



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

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Decision Submission

English Print

Decision ID	DE-0300011
Case ID	HK-0300026
Disputed Domain Name	www.essocn.com www.cn-esso.com www.aisocn.com www.cn-aiso.com www.中国埃索.com
Case Administrator	Iris Wong
Submitted By	Claus Von Wobeser
Participated Panelist	Claus Von Wobeser Karen Mills
Date of Decision	Loke Khoon Tan 23-07-2003

The Parties Information

Claimant	ExxonMobil Corporation
Respondent	Cixi Fei Chi Electrical Appliance Co., Ltd.

Procedural History

On April 17, 2003, the Hong Kong Office of the ADNDRC (the "Centre") confirmed the receipt of the Complaint and correspondent payment of the fee, and on the same day the Centre notified the Respondent that a Complaint had been properly filed against him.

This Complaint was amended in order for it to exclude the domain name known as "中国埃索.com" in the Complaint Form C. As stated by Complainant, the "中国埃索.com" domain name was registered by the Respondent but the registration had expired because of the Respondent's failure to make payment for renewal. In consequence at the date of lodging the amended Complaint, the "中国埃索.com" domain name was not available for registration by the public, and therefore the "中国埃索.com" domain name is not currently a Disputed Domain Name.

The Hong Kong Office of ADNDRC was properly notified of this modification on May 2, 2003 and the Respondent was notified of such inclusion on May 3, 2003 and given twenty (20) calendar days to file its response.

The Respondent did not file a Response before the Centre.

The Centre appointed Mr. Claus von Wobeser as presiding panelists, and Ms. Karen Mills and Mr. LokeKhoon Tan (proposed by Complainant) as Co-Panelists and having received the Declarations of Impartiality and Independence and the Statements of Acceptance from all of them, on May 31, 2003 the Centre informed the Complainant and the Respondent that the three-member Panel was formally set up.

No further materials were received by the HKIAC and the Panel thereafter.

During the next days, the Centre transferred the case file to the Panelists by courier, but due to the fact that the file was not received by the Presiding Panelist until June 12, 2003, the tribunal requested an extension of the time limit to render its decision. The Centre confirmed the Arbitral Panel the extension of the deadline until June 28, 2003 in terms of article 10(2) of the ADNDRC Supplementary Rules. Due to the complexity of the case, the Arbitral Panel on June 24, 2003 requested a second extension. On the same day, the Centre notified the Arbitral Panel that the referred deadline was extended to the 8th of July 2003.

After finding that the Panel was properly constituted and appointed in accordance with the Rules and the Supplemental

Rules and since it had not received any further requests from the Complainant or the Respondent regarding other submissions, waivers or extensions of deadlines, the panel decided that it was unnecessary to hold any exceptional in-person hearings for deciding the Complaint, as provided for in Paragraphs 12 and 13 of the Rules. The Panel, in accordance with the Rules, Paragraph 11 (a), determined that the language of the proceeding should be English.

Factual Background

For Claimant

The Complainant is a multinational oil company listed on the New York Stock Exchange and is one of the world's largest energy companies. The Complainant was incorporated in the United States of America in 1882. On November 30, 1999, when Mobil Corporation became a wholly-owned subsidiary of the Complainant Exxon changed to its current name, ExxonMobil Corporation.

The Complainant informed this Arbitral Panel that its principal business is in the energy field, involving exploration for, and production of, crude oil and natural gas, manufacture of petroleum products and transportation and sale of crude oil, natural gas and petroleum products. It is also a major manufacturer and marketer of basic petrochemicals, including olefins, aromatics, polyethylene and polypropylene plastics and a variety of specialty automotive and related products.

The Complainant has several divisions and hundreds of affiliates, many with names that include ExxonMobil, Exxon, Esso or Mobil. The Complainant has already established offices in cities in the People's Republic of China, and has also established foreign investment enterprises.

The Complainant affirms that since 1952, it has produced, marketed and distributed oil and automotive products under the "Esso" brand world-wide and has spent millions of US dollars promoting, and developing goodwill in the "Esso" brand and its derivatives. The Complainant attached substantial evidence (Annex F-1 of the Amended Complaint form C) to prove that such trademarks are registered worldwide in different classes under the Complainant's name or its affiliates.

For Respondent

Little is known about the Respondent, except for its address in Cixi, Ningbo Zhejiang, People's Republic of China, that it apparently applied to register the trademark "埃索 Esso & Oval device" through Ningbo City Trademark Agent, and that it apparently produces and sells sparkplugs under the brand name "Esso" in China.

Parties' Contentions

Claimant

The Complainant argues that the Respondent violates Article 4(a) sections (i), (ii) and (iii) of the Policy. In particular, the arguments of the Complainant are the following:

A) The name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights

The Complainant contends that the Respondent's Domain Names are identical to or confusingly similar to the Complainant's trademark "Esso". In particular, the Complainant states that the disputed domain names "essocn.com" and "cn-esso.com" incorporate the "Esso" trademark which has been registered by such important company in most Classes in around 169 jurisdictions around the world, including six different Classes in the People's Republic of China (Classes 1, 4, 17, 19, 37 and 42). The Complainant contends that the Respondent has simply added the letters "cn" to the Complainant's registered trademark and domain name, presumably in an effort to associate the domain name with the country code top level domain extension "cn" for China.

With respect to the "aisocn.com" and "cn-aiso.com" Complainant contends that it has registered the "埃索", the Chinese character trademark in the People's Republic of China in Classes 1 and 4 in respect of a number of goods. As stated by Complainant, the pronunciation in English of the word "aiso" is the same as, or similar to, the pronunciation in Chinese of the Complainant's well-known "埃索" registered Chinese character trademark. On this basis, the Complainant submits that the Respondent has used a phonetic English translation of the Complainant's registered Chinese character trademark which is confusingly similar to the Complainant's registered Chinese character trademark.

B) Respondent has no rights or legitimate interests in respect of the domain names

The Complainant notes that it has not licensed, endorsed, allowed or otherwise permitted the Respondent to use the

"essocn.com" and "cn-esso.com" disputed domain names or to use the Complainant's "esso" registered trademarks in any business name, business license or business registration. Nor has the Complainant in any way acquiesced to the Respondent's use of the "essocn.com" and "cn-esso.com" disputed domain names or the use of the Complainant's "esso" registered trademarks.

The Complainant states that it has commenced a cancellation action with the CTO in respect of the Respondent's "埃索 esso oval device" trademark registration and has also commenced an opposition action with the CTO in respect of the Respondent's application for an extension of the goods covered by the "埃索 esso oval device".

With respect to the domain names "aisocn.com" and "cn-aiso.com," the Complainant notes that it has not in any way licensed, endorsed, allowed or otherwise permitted the Respondent to use the "aisocn.com" and "cn-aiso.com" disputed domain names, being English translations of the Complainant's "埃索" registered Chinese character trademark, or to use the Complainant's "埃索" registered Chinese character trademark in any business name, business license or business registration. Nor has the Complainant in any way acquiesced to the Respondent's use of the "aiso.com" and "cn-aiso.com" disputed domain names or the use of any English translation of the Complainant's "埃索" registered Chinese character trademark in any business name, business license or business registration.

Finally, the Complainant states that due to its existing trademark registrations for the "esso," "esso oval," and the "埃索" marks, there is no conceivable bona fide use of the "aiso" mark in relation to the offering of goods and services to the public in the People's Republic of China.

C) Respondent registered and has used the Disputed Domain Names in Bad faith

The Complainant states that the Respondent has used and registered the domain names "essocn.com", "cn-esso.com", "aisocn.com" and "cn-aiso.com" in bad faith. However, the Complainant notes that as at the date of lodging its amended Complaint, the "中国埃索.com" domain name was not available for registration by the public, since the Respondent has priority to it pending payment of renewal fees.

In view of the above, the Complainant contends that the prior registration and use of the "中国埃索.com" domain name is evidence of Respondent's intentional attempt to attract, for commercial gain, Internet users to its web site, "by creating a likelihood of confusion with the Complainant's "esso," "esso oval device," and "埃索" registered trademarks as to the source, sponsorship, affiliation or endorsement of the Respondent's web site and of products displayed on the Respondent's web site." The Complainant also noted that when an Internet user typed in the "中国埃索.com" domain name, the internet browser used the "cn-esso.com" Disputed Domain Name to locate the Respondent's web site.

The Complainant sought to have each of the four domain names transferred to the Complainant.

Respondent

The Respondent has not responded. It has therefore not contested the allegations of the Complaint and is in default.

Findings

Identical / Confusingly Similar

A) General

Paragraph 15(a) of the Rules instructs the Panel as to the principles to decide 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 directs that the Complainant must prove each of the following:

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

Identical or Confusing Similarity

1) Domain Names “essocn.com” and “cn-esso.com”

The Panel finds that the domain names “essocn.com” and “cn-esso.com” are confusingly similar to the mark “Esso” in which Complainant has rights.

This Panel is persuaded by the fact that Complainant has proved that it is the owner of the well known trademark “Esso” which has had registered firstly in the United States since 1923 and later all over the world, including China. In this last country, Complainant has registered the trademarks “埃索” (the transliteration of “Esso” into Chinese) and “Esso” in respect to multiple classes and in a number of goods.

This Panel also finds, by contrasting both domain names with the Complainant’s trademark, that the trademark’s letters “Esso” are directly and wholly incorporated into the domain names “essocn.com” and “cn-esso.com”. The only difference between the domain names and the trademark, is the addition of the letters “cn” in Respondent’s domain names which presumably can be related to stand for China’s domain code. Consequently, the domain names in dispute are, if not identical, at least confusingly similar to the “Esso” trademark and domain name owned by the Complainant. In this regard, it is highly possible that any reasonable person seeking to find “Esso” products in the internet would be likely to try the domain names previously referred to. Thus, consumers would expect to find the websites “essocn.com” and “cn-esso.com” somehow associated with or sponsored by “ExxonMobile” or the “Esso” trademark holder. See *Microsoft Corporation v. J. Holiday Co.* WIPO Case No. D2000-1493.

Finally, the Panel finds the decision in *Adaptive Molecular Tech., Inc. v Woodward* WIPO D2000-0006 cited by Complainant persuasive and applicable to the present case since, as was ruled by such Panel, in the present case the domain names “essocn.com” and “cn-esso.com” are “undoubtedly” confusingly similar because both incorporate the “primary, distinctive element” ESSO of the Complainant’s trademark. See also *The Price Company v. Price Club*, WIPO Case No. D2000-0664 (finding *priceclub2000.com* to be confusingly similar to the PRICE CLUB mark).or *Paccar Inc. v. Telescan Technologies, L.L.C.*, 115 F. Supp. 772 (E.D. Mich. 2000) (finding that <*peterbuilttrucks.com*>, <*kenworthtrucks.com*> and similar domain names are not appreciably different from the trademarks PETERBUILT and KENWORTH).

2) Domain Names “aisocn.com” and “cn-aiso.com”

The Panel finds that the domain names “aisocn.com” and “cn-aiso.com” are not confusingly similar to the mark “Esso” or “埃索” (registered Chinese character trademark) in both which Complainant has rights.

The Complainant submits that the Respondent has used a phonetic English translation/transliteration of the Complainant’s registered Chinese character trademark which is confusingly similar to the Complainant’s registered Chinese character trademark. Complainant submits that the pronunciation in English of the word “aiso” is the same as, or confusingly similar to, the pronunciation in Chinese of the Complainant’s “埃索” registered Chinese character trademark.

Notwithstanding the above, this Panel finds that the exact phonetic translation for the Chinese “埃索” is “ai” for “埃” and “suo”, not “so” for “索”. In the unlikely case that an internet user does search for a phonetic translation of the Chinese “埃索” trademark, they would use the search term “aisuo” rather than “aiso”.

Viewed in isolation, the letter group “aiso” may or may not be a phonetic translation from Chinese to English. For example, it could be an acronym. A simple Google search for this letter group reveals several “a-i-s-o as acronym” sites, such as “www.aiso.net”, “www.aisoweb.com”, “www.aiso.com” which offer services ranging from web hosting companies to student associations. None of these are associated with either the Respondent or the Complainant.

In any case, this panel finds that similarity shall be analyzed pointing out the global appreciation of the visual, aural or conceptual similarity of the marks and domain names in question, and must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.

In this regard, the elements of similarity shall be relevant to such degree of showing that the perception of the trademarks in the mind of the average consumer of the type of goods or services in question is likely to be induced in confusion, since the average consumer normally perceives a mark as a whole and does not proceed to analyze its various details.

The Panel refers to the decision of European Court of Justice in *Sabel B.V. v. Puma A.G.* (Case C-251/95), which concluded that:

"the mere association which the public might make between two trade marks as a result of their analogous semantic content is not in itself a sufficient ground for concluding that there is a likelihood of confusion"

Therefore, and under the eyes of this Panel, the familiarity of the Chinese speaking people with the “Esso” trademark

would be primarily from visually being in contact with signs and the "Esso" name or the Chinese character equivalent in i.e. petrol stations or other places where products displaying the "Esso" trademark are sold. Thus by looking in the internet, this Panel finds it difficult to conclude that such people search the trademark in question under a name that only sounds like the Chinese character equivalent.

In conclusion, and only in relation with the Domain Names "aisocn.com" and "cn-aiso.com", this Arbitral Panel finds that the required element established in article 4(a)(i) of the Policy has not been satisfied.

Rights and Legitimate Interests

1) Domain Names "essocn.com" and "cn-esso.com"

The Respondent has not shown a legitimate interest in the domain names "essocn.com" and "cn-esso.com," and has failed to answer the allegations of the Complainant.

The Complainant submitted that the Respondent has no rights or legitimate interests in the disputed domain names. The Respondent did not file a Response, nor provide information as to its interests to use the disputed domain names. In this regard, the Panel refers to the decision in Law Society of Hong Kong vs. Domain Strategy Inc. in which the Panel found that:

"a respondent is not obliged to participate in a domain dispute and its failure to do so does not constitute an admission of the facts and propositions asserted by a complainant, but the failure to participate leaves a respondent vulnerable to the inferences that flow naturally from the assertions of the complainant that are not unreasonable."

The Panel also considers that the Respondent's registration of the trademark using the oval with the "Esso" and the Chinese characters having such meaning in Class 7 (for sparkplugs) is particularly relevant to determine whether or not it has a legitimate interest. It is true, that Complainant has not registered any trademark for Class 7 in China, but it has registered trademarks for Class 7 in other jurisdictions. However, this Panel recognises the fact that the Complainant has already lodged its objection to Respondent's registration with the trademark authority in China as stated in his Complaint submitted to the Centre.

In view of the above and based in the event that the Respondent has registered the trademark using the oval with the "Esso" and the Chinese characters having such meaning, under the eyes of this Panel it is possible that Respondent has a certain kind of interest for the domain names "essocn.com" and "cn-esso.com." However, it also seems apparent to this Panel that Respondent uses the letters "esso" on its domain names in order to confuse people as to the source of manufacture and therefore, Respondent's interest is not legitimate.

Accordingly, the Panel finds that Respondent has no rights or legitimate interests in respect of the domain names "essocn.com" and "cn-esso.com".

2) Domain Names "aisocn.com" and "cn-aiso.com"

Having reached the aforementioned conclusion in relation to the lack of confusing similarity of the "aisocn.com" and "cn-aiso.com" Domain Names, it is not necessary for the Panel to consider whether or not the Respondent has any rights or legitimate interests in respect of the domain names "aisocn.com" and "cn-aiso.com".

Bad Faith

Paragraph 4(b) of the Policy specifies four types of circumstances that could constitute evidence of the registration and use of a domain name in bad faith. They include:

- (i) circumstances indicating that the holder of the domain name has registered or has 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 the holder's documented out-of-pocket costs directly related to the domain name; or
- (ii) the holder of the domain name has 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 the holder has engaged in a pattern of such conduct; or
- (iii) the holder of the domain name has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the holder of the domain name has intentionally attempted to attract, for commercial gain, Internet users to his 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 his web site or location or of a product or service on his web site or location. However, Paragraph 4(b) of the Policy expressly recognizes that other circumstances can be evidence that a domain name was registered and is being used in bad faith.

In this regard, this Panel concludes that the Complainant has demonstrated that the Respondent registered and used all the Disputed Domain Names in Bad Faith in terms of article 4 section b sub-section (iv) of the Policy.

In order to arise to such conclusion, this Panel is persuaded by the fact that all of the disputed domain names, including “aisocn.com” and “cn-aiso.com”, direct internet users to one website of the Respondent, which display the Respondent’s product bearing the “Esso” name and logo, including the illustration of a tiger with similar characteristics to the Tiger used by Exxon to promote its products. In fact, at the “aisocn.com” and “cn-aiso.com” sites there is no mention of the letter group “aiso” in any part of the website; only the “Esso” trademark is referred to.

The similarity in the domain names, the web site style and the elements displayed in the web site, with the trademark “Esso”, being the Complainant’s Intellectual Property Rights, in a market in which the Parties both commercialize their products (automotive industry), in the eyes of the Arbitrators would seem to be intended to create in consumers confusion as to the source of the web site and the product promoted therein. In this regard, Respondent illicitly exploits Complainant’s trademarks and intellectual property goodwill in order to promote its products, thereby directly inducing consumers into confusion as to the source of manufacture of the same.

In this regard, the Panel refers to the decision in TPI holdings Inc. v. JB Designs WIPO D2000-0216 cited by the Claimant, in which the Panel found that:

“the respondent’s slavish copying of the complainant’s web site on the respondent’s web site was determinative that the respondent had registered and used the disputed domain name in bad faith.”

Even though the statement that the Respondent is probably infringing the Complainant’s copyright, by displaying Exxon’s registered trademarks on its website without its consent is beyond the scope of the Arbitrators’ task here, such fact cannot be ignored in its consideration as an element of the intention of Respondent and as an indication of Bad Faith in using the Dispute Domain Names.

In addition, in the Respondent’s reply to the Complainant’s initial letter of action dated 15 March 2003, the Respondent stated that it would consider transferring the domain name “if the conditions are appropriate”. Yet what qualifies as appropriate was not stated in the Respondent’s reply. The Complainant stated in its letter of 9 April 2002 that it was willing to reimburse actual expenses incurred by the Respondent in transferring the domain names. The Respondent did not reply. Failure to respond to a Complainant’s efforts to make contact was said to be strong support for a determination of bad faith registration and use in *Encyclopaedia Britannica v Zuccharini* WIPO Case No.D2000-0330.

All of the points described above support the Complainant’s contention that the Disputed Domain Names “essocn.com” and “cn-esso.com” were registered and subsequently used in bad faith pursuant to sub-paragraph 4(a) (iv) of the Policy. Although the content of the “aisocn.com” and “cn-aiso.com” sites, being the same as that of the “essocn.com” and “cn-esso.com” sites, are further evidence of bad faith on the part of the Respondent, since the trademark issue is beyond the scope of this Arbitration, the Panel’s conclusion regarding the lack of confusing similarity of such Domain Names is unaffected.

Status

www.essocn.com	Domain Name Transfer
www.cn-esso.com	Domain Name Transfer
www.aisocn.com	Complaint Rejected
www.cn-aiso.com	Complaint Rejected
www.中国埃索.com	Complaint Rejected

Decision

In light of the above mentioned findings, the Panel hereby decides:

That the Domain Names “essocn.com” and “cn-esso.com”, are identical or confusingly similar to the “Esso” trademark in which the Complainant has demonstrated to have rights, and that the Respondent has no rights nor legitimate interests in respect of such Domain Names; and both Domain Names were registered and are being used by Respondent in “bad faith”.

As such, the Panel requires that the registration of the Domain Names listed below be transferred to the Complainant:

- i) “essocn.com”
- ii) “cn-esso.com”

With regard to Domain Names (i) “aisocn.com” and (ii) “cn-aiso.com”, the Complainant fails to satisfy the requirements of Paragraph 4(a)(i) of the Policy and accordingly the Panel decides that the Complaint with respect to such Domain Names should be dismissed.

"中国埃索.com" domain name is not currently a Disputed Domain Name.

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