



Asian Domain Name Dispute Resolution Centre

hong kong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-2301750
Complainant:	Caterpillar (NI) Limited
Respondent:	Ma Chao
Disputed Domain Name(s):	<cn-fgwilson.com>

1. The Parties and Contested Domain Name

The Complainant is Caterpillar (NI) Limited, of Old Glenarm Road, Larne, County Antrim, Northern Ireland, BT40 1EJ, United Kingdom. The Complainant is represented by Hogan Lovells (Shanghai) Intellectual Property Service Co., Ltd.

The Respondent is Ma Chao, of Min quan xian cheng guan zhen lao cheng cun, Shang Qiu, Henan, China.

The domain name at issue is <cn-fgwilson.com>, registered by the Respondent with Hong Kong Juming Network Technology Co., Ltd., of 3A-9, 12/F, Kaiser Centre, No.18 Centre Street, Sai Ying Pun, Hong Kong.

2. Procedural History

On 6 May 2023, the Complainant filed a Complaint involving the Disputed Domain Name <cn-fgwilson.com> with the Hong Kong Office of Asian Domain Name Dispute Resolution Centre (“Centre”), pursuant to the Uniform Domain Name Dispute Resolution Policy (“Policy”) approved by the Internet Corporation for Assigned Names and Numbers (“ICANN”) on 24 October 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (“Rules”), approved by ICANN Board of Directors on 28 September 2013 and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (“Supplemental Rules”) effective from 31 July 2015.

On 8 May 2023, the Centre transmitted by email to the Registrar a request for confirmation of the WHOIS records of the Disputed Domain Name and other related information.

On 10 May 2023, the Registrar confirmed by email that it is the Registrar of the Disputed Domain Name that was registered by the Respondent; and that the Policy is applicable to the dispute relating to the Disputed Domain Name and the language of the Registration Agreement of the Disputed Domain Name is English and provided to the Centre the Respondent’ email address and other WHOIS information of the Disputed Domain Name.

On 19 May 2023, in accordance with Articles 2(a) and 4(a) of the Rules, the Centre issued a Written Notice of the Complaint and formally notified the Respondent of the commencement of the proceedings in this dispute. In accordance with Article 5(a) of the Rules, the due date for the Respondent to submit a Response to the Complaint was 8 June 2023.

On 9 June 2023, the Centre issued a notification of the Respondent in Default, confirming that the Centre did not receive response forms from the Respondent in respect of the Complaint concerning the Disputed Domain Name within the required time.

On 12 June 2023, the Centre appointed Prof Chan-Mo Chung as the sole panelist of the Administrative Panel (the "Panel") in this matter. Prior to the appointment, the said sole panelist had submitted to the Centre his Statement of Acceptance and Declaration of Impartiality and Independence in compliance with Article 7 of the Rules.


Having reviewed the communications records, the Panel finds that it was properly constituted and appointed in accordance with the Rules and the Supplemental Rules. The Panel also finds that the Centre rightly decided English as the language of this proceeding.

3. Factual background

The Panel accepts the followings as undisputed facts:

The Complainant was formerly known as F.G. Wilson (Engineering) Limited, founded in 1966 by Fred George Wilson in Belfast, Northern Ireland. In 1999, the Complainant became a wholly-owned subsidiary of Caterpillar Inc. while retaining the F.G. Wilson brand as an independent brand.

The Complainant's FG Wilson-branded products are sold in many countries around the world including China. The Complainant also registered relevant trademarks based on the brand in various jurisdictions in product areas of generators, generator sets, and related spare parts. Trademarks registered in China are set out below.

Trademark	TM Number	Class	Reg. Date
	1251634	7	1999-02-28
	6258959	7	2010-02-07
	49630196	7	2021-04-14
FG Wilson	49630205	7	2021-04-14

The Complainant's "FG Wilson" brand has featured on a large number of websites and reports on the Internet (Annex 5 of the Complaint) so that it has obtained a strong reputation in the industry of power systems in China. The Panel finds that a direct relationship between the Complainant and the brand has been established among the relevant public in China. The Panel also notes that the Complainant registered the <fgwilson.com> domain name in 1996 to host its official website.

The Respondent registered the Disputed Domain Name on 15 May 2021.

4. Parties' Contentions

A. Complainant

The Complainant contends that the Disputed Domain Name is confusingly similar or identical to the Complainant's registered trademarks, the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name, and that the Disputed Domain Name was registered and is being used in bad faith.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

According to Paragraph 5(f) of the UDRP Rules, if a Respondent does not submit a response, the Panel shall decide the dispute based upon the Complaint and evidence adduced by the Complainant.

5. Findings

Paragraph 15(a) of the Rules instructs the Panel to decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

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.

A) Identical / Confusingly Similar

It is accepted that the Complainant has the right to bring this case as proved by the various trademarks incorporating the "FG Wilson" characters that it has registered in China and around the world.

In the Disputed Domain Name, ".com" may be disregarded in our analysis of similarity as it is a non-distinctive identifier of generic top level domain name (See *Tencent v. Livon Biswas & Shubhankar Ghosh*, ADNDRC/HK-2001374; WIPO Overview 3.0, section 1.11.1).

The remaining second level domain of the Disputed Domain Name is composed of "cn-" and "fgwilson". The prefix "cn" is understood as an abbreviation for China. It is a well-established law that an addition of a geographic term to a trademark does not preclude a finding of confusing similarity between a domain name and the corresponding trademark (e.g., *Hurom v. Alexander*, ADNDRC/KR-2300244; *AltaVista v. S.M.A.*, WIPO/D2000-0927; WIPO Overview 3.0, section 1.8). The prefix only creates misunderstanding among the public that the Disputed Domain Name is associated with the

Complainant's China branch. Thus, the Panel recognizes that the Disputed Domain Name is confusingly similar to the Complainant's "FG Wilson" mark.

Accordingly, the Panel finds that the Complainant has succeeded in proving the elements in Paragraph 4(a)(i) of the Policy.

B) Rights and Legitimate Interests

The Panel accepts the following facts that are provided by the Complainant and undisputed by the Respondent:

- 1) The Complainant has never authorized or licensed the Respondent or any third party to use or register the Disputed Domain Name or any domain names incorporating the Complainant's Marks.
- 2) The name of the Respondent does not correspond to "FG Wilson" at all, and the Respondent is not commonly known as "FG Wilson". An Internet keyword search using the term "MA Chao" shows results which are totally unrelated to the "FG Wilson" marks.
- 3) Online trademark searches in Mainland China reveals that the relevant owner of the trademark applications and registrations for the mark "FG Wilson" is the Complainant, while the proprietor name "MA Chao" does not reveal any trademark applications or registrations reflecting the mark "FG Wilson".
- 4) At the time of the Complaint, the domain name is inactive. No element suggests that the Respondent has made any reasonable and demonstrable preparations to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services.

Thus, the Panel finds that the Complainant made a *prima facie* case that the Respondent lacks rights and legitimate interests in the Disputed Domain Name under paragraph 4(a)(ii) of the Policy

C) Bad Faith

According to the various evidence submitted by the Complainant, the Complainant has built up goodwill and reputation in the brand over the years predating the registration of the Disputed Domain Name. The Respondent cannot have reasonably been unaware of the Complainant's mark at the time of its registration of the Disputed Domain Name.

"FG Wilson" does not correspond to the name of the Respondent. It is actually an expression not easily coinable by a person in Asia. The Respondent cannot accidentally devise this string of Western characters. In these circumstances, the passive holding of the Disputed Domain Name by the Respondent may interrupt ordinary businesses of the rightful owner of the brand, thus constituting 'use in bad faith'.

The result of domain name searches against the Respondent's name and email address also reveals that the Respondent has registered more than 400 domain names, some of which indicate a pattern of bad faith registration of domain names (See Annex 12 of the Complaint).

Accordingly, the Panel finds that the Complainant has succeeded in proving the elements in Paragraph 4(a)(iii) of the Policy.

Therefore, the Panel finds that the Complainant has proved all three elements required under Paragraph 4(a) of the Policy.

6. Decision

For the foregoing reasons, in accordance with Paragraph 4(i) of the Policy and Paragraph 15 of the Rules, the Panel orders that the Disputed Domain Name, <cn-fgwilson.com>, be transferred to the Complainant.



Chan-Mo Chung
Panelist

Dated: 23 June 2023