



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (BEIJING OFFICE)

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Decision Submission

English Print

Decision ID	DE-0700117
Case ID	CN-0700137
Disputed Domain Name	www.Carlylechina.com
Case Administrator	Xinmin Cui
Submitted By	Shaojie Chi
Participated Panelist	Lulin Gao Shoukang Guo Ping Zhang
Date of Decision	09-07-2007

The Parties Information

Claimant	T.C.Group, L.L.C
Respondent	Chen Derong

Procedural History

On May 8, 2007, the Complainant submitted a first Complaint in English together with a Chinese version to the Beijing Office of the Asian Domain Name Dispute Resolution Center (the "Center"), 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 Asian Domain Name Dispute Resolution Center Supplemental Rules for Uniform Domain Name Dispute Resolution Policy Disputes (the "ADNDRC Supplemental Rules") effected on February 28, 2002. The Center confirmed the reception of the Complaint.

On May 9, 2007, the Center received the Registrar's confirmation on registration information of the disputed domain name.

On May 14, 2007, the Center sent the Complaint to the Respondent.

On May 31, 2007, with the Complaint forwarded to the Respondent, the Center notified the parties regarding the commencement of proceedings and had also sent the notification to both ICANN and the Registrar.

On June 21, 2007, having received no response from the Respondent, the Center notified the Complainant that the hearing will take place by default.

As chosen by the Complainant and no choice to the contrary from the Respondent, a Panel of three is to be constituted to hear the case. Upon receiving the declaration of impartiality and independency and the statement of acceptance from the three nominated Panelists, Mr. Chi Shaojie, Mr. Tang Guangliang and Mr. Gao Lulin on June 22, 2007, the Center informed the Complainant and the Respondent of the appointment of Mr. Chi Shaojie as chief Panelist, Mr. Tang Guangliang and Mr. Gao Lulin as Panelists on June 28, 2007, forming the Panel to hear the case.

The Panel finds that they are properly constituted and appointed in accordance with the Rules and the ADNDRC Supplemental Rules.

Having requested the Respondent to submit a response, the Center received no such response during the entire proceeding.

The language of the proceedings is English owing to the language of the Domain Name Registration and Service Agreement pursuant to Paragraph 11(a) of the Rules, and considering that it is one of the languages used by the Complainant when filing the Complaint and that there is no express agreement to the contrary by the disputing parties, or

at least no express objection by the Respondent.

Factual Background

For Claimant

Established in 1987, The Carlyle Group (Complainant, also referred to as Carlyle) is one of the world's largest private equity firms with around 750 investment professionals working in 16 countries in North America, Europe, Oceania and Asia (incl. Shanghai, Beijing and Hong Kong). Carlyle is the trade name of the Complainant and has been used as the company's logo in its global business operation since the year of 2000. On January 4, 1996, the Complainant applied to register "The Carlyle Group" as a trademark through European Community Trademark registration proceedings and the registration was granted on October 20, 1998 and renewed in 2006 to the expiry on April 1, 2016. As a world equity management giant, the Complainant operates on a total equity assets of USD54.5 billion through management of 48 funds operating in the fields of leveraged buyouts, venture & growth capital, real estate and leveraged financing, etc. The total annual revenue of the Carlyle-invested-or-managed companies reaches more than USD 68 billion, and the total employment of the companies are more than 200,000 currently.

Carlyle has a very high profile in China due to its extensive business presence in the country. The well-known successful projects involve Ctrip.com International Ltd., Target Media, Pacific Mall, Sunco, China Pacific Insurance (Group) Co., Ltd, etc. So far, three offices have been formed in Shanghai, Beijing and Hong Kong to manage Carlyle's business in China. The extensive business operations in China market made the name Carlyle and its Chinese translation "凯雷" famous in the country and particularly well-known in the fields of investment, financial and equity management and capital market.

As early as in 1996 and 1997, the Complainant registered the domain names "thecarlylegroup.com" and "carlyle.com" which are being used in the Complainant's official website that are frequently visited by the Chinese consumers.

The Respondent operates a website by the name of Carlyle Global Private Fund which can be linked by logging on the disputed domain name. In view of certain illegal conducts by the Respondent in the usage of its website, the Complainant filed petitions to local government authorities to take action against it. The website cannot be visited anymore.

For Respondent

The Respondent is Chen Derong who registered the disputed domain name on December 15, 2006 through the Registrar WEB Commerce Communications Limited DBA WEBNIC.CC, and made no response to any allegations made by the Complainant.

Parties' Contentions

Claimant

The Complainant is a multinational company by the name of "The Carlyle Group (T. C. Group L.L.C.*)" involved in the global business of capital investment, equity and financial management, etc. under the trade name, company logo and registered trademark of "Carlyle" or "The Carlyle Group" which are famous in world capital market. The Respondent has no legitimate right or interest regarding the disputed domain name and has registered and used the name in bad faith. The disputed domain name has confusing similarity to the Complainant's registered mark. Thus, the disputed domain name should be transferred to the Complainant.

Respondent

The Respondent failed to submit any defense.

Findings

One of the prerequisites for a domain name registration through the Registrar is to accept the Policy as the binding regulations in terms of the procurement of the entitlement. As previously mentioned, the Policy governs the procedural and substantive issues in the domain name dispute resolution. As stipulated in the Paragraph 4(a) of the Policy, when claiming a domain name registered by another, the Complainant must prove each of the following:

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

Based on the relevant stipulations under the Policy, the Rules and ADNDRC Supplemental Rules, the Panel needs to determine whether the Complainant satisfies each of the afore-said prerequisites. If the answer is yes, the Panel will make a final decision in accordance with the facts and relevant stipulations under the Policy, the Rules and the ADNDRC Supplemental Rules; if not, the Complainant's claims shall be rejected.

With regard to the current dispute, a fundamental fact is that the Respondent failed to submit a defense or a response of any sort. Particularly, the Respondent did not exhibit any intention to RETAIN the disputed domain name. As stipulated in Paragraph 5(e) of the Rules, "If a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint". In light of this stipulation, the Panel has no choice but to make the decision based primarily on the Complainant's contentions and the accompanying exhibits unless proven otherwise or that the Panel, based upon its professional experiences, thinks that the Complainant's allegations are not logical or obviously contradictory to a prior judgment or any other enforceable decisions.

Identical / Confusingly Similar

Pursuant to Paragraph 4(a) (i) of the Policy, the Complainant must prove that the domain name in dispute is identical or confusingly similar to a trademark or service mark in which the Complainant has right to. In order to meet this requirement, the Complainant provided proves certifying its entitlement to the registered trademark "The Carlyle Group" which by a renewal shall be valid until April 4, 2016. As demonstrated by the Complainant's exhibits, the Complainant's trademark was registered well before the Respondent had obtained the disputed domain name. Additionally, the complainant's evidence reveals that the Complainant's trademark and names have been used in China and achieved some reputation by such use. As such, what the Panel needs to do is to make a conclusion on the identity or confusing similarity between the Complainant's registered trademark "The Carlyle Group" and the Respondent's registered domain name "carlylechina.com".

When making a judgment on the issue of identity or confusing similarity, the Panel often compares the identifying part of the questioned domain name with that of the claimed trademark. It is observable that the identifying part of the domain name in dispute is "carlylechina" which is normally identified as composed of two words, namely "carlyle" and "china" by ordinary consumers who are supposed to understand English to a certain extent, due to the fact that the word "carlyle" cannot be found in most English dictionaries available in China and resembles a family name of Anglo-Saxon origin. The Complainant's registered trademark is composed of three words, namely "The", "Carlyle" and "Group" due to the fact that when the Complainant registered the mark the three words are separated on purpose.

The Complainant's mark has a meaning. The word "The" is a definite article linguistically and has no special meaning generally. The word "Carlyle" is identical to the word "carlyle" in the disputed domain name, and the two may have the same meaning to the general public. The word "Group" has a special meaning when being used on a definite occasion, and in this case it may mean a legal entity that controls certain number of other legal entities for profit-making purpose. It is obvious that the registered trademark is the same as the trade name of the Complainant's, both of which the key word is "Carlyle".

What the Panel needs to compare are "carlyle" plus "china" on the one side, and "The", "Carlyle" & "Group" on the other. No doubt, there is an identical part between the two, i.e. "Carlyle", based upon which the identifying part of the disputed domain name may be understood as "carlyle in china". Who is "Carlyle"? The Complainant's registered mark gives the answer. "Carlyle" is the Complainant's trade name that is registered and used as the Group's trademark. Based on this logically deduction, the general public may easily think that "carlylechina.com" is the name used on the website by an establishment in China set up by The Carlyle Group. Therefore, there is no other conclusion by the Panel than that the disputed domain name is confusingly similar to the Complainant's registered trademark.

In light of the above reasoning, the Panel holds that the identifying part of the domain name in dispute is confusingly similar to the registered trademark belonging to the Complainant, thus the Complainant satisfies the first requirement when claiming back a domain name registered by another as set forth in the Policy.

Rights and Legitimate Interests

Paragraph 4(c) of the Policy stipulates how a Respondent can effectively demonstrate its rights or legitimate interests with regard to the disputed domain name, as an argument against the Complainant's claim. The Panel does not think that the Respondent has any legitimate right or interest in respect of the disputed domain name owing to the fact that the Respondent has not claimed any such a right or interest and nothing so far could lead the Panel to conclude otherwise.

Though the burden of proof regarding "rights or legitimate interests" is generally on the party making the defense in the dispute resolution of a domain name, the Respondent, the Panel pays special attention to the allegations and supporting evidences provided by the Complainant when coming to the conclusion on the issue of "rights or legitimate interests".

The first persuasive factor to which the Panel pays special attention is the essential word in this dispute, "carlyle". As mentioned in the foregoing paragraph, the word looks like and sounds Anglo-Saxon. It is hard to hold that the Respondent whose name sounds Chinese, has any right or legitimate interest in such an occidental word prior to the Complainant. The simple reason is that the Complainant residing in the States may have certain historical linkage to the word "carlyle", and the Respondent can hardly have such a linkage, at least the Panel has not seen that linkage so far.

The second convincing factor which draws the Panel's attention is the word "carlyle" has been the trade name of the Complainant ever since its coming into being in 1987; there has been no sign so far, to show that the Respondent even knew the word "carlyle" prior to the formation of the Complainant.

The third certifying factor which comes to the Panel's attention is the Complainant registered the domain names "thecarlylegroup.com" & "carlyle.com" in 1996 and 1997, while the Respondent registered the domain name in dispute in 2006, some ten years after the Complainant's registration and usage of the domain names which containing the key word "carlyle". In particular, the only difference between the previously registered domain name "carlyle.com" and the disputed domain name "carlylechina.com" registered nearly ten years later than the former is the word "china" which may easily lead the consumer to think confusingly that the latter is somebody established by the former in China.

Based upon the above reasoning, the Panel comes to the conclusion that the Complainant has legal rights and legitimate interests in connection to the disputed domain name. In contrast, the Panel does not see any chance for the Respondent to claim any of such a right or legitimate interest regarding the disputed domain name. Therefore, the Panel thinks that the Complainant meets the second requirement as set forth under the Policy.

Bad Faith

The Complainant also needs to establish the Respondent's bad faith as set forth in the Paragraph 4(a)(iii) of the Policy. Under Paragraph 4(b)(i) of the Policy, the following circumstances in particular shall 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 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 Complainant alleges that the Respondent when making the registration did not give the exact detailed information on itself. By using the disputed domain name, the Respondent created a website using the title "Carlyle Global Private Fund" trying to mislead web visitors to confuse the Respondent with the Complainant. Owing to fact that the Complainant "The Carlyle Group" is well-known to the investors in China and quite a lot of Chinese investors took the Respondent for someone linked to the Complainant and suffered heavy losses after being deceived by the Respondent, the Complainant appealed to local government authorities to take action against the Respondent. It seems that the Respondent's website was closed.

Meanwhile, the Panel has not heard any argument by the Respondent stating the contrary.

The Panel notes that the Complainant provides a series of exhibits to support its allegation that the Respondent registered and used the disputed domain name in bad faith. Having gone through those exhibits, the Panel may simply think the Complainant's allegations are true. Comparing what is demonstrated on the Respondent's website using the disputed domain name with what is on the Complainant's website, one may easily see the Respondent's purpose, attracting, for commercial gain, internet users to log on to its website by creating a likelihood of confusion with the Complainant as to the affiliation, sponsorship or source of service, etc. As revealed by the exhibits by the Complainant, the website using the disputed domain name may be logged on early this year, but cannot be visited currently. The Panel tries to conduct google searching by logging on the disputed domain name and could not visit the Respondent's website, but found out plenty of reports on the so-called Carlyle Global Private Fund being linked to the Complainant's name, out of which not a few revealed the Respondent's name as the manager of the Fund. Judging from the contents of the reports, the Panel firmly believes what the Complainant alleges are not fraudulent.

Based on the above reasoning, the Panel finds that the acts of Respondent fall under the circumstances in Paragraph 4(b) (iv) and shall be considered as evidence of the registration and use of the disputed domain name in bad faith and thus the Complainant meets the third requirement under the relevant articles of the Policy.

Based on all the above findings and comments, the Panel rules that the Complainant fulfills all conditions provided in Paragraph 4(a)(i)(ii) (iii) of the Policy, hence its claims shall be held.

Status

www.Carlylechina.com Domain Name Transfer

Decision

In light of all the foregoing findings and in accordance with Paragraphs 4(a), 8(a) of the Policy and 5(e) of the Rules, the Panel holds:

- a) That the disputed domain name "carlylechina.com" is confusingly similar to the Complainant's registered trademark "The Carlyle Group"; and
- b) That the Respondent has no right or legitimate interest with regard to the disputed domain name; and
- c) That the domain name was registered and subsequently utilized in bad faith.

As such, the Panel requires that the domain name "carlylechina.com" be transferred to the Complainant.

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