



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1600888
Complainant:	ASSAB Pacific Pte. Ltd.
Respondent:	Xu Yong Jia
Disputed Domain Name(s):	<assab-cn.com>

1. The Parties and Contested Domain Name

The Complainant is ASSAB Pacific Pte. Ltd., of 8 Cross Street, #27-04/05 PWC Building Singapore 048424.

The Respondent is Xu Yong Jia, of Dong Guan Shi Chang An Zhen Shang Sha Ming He Dian Zi Guang Chang B301.

The domain name at issue is < assab-cn.com >, registered by Respondent with Foshan YiDong Network Co., Ltd., of Room 1801, 18th Floor, No. 1 of Jun Ning Building, No.213 Fu Ning Road, Foshan City, Guangdong Province.

2. Procedural History

The Complaint was filed with the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (the “Centre”) on August 29, 2016 and the Complainant chose a sole panelist to review this case in accordance with the Uniform Domain Name Dispute Resolution Policy (“the Policy”) which was adopted by the ICANN and came into effect on October 24, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”) which became effective on September 28, 2013 and the Supplemental Rules thereof which came into effect on July 31, 2015.

On August 30, 2016, the Centre confirmed the receipt of the Complaint and Annexures thereof, and transmitted by email to Foshan YiDong Network Co., Ltd. (the Registrar of the domain name) a request for registrar verification in connection with the domain name at issue. On the same day, the Registrar made the verification to the Centre, and pointed out that the language used in the Registration Agreement is Chinese.

On September 5, 2016, the Centre confirmed the receipt of the case fee from the Complainant, and sent the Complainant the Notification of Deficiencies of the Complaint to request that submitting the Complaint in Chinese on or prior to September 10, 2016. On September 8, 2016, the Complainant submitted to the Centre a Supplemental

Complaint requesting that English be used as the language of the administrative proceeding.

On September 9, 2016, the Centre sent the formal Complaint Notice to the Respondent and requested the Respondent to reply within 20 days (on or prior to September 29, 2016) in accordance with the Rules and Supplement Rules, and forwarded the Complaint, all the Annexes thereof as well as the language request from the Complainant. The procedures for this case formally commenced on September 9, 2016.

On September 30, 2016, the Centre issued a Default Notice and confirmed that the Respondent did not file a formal reply with the Centre, within the required time limit for filing a reply.

On September 30, 2016, the Centre sent a Notice of Panelist Appointment to Mr. Matthew Murphy as Panel candidate for the current case, and the Panel candidate considered that it was properly constituted and submitted the acceptance notice as well as a statement of impartiality and independence. On the same day, the Centre notified both parties and the Panel Mr. Matthew Murphy by email that Mr. Matthew Murphy be the sole panelist for arbitrating this case. The Centre then formally transferred the case to the Panelist. The Panelist agreed to deliver his decision with respect to the Disputed Domain Name on or prior to October 14, 2016.

3. Factual background

For the Complainant

The Complainant, ASSAB Pacific Pte. Ltd., claims that, it was formed in 1945 to market high quality tool steel from Sweden and was renowned for its quality standards. With its headquarters in Singapore, the Complainant claims that it operates around 50 offices in Asia Pacific supplying the steel, metallurgical tooling services and technical knowhow. It further claims that, through anchoring the distribution network for Uddeholm, a well known tool steel company, they together service leading multinational companies across practically all key industrial sectors in more than 90 countries.

The Complainant claims that in the Greater China region, it is called Yi Sheng Bai (一胜百) which means “One beats One Hundred” and underlines its position as an industry leader. It claims that its history in China can be dated back more than 60 years, and its tool steel were distributed in Southern China from the mid 1950s. Furthermore, the Complainant claims that it established its first wholly owned outlet in Shenzhen in early 1990s; and since then it has grown to be the leading foreign distributor of quality tool steels and services in China, with more than 500 employees in 22 locations and 18 affiliates across China.

In addition, the Complainant claims that it owns trademark registrations for the “ASSAB” trademark and other related trademarks (“ASSAB trademarks”) in various jurisdictions worldwide. Among the ASSAB trademarks, the Complainant registered its “ASSAB” mark in class 6 in Hong Kong on July 13, 1957, under No. 19570513. It also owns many ASSAB trademarks registered in Mainland China, such as No. 1055408 for “一勝百 ASSAB” in class 6 registered on July 14, 1997.

For the Respondent

The Respondent, Xu Yong Jia, is an individual located at Dong Guan Shi Chang An Zhen Shang Sha Ming He Dian Zi Guang Chang B301. The Respondent registered the Disputed Domain Name on August 5, 2013. The Respondent did not file any Reply or other materials with the Centre.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights:

The Complainant claims that it owns prior trademark rights in the "ASSAB" trademark in various jurisdictions worldwide. For instance, it obtained its registration for the "ASSAB" trademark in class 6 in Hong Kong (Reg. No. 19570513) on July 13, 1957, long before the registration date of the Disputed Domain Name.

The Complainant claims that the Disputed Domain Name <assab-tooling.com> contains two elements, "assab-cn" and top-level domain "com". Since the top-level ".com" does not have trademark significance and the letters "cn" is the abbreviation of "China" which cannot be recognized as being distinctive in itself, the only distinctive part of the Disputed Domain Name should be seen as "assab" and it is identical to the Complainant's "ASSAB" trademark. Thus, the Complainant contends that the Disputed Domain Name contains its "ASSAB" trademark as well as its trade name in its entirety, and such resemblance will no doubt mislead consumers into believing that the website is operated by or associated with the Complainant.

- ii. The Respondent has no rights or legitimate interests in respect of the domain name:

The Complainant claims that the Disputed Domain Name was registered by the Respondent long after most application and registration dates of its ASSAB Marks. It contends that its ASSAB Marks has acquired significant recognition worldwide after years of extensive use. The Complainant claims that it has no prior connection with the Respondent, nor authorizing the Respondent to use its mark in the Disputed Domain Name. Since the mark ASSAB is not a commonly used English term and there is no evidence showing that the Respondent has been commonly known by the Disputed Domain Name, the Complainant considers that it indicates the Respondent's deliberate attempt to take advantage of the "ASSAB" mark for commercial gain.

- iii. The disputed domain name has been registered and is being used in bad faith:

The Complainant claims that the bad faith can be shown based on the sufficient grounds as follows: 1) the long history and high degree of fame enjoyed by the Complainant and its trademarks in the world, including in China; 2) the filing

dates of the Complainant's marks long before the registration date of the Disputed Domain Name; 3) the incorporation of the Complainant's famous trademark in its entirety in the Disputed Domain Name; 4) the various additional infringing domain names associated with the Respondent targeting the Complainant's ASSAB trademark; 5) the striking similarity of the Complainant's and the Respondent's websites; 6) the false and misleading claims regarding its history on the Disputed Domain Name website; and 7) the use of the Complainant's Chinese mark “一胜百(ASSAB in Chinese)” in the Respondent's Chinese company name. The Complainant also mentions that in a recent UDRP case, a disputed domain name <china-assab.com> registered by using the same contact email address (pig620@139.com) as that of the Disputed Domain Name, which is similar to the Disputed Domain Name herein, was transferred to the Complainant.

B. Respondent

The Respondent did not submit any Reply.

5. Findings

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

- i. Respondent's domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- ii. Respondent has no rights or legitimate interests in respect of the domain name; and
- iii. Respondent's domain name has been registered and is being used in bad faith.

Language of the Proceedings

The Complaint was filed with the Centre in English, whereas the Registrar of the Disputed Domain Name confirmed to the Centre that the language used in the Registration Agreement is Chinese. When the Complainant was requested to submit the Complaint in Chinese, the Complainant submitted a request that English be the language of the administrative proceedings instead, based on the following reasons: 1) the Complainant is a foreign company which is not familiar with the Chinese language; 2) it would cause tremendous costs, time and unfair prejudice to the Complainant by requiring it to provide Chinese translations of all the evidence; and 3) the Disputed Domain Name < assab-cn.com > is in the English language and it consists of a trademark “ASSAB” and two letters “cn”. To further support its language request, the Complainant also lists numerous UDRP precedents as supportive material, such as D2006-0432, D2010-1589, D2010-2170, D2010-1569 and so on.

As is stated in a previous case, when deciding “whether to allow the proceedings to be conducted in a language other than the language of the Registration Agreement, and to require the Complainant in an appropriate case to translate the Complaint into the language of that agreement, the Panel must have regard to all ‘the relevant circumstances’”. And such circumstances include “whether the Respondent is able to understand and effectively

communicate in the language in which the Complaint has been made and would suffer no real prejudice, and whether the expenses of requiring translation and the delay in the proceedings can be avoided without at the same time causing injustice to the parties” - *See WIPO Case SWX Swiss Exchange v. SWX Financial LTD, D2008-0400.*

Accordingly, the Panel notes circumstances that may affect the determination of the language of the proceedings in the current case as follows:

- (1) The Respondent had been notified of the Complaint against it and invited to provide comments on the Complainant’s language request through email communications written in both Chinese and English by the Centre.
- (2) The Respondent did not raise any objection with respect to the Complainant’s language request, nor make any comments.
- (3) The Respondent registered many domain names, including the Disputed Domain Name, that contain English words; and
- (4) The Complainant, as a foreign company, is not able to understand Chinese at all, and most of the materials presented thereby are in English, which would take a lot of time and additional cost for such Chinese translation, and therefore, a delay in the proceedings will be inevitable.

Based on the above, the Panel considers that: it is reasonable to infer that the Respondent probably has the language ability of English, and therefore, should be able to understand English used in the proceedings. Even if the Respondent might have any difficulty of understanding English, since all the email communications were written in both Chinese and English, the Respondent must have been fully aware of the language request raised by the Complainant, and should have understood that what would happen if the proceeding is determined to be conducted in English. However, with sufficient time and opportunity to comment on or object to such language request, the Respondent did not object and did nothing.

Thus, upon weighing relevant circumstances from both sides, the Panel considers that it would be appropriate to exercise its discretion and conduct the proceedings in English.

A) Identical / Confusingly Similar

The Complainant has established its right to the “ASSAB” trademarks by submitting trademark registrations certificates and records from various jurisdictions, such as Hong Kong, Mainland China and so on.

There is no doubt that the Disputed Domain Name < assab-cn.com > completely incorporates the Complainant’s “ASSAB” trademark which is the only distinctive part of the whole Disputed Domain Name, and such incorporation makes the Disputed Domain Name confusingly similar with the Complainant’s trademark. With respect to the “cn”, considering that the website connected to the Disputed Domain Name is mainly a Chinese website and aims at Chinese speaking customers, it is reasonable to infer that the “cn” is referred to “China”. Thus, it means that the added “cn” can be deemed as a geographical term, which does not reduce the confusing similarity. As to the hyphen “-” added between the words of the Disputed Domain Names and the gLTD“.com” attached at the end thereof, such additions do not confer to the whole a new meaning involving the absence of risk of confusion with the trademarks - *See WIPO Case France Telecom SA v. France Telecom Users Group, D2000-0074.*

In conclusion, the Panel finds that the Complainant has satisfied the Paragraph 4(a)(i).

B) Rights and Legitimate Interests

As the rights owner of the “ASSAB” trademarks, the Complainant has confirmed that it has no prior connection with the Respondent in any way, nor has authorized the Respondent to use its trademarks in the Disputed Domain Name.

When it comes to determine whether the Respondent has any legal right and interest to the Disputed Domain Name or not, the mere registration of the Disputed Domain Name by the Respondent itself is not sufficient to prove that it owns legal right and interest thereof; otherwise, “all registrants would have such rights or interests, and no complainant could succeed on a claim of abusive registration” - *See: Adobe Systems Incorporated v. Domain OZ, WIPO Case No.: D2000-0057.*

The Panel notes that the Respondent failed to prove and there is no evidence indicating that, it has been commonly known by the Disputed Domain Name, nor has making a legitimate noncommercial or fair use thereof. On the contrary, the Complainant pointed out with screenshots of the Disputed Domain Name website that, the Disputed Domain Name has been resolving to a website that contains logos and content that is very similar to those of the Complainant’s official websites <www.assab.com> and <www.assab-china.com>. Such similarity between the two parties’ websites will give people the wrong impression that the operator of the Disputed Domain Name website may be associated with the Complainant, or be the Complainant. Obviously, using the Disputed Domain Name to attract visitors to a website with misleading and potentially infringing content does not count for any “bona fide offering of goods or services”. Not to mention, such use is also an indication of bad faith use as well.

In conclusion, the Panel finds that the Complainant has satisfied the Paragraph 4(a)(ii).

C) Bad Faith

In looking at bad faith, the following issues must be considered:

- (1) the registration date of the Complainant’s trademark is much earlier than that of the Disputed Domain Name;
- (2) the fame of the Complainant and its “ASSAB” trademarks accumulated in the steel business;
- (3) similarity between the Disputed Domain Name and the Complainant’s trademark;
- (4) in a reverse WHOIS search using the Respondent’s email pig620@139.com conducted by the Complainant, the said email address was found in association with 82 domain names;
- (5) the same result shows the Respondent registered three other domain names that contain the Complainant’s trademark:<assab-17.com.cn>, <assab-tool.com> and <assab-zg.cn> as well;
- (6) the way the Disputed Domain Name was used, which was to attract visitor to a misleading which copies the Complainant’s website content and logo, without authorization thereof.

Apart from the issues (1)-(3) above which indicates the Respondent's prior knowledge the Complainant's trademark whilst registering the Disputed Domain Name, it can also be seen from the issues (4)-(5) that the Respondent has a pattern of registering numerous domain names, including those containing other parties' trademarks. With respect to the four domain names incorporating the Complainant's trademarks, such as <assab-tool.com>, the way the Respondent combined the "assab" and the corresponding suffix together actually indicates that he/she may be well aware of the Complainant's "ASSAB" trademark and its value when he/she registered the Disputed Domain Name. Accordingly, it is reasonable for the Panel to infer that the Respondent must have been aware of the Complainant and its "ASSAB" trademark while registering the Disputed Domain Name, and such registration with prior knowledge of the Complainant's trademark indicates bad faith registration.

Moreover, such bad faith registration is further supported by the way the Disputed Domain Name was used as it is stated in issue (6) above: when internet users were attracted to and clicked the Disputed Domain Name due to the confusingly similarity between the said domain name and the Complainant's trademarks, they would be immediately led to the misleading website mentioned above. The fact that such website has been unauthorized using the Complainant's trademarks and copying the Complainant's history and introduction to promote itself, would probably mislead consumers to believe that they were visiting the website of an affiliate of the Complainant, or the Complainant itself. Thus, the Panel concludes that the Disputed Domain Name has been used in bad faith as well.

In conclusion, the Panel finds that the Complainant has satisfied the Paragraph 4(a)(iii).

6. Decision

Pursuant to Paragraph 4(i) of the Policy and Article 15 of the Rules, the Panel orders that the disputed domain name < assab-cn.com > be transferred to the Complainant.

Matthew Murphy
Sole Panelist

Dated: October 12, 2016