



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

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Decision Submission

English Print

Decision ID	DE-0600067
Case ID	HK-0600077
Disputed Domain Name	www.santonprene .com
Case Administrator	Dennis CAI
Submitted By	Anthony Wu
Participated Panelist	Anthony Wu
Date of Decision	10-03-2006

The Parties Information

Claimant	Advanced Elastomer Systems L.P
Respondent	Li Ming

Procedural History

On 29-12-2005, the Hong Kong Office of Asian Domain Name Dispute Resolution Centre (“ADNDRC”) received a hardcopy Complaint form in English filed by the Advanced Elastomer Systems L.P (the “Complainant”) pursuant to the Uniform Domain Name Dispute Resolution Policy (the “Policy”) adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on 24-10-1999. On the same day, the Hong Kong Office of ADNDRC received payment for Domain Name Dispute Complaint fee in connection with the case.

The Registrar, BIZCN.COM, Inc was notified of the Complaint on 4-1-2006 . The Registrar was requested to confirm that the domain name at issue was registered by the Respondent with them. On 6-1-2006, BIZCN.COM confirmed that the disputed domain name was registered with it by Respondent.

On 10/1/2006, the Hong Kong Office of ADNDRC by email notified the Respondent of the Complaint and provided copy of the Complaint to the Respondent. On 16/1/2006, the Hong Kong Office of ADNDRC served a notification of Commencement of the Proceedings on the Respondent and the Respondent was asked to submit a Response to the Complaint. On 18/1/2006, the Respondent replied advising the Hong Kong Office of ADNDRC to contact the factory entity, alleging that he was responsible for registration and the ownership belongs to the factory entity. The Respondent did not file any substantive response.

On 10-2-2006, the Hong Kong Office of ADNDRC notified the parties that as a Response to the Complaint has not been submitted by the Respondent within the required time, the Case Administrator will shortly appoint Panelist for the matter.

On 21-2-2006, the Hong Kong Office of ADNDRC appointed Mr Anthony Wu to serve as Panelist and notified the parties of the appointment. All documents submitted by the parties were sent to the Panelist by letter dated 21-2-2006.

Note: As the Complaint was lodged in English with Chinese translation and that the Respondent did not file a Response, the Panel, pursuant to Paragraph 11 of the Rules for the Policy, decides to use English in writing out this the decision.

Factual Background

For Claimant

Background and history of the Complainant

The Complainant is a limited partnership formed in 4 October 1990 and is wholly owned by ExxonMobil Corporation. The Complainant's headquarter is in Akron, Ohio, USA and it has regional offices in Brussels, Belgium; Tokyo, Japan; Santo Andre, Brazil; and Singapore. The Complainant is one of the world's leading suppliers of engineered thermoplastic elastomers ("TPEs") and one of the largest producer of TPVs (dynamic vulcanized alloys); it is the only global company fully dedicated to development, production and sales of TPVs under the "SANTOPRENE" brand.

The Complainant and its predecessor have been serving the world for more than 20 years. In 2004, the Complainant has spent over US\$285,000 each year on the running of advertisements worldwide of the Complainant's products marketed and sold under and by reference to the Complainant's trademarks including the "SANTOPRENE" mark. From 2001 to 2005, the Complainant sold an average of 91,000 kilograms of products each year under the "SANTOPRENE" brand worldwide.

The Complainant's predecessor made its foray into the PRC in the early 1980s. The Complainant and its predecessor have maintained a prominent presence in Asia-Pacific region since then. The Complainant's products with which the "SANTOPRENE" brand is used have been extensively promoted in the PRC since 1994, by means of press, circulars, display of posters and promotional products. Copies of samples of advertisements in the form of promotional materials, magazine and postcard promoting seminars having been made available in the PRC are appended at Attachment 4. Approximately RMB 282,200 was spent each year on the running of advertisements in the PRC of the Complainant's products marketed and sold under and by reference to the Complainant's trademarks including the "SANTOPRENE" mark from 2003 to 2005. From 2001 to 2005, the Complainant sold an average of 4,740 kilograms of products each year under the "SANTOPRENE" brand in China and Hong Kong SAR.

The Complainant's registered trademark "SANTOPRENE"

As early as 1978, the Complainant's trademark "SANTOPRENE" was first registered in the United States for thermoplastic elastomer in Class 1 under registration no. 1081414. The Complainant's trademark "SANTOPRENE" is registered in Class 17 in the PRC under registration number 255437 for goods of thermoplastic elastomer since 10 July 1986. The Complainant's trademark is also registered in over 60 countries in different in Class 1 and 17.

The "SANTOPRENE" brand quickly established itself as the leading brand worldwide for TPEs. TPEs include several product categories, namely styrenics (SBS, SEBS), olefinics, TPOs, TPVs, polyurethanes, co-polyesters and polyamides.

The Complainant's domain names

The Complainant is the registrant of the following domain names:

1. www.santoprene.com; and
2. santoprene.com.hk

At Attachment 5 of the Form C are copies of the Whois search results of the above Complainant's domain names.

Information on the Respondent

The Complainant has made investigation and provided information on the Respondent.

According to the record of the Whois database, the Respondent, Li Ming, a natural person in the PRC registered the domain name "santonprene.com" on 29 December 2004. A copy of the relevant Whois database record as inspected on 23 November was appended at Attachment 1 of Form C. It is not clear from the Whois database what Li Ming's mailing address is.

The domain name is used by a company called Ningbo Santon Polymer New Material Ltd ("Ningbo Santon"). Investigations conducted on behalf of the Complainant show that Ningbo Santon is not a registered company in the PRC but a personal business in Ningbo City, Zhejiang Province of the PRC. A copy of the company search of Ningbo Santon was appended at Attachment 6. The investigations and searches did not reveal any relationship between Li Ming and Ningbo Santon.

For Respondent

As noted above, the Respondent only replied very briefly by email to the Hong Kong Office of ADNDRC on 18/1/2006 advising it to contact the factory entity, alleging that he was responsible for registration and the ownership belongs to the factory entity. The Respondent did not file any substantive response.

Parties' Contentions

Claimant

The Complainant's contentions are as follows:
Use of the disputed domain name

Attachment 7 of Form C contains sample pages of the infringing website operated under the disputed domain name downloaded on 2 December 2005.

In the "Company Introduction" page of the infringing website, Ningbo Santon claims that it specialises in manufacturing and selling products relating to TPEs for many years. This statement is clearly false as Ningbo Santon has only been registered as a personal business on 27 February 2004. In fact, it is the Complainant which has years of experience in manufacturing and selling TPEs-related products.

Confusing similarity with the Complainant's registered trade mark

(i) The term "SANTOPRENE" is a distinctive mark and is not a descriptive or generic term.

(ii) It is obvious that the disputed domain name "SANTONPRENE" is confusingly similar to the Complainant's trademark "SANTOPRENE", both phonetically and visually.

No rights or legitimate interests of the Respondent

(i) The Respondent has no connection with the Complainant whatsoever. The Complainant has not authorised, licensed or otherwise permitted the Respondent or Ningbo Santon to use its trademark "SANTOPRENE" or any mark confusingly similar thereto nor has it licensed or otherwise permitted the Respondent to apply for or use, or allow anyone to use, any domain name incorporating the same.

(ii) As far as we are aware, neither the Respondent nor Ningbo Santon has applied for or registered the disputed domain name as a trade mark.

(iii) There is no evidence to indicate that either the Respondent or Ningbo Santon is using the disputed domain name as a trade mark or trade name. At Attachment 8 is a copy of Ningbo Santon's brochure. It is apparent that Ningbo Santon is using an English name "Santon" and not "SANTONPRENE", the disputed domain name. There is no reputation nor goodwill existing in the disputed domain name as a trade mark or trade name by either the Respondent or Ningbo Santon.

Bad Faith

(i) With the Complainant's global reputation and its reputation in the PRC, it is implausible that the Respondent and Ningbo Santon would not have heard of the Complainant and the trademark "SANTOPRENE" in the industry of TPEs. Ningbo Santon is operating the same nature of business as that of the Complainant. There is no plausible or justifiable reason for the Respondent to register and for Ningbo Santon to use the disputed domain name which is so confusingly similar to the Complainant's trademark. The inevitable and logical conclusion must be that the registration and use by the Respondent and Ningbo Santon of the disputed domain name is calculated to cause confusion: by using and registering a domain name confusingly similar to the Complainant's trademark, members of the public in the PRC and elsewhere will inevitably believe that Ningbo Santon and its infringing website are associated with the Complainant.

(ii) Furthermore, Ningbo Santon puts on its website false information about the background of its company which is intended to make the public believe that it is a well established company which has been committed in manufacturing

and selling TPEs contrary to the fact. The Respondent, as the registrant of the domain name, is fully responsible for the improper use of the disputed domain name.

(iii) Attachment 8, which shows no use of the "SANTOPRENE" name in the business of Ningbo Santon, suggests that the use of the "SANTOPRENE" domain name serves the only purpose of attracting visitors to its infringing website in the mistaken belief by the visitors that the infringing website is the Complainant's. Further, the brochure misleadingly and falsely suggests the cooperation with the Complainant by the reference to the Complainant's trademark "SANTOPRENE" as Ningbo Santon's partner. The reference to the Complainant's trademark is, in fact, a trademark infringement and further proves that Ningbo Santon has knowledge of the Complainant and its trademark "SANTOPRENE".

On the premises, the Complainant contends that the domain name is registered and used for illegitimate purposes, which has caused and will continue to cause damage to the Complainant's reputation and disruption to the Complainant's normal business operation.

Respondent

The Respondent did not respond substantively.

Findings

Identical / Confusingly Similar

The Complainant has the burden of proving that the domain name in dispute is identical to or confusingly similar to the "SANTOPRENE" mark. The Respondent's failure to respond does not relieve this burden or its burden of proof over either of the other two elements of Paragraph 4(a) of the Policy. However, the failure to deny any of the Complainant's allegations and evidence does entitle the Panel to take the Complainant's allegations and evidence as true and to draw appropriate inferences.

The Panel accepts the evidence of the Complainant that by virtue of the registration of its predecessor or itself it has rights over the trademark of "SANTOPRENE" for goods of TPEs in 1978. It is also registered in the PRC (since 1986) and elsewhere in the world as detailed by the Complainant for such goods.

"Confusingly similar turns on the inherent distinctiveness of the trademark, the extent of use of the trademark, the extent of time the trademark has been in use, the nature of the wares, services and business, the similarity in sound, appearance and idea suggested by the trademark and the domain name, among other factors." See *AltaVista Company v. Geoffrey Fairbairn*, Case No. D2000-0849.

For the following reasons, the Panel finds that the disputed domain name is confusingly similar to the trademark "SANTOPRENE":

1. "SANTOPRENE" is a distinctive mark and it is not a descriptive or generic term;
2. the trademark is a well known mark world-wide for highly specialised goods and has been in use for a very long time (over 20 years);
3. the disputed domain name has a only minor difference in spelling. Phonetically and visually it is very similar to "SANTOPRENE".

The Panel is satisfied that the requirements of Paragraph 4(a)(i) are met with.

Rights and Legitimate Interests

Paragraph 4(c) of the Policy requires the Complainant to prove that the Respondent has no right or legitimate interest in the disputed domain name. However, it is consensus view among Panelists that if the Complainant makes out a prima facie case that the Respondent has no rights or legitimate interests, and the Respondent fails to show one of the three circumstances under Paragraph 4(c) of the Policy, then the Respondent may lack a legitimate interest in the domain name. See *Société pour l'Oeuvre et la Mémoire d'Antoine de Saint Exupéry - Succession Saint Exupéry - D'Agay v. Perlegos Properties*, Case No. D2005-1085.

The Complainant avers and the Panel finds that the Respondent has no connection with the Complainant whatsoever. The Complainant has not authorised, licensed or otherwise permitted the Respondent or Ningbo Santon to use its trademark

"SANTOPRENE" or any mark confusingly similar thereto nor has it licensed or otherwise permitted the Respondent to apply for or use, or allow anyone to use, any domain name incorporating the same.

Further, the Complainant asserts that neither the Respondent nor Ningbo Santon has applied for or registered the disputed domain name as a trade mark and that there is no evidence to indicate that either the Respondent or Ningbo Santon is using the disputed domain name as a trade mark or trade name. On the basis of Attachment 8 (a copy of Ningbo Santon's brochure), the Complainant further asserts that Ningbo Santon is using an English name "Santon" and not "SANTONPRENE", the disputed domain name. There is no reputation nor goodwill existing in the disputed domain name as a trade mark or trade name by either the Respondent or Ningbo Santon. On the use of the website, the Complainant produced Attachment 7 and asserts that "In the "Company Introduction" page of the infringing website, Ningbo Santon claims that it specialises in manufacturing and selling products relating to TPEs for many years. This statement is clearly false as Ningbo Santon has only been registered as a personal business on 27 February 2004. In fact, it is the Complainant which has years of experience in manufacturing and selling TPEs-related products."

The Panels finds that a prima facie case has been made out by the Complainant. The burden of going forward with the evidence shifts to the Respondent. The Respondent is uniquely in the position of adducing evidence on his rights or legitimate interests in the disputed domain name. The notice given by the Respondent to the Hong Kong Office of ADNDRC that he was only responsible for the registration does not relieve the Respondent from responding to complaints. The Respondent has elected not to respond, and this Panel may therefore treat Complainant's assertions as true and the evidence adduced as uncontested. Under the circumstances, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name. The requirements under Paragraph 4(b)(ii) are met with by the Complainant.

Bad Faith

It is provided under Paragraph 4 (b) of the Policy that:

"For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be 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 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 of 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 onus of proof is on the Complainant to satisfy the Panel that one of the circumstances exists or otherwise there is bad faith in the registration and use of the domain name in dispute.

It appears to the Panel the contention of the Complainant falls to be considered under sub-paragraph (iv). In this regard, the Panel notes the following:

1. the Complainant is one of the world leading suppliers for goods of TPEs and "SANTOPRENE" is a renowned brand for TPEs;
2. the Respondent registered the dispute domain name for the benefit of Ningbo Santon which operates a website at the disputed domain in respect of products relating to TPEs and therefore the latter is operating the same nature of business as the Complainant;
3. the Complainant's mark has been registered and in use for over 20 years, it is inconceivable that the Respondent was not aware of the Complainant's mark before the registration of the disputed domain name in 2004. Further, in the brochures of Ningbo Santon, reference was made of the Complainant's mark. This supports the suggestion that the Respondent knew of the mark before or at the time of registration of the disputed domain name.
4. the Complainant asserts that the statement by Ningbo Santon that it specialises in manufacturing and selling product relating to TPEs for many years was false because Ningbo Santon was registered as a personal business only in 27 February 2004;

5. the Complainant asserts that the statement by Ningbo Santon in its brochure at Attachment 8 suggesting that the Complainant is in cooperation with Ningbo Santon was misleading and false.

The fact that the Respondent has chosen not to submit a response is particularly relevant to the issue of whether the Respondent has registered and is using the domain name in bad faith. Paragraph 14(b) of the Rules provides that, in the absence of exceptional circumstances, a Panel shall draw such inferences as it considers appropriate from the failure of a party to comply with a provision or requirement of the Rules. See *Société pour l' Oeuvre et la Mémoire d' Antoine de Saint Exupéry - Succession Saint Exupéry - D' Agay v. Perlegos Properties*, Case No. D2005-1085.

The Panel finds no exceptional circumstances for the Respondent' s failure to submit a response. The Panel draws the inference that the Respondent does not deny the facts which the Complainant asserts and accepts the evidence adduced by the Complainant.

Having regard to the assertions of the Complainant and the evidence adduced by the Complainant, the Panel is satisfied that Sub-paragraph(iv) is proved by the Complainant. The Panel comes to the conclusion that the intention of the Respondent in registering and using the disputed domain name (via Ningbo Santon) was an attempt to attract, for commercial gain, Internet users to the website at the disputed domain name, by creating a likelihood of confusion with the Complainant' s mark as to affiliation, or endorsement of the website at the disputed domain name or of the product on the website. As the contents of the webs site at the disputed domain name are in respect of the same line of business, and the erroneous description therein of having been in the business for many years, which would be apt for the complainant and not the Respondent , Internet users would easily be lured into believing that they are patronising a website of the Complainant. The website is a business website and purchase forms could be downloaded, it is clearly set up for commercial gain.

The Panel finds that the domain name has been registered and is being used in bad faith. The requirements under Paragraph 4(a)(iii) are with.

Status

www.santonprene .com

Domain Name Transfer

Decision

It is the finding of the Panel that all requirements of paragraph 4(a) are proved by the Complainant. In paragraph 9 of the Complaint, Complainant sought to have the domain name in question transferred to it. Having regard to circumstances of the case, the Panel believes that it is appropriate to transfer the domain name www.santonprene to Complainant and so orders.

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