



# Asian Domain Name Dispute Resolution Centre

hong kong

(Hong Kong Office)

## ADMINISTRATIVE PANEL DECISION

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<b>Case No.</b>	HK - 1400584
<b>Complainant:</b>	UL LLC and Underwriters Laboratories Inc.
<b>Respondent:</b>	Steven Brown / BP Consulting
<b>Domain Name:</b>	<ul-ccic.com>

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### 1. The Parties and Contested Domain Name

The Complainants are UL LLC and Underwriters Laboratories Inc., incorporated and domicile in the United States.

The Respondent is Steven Brown/BP Consulting  
Domiciled 391 West Broadway, Lincoln, ME 04457, United States

The domain name at issue is <ul-ccic.com>, registered by Respondent with GODADDY.COM, LLC (Annex 1)  
14455 North Hayden Rd  
Suite 219  
Scottsdale AZ 85260  
United States

### 2. Procedural History

The Complaint has been filed with the Hong Kong office of the Asian Domain Name Dispute Resolution Centre (ADNDRC) on March 13, 2014. The ADNDRC Hong Kong office transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. Also on March 14, 2014, the Registrar transmitted by email to the Center its verification response disclosing the identity and the contact details of the registrant, since he had used a privacy service.

In accordance with the Rules, paragraphs 2(a) and 4(a), the ADNDRC Hong Kong office notified the Respondent of the Complaint. In accordance with the Rules, paragraph 5(a), the due date for Response was April 17, 2014. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 22, 2014.

Marie-Emmanuelle Haas has been appointed in this matter on April 29, 2014 by the ADNDRC Hong Kong Office as the Panelist, pursuant to the Internet Corporation for Assigned Names and Numbers (ICANN) Uniform Domain Name Dispute Resolution Policy, the Rules for ICANN

Uniform Domain Name Dispute Resolution Policy, and the ADNDRC Supplemental Rules in respect of the above Domain Name.

Soon after the notification of the Panelist's appointment, the Respondent sent an email to the parties, to the ADNDRC Hong Kong office and to the Panelist, on April 29, 2014, offering to transfer the Domain Name.

The deadline granted to render the decision has been extended until May 19, 2014.

### **3. Factual background**

The Complainants UL LLC and Underwriters Laboratories Inc., independent safety consulting and certification provider, are originally established in 1894 and headquartered in U.S.A.

The Complainants have more than a century of expertise innovating safety solutions from the public adoption of electricity to new breakthroughs in sustainability, renewable energy and nanotechnology. They provide safety-related certification, validation, testing, inspection, auditing, advertising and training services to a diverse array of stakeholders, including manufacturers to optimize their supply chains, retailers on inspections and audits, and industry on standards that create level playing fields.

As one of the global leaders in the industry, have been known for developing standards including life safety standards, sustainability standards, standards for electrical and electronic products, standards for industrial control equipment, standards for plastic materials, and standards for wire and cable. There are 1,485 current standards for safety published by the Complainants.

The Complainants have employees in 40 countries and regions around the world. In 2013, the Complainants evaluated 20, 268 types of products and nearly 22 billion UL marks were used on various products, to make the world safer and provide assurance. UL customers appeared in 104 countries and nearly 700 million consumers were reached with safety messages in Asia, Europe and North America.

The Complainants began conducting business in China in 1980, making UL the first foreign-headquartered certification company to enter the market and the first to help Chinese manufacturers gain access to key markets. In 2003, the Complainant Underwriters Laboratories Inc. and China National Import and Export Commodities Inspection Corporation (now China Certification and Inspection Group, CCIC) partnered to set up a UL-CCIC joint venture, UL-CCIC Company Limited (苏州UL美华认证有限公司). Today, the Complainants have 12 offices in China and provide a vital link between Chinese manufacturers and the global market.

The Complainants' China subsidiary UL-CCIC Company Limited registered the Domain Name on 15 January 2003 and operated an official website at the address [www.ul-ccic.com](http://www.ul-ccic.com), where information was provided on the UL mark and its service in China. UL-CCIC Company Limited remained registrant of the Domain Name until at least 17 January 2013; however, due to an administrative oversight, UL-CCIC Company Limited and the Complainants were not notified of the renewal. As [www.ul-ccic.com](http://www.ul-ccic.com) had been forwarded to [www.ul.com](http://www.ul.com) since 2011, the Complainants thus did not become aware of the expiration of the Domain Name until mid January 2014.

The Domain Name was registered with GODADDY.COM, LLC, using a privacy shield service, on 30 March 2013, shortly after the Domain Name was deleted after its expiration. The Domain Name has been used to host a purported blog for dental health.

According to the information provided by the Registrar, the Registrant is Steven Brown / BP Consulting.

#### 4. Parties' Contentions

##### A. Complainant

The Complainant's contentions may be summarized as follows.

##### i. Likelihood of confusion

The Complainants rely on UL word and device trademarks, registered in China since 1998 and in the United States.

Underwriters Laboratories is the owner of the UL Chinese trademarks registrations No. 1219954, No. 1219955, No. 1219952 and of the UL American trademark registrations No. 0782589 and No. 2391140.

UL LLC Ltd is the owner of the UL word trademarks, with a US registration No. 4201014 and International Registration No. 1162825 protected since 2012 and with another UL word and device International Registration No. 1114610.

UL-CCIC Company Limited has been the Registrant of <ul-ccic.com> until it expired on January 15, 2013.

After over a century's extensive use and continuous advertisement by the Complainants, the UL trademark enjoys very high and broad reputation worldwide, particularly in the United States where the Complainants are headquartered and where the Respondent appears to reside.

"UL" stands for the Complainants' trade name "UL" or the abbreviation of its trade name "Underwriters Laboratories". "UL" is a brand name coined by the Complainants, and no other third party appears to have used the mark UL in the past commercially except in relation to the Complainants. The mark "UL" is exclusively associated with the Complainants, and known primarily as an identifier of Complainants' products and services.

The prominent part of the Domain Name is "ul-ccic", consisting of the Complainants' distinctive mark "UL", and "ccic", the abbreviation of China National Import and Export Commodities Inspection Corporation, the China partner of the Complainants.

"UL-CCIC" is directly referring to the Complainants' joint venture in China and is the trade name of UL-CCIC Company Limited. Before the Respondent's registration of the Domain Name, the Domain Name had been registered and used by the Complainants' joint venture as official website for around ten years (2003-2013), which definitely had established exclusive association between the Complainants' joint venture and the Domain Name.

The mark UL is a coined word and a highly distinctive mark. Incorporation of the Complainants' distinctive and famous UL trademark in entirety in the Domain Name in itself establishes that the Domain Name is confusingly similar to the UL trademark. See *EAuto, L.L.C. v. Triple S. Auto Parts d/b/a Kung Fu Yea Enterprises, Inc.*, WIPO Case No. D2000-0047, "When a domain name incorporates, in its entirety, a distinctive mark, that creates sufficient similarity between the mark and the domain name to render it confusingly similar". See also *Hoffmann-La Roche Inc. v. Wei-Chun Hsia*, WIPO Case No. D2008-0923, "wrapping a well-known mark with merely descriptive or generic words is a doomed recipe for escaping a conclusion that the domain name is confusingly similar to the well-known mark". The Panel also finds in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903, that "The fact that a domain name wholly incorporates a complainant's trademark is sufficient to establish identity or confusing similarity for the purpose of the Policy, despite the addition of other words to such marks".

The Domain Name is therefore confusingly similar to the Complainants' UL trademark.

ii. Absence of rights and legitimate interests

It has been a general rule via UDRP precedents that mere registration does not establish rights or legitimate interests in a domain name so as to avoid the application of paragraph 4(a)(ii) of the Policy. See *Potomac Mills Limited Partnership v. Gambit Capital Management*, WIPO Case No. D2000-0062. The Respondent thus does not enjoy any rights or legitimate interests in the Domain Name merely because of its registration of the Domain Name.

The Respondent has never been licensed or authorized to use the trademark UL or to use it to register the Domain Name. To the best of the Complainants' knowledge, the Respondent does not hold any UL trademarks or trademarks incorporating the letters "UL". The Respondent thus does not have trademark right in respect of the Domain Name.

In the current case, no plausible explanation exists to suggest the possibility of any circumstances of the type specified in paragraph 4(c) of the Policy, or of any other circumstances giving rise to a right to or legitimate interest of the Respondent in the Domain Name. The Respondent's use of the Domain Name is not a *bona fide* use pursuant to paragraph 4(c) of the Policy, and there is no indication that the Respondent has been commonly known by the Domain Name.

In all, the Respondent has no rights or legitimate interests in the Domain Name. It is well-established that once a Complainant establishes a *prima facie* case that a Respondent lacks rights or legitimate interests in a domain name, the burden of production shifts to the Respondent. See *Croatia Airlines d.d. v. Modern Empire Internet Ltd*, WIPO Case No. D2003-0455.

iii. Bad faith registration and use

As previously stated in this Complaint, the UL trademark, through extensive use in connection with services provided in respect of safety consulting and certification, is well known worldwide and in particular, United States where the Complainants are headquartered and where the Respondent appears to reside. Furthermore, the Domain Name had been held and used by the Complainants for over ten years before its expiration. A simple search via Google or any other search engine using the keyword "UL" or "UL CCIC" or "www.ul-ccic.com" would demonstrate that the UL mark and the Domain Name is exclusively connected with the Complainants and

UL-CCIC Company Limited. The Complainants thus find it inconceivable that the Respondent would not have had actual notice of the mark UL at the time of registering the Domain Name.

The Domain Name had been used by the Complainants for over ten years and is closely connected with the Complainants. The Panel decides in *Deutsche Bank AG v. Diego-Arturo Bruckner*, WIPO Case No. D-2000-0277, that “the Domain Name is so obviously connected with the Complainant and its services that its very use by someone with no connection with the Complainant suggests opportunistic bad faith”. In similar circumstances, other panelists also have considered re-registration of a domain name by another shortly after its accidental expiration amounts to opportunistic bad faith. See *Bryant Tyson v. Fundacion Private Whois/ Domain IP Holding Corp.*, WIPO Case No. D2013-0529; *Kevin Nealon v. Whois Protection*, WIPO Case No. D2007-1225; *Rug Doctor L.P. v. Domain Strategy, Inc.*, WIPO Case No. D2002-0355.

As the Panel decides in *Skype Limited v. Xiaochu Li*, WIPO Case No D2005-0996, if a trademark is a coined word with no meaning or connection with the goods or services sold under it, a Respondent could not be using the mark in a descriptive sense, and a Respondent must provide plausible explanations in his choice of the Domain Name which are confusingly similar to the mark.

No plausible explanation exists as to why the Respondent selected the mark UL as part of the Domain Name other than to exploit the goodwill of the Complainants and its trademark to make illegitimate interests. There is no evidence to justify the Respondent’s registration and use of the Domain Name, and bad faith registration could be inferred. See *Paule Ka v. Paula Korenek*, WIPO Case No. D2003-0453, “*The Respondent knew she was using a commercial name (protected as a trademark) because she copied it ... That knowledge is sufficient to constitute bad faith registration under the Policy, even if the Respondent asserts that she did not think she was infringing any rights. Ignorance of the law is no excuse*”. See also *Government Employees Insurance Company v. Gonzalez*, WIPO Case No. D2011-1130, “*What does show bad faith, however, is the very domain name itself... Complainant’s mark is ‘distinctive and not an everyday word or phrase... a coined term that is today known primarily as an identifier of Complainant’s products and services. There is, or could be, no contention that Respondent selected the Domain Name for its value as a generic term or random combination of letters*”.

The Domain Name is currently used to host a purported blog for dental health. It is obvious that the Respondent does not intend to use the Domain Name for a *bona fide* offering of goods or services, but deliberately registered the Domain Name in order to prevent the Complainants from registering and using it. The Respondent was clearly aware of the Complainants’ ownership of the Domain Name when he decided to pick up the Domain Name. The ultimate purpose of the Respondent is to offer to resell the Domain Name back to the Complainants or their competitors, for unjustified commercial gains.

The Respondent, by using the Domain Name, is trying to profit from the diversion of Internet users by confusion between the Domain Name and the Complainants, and disrupts business of the Complainants. The purpose of registering the Domain Name is to trade on the fame of the Complainants’ famous trademark UL, in order to attract, for commercial gain, Internet users to visit the corresponding website under the Domain Name, by creating a likelihood of confusion with the Complainants and the UL trademark. The Domain Name is currently used to misleadingly direct traffic to a website not associated with the Complainants, while Internet users are likely to assume that by visiting the Domain Name, they would access information provided by the Complainants’ subsidiary about its services in China. The Respondent has traded on such

confusion to direct traffic to its own site and such use of has caused *de facto* confusion and misidentification as to the affiliation to the Complainants.

Finally, the Respondent has taken deliberate steps to conceal its true identity and ensure that its true identity cannot be determined, by using privacy service. Although mere use of a privacy service does not necessarily imply bad faith as such service could be used to serve legitimate interests of privacy and spam protection, but in the light of all the bad faith factors discussed above, the concealment of the Respondent, coupled with the Respondent's exploitation of the Complainants' trademark for commercial gain, does demonstrate bad faith registration and use. See *Villeroy & Boch AG v. Whois Data Shield/Hong Kong Names LLC*, WIPO Case No. D2008-1300; *Fifth Third Bancorp v. Secure Whois Information Service*, WIPO Case No. D2006-0696.

#### iv. Remedy

The requested remedy is the transfer of the Domain Name to the Complainants.

#### B. Respondent

The Respondent did not respond to the Complaint.

Pursuant to the notification of its default to respond, he sent an email dated April 29, 2014, offering to transfer the Domain Name:

"Thank you for the continued contact about this domain. However, I apologize that either of you have to spend any time on it. I offered to give the domain back to the complainant free of charge as soon as I was notified of their desire to retain it. Unfortunately that notification came in the form of an official complaint that locked the domain, prohibiting me from giving it back to them. Had they merely asked they would have it back already. Even though I dispute the charges in their complaint that allege an attempt to infringe upon their trademark, I did not bother to fill out the official response paperwork since I had already agreed to let them have it back. I have already lost time and money on this domain due to their negligence in maintaining its registration, and don't want to waste any more on it. Please take whatever steps necessary let them have it back without costing me any more money. I just want to be rid of it".

### 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 must be 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.

#### A) Identical / Confusingly Similar

The Complainants have both rights in the respectively cited UL trademarks.

The Domain Name consists of the distinctive term UL of the Complainants' trademarks and of the name of its Chinese partner

The Panel thus finds that the Domain Name is confusingly similar to the UL trademark and that paragraph 4(a)(i) of the Policy is satisfied.

### **B) Rights and Legitimate Interests**

Paragraph 4(c) of the Policy enumerates several ways in which the Respondent may demonstrate rights or legitimate interests in the Domain Name:

“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for the purposes of paragraph 4(a)(ii):

- (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”.

The Panel notes that the Respondent is not a licensee of, or otherwise affiliated with, the Complainant, and has not provided any evidence that it has been commonly known by the Domain Name. According to the available record, the Respondent has neither used the Domain Name in connection with a *bona fide* offering of goods or services, nor used the Domain Name for a legitimate noncommercial or fair use.

The Complainant has, therefore, made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name. The Respondent has not filed a Response. When he sent an email, pursuant to the default’s notification, it was to offer to transfer the Domain Name.

Accordingly, the Panel finds that paragraph 4(a)(ii) of the Policy is satisfied.

### **C) Bad Faith**

Paragraph 4(b) of the Policy enumerates four, non-exhaustive, circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- “(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site 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 web site or location or of a product or service on your web site or location."

The Complainants produce evidence of the former registration of the Domain Name in the name of UL-CCIC Company Limited until the expiration date of January 15, 2013.

The Respondent chose to register a domain name that consists of the distinctive word part of the UL Complainants' trademarks to which it merely added the acronym CCIC, which designates their Chinese partner.

He, not only did not contest the Complaint, but later offered to transfer the Domain Name.

In light of the above, the Respondent cannot have ignored neither the Complainants' trademark rights when he registered the Domain Name, nor the joint-venture with the Chinese company CCIC, that took place in 2002, long before he registered the Domain Name.

Therefore, the Panel believes that the Respondent has registered the Domain Name in bad faith, in the meaning of paragraph 4(b)(i) of the Policy.

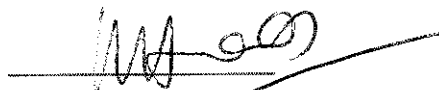
The Respondent used the Domain Name to resolve to a website consisting of articles on "cosmetic dentistry", offering to leave comments.

Accordingly, the Panel finds that paragraph 4(b)(iv) of the Policy is satisfied.

For the above reasons, the Panel finds that paragraph 4(a)(iii) is satisfied in this case and that the registration and use of the Domain Name has been made in bad faith.

## 6. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name <ul-ccic.com> be transferred to the Complainants. In case the Registrar does not allow a transfer to both Complainants, the Domain Name shall be transferred to one of them.



Marie-Emmanuelle HAAS  
Panellist

Dated: May 19, 2014