



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-2301724
Complainant:	XCMG Construction Machinery Co., Ltd.
Respondent:	Rodrigo Mora
Disputed Domain Name(s):	<xcmg-iberica.com >

1. The Parties and Contested Domain Name

The Complainant is XCMG Construction Machinery Co., Ltd., of Industrial Zone 1, Xuzhou Economic Development Zone Jiangsu(China).

The Respondent is Rodrigo Mora, of Tellinares 24, Gava, Barcelona, Spain.

The domain name at issue is <xcmg-iberica.com>, registered by Respondent with Instra Corporation Pty Ltd., of GPO BOX 988, Melbourne, Victoria, Australia, 3001.

2. Procedural History

On March 1, 2023, pursuant to the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”) and the Rules for the Uniform Domain Name Dispute Resolution Policy (the “Rules”), the Complainant submitted a Complaint to the Hong Kong Office (“HK Office”) of the ADNDRC (“ADNDRC”). On the same day, the HK Office sent to the Complainant by email an acknowledgment of the receipt of the Complaint and reviewed the format of the Complaint for compliance with the Policy, the Rules and the HK Office Supplemental Rules. The HK Office also notified the Registrar of the Complaint by email.

On March 2, 2023, the Registrar replied to the HK Office informing the identity of the domain name Registrant. On the same day, the HK Office informed the Complainant that the information of the Respondent in the Complaint was different from the WHOIS information provided by the Registrar. On March 7, 2023, the Complainant submitted an amended Complaint to the HK Office. On March 8, 2023, the HK Office confirmed that the amended Complaint is in administrative compliance with the Policy and the Rules. On March 9, 2023, the HK Office forwarded the amended Complaint to the Respondent. The due date of the Response was March 29, 2023. On the same day, the Respondent sent an unofficial response to the HK Office by way of an email. The HK Office invited the Respondent to file an official Response but the Respondent did not do so and on March 30, 2023, the HK Office informed the Respondent of his default. On the same day, the HK

Office appointed Francine Tan as the sole panelist in this matter. After the Respondent was informed of the appointment, he sent another unofficial response to the HK Office.

3. Factual background

The Complainant, XCMG Construction Machinery Co., Ltd., was founded in 1993. It manufactures and sells construction machinery. The Complainant's products include earthmoving machinery, lifting machinery, piling machinery, concrete mixing machinery, road machinery, mining machinery, aerial work platforms, environmental industries, agricultural machinery, port machinery and rescue and protection equipment. The Complainant states that it is the third largest construction machinery company in the world and is ranked 65th in the list of China's Top 500 Companies. Currently, the Complainant has established a marketing network of more than 2,000 service terminals, 6,000 technical experts, more than 5,000 marketing and sales service staff, covering 183 countries with over 300 distributors worldwide. The Complainant's European research and development centre was established in 2013, followed by a procurement centre and sales centre in Europe, with its European headquarters in Krefeld, Germany. The Complainant's global sales revenue for the year ending 2021 was US\$15.1 billion.

The Complaint states that it has been using XCMG as its corporate name and trade mark for many years, which has become highly recognizable in Europe. It is the owner of XCMG trademark registrations (the "XCMG Marks"), including but not limited to the following:

- Italian Trademark Registration No. 2,777,959 for “”, registered on December 13, 2007;
- German Trademark Registration No. 30 2022 015 006 for “”, registered on October 5, 2022;
- U.K. Trademark Registration No. UK00003686558 for “”, registered on August 26, 2021; and
- Romanian Trademark Registration No. 181179 for “”, registered on August 10, 2021.

The disputed domain name was registered on December 16, 2018, and at the time of the filing of the Complaint, resolved to an active website bearing the Complainant's XCMG Marks and identifying the Respondent as the Complainant's distributor. The website also featured products which bore the Complainant's XCMG Marks.

The Respondent appears to be affiliated with Maquinas Elevacion XCMG Iberica S.L. ("Maquinas Elevacion"), which was the Complainant's distributor "in the Spanish region" by way of a Distribution Agreement entered between the Complainant's associated company, Xuzhou Construction Machinery Group Import and Export Co., Ltd., and Maquinas Elevacion on April 1, 2020. The Complainant states that it unilaterally

terminated the Distribution Agreement¹ as Maquinas Elevacion had breached the Distribution Agreement.

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 the Complainant's XCMG trade mark in which it has rights. The disputed domain name consists of the Complainant's XCMG trade mark (which is identifiable therein), "-iberica", and the generic Top-Level domain ("gTLD") ".com". The word "iberica" corresponds to the English short form for "Iberian Peninsula" and is a common word that lacks prominence in the disputed domain name. The hyphen "-" also carries no significance when considering the identity or confusing similarity with the Complainant's trade mark. XCMG is the main aspect of the disputed domain name and the incorporation of the trade mark in the disputed domain name is likely to cause confusion.
- ii. The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent has no trademark or name rights in the XCMG Marks. The Complainant and Respondent used to have a partnership relationship which has since been terminated due to the Respondent's/ Maquinas Elevacion's (collectively "the Respondent") breach of the Distribution Agreement. On the issue of whether the Respondent had rights and legitimate interests in the disputed domain name, the Complainant submitted the following, with reference to the seminal case² from which the "Oki Data" test originated:
 - a. The respondent must actually be offering the goods or services at issue. The Complainant submitted evidence that the Respondent had previously used the disputed domain name to feature the Complainant's XCMG Marks and the Complainant's goods that bore the XCMG Marks. The Complainant also submitted evidence that the Respondent was using the disputed domain name to redirect Internet users to third-party websites which display the Complainant's competitors' trade marks, and the disputed domain name does not offer the goods or services at issue.
 - b. The respondent must use the disputed domain name website to sell only the trademarked goods or services. The Respondent was using the disputed domain name to redirect Internet users to third-party websites which display the Complainant's competitors' trade marks.
 - c. The disputed domain name website must accurately and prominently disclose the registrant's relationship with the trademark holder. The Complainant submitted evidence that the Respondent did not accurately reflect its relationship with the Complainant as the Respondent claimed that it is the Complainant's exclusive agent in the Spanish region.

¹ Having an expiry date of March 30, 2023.

² *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903.

- d. The respondent must not try to “corner the market” in domain names that reflect the trademark. The Respondent claimed that it is the Complainant’s exclusive agent in the Spanish region and was attempting to operate a monopoly in the Spanish region.
- iii. The Respondent does not satisfy the “Oki Data” test. The Respondent should have cancelled its business name after the termination of the Distribution Agreement. The Complainant did not authorize the Respondent to use its XCMG Marks in a domain name.
- iv. The disputed name has been registered and is being used in bad faith. The Respondent used the disputed domain name to sell the Complainant’s products. The Respondent had clear knowledge of the Complainant and its XCMG Marks. Before the Distribution Agreement was terminated by the Complainant, the Respondent claimed to be the Complainant’s exclusive distributor in Spain without the Complainant’s permission and in breach of the Distribution Agreement. After the Complainant terminated the Distribution Agreement and ended the commercial relationship with the Respondent, the Respondent redirected the disputed domain name to a website displaying the Complainant’s competitor’s ZOOMLION trade mark.

B. Respondent

The Respondent did not submit an official Response, but sent two informal responses, which may be summarized as follows:

- i. On March 9, 2023, the Respondent sent an email to the HK Office, with the Complainant in copy, stating:

“To whom it may concern:

We send the following attachment:

- 1- Letter of authorisation issued by the factory to use the name XCMG for the creation of our company XCMG Iberica. (International Company Multiservice 2013 S.L. was a holding of Xcmg Iberica)
- 2- Domain registration certificate in the kingdom of Spain of our company "Maquinaria Elevacion XCMG Iberica". Made within the term allowed by the factory
- 3- Distribution contract.

I would like to clarify that the company Maquinaria Elevacion Xcmg Iberica S.L. has changed its name because you have terminated the contract with Xuzhou Construction Machinery Group Import and Export Co., Ltd

Best regards
Rodrigo Mora”

- ii. The HK Office invited the Respondent to submit an official Response before the deadline, but the Respondent failed to do so. Instead, the Respondent sent another

email after the deadline to the HK Office with the Complainant's representative and appointed Panelist in copy, stating:

“Dear Ms. Francine Tan

This domain is mine and I'm willing to sell it
If somebody is interesting (*sic*) please let me know.

Best regards
Rodrigo Mora”

5. Findings

The 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 trade mark 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 Complainant has provided evidence of its trademark registrations for the XCMG Marks. Although the XCMG Marks are stylized and feature Chinese words and/or a logo on the left side, the Panel finds that the disputed domain name is confusingly similar to the Complainant's XCMG Marks in which the Complainant has rights. It is well-established in earlier UDRP Panel decisions that “these [stylized] elements are largely disregarded for purposes of assessing identity or confusing similarity under the first element [of the Policy. ... On this basis, trademark registrations with design elements would prima facie satisfy the requirement that the complainant show ‘rights in a mark’ for further assessment as to confusing similarity”. (See section 1.10 of the *WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition* [“*WIPO Overview 3.0*”].)

The Complainant's XCMG trade mark is reproduced entirely in the disputed domain name with the addition of a hyphen and short form geographical term, “-iberica”, for the Iberian Peninsula. It is a well-established principle that where the relevant trade mark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The inclusion of the gTLD “.com”, does not remove the confusing similarity with the Complainant's XCMG trade mark as the gTLD is merely a technical requirement for domain name registrations.

The first element of paragraph 4(a) of the Policy has been satisfied.

B) Rights and Legitimate Interests

The Panel finds that the Complainant has demonstrated a *prima facie* case that the Respondent lacks rights or legitimate interests in respect of the disputed domain name. The Respondent was not authorized to register a domain incorporating the Complainant's XCMG trade mark without the Complainant's consent. There is no evidence that the Respondent is commonly known by the disputed domain name. The Respondent does not appear to use the disputed domain name for a legitimate noncommercial or fair use, without intent for commercial gain.

Once a complainant has established a *prima facie* case that a respondent lacks rights or legitimate interests in the disputed domain name, the burden of production shifts to the respondent to show that it has rights or legitimate interests in respect of the disputed domain name. (See *WIPO Overview 3.0*, section 2.1.) The Panel finds that the Complainant has established a *prima facie* case that the Respondent has no legitimate rights or interests in the disputed domain name. The Respondent's two unofficial responses were brief and vague, and more significantly, failed to address or answer the Complainant's contentions. The Respondent failed to produce evidence and arguments showing it had a legitimate interest or rights in the disputed domain name. In fact, the latest email addressed to the Panel indicates that the Respondent has no interest in the disputed domain name since it is willing to offer it up for sale.

The Panel notes that the Respondent submitted certain documents, which appeared to be the following:

- (i) An authorization letter issued by an affiliated company of the Complainant, Xuzhou Construction Machinery Group Imp. & Exp. Co., Ltd to Internayional (*sic*) Company of Multiservices 2013 SL for the use of the "XCMG" trade mark in Spain to register and use "XCMG IBERICA" for the promotion, sales and other commercial activities of XCMG products. Notably, the authorization was valid for two years, from April 24, 2019 to April 23, 2021.
- (ii) An untranslated document in the Spanish language which the Respondent states is a domain registration certificate issued in Spain for Maquinaria Elevacion XCMG Iberica that was registered during the "term allowed by the factory".
- (iii) The Distribution Agreement.

Apart from the fact that the above documents were not submitted by way of a formal Response within the stipulated deadline, the Panel notes that the validity period of the authorization letter has passed and the Respondent failed to address the Complainant's contentions or rebut its *prima facie* cases.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The second element of paragraph 4(a) of the Policy has been satisfied.

C) Bad Faith

A complainant has the burden of proving that the respondent registered and is using the disputed domain name in bad faith. Paragraph 4(a)(iii) of the Policy states that:

“[T]he following circumstances, in particular but without limitation, 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 [the respondent has] registered or [the respondent has] 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) [the respondent has] 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 [the respondent has] engaged in a pattern of such conduct; or
- (iii) [the respondent has] registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [its] 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 [the respondent's] web site or location or of a product or service on [the respondent's] web site or location.”

The Complainant's XCMG Marks are registered in several countries, including in Italy, since 2007. Given the apparent notoriety of the Complainant's XCMG Marks (which has not been disputed by the Respondent), the look of the Respondent's website, and how the disputed domain name was and is being used by the Respondent, it is evident that the Respondent, being well aware of the Complainant and its XCMG Marks, specifically targeted the Complainant and its marks and sought to capitalize from the likely confusion resulting from the registration of the disputed domain name.

The Respondent is no longer an authorized distributor of the Complainant and was never an exclusive distributor. The Panel would add a comment herein that this administrative proceeding under the UDRP is not the appropriate forum to determine the legality and effect of the termination of the Distribution Agreement and the Panel makes no finding on these points. If this issue had been raised by the Respondent, the Panel would have declined to make a determination on such an issue. The Panel makes its determination in this case with reference to the *prima facie* case and in accordance with the stipulations and well-established principles of the UDRP.

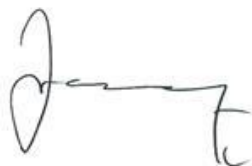
The Complainant's claim that the Respondent has attempted to pass off itself as the official Iberian website of the Complainant and to ride off the reputation and goodwill of the Complainant, and subsequently to redirect Internet users to websites which feature the Complainant's competitors' trade marks, have not been disputed by the Respondent. Since the disputed domain name is confusingly similar to the Complainant's XCMG Marks, the Panel finds that the circumstances indicate that there has been a blatant attempt by the Respondent to confuse and/or mislead Internet users seeking or expecting to find the Complainant at the website to which the disputed domain name resolves. The Respondent's offer to sell the disputed domain name to interested buyers, in the context of this case, is a further indicator of evidence of bad faith of registration and use of the disputed domain name.

Therefore, the Panel agrees that the circumstances constitute evidence of bad faith registration and use under paragraph 4(b)(iv) of the Policy.

The third element of paragraph 4(a) of the Policy has been satisfied.

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 disputed domain name <xcmg-iberica.com> be transferred to the Complainant.



Francine Tan
Panelist

Dated: April 13, 2023