



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (BEIJING OFFICE)

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Decision Submission

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Decision ID	DE-0300024
Case ID	CN-0300024
Disputed Domain Name	www.zebrachina.com
Case Administrator	anitaw
Submitted By	Hong Xue
Participated Panelist	Hong Xue Shoukang Guo Shaojie Chi
Date of Decision	11-12-2003

The Parties Information

Claimant	ZIH Corp.
Respondent	argox computer

Procedural History

On 9 October 2003, the Complainant submitted its Complaint to the Beijing Office of the Asian Domain Name Dispute Resolution Centre (the “Centre”), in accordance with the Uniform Domain Name Dispute Resolution Policy (the “Policy”) adopted by the Internet Corporation for Assigned Names and Numbers (“ICANN”) on August 26, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “ADNDRC Supplemental Rules”).

On 9 October 2003, the Centre confirmed the receipt of the Complaint and forwarded a copy of the Complaint to the Respondent as well as to the Registrar of the domain name in dispute, Network Solutions, Inc.

On 17 October 2003, the Centre received the Registrar’s confirmation of registration information of the domain name in dispute.

On 17 October 2003, the Centre notified the parties that the language of the proceeding be English, which was the language of the Domain Name Registration and Service Agreement between the Respondent and the Registrar.

On 21 October 2003, the Centre received the Complaint in English from the Complainant.

On 22 October 2003, the Centre sent the Transmittal of Complaint to the Respondent.

On 29 October 2003, the Centre notified the Complainant that the Complaint had been confirmed and forwarded, and; the Centre notified the Parties, the Registrar and the ICANN of the commencement of the case proceeding.

On 11 November 2003, the Centre received the Response from the Respondent.

On 12 November 2003, the Centre acknowledged the receipt of the Response, transmitted the Response to the Complainant, and notified the parties of selection of the panelists.

Having received a Declaration of Impartiality and Independence and a Statement of Acceptance from Professor Xue Hong, Professor Guo Shoukang and Mr. Chi Shaojie, on 14 November 2003, the Centre informed the Complainant and the Respondent of the appointment of the Panelists. The Panel should render the Decision within 14 days, ie, on or before 28 November 2003.

On 14 November 2003, the Centre transferred the case file to the Panelist by email as well as by post, and the Panelist confirmed the receipt of the file.

The Panelists find that the Panel was properly constituted and appointed in accordance with the Rules and the ADNDRC Supplemental Rules.

On 20 November 2003, the Complainant submitted to the Centre a Supplementary Statement to comment on the Response. On 21 November 2003, upon the approval of the Panel, the Centre forwarded the Complainant's Supplementary Statement to the Respondent as well as to the Panelist, and informed the parties that any supplementary statement or evidence should be submitted to the Centre on and before 26 November 2003.

Since 26 November 2003, the Panel has not received any further requests from the Complainant or the Respondent regarding other submissions, waivers or extensions of deadlines.

On 27 November 2003, the Centre notified the parties that, upon the request of the Panel, the deadline for the Panel to render the Decision was extended to 8 December 2003.

The language of the proceeding is English, as being the language of the Domain Name Registration and Service Agreement, pursuant to Paragraph 11(a) of the Rules, and also in consideration of the fact that there is no express agreement to the contrary by the Parties.

Factual Background

For Claimant

The Complainant is a subsidiary of Zebra Technologies Corporation. The Complainant's main business is holding and managing the intangible assets of the Zebra Group, which includes Zebra Technologies, the Complainant and other affiliates. The Complainant is the legal and/or beneficial owner of the trademark registrations for the "ZEBRA" mark worldwide.

For Respondent

The Respondent registered the domain name in dispute "zebrachina.com" on 25 January 2002.

Parties' Contentions

Claimant

1. The Complainant owns "ZEBRA" trademark and has rights in "ZEBRA" trademark. The Complainant owns the following trademark registrations for the "ZEBRA" mark in China:

Registered Trademark Number	Registration Date	Designated Goods
ZEBRA 714004	November 7, 1994	Label printing equipment
ZEBRA 1234941	December 28, 1998	Software for enabling a general-purpose computer to print (recorded); software for enabling a general-purpose computer to read bar codes (recorded)

The Complainant is currently applying to change the registrant's name of the above two "ZEBRA" trademarks from Zebra International Intangibles to the Complainant.

In addition, the Complainant is also the legal and/or beneficial owner of the trademark registrations for the "ZEBRA" mark worldwide.

The Complainant is a subsidiary of Zebra Technologies Corporation (hereinafter referred to as "Zebra Technologies"; Zebra Technologies, Complainant and other affiliates hereinafter collectively referred as "Zebra Group"). The Complainant's main business is holding and managing the intangible assets of the Zebra Group. The Zebra Group is the leading global provider of thermal barcode label and receipt printers, card printers, the widest range of thermal printer connectivity and networking solutions, etc. Zebra Technologies was incorporated in 1969 and was listed in NASDAQ in 1991. In October 1998, Zebra Technologies acquired Eltron International Inc., which was also a leading manufacturer of desktop barcode label and plastic card printers.

Offering innovative and reliable technologies and practical solutions, Zebra Technologies is highly valued by its customers, which include more than 90 percent of the Fortune 500 companies. Zebra Technologies' international distribution network encompasses approximately 100 countries throughout Europe, Asia, the Americas, Africa, the

Middle East, and the Pacific. Zebra Technologies also has various sales support offices located around the world, including China. In 2002, the total global turnovers of Zebra Technologies exceeded US\$470 million (approximately RMB3.89 billion).

Zebra Technologies has been using “ZEBRA” and “ELTRON” as trademarks on products under license from the Complainant. By way of a trademark license agreement, the Complainant has authorized Zebra Technologies to use the “ZEBRA” mark in China.

Zebra Technologies has extensive sales of printers and other products bearing the “ZEBRA” mark in China and the world. With respect to the China market, Zebra Technologies started to sell “ZEBRA” products into China since as early as 1988. Since 1993, Zebra Technologies started to appoint a company called Castek as its distributor in China. During the periods of 2000-2002, the annual sales figures for “ZEBRA” products in China were around RMB84,350,000, RMB76,910,000 and RMB91,790,000 respectively. For 2003 (up to July), the sales figure has already reached RMB57,890,000.

In summary, although the word “ZEBRA” is not a coined word and may have other meaning, through extensive trademark registrations and uses by the Complainant and the Zebra Group over a long period of time, the “ZEBRA” mark has become well-known and highly recognized by both customers and other competitors in the printer industry. Therefore, the Complainant has exclusive rights in the “ZEBRA” mark in the printer industry.

The disputed domain name is identical or confusingly similar to the “ZEBRA” mark in which the Complainant has rights. The disputed domain name is “zebrachina.com”. “.com” is a common suffix of domain names and “China” means the People’s Republic of China. Therefore, the main part of the disputed domain name is “ZEBRA”, which is identical with the Complainant’s “ZEBRA” mark. The disputed domain name is therefore confusingly similar to the “ZEBRA” mark in which the Complainant has rights.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent does not carry out any business or own any entities using that name nor does it have any related trademark registrations.

The disputed domain name has been registered and been used in bad faith. The registration and use of the disputed domain name by the Respondent demonstrates the Respondent’s bad faith of intentionally pirating the Complainant’s trademark and misleading the public.

(1) The Respondent pirated not only this disputed domain name but also four other domain names namely “zebra.com.cn”, “zebra.cn”, “eltron.com.cn” and “zebraprinter.com.cn”, whose main parts contain the Complainant’s “ZEBRA” and “ELTRON” marks respectively.

(2) The Respondent is a branch of Argox Information Co., Ltd. of Taiwan (“Taiwan Argox”) and its main business includes sales of barcode printers. The Respondent is in the same industry as the Complainant and the Zebra Group. The Respondent has full knowledge of the Zebra Group and Zebra Group’s use and rights in the “ZEBRA” mark. In fact, apart from the disputed domain name, the Respondent also registered “zebra.com.cn”. In that website, the Respondent displayed a picture for a school of zebras, and, without authorization, also displayed the link of Zebra Technologies’ website at “www.zebra.com” beside Respondent’s own website link at “www.argoxx.com.cn”. In addition, the Respondent also inserted above the two links a statement saying to the effect of “Welcome to the website of the world’s biggest barcode equipment manufacturer”. This is extremely misleading as it clearly suggested to customers that the Respondent was a licensee or a related company of Zebra Technologies, or that products and/or services of Respondent are endorsed by Zebra Technologies or its affiliates.

This is particularly so if customers then followed the links and visited the Respondent’s website at “www.argoxx.com.cn”, which contained indications that its products are “Zebra compatible”.

(3) In another website “www.argoxx.cn”, which is also registered and operated by the Respondent, the Respondent lists the website link under the disputed domain name and “zebraprinter.com.cn”. However, besides these two website links, there are notes of “Argox Zebra Compatible Equipment” and “Argox barcode printer Zebra (internet keyword)” respectively. This obviously demonstrates the Respondent’s intention of misleading consumers and causing confusion in bad faith. In another website “www.barcodeunion.com” registered and operated by the Respondent, the Respondent lists the websites of many barcode printer manufacturers, including Zebra Technologies. However, next to Zebra Technologies’ website, there are also links of the websites of “www.zebra.com.cn” and “www.eltron.com.cn”, both of which were registered by Respondent. This further proves that the Respondent knows of the Zebra Group’s use of the “ZEBRA” mark and clearly intended to mislead consumers into thinking that those two websites belong to Zebra Technologies.

(4) Authorized by the Complainant, Zebra Technologies sent a letter to the Respondent through the Group’s lawyer, Baker & McKenzie (“B&M”) on May 20, 2003, requesting the Respondent to assign the disputed domain name and other pirated domain names to Zebra Technologies and to stop unfair competition activities and other illegal activities against Zebra Technologies.

(5) The Complainant subsequently discovered that the Respondent changed the home page of the “www.zebra.com.cn” website to a Google search screen. However, if consumers conducted Google searches at that URL, they would find a lot of web pages in which there are words such as “compatible with ZEBRA” or words such as “ARGOX ZEBRA Barcode Printers” and “ARGOX ZEBRA Printing Platform” which have “ARGOX” and “ZEBRA” side-by-side. Such words would mislead the public into thinking that the relevant products were jointly manufactured and co-branded by the Respondent and the Complainant / Zebra Group, which is totally wrong. In addition, most of these web pages are indicated to be operated by the Respondent.

(6) B&M had contacted the Respondent after sending the letter on May 20, 2003. Mr. Yeung of B&M was first informed

by Mr. Guo of the Respondent that the Respondent agreed to delete the “ZEBRA” and “Ban Ma” words from its websites and was considering transferring the various domain names to Zebra Technologies.

(7) B&M contacted the Respondent again in July 2003 but was told that the Respondent had already assigned the “zebra.com.cn” and “zebra.cn” domain names to a third party and the assignment was in progress. The Respondent refused to disclose the assignee’s identity and refused to assign the disputed domain name.

(8) The Complainant then started to prepare the materials for filing domain name complaints. On August 4, 2003, the Complainant discovered that the registration of one of the domain names pirated by the Respondent, i.e., zebraprinter.com.cn, was cancelled. This clearly indicates that the Respondent acknowledged that it was wrong to register this domain name. The Complainant immediately arranged Zebra Technologies to register this domain name.

(9) Whois searches with the CNNIC then revealed that the “zebra.com.cn” and “zebra.cn” domain names were assigned to Shanghai Wenji Digital Science and Technology Co., Ltd. (“Shanghai Wenji”). The Complainant further discovered that there is close ties between the Respondent and Shanghai Wenji. In the Shanghai Wenji’s website at “www.zebra.com.cn”, Shanghai Wenji claims that it is Taiwan Argox’s sale agent in Shanghai and distributes Taiwan Argox’s barcode printers.

The Whois search against “zebra.com.cn” has revealed that despite the assignment, the contact person of this domain name remains unchanged. It is still Respondent’s Li Yuan. Shanghai Wenji has the same postal address as the Respondent. Li Yuan’s email address also remains unchanged. In addition, the administrative contact, fee payment contact and technical contact of this domain name, “Shi Jian”, has an email address at “shijian@argox.com.cn”. Please note that “argox.com.cn” is the Respondent’s website.

Whois search against another domain name “zebra.cn” has revealed that Shanghai Wenji’s contact Zhang Zhanbo has an email address at james@argox.com.cn. Argox.com.cn is the Respondent’s website.

The above facts clearly show that the Respondent and Shanghai Wenji are closely related. The assignment of the “zebra.com.cn” and “zebra.cn” domain names from the Respondent to Shanghai Wenji was aimed at preventing the Complainant to recover the two domain names. The Complainant has also filed a domain name dispute complaint with the Domain Name Dispute Resolution Centre of CIETAC in respect of the above two domain names.

(10) The above shows that the Respondent is fully aware of the Complainant’s “ZEBRA” trademark and the well-known printer products of the Zebra Group. The Respondent has registered the disputed domain name in bad faith. In addition, the main contents of the Respondent’s “www.zebrachina.com” website include printers, i.e., the designated products covered by the Complainant’s “ZEBRA” trademark registrations. In other words, the Respondent promotes and sells printers in the website using the disputed domain name. Given that the Respondent and the Complainant/Zebra Group are in the same industry, the Respondent’s use of the disputed domain name will mislead the public and disrupt the Complainant’s ordinary businesses. Further, the fact that the Respondent uses the disputed domain name for commercial activities for printers clearly shows that it has been using the disputed domain name in bad faith.

Based on the facts and grounds stated above, the Respondent has no legal rights in the “ZEBRA” and was registered and has been using the disputed domain name in bad faith.

2. The Complainant’s Supplementary Statement-regarding the Respondent’s response

The Complainant does not deny that the word “zebra” carries other meaning. However, within the printing industry, “ZEBRA” has become highly recognized as the Complainant’s trademark and trade name. The Google search report on “ZEBRA” shows Zebra Technologies websites as the first hit of the search. When Google search is narrowed down to “Zebra” and “Printing”, the hits are overwhelmingly related to Zebra Group’s products or website. The same results are found when the search is further limited to simplified Chinese language. It is beyond doubt that the mark “ZEBRA” is recognized as and associated with the Complainant’s products and services in the printer/barcode industry, and any misappropriation of such mark will cause harm to the Complainant and Zebra Group, as well as mislead the consumers. In this regard, the Complainant wishes to stress that it is the owner of “ZEBRA” trademark registration in China and many other countries.

The Respondent referred to “Argox Zebra Compatible Equipment” and “Argox barcode printer Zebra (Internet keyword)” in its website. The way that “Argox” and “Zebra” are presented side by side will undoubtedly mislead users into thinking that Argox is a business partner of the Zebra Group, which is not true. Such use of the mark “ZEBRA” is beyond the identification of “Zebra Compatible”. This clearly demonstrates that the Respondent’s intention of misleading the public and causing confusion in bad faith.

There have always been close ties between the Respondent and Shanghai Wenji. Given this background and the timing of the domain name transfer (at the time when the Zebra Group’s lawyer was negotiating with the Respondent for the transfer of the domain names to Zebra Technologies), it is obvious that the transfer is another tactic that the Respondent has used to make it more difficult for the Complainant to recover the “zebra.cn” and “zebra.com.cn” domains.

Respondent

[The following is the ORIGINAL text of the Response.]

*zebra is just a name generally used on many fields, like design, stationary, ...

*shanghai argox is a independent company in China, as common sense, Taiwan company is not allowed to establish non-manufacture company here. Shanghai argox have the same name with Taiwan argox just because shanghai argox import products from Taiwan argox. Shanghai argox is not branch of Taiwan argox.

*the description “zebra compatible” is just the same reason that several years ago, there are many pc showed “IBM

compatible” , it is a very simple and nothing to do with patent if we learn more about computer technology. This is a very important concept that it bring us to enjoy so many computer achievements.

*In the beginning, we put the link mark to lead people to visit www.zebra.com on obvious place, but by zebra company’ s request, they hope shanghai argox take away the description “ the largest barcode equipment <http://www.zebra.com>” , so we change it to google page to indicate all person to find what they need.

*Wenji company is another company which sell some stationary and barcode label. Shanghai argox give domain www.zebra.com.cn to them. It is a normal action.

* we shanghai argox have ever told zebra company, the stripe black and white is very clear to barcode image, if they think the stripe we use is similar to their, we can take away and we take away immediately.

zebra is a brand used by the company that they owns zebra.com, but the name also used by zebra pen, zebra design... as much as thousands of companies.

In the world, there are , maybe, 2000 domains contain “zebra” , if any company claims they owned all the domain contains “zebra” , then all the company that owns domains contains zebra would MUST GIVE UP their domain(s) ? This is a very clear issue. ... Please see the attached exhibit 1.

We can find another website offer such service, www.deleteddomains.com, and we find there are 235 results show the general people can apply the domain including zebra. If any company could claim that anybody cannot apply the domains contains zebra, that means ICANN encourage any person to involve to so many dispute. ... Please see the attached exhibit 2.

We know that even China government don’ t own the domain : www.china.com, the same reason, any company have no the right to claim that they own the domain including any country’ s name just because they come to this country to establish branch.

If anybody can claim that a general used word like zebra, I think this would cause great problems, even McDonald company cannot get their domains by dispute resolution Centre, the general name like zebra should not to be claimed controlled or owned by sole company. If there are no such rule, any company don’ t need to apply domain, when any other apply a domain and have good website (for example, there have good google rank or good inbound links) , anybody can make a “ dispute “ to get the domains with no price and receive other’ s hard work .

The zebrachina.com domain name is so clear that any company have no right to get it with no price, especially under the condition that we have ever make great work on it, and , by the way, our company never use zebrachina.com to do anything damage any company.

This problem is very easy and clear, we hope asian domain name dispute resolution centre can insist the general rule to judge it. This is a very easy and clear case, anybody with good sense on domains’ rule know the result.

With regard to the Complainants supplementary Statement, the Respondent did not submit any supplementary statement.

Findings

Identical / Confusingly Similar

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.

The Complainant claims that it is the legal and/or beneficial owner of the trademark registrations for the “ZEBRA” mark worldwide. In China, the registrant for the mark “ZEBRA” is Zebra International Intangible, Inc. On 4 April 2003, Zebra International Intangible applied to the China Trademark Office for assigning the registration for the mark “ZEBRA” to the Complainant. Although in term with the Chinese Trademark Law, assignment of a trademark registration is subject to the approval and public announcement of the China Trademark Office, the application for assignment proves that the Complainant has been authorized by the current trademark registrant to exercise the trademark right in China. Therefore, “ZEBRA” is a trademark in which the Complainant has right.

The disputed domain name is “zebrachina.com” . The Panel finds that the addition of the name of a place to a trademark, such as the addition of “China” to “ZEBRA” , is a common method for specifying the location of business provided under the trademark. The addition of a place name generally does not alter the underlying mark to which it is added (See WIPO D2000-0150; WIPO D2000-0713). Therefore, main part of the disputed domain name “zebrachina” , is confusingly similar to the Complainant’ s trademark “ZEBRA” , and the addition of the generic top-level domain “.com” does not make any difference.

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 claims that the Respondent had no legitimate right or interest in respect of the disputed domain name.

The Respondent does not prove that it carries out any business or owns any entity using the name “zebra”, or it has any related trademark registration in respect of “zebra”, but it contends that “zebra” is a generic name which is being used by many companies in different fields so that anybody may register a domain name containing “zebra”.

The Panel is not convinced by the contention raised by the Respondent. It has been sufficiently proved that “ZEBRA”, in the printer industry, is the trademark that has been extensively registered and used by the Complainant and its related companies for a long period of time, instead of the generic word referring to the animal “zebra”. The Respondent, which is in the same field of business as the Complainant, is fully aware of such fact. The Panel believes that the Respondent who has actual knowledge of the Complainant’s trademark has no right or legitimate interests to register a domain name that is confusingly similar to the Complainant’s trademark (See WIPO D2000-0090).

The Panel therefore finds that the Complaint fulfills the condition provided in Paragraph 4(a) (ii) of the Policy.

Bad Faith

A non-exhaustive list of what constitutes bad faith registration and use is set out in Paragraph 4(b) of the Policy, including the circumstances indicating that the respondent has registered the domain name in order to prevent owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct.

The Panel finds that the Respondent’s registration of the disputed domain name, namely “zebrachina.com”, has the effect of preventing the Complainant from reflecting its trademark “ZEBRA” in a domain name corresponding to its activities in China (See WIPO D2000-0438), and the Respondent has engaged in a pattern of such conduct by registering a series of domain names containing the Complainant’s trademarks “ZEBRA”, including “zebra.com.cn”, “zebra.cn”, and “zebraprinter.com.cn” (See WIPO D2000-0113; WIPO D2000-0708). The Respondent’s subsequent transfer of the domain names “zebra.com.cn” and “zebra.cn” to its related company, after being notified by Zebra Group’s lawyer, cannot conceal the fact that it has engaged in the pattern of such conduct. The Panel believes that the Respondent’s registration of the disputed domain name shows its calculated attempt to foreclose the Complainant from using its own trademark “ZEBRA” on the Internet. This is use of the domain name of the type contemplated by Paragraph 4(b)(ii) of the Policy, and accordingly is evidence of the registration and use of the domain name in bad faith.

Based on the above finding, the Panel ruled that the Complaint fulfills the condition provided in Paragraph 4(a) (iii) of the Policy.

Status

www.zebrachina.com

Domain Name Transfer

Decision

For all the foregoing reasons, in accordance with Paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain names, “zebrachina.com” be transferred to the Complainants.

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