

ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE
(Beijing Office)
ADMINISTRATIVE PANEL DECISION
Case No. CN-20100356

Complainant: Thule Sweden AB

Respondent: beijingbohaiyangfankejiyouxiangongsi

Domain Name: bjtule.com

Registrar: WEB COMMERCE COMMUNICATIONS LIMITED DBA WEBNIC.CC

1. Procedural History

On April 15, 2010, the Complainant submitted a Complaint to the Beijing Office of the Asian Domain Name Dispute Resolution Center (the "ADNDRC Beijing Office"), in accordance with the Uniform Domain Name Dispute Resolution Policy (the "Policy") adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN"), the Rules for Uniform Domain Name Dispute Resolution Policy Disputes (the "Rules") approved by ICANN, and Asian Domain Name Dispute Resolution Center Supplemental Rules for Uniform Domain Name Dispute Resolution Policy Disputes (the "ADNDRC Supplemental Rules").

On April 15, 2010, 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 such registration information was confirmed by the Registrar on April 23, 2010.

On June 28, 2010, the ADNDRC Beijing Office transmitted the Claims to the Respondent by email.

On July 20, 2010, the 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. The ADNDRC Beijing Office also requested the Respondent to file a Response within 20 calendar days scheduled time.

On August 9, 2010, the ADNDRC Beijing Office confirmed the Response from the Respondent.

On August 11, 2010, the ADNDRC Beijing Office transmitted the Response to the Complainant.

On August 13, 2010, the ADNDRC Beijing Office gave notice to the potential candidate of the Panelist Mr. Gao Lulin, 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. On the same day, the ADNDRC Beijing Office received a declaration of impartiality and independence and a statement of acceptance from Mr. Gao Lulin.

On August 13, 2010, the ADNDRC Beijing Office informed by email the Parties that Mr. Gao Lulin would be the Sole Panelist of this case and transferred the files of this case to the Panel formally on the same day. The Panel should render the Decision within 14 days, i.e. on or before August 27, 2010.

2. Factual Background

For the Complainant

The Complainant of this case is Thule Sweden AB. Its address is BOX 69, SE-330 33HILLERSTORP, SWEDEN. Its authorized representative is Thule (Shanghai) Co., Ltd..

For the Respondent

The Respondent of this case is beijingbohairyangfankejiyouxiangongsi with the address at Room 2003, Peking International Trade Building, West No.16 Fengguan Road, Fengtai District, Peking, CN100071.

The Respondent registered the Disputed Domain Name on December 14, 2009.

3. Parties' Contentions

The Complainant

The Complainant's contentions are as follows:

In December 2009, the Respondent registered the Disputed Domain Name. The Respondent not only uses the Disputed Domain Name without permission and authorization on behalf of Beijingtulezijiazhuangbeidian to build the THULE-related sites, but also uses brand identity and product pictures containing "THULE" or "thule" on the website, and imitates "拓乐"、"THULE", or "thule" to make the trademarks "途乐", "TULE", or "tule" which can cause confusion. The trademark's shadow on the homepage is the brand "THULE" of "Sweden", and the color and the design pattern of the website have similar nature which can lead to confusion. The Respondent conducts THULE product network sales and concept promotion on the website without permission and authorization to interchange and link to the webpage of Beijing Special Store, which has seriously affected the company's image of the Complainant.

The Disputed Domain Name and the Complainant's trademark "thule" are confusingly similar. The Disputed Domain Name and "www.thule.com" as well as "www.thulediscovery.com" which the Complainant registers and uses have a high degree of similarity.

The Respondent's company is irrelevant with the main part of the domain name—"bjthule.com", and the Respondent doesn't have trademark rights and other related civil rights on "thule" at the same time. Therefore, the Respondent is not entitled to have the rights and legitimate interests of the Disputed Domain Name.

The Respondent registered and used the Disputed Domain Name for commercial malicious purpose, which will make network users who search for "thule" commodity confused of the source of the Complainant's site and think by mistake that the website is authorized by the Complainant. Even when the customers are visiting the website, they will still think by mistake that the Respondent is a legitimate company in Beijing of the Complainant. This will not only increase the click rate and awareness of the Respondent's website, but also increases the Respondent's business opportunities. The Complainant registers and

uses “www.thule.com” and “www.thulediscovery.com” which have enjoyed a high degree of brand awareness in the industry. The Respondent’s above-mentioned acts not only undermine the Complainant’s normal business operations, but also constitute unfair competition with the Complainant.

The Complainant believes that the Disputed Domain Name is confused with the trademark “THULE”, and the registration of the Disputed Domain Name is malicious. The Respondent doesn’t enjoy the corresponding rights or legitimate interests. The Respondent used registered trademark of the Complainant as part of its domain name (bjtule.com), which is a serious violation of the legitimate rights and interests of the Complainant. The registration of the Disputed Domain Name is malicious and infringes the legitimate interests of the public and the Complainant.

The Complainant files the complaint especially to the Asian Domain Name Dispute Resolution Center, and requests a ruling that cancels the Disputed Domain Name —“bjtule.com”.

The Respondent

The Respondent responds to the Complainant's contentions as follows:

The name “途乐” (Chinese Pinyin is “tule”) and the word “bjtule” revealed in the Disputed Domain Name is just Chinese Pinyin of “北京途乐”, which has nothing to do with “拓乐” as well as “Thule”. We get the name from “自驾旅途, 乐享无限” (which means “Enjoy enormous pleasure during self-driving”), the last word of “自驾旅途”—“途” and the first word of “乐享无限”—“乐”, the two words composed together, then we get “途乐”, and its Chinese Pinyin is “tule”, so it has nothing to do with “THULE”.

“途乐” (“tule”) is not a registered trademark of the Complainant and “bjtule”, as Chinese Pinyin of “北京途乐”, obviously has huge difference from “THULE” of the Complainant. Every person that knows basic words can easily tell the difference between “bjtule” and “THULE”, “thulediscovery”, and no one would take “bjtule” as “Thule” and “thulediscovery”.

We invested and opened sales store in September 2009. The store sells self-driving traveling equipments. We wish every client to enjoy the pleasure during self-driving traveling. Therefore, for having fun which means “途乐” in Chinese, we called ourselves “途乐自驾装备” (Means “having these equipments to have fun”). At the end of December 2009, we registered domain name “bjtule.com”, of which “bj” is the abbreviation of “Beijing”, and “tule” is Chinese Pinyin for “途乐”. We register this domain name so our clients can easily search for our website.

Our website “www.bjtule.com” contains Chinese Pinyin of “北京途乐”, while the domain name of the Complainant is “www.thulediscovery.com”, so the difference is obvious; besides, our website is a Chinese website and is exclusively for Chinese market, while the website “www.thule.com” of the Complainant is an English website that headquarters in a foreign country. If it is true for what they claim that “THULE” is a very famous brand, then how could the consumer make such mistake that consider “bjtule” and “THULE”?

We were once the distributor of THULE in China and we set up a website “www.bjthule.com” to sell THULE products. The “THULE” LOGO as well as THULE were once appeared on this website, but after the final judgment of ADNDRC, we gave up to use this website, but the website “www.bjtule.com” has nothing to do with THULE and there is no LOGO of THULE on that website.

We have signed cooperation contract with world brands “Prorack” and “HAPRO” since 2010 and we are now cooperation partners of these two brands. They are competitors of THULE in international market, and their products are very popular. Products of these two brands are also exhibited in Beijing Automobile Parts Exhibition; Thule Shanghai Company also gathered its distributors to attend this expo. We showed the visitors good competitive advantage of our products. Therefore, many THULE distributors paid strong attention to our products and started business relationship with us. The two brands we represent break the monopoly status of Thule in China market and our business is a threat for them.

“途乐” (“tule”) has very rich full meanings. Its essential meaning is to wish every single client enjoys their self-driving traveling, just like what we

promoted “自驾旅途，乐享无限” (“Enjoy enormous pleasure during self-driving”). What the Complainant have about the Chinese trademark “拓乐” is just one kind of transliterated translation of the English trademark “THULE”.

The Complainant is not the holder of trademark “bjtule”, and the Disputed Domain Name “bjtule” and “THULE” has huge and obvious difference. The Complainant is either not the holder of trademark of “北京途乐” (“bjtule”). No one that knows word would take “北京途乐” (“bjtule”) as “拓乐” (“THULE” and “thulediscovery”). Just because our existence threatened their market status, they start take this kind of measures and hope to take ADNDRC and Registration Authority to strike our business. The registration authority already stated that they would not consider THULE’s nonsense request. What THULE has done not only expose the intention of monopoly China market but also shows that they are not so confident with their products and are afraid to face the competition and challenge.

Coca cola, Pepsi Cola, and Future Cola all sell their own cola, but no one would think they infringe against each other or mislead consumers. What THULE Company did in China is illicit competition.

“途乐” (“tule”) is not a registered trademark of the Complainant, and we get the name form “自驾旅途，乐享无限”，the last word of “自驾旅途”—“途” and the first word of “乐享无限”—“乐”，the two words composed together, then we get “途乐”，and its Chinese Pinyin is “tule”，so it has nothing to do with “THULE”. The “bjtule” as Chinese Pinyin of “北京途乐” also has obvious difference from “THULE” and “thulediscovery” of the Complainant. As this is not the trademark of the Complainant and it’s not misleading, so please reject the nonsense request of the Complainant.

4. Panel’s Findings

As stipulated in the Paragraph 4(a) of the Policy, when claiming a domain name registered by Respondent, the Complainant must prove each of the followings:

(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 is being 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.

Identical or Confusing Similarity

Pursuant to Paragraph 4(a)(i) of the Policy, the Complainant must prove that the 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 evidence certifying its entitlement to the registered trademark "THULE" (Reg. No. 914965) in China, which was registered in 1996, and remains valid after renewal. Just as demonstrated by the Complainant's exhibits, the Complainant's trademark was registered well before the registration date of the Disputed Domain Name (December 14, 2009) in terms of "carrying stents installed on the car; etc.". Thus, the Panel is of the view that the Complainant enjoys the prior trademark right to "THULE".

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 "THULE" and the Disputed Domain Name "bjtule.com". The Panel notices that, the identifying part of the Disputed Domain Name can be deemed as a combination of the prefix "bj" and the part "tule" which shares four identical English letters with Complainant's registered trademark "THULE", and the order of such letters is nearly the same. The only difference lies in the letter "h", however, the letter is not the first letter of "tule" or "thule", nor can the letter make "tule" and "thule" obviously different in terms of visual impact. For the prefix "bj", as stated by the Respondent, "bj" refers to the abbreviation for "Beijing". And the Panel holds that it is not distinctive enough to differentiate the Disputed

Domain Name from Complainant's registered trademark.

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

Rights or Legitimate Interests of the Respondent

The Panel makes the decision based on the evidence provided by both parties and in case that either party fails to meet its burden of proof, such party shall undertake the risk of the possible unfavorable result against it. The Complainant has contended that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name, and its registration and use of the Disputed Domain Name is without the permission and authorization of the Complainant. 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. The Panel finds that, with no other evidence supported, merely the Respondent's allegation is hard to establish that the Respondent has any rights or legitimate interests in respect of the Disputed Domain Name. In addition, there is no evidence to prove that the Respondent has been commonly known by the Disputed Domain Name.

In view of the foregoing, the Panel comes to the conclusion that the Respondent has no rights or any legitimate interests in respect of the Disputed Domain Name. Accordingly, the Complainant has satisfied the second condition under Paragraph 4(a) of 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) 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 Respondent states in its Response that it was once the distributor of the Complainant, and once set up a website www.bjthule.com to sell THULE products as well as displayed "THULE" logo on this website, thus, the Panel can draw the conclusion that the Respondent should have known or even is very familiar with the Complainant, its business as well as its registered "THULE" mark when the Respondent registered the Disputed Domain Name. In addition, the Respondent claims that it adopted the Disputed Domain Name based on the creation of the Chinese vocabulary of "途乐", of which the Chinese Pinyin is "tule". However, the Panel notes that the Complainant's enterprise name is also translated into "途乐" at least in 2007, as revealed in Complainant's trademark registration certificate. In fact, there is only minor difference between the Complainant's trademark "THULE" and the distinguishing part of the Disputed Domain Name "tule", which may easily cause confusion. Based on the above, it is very hard to convince the Panel that the registration of the Disputed Domain Name is a coincidence.

In addition, based on the submissions of the two Parties, it appears that the Disputed Domain Name is registered and used for the purpose of providing similar products as the Complainant's, which may be likely to disrupt the Complainant's business and attract the Internet users to the Respondent's website for commercial gain by creating a likelihood of confusion with the Complainant's mark.

Based on the above-said, taking into account the Respondent has no rights or legitimate interests in the Disputed Domain Name, the Panel conclude that it shall be considered as circumstance (iv) under the Paragraph 4(b) of the Policy that the registration and use of the Disputed Domain Name is 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.

5. Decision

For all the forgoing reasons, the Panel decides that the Complainant has proved sufficiently the three elements of Paragraph 4(a) of the Policy. Accordingly, the Panel supports the Complaint that the Disputed Domain Name should be cancelled.

Sole Panelist: 

Dated: August 27, 2010