

Asian Domain Name Dispute Resolution Center
Beijing Office
Administrative Panel Decision
Case No. CN-1300650

Complainant: GUINNESS WORLD RECORDS LIMITED

Respondent: xingxing zhou

Domain Name: jinisijilu.com

Registrar: GODADDY.COM, LLC

1. Procedural History

On 31 January 2013, the Complainants submitted a Complaint in the English language to the Beijing Office of the Asian Domain Name Dispute Resolution Center (the ADNDRC) and elected this case to be dealt with by a one-person panel, in accordance with the Uniform Domain Name Dispute Resolution Policy (the Policy) approved by the Internet Corporation for Assigned Names and Numbers (ICANN), the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules), and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the ADNDRC Supplemental Rules).

On 4 February 2013, the ADNDRC sent to the Complainant by email an acknowledgement of the receipt of the Complaint. On the same day, the ADNDRC transmitted by email to the Registrar and ICANN a request for registrar verification in connection with the disputed domain name. On 6 February 2013, the Registrar transmitted by email to the ADNDRC its verification response, confirming that the Respondent is listed as the registrant and providing the contact details.

On 26 February 2013, the ADNDRC transmitted the Written Notice of the Complaint to the Respondent, which informed that the Complainant had filed a Complaint against the Respondent over the disputed domain name and the ADNDRC had sent the Complaint and its attachments to the Respondent through email according to the Rules and the Supplemental Rules. On the same day, the ADNDRC notified the Complainant that the Complaint has been confirmed and transmitted to the Respondent, and notified the ICANN and the Registrar of the commencement of the

proceedings.

The Respondent failed to submit a Response within the specified time period. On 21 March 2013, the ADNDRC notified both parties of the Respondent's default.

Having received a Declaration of Impartiality and Independence and a Statement of Acceptance from Mr. ZHAO Yun, the ADNDRC notified the parties on 7 April 2013 that the Panel in this case had been selected. The Panel determines that the appointment was made in accordance with Rules 6 and Articles 8 and 9 of the Supplemental Rules.

On 7 April 2013, the Panel received the file from the ADNDRC and should render the Decision within 14 days, i.e., on or before 21 April 2013.

Pursuant to Paragraph 11 (a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding. The language of the current disputed domain name Registration Agreement is English, thus the Panel determines English as the language of the proceedings.

2. Factual Background

For the Complainants

The Complainant in this case is GUINNESS WORLD RECORDS LIMITED. The registered address is 184-192 DRUMMOND STREET, LONDON NW1 3HP. The authorized representative in this case is Tracy Shen & Sue Gui from Chang Tsi & Partners.

For the Respondent

The Respondent in this case is xingxing zhou. The registered address is bei jing shi dong cheng qu 589 shi. The Respondent is the current registrant of the disputed domain name "jinisijilu.com" according to the Whois information.

3、Parties' Contentions

Complainant

(1) The disputed domain name is so similar to the Complainant's trade name and trademarks to cause confusion

The Respondent registered the disputed domain name "jinisijilu.com" on 22 October 2012, which was far later than the date when the Complainant established fame and good will for its trade name and the registration of the "Guinness in Chinese" and "Guinness World Records in Chinese" trademarks.

The only meaningful part of the disputed domain name is "jinisijilu". The "jinisijilu" is the Chinese spelling and pronunciation of "Guinness Records in Chinese", which fully includes the distinctive part of the Complainant's trade name and trademarks. To the general public, especially the China public, the disputed domain name "jinisijilu.com" is very likely to be misbelieved as associated with the Complainant.

Searching "jinisijilu" through the most popular search engines www.baidu.cn and <http://cn.bing.com/>, the engines correctly connect and associate "jinisijilu" with "吉尼斯纪录" (Guinness records in Chinese) and "吉尼斯世界纪录" (Guinness World Records in Chinese). Most of the resulting information is related to the Complainant. This fact explains the exclusive connection between "jinisijilu" and "吉尼斯纪录" (Guinness records in Chinese) and the Complainant's "吉尼斯世界纪录" (Guinness World Records in Chinese). Public familiar with the Complainant will misunderstand that the Complainant registered the disputed domain name, which increases the possibility of confusion between the disputed domain name and the Complainant.

The Complainant's trade name, "吉尼斯"(Guinness in Chinese) trademark and "吉尼斯世界纪录" (Guinness World Records in Chinese) trademark enjoy so high reputation in China to be well known names in fact. To the contrary, the disputed domain name or the Respondent has no reputation, influence at all. It easily causes the public to associate the disputed domain name to the Complainant.

The Respondent prominently used “吉尼斯世界纪录” (Guinness World Records in Chinese) and “吉尼斯纪录” (Guinness Records in Chinese) marks on the website www.jinisijilu.com. The contents of the website all are world records adjudicated by the Complainant. This fact increases the likelihood of confusion.

The extension “.com” of the disputed domain name is launched by ICCAN and should not be included in the identification process of whether the disputed domain name is identical with the Complainant’s registered trademarks and trade name.

(2) The Respondent has no legitimate right or interest to the disputed domain name or its major part

There is no evidence to prove that the Respondent has ever registered, used trademark or trade name containing “jinisijilu”, “吉尼斯纪录” (Guinness Records in Chinese) or “吉尼斯” (Guinness in Chinese) marks, nor did the Respondent claim any civil rights to them. The Complainant never authorized/licensed the Respondent to use its marks or pictures, etc., nor to register the disputed name. The Respondent is not affiliated in any way with the Complainant. The search of official website of China Trademark Office indicated that the Respondent did not register nor apply for registration any related trademarks.

The burden of proof shifts to the Respondent once the Complainant provides a prima facie evidence showing that the Respondent lacks legitimate rights or interests.

(3) The Respondent registers or uses the disputed domain name in bad faith

To determine whether the Respondent has bad faith, various situations should be considered under the principle of a preponderance of evidence, which provided that the existing evidence indicates the possibility that the Respondent has bad faith outweighed the possibility that he has not.

As stated above, a searching via the most popular searching engine www.baidu.cn and <http://cn.bing.com/> with the term “jinisijilu” shows that most of the resulting information is related to the Complainant. The Respondent’s cyber squatting the disputed

domain name with the knowledge of the Complainant and the Complainant's famous trademark and its lack of rights clearly shows its bad faith.

The Complainant's trade name, “吉尼斯”(Guinness in Chinese) trademark and “吉尼斯世界纪录” (Guinness World Records in Chinese) trademark enjoy so high reputation in China to be well known names in fact. Without authorization from the Complainant, the Respondent, on the website www.jinisijilu.com, used the marks “吉尼斯纪录” (Guinness Records in Chinese) trademark and “吉尼斯世界纪录” (Guinness World Records in Chinese) in trademark way, and published many records adjudicated by the Complainant. Therefore the disputed domain name will be taken by the public as belonging to or affiliated to the Complainant. The content of website clearly shows that the Respondent is quite familiar with the Complainant and its business status. The Respondent also set a section specially attracting sponsors and advertisement. The purpose of the Respondent is very clear to free riding upon the reputation of the Complainant and their trademarks to attract web users so as to make unjustifiable profits from the ads.

The Respondent's conduct may not only confuse the public, but also bring business disturbance to the Complainant and threat to the good fame of the Complainant.

In accordance with Paragraph 4(b)(i) of the Policy, the Complainant requests the Panel to issue a decision to transfer the Disputed Domain Name to Complainant.

Respondent

The Respondent failed to submit a Response within the specified time period.

4. Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: “A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”

Paragraph 4 (a) of the Policy requires that the Complainant should prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- 1) 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) the Respondent has no rights or legitimate interests in respect of the domain name; and
- 3) the domain name has been registered and is being used in bad faith.

Identity or Confusing Similarity

The Complainant is a British company, publishing the well-known “Guinness World Records” in the world. The evidence shows that the Complainant registered the trademarks “吉尼斯” and “吉尼斯世界纪录” in mainland China as early as 2003. The trademarks are still within the protection period at the moment. The Panel has no problem in finding that the Complainant enjoys the trademark rights in “吉尼斯” and “吉尼斯世界纪录”.

The disputed domain name is “jinisijilu.com”. As the suffixes “.com” only indicate that the domain name is registered under this gTLD and is not distinctive, the main part of the disputed domain name is “jinisijilu”. “jinisijilu” can include two sub-parts: “jinisi” and “jilu”. No doubt the pinyin form (“jinisi”) of the Chinese trademark “吉尼斯” is identical to the first sub-part of the disputed domain name. While the Chinese trademark “吉尼斯” is completely different in formality from the first sub-part of the disputed domain name, several factors, besides formality, shall be taken into account in comparing the confusing similarity between the trademark and the main part of the domain name. Such factors include pronunciation, combination of words, exclusivity.

As such, the current Panel needs to consider whether the first sub-part of the disputed domain name “jinisi” corresponds exclusively to the Chinese trademark “吉尼斯”, not combination of any other Chinese words. The evidence shows that the Complainant has been very successful upon entering the Chinese

market; the Complainant promoted the Chinese trademarks and through various medias, including television, newspaper, magazines; through years of promotion and advertisement, the trademarks have achieved great fame and is closely associated with the Complainant. The combination of “jinisi” and “jilu” in the main part of the disputed domain name has further strengthened the possibility of correspondence between the pinyin form (“jinisijilu”) and the Chinese term (“吉尼斯纪录”), consequently, such a combination strengthened the relationship between the disputed domain name and the Complainant. By inputting the term “jinisijilu” in search engines, you are either directly led to the information or news about the Complainant, or suggestions to refer to the Complainant. For most Chinese users, the term “jinisijilu” will immediately lead to the Chinese term (“吉尼斯纪录”). Accordingly, the Panel decides that the main part of the disputed domain name (“jinisijilu”) is confusingly similar to the trademarks “吉尼斯” and “吉尼斯世界纪录”.

The Panel therefore holds that the Complaint fulfills the condition provided in Paragraph 4 (a)(i) of the Policy

Rights and Legitimate Interests

The Complainant contends that the Respondent does not have rights to or legitimate interests in the disputed domain name. The Complainant has never authorized the Respondent to use the trademarks or the disputed domain name. The Complainant's assertion is sufficient to establish a *prima facie* case under Policy 4 (a)(ii), thereby shifting the burden to the Respondent to present evidence of its rights or legitimate interests.

Under Paragraph 4 (c) of the Policy, the following are relevant examples a Panel may take as evidence of the Respondent's rights or legitimate interests to the disputed domain name:

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a

- name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
 - (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Obviously, the above circumstances do not exist in the current case. The Respondent has failed to show that the Respondent has any rights or legitimate interests in respect of the disputed domain name. No evidence has shown that the Respondent is using or plans to use the domain name for a bona fide offering of goods or services. The Respondent is not commonly known by the domain name. The evidence submitted by the Complainant further shows that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name. The act of registering the disputed domain name does not automatically endow any legal rights or interests with the Respondent.

The Panel therefore finds that the Complaint fulfills the condition provided in Paragraph 4(a)(ii) of the Policy.

Bad Faith

Under Paragraph 4 (b) of the Policy, the following are relevant examples a Panel may take as evidence of registration and use 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 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 or service on your website or location.

The Complainant publishes the world-famous "Guinness World Records" and related media offerings. This publication was introduced into China in early 1991. Since then, the Complainant has been very successful in the Chinese market. Relevant Guinness World Records programs were presented in the influential media—CCTV, reaching millions of Chinese citizens. The trademarks "吉尼斯" and "吉尼斯世界纪录" were registered in mainland China in 2003. The trademarks were widely promoted in mainland China through various means, including newspapers and magazines. Through extensive use, advertisement and active promotion, the Complainant and the trademarks have been well recognized by the Chinese consumers and the public has come to associate the trademarks as originating from the Complainant and no other. The Respondent registered the disputed domain name in 2012, much later than the registration date of the trademarks; the trademarks are not common Chinese words. The fact that the website of the disputed domain name contains the Chinese trademarks ("吉尼斯" and "吉尼斯世界纪录") and is obvious to all that the Respondent is well aware of the existence of the Complainant and the trademarks. The action of registering the dispute domain name *per se* has constituted bad faith. Actually, it is impossible to conceive of any plausible active use of the disputed domain name by the Respondent that would not be illegitimate.

The Complainant has never authorized the Respondent to use the trademarks. The act of containing the Complainant's trademarks and soliciting sponsors and advertisements in the website of the disputed domain name constitutes exactly the type of bad faith use of the disputed domain name as identified in the Policy, i.e. the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the website or other on-line location, by creating a likelihood of confusion with the Complainant's trademark as to source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

The Panel concludes that the Respondent has registered and used

the disputed domain name in bad faith. Accordingly, the Panel finds that the Complaint satisfies the condition provided in Paragraph 4(a)(iii) of the Policy.

5. Decision

Having established all three elements required under the ICANN Policy, the Panel concludes that relief should be granted. Accordingly, it is ordered that the disputed domain name “jinisijilu.com” should be TRANSFERRED from the Respondent to the Complainant GUINNESS WORLD RECORDS LIMITED.

Sole Panelist:



DATED: 21 April 2013