complainant's "DELL" trade mark without authorization to conduct its business activities. Therefore, the Respondent's use of the Disputed Domain Name is not use in good faith, as the ultimate aim of using the similar domain name is to mislead customers and to obtain an unfair commercial advantage.

Furthermore, the Respondent does not enjoy any rights or legitimate interests in the dominant parts of the Disputed Domain Name, nor does it have any basis for using an associated name in good faith. As noted above, although the Respondent's use of the Disputed Domain Name infringes the Complainant's trade mark, the ultimate goal of the Respondent is actually to deceive consumers.

In conclusion, the Respondent does not comply with any of the situations specified in the Regulation 4(c) of the UDRP and therefore does not enjoy any lawful rights in the Disputed Domain Name.

(3) The Respondent's registration and use of the Disputed Domain Name is obviously in bad faith

As mentioned above, the Complainant's trade marks have already been registered in the PRC and numerous other countries for computer equipment and electrical appliances. There has also been extensive advertising worldwide, leading to a high degree of recognition amongst a large proportion of consumers. "DELL/戴尔" is one of the best brands in the PRC and the rest of the world within the IT sector.

The Respondent was fully aware of the high degree of recognition by consumers of the Complainant's trade mark, and yet proceeded to register and use the Disputed Domain Name. Not only that, the Respondent also offered for selling computer products bearing the Complainant's trade mark. These acts have seriously damaged the Complainant's reputation and normal business activities. Furthermore, the Respondent's acts have caused confusion in the relevant sector of the public by luring customers to its website and to ultimately enable the Respondent to obtain commercial gain.

The Complainant initially filed complaint against the disputed domain name in September 2009. At the time of filing of the complaint, "Li Ren" was identified as the Respondent in the complaint. In June 2010, the Registrar responded to the complaint and notified the Beijing Office of the ADNDRC that the information of the domain registrant has changed (since May 2010).

On the Whois record the Registrar provided, the Respondent/Domain Registrant of the disputed domain is now changed to "Honest Wisdom SinoDNS". The Complainant has been requested by the ADNDRC to amend the complaint with the updated information of the domain registrant. However, as shown on the Whois record of the domain, "Honest Wisdom SinoDNS" "only provide registration services". As such, it is obvious that "Honest Wisdom SinoDNS" is only a service agent and

“Li Ren” should remain as the actual registrant of the disputed domain.

Meanwhile, when receiving the notification of amendment from the ADNDRC, we checked the website of the disputed domain name and found it is presently not operative. In light of the above, we believe that it is most likely that “Li Ren” closed down the website upon becoming aware of the present dispute.

In spite of the fact that the present un-operative state of the website, the evidence clearly shows that the Respondent used the disputed domain name, which was confusingly similar to the Complainant’s trade mark and trade name, to promote and sell a large number of unauthorized products of the Complainant. The Respondent’s motive is obviously to mislead customers into thinking that the Disputed Domain Name is somehow associated with the Complainant in order to take advantage of the Complainant’s reputation to obtain unfair advantage. The Respondent’s conduct will not only damage the Complainant’s legal rights in its trade mark and business name, interfere with the Complainant’s normal business activities, but also lead to confusion in the market place. This in turn would cause injuries to consumers’ legal rights. Therefore, according to Regulation 4(b)(iv) of the UDRP, the Respondent’s registration and use of the Disputed Domain Name fully constitutes registration and use in bad faith.

In accordance with Paragraph 4(b)(i) of the Policy, the Complainant requests the Panel to issue a decision to transfer the Disputed Domain Name to the Complainant.

Respondent

The Respondent failed to submit a Response within the specified time period.

4. 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:

- 1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- 2) the Respondent has no rights or legitimate interests in respect of the domain name; and
- 3) the domain name has been registered and is being used in bad faith.

Identical/Confusingly Similar

The Complainant is a well-known company in technology and computer products and services. The evidence shows that the trade mark “DELL” has been registered in mainland China as early as 1992, much earlier than the registration date of the disputed domain name (i.e. May 2009). The same trademark has also been registered in many other countries/regions. The Panel has no problem in finding that the Complainant enjoys the prior rights in the trademark “DELL”.

The disputed domain name is “dell-and-hp.com”. As the suffix “.com” only indicates that the domain name is registered under this gTLD and is not distinctive, the main part of the disputed domain name consists of three separate sub-parts (“dell”, “and”, “hp”), which are connected by hyphens. The first separate sub-part is the same as the Complainant’s trademark. The second separate sub-part is a simple/common English word, the Panel finds that the addition of a simple/common English word, such as the addition of a prep word “and”, to a trademark does not alter the underlying mark to which it is added. The third separate sub-part “hp” consists of only two English letters; while it can be related to the famous trademark of another computer company, the placing of the three sub-parts (with “dell” first, and separated by hyphens) cannot mitigate the distinctiveness of “dell” in the disputed domain name. Therefore, the main part of the disputed domain name “dell-and-hp” is confusingly

similar to the Complainant's trademark "DELL".

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. 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 interests.

The Respondent has failed to show that the Respondent has any rights or legitimate interests in respect of the disputed domain name. The act of registering the disputed domain name and the Respondent's like/dislike do not automatically endow any legal rights or interests with the Respondent.

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

Bad Faith

Under Paragraph 4 (b) of the Policy, the following are relevant examples a Panel may take as evidence of registration and use 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 or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) You have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) You have registered the domain name primarily for the purpose disrupting the business of a competitor; or
- (iv) By using the domain name, you have intentionally attempted to

attract, for commercial gain, internet users to your website 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 your website or location or of a product or service on your website or location.

Evidence shows that the Complainant's trademark "DELL" has achieved a strong reputation and the worldwide significance of the brand name through extensive use, promotion, advertisement. As such, the public has come to recognize and associate the Complainant's trademark as originating from the Complainant and no other. The Complainant's trademark, recognized as a "Well-known Mark" in China in 2004 and 2008, has been well known by Chinese consumers. The contact information shows that the Respondent situates in China. The above facts serve to prove that the Respondent is aware of the existence of the Complainant and its trademark. The action of registering the disputed domain name *per se* has constituted bad faith.

Accordingly, the Panel finds that the Complaint satisfies the condition provided in Paragraph 4 (a) (iii) of the Policy.

5. 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 <dell-and-hp.com> domain name should be TRANSFERRED to the Complainant.

Sole Panelist:



DATED: 12 January 2011