



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (BEIJING OFFICE)

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Decision Submission

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Decision ID	DE-0800153
Case ID	CN-0700172
Disputed Domain Name	www.中银.com
Case Administrator	xiechangqing
Submitted By	Lulin Gao
Participated Panelist	

Date of Decision	15-02-2008
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The Parties Information

Claimant	BANK OF CHINA LIMITED
Respondent	li zhang

Procedural History

The Complainant of this case is BANK OF CHINA LIMITED. Its address is at 1, Fu Xing Men Nei Avenue, Xicheng District, Beijing, China. Its authorized representative is Zhou, Sheng.

The Respondent of this case is LI ZHANG with addresses at 11 catford road, #607, north york, toronto on m3j1p9, CA.

The Disputed Domain Name is 中银.com. The Registrar of the Disputed Domain Name is Spot Domain LLC dba Domainsite.com.

A Complaint, made pursuant to the Uniform Domain Name Dispute Resolution Policy (“UDRP”) implemented by the Internet Corporation for Assigned Names and Numbers (“ICANN”) on 24 October 1999, and under ICANN Rules for UDRP and Asia Domain Name Dispute Resolution Center (“ADNDRC”) Supplemental Rules for UDRP, was received by ADNDRC Beijing Office on 24 October 2007. On 24 October 2007, the ADNDRC Beijing Office requested the Registrar by email for the provision of information at their WHOIS database in respect of the Disputed Domain Name, and the registration information was confirmed by the Registrar on 29 October 2007.

On 1 November 2007, ADNDRC Beijing Office transmitted the Complaint to the Respondent by email.

On 12 November 2007, ADNDRC Beijing Office notified the Complainant by email that the Complaint was reviewed and forwarded to the Respondent and confirmed with the parties and Registrar by email that the captioned case was formally commenced. ADNDRC Beijing Office also requested the Respondent to file a Response within the 20 days scheduled time.

On 29 November 2007, the ADNDRC Beijing Office received the Response from the Respondent. On 10 December 2007, the ADNDRC Beijing Office transmitted the Response to the Complainant.

On 9 January 2008, ADNDRC Beijing Office gave notice to the potential candidate of the Panelist Dr. Lulin Gao, requesting him to confirm whether he would accept the appointment as a Panelist for this case, and if so, whether he could maintain impartiality and independence between the parties in this case.

Having received a declaration of impartiality and independence and a statement of acceptance from Dr. Lulin Gao, ADNDRC Beijing Office informed by email the parties that Dr. Lulin Gao would be the sole Panelist of this case and transferred the files of this case to the Panel formally on 14 January 2008.

On 14 January 2008, the Panel received the file from the ADNDRC Beijing Office and should render the Decision within 14 days, i.e., on or before 28 January 2008.

Factual Background

For Claimant

The Complainant is BANK OF CHINA LIMITED with addresses at 1, Fu Xing Men Nei Avenue, Xicheng District, Beijing, China.

The complainant is the registrant of the prior trademark “中銀” with Reg. No 911704 in the P.R.China, which is used on services of insurance underwriting, financial service, capital investment, trust fund, credit cooperative, fund investments, loans (financing), savings banks, credit card services, electronic funds transfer, foreign currency settlement, clearing of bills, currency exchange, mortgage loans, financial consultancy and securities brokerage (refer to attachment 5). The complainant and the mentioned trademark are well-known in the world.

The respondent knew or should have known the great reputation of the complainant and the mentioned trademark. However, the respondent still registered the mentioned domain name which is confusingly similar to the complainant’s well-known trademark. The respondent has prevented the complainant from reflecting the mentioned trademark in corresponding domain name by the registration of the mentioned domain name. And the mentioned domain name has not been practically used for more than 3 years.

The complainant claims that the domain name should be transferred to the complainant.

For Respondent

The Respondent is LI ZHANG with addresses at 11 catford road, #607, north york, toronto on m3j1p9, CA.

Parties' Contentions

Claimant

(1) Introduction on the complainant (refer to attachment 2 and 6)

The complainant, BANK OF CHINA, or BANK OF CHINA LIMITED in full, established in 1912 pursuant to the approval of Mr. Sun Yatsen (孙中山), is one of the four largest commercial banks controlled by Chinese government and the most internationalized commercial bank in China with over 600 overseas operations, whose business ranges over commercial banking, investment banking and insurance. Members of the group include BOC Hong Kong, BOC International, BOCG Insurance and other financial institutions. The complainant provides a comprehensive range of high-quality financial services to individual and corporate customers as well as financial institutions worldwide. In tier one capital, it ranked 18th among the world’s top 1000 banks by The Banker magazine in 2005. Over the past century, it played and still plays an important role in China’s financial history.

In 2003, it was named by the State Council as one of the pilot banks for the joint-stock reform of the wholly state-owned commercial banks. On August 26, 2004, it was formally incorporated as a joint stock commercial bank.

On July 14, 2004, the complainant became the sole banking partner of Beijing 2008 Olympic Games.

The complainant has received wide recognition from its peers, customers and authoritative media for the credit and performance it achieved in past years. It has been awarded “Best Bank in China” and “Best Bank in China” by Euromoney for eight times; it has been included in the Fortune Global 500 for 17 consecutive years; in addition, it was awarded “Best Domestic Bank in China” by The Asset, “Best Trade Finance Bank in China” and “Best Foreign Exchange Bank in China” by Global Finance, and “the Top 10 Product Service Enterprise in China” by Far Eastern Economic Review; since BOC Hong Kong was restructured and listed in the Hong Kong stock market, it has been the winner of many significant awards, including “Best IPO Investor Relation Award” issued by the Investor Relations Magazine and “Best Transactions” and “Best Privatization Award” issued by Asian Finance.

(2) Prior rights of the complainant

i . The prior registered trademark (refer to attachment 5)

The complainant is the registrant of the cited trademark “中銀” with Reg. No. 911704, which was announced on Sept. 7, 1996 after preliminary examination of Chinese Trademark Office and was registered on December 7, 1996. These dates are much earlier than the date, August. 10, 2004 when the mentioned domain name was created.

ii . Well-known trademark (refer to attachment 7)

The cited trademark, “中银”, was approved as well-known trademark by Trademark Office of the State Administration for Industry and Commerce of P.R.China on February 8, 2002. The mentioned date, February 8, 2002, is much earlier than the date of August 10, 2004 when the mentioned domain name was created.

(3) The mentioned domain name is confusingly similar to the cited trademark in which the complainant has prior rights

The cited trademark has been utilized for many years and wins a great reputation for the services provided by the complainant and history of the complainant. It is a well-known trademark. The public naturally associate “中银” with the complainant and its trademark when they face “中银”. The main part of mentioned domain name of “中银.com”, is “中银”. The mark of the cited trademark is “中银”. It is obvious that the mentioned domain name is confusingly similar to the cited trademark in which the complainant has exclusive rights.

(4) The respondent has no rights or legitimate interests in respect of the mentioned domain name

(5) The mentioned domain name is being used in bad faith

The respondent knew or should have known the complainant and the mentioned trademark because of their great reputation.

The mentioned domain name has prevented the complainant from reflecting the well-known trademark in a corresponding domain name and the respondent has not used it practically for more than 3 years.

By creating the domain name, the respondent shall have attracted internet users to his 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 respondent’s website of location. It also shall be dangerous for the clients of banks.

Respondent

The Procedural Issue

According to the Policy, the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules) and the Center’s Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the Supplemental Rules), the Center shall check a Complaint to determine that it satisfies the formal requirements of the Policy, the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules) and the Center’s Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the Supplemental Rules) and that it has received the required payment from the Complainant, then it will sign and forward an official copy of the Complaint to the Respondent. But the Complainant has not sent the Respondent any hardcopy of the Complaint, thus failing to satisfy the formal requirements or rather the requirements of process of service. Therefore, the Complainant has breached the procedural rule or rather due process or procedural justice. The Complaint thus should have been and still shall be withdrawn or otherwise voided.

The Substantive Issue

Response to Statements and Allegations Made in Complaint (Policy, para. 4(a), (b), (c); Rules, para. 5)

According to the Rules Para. 5(b)(i), the Respondent in its Response shall respond specifically to the statements and allegations contained in the Complaint and include any and all bases for the Respondent (Domain Name Holder) to retain registration and use of the disputed Domain Name; For the Complainant to succeed, they must establish that each of the three conditions under the Policy, Para. 4(a) (i), (ii), (iii) is satisfied. With reference to Para.4(a), in this section the Respondent wishes to discuss all of the following, to the extent relevant and supported by evidence.

As to whether the Respondent’s domain name is identical or confusingly similar to the Complainant’s Trademark (Policy, para. 4(a) (i), the Respondent claims:

A. The domain name is a common or generic name or word or term or mark, and should be protected according to the cases and their decisions or precedents of the Center and the WIPO Arbitration and Mediation Center and related laws and cases.

B. For the above reason, there are 36 more companies that have registered the same trademark (See Annex); Further, as referred to earlier, the Complaint make up deceptive information to the panel by claiming that they have exclusive rights for the disputed trade mark and the domain.

C. The Complainant’s trademark was acquired by transfer or alienation on September 28, 2005, but the Respondent’s domain name was registered prior to it, on August 10, 2004.

D. Besides, based on all the preceding arguments and the more recent pertinent UDRP decisions, it can be concluded that rather than the Respondent should be accused as it is in this present case, the Complainant can be accused of reverse domain name hijacking. When a complainant does not have exclusive use of a possible “generic” mark and a Respondent has registered the “generic” term(s) as a domain, then there is the possibility of “reverse domain name hijacking.

As to whether the Respondent has rights or legitimate interests in respect of the domain name (Policy, para. 4(a)(ii)), the respondent claims that it does:

A. The Respondent is making a legitimate fair use of the domain name, without intent to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

B. The Respondent had never in any way, in any place, in any time, acquired or otherwise accessed any kind and any degree of knowledge and/or information of and about the Complainant and their trade mark when registering for the

reasons below: First, as a Canadian having been living in Canada, a common citizen not in any of capacity of legislative, executive, regulatory, judicial or any quasi-legislative, quasi-executive, and quasi-judicial officers or officials or agents or representative in any affairs related to the Complainant, an common individual not otherwise associated in any way with the Complainant and their trademark, the Respondent had never heard or learned about the Complainant or their productions or their trademark. Furthermore, and also for the above reason, under the same conditions, the Respondent did not know in any sense about the Complainant and their products or trademark when registering the disputed domain. Especially, for the very same reasons as above, the Complainant can not present and has not presented any evidence except imaginations or speculations to counter the Respondent's position.

C. As has been established earlier in the Respondent, the Domain name is a common and/or generic word or term or mark, and the registration of such a symbol as a domain name in such situations is entirely permissible and legal under the UDRP decisions and trademark law, thus establishing the Respondent's right and legitimate interest.

D. The Respondent never would not, did not, does not, and will not sell this domain to any person or group, nor have the Complainant been or will be able to provide any evidence to contend the Respondent's such position and fact as well. As to Whether the domain name has been registered and is being used in bad faith. (Policy, para. 4(a)(iii)), the Respondent claims that it has not and is not:

A. The domain name was not registered or acquired and is not being used for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant, as the alleged owner of the trademark or service mark, or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's out-of-pocket costs directly related to the domain name.

B. The domain name was not registered in order to prevent the Complainant from reflecting the mark in a corresponding domain name and, in connection therewith, the Respondent has not engaged in a pattern of such conduct.

C. The Complainant and the Respondent are not competitors and the domain name was not registered by the Respondent in order to disrupt the Complainant's business.

D. The domain name was not registered by the Respondent in an intentional attempt to attract Internet users to the Respondent's web site or any other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's web site or location or of a product or service on the Respondent's web site or location.

Also, and/or specifically, all the above refutations and positions respectively can be supported in detail as follows.

E. Technically, it is almost not operable or possible for the Respondent to use this domain to design a website for profit.

F. In respect of the very nature and classification of the Complaint and the Respondent, of their websites, domain names and trade marks, respectively, the Complainant is a giant enterprise, has their own domains and trade marks for such specialized purposes; all of which are very easy and convenient to distinguish from the Respondent and its domain, website and services to offer. Thus, it's not possible for the general public, let alone those professionals, to confuse the Complainant with any other non-profit counterparts such as those of the Respondent.

THEREFORE,

1.The Complaint has not and does not disclose a reasonable cause of action as against the Respondent within the jurisdiction of this Forum.

2.The Complaint is bringing an ill founded action against the Respondent.

3.The Complaint is otherwise frivolous or vexatious.

4.Service outside of China of the Complaint was neither legitimate nor appropriate.

5.The Complaint is an abuse of the processes of the UDRP, the Rules, the Supplemental Rules, and all those of the Beijing Center.

Findings

In the Response, the Respondent alleged that the Complainant has not sent the Respondent any hardcopy of the Complaint, thus failing to satisfy the formal requirements or rather the requirements of process of service. Therefore, the Respondent requested the Panel to render a decision that the Complaint should be withdrawn or otherwise voided. According to Paragraph 4(a) of ICANN Rules, it is the ADNDRC Beijing Office, rather than the Complainant that shall forward an official copy of the Complaint to the Respondent. And after the confirmation with ADNDRC Beijing Office, the panel finds out ADNDRC Beijing Office did transfer the hardcopy of the Complaint to the address of Respondent provided by the Registrar. To view the above Procedural History, the Panel considers that no flaw exists in the process of service and the Complainant has already satisfied the formal requirements in accordance with the procedural rules. Therefore, the argument claimed by the Respondent shall not be adopted.

According to Paragraph 4a of the Policy that is applicable hereto, the Complainant has the burden of proving that:

- 1) that the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- 2) that the Respondent has no rights or legitimate interests in respect of the domain name; and
- 3) that the domain name has been registered and is being used in bad faith.

Identical / Confusingly Similar

The Panel holds that, pursuant to Paragraph 4(a) (i) of the Policy, the Complainant must prove that Disputed Domain Name 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 proof certifying its entitlement to the registered trademark “中银” in China (Reg. No.: 911704), which is still valid by renewal. As demonstrated by the Complainant’s exhibits, the Complainant’s trademark was registered well before the Respondent had registered the Disputed Domain Name (10 August 2004). Thus, the Panel is of the view that the Complainant enjoys the prior trademark right to “中银”. When coming to the conclusion on the issue of “prior right”, the Panel pays special attention to the arguments and supporting evidences provided by the Respondent, but cannot uphold the following allegations.

The first allegation of the Respondent that comes to the Panel’s attention is that the Complainant’s trademark was acquired by transfer or alienation on September 28, 2005, but the Respondent’s domain name was registered prior to it, on August 10, 2004. For this case, the panel holds that the Complainant accepted the transfer of registered mark, Meanwhile it should accept the transfer of all rights of former registrant (including the rights of initiating UDRP procedure based on the registered mark). Even though the mark is transferred on the date later than the registration date of Disputed Domain Name, the protection term of the right to exclusive use of registered mark, which has been acquired due to transfer, shall still be counted from the date where the mark was registered. Thus, the Complainant still enjoys the trademark right to “中银” prior to the registration date of the Disputed Domain Name.

The second allegation which draws the Panel’s attention is some other companies other than the Complainant have registered the trademark “中银” in some Classes in China. Notwithstanding the forgoing, considering the high reputation and goodwill of the mark “中银”, which was ever recognized the well-known mark by the Trademark Office of the State Administration of Industry and Commerce in 2002, in combination with the distinctiveness of the mark, the Panel finds that the Complainant should have the prior trademark right to “中银”. Based upon the above reasoning, the Panel comes to the conclusion that the Complainant enjoys the prior trademark right to “中银”. As such, what the panel needs to do is to make a conclusion on the identity or confusing similarity between the Disputed Domain Name “中银.com” and the Complainant’s registered trademark “中银”. Obviously, “中银”, as the identifying part of the Disputed Domain Name, is exactly the same as the Complainant’s registered trademark.

Therefore, the Panel finds that the Disputed Domain Name is identical or confusingly similar to the Complainant’s trademark, and the Complainant has satisfied the first condition under Paragraph 4(a) of the Policy.

Rights and Legitimate Interests

The Panel makes the decision based on the evidence provided by both parties and in case that any party fails to meet its burden of proof, such party shall undertake the risk of the possible unfavorable result against it. The Complainant claims that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. The Panel finds that the Complainant has already fulfilled the burden of proof required by the second condition under Paragraph 4(a) of the Policy, thus 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 considers that, 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. Although the Respondent contends that he is making a legitimate fair use of the domain name, without intent to misleadingly divert consumers or to tarnish the trademark or service mark at issue, he failed to provide any evidence to prove he had any right or legitimate interest whatsoever in respect of the trademark “中银”, or there was any association between the trademark “中银” and his activities before registering the Disputed Domain Name. Given that there is no evidence from the Respondent on his contention that he has legitimate right, the Panel cannot draw conclusion that the Respondent has any rights or legitimate interests in respect of the Disputed Domain Name and nothing so far could lead the Panel to conclude otherwise.

Meanwhile, the Panel is not convinced by Respondent’s contention that the Disputed Domain Name is a common and/or generic word or term or mark and the registration of such a symbol as a domain name in such situations is entirely permissible and legal under the UDRP decisions and trademark law, thus establishing the Respondent’s right and legitimate interest. It is easily observable that “中银”, appears to be a coined word instead of the generic word in Chinese. The question is, there are hundreds and thousands of Chinese words, why did the Respondent specifically choose the combination of such two words especially that there is no sign that the Respondent has any linkage to the two Chinese words. The Panel sees no defense capable of removing the curious coincidence and can think of no reasonable explanation or even logical probability to the question.

In view of the foregoing, the Panel comes to the conclusion that the Respondent has no legitimate right or interest in respect of the Disputed Domain Name. Accordingly, the Complainant has satisfied the second condition under Paragraph

4(a) of the Policy.

Bad Faith

In accordance with Paragraph 4 (b) of UDRP, it sets out four non-exclusive criteria which shall be evidence of the registration and use of a domain name in bad faith:

(i) the Respondent has registered or has 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 trade mark or service mark or to a competitor of that Complainant for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the Respondent has registered the domain name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or

(iii) the Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 its web site or location or of a product or service on its web site or location.

First of all, the Complainant, as one of the four largest commercial banks controlled by Chinese government and the most internationalized commercial bank in China, has been included in the Fortune Global 500 for 17 consecutive years, and received wide recognition from international authoritative media. Through the Complainant's long-term promotion and use, the mark “中银” is well-known enough around the world and especially in China. We note that the distinctiveness of the Disputed Domain Name is actually the two Chinese characters. Since the Respondent registers such a domain, the panel is of the view that the Respondent should know or is very interested in China. Therefore, considering the great fame of the mark in China, it is presumable that the Respondent knew and should have known about its existence when registering the Disputed Domain Name. Furthermore, given the inherent distinctiveness of the mark “中银”, the Panel finds it difficult to accept that the Respondent registered the Disputed Domain Name without knowledge of the Complainant's rights in “中银”. It cannot be a mere co-incidence that the Respondent has chosen the domain name, which is identical to and is an imitation of the Complainant's mark, as his domain name. These findings, together with the finding above that the Respondent has no rights or interests in the Disputed Domain Name, lead the Panel to conclude that the Disputed Domain Name has been registered by the Respondent in bad faith.

Secondly, as demonstrated above, the Respondent should be aware of the Complainant and the Complainant's mark, while the Respondent has registered the Disputed Domain Name “中银.com” which consists of the Complainant's mark “中银” only, thereby inevitably preventing the Complainant from reflecting its trademark in such corresponding domain name. Accordingly, the stipulations of paragraph 4 (b) (ii) concerning the bad faith are satisfied here.

Thirdly, according to the Complainant's allegation that the respondent has not used the Disputed Domain Name practically for more than 3 years, the Panel tried to log on the website using the Disputed Domain Name, but failed. The fact is that there is no evidence so far to show that the Disputed Domain Name is used in whatever way. As such, the panel is of the opinion that that bad faith conditions may not be limited to the above four conditions according to UDRP. It is possible, in certain circumstances, for passive holding by the Respondent to amount to the domain name being used in bad faith. This point is acknowledged in the Panel Decision in *Telstra Corporation Limited v. Nuclear Marshmallows* (WIPO Center Case No. D2000-0003).

Based on the above analysis, the Complainant's mark “中银” has a high reputation and is widely known in China and around the world. While, the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the domain name. Taking into account these particular circumstances, the panel may infer that the Respondent has no real intention of active use of the Disputed Domain Name, and such acts of the Respondent have constituted the passive holding of the Disputed Domain Name, which amounts to the domain name being used in bad faith.

In light of all of the above circumstances, the Panel concludes that the Complainant has satisfied the third condition under Paragraph 4(a) of the Policy.

Status

www.中银.com

Domain Name Transfer

Decision

For all the forgoing reasons, the Panel has decided that the Complainant has proved sufficiently the three elements of Paragraph 4(a) of UDRP. Accordingly, the Panel directs that the Disputed Domain Name be transferred to the Complainant.

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