



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1701019
Complainant:	Voestalpine High Performance Metals Pacific Pte Ltd. (formerly ASSAB Pacific Pte Ltd.)
Respondent:	许文森
Disputed Domain Name(s):	<assab.xin>

1. The Parties and Contested Domain Name

The Complainant is Voestalpine High Performance Metals Pacific Pte Ltd. (formerly ASSAB Pacific Pte Ltd.), of 8 Cross Street, #27-04/05 PWC Building Singapore 048424.

The Respondent is 许文森, of 广东东莞市长安镇沙头滨河路 78 号.

The domain name at issue is assab.xin, registered by Respondent with 阿里云计算有限公司 (万网), of abuse@list.alibaba-inc.com; +86 1064242299.

2. Procedural History

On 14 September 2017, the Complainant filed a Complaint in this matter with the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (“ADNDRC-HK”). On the same day, the ADNDRC-HK confirmed receipt of the Complaint and requested the Complainant to submit the case filing fee.

On 14 September 2017, the ADNDRC-HK notified 阿里云计算有限公司 (万网) (“Registrar”) of the Disputed Domain Name of the proceedings by email.

On 14 September 2017, the Registrar acknowledged the email of ADNDRC-HK confirming that the Disputed Domain Name is registered with the Registrar, that 许文森 is the holder of the Disputed Domain Name, that the Internet Corporation for Assigned Names and Numbers Uniform Domain Name Dispute Resolution Policy (“the Policy”) is applicable to the Disputed Domain Name, the language of the Disputed Domain Name is Chinese as provided by the WHOIS information in relation to the Disputed Domain Name and confirmed that the Disputed Domain Name is under Registrar lock status.

On 27 September 2017, the ADNDRC-HK sent a Written Notice of Complaint (“Notification”), together with the Complaint, to the email address of the Respondent’s

nominated registrant contact for the Disputed Domain Name (as recorded in the WHOIS database). The Notification gave the respondent twenty (20) calendar days to file a Response (i.e. on or before 17 October 2017).

The Panel comprising of Dr. Shahla F. Ali as a single panelist was appointed by the ADRDRC-HK on 31 October 2017. The papers pertaining to the case were delivered to the Panel by email on the same day.

3. Factual background

The Complainant, Voestalpine High Performance Metals Pacific Pte Ltd. (formerly ASSAB Pacific Pte Ltd.) contends that it was established in 1945 to market high quality tool steel from Sweden and has been renowned for its quality standards. With its headquarters in Singapore, the Complainant claims that it operates around 50 offices in the Asia Pacific supplying the steel, metallurgical tooling services and technical knowhow. It further claims that, through anchoring the distribution network for Uddeholm, a well known tool steel company, they together service leading multinational companies across practically all key industrial sectors in more than 90 countries.

The Complainant claims that in the Greater China region, ASSAB is called Yi Sheng Bai (一胜百) which means “One beats One Hundred” highlighting its position as an industry leader. It claims that ASSAB’s history in China dates back more than 60 years, and its tool steel has been distributed in Southern China from the mid 1950s. Furthermore, the Complainant claims that it established its first wholly owned outlet in Shenzhen in the early 1990s; and since then it has grown to be the leading foreign distributor of quality tool steel and services in China, with more than 500 employees in 22 locations and 18 affiliates across China.

In addition, the Complainant claims that it owns trademark registrations for the “ASSAB” trademark and other related trademarks (“ASSAB trademarks”) in various jurisdictions worldwide. Among the ASSAB trademarks, the Complainant registered its “ASSAB” mark in class 6 in Hong Kong in July 13, 1957 under No. 19570513. It also owns many ASSAB trademarks in Mainland China, such as No. 1055408 “一勝百 ASSAB” in class 6 registered on July 14, 1997.

The Respondent, 许文森 (Xu Wen Sen), of Guangdong Province, registered the disputed domain name on 16 September 2015. The Respondent did not file a Reply with the Centre.

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 claims that it owns prior trademark rights in the “ASSAB” trademark in various jurisdictions worldwide. For instance, it obtained its

registration for the “ASSAB” trademark in class 6 in Hong Kong (Reg. No. 19570513) on July 13, 1957, long before the registration date of the Disputed Domain Name.

The Complainant claims that the Disputed Domain Name < assab.xin > contains two elements, “assab” and top-level domain “xin”. Since the top-level “.xin” does not have trademark significance as established by many UDRP precedents, it confers no distinctiveness to the domain name sufficient to avoid user confusion. The only distinctive part of the Disputed Domain Name should be considered to be “assab”, which is identical to the Complainant’s “ASSAB” trademark. Thus, the Complainant contends that the Disputed Domain Name contains its “ASSAB” trademark as well as its trade name in its entirety, and such resemblance will no doubt mislead consumers into believing that the website is operated by or associated with the Complainant.

In addition, the Complainant contends that it maintains a significant presence in Guangdong, China and has participated in several trade fairs and exhibitions in the area. The disputed domain name <assab.xin> resolves to a website operated under the name of a PRC company called 广东一胜百模具技术有限公司 (Guangdong Yi Sheng Bai Mould Technology Co., Ltd.) and therefore consumers may be led to believe that it is an entity or subsidiary affiliated with the Complainant.

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

The Complainant claims that the Disputed Domain Name was registered by the Respondent on September 16, 2015 long after most application and registration dates of its ASSAB trademarks. It contends that its ASSAB trademarks have acquired significant recognition worldwide after years of extensive use. The Complainant claims that it has no prior connection with the Respondent, nor has it authorized the Respondent to use its mark in the Disputed Domain Name. Since the mark ASSAB is not a commonly used English term and there is no evidence showing that the Respondent has been commonly known by the Disputed Domain Name, the Complainant considers that it indicates the Respondent’s deliberate attempt to take advantage of the “ASSAB” mark for commercial gain.

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

The Complainant claims that the bad faith can be shown based on the following grounds: 1) the long history and high degree of fame enjoyed by the Complainant and its trademarks in the world, including in East Asia and China; 2) the filing dates of the Complainant’s marks long before the registration date of the Disputed Domain Name; 3) the incorporation of the Complainant’s well known trademark in its entirety in the Disputed Domain Name; 4) the striking similarity of the Complainant’s and the Respondent’s websites and images; 5) the numerous instances of registration of other domains with the Complainant’s trademark ; and 6) the use of the Complainant’s Chinese mark “一胜百 (ASSAB in Chinese)” in the Respondent’s Chinese company name.

B. Respondent

The Respondent's contentions may be summarized as follows:

The Respondent did not submit a reply.

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 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.

Language of Proceedings

The Panel notes that the Claimant requested that the language of proceedings be in English for reasons of convenience. While the Panel observes that the language of the registration agreement is in Chinese, in accordance with the Rules of UDRP, the Panel has the authority to determine otherwise, having regard to the circumstances of the proceedings.

As is stated in a previous case, when deciding "whether to allow the proceedings to be conducted in a language other than the language of the Registration Agreement, and to require the Complainant in an appropriate case to translate the Complaint into the language of that agreement, the Panel must have regard to all 'the relevant circumstances'". And such circumstances include "whether the Respondent is able to understand and effectively communicate in the language in which the Complaint has been made and would suffer no real prejudice, and whether the expenses of requiring translation and the delay in the proceedings can be avoided without at the same time causing injustice to the parties" - See WIPO Case SWX Swiss Exchange v. SWX Financial LTD, D2008-0400. Having reviewed the Complainant's submission, and given that the Respondent issued no objection, the Panel thus determines that the language of the proceedings is English.

A) Identical / Confusingly Similar

The Complainant has established its right to the "ASSAB" trademarks by submitting trademark registration certificates and records in a number of jurisdictions including in Hong Kong and Mainland China. The disputed domain name <assab.xin> contains two elements: "assab" and top-level domain "xin". Numerous UDRP precedents have established that the top-level domain does not have trademark significance, conferring no distinctiveness to the domain name sufficient to avoid user confusion. The only distinctive part of the disputed domain should be "assab", which is identical to the Complainant's "ASSAB" trademark and trade name. This striking resemblance will no doubt mislead consumers into believing that the website is operated by or associated with the Complainant. There is no doubt that the Disputed Domain Name < assab.xin > completely incorporates the Complainant's "ASSAB" trademark which is the distinctive part of the Disputed Domain Name, and such incorporation makes the Disputed Domain Name confusingly similar with the Complainant's trademark.

In conclusion, the Panel finds that the Complainant has satisfied the Paragraph 4(a)(i).

B) Rights and Legitimate Interests

As the owner of the “ASSAB” trademarks, the Complainant has confirmed that it has no prior connection with the Respondent in any way, nor has it authorized the Respondent to use its trademarks in the Disputed Domain Name.

In determining whether the Respondent has any legal right and interest in the Disputed Domain Name, the mere registration of the Disputed Domain Name by the Respondent itself is not sufficient to prove that it owns legal rights and interests thereof; otherwise, “all registrants would have such rights or interests, and no complainant could succeed on a claim of abusive registration” - See: Adobe Systems Incorporated v. Domain OZ, WIPO Case No.: D2000-0057.

In the present case, the Respondent failed to provide evidence indicating that it has been commonly known by the Disputed Domain Name, nor has been making a legitimate noncommercial or fair use thereof. On the contrary, the Complainant has pointed out with screenshots of the Disputed Domain Name website that the Disputed Domain Name resolves to a website that contains the term, “Yi Sheng Bai (一胜百)” which is the same as the Chinese trade name and Chinese trademark of the Complainant. Such a high degree of similarity between the two will lead to confusion as to the identity of the operator of the Disputed Domain Name. It is well established that using a Disputed Domain Name to attract visitors to a website with misleading and potential infringing content does not constitute a “bona fide offering of goods or services”.

In conclusion, the Panel finds that the Complainant has satisfied the Paragraph 4(a)(ii).

C) Bad Faith

In determining whether the Respondent has registered or used the Disputed Domain Name in bad faith, paragraph 4(b) of the Policy sets down four (4) factors which the Panel will need to examine. The four (4) factors are as follows:

“Evidence of Registration and Use in Bad Faith. For the purposes of Paragraph 4(a)(iii), the 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 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 Respondent, domiciled in the PRC, must have been aware of the Complainant's prior rights and interest in the Disputed Domain Name given the Complainant's reputation in the mark “ASSAB” and “Yi Sheng Bai (一胜百)” internationally and within China as of the date that the Respondent registered the Disputed Domain Name.

According to the Claimant, the fact that the website features the name “Yi Sheng Bai (一胜百)” in relation to a website bearing the Complainant's registered trademarks, makes it clear that the Respondent knew of the Complainant's trademark and registered the Disputed Domain Name in an attempt to attract internet traffic to the website on the mistaken belief that it is associated with the Complainant's business.

No evidence has been provided showing that the Respondent sought the permission of the Claimant to use its mark, nor any evidence showing that the Claimant gave such permission to the respondent.

Given the above findings, the Panel is of the view that the Respondent registered and used the contested domain name in bad faith.

6. Decision

Pursuant to Paragraph 4(i) of the Policy and Article 15 of the Rules, the Panel orders that the disputed domain name < assab.xin > be transferred to the Complainant.

/s/ Shahla F. Ali

Dr. Shahla F. Ali
Panelist

Dated: 13 November 2017