



Asian Domain Name Dispute Resolution Centre

hong kong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-2401929
Complainant:	Chongqing Carpenter Tan Handicrafts Co., Ltd.
Respondent:	Kent Chong
Disputed Domain Name(s):	<tanmujiang.com>

1. The Parties and Contested Domain Name

The Complainant is Chongqing Carpenter Tan Handicrafts Co., Ltd., of Workshop A Shuanghekou, Longbao, Wanzhou District, Chongqing, China.

The Respondent is Kent Chong, of 50 Mass Ave NE, 20002, Washington, DC, United States.

The Disputed Domain Name is <tanmujiang.com>, registered by Respondent with IONOS SE, of Elgendorfer Strasse 57 Montabaur, RP 56410 Germany.

2. Procedural History

The Complaint was filed with the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (the “Centre”) on 23 September 2024 in English language. The Complainant chose to have this case dealt with by a single-member panel. On 23 September 2024, the Centre transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On 24 September 2024, the Registrar transmitted by email to the Centre its verification response disclosing registrant and contact information for the Disputed Domain Name which differed from the named Respondent (REDACTED FOR PRIVACY) and contact information in the Complaint. The Centre sent a notification of deficiencies of the Complaint to the Complainant on 8 October 2024 providing the registrant and contact information disclosed by the Registrar and notifying that the Complainant had five calendar days to rectify the deficiencies. The Complainant filed an amendment to the Complaint on 9 October 2024.

The Centre verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the ADNDRC Supplemental Rules to the ICANN Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with paragraphs 2 and 4 of the Rules, the Centre formally notified the Respondent of the Complaint, and the proceedings commenced on 10 October 2024. In accordance with paragraph 5 of the Rules, the due date for Response was 30 October 2024. The Respondent did not submit any response. Accordingly, the Centre notified the Respondent's default on 31 October 2024.

The Centre appointed Yuji Yamaguchi as the sole panellist in this matter on 31 October 2024. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Centre to ensure compliance with paragraph 7 of the Rules.

3. Factual background

The Complainant was established on March 6, 1997 and created the brand name 谭木匠.

The Complainant is a company engaged in the design, manufacture and distribution of small size wooden accessories which are mainly made of natural wood and designed with traditional Chinese cultural features and with artistic qualities. The Complainant's products are mainly classified into four categories, namely wooden or horn combs such as colored drawing combs, grass-and-tree dyed wooden combs and carved combs and pocket-size wooden mirrors such as colored drawing mirrors and carved mirrors. The Complainant's products comprise other wooden accessories and adornments such as bead bracelets, pendants, barrettes, hair bobs and massage tools and box set which combine its different products featured in themes for gift purpose.

On March 7, 1998, the Complainant opened its first franchise in Nanchong, China. As of mid-April 2003, the Complainant had opened nearly 200 stores. The Complainant engages in the operation of a franchise and distribution network primarily in China and the operation of retailing shops for direct sale of its products in Hong Kong, Malaysia, Korea, Singapore, Germany, and the United States. Now there are more than 1100 offline Tan Mujiang stores around the world. The Complainant is a wholly owned subsidiary of Carpenter Tan Holdings Limited, which was listed in December 2009 on the Hong Kong Stock Exchange. The Complainant's revenue has been growing since 2009 and as of 2023, the Complainant has annual revenue of RMB 499,688,000.

The Complainant has registered the Tan Mujiang and 谭木匠 trademarks in a number of countries and regions in which the Complainant has frequent business activities. In particular, the Complainant is the owner of the following trademarks, which were registered long before the registration of the Disputed Domain Name:

- China Trademark No. 3008363 for 谭木匠, registered on 14 April 2003, designating goods and services in international classes 35.
- United States Trademark No. 5748333 for Tan Mujiang, registered on 14 May 2019, designating goods and services in international classes 20, 21, 26, 35, 40.
- European Union Trademark No. 017763913 for Tan Mujiang, registered on 31 May 2018, designating goods and services in international classes 20, 21, 26, 35, 40.

The Disputed Domain Name was registered on 3 June 2004. The Disputed Domain Name has not been used in the past 20 years and currently does not resolve to an active website.

4. Parties' Contentions

A) Complainant

The Complainant's contentions may be summarized as follows:

- i. The Disputed Domain Name completely contains the Complainant's Tan Mujiang trademark and is identical in spelling and pronunciation to the Complainant's Chinese 谭木匠 trademark. When comparing the Disputed Domain Name and the Complainant's trademark, the relevant comparison should only focus on the second-level part of the Disputed Domain Name and the Complainant's trademark. Removing the suffix ".com", the Disputed Domain Name is exactly the same as the Complainant's Tan Mujiang trademark and is identical in spelling and pronunciation to the Complainant's Chinese 谭木匠 trademark. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the trademark and the domain name to determine whether the domain name is confusingly similar to the trademark. The test involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name.
- ii. The Complainant searched various national and regional trademark databases in the name of the Respondent and did not find that the Respondent had trademark rights in the name of Tan Mujiang and 谭木匠. The factual situation is that the Respondent is not in the identity of the Complainant's distributor or partner. The Complainant has never directly or indirectly authorized the Respondent to use the Tan Mujiang trademarks and the corresponding domain names in any form.
- iii. Prior to the registration of the Disputed Domain Name on 3 June 2004, the 谭木匠 brand had already achieved a high level of popularity in China due to its extensive use and the 谭木匠 trademark itself does not correspond to any word in common use in Chinese or any other language. From the name of the Respondent, it can be seen that the Respondent may be a Chinese or a Chinese of other nationalities, which suggests that the Respondent has at least the ability to read Chinese, and then the Complainant can further infer that the Respondent has the ability, access, and motivation to learn about information from China, regardless of the location of the Respondent.
- iv. The act of "registering a domain name without using it" can itself be regarded as a kind of "passive use", which has the direct effect of preventing the Complainant from registering the same domain name with the same combination of letters. The fact that the Disputed Domain Name has been registered for more than 20 years and has not been used in the past 20 years prevented the Complainant from reflecting the trademark in the corresponding domain name.

B) Respondent

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

5. Findings

The Policy provides, at paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

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

A) Identical / Confusingly Similar

The Complainant maintains the registrations of the Tan Mujiang and 谭木匠 trademarks in China, the United States, the European Union and some other countries. Thus, the Complainant has shown the threshold requirement of having trademark rights for purposes of standing to file a UDRP case (see section 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0")).

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name (see section 1.7 of the WIPO Overview 3.0).

The Disputed Domain Name consists of the letters "tanmujiang" and the generic Top-Level Domain ("gTLD") ".com". The Panel finds that the letters "tanmujiang" is the same as the Complainant's Tan Mujiang trademark after deleting the space between the two words, and the same as direct phonetic transliteration of the Complainant's Chinese 谭木匠 trademark (see section 1.14 of the WIPO Overview 3.0; see also *La Roche-Posay Laboratoire Pharmaceutique v. Domain Whois Protection Service / sdfdsf*, WIPO Case No. D2012-1606).

The generic TLD ".com" is viewed as a standard registration requirement and as such may be disregarded for the assessment of confusing similarity under the first element in paragraph 4(a) of the Policy (see section 1.11 of the WIPO Overview 3.0).

Accordingly, the Disputed Domain Name is identical or confusingly similar to the Tan Mujiang and 谭木匠 trademarks, and then the Panel finds that the first element in paragraph 4(a) of the Policy has been established.

B) Rights and Legitimate Interests

According to the Complainant's assertion, the Respondent had no trademark rights in the name of Tan Mujiang and 谭木匠, the Respondent is not the Complainant's distributor or partner, and the Complainant has never directly or indirectly authorized the Respondent to use the Tan Mujiang trademarks and the corresponding domain names in any form.

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name and the Complainant asserted that the Respondent does not meet any of the circumstances.

Although the overall burden of proof in UDRP proceedings is on the complainant, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on the second element in paragraph 4(a) of the Policy shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element in paragraph 4(a) of the Policy. See section 2.1 of the WIPO Overview 3.0.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name such as those enumerated in the Policy or otherwise.

As a result, the Panel finds the second element in paragraph 4(a) of the Policy has been established.

C) Bad Faith

Considering the evidence submitted with the Complaint, the Panel finds that the Complainant has gained a high level of popularity and influence in Asian and European countries and the United States at the registration of the Disputed Domain Name by its actual use and promotion of Tan Mujiang and 谭木匠 trademarks for many years. In addition, the web search of “Tan Mujiang” and “谭木匠” on the major search engines shows that all the search results point to the Complainant. Therefore, when registering the Disputed Domain Name, the Respondent must have been aware of the existence of the Complainant's Tan Mujiang and 谭木匠 trademarks.

The Disputed Domain Name resolved to a page titled “THIS DOMAIN NAME HAS JUST BEEN REGISTERED FOR ONE OF OUR CUSTOMERS!” (see *NBC Universal, Inc. v. Roger Pelfrey*, WIPO Case No. D2009-1531; see also *Bayer AG v. David Le*, WIPO Case No. D2023-1162) for a long period of time, and now does not resolve to an active website. Thus, the Respondent merely passively holds the Disputed Domain Name. Even though the Respondent is not undertaking a positive action in relation to the Disputed Domain Name, in consideration of (i) the degree of distinctiveness or reputation of the Complainant's Tan Mujiang and 谭木匠 trademarks, (ii) the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the Respondent's concealing its identity (as REDACTED FOR PRIVACY), by the Registrar's privacy service, and (iv) the implausibility of any good faith use to which the Disputed Domain Name may be put, the totality of the circumstances in this case leads to the conclusion that the Respondent's passive holding amounts to bad faith (see section 3.3 of the WIPO

Overview 3.0; see also *Guangzhou Rimsea Technology Co., Ltd. v. BERAT ASLAN*, ADNDRC Case No. HK-2301790).

Thus, the Panel finds that the Respondent is also using the disputed domain name in bad faith.

Consequently, the Panel concludes that the third element in paragraph 4(a) of the Policy has been established.

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 <tanmujiang.com> be transferred to the Complainant.



Yuji Yamaguchi
Solo Panellist

Dated: 14 November 2024