

Asian Domain Name Dispute Resolution Center
Beijing Office
Administrative Panel Decision
Case No. CN-1100490

Complainant: Shandong Hengfeng Rubber & Plastic Co., Ltd.(山东恒丰橡塑有限公司)

Respondent: J Y

Domain Name: hengfengtyre.com、hengfengtyres.com、hengfengtire.com、hiflytires.com、hiflytyre.com、hiflytyres.com、changfengtire.com、changfengtyre.com

Registrar: GODADDY.COM, INC.

1. Procedural History

On September 1, 2011, the Complainant submitted a Complaint to the Beijing Office of the Asian Domain Name Dispute Resolution Center (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"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") approved by ICANN, and Asian Domain Name Dispute Resolution Center Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "ADNDRC Supplemental Rules").

On September 8, 2011, the ADNDRC Beijing Office confirmed the receipt of the Complaint. On September 8, 2011, the ADNDRC Beijing Office transmitted by email to ICANN and GODADDY.COM, INC. (the Registrar of the domain name) a request for verification of registrant information in connection with the domain name in dispute. On September 9, 2011, GODADDY.COM, INC. transmitted by email to the ADNDRC Beijing Office its verification response confirming that, the domain name in dispute was registered under its domain registrar and the registrant is J Y.

The ADNDRC Beijing Office sent by email the Transmittal of Claims

attached by the Complaint to the Respondent on September 21, 2011.

On September 26, 2011, the ADNDRC Beijing Office notified the Complainant that the Complaint had been confirmed and forwarded and the proceedings commenced on September 26, 2011. On the same day, the Notifications of Commencement of Proceedings were sent by email to the Respondent, ICANN and the Registrar.

On October 16, 2011, having received no response from the Respondent, the ADNDRC Beijing Office notified the Complainant that the hearing will take place by default.

On October 17, 2011, the ADNDRC Beijing Office notified the Proposed Panelist Mr. ZHAO Yun to see whether he is available to act as the Panelist in this case and if so, whether he is in a position to act independently and impartially between the parties. Having received a Declaration of Impartiality and Independence and a Statement of Acceptance from Mr. ZHAO Yun, on October 17, 2011, the ADNDRC Beijing Office informed the Complainant and the Respondent of the appointment of the Panelist and the constitution of the Panel, transferred the case file to the Panel, and asked the Panel to submit a decision on or before October 31, 2011.

Pursuant to Paragraph 11 (a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of this dispute resolution 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 dispute resolution proceeding. The language of the current disputed domain name Registration Agreement is English.

2. Factual Background

For the Complainant

The Complainant in this case is Shandong Hengfeng Rubber & Plastic Co. Ltd. The registered address is Dawang Economic Development Zone, Dongying, Shandong, China. The authorized representative in this case is

Haiming Han & Mingjie Zhao from Shanghai Keenmore Law Firm.

For the Respondent

The Respondent in this case is J Y. The address is 105 yuanlou village, yanggu county, Shandong, China. The Respondent is the current registrant of the disputed domain names “hengfengtyre.com、hengfengtyres.com、hengfengtire.com、hiflytires.com、hiflytyre.com、hiflytyres.com、changfengtire.com、changfengtyre.com” according to the Whois information.

3. Parties’ Contentions

The Complainant

Incorporated in 1995 and with registered capital of RMB 220 million and total asset of RMB 5 billion, the Complainant is an enterprise with the principal business in the production and operation of rubber tires and possesses a steel radial tire factory with 4 million sets thereof and a semi-steel radial tire factory, rubber machinery factory and thermal power plant with 12 million sets thereof. The enterprise has a floor area of about 1.6 million square meters with more than 6000 staff and workers and is a group enterprise integrated with development and design, production and sales. The Complainant has passed many certifications including China Compulsory Certification (CCC), ISO9001 international quality system, TS16949 quality system, US Department of Transportation (DOT) quality safety, Economic Commission for Europe (ECE) product safety, Brazil (INMETRO) and Indonesia (SNI) and in addition has been awarded Provincial Contract—Honoring and Faith Keeping Enterprise in Shandong Province, Provincial Product Inspection-free Entity, Provincial Enterprise with AAA Faith Grating, Provincial Customer Satisfaction Entity and Class A Taxation Enterprise. The products of the Complainant has superior quality and are sold throughout the country and Europe, Asia, Africa, United States, Middle East and other regions. The tires of various specifications with such trademarks as “HIFLY”, “changfeng” and

“shuangfeng” produced by the Complainant enjoy great popularity in the domestic and foreign markets.

The Complainant was incorporated in August 1995 with the enterprise name Shandong Hengfeng Rubber & Plastic Co., Ltd, in which “hengfeng” is the trade name thereof and the direct Chinese phonetic alphabets of the Chinese trade name “恒丰”, which is widely used by the Complainant in the production and operation.

On 21 September 2009, the Complainant was granted the exclusive right to use the trademark “CHANGFENG” with the registration No. 5810613. The trademark is combined by “CHANGFENG”, “昌丰” and figures, among which “CHANGFENG” is the main and prominent constituent of the trademark and which expires on 20 September, 2019 and in which the commodities (the 12th category) checked and ratified include inner tubes for pneumatic tires, tires for vehicle wheels, tires for automobiles, tires for vehicles and casings for pneumatic tires (tyres).

On 7 April, 2010, the Complainant was granted the exclusive right to use the trademark “HIFLY” with the registration No. 6739176. The valid period of the trademark expires on 6 April 2020. Commodities (the 12th category) checked and ratified therein include tires for vehicle wheels, airplane tires, pneumatic tires (tyres), inner tubes for pneumatic tires (tyres), inner tubes for bicycles and tricycles, treads for vehicles (roller belts), casings for pneumatic tires (tyres), treads for retreading tires (tyres), adhesive rubber patches for repairing inner tubes and repair outfits for inner tubes.

On 9 April 2010, the Complainant registered the domain name “hengfengtires.com”, the recognizable part of the main body of which is composed of the Chinese phonetic alphabets “hengfeng” of the Complainant’s trade name “恒丰” and the English word “tires” (plural) with the Chinese meaning “轮胎”. As the official website of the Complainant, “www.hengfengtires.com” has been in use up to now.

(1)The recognizable parts of the main body of the eight domain names in

dispute are identical or confusingly similar to the trademarks and trade name owned by the Complainant, which are apt to cause confusion.

The Complainant enjoys the right of the enterprise name “恒丰”, the Chinese phonetic alphabets of which are “hengfeng”. “恒丰” and “hengfeng” have been widely used in activities and publicity of the production and sales of the tires by the Complainant. In accordance with Article 8 under the Paris Convention for the Protection of Industrial Property provides: A trade name shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark. “hengfeng” in the three domain names “hengfengtire.com,” “hengfengtyre.com” and “hengfengtyres.com” is identical with the Chinese phonetic alphabets of the Complainant’s enterprise name “恒丰” and “tyre”, “tyres” and “tire” are the English words with the Chinese meaning “轮胎”. All the aforementioned three domain names are sufficient to have the public mistake that they are related to the Complainant, thus causing confusion.

“CHANGFENG” is the main and prominent constituent of the trademark combined by characters and figures to whom the exclusive right to use of the trademark entitles is granted and in which the commodities checked and ratified are various tires. “changfeng” in the two domain names “changfengtyre.com” and “changfengtire.com” and “CHANGFENG” are only distinguished from each other in lower and upper cases and “tyre” and “tire” are the English words with the Chinese meaning “轮胎”. All the aforementioned two domain names are sufficient to have the public mistake that they are related to the Complainant, thus causing confusion.

“HIFLY” is the trademark of which the Complainant has the exclusive right to use and the commodities checked and ratified therein include various tires. The recognizable parts of the main body “hifly” in the three domain names “hiflytires.com”, “hiflytyre.com” and “hiflytyres.com” registered by the Respondent and “HIFLY” are only distinguished from each other in lower and upper cases and “tyre”, “tyres” and “tire” are the

English words with the Chinese meaning “轮胎”. All the aforementioned three domain names are sufficient to have the public mistake that they are related to the Complainant, thus causing confusion.

Before the Respondent registered the domain names in dispute, the Complainant had already obtained the exclusive right to use the legally registered aforementioned trademark and the right of the enterprise name. The Respondent registered a group of domain names, ten in total, in July 2010 with the eight domain names in dispute involved in the complaint included. These domain names were registered after the Complainant obtained the aforementioned rights, thus the Complainant owned indisputable prior rights over the eight domain names in dispute.

The Complainant is an enterprise famous for its tyres, the main products of which are various tyres. The recognizable parts of the main body of the domain name “hengfengtires.com” registered by the Complainant in April 2010 are the combination of “hengfeng” in front and “tires” behind, the purpose of which is to specifically inform the public that the Complainant is an enterprise with the principal business the production of tires. When the Respondent applied for the registration of the domain names in dispute, the Respondent not only used the trade name and the trademark sign of the Complainant in the recognizable parts of the main body thereof, which are identical therewith or extremely similar thereto, in particular the suffix of these domain names added with the English words (tire, tires, tyre or tyres) with the Chinese meaning “轮胎”. The Respondent didn't take the character combination in coincidence, but intended to attain the most approximate effect with the sign and domain names owned by the Complainant, which are extremely apt to make the public confuse these domain names with the trade name, trademark and domain names owned thereby, the purpose of which is to lead the general network users to mistake that these domain names have some commercial or legal relationship with the Complainant.

(2)The Respondent has no rights or legitimate interests in respect of the domain names.

The Respondent “J Y”, Chinese name YUAN, Liying, is a natural person. According to the inquiry by the Complainant, the Respondent hasn't yet registered “hengfeng”, “changfeng” or “hifly” in any category. The Respondent is impossible to or doesn't in fact enjoy any legal rights of “hengfeng”, “changfeng” or “hifly”. As such, the Respondent doesn't have any legal rights including the right of the enterprise name and the trademark right of the recognizable parts of the main body of the domain names in dispute. The domain names registered and held by the Respondent aren't based on any civil rights and interests.

“hengfeng”, “changfeng” or “hifly” is not a separate entry in a dictionary or daily expression, but a brand created by the Complainant. The Respondent registered the domain names in dispute after the Complainant obtained the right of the enterprise name, trademark right and domain names. The Respondent doesn't have any relationship with the Complainant, and the Complainant has never authorized or granted the Respondent to use the sign “hengfeng”, “changfeng” or “hifly” in any form.

(3)The domain names have been registered and are being used in bad faith.

In September 2010, the Respondent took the initiative to find the Complainant and claimed that he had registered a group of domain names, ten in total (the eight domain names in dispute included), all of which are related to the Complainant and conducive to the development of the business and popularization thereof and if the Complainant wanted to obtain these domain names, the Complainant had to pay US\$ 3500 transfer fee for each domain name. The Complainant indicated that the domain names registered by the Respondent are related to the signs of the Complainant such as “hengfeng”, “changfeng” or “hifly” in which the Com and there was a great disparity between the registration costs for these domain names and the transfer price, which could not be accepted by the Complainant. Thereafter the Respondent adjusted the price of each domain name to US\$ 2800. During the negotiation process, the Respondent specifically stated that he operated the whole registration and

transfer process with his partner and frankly indicated that they operated the whole process for enormous profits by rush-registration of the enterprise domain names. On 2 November 2010, the Respondent sent to the mailbox ttire@163.com used by Manager PAN, Xiumei, the section-leader of the Complainant, the formatted Agreement on the Domain Name Transfer, which stated the total transfer price of the ten domain names is US\$ 28000. The Complainant has made evidence preservation for the contents of the abovementioned e-mail by application to the notary office. It can be clearly known from the conversation with the Respondent that the Respondent registered these domain names with premeditation and aims, he knew that “hengfeng”, “changfeng” and “hifly” were the signs owned by the Complainant and was aware of the role of the domain names in dispute in the production and operation of the Complainant, the Respondent registered these domain names at very low costs and actively attempted to transfer these domain names to the Complainant with extremely high price, with apparent subject malice.

In addition, in June 2011, the Complainant found that “hiflytires.com”, “hiflytire.com” and “hiflytyres.com” had been used in a short time, the contents on which were exactly the same. The aforementioned three websites have been closed on 27 June 2011, the Complainant printed the contents on the web page of one of the three websites, which showed the models, specifications and other contents of partial products of “Hifly” owned by the Complainant and the e-mail address for contact, which was exactly the same as the mailbox used to send e-mail to Manager PAN by the Respondent, both of which were firstdomain@hotmail.com, as such it can be determined that the actual user of the aforementioned three websites is the Respondent. The Complainant has never had any business, legal or economic relationship with the Respondent. The aforementioned three websites used the sign “Hifly” in an intentional and conspicuous manner, product models, specifications and introductions shown were exactly the same as the product category of “HIFLY” prepared by the Complainant, which will make the network users mistake that the web page is the sales web page related to the Complainant, resulting in confusion. The Respondent used the aforementioned three websites 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 names to the Complainant.

For the Respondent

After being served of the claim and all the accompanying documents submitted by the Complainant, and of all the procedural documents by the ADNDRC Beijing Office, the Respondent makes no response by any means in the whole course of the proceeding.

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.

1. “hengfengtyre.com、hengfengtyres.com、hengfengtire.com”

Identity or Confusingly Similarity

The Complainant claimed that he was incorporated in August, 1995 with

the enterprise name Shandong Hengfeng Rubber & Plastic Co., Ltd, in which “hengfeng” is the trade name thereof and the direct Chinese phonetic alphabets of the Chinese trade name “恒丰”, which is widely used by the Complainant in the production and operation. In accordance with Article 8 under the Paris Convention for the Protection of Industrial Property provides: A trade name shall be protected in all the countries of the Union without the obligation of filling or registration, whether or not it forms part of a trademark.

According to Article 4(a)(1) of the Policy, the Panel will need to decide on whether the Complainant has trademark or service mark rights over “hengfeng”. Such trademark or service mark rights include both registered and unregistered mark rights. In the current case, the Complainant did not register “hengfeng” as the trademark and did not claim in the Complaint any unregistered trademark rights over “hengfeng”. In this regard, the Panel does not need to move further to examine the existence of any unregistered trademark rights. But even the claim is made, there is no evidence at all to show the use of “hengfeng” as trademark in the Complainant’s promotion and advertisement activities. Accordingly, the Complainant does not enjoy any trademark or service mark rights over “hengfeng”.

Since all the three elements under the Policy should be satisfied to support the complaint, it is not necessary for the Panel to examine further the other two elements (rights or legitimate interests and bad faith).

2. hiflytires.com、hiflytyre.com、hiflytyres.com、changfengtire.com、changfengtyre.com

Identity or Confusingly Similarity

The Complainant registered “CHANGFENG” as a major part of the trademark on 21 September 2009, the registration number is 5810613. The trademark has been registered for the products of various types of tyres and the protection period lasts till 20 September 2019. The Panel has no problem in finding that the Complainant enjoys the trademark right over “CHANGFENG”.

The Complainant registered “HIFLY” as its trademark on 7 April 2010 for the products of various types of tyres. The protection period lasts till 6 April 2010. The Panel has no problem in finding that the Complainant enjoys the trademark right over “HIFLY”.

The Panel further finds that the registration dates of the above trademarks are earlier than the registration date of the disputed domain names (16 July 2011). The Complainant enjoys the prior rights in the two trade marks “CHANGFENG”, “HIFLY”.

All the disputed domain names ends with “.com”, this suffix only indicates that the domain names are registered under this gTLD and “.com” is not distinctive. Thus, we will only need to examine the main part of the disputed domain names.

The main parts of the disputed domain names--“hiflytires.com”, “hiflytyre.com” and “hiflytyres.com”—consist of two parts. These three domain names share the same first part “hifly”, this first part is the same as the Complainant’s trademark “HIFLY”. All the second parts—“tires”, “tyre” and “tyres”— are ordinary English words, with the same meaning “轮胎”, which is the Complainant’s major business and products. The combination of the two parts cannot differentiate the main parts of the disputed domain names from the Complainant’s trademark “HIFLY”; with “tires/tyre/tyres” being the major products of the Complainant, such a combination, on the contrary, strengthens the connection between the disputed domain names and the Complainant’s trademark. Therefore, the disputed domain names are confusingly similar to the Complainant’s trademark “HIFLY”.

The main parts of the disputed domain names—“changfengtire.com” and “changfengtyre.com”—consist of two parts. These two domain names share the same first part “changfeng”; this first part is the same as the Complainant’s registered trademark “CHANGFENG”. Both the second parts—“tire” and “tyre”— are ordinary English words, with the same meaning “轮胎”, which is the Complainant’s major business and products. The combination of the two parts cannot differentiate the main parts of

the disputed domain names from the Complainant's trademark "CHANGFENG"; with "tire/tyre" being the major products of the Complainant, such a combination, on the contrary, strengthens the connection between the disputed domain names and the Complainant's trademark. Therefore, the disputed domain names are confusingly similar to the Complainant's trademark "CHANGFENG".

Accordingly, the Panel 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 names. The Complainant has never authorized the Respondent to use the trademarks or the disputed domain names. 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 names. No evidence has shown that the Respondent is using or plans to use the domain names for a bona fide offering of goods or services. The Respondent is not commonly known by the domain names. The evidence submitted by the Complainant further shows that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain names. The act of registering the disputed domain names does 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 Respondent registered all the disputed domain names on the same date. All the disputed domain names contain the Complainant's registered trademark. Evidence further shows that the Respondent actively contacted the Complainant and intended to sell the disputed domain names to the Complainant at the price of US\$ 3500 for each domain name (which was later reduced to US\$ 2800 each). This price is much higher than the necessary cost for registering a domain name. Such an act constitutes the typical act of registration and use of domain name in bad faith as envisaged in Paragraph 4(b) of the Policy, namely, the circumstances indicating that the Respondent has registered or acquired the domain names 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, for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain names.

Accordingly, the Panel finds that the Complaint satisfies the condition

provided in Paragraph 4 (a) (iii) of the Policy.

5、 Decision

The Complainant failed to satisfy the requirements under the ICANN Policy for the first three domain names, the complaint over “ hengfengtyre.com 、 hengfengtyres.com 、 hengfengtire.com ” is accordingly rejected.

Having established all three elements required under the ICANN Policy for the other five disputed domain names, the Panel concludes that relief should be granted. Accordingly, it is ordered that the disputed domain names “hiflytires.com、hiflytyre.com、hiflytyres.com、changfengtire.com、changfengtyre.com” should be TRANSFERRED to the Complainant.

Sole Panelist:



DATED: October 31, 2011