

ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

(Beijing Office)

ADMINISTRATIVE PANEL DECISION

Case No. CN-1300672

Complainant: YASKAWA ELECTRIC CORPORATION

Respondent: XUEFENG WANG

Domain Name: yaskawa-inverter.com

Registrar: GODADDY.COM, LLC

1. Procedural History

On 9 May, 2013, the Complainant submitted a Complaint in English to the Beijing Office of the Asian Domain Name Dispute Resolution Center (the ADNDRC) and elected this case to be dealt with by a one-person panel, in accordance with the Uniform Domain Name Dispute Resolution Policy (the Policy) approved by the Internet Corporation for Assigned Names and Numbers (ICANN), the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules), and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the ADNDRC Supplemental Rules).

On 13 May, 2013, the ADNDRC sent to the Complainant by email an acknowledgement of the receipt of the Complaint and reviewed the format of the Complaint in compliance with the Policy, the Rules and the ADNDRC Supplemental Rules.

On 13 May, 2013, the ADNDRC transmitted by email to ICANN and the Registrar, GODADDY.COM, LLC, a request for registrar verification in connection with the disputed domain name. On 15 May, 2013, the Registrar transmitted by email to the ADNDRC its verification response, confirming that the Respondent is listed as the registrant and providing the contact details.

On 8 June, 2013, the ADNDRC notified the Complainant that the Complaint has been confirmed and transmitted to the Respondent and the case officially commenced. On the same day, the ADNDRC transmitted the Written Notice of the Complaint to the Respondent, which informed that the Complainant had filed a Complaint against the disputed domain name and the ADNDRC had sent the complaint and its attachments through email according to the Rules and the Supplemental

Rules. On the same day, the ADNDRC notified ICANN and registrar, GODADDY.COM, LLC, of the commencement of the proceedings.

The Respondent failed to submit a Response within the specified time period. The ADNDRC notified the Respondent's default. Since the Respondent did not mention the Panel selection in accordance with the time specified in the Rules, the ADNDRC Supplemental Rules, and the Notification, the ADNDRC informed the Complainant and the Respondent that the ADNDRC would appoint a one-person panel to proceed to render the decision.

Having received a Declaration of Impartiality and Independence and a Statement of Acceptance from Mr. LIAN YUNZE, the ADNDRC notified the parties on 5 July, 2013 that the Panel in this case had been selected, with Mr. LIAN YUNZE 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 9 July, 2013, the Panel received the file from the ADNDRC and should render the Decision within 14 days, i.e., on or before 23 July, 2013.

Pursuant to Paragraph 11 (a) of the Rules, 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. The language of the current disputed domain name Registration Agreement is English, thus the Panel determines English as the language of the proceedings.

2. Factual Background

For the Complainant

The Complainant in this case is YASKAWA ELECTRIC CORPORATION. The registered address is 2-1 Kurosaki-shiroishi, Yahatanishi-ku, Kitakyushu 806-0004 Japan. The authorized representative in this case is Yugong Qin/ Chenghe Lian.

For the Respondent

The Respondent in this case is XUEFENG WANG. The registered

address is No.4800, Boyuan Road Jiading District, Shanghai 201804 China. The Respondent is the current registrant of the disputed domain name “yaskawa-inverter.com” according to the Whois information. The registrar of the disputed domain name is GODADDY.COM, LLC.

3. Parties’ Contentions

The Complainant

The Complainant own a series of prior trademark rights, including but not limited to the following:

Trademark	Registered No.	Class	Goods	Valid period
YASKAWA	938169	7	Control mechanisms for machines, engines or motors; Dynamos; Robots; electric engines other than for land vehicles, etc.	From January 28, 2007 to January 27, 2017
YASKAWA	1328782	9	Current rectifiers; Commutators; Remote control of industrial operations (Electric installations for the —); Inverter, etc.	From October 28, 2009 to October 27, 2019
YASKAWA & Device	1328783	9	Current rectifiers; Commutators; Remote control of industrial operations (Electric installations for the —); Inverter, etc.	From October 28, 2009 to October 27, 2019

1) The effectively distinctive part of the disputed domain name is confusingly similar to the prior used registered trademark “YASKAWA” of the Complainant

1.1) The Complainant has the rights to “YASKAWA” as its prior used registered trademark and its trade name;

Founded in 1915, the Complainant is a leading global manufacturer of motors, inverters, robots, etc., and its sales and manufacturing network has already spread over main countries and districts in the world, including USA, Brazil, China, India, Germany, South Africa, etc. At present, the global market shares of the Complainant in both the field of motors and the field of robots rank top in these industries, and the Complainant also enjoys extremely high market share in robot global market. The Complainant has historical ties of friendship with China, and as a result of wide publicity and large-scale sales, the Complainant’s products, including motors, inverters and robots, with the brand name of

“YASKAWA”, have become very famous in China market.

“YASKAWA” is the registered trademark of the Complainant on the goods including motor, inverters, robots, etc, as well as the distinctive part of the disputed domain name and the Complainant’s English shop name.

To begin with, the Complainant has registered “YASKAWA” as a trademark mainly in Class 7 and 9 on the goods including motors, inverters, robots, etc., in nearly one hundred countries and districts. The Complainant obtained the Japanese registered trademark in 1954, and the Chinese one in 1997.

Besides, the Complainant has been using “安川”(Chinese characters for “Yaskawa”) as its Japanese shop name ever since it established, and then, it adopted “YASKAWA” as its English shop name based on the expression in Roman letter for the Japanese pronunciation of “安川”. Furthermore, the Complainant registered many domain names consisting of “YASKAWA”. Nowadays, the Complainant uses “yaskawa.co.jp” as its domain name.

1.2) “yaskawa-inverter”, the effectively distinctive part of the of the disputed domain name, is confusingly similar to the prior well-known trademark of the Complainant;

The distinctive part of the disputed domain name is “yaskawa-inverter”, which is composed of “yaskawa”, “-” and “inverter”. For the following reasons, the Complainant believes that “yaskawa-inverter” is confusingly similar to “YASKAWA” as the trademark of the Complainant:

Firstly, “yaskawa” has the main function of distinguishing the disputed domain name from others. However, comparing it with “YASKAWA” as the trademark of the Complainant, there exists only a difference between capital and small letter printing, and thus the two can be considered as identical.

Secondly, because “-” has no distinctive meaning, it also has no effect on judgment of the similarity between the effectively distinctive part of disputed domain name and “YASKAWA” as the trademark of the Complainant.

Finally, “inverter” is the English name of the product, and it is one of the main products of the Complainant. And also the “YASKAWA” has already been registered as the trademark on the product. Therefore, the

difference also has no effect on judgment of the similarity owing to lack of distinctiveness.

Since the Complainant's inverters with the brand of "YASKAWA" have become very famous in the industry, related public would be easily misled to believe that the disputed domain name or the website based on it is owned by the Complainant or has some connection with the Complainant.

2) The Respondent has no rights or legitimate interests in respect of the disputed domain name;

The Complainant has already registered the trademark "YASKAWA" in China since 1997. According to the search results made on the database of China Trademark Office's official website, the Respondent does not own any civil rights on "YASKAWA". Meanwhile, the Complainant has never authorized the Respondent to use its "YASKAWA" trademark in any way including registering "YASKAWA", "yaskawa-inverter" as a domain name. Therefore, the Respondent does not have any rights or legitimate interests in respect of the disputed domain name.

3) The disputed domain name is registered and used by the Respondent in bad faith.

In spite of being fully aware of the Complainant's trademark "YASKAWA", the Respondent registered the domain name in order to sell inverter, braking resistor and electrical motor with the brand of "YASKAWA". Meanwhile, the Respondent uses many false statements as "It is the Complainant's general agency and general distributor in China.", "The supplier of 'YASKAWA' inverter", "Providing all types of YASKAWA inverters with original factory quality and the cheapest price", to mislead customers. The above-mentioned facts demonstrate that the Respondent registered and used the disputed domain name in bad faith.

The Complainant has never authorized the Respondent as the general agency, general distributor or supplier, nor to be engaged in business activities in the name of the Complainant. Meanwhile, the Complainant never sold any YASKAWA branded inverters with original factory quality to the Respondent, and it is hard to imagine the Respondent would be able to sell such products at the price even lower than the selling price of the Complainant, based on business common sense.

The Complainant has many agencies and distributors in Shanghai where the Respondent is located. Along with the spreading of false advertising

by the Respondent, the business of the normal agencies and distributors also has been badly influenced in different degree. So their legitimate interests are harmed.

To sum up, the above activities of the Respondent belong to the Article 4(b) (iv) “by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your web site or location or of a product or service on your web site or location” of the Policy.

In addition, the Complainant found that the Respondent has also registered another domain name “zoomliontowercraneparts.com”, and is engaged in operation of elevator parts for construction and tower crane parts under the domain name. After examination, zoomlion is the registered trademark and shop name of Zoomlion Heavy Industry Science & Technology Development Co., Ltd, which is quite famous in the crane industry in China. The core products of Zoomlion are cranes and crane parts. So, the Respondent, in spite of being fully aware of others' registered trademarks, registered domain names by using those trademarks together with the goods on which the trademarks are used, and is engaged in related business activities. This is the common way for the Respondent and its controlled companies to seek gains. Obviously, the Respondent registered the disputed domain name out of ill intention to seek gains in an improper way.

In conclusion, considering the distinctive part of the disputed domain name is almost identical to the famous trademark “YASKAWA” of the Complainant, and the Respondent registered the disputed domain name with the bad faith listed in the article 4 (b) (iii) and (iv) of the Policy, the Complaint therefore requests the panel to issue a decision that the disputed domain name shall be transferred to the Complainant.

The Respondent

The Respondent was duly notified by the ADNDRC of the Complaint lodged by the Complainant and asked to submit the Response in accordance with the relevant stipulations under the Policy, the Rules and the ADNDRC Supplementary Rules, but failed to give any sort of defense in any form against the Complaint by the Complainant.

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.”

The Policy, at paragraph 4(a), that the Complainant must prove that each of the following three elements are present in order for the 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.

Based on the above stipulations under the Policy, what the Panel needs to do is to find out whether each and all of the above-mentioned elements are present. If all the three elements are present, the Panel will make a decision in favor of the Complainant in accordance with the fact-finding and the relevant stipulations under the Policy, the Rules and the ADNDRC Supplemental Rules. If the three elements are not present, the claims by the Complainant shall be rejected.

The Respondent failed to submit the Response of any argument against what the Complainant claimed and to show his intention to retain the disputed domain name as required by the Policy, the Rules and the ADNDRC Supplemental Rules, “If a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint”. In view of the situation, the Panel cannot but make the decision based primarily upon the contentions and the accompanying exhibits by the Complainant, except otherwise there is an exhibit proving to the contrary.

Identity or Confusing Similarity

Pursuant to Paragraph 4(a) (i) of the Policy, a complainant must prove that the domain name is identical or confusingly similar to a trademark or

service mark in which the complainant has rights.

According to the evidence provided by the Complainant and the information revealed in the databases of China Trademark Office, the Panel notices that the Complainant owned registered trademarks No. 938169 for “YASKAWA” in class 7, No. 1328782 for “YASKAWA” in class 9 and No. 1328783 for “YASKAWA & device” in class 9 on such goods as “current rectifiers, commutators, remote control of industrial operations (electric installations for the -), inverters, etc”. All the three marks mentioned above are valid and registered in China earlier than the registered date of the disputed domain name, i.e. 18 June, 2012. The Complainant therefore enjoys prior exclusive trademark right to “YASKAWA”.

The disputed domain name is “yaskawa-invert.com”. Apart from the generic top-level domain suffix “.com”, the major part of the disputed domain name is “yaskawa-inverter”, which could be easily regarded as “yaskawa” plus “inverter”. “inverter” is a generic English word and has no distinctiveness itself. Like many UDRP cases, the addition of a generic term does not necessarily distinguish a domain name from a trademark. Furthermore, the generic term “inverter” refers to the Complainant’s major business and may easily lead consumers into associating the disputed domain name with the Complainant. The Panel therefore finds that the disputed domain name is confusingly similar to the Complainant’s registered trademark “YASKAWA”. Accordingly, the Complainant has proven that the first element is present under paragraph 4(a) of the Policy.

Rights or Legitimate Interests of the Respondent

The Complainant asserts that the Respondent has no rights or legitimate interests in the disputed domain name and, as stated above, the Respondent did not provide any information to the Panel asserting any right or legitimate interest it may have in the disputed domain name.

It is apparent from the Complaint that there is no agency, trademark licensing or any commercial contact between the Complainant and the Respondent. Paragraph 4(c) of the Policy lists a number of circumstances which can be taken to demonstrate a respondent’s rights or legitimate interests in a domain name. However, there is no evidence before the Panel that any of the situations described in paragraph 4(c) of the Policy apply here. To the contrary, the lack of a response leads the Panel to draw a negative inference.

Therefore, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name. Accordingly, the Complainant has proven the second element required by paragraph 4(a) 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.

The Complainant was established in 1915 and acquired trademark registrations for "YASKAWA" in Japan, China and many other countries in the world. The Complainant, after decades of development, has become one of the leading enterprises in the field of inverters, motors, robots, etc. The Complainant's trademark "YASKAWA", recognized as "famous trademark" in Japan, also acquired reputation in China.

The screen shots of the website that the disputed domain name directs to reveals that products branded "YASKAWA" were sold and words like "professional YASKAWA inverter supplier in China" and "one of the YASKAWA top dealers & agents in China" were used. The content of the website could easily cause confusion among consumers and mislead internet users into believing that the products sold on the said website are

provided by or related with the Complainant.

Therefore, the Panel believes that the Respondent, by using the disputed domain name, has intentionally attempted to attract, for commercial gain, internet users to its 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 web site or location or of a product or service on the web site or location.

In view of the above, the Panel holds that the disputed domain name should be considered as having been registered and used in bad faith under the Policy, paragraph 4(b). Therefore, the Complainant has proven the third element required by paragraph 4(a) of the Policy.

5. Decision

For all the foregoing reasons, in accordance with Paragraph 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name “yaskawa-inverter.com” be transferred to the Complainant, YASKAWA ELECTRIC CORPORATION.

The Sole panelist:



Dated: 22 July, 2013