



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1700973
Complainant:	Shenzhen Hongfeng Century Technology Co. Ltd.
Respondent:	深圳市威孚恒创科技有限公司 (VIOFO LTD)
Disputed Domain Name(s):	<sjcam.com>

1. The Parties and Contested Domain Name

The Complainant is Shenzhen Hongfeng Century Technology Co. Ltd., of 4/F, Building C, No. 2, Road 1, Shangxue Industrial Area, Bantian Street, Longgang District, Shenzhen, China.

The Respondent is 深圳市威孚恒创科技有限公司 (VIOFO LTD), of SHAXIA INDUSTRIAL ZONE, MINZHI ROAD, SHENZHEN CN.

The domain name at issue is [sjcam.com], registered by Respondent with FastDomain Inc., of 1958 South 950 East, Provo, UT 84606.

2. Procedural History

On 9 May 2017, the Complainant submitted a Complaint in the English language to the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (the ADNDRC) and elected this case to be dealt with by a one-person panel, in accordance with the Uniform Domain Name Dispute Resolution Policy (the Policy) approved by the Internet Corporation for Assigned Names and Numbers (ICANN), the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules), and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the ADNDRC Supplemental Rules). On 9 May 2017, the ADNDRC sent to the complainant by email an acknowledgement of the receipt of the complaint. All correspondence to and from the ADNDRC described herein was in the English language.

The ADNDRC transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On 13 May 2017, the Registrar transmitted by email to the ADNDRC its verification response. On 7 June 2017, the ADNDRC notified the Complainant of deficiencies of the Complaint. The Complainant submitted to the ADNDRC the amended Complaint.

On 12 June 2017, the ADNDRC transmitted the Complaint to the Respondent and notified

the Respondent of the commencement of the action and requested the Respondent to submit a Response within 20 calendar days. The Respondent submitted a Response on 2 July 2017. The ADNDRC transferred the Response to the Complainant.

Since both parties chose to have the case to be dealt with by a one-person panel, in accordance with the time specified in the Rules, the ADNDRC Supplemental Rules, and the Notification, the ADNDRC informed the Complainant and Respondent that the ADNDRC would appoint a one-person panel to proceed to render the decision.

Having received a Declaration of Impartiality and Independence and a Statement of Acceptance on 3 July 2017, the ADNDRC notified the parties that the Panel in this case had been selected, with Prof. ZHAO Yun acting as the sole panelist. The Panel determines that the appointment was made in accordance with Rules 6 and Articles 8 and 9 of the Supplemental Rules. On 3 July 2017, the Panel received the file from the ADNDRC and should render the Decision within 14 days, i.e. on or before 17 July 2017.

3. Factual background

For the Complainant

The Complainant in this case is Shenzhen Hongfeng Century Technology Co. Ltd., a corporation registered in Shenzhen, China. The registered address is 4/F, Building C, No. 2, Road 1, Shangxue Industrial Area, Bantian Street, Longgang District, Shenzhen, China.

For the Respondent

The Respondent, 深圳市威孚恒创科技有限公司(VIOFO LTD), is the current registrant of the disputed domain name <sjcam.com> according to the Whois information. The registered address is SHAXIA INDUSTRIAL ZONE, MINZHI ROAD, SHENZHEN CN. The authorized representative in this case is 李雅林 (Yalin Li).

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 is one of the first globally renowned Chinese manufacturers of sports action cameras (popularly known as action cams, sport DVs, or helmet cameras). Since its registration in 2010, the company has been dedicated to designing and manufacturing of multiple models of action cameras branded SJcam after the Complainant's Chinese name 世纪 (Shi Ji). The first SJCAM model of action cameras was designed in 2011 and sold worldwide under the model name SJ1000 throughout 2012 and 2013. In 2013 the company started manufacturing and sales of SJ1000 successors, SJ2000, SJ3000, and SJ4000. With the introduction of SJ4000, its most successful model, the Complainant started worldwide marketing of the SJCAM brand through its wide network or international distributors. By the end of 2015, SJCAM has become number 2 best-selling brand of action cameras in Russia and number 1 best-selling action camera in

Hungary. Today, the company continues development of new models of action cameras being present in over 100 countries, participating in world biggest exhibitions, and conducting numerous marketing activities worldwide. Some of the biggest exhibitions the company has taken part are CES (Las Vegas, USA), CEBIT (Hannover, Germany), and Global Sources (Hong Kong). The company produces over 10 models of action cameras and over 50 action camera accessories that are used worldwide and sold both in retail stores and on the world's biggest online ecommerce platforms (Amazon, eBay, Aliexpress, JD.com, Taobao, and others). In 2017, the company has launched 3 new action camera models, namely the SJ6 Legend, SJ7 Star, and SJ6 Legend Air. The company is also about to launch its first model of Car Recorder and a 360 VR camera. SJCAM brand has thousands of fans and followers worldwide, its official Facebook page has over 200 thousand followers, and the brand's official website has over 500 thousand monthly viewers.

The Complainant registered and has been using sjcamhd.com as its main domain name and the official website of the SJCAM products; furthermore, the Complainant has registered several dozen other domain names corresponding to the brand and trademark such as sjcam.mobi, sjcamzone.com, sjcamchina.cn, sjcam.co, sjcamhd.cn, sjcamzone.store, sjcamcn.com, shop-sjcam.com, sjcamhd.mobi, sjcamhd.co, sjcam.tech, sjcam.video, sjcam.link, sjcamonline.com, sjcamtech.com, sjcamhd.cc, sjcamchina.com, sjcamdirect.com, sjcamdirect.net and others. Furthermore, the Complainant has given authorization to use the brand name, the trademark, and local domain names to its multiple international distributors such as: SJCAM Spain sjcamhd.es; SJCAM India sjcamindia.com; SJCAM Poland sjcamhd.com.pl; SJCAM Russia sjcam.ru; SJCAM USA sjcam.us; SJCAM Philippines sjcamphilippines.com; SJCAM Slovakia sjcam.cz; SJCAM Romania sjcam.ro; Etc.

Furthermore, the Complainant is running multiple social media channels dedicated to the SJCAM brand such as: Facebook Official SJCAM Global pages: www.facebook.com/sjcamofficial; Twitter Official SJCAM Global page: http://twitter.com/sjcam_official.

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

After the SJ cameras have rapidly gained on popularity throughout 2012 and 2013, the Complainant has intended to register the sjcam.com domain name in late 2013. However, the Complainant came into realization the domain name had just been registered by somebody else.

The Respondent has approached the Complainant in December 2013 with the notice of having registered the sjcam.com domain name and an offer to start an online shop with SJCAM products. The registered domain name was confusingly similar to the Complainant's brand name "SJCAM", as well as its action camera models (SJ1000, SJ2000, and SJ3000) and identical to the popular name of the SJ cameras (SJcam). It is worth noticing that the domain name was registered without prior approval of the Complainant and against the Complainant's will.

However, due to the fact that at that time the Complainant was mainly focusing on wholesale distribution of its products (SJCAM cameras), the Complainant gave a temporary consent to the Respondent to distribute the SJCAM products through its website with a note that the domain name shall be immediately ceded to the Complainant. The Respondent, however, has continuously refused to cede the domain name to the Complainant. The cooperation between the Complainant and the Respondent lasted for a few months and was terminated due to negative customer service and influence the Complainant's website had on the SJCAM brand, while

pretending to be the official representative of the brand rather than just a reseller. Immediately after the Complainant ceased cooperation with the Respondent, the Complainant requested for the domain name to be ceded back to the Respondent.

Since the cooperation agreement between the Complainant and the Respondent expired, yet the Complainant had not given authorization to the Respondent to register the disputed domain name, it is evident the Respondent has no legitimate interests in respect of the disputed domain name. The Respondent is not only no longer using the domain name, but also is an owner and manufacturer of its own brand of action cameras (Gitup and Viofo, the registered trademarks)

From the very beginning of production and manufacturing of the SJ action cameras, the Complainant has been the sole and only manufacturer of the SJ action cameras marked both SJ or SJCAM, and the sole owner of the SJCAM trademark. No other company could therefore have an interest in respect of its trademark rather than for “reseller website” purposes. However, the Respondent does not possess the Complainant’s authorization to resell the SJCAM products.

Apart from the aforementioned, it is worth noticing that the Respondent has never in the past been commonly known by the disputed domain name. furthermore, the disputed domain name is currently not being used in any legitimate commercial or non-commercial way. The only visible words on the website “Hello World” are used to mislead the potential SJCAM customers and tarnish the SJCAM trademark.

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

Over the period of the last 2 years, the Respondent has not only refused to transfer the domain name rights to the Complainant, but has used the disputed domain name in bad faith which has had a very bad influence on the SJCAM brand image, namely because of the following reasons:

- The Respondent has falsely used the SJCAM domain name claiming it was the official website of the SJCAM products;
- The Respondent used the SJCAM website to sell and promote its own brand of action cameras;
- The Respondent sold SJCAM products through the disputed domain name and gave very little or no support at all, leading to negative comments about the brand on the Internet channels and continued emails to the Complainant about that case;
- The Respondent did not comply with the Complainant’s multiple requests to stop using the disputed domain name in bad faith and cede the domain to the Complainant;
- The Respondent has used content on the disputed domain name suggesting the company or brand doesn’t exist anymore.

Moreover, the Complainant has made numerous attempts to recover the disputed domain name but in every case the Respondent demanded from the Complainant unreasonable amount of money for ceding the domain name to the Complainant. That clearly proves that the Respondent had registered the domain name primarily for the purpose of profiting from such registration by later reselling the domain name to the owner of the mark, and before that to use the website to resell the SJCAM products by confusing the potential customers of the domain name being the official website of the SJCAM brand.

The sole registration of the domain name with the name that had shortly before been used by the Complainant to brand its products and without the Complainant’s prior authorization may be also seen as if it had been done in order to prevent the Complainant from reflecting the mark with the most commonly used domain name for global brands (.com).

By using the SJCAM.COM domain name and pretending to be the Official Representative of the SJCAM brand, the Respondent intentionally attempted to attract potential buyers by creating a likelihood of confusion with the Complainant's brand name.

The Complainant requests that the disputed domain name be transferred to the Complainant.

B. Respondent

The Respondent's contentions may be summarized as follows:

- i. The Complainant does not have the prior trademark rights related to the disputed domain name, and the disputed domain name will not cause confusion.

The registration time of the disputed domain name (sjcam.com) is 11 December 2013. The application time of the trademark "sjcam" is 24 March 2014, and the registration time is 7 May 2015. Obviously, the Complainant does not have the prior trademark rights related to the disputed domain name.

The Complainant registered the trademark "SJHF" which is the same with its company name on 7 September 2012. The Respondent found through a public internet search that the brand of the Complainant's products of sj1000 and other serial products is "SJHF" instead of "SJCAM". The Complainant also did not provide evidence to prove the using of the trademark "sjcam" on sport cameras before the registration date of the disputed domain name.

To sum up, the Complainant did not have the prior trademark rights related to the domain name and did not use the trademark "sjcam" on sport cameras first. So the domain name is unlikely to cause customer confusion. Therefore, the disputed domain name does not violate the rules of the UDRP paragraph 4(a)(i), and the Complainant's request should not be supported.

- ii. The Respondent has rights and legitimate interests in respect of the domain name.

The Respondent is the reseller or distributor of the Complainant and the Complainant agreed that the domain name registered by the Respondent can be used for sale of the sport cameras which the Complainant produces. The Respondent was founded in 2011 with the main business of selling all kinds of car recorders and sport cameras. The Respondent owned three domain names "viofo.com", "gitup.com" and "sjcam.com" for global sale of the brands of "viofo" car recorders, "gitup" and "sjcam" sport camera products.

The Respondent and the Complainant established a cooperative relationship in 2013 and confirmed verbally by the Complainant for selling the SJ series cameras and registering the disputed domain name by the Respondent for global sales. Because the Respondent devoted significant amount of money to the disputed domain name, the SJ series sport camera product sales were very good through the website of the disputed domain name.

In order to affirm the outstanding distribution performance of the Respondent, the Complainant issued the authorization of the core dealer to the Respondent in 2014. GOPRO, INC prosecutes the Respondent and the Complainant to the intermediate people's court of Shenzhen City as co-defendants in 2016, because of the Respondent's reselling relationships with the Complainant.

The disputed domain name on the site only sells the SJ series sport camera products which the Complainant manufactures. The screenshots of the disputed domain name and the evidence which the Complainant provided can clearly show that the Respondent actually is offering the goods or services at issue and the Respondent uses the site to sell only the trademarked goods.

The disputed domain name accurately and prominently discloses the relationships of the Respondent with the Complainant. The Respondent never tried to “corner the market” in domain names that reflect the trademark. The domain name of “sjcamhd.com” which the Complainant registered normally sells SJ series sport cameras and the maximum number of visits for the site of “sjcamhd.com” is 500 thousand people per day. At the same time, the Complainant promote through other e-commerce platforms like Taobao in the normal sales of SJ series sports cameras. The indictment in which GOPRO, INC prosecuted the Respondent and the Complainant shows the sale situation of the Complainant.

So according to the regulation of “WIPO Jurisprudential Overview 3.0” paragraph 2.8.1, the Respondent has rights and legitimate interests in respect of the disputed domain name.

At the same time, the Respondent has invested a lot of money in the disputed domain name since the disputed domain name was registered in 2013. So far, the registered users of the disputed domain name have exceeded thirty thousand, and the order has more than 14000, and the maximum number of visits of the site of the disputed domain name is 800 thousand people per day. Obviously, the disputed domain name has always been legitimately and fairly used by the Respondent and has accumulated a large number of consumers and visibility. So the Respondent has rights and legitimate interests in respect of the disputed domain name.

iii. The Respondent registered and used the disputed domain name in good faith.

As mentioned above, the Respondent is based on a distribution relationship with the Complainant and has registered the disputed domain name with the consent of the Complainant, exclusively for the global sale of the SJ series sport cameras. In the course of use, the Respondent explicitly discloses the distribution relationship with the Complainant in the website of the disputed domain name. After the distributor authorization expired, the Respondent changed the website of the disputed domain name to “Hello World” on 5 June 2017, which is earlier than the start of this administrative proceeding (12 June 2017).

At the same time, the Respondent initially disclosed a notice in the website of the disputed domain name that the distributor authorization expired, and the related products have been off the shelves from the disputed domain name; and pointed out that the Complainant registered the website of “sjcamhd.com” as official website for the production of the SJ series sports camera.

In summary, the Respondent did not register and use the disputed domain name in bad faith. Therefore, the disputed domain name does not violate the rules of the UDRP paragraph 4(a), and the Complainant’s request should not be supported.

5. Findings

On 29 June 2017, the Respondent requested to use Chinese as the language of the proceedings because both parties are Chinese companies. The Respondent at the same time requested for extension of time for submitting a Response. On the same date, the ADNDRC advised the Respondent that such requests will be considered by the Panel. On 2 July 2017, the Respondent filed an English Response within the stipulated timeframe. On 3

July 2017, the Respondent requested to file a Chinese Response.

The Respondent requested on 29 June 2017 an extension of time period for filing a Response. Since the Respondent has submitted a Response within the time limit, there is no need for extension of the time period for a Response.

Pursuant to Paragraph 11 (a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceedings shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceedings. The language of the current disputed domain name Registration Agreement is English, which should normally be the language of the proceedings.

In the present case, the Complainant submitted the Complaint in English; the Respondent chose to register the disputed domain name with the Registration Agreement in English and submitted a Response in English within the time limit. It is clear that both parties, though both Chinese companies, have no problem in reading and using English. This UDRP mechanism was designed with the aim to resolve domain name disputes in an efficient and effective manner. The decision on using the Chinese language will inevitably cause undue delay in the proceedings, which would mean that both parties will have to use extra resources in translating the current English documents. The English documents and the evidence submitted so far would not prevent the Panel from making a decision in a neutral and objective manner. Accordingly, the Panel determines English as the language of the proceedings.

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

The Complainant is a Chinese company in the field of manufacturing powers action cameras. The evidence shows that the Complainant registered the trademark "SJCAM" in China. The trademark is still within the protection period. The Panel has no problem in finding that the Complainant enjoys the trademark rights in "SJCAM". The timing of the trademark registration will only be relevant in the discussion of the third element "bad faith".

The disputed domain name is "sjcam.com" The suffix ".com" only indicates that the domain name is registered under this gTLD and is not distinctive. The main part of the disputed domain name is "sjcam", which is the same as the Complainant's trademark "SJCAM".

The Panel decides that the disputed domain name is identical or confusingly similar to the trademark "SJCAM". The Panel therefore holds that the Complaint fulfills the condition provided in Paragraph 4(a)(i) of the Policy.

B) Rights and Legitimate Interests

The Complainant contends that the Respondent does not have rights to or legitimate interests in the disputed domain name. The Complainant has never authorized the Respondent to use the trademark. The Complainant's assertion is sufficient to establish a prima facie case under Policy 4(a)(ii), thereby shifting the burden to the Respondent to present evidence of its rights or legitimate interests.

Under Paragraph 4(c) of the Policy, the following examples a Panel may take as evidence of the Respondent's rights or legitimate interests to the disputed domain name:

- (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 Complainant acknowledged that a consent, albeit temporary, was given to the Respondent to distribute the Complainant's products through the website of the disputed domain name. The evidence submitted by the Respondent shows that the Complainant authorized the Respondent to be the core strategic partner for marketing and distribution of SJCAM brand from 25 November 2014 to 25 November 2015. The evidence also shows that the Respondent made it clear in the website of the disputed domain name its role as the distributor of the Complainant's products.

The Respondent relied on the WIPO Jurisprudential Overview 3.0 to argue its rights and legitimate interests. Paragraph 2.8.1 and the WIPO Overview provides that "resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a bona fide offering of goods and services and thus have a legitimate interest in such domain name." This Overview further defines the "Oki Data test" that "the following cumulative requirements will be applied in the specific conditions of a UDRP case: (i) the respondent must actually be offering the goods or services at issue; (ii) the respondent must use the site to sell only the trademarked goods or services; (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark." However, it must be noted in Paragraph 2.8.2 of the WIPO Overview that "cases applying the Oki Data test usually involve a domain name comprising a trademark plus a descriptive term (e.g., "parts", "repairs", or "location"), whether at the second-level or the top-level. At the same time, the risk of misrepresentation has led panels to find that a respondent lacks rights or legitimate interests in cases involving a domain name identical to the complainant's trademark". Obviously, in the present case, the disputed domain name is identical to the Complainant's trademark "SJCAM", thus the Respondent cannot rely on the "Oki Data test" to argue its rights and legitimate interests under the first typical example as envisaged in Paragraph 4(c) of the Policy.

No evidence is able to show that the Respondent has been commonly known by the domain name. The number of visitors and registered users of the disputed domain name cannot directly can only shows the popularity of this domain name for its products and services, but cannot be used to prove the linkage between the Respondent and the domain name. Furthermore, the domain name is being used for commercial purposes for commercial gain. Consequently, the other two typical examples as envisaged in Paragraph 4(c) of the Policy do not exist. The act of registering the domain name does not automatically endow any legal rights or interests with the Respondent.

The Panel therefore finds that the Complaint fulfills the condition provided in Paragraph 4(a)(ii) of the Policy.

C) Bad Faith

Under Paragraph 4 (b) of the Policy, the following are relevant examples a Panel may take as evidence of registration and use 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 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 website 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 website or location or of a product or service on your website or location.

The Complainant enjoys the trademark rights in China in "SJCAM". The application date and the registration date of the trademark are 24 March 2014 and 7 May 2015 respectively. The Respondent, a distributor of car recorders and sport cameras, registered the disputed domain name on 11 December 2013, which is earlier than both the application date and the registration date of the trademark "SJCAM". Where a Respondent registers a domain name before a trademark, Panels will not normally find bad faith on the part of the Respondent. However, there are exceptions to this general proposition. In certain circumstance where the Respondent's intent in registering the domain name was to unfairly utilize on the Complainant's unregistered trademark rights, Panels have in previous cases found the existence of bad faith on the part of the Respondent. Accordingly, the Panel will continue to examine the existence of unregistered trademark rights, if any, that the Complainant may enjoyed before the registration of the disputed domain name.

In the present case, no evidence whatsoever has been submitted by the Complainant regarding the fame of the trademark "SJCAM" before the registration date of the disputed domain name (11 December 2013). On the contrary, the evidence submitted by the Respondent shows that the Complainant had been using "SJHF" for its products and services. Furthermore, the evidence submitted by the Complainant (Annex I) shows that

the Complainant “has continuously used “SJCAM” (the Mark”) throughout the world since November 2013.” It is impossible to establish common law trademark rights or unregistered trademark rights within 1 month (before the registration of the disputed domain name).

As such, the Complaint failed to establish that the disputed domain name was registered in bad faith. Accordingly, the Panel finds that the Complaint fails to satisfy the conditions provided in Paragraph 4(a)(iii) of the Policy. Since the Complainant needs to establish all three elements required under the ICANN Policy, it follows that the Complainant’s request cannot be supported in this case.

6. Decision

For the foregoing reasons, the Complaint is denied.

ZHAO Yun
Panelists

Dated: 12 July 2017