

[Review Decision](#) [Publish Decision](#) [Cancel](#) [Home](#) [Back](#) [Create English Version](#)



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

— ADNDRC is a charitable institution limited by guarantee registered in Hong Kong

Decision Submission

[English](#) [Print](#)

Version
Decision ID DE-0700120
Case ID HK-0700135
Disputed Domain Name www.saia-borgess.com
Case Administrator Dennis CAI
Submitted By Yun Zhao
Participated Panelist

Date of Decision 12-09-2007

Language Version : English

The Parties Information

Claimant Saia-Burgess Electronics Holding AG
Respondent Yueqingshi Kaidaliyibiao Co., Ltd

Procedural History

On 19 July 2007, the Complainant submitted a Complaint in the English language to the Hong Kong 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 20 July 2007, the ADNDRC sent to the complainant by email an acknowledgement of the receipt of the complaint and reviewed the format of the complaint for compliance with the Policy, the Rules and the ADNDRC Supplemental Rules. All correspondence to and from the HKIAC described herein was in the English language.

On 20 July 2007, the ADNDRC transmitted by email to the Registrar, Xin Net Technology Corporation, a request for registrar verification in connection with the disputed domain name and on the same date, 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 2 August 2007, the ADNDRC transmitted the Complaint to the Respondent and notified the Respondent of the commencement of the action.

On 4 September 2007, the ADNDRC notified the Complainant that the Respondent had failed to submit a Response.

Since the Respondent did not file a response in accordance with the time specified in the Rules, the ADNDRC Supplemental Rules, and the Notification, the ADNDRC informed the Complainant and Respondent by email about the default, stating that, as the Respondent did not file a response within the required time, the ADNDRC would appoint the panelist to proceed to render the decision, in the absence of a response by the Respondent.

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

On 6 September 2007, the Panel received the file from the ADNDRC and should render the Decision within 14 days, i.e., on or before 21 September 2007.

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 Chinese, thus Chinese should normally be the language of the current proceeding. However, in the present case, the complaint was submitted in the English language; and the Respondent did not object to the use of English during the required period of time for response. The Panel, in consideration of the circumstances of this administrative proceedings and having regard to the fact that there is no express opposition submitted by the parties, determines English as the language of the proceedings.

Factual Background

For Claimant

The Complainant in this case is Saia-Burgess Electronics Holding AG, a corporation registered in Switzerland. The Complainant is the owner of the trademark “SAIA BURGESS”, “SAIA-BURGESS”.

For Respondent

The Respondent, Yueqingshi Kaidaliyibiao Co., Ltd, is the current registrant of the disputed domain name <saia-borgess.com> according to the Whois information.

Parties' Contentions

Claimant

The Saia-Burgess group was formed in 1989 by the restructuring of two predecessors, SAIA, which was established in 1920, and Burgess, which was established in 1935. The Complainant operates a leading electronics business under the trademarks which produces and sells a broad variety of electronics goods, parts, motors and accessories to a wide range of clients.

(1) The Respondent's disputed domain name is identical or confusingly similar to the Complainant's trade marks in which the Complainant has rights

The Complainant has numerous registration for the trademarks “SAIA BURGESS”, “SAIA-BURGESS”, “SAIA”, “BURGESS”, “SAIA PCD” and “思博 SAIA BURGESS”. These registrations are valid and subsisting and serve as prima facie evidence of the Complainant's ownership and of the validity of the trademarks.

Moreover, the Complainant has also filed numerous applications for the trademarks in various jurisdictions and used the trademarks worldwide starting from 1920. The Complainant submits that these applications and use of the trademarks establish the Complainant's rights in them.

The disputed domain name was registered on 28 December 2005, which far postdates the Complainant's dates of first use of the trademarks worldwide, including in China.

In addition to the registration and widespread use of the trademarks by the Complainant, since the Complainant already holds various top level and second level domain names containing the trademarks or combinations of the words comprised in the trademarks, persons accessing the disputed domain name are highly likely to think that the disputed domain name has a connection with the Complainant or is otherwise associated with or authorized, sponsored or approved by the Complainant. There is a very high risk of confusion, as a customer may think that the disputed domain name directly refers to the Complainant's business. As a result of the Respondent's actions, customer expectations are frustrated as they are either unable to purchase genuine products of the Complainant or mistakenly purchase products believing them to be supplied by the Complainant.

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

The trademarks are invented words, and as such as not words traders would legitimately choose unless seeking to create an impression of an association with the Complainant. Such an impression of association is an illegitimate exploitation of the distinctiveness of the Complainant's trademarks and goodwill.

The Respondent's website to which the disputed domain name resolves displays contents regarding the Respondent's business. The Respondent's website offers to supply a wide range of electronics goods, parts, motors and accessories, all of which are products offered by the Complainant under the trademarks. The Respondent's website is of similar design to the Complainant's websites. It can be clearly seen that the Respondent is using its website to illegitimately pass itself off as and for the business of or a business sponsored, approved, endorsed, licensed or authorized by the Complainant.

The Respondent does not hold any registered trademark rights in respect of the trademarks. The Complainant has conducted registration searches in all classes via the online trademark search engines and the results did not reveal any registrations by the Respondent for any trademarks in Hong Kong and China. On the other hand, the Complainant has prior registered trademark rights,

which precedes by over 70 years the Respondent's registration of the disputed domain name.

The Respondent is well aware that the trademarks are protected and is intentionally confusing the public by the use of the disputed domain name. There can be no valid suggestion that the Respondent is making a legitimate non-commercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers.

The Complainant has not authorized, licensed, endorsed or otherwise permitted the Respondent to register or use the disputed domain name or to use the trademarks to its business as a business name or otherwise. The Complainant has not in any way acquiesced to the Respondent's registration or use of the disputed domain name or the use of the Complainant's trademarks or similar marks in relation to the Respondent's business or otherwise.

(3) The disputed domain name has been registered and is being used by the Respondent in bad faith

The Complainant submits that the Respondent has registered the disputed domain name in order to prevent the Complainant from reflecting the Complainant's names and trademarks in a corresponding domain name.

The Respondent is a direct competitor of the Complainant and counterfeits the Complainant's products. The disputed domain name is accessible to persons in Greater China and worldwide. Using the disputed domain name, the Respondent disrupts the Complainant's business primarily by confusing the public and soliciting the Complainant's customers away to its counterfeit website and products.

The Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website and of the products on the website. It is unequivocal that the Respondent has registered and is using the disputed domain name to create confusion. The design of the website to which the disputed domain name resolves resembles that of the Complainant's websites. The website to which the disputed domain name resolves also achieves confusion by offering very similar electronic products, parts, motors and accessories in direct competition with the Complainant. Such confusion is intended for misleading the public in order to pass the Respondent off as and for the business of or a business sponsored, approved, endorsed, licensed or authorized by the Complainant and thereby attract the public to the Respondent's website.

The Complainant is famous all over the world and also in Greater China, particularly in the electronics industry, and the trademarks are used globally to designate the Complainant's products. The trademarks carry substantial goodwill throughout the world and in Greater China. Registration of a domain name containing a famous mark is strong evidence of bad faith.

The Respondent has not just been deceiving the public by using its confusingly similar domain name and website, but also by using the website to offer counterfeits of the Complainant's products which bear the trademarks.

The Respondent and certain persons and entities affiliated with and/or controlled by the Respondent have been producing and selling infringing SAIA BORGESS products via the Respondent's infringing website. Following a formal request from the Complainant, the Yueqing Administration of the Industry and Commerce took administrative action against the Respondent. A total of 12153 infringing items have been found and sealed. The Administration further gave oral orders to delete the words "SAIA-BORGESS" from its website. The Respondent is persistently continuing in its exploitation of the distinctiveness of the Complainant's trademarks in order to confuse and solicit customers for commercial gain.

Respondent

Respondent failed to submit a Response in this proceeding within the stipulated time.

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."

In view of the Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations pursuant to paragraphs 5(e), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence suggests to the contrary.

Paragraph 4 (a) of the Policy requires that the Complainant should prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

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

Identical / Confusingly Similar

The evidence submitted by the Complainant shows that the Complainant owns the trademarks “SAIA-BURGESS” and “SAIA BURGESS”, “SAIA PCD” and “思博 SAIA BURGESS”. Through continuous use, the trademarks have become famous among people worldwide. The question, therefore, is whether the use of the variant “saia-borgess” in the disputed domain name <saia-borgess.com> renders this confusingly similar to the above trademarks.

In the Panel’s view, the use of the disputed domain name for a website with similar design to the Complainant’s websites demonstrates that the disputed domain name has been chosen precisely for that reason. Furthermore, “saia-borgess” is a predictable spelling error away from “saia-burgess”. This can be further substantiated by the fact the pronunciation of “saia-borgess” is very similar, and even closer (compared with “saia-burgess”), to the Complainant’s Chinese trademark “思博” (which pronounces as “si bo”). The surfer looking for <saia-burgess.com> might not even realize if they mistyped and arrived at <saia-borgess.com>. Confusion, in the Panel’s view, is intended and intended to be exploited.

The Panel has no problem finding that the domain name <saia-borgess.com> is confusingly similar to the registered trademarks in which the Complainant has rights. The Panel therefore holds that the Complaint fulfills the condition provided in Paragraph 4 (a)(i) of the Policy

Rights and Legitimate Interests

The Complainant contends that the Respondent does not have rights to or legitimate interests in the disputed domain name. The Complainant’s assertion is sufficient to establish a prima facie case under Policy 4 (a)(ii), thereby shifting the burden to the Respondent to present evidence of its rights or legitimate interests. The Respondent has failed to show that the Respondent has any rights or legitimate interests in respect of the disputed domain name. This entitles the Panel to infer that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Panel therefore finds that the Complaint fulfills the condition provided in Paragraph 4(a)(ii) of the Policy.

Bad Faith

Under Paragraph 4 (b) of the Policy, the following are relevant examples a Panel may take as evidence of registration and use in bad faith:

(i) Circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) You have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) You have registered the domain name primarily for the purpose disrupting the business of a competitor; or

(iv) By using the domain name, you have intentionally attempted to attract, for commercial gain, internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.

Evidence shows that the Complainant’s trademarks have achieved a strong reputation throughout the world through long history of use and the worldwide significance of the brand name. As such, the public has come to recognize and associate the Complainant’s trademarks as originating from the Complainant and no other. This entitles the Panel to infer that the Respondent should be aware of the existence of the Complainant and its trademarks. The above inference has been further substantiated by the fact that the website to which the disputed domain name resolves is of similar design to the Complainant’s website and offers to supply a wide range of goods and products which are also offered by the Complainant. The action of registering the disputed domain name per se has constituted bad faith.

The Panel finds that the Respondent, offering to sell the same products of the Complainant by using the website of similar design to the Complainant’s website, has intentionally attempted to attract, for commercial gain, Internet users to the Respondent’s website by creating a likelihood of confusion with the Complainant’s trademarks. It could not reasonably be considered to be bona fide commercial practice. This is the use of the domain name of the type contemplated by Paragraph 4 (b) (iv) of the Policy.

In conclusion, the Panel finds that the Respondent has registered and used the domain name in bad faith. Accordingly, the Panel finds that the Complaint satisfies the condition provided in Paragraph 4 (a) (iii) of the Policy.

Status

www.saia-borgess.com

Domain Name Transfer

Decision

Having established all three elements required under the ICANN Policy, the Panel concludes that relief should be granted. Accordingly, it is ordered that the <saia-borgess.com> domain name should be TRANSFERRED from the Respondent to the Complainant.

ZHAO Yun
Sole Panelist

DATED: 11 September 2007

[Print](#)

[Back](#)

[Home](#)