



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1600892
Complainant:	ASSAB Pacific Pte. Ltd.
Respondent:	Zhang Qiang
Disputed Domain Name(s):	< assab-gd.net >

1. The Parties and Contested Domain Name

The Complainant is ASSAB Pacific Pte. Ltd., of 8 Cross Street, #27-04/05 PWC Building Singapore 048424.

The Respondent is Zhang Qiang, of Beijing, 100000 China.

The domain name at issue is < assab-gd.net >, registered by Respondent with GoDaddy.com, LLC, of 14455 N Hayden Rd Ste 226, Scottsdale AZ 85260.

2. Procedural History

The Complaint was filed with the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (the “Centre”) on August 29, 2016 and the Complainant chose a sole panelist to review this case in accordance with the Uniform Domain Name Dispute Resolution Policy (“the Policy”) which was adopted by the ICANN and came into effect on October 24, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”) which became effective on September 28, 2013 and the Supplemental Rules thereof which came into effect on July 31, 2015.

On August 30, 2016, the Centre confirmed the receipt of the Complaint and Annexures thereof, and transmitted by email to GoDaddy.com, LLC (the Registrar of the domain name) a request for Registrar verification in connection with the domain name at issue. On the same day, the Registrar made the verification to the Centre, and pointed out that the language used in the Registration Agreement is English. On September 5, 2016, the Centre confirmed the receipt of the case filing fee from the Complainant.

On September 6, 2016, the Centre sent the formal Complaint Notice to the Respondent and requested the Respondent to reply within 20 days (on or prior to September 26, 2016) in accordance with the Rules and Supplement Rules, and forwarded the Complaint as well as all the Annexures thereof. The procedures for this case formally commenced on September 6, 2016.

On September 27, 2016, the Centre issued a Default Notice and confirmed that the Respondent did not file a formal Reply with the Centre, within the required time limit for filing a Reply.

On September 28, 2016, the Centre sent a Notice of Panelist Appointment to Mr. Matthew Murphy as Panel candidate for the current case, and the Panel candidate considered that it was properly constituted and submitted the acceptance notice as well as a statement of impartiality and independence. On September 29, 2016, the Centre notified both parties and the Panelist Mr. Matthew Murphy by email that Mr. Matthew Murphy be the sole panelist for arbitrating this case. The Centre then formally transferred the case to the Panelist. The Panelist agreed to deliver his decision with respect to the Disputed Domain Name on or prior to October 13, 2016.

3. Factual background

For the Complainant

The Complainant, ASSAB Pacific Pte. Ltd., claims that, it was formed in 1945 to market high quality tool steel from Sweden and is renowned for its quality standards. With its headquarters in Singapore, the Complainant claims that it operates around 50 offices in the Asia Pacific region supplying the steel, metallurgical tooling services and technical knowhow. It further claims that through anchoring the distribution network for Uddeholm, a large tool steeling 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, it is called Yi Sheng Bai (一胜百) which means “One beats One Hundred” and underlines its position as an industry leader. It claims that its history in China can be dated back more than 60 years, and its tool steel were distributed in Southern China in the mid 1950s. Furthermore, the Complainant claims that it established its first wholly owned outlet in Shenzhen in early 1990s; and since then it has grown to be the leading foreign distributor of quality tool steels 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 trademark”) 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 Trademark Registration No. 19570513. It also owns many ASSAB trademark registrations in Mainland China, such as No. 1055408 for the “一勝百 ASSAB” mark in class 6, being registered on July 14, 1997.

For the Respondent

The Respondent, Zhang Qiang, is an individual allegedly domiciled in Beijing, China, at postcode area 100000. The Respondent registered the Disputed Domain Name on October 28, 2015. The Respondent did not file any Reply or other materials 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-gd.net > contains two elements, "assab-gd" and top-level domain ".net". Since the top-level ".net" does not have trademark significance and the "gd" can be used as abbreviation of "Guangdong", which is a province of China, it cannot be recognized as distinctive. The only distinctive part of the Disputed Domain Name should 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.

- 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 long after most application and registration dates of its various ASSAB trademark registrations. 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 ever authorized the Respondent to use its trademark 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 sufficient grounds as followings: 1) the long history and high degree of fame enjoyed by the Complainant and its trademarks in the world, including in 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 famous trademark in its entirety in the Disputed Domain Name; and 4) the Respondent's website with pornographic materials will cause damage to the brand image and reputation of the Complainant. The Complainant also mentions that in a recent UDRP case decided by another Panelist, a disputed domain name

<china-assab.com> which is similar to the Disputed Domain Name herein, was transferred to the Complainant.

B. Respondent

The Respondent did not submit any 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.

A) Identical / Confusingly Similar

The Complainant has established its right to the "ASSAB" trademark by submitting trademark registration certificates and records for various jurisdictions, such as Hong Kong, Mainland China and others.

There is no doubt that the Disputed Domain Name < assab-gd.net > completely incorporates the Complainant's "ASSAB" trademark which is the only distinctive part of the Disputed Domain Name, and such incorporation makes the Disputed Domain Name confusingly similar with the Complainant's trademark. With respect to the letters "gd", it is accepted that it may refer to the abbreviation of "Guangdong", a province in China, which will not reduce the confusing similarity between the Dispute Domain Name and the "ASSAB" trademark to any significance. Even if it cannot be inferred as the abbreviation of "Guangdong", considering the great fame possessed by the Complainant's "ASSAB" trademark, the addition of these two letters will not alleviate confusion to any significant extent.

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

B) Rights and Legitimate Interests

As the rights owner of the "ASSAB" trademark, 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 trademark in the Disputed Domain Name, or in any way.

When it comes to determine whether the Respondent has any legal right and interest to the Disputed Domain Name or not, the mere registration of the Disputed Domain Name by the Respondent itself is not sufficient to prove that it owns legal rights and interests therein; 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.*

The Panel notes that the Respondent failed to prove and there is no evidence indicating that it has been commonly known by the Disputed Domain Name, nor has it been making a legitimate noncommercial or fair use thereof. On the contrary, the Complainant pointed out with screenshots of the Disputed Domain Name website that, the Disputed Domain Name has been resolving to a pornography website. Obviously, using the Disputed Domain Name to link to a pornography website does not count for “bona fide offering of goods or services”. Not to mention, such use can clearly and obviously be considered as indication of bad faith use.

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

C) Bad Faith

In considering this issue, the following issues are taken into account:

- (1) the registration date of the Complainant’s trademark is much earlier than that of the first registration date of the Disputed Domain Name;
- (2) the fame of the Complainant and its “ASSAB” trademark, that has accumulated in the steel industry;
- (3) the similarity between the Disputed Domain Name and the Complainant’s trademark;
- (4) the way the Disputed Domain Name was used, which was resolve to a pornography website.

Accordingly, it is reasonable for the Panel to infer that the Respondent must have been aware of the Complainant and its “ASSAB” trademark whilst registering the Disputed Domain Name based on the issues given above. Such registration with prior knowledge of the Complainant’s trademark, indicates bad faith registration.

Moreover, as stated in a previous UDRP decision, “while many adult sex sites are perfectly legal and constitute bona fide offerings of goods or services, the use of somebody else’s trademark as a domain name (or even as a meta-tag) clearly does not constitute a “bona fide” offering of goods or services when the web site owner has no registered or common law rights to the mark, since the only reason to use the trademark as a domain name or meta-tag is to attract customers who were not looking for an adult sex site, but were instead looking for the products or services associated with the trademark. Such use of a trademark can create customer confusion or dilution of the mark, which is precisely what trademark laws are meant to prevent. And actions that create, or tend to create, violations of the law can hardly be considered to be “bona fide””. *See: Motorola, Inc. vs NewGate Internet, Inc., WIPO Case No.: D 2000-0079.* Thus, the Panel concludes that the Disputed Domain Name has been used in bad faith as well.

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

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-gd.net > be transferred to the Complainant.

Matthew Murphy
Sole Panelist

Dated: October 12, 2016