



**(Hong Kong Office)**

**ADMINISTRATIVE PANEL DECISION**

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<b>Case No.</b>	HK-1600872
<b>Complainant:</b>	ASSAB Pacific Pte. Ltd.
<b>Respondent:</b>	San Ming
<b>Disputed Domain Name(s):</b>	<china-assab.com>

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**1. The Parties and Contested Domain Name**

The Complainant is ASSAB Pacific Pte. Ltd., of 8 Cross Street, #27-04/05 PWC Building, 048424 Singapore. The authorized representative of the complainant is Baker & McKenzie, of 14th Floor, Hutchison House, 10 Harcourt Road, Hong Kong.

The Respondent is San Ming, Changan, Donnuan, Guangdong Province, China.

The domain name at issue is <china-assab.com>, registered by Respondent with NameSilo LLC, of 1300 E. Missouri Avenue Suite A-110 Phoenix, Arizona 85014, USA.

**2. Procedural History**

On May 25, 2016, the Complainant submitted the Complaint in English on domain name <china-assab.com> to the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (the "Centre"), in accordance with the Uniform Domain Name Dispute Resolution Policy (the "Policy") adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy Disputes (the "Rules") approved by ICANN on October 24, 1999, and the Asian Domain Name Dispute Resolution Centre Supplemental Rules in effect as of February 28, 2002. The Complainant requested a single person panel.

After receiving the Complaint, the Centre, in accordance with the Supplemental Rules, verified that the Complaint complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on May 26, 2016, the Centre requested the Registrar to confirm: (1) that the disputed domain name was registered with the Registrar, (2) whether the Respondent is the registrant or holder of the name, and (3) whether the Policy applies to the name; and to specify: (4) the language of the Registration Agreement of the disputed domain name, (5) WhoIs information for the disputed domain name, and (6) the current status of the domain name. Also, by email message dated May 26, 2016, the Center confirmed the receipt of the Complaint, together with Annexures I to VII.

On May 27, 2016, the Registrar provided its response to the Centre through which it (1) specified that the registrant is San Ming. In addition, the Centre confirmed that: (2) the name was registered with NameSilo LLC, and (3) the Policy applies to the name. The Registrar also stated that (4) the registration agreement is in the English language, (5) provided name and contact information pertinent to the name as reflected in its WhoIs database, and stated that (6) the domain name was locked and would remain locked during the pending administrative proceeding. As requested by paragraph 4 (b) of the Rules, the Centre asked the Complainant to revise the Complaint Form with regard to the details of the Registrant on or before 4 June 2016, failing which the Complaint will be deemed withdrawn without prejudice to submission of a different complaint by the Complainant.

On June 3, 2016, the Complainant submitted a revised Complainant to the Centre, within the required period of time, with regard to the registrant details only.

On June 6, 2016, the Centre sent the Complaint to the Respondent. The Respondent was then provided with a 20 calendar day period, expiring on June 26, 2016, to file its Response both with the Centre and the Complainant. As of June 26, 2016, the Respondent had not filed any Response with the Centre. Accordingly, on June 29, 2016, the Centre advised the parties by email that the Respondent had not filed any Response to the Complaint with the Centre on or before the deadline and, as such, the Centre would then proceed to appoint a Panelist for this matter.

Pursuant to the Rules and Supplemental Rules, the Centre, by email dated June 29, 2016, contacted the undersigned, Prof. Dr. Julien Chaisse, requesting his service as a Sole Panelist for this dispute. Subsequently, on the same day, Prof. Chaisse responded and affirmed his ability to act completely independently and impartially in this matter. Subsequently, the Centre, through an email dated June 29, 2016, notified the Parties of the appointment of Prof. Chaisse as the Sole Panelist. The Panel finds that the Administrative Panel was properly constituted and appointed in accordance with the Rules and the Supplemental Rules. Based on the deadline set forth in paragraph 15 of the Rules, a decision was to be issued by the Panel to the Center on or before July 13, 2016.

### **3. Factual background**

**The Complainant:** ASSAB Pacific Pte. Ltd. ('ASSAB')

#### **A. The Complainant's ASSAB's Marks**

The Complainant, ASSAB Pacific Pte. Ltd., currently holds trademark registrations for the "ASSAB" trademark and other related trademarks ("ASSAB Marks") in various jurisdictions worldwide, including Hong Kong, Taiwan, and China. The Complainant provided in Annexure II to the Complaint, the lists of the registered trademarks on which the Complainant relies, together with the copies of the registration certificates. Some of the Complainant's registered "ASSAB Marks" are listed below.

Hong Kong

<u>Mark</u>	<u>Class</u>	<u>Registration Number</u>	<u>Registration Date</u>	<u>Specification of Goods/ Services</u>
<b>A S S A B</b>	6	19570513	July 31, 1957	All kinds of iron, steel bars, strips, tubular products, sheets, wires and tool bits.
ASSAB 一勝百	6	199609203	October 4, 1996	Iron, steel bars, and strips, tubes, sheets, wires; all included in Class 6
ASSAB SuperClean	6	302784754	July 31, 2014	Molds, mold lumps, mold seats, steel, high speed steels, tool steels, moulded steels, hard alloys, stainless steels, high tensile steels, steel tubes, steel wires, hot rolled steel plates, cold rolled steel sheets, cold rolled strip and valve steels; processed or semi-processed steels, irons, cast irons and common metals; alloys; beryllium copper and carbide alloy; common metals and their alloys; metal building materials; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; goods of common metal not included in other classes; ores; all included in class 6.

Taiwan

<u>Mark</u>	<u>Class</u>	<u>Registration Number</u>	<u>Registration Date</u>	<u>Specification of Goods/ Services</u>
ASSAB	6	1080356	January 16, 2004	Molds, mold lumps, mold seats, steels, high speed steels, tool steels, molded steels, hard alloys, stainless steels, high tensile steels, steel tubes, steel wires hot rolled steel plates, cold rolled sheets, cold rolled strip steel & valve steels. Processed or semi processed steels, iron, cast irons. & common metals; alloys; beryllium copper & carbide alloy.

China

<u>Mark</u>	<u>Class</u>	<u>Registration Number</u>	<u>Registration Date</u>	<u>Specification of Goods/ Services</u>
ASSAB 718	6	5711810	August 7, 2009	Common metal, unwrought or semi wrought; common metal alloys; bar of metal; sheets of metal; plates of metal; steel alloys; steel sheets; steel strip; steel forged, rolled or cast; strip steel.
ASSAB S-136	6	5711811	August 7, 2009	Common metal, unwrought or semi wrought; common metal alloys; bar of metal; sheets of metal; plates of metal; steel alloys; steel sheets; steel strip; steel forged, rolled or cast; strip steel.
ASSAB SuperClean	6	13443130	January 21, 2015	Metallurgical powder; steel sheets; hoop steel; steel alloys; nickel-silver; cast steel; steel, unwrought or semi-wrought; aluminium; steel wire; steel hoop strip.
ASSAB 618	6	5711809	August 7, 2009	Common metal, unwrought or semi wrought; common metal alloys; bar of metal; sheets of metal; plates of metal; steel alloys; steel sheets; steel strip; steel forged, rolled or cast;

ASSAB XW-42	6	5711812	August 7, 2009	Common metal, unwrought or semi wrought; common metal alloys; bar of metal; sheets of metal; plates of metal; steel alloys; steel sheets; steel strip; steel forged, rolled or cast; strip steel.
一勝百 ASSAB	6	1055408	July 14, 1997	Steel bars; steel sheets; iron; metal wire and ironmongery; metal plate; steel pipe products.
ASSAB	6	13443140	February 28, 2015	Steel, unwrought or semi-wrought; synthetic steel; hoop steel; steel sheets; steel masts; cast steel; aluminium; nickel-silver; blooms [metallurgy]; sheets and plates of metal; aluminium foil; chromium; alloys of common metal; cast iron, unwrought or semi-wrought; hoop iron; iron, unwrought or semi-wrought; copper, unwrought or semi-wrought; iron slabs; chrome iron; metallurgical powder; beryllium [glucinium]; common metals, unwrought or semi-wrought; laths of metal; steel pipes; pipes of metal; platforms, prefabricated, of metal; sheet steel form; fittings of metal for building; railway material of metal; steel hoop strip; steel wire; wire of common metal alloys, except fuse wire; aluminium wire; bolts of metal; foundry molds [moulds] of metal; signalling panels, non-luminous and non-mechanical, of metal; rods of metal for brazing and welding.

<b>ASSAB</b>	8	13443138	January 21, 2015	Knife steels; handsaws [hand tools]; milling cutters [hand tools]; milling cutter strips [part of hand tools]; fire irons; pin punches; scrapers [hand tools]; steel knives.
<b>ASSAB</b>	40	13443137	January 21, 2015	Grind processing; burnishing by abrasion; soldering; chromium plating; metal treating; nickel plating; metal casting; metal forging; metal plating; electroplating; sawing [saw mill].

#### B. The Complainant and its activities

The Complainant is a company that offers a wide range of products such as machinery steels, wear plates, high speed steel, tool steel for plastic molding, and other steel products for engineering components.

As provided in Annexure III by the Complainant, ASSAB was formed in 1945 to market high quality tool steel from Sweden, renowned for its quality standards. Headquartered in Singapore, ASSAB operates close to 50 ASSAB sales offices in Asia Pacific supplying the best steel available in the market.

Furthermore, ASSAB's presence in China dates back more than 60 years. In the mid 1950s, ASSAB tool steels were distributed in southern China. In the early 1990s, ASSAB established its first ASSAB owned outlet in Shenzhen. Since the start, ASSAB has grown to be the leading foreign distributor of quality tool steels and services in China. Today, ASSAB has more than 500 employees in 22 locations across the mainland and continue to expand our network of services in tandem with the growing needs and precision requirements of the manufacturing industry in China. There are 18 affiliates in Beijing, Changchun, Changzhou, Chongqing, Dalian, Dongguan, Guangzhou, Hong Kong, Hunan, Ningbo, Qingdao, Shanghai, Suzhou, Tianjin, Wuhan, Xiamen, Xi'an, Yantai

#### The Respondent

As indicated in the WhoIs registration record provided in Annexure I to the Complaint, the Respondent registered the disputed domain name on May 27, 2012. Since May 27, 2016, the Disputed Domain Name has been locked by the Registrar and is currently inactive. The Centre confirmed that documents have been sent to the Respondent's address as registered with the registrar NameSilo LLC. However, the Centre did not receive a Response Form R from the Respondent for the Domain Name Dispute concerning Domain Name <china-assab.com>.

#### 4. Parties' Contentions

## A. Complainant

The Complainant's contentions may be summarized as follows:

### i. Identical or Confusingly Similar

The Complainant submits that the Disputed Domain Name is identical or confusingly similar to marks in which the Complainant has rights on the basis of its ASSAB trade mark registrations. The Disputed Domain Name and the Complainant's registered ASSAB trade mark are identical.

The Complainant accordingly submits that it has proved that the Disputed Domain Name is identical and/or confusingly similar to its registered trade marks in which the Complainant has rights or interests for the purposes of paragraph 4(a)(i) of the Policy.

### ii. Rights or Legitimate Interests

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraphs 4(a) (ii) and particular 4(c) of the Policy.

In particular, the Respondent registered the disputed domain name on May 27, 2012, long after most of the application and registration dates of the Complainant's "ASSAB Marks".

The Complainant accordingly submits that it has proved that the Respondent has no right or legitimate interest in respect of any of the Disputed Domain Name for the purposes of Article 4(a)(ii) of the Policy.

### iii. Registered and Used in Bad Faith

The Complainant contends that the Respondent registered and is now using the disputed domain name in bad faith under paragraph 4(a)(iii) of the Policy. According to the Complainant, there are seven grounds for an inference of bad faith based on the following:

- 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;
- 4) The various additional infringing domain names associated with the Respondent targeting the Complainant's ASSAB trademark;
- 5) The striking similarity of the Complainant's and the Respondent's websites;
- 6) The false and misleading claims regarding its history on the website; and
- 7) The use of the Complainant's Chinese mark "—fit (ASSAB in Chinese)" in its Chinese company name.

The Complainant accordingly submits that it has proved that the Respondent has registered and used the Disputed Domain Name in bad faith for the purposes of Article 4(a)(iii) of the Policy.

## B. Respondent

The Centre did not receive a Response Form R from the Respondent for the Domain Name Dispute concerning Domain Name <china-assab.com>. The Respondent is in default.

## 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.

### i) Identical / Confusingly Similar

This element of the Policy requires the Complainant to prove that it has rights in a trademark or service mark, and that the Disputed Domain Name is identical to or confusingly similar to such trademark or service mark.

The Complainant demonstrated that it owns trademark registrations for the "ASSAB Marks" in various jurisdictions. Details of the Complainant's trademark registrations for the "ASSAB Marks" have been provided in Annexure II. As listed above, among all other registrations, the Complainant obtained its registration for the "ASSAB" trademark in Class 6 (Reg. No. 19570513) in Hong Kong in as early as 1957, long before the Respondent applied to register the disputed domain name on May 27, 2012. Therefore, the Complainant owns prior trademark rights in the "ASSAB" trademark.

The disputed domain name <china-assab.com> contains two elements: "china-assab" and top-level domain ".com". Numerous UDRP precedents have established that the top-level domain ".com" does not have trademark significance, conferring no distinctiveness to the domain name sufficient to avoid user confusion. The distinctive portion of the disputed domain name is therefore "china-assab". As "china" is the name of country, it cannot be recognized distinctive. Thus, the only distinctive part of the disputed domain should be "assab", which is identical to the Complainant's "ASSAB" trademark.

The disputed domain name <china-assab.com> contains the Complainant's "ASSAB" trademark and the Complainant's trade name in its entirety. This striking resemblance will mislead consumers into believing that the website is operated by or associated with the Complainant.

The Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

### ii) Rights and Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which, under the circumstances here, would legitimize a claim to the disputed domain name under paragraph 4(c) of the Policy.

After years of extensive use, the ASSAB mark has acquired significant recognition worldwide. The Complainant and the Respondent have no prior connection, and the latter has not been authorized by the former to use its mark in the disputed domain name. Additionally, the mark ASSAB is not a term commonly used in the English language. There is also no evidence that the Respondent has been commonly known by the disputed domain. It is therefore impossible to conceive of a circumstance in which the Respondent would use the disputed domain name, except in a deliberate attempt to take advantage of the "ASSAB" mark for commercial gain.

In addition, the Disputed Domain Name is not as at the date of this Complaint being used, nor to the Complainant's knowledge has it ever been used, in connection with any *bona fide* offering of goods or services within the meaning of paragraph 4(c)(i) of the Policy. As stated in *Madonna Ciccone v. Dan Parisi*, WIPO Case No. D2000-0847 (October 16, 2000), "use which intentionally trades on the fame of another cannot constitute a 'bona fide' offering of goods or services [...] to conclude otherwise would mean that a Respondent could rely on intentional infringement to demonstrate a legitimate interest, an interpretation which is obviously contrary to the intent of the Policy." Here, the Disputed Domain Name is "parked" (i.e. the parked domain name means that visitors see a temporary Web page when they enter the domain name in their browser) with the registrar of the Disputed Domain Name and the webpage to which the Disputed Domain Name is pointed invites offers for the purchase of the Disputed Domain Name.

The Panel infers from the above that the Respondent is not using the name on either a non-commercial or fair use basis without intent to misleadingly divert consumers or tarnish any of the Complainant's marks, or, prior to receiving notice of this dispute, in connection with any bona fide offering of goods or services or demonstrable preparations for making such an offering, thus failing to qualify under either of paragraphs 4(c)(i) and 4(c)(iii) of the Policy.

Accordingly, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain name within paragraph 4(a) (ii) and 4(c) of the Policy.

### **iii) Bad Faith**

In accordance with Paragraph 4(a)(iii) of the Policy the Complainant must prove that the Domain Name has been registered and is being used in bad faith.

The requirement of bad faith is distinct from the requirement that the Respondent lacks any right or legitimate interests in the disputed domain name. As expressed by another panel, something more is required because the Policy is not only designed to combat trademark infringement on the Internet or even questionable cases of cybersquatting, but rather abusive, bad faith cybersquatting (*Edward Van Halen v. Deborah Morgan*, WIPO Case No D2000-1313).

Paragraph 4(b) of the Policy sets forth four criteria that are to be considered as 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 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."

As mentioned above, the Complainant obtained its registration for the "ASSAB" trademark in Class 6 (Reg. No. 19570513) in Hong Kong in as early as 1957. Subsequently, the Complainant has obtained registrations for its "ASSAB Marks" in various jurisdictions. The Complainant's "ASSAB Marks" had become widely known among consumers and relevant public as a result of its long-term promotion and use. The Respondent must have prior knowledge of the Complainant's "ASSAB Marks" before the registration of the disputed domain name on May 27, 2012.

The disputed domain name <china-assab.com> resolves to a website that is strikingly similar to Complainant's websites "[www.assab.com](http://www.assab.com)" and "[www.assab-china.com](http://www.assab-china.com)". The design and layout were apparently copied from that of the Complainant's websites, indicating a clear bad faith attempt to mimic the look and feel of the Complainant's websites and to confuse and deceive consumers.

The disputed domain name <china-assab.com> resolves to website operated under the name of a PRC company called ASSAB Tooling (Dongguan) Co., Ltd. ("ASSAB Dongguan"). ASSAB Dongguan's Chinese company name as appeared on the website is "—gig A", which contains the Complainant's Chinese mark "—Ei (ASSAB in Chinese)" in its entirety. In addition, on its website, ASSAB Dongguan has also copied introduction and history of the Complainant to confuse and deceive consumers into believing that it is an entity or subsidiary affiliated or related to the Complainant. Finally, < assab-cn.com > and < assab-tool.com > all resolve to websites that are similar to the Complainant's website.

After a careful examination of the four, non-exclusive examples enumerated in paragraph 4 (b) of the UDRP, the Panel ultimately found, that, based on the available facts and circumstances, the registration and use of the domain name could be said to have been made in bad faith.

The Panel finds that the Respondent's actions, with respect to the disputed domain name, constitute bad faith registration and use. Consequently, the Panel concludes that the Respondent violated paragraph 4(a)(iii) of the Policy and specifically paragraph 4(b)(i) thereof. Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to the disputed domain name, to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

## 6. Decision

Based on the above analysis, the Panelist decides that: (1) the disputed domain name <china-assab.com> is confusingly similar to the Complainant's name or mark in which the complaint has rights; (2) the Respondent has no right or legitimate interest in respect of the disputed domain names; (3) the Respondent has registered and is using the domain name in bad faith.

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panelist grants the relief sought by the Complainant. The disputed domain name, <china-assab.com>, is ordered transferred to the Complainant.

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Prof. Julien Chaisse  
Panelist

Dated: July 6, 2016