

Asian Domain Name Dispute Resolution Center
Beijing Office
Administrative Panel Decision
Case No. CN-1200574

Complainant: TRILUX GmbH & Co. KG

Respondent: Kevin Hong

Domain Name: trilux-led.com

Registrar: Go Daddy Operating Company, LLC.

1. Procedural History

On 4 June 2012, the Complainant submitted a Complaint in the English language to the Beijing Office of the Asian Domain Name Dispute Resolution Center (the ADNDRC) and elected this case to be dealt with by a one-person panel, in accordance with the Uniform Domain Name Dispute Resolution Policy (the Policy) approved by the Internet Corporation for Assigned Names and Numbers (ICANN), the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules), and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the ADNDRC Supplemental Rules). 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 ADNDRC described herein was in the English language.

On 4 June 2012, The ADNDRC transmitted by email to the Registrar Go Daddy Operating Company, LLC. and ICANN a request for registrar verification in connection with the disputed domain name.

On 26 June 2012, The Registrar Go Daddy Operating Company, LLC. transmitted by email to the ADNDRC its verification response, confirming that the Respondent is listed as the registrant and providing the contact details.

On 1 August 2012, The ADNDRC transmitted the Complaint to the Respondent. Then the ADNDRC notified the Respondent of the commencement of the proceedings. On the same day, the

ADNDRC notified the Complainant that the Complaint has been confirmed and transmitted to the Respondent, and notified the ICANN and the Registrar of the commencement of the proceedings.

The Respondent submitted a Response within the specified time period. On 20 August 2012, The ADNDRC transmitted the Response to the Complainant.

Since both the Complainant and the Respondent chose to have a one-person panel, the ADNDRC informed the Complainant and the Respondent that the ADNDRC would appoint a one-person panel to proceed to render the decision.

Having received a Declaration of Impartiality and Independence and a Statement of Acceptance, the ADNDRC notified the parties that the Panel in this case had been selected, with Mr. ZHAO Yun acting as the sole panelist on 5 September 2012. The Panel determines that the appointment was made in accordance with Rules 6 and Articles 8 and 9 of the Supplemental Rules.

On 5 September 2012, the Panel received the file from the ADNDRC and should render the Decision within 14 days, i.e., on or before 19 September 2012.

Pursuant to Paragraph 11 (a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding. The language of the current disputed domain name Registration Agreement is English, thus the Panel determines English as the language of the proceedings.

2. Factual Background

For the Complainant

The Complainant in this case is TRILUX GmbH & Co. KG. The registered address is No. 4, Heidestraße, Arnsberg, Germany. The authorized representative in this case is Du Dandan and Zheng Jibin.

For the Respondent

The Respondent in this case is Kevin Hong. The registered address is Longhua Town, Shenzhen City, Guangdong Province 518109, China. The Respondent is the current registrant of the disputed domain names <trilux-led.com > according to the Whois information.

3. Parties' Contentions

Complainant

The Complainant was initially set up in Sauerland, Germany in 1912. The company conquered the entire market by its fluorescent lamps whose lumens brightness were three times the traditional incandescent light bulbs. And the name of the company came from this: TRILUX—threefold light. TRILUX has been the abbreviation of the Complainant for a long time. In 1950s, the Complainant set up a branch in France and began to expand the international market. Nowadays, the Complainant has established many sales offices in Europe, such as Austria, Switzerland, Czech Republic, Spain, France, United Kingdom, Hungary, Italy, Finland, Norway, Poland and Slovakia etc. Through continuous research and development over the past century, the Complainant has made itself a prime in the current lighting field all over the world, and being strict with the quality of products brings up its enduring leading position in the lighting market.

In China, in the early 1970s, the Complainant had filed an application with Trademark Office of China for the trademark "TRILUX" and the registration was approved. The registration was in Class 11 of International Classification and has been renewed all the time. In 1990s, through its investment company in Hong Kong, the Complainant set up Guangdong Ke Li Electronics Company Ltd., Intelligent Components Technology Zhuhai LTD. etc in Mainland China, and set off an upsurge to promote its products in Mainland China. The trademark "TRILUX" has gained enormous commercial value and enjoyed a high popularity and reputation both in China and the entire world by the long and extensive use, market promotion and advertising of the mark. In 2004, the Complainant entered the Guangzhou International Exhibition Center in a high-profile way and then attended the ninth Guangzhou International Lighting Exhibition held in 6 to 12 June,

which is the biggest lighting exhibition in Asia and second in the world. This aroused a wide attention in the lighting field, and numerous media scrambled to report this event. Thus, the brand awareness and influence of the Complainant and its trademark “TRILUX” reached a higher level in China. In January 2010, nine lighting industry giants including the Complainant, announced to launch a lighting cooperation organization—ZHAGA Consortium.

(1) The disputed domain name is the same or extremely similar to the Complainant’s trademark so that it leads to confusion.

The domain name consists of the main part “TRILUX-LED” and domain suffix “.COM”. As far as whether a domain name and a trademark are the same or confusingly similar is concerned, the suffix of the domain name will not be considered and can be ignored. The main part of the disputed domain name can be divided into two parts: “TRILUX” and “-LED”. As we know, “LED” is the abbreviation for “Light Emitting Diode”, in Chinese it is “发光二极管”, which is a general term without identification and obviously cannot be regarded as the core of the domain name. It is universally acknowledged that if the identification and remarkable part of a disputed domain name is the trademark of the Complainant, and the only difference between them is a general term without remarkable factor, the similarity between the dispute domain name and the trademark shall not be denied. The core of the disputed domain name is “TRILUX” that is almost the same to the Complainant’s trademark. The trademark is not a general term in English, but a connected word which has a high connection with the products; features, and it is the only specific word in which the Complainant has the legitimate rights. For ordinary network users, especially people in lighting industry, it is natural for them to associate the disputed domain name with the Complainant.

(2) The Respondent does not own the legitimate rights and interests to the disputed domain names.

The Complainant deems that it has the undoubted legitimate rights and interest to “TRILUX”. The Complainant has never licensed the Respondent to use the above-mentioned trademark or any other related label, or authorized the Respondent to register this disputed domain name, so the Respondent does not have any rights and interests to the disputed domain name. The trademark “TRILUX” has gained a very strong distinctiveness since the registration in

1970s through the extensive use by the Complainant and their associated companies. The date that the Complainant adopted and started to use the trademark is much earlier than the date when the Respondent registered the disputed domain name. As a result, the Respondent shall be responsible to prove that he owns the legitimate rights and interests of the disputed domain name.

Mainland China and Hong Kong are the location/principal business places of the Respondent and its associated companies. Through a search of the names of the Respondent and its associated companies in the official database of Trademark Office of China, the result shows that the Respondent and its associated companies do not have any trademark registration or application. Through a search at the website of Shenzhen Administration of Commerce and Industry, the result shows that the Respondent and its associated companies do not have registered companies in Shenzhen China. The query result shows the information of the Respondent's company on the website of Hong Kong Companies Registry. However, the company's registration date is 28 July 2011, which is later than the registration date of the disputed domain name and much later than the registration date of the trademark "TRILUX". The related companies' using "TILUX" in their name is a conduct of preemption in company name and a malicious violation to the Complainant's trademark "TRILUX". Based on a common sense that "anyone shall not profit from their illegal behavior", it is impossible that the Respondent can get any legitimate rights and interests related to the disputed domain name through the violation to the Complainant's trademark "TRILUX".

At the same time, there is no evidence demonstrating that the Respondent is known by others through the disputed domain name. The Respondent is a natural person, so his name does not have any similarity to the disputed domain name in any aspect. Therefore, the Respondent has no apparent need to use "TRILUX". The "TRILUX" in the trademark is a non-common term with a specific meaning and a high popularity and only has direct connection with the Complainant while the Respondent does not have any relationship with it. So the Respondent does not have any legitimate rights and interests or any reasonable ground to register and use this disputed domain name.

Moreover, the products introduced and promoted on the website pointed to by the disputed domain name and the goods covered by

the Chinese trademark “TRILUX” are in the same class. So the Respondent directly competes with the Complainant on the products. The use of the disputed domain name by the Respondent cannot be regarded as a legal non-commercial behavior or equitable use, and the behavior that the Respondent provides commodities and services through the disputed domain name cannot be in good faith.

(3) The Respondent registers and uses the disputed domain name is obviously in bad faith.

The “TRILUX” in the trademark is not a general term and does not have common meaning. Instead, it is a concocted word highly connected to the Complainant’s name and products’ features. The Complainant had registered the trademark in Trademark Office of China in the last 70s, while the registration date of disputed domain name is 14 July 2011 which is much later than the registration date of the Chinese trademark. Being a Marketing Director of a company in the same industry, it is impossible that the Respondent does not know the Complainant’s registered trademark. Besides, in 2009, the Complainant registered the domain name “TRILUX.COM”, and its registration date is also much earlier than that of the disputed domain name. Under these circumstances, it is obvious that the Respondent registers and uses the disputed domain name which causes confusion is in bad faith. One panel considers that a related factor that makes the panel decide that the Respondent in bad faith is that the Respondent registered a disputed domain name containing a put-together expression.

The products introduced and promoted on the website pointed to by the disputed domain name and the goods covered by the Chinese trademark “TRILUX” are in the same class. Besides, the Respondent highlights the use of the trademark which is similar to the trademark “TRILUX” of the Complainant on the website. This further proves the malicious behavior. Therefore, it is obvious that the Respondent aims to mislead the public that the Respondent is the Complainant’s branch in China or has cooperation relationship with the Complainant, so as to entice the network users to visit the Respondent’s website and gain illegitimate business benefits from the disputed domain name.

According to the reasons clarified above, the Complainant requests the Panel to issue a decision to transfer the Disputed Domain

Name to the Complainant.

Respondent

The disputed domain name is made from the Respondent's product features, and it was run and owned by the Respondent's company, not for personal use. The Respondent's company uses best raw materials to make LED products, so the quality is pretty good and the performance is 2 to 3 times better than others in the market, so the Respondent named the company "Trilux LED Lighting Industry Corporation Limited" and the domain name "TRILUX-LED.COM" accordingly. The company was founded on 28 July 2011 under the Companies Ordinance of Hong Kong, the registered Chinese name is 晶亮照明(控股)有限公司. The main business of the company is offering OEM/ODM/customized LED products to international clients. "Trilux LED" means three times brightness LED products, and the Chinese name "晶亮" means three Suns and three times brightness. And the company LOGO "Trilux LED Lighting + Three LEDs symbol", which also means three times brightness LED, and the most remarkable factor is LED. In the Respondent's company VI system, the disputed domain name, the company English name, the company Chinese name and the company LOGO are associated and have specific meaning, which compose a company VI system, and cannot be separated.

The disputed domain name registrant is the marketing director of Trilux LED Lighting Industry Corporation Limited, and in charge of marketing and advertising in the company. So, the board of Trilux LED Lighting Industry Corporation Limited applies to be as one of the Respondent to response to this Complaint, hope it will be accepted by the panel.

The disputed domain name is not the same or extremely similar to the Complainant's trademark, never leads to any confusion to related customers or visitors. The disputed domain name is made from the Respondent's company name and product features, it's together with the LOGO, the Chinese company name and the English company name are the complete system, and in specific meaning. It's quite different from the Complainant's trademark in design, shape, character font, form, structure and any other aspects. The disputed domain name and the Respondent's company name defines the Respondent's business range is ONLY LED RELATED PRODUCTS. It's quite different from the

Complainant's business range: goods and services, with the goods plugs and sockets for electric lights, lamp holders, sockets for electric lights, electric lights fixation, lampshade brackets, and chandelier brackets.

It cannot be regarded as the same or extremely similar to the Complainant's trademark, and never confuse the related customers. For ordinary network users, they don't know the Complainant's trademark and company; for people in lighting industry, they have professional knowledge to know which is the Complainant's trademark and company, and which is the Respondent's company, never leads any confusion to related customers or visitors. The Complainant's hypothetical conclusion cannot be regarded as evidence.

The Respondent owns the undoubted legitimate rights and interests to the disputed domain name. The disputed domain name is registered for Trilux LED Lighting Industry Corporation Limited, and was run and extensively used from the registered date to now. The "Trilux" from the disputed domain name and the company name is made form the Respondent's product features.

Just as the Complainant said, the Respondent and its associated companies don't have any trademark registration or application in trademark office of China. The Respondent did not register any trademark, and also did not know "TRILUX" is a trademark before registration of the disputed domain name, even the Respondent is marketing director of the Company. There is no official evidence demonstrating "TRILUX" is a well-known trademark in China, it has no special protection rights in China. There is no product in China market in "TRILUX" trademark or brand, even in the Complainant's company name. Therefore, the Respondent's legitimate behavior cannot be regarded as a conduct of preemption in company name and a malicious violation to the Complainant's trademark.

Actually, the registration of the company name is much earlier than the disputed domain name, but the company registration cannot be finished in a while universally. Some arrangements have to be made for the company during the period. The disputed domain name was registered under the principle of "First come, first served" after the company search was finished.

The disputed domain name and the company name is a symbol for

the high quality products and thoughtful services. The Respondent promoted the disputed domain name in various methods, and the disputed domain name was indexed by a lot of worldwide professional LED media or forums. The Respondent offer high quality products and thoughtful service through the disputed domain name and related website, and gains a lot of clients from Spain, Holland, UAE, Qatar, Bahrain, Lebanon, Malaysia, Thailand, Russia, Australia, New Zealand, etc. All these demonstrate that the Respondent was known by others through the disputed domain name and the related website. Now the disputed domain name becomes very famous in LED industry by the Respondent's long term promotion and advertisement, so the Complainant aims to abuse the trademark right to reverse hijacking the Respondent's legal domain name to gain illegal benefits.

The Respondent registers and uses the disputed domain name in good faith. The disputed domain name is an indispensable marketing and public visiting channels and basic method to extend the Respondent's business, it's not for sale. The website of the disputed domain name was updated frequently. The registrant registered only this domain name and there is no evidence demonstrating that the registrant sells domain names or has any disputes for domain names with other companies or individuals.

The Respondent never writes or hints any information on related website which shows the Respondent company and the disputed domain name has any relationships with the Complainant's trademark and the Company. The Respondent offers 100% customized products to clients, the product is with the Client's LOGO or trademark under the client's authorization. The samples are also without any trademark or LOGO on the website. The disputed domain name, the LOGO and the company name are standard for the Respondent's company, each of them is not trademark.

The disputed domain name is registered for Trilux LED Lighting Industry Corporation Limited, and was run and used from the registered date to now. The Respondent used the disputed domain name in a reasonable and rightful way; it cannot be regarded as malicious behavior. There is no evidence demonstrating that the Respondent uses the disputed domain name to destroy or affect the Complainant's trademark right and business. Therefore, it is obvious that the Respondent never misled the public that the

Respondent is the Complainant's branch in China or has cooperation relationship with the Complainant, so never enticed the network users to visit the Respondent's website and gain illegitimate business benefits from the disputed domain name.

For the reasons above, the Respondent request the Panel to reject this Complaint.

4. Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

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.

Identity/Confusingly Similarity

The Complainant is a German company with a history of around 100 years in the field of fluorescent lamps. The evidence shows that the Complainant registered the trademark "TRILUX" in mainland China as early as 1977. The protection period lasts till 2017. The registration date is far earlier than the registration of the disputed domain name (14 July 2011). The Panel has no problem in finding that the Complainant enjoys the prior rights in the trademark "TRILUX".

The disputed domain name is "trilux-led.com". As the suffix ".com" only indicates that the domain name is registered under this gTLD and is not distinctive, the main part of the disputed domain name is "trilux-led". This main part consists of two sub-parts ("trilux" and

“led”) connected by slashes. Obviously, the first sub-part (“trilux”) is identical to the Complainant’s trademark “TRILUX”. The second sub-part (“led”), abbreviation form for “Lighting Emitting Diode”, is exactly the major product of the Complainant and thus is not distinctive. The addition of “led” to the Complainant’s trademark “TRILUX” does not differentiate the main part of the disputed domain name from the Complainant’s trademark; with “led” being the major product of the Complainant, such an addition, on the contrary, strengthens the connection between the disputed domain name and the Complainant’s trademark.

The Respondent argues that the disputed domain name is different from the Complainant’s trademark in design, shape, character font, form, structure and any other aspects. It is noted that the first element of the Policy only requires the comparison between the main part of the disputed domain name and the trademark. The first element shall be satisfied as long as the main part of the disputed domain name and the trademark are so similar as to cause confusion. The addition of common or descriptive terms is insufficient to prevent threshold Internet user confusion.

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 has never authorized the Respondent to use the trademark or the 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 evidence submitted by the Respondent shows that the Respondent is the marketing director of a company set up in Hong Kong on 28 July 2011. The English name of this company is “Trilux LED Lighting Industry Corporation Limited.” The term “Trilux” is the distinctive part of the trade name of the company. The Panel noted that the Respondent is a company registered in Hong Kong; however, Hong Kong takes a liberal approach in the company registration process and does not examine the trademark rights which may be enjoyed by other right owners, as such, the

trade name of the Respondent should not serve as sufficient basis for relevant interests and legitimate rights enjoyed by the Respondent. As such, the Panel will need to decide on whether the Respondent has trademark or service mark rights over “Trilux”. Such trademark or service mark rights include both registered and unregistered trademark rights. In the current case, the term “trilux” was not the registered trademark of the Respondent’s company; the Respondent did not claim in the Response any unregistered trademark rights over “trilux”. In this regards, the Panel does not need to move further to examine the existence of any unregistered trademark rights over “trilux” by the Respondent or the Respondent’s company.

Under Paragraph 4 (c) of the Policy, the following are relevant examples a Panel may take as evidence of the Respondent’s rights or legitimate interests to the disputed domain name:

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

It is clear from the website of the disputed domain name that the Respondent is making commercial use of the domain name. Then has the Respondent carried out the business in good faith? The website of the disputed domain name shows that it is designed for the LED products, which are exactly the same products of the Complainant. Furthermore, it is noted that “TRILUX” is not a common or generic word. This induces the Panel to conclude that the Respondent is aware or should have been aware of the existence of the Complainant and its trademark “TRILUX”. The use of the disputed domain name, which is confusingly similar to the Complainant’s trademark, to sell the same goods and services of the Complainant cannot be a bona fide offering goods or services.

The Respondent submitted evidence to show that the Respondent

and his company were known by professional media and forums in the LED industry worldwide. The Respondent further submitted evidence (emails from clients) to show that the disputed domain name becomes very famous in the LED industry. All these evidences are not conclusive as to prove that the Respondent and his company have been commonly known by the domain name. The indexes of the disputed domain name only show the fact that the domain name is indexed by certain websites; nothing touches on the fact that the company has become commonly known by this disputed domain name. The earlier conclusion as to the confusing similarity between the disputed domain name and the trademark of the Complainant can create an unnecessary likelihood of confusion among the consumers, notwithstanding the fact that the Complainant trademarked with "TILUX" has been in the LED industry for around 100 years, while the Respondent has only been in the industry for less than 3 years.

It is indeed inconceivable that the disputed domain name could be used without creating a false impression of the association with the Complainant and its trademark "TRILUX".

As such, the Respondent has failed to show that the Respondent has any rights or legitimate interests in respect of the disputed domain name. The act of registering the disputed domain name does not automatically endow any legal rights or interests with the Respondent.

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.

The Complainant is a German company in the field of LED industry with a history of around 100 years. The evidence shows that the Complainant registered the trademark in mainland China in 1977 and that the trademark is still in the protection period. Through extensive use, advertisement and promotion, the trademark "TRILUX" has achieved a strong reputation around the world. The term "TRILUX" is not a common word, having no special meaning other than as a trademark denoting the goods or services of the Complainant. As such, the public has come to recognize and associate the Complainant's trademark as originating from the Complainant and no other. The products of the Complainant are for everyday use, not something unusual to the general public. The fact that the website of the disputed domain name contains the trademark "TRILUX" is obvious to all that the Respondent is aware of the existence of the Complainant and its trademark. The action of registering the disputed domain name *per se* has constituted bad faith.

The evidence further shows that the website of the disputed domain name has been designed to sell the same products as the Complainant. In fact, the Complainant has never authorized the Respondent and/or his company to use the trademark or sell these products. This is exactly the type of bad faith use of the disputed domain name as identified in the Policy, i.e. the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the website or other on-line location, by creating a likelihood of confusion with the Complainant's trademark as to source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

The Respondent argues that no attempts have been made to sell

the disputed domain name to the Complainant. It is noted that the requirement of bad faith shall be satisfied as long as one example listed in the Paragraph 4(b) of the Policy exists in a specific case.

As such, the Panel concludes 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.

Reverse Hijacking

The Respondent claims that the act of the Complainant constitutes reverse hijacking of the disputed domain name. With the Complaint's satisfying the three elements in Paragraph 4 (a) (iii) of the Policy, the Panel rejects the Respondent's claim accordingly.

5. Decision

For the foregoing reasons, the Panel orders that the domain name "trilux-led.com" be transferred to the Complainant TRILUX GmbH & Co. KG.

Sole Panelist:



DATED: 19 September 2012