



# ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

— A charitable institution limited by guarantee registered in Hong Kong

(Hong Kong Office)

## ADMINISTRATIVE PANEL DECISION

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Case No.	<b>HK-1000308</b>
<b>Complainant:</b>	Sino-Forest Corporation
<b>Respondent :</b>	ShenZhen South China Network Co. Ltd.

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### 1. THE PARTIES

The Complainant is Sino-Forest Corporation of Ontario, Canada.

The Respondent is ShenZhen South China Network Co. Ltd. of the People's Republic of China.

### 2. THE DOMAIN NAME AND REGISTRAR

The disputed domain name <sino-forest.com> (the "Domain Name") is registered with OnlineNIC Inc. (the "Registrar").

### 3. PROCEDURAL HISTORY

The Complaint was filed with the Asian Domain Name Dispute Resolution Center (the "Center") on 18 August 2010. On 26 August 2010, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On the same day, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and confirming the Respondent's contact details as specified in the Complaint. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced 27 August 2010. In accordance with the Rules, paragraph 5(a), the due date for Response was 16 September 2010. The Respondent did not submit any response. Accordingly, the Center notified the Parties of the Respondent's default on 17 September 2010.

The Complainant elected to have the Complaint decided by a three member panel. However, on 20 September 2010 the Centre mistakenly appointed Gabriela Kennedy as sole panelist in the matter. The Center proceeded to appoint a three person panel,

consisting of Gabriela Kennedy, Tang Guangliang and Arthur Chang in this matter on 27 September 2010. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. **FACTUAL BACKGROUND**

The Complainant is the owner of the SINO-FOREST trade mark, which has been used by the Complainant continuously in relation to wood, paper and forestry products since 1993. The Complainant is a publically listed company and is the leading commercial forest plantation operator in China. In 2009, the Complainant generated revenue of US\$1,238.2 million and gross profit of US\$440.9 million.

The Complainant is the owner of seven trade mark registrations for SINO-FOREST in the UK, the PRC and Japan, which cover, inter alia, paper products, wood products, forestry products and trading and consultancy services. Five of the Complainant's seven trade mark registrations for SINO-FOREST are in the PRC and all seven registrations were granted prior to 2005. The Complainant has maintained a presence on the Internet since July 1996 and has registered nine domain names incorporating its SINO-FOREST mark.

The Respondent registered the Domain Name on 17 May 2005. As at the date of this Complaint, the Domain Name was pointed to a website featuring pictures of trees and forests. The website does not contain any information or disclose the identity of the Respondent or the true operator of the website, nor their connection (or lack thereof) with the Complainant.

5. **PARTIES' CONTENTIONS**

**A. Complainant**

The Complainant's contentions can be summarised as follows:

- (a) the Domain Name is confusingly similar to the Complainant's SINO-FOREST trade mark;
- (b) the Complainant has not authorised the Respondent to use the SINO-FOREST trade mark and the Respondent otherwise has no relationship with the Complainant;
- (c) the Respondent has not been commonly known by the Domain Name nor has the Respondent acquired any trade mark or service mark rights in the Domain Name;
- (d) the Respondent does not use the Domain Name in connection with a bona fide offering of goods or services and there is no evidence that the Respondent intends to use the Domain Name for legitimate non-commercial purposes.

- (e) the Respondent has registered the Domain Name due to its similarity with the Complainant's well known trade mark to: trade on the Complainant's notoriety and goodwill in the SINO-FOREST mark; to confuse, mislead, deceive and divert consumers and misdirect them to a website that is offering directly competitive products; and to intentionally tarnish and dilute the Complainant's trade marks;
- (f) the Respondent most likely knew or should have been aware of the Complainant and the Complainant's rights in the SINO-FOREST trade mark at the time of registering, and during the period of use of, the Domain Name;
- (g) that the Respondent registered the Domain Name in order to attempt to attract Internet users seeking the Complainant's official SINO-FOREST website and to create confusion as to the source, affiliation or endorsement of the website; and
- (h) registration of the Domain Name prevents the Complainant from reflecting its SINO-FOREST mark in a corresponding domain name, and is likely to disrupt the business of the Complainant.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

- (a) The fact that the Respondent has not submitted a Response does not automatically result in a decision in favour of the Complainant. However, the failure of the Respondent to file a Response may result in the Panel drawing certain inferences from the Complainant's evidence. The Panel may accept all reasonable and supported allegations and inferences following from the Complaint as true. *See Charles Jourdan Holding AG v. AAIM, WIPO Case No. D2000-0403; Entertainment Shopping AG v. Nischal Soni, Sonik Technologies, WIPO Case No. D2009-1437.*

## 6. **DISCUSSION AND FINDINGS**

Under paragraph 4(a) of the Policy, the burden of proof lies with the Complainant to show each of the following three elements:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
  - (ii) the Respondent has no rights or legitimate interests in respect of the Domain Name; and
  - (iii) the Domain Name has been registered and is being used by the Respondent in bad faith.
- (i) ***Identical or Confusingly Similar***

The Panel accepts that the Complainant has rights in respect of the SINO-FOREST trade mark on the basis of the numerous trade mark registrations

owned by the Complainant (or its subsidiaries) for SINO-FOREST, and based on the Complainant's reputation in the SINO-FOREST trade mark as evidenced, among other things, by the Complainant's sales revenue.

The Complainant has submitted evidence that its SINO-FOREST trade mark has been registered in the PRC where the Respondent is located and where the Complainant conducts a large portion of its business.

The Panel notes that the Complainant's trade mark registrations for SINO-FOREST are composite word and device marks (featuring the stylised words "SINO-FOREST" along with two Chinese characters and a tree device), and this is the form that the trade mark is displayed on the Complainant's website. While the Domain Name is therefore not identical to the Complainant's trade mark, this is of no practical significance given that it is not possible for domain names to include design elements, and Internet users seek websites by typing in familiar words or names: *Park Place Entertainment Corporation v. Mike Gorman*, WIPO Case No. D2000-0699.

The Panel considers that the word SINO-FOREST is the distinctive and dominant portion of the Complainant's trade mark. Further, the word SINO-FOREST (being part of the Complainant's company name) is used widely on the Complainant's website and is the term that consumers would likely use when referring to the Complainant. The Panel finds that the Domain Name is identical to the dominant portion of the Complainant's SINO-FOREST trade mark and internet users who are familiar with the Complainant's trade mark would be likely to assume that the Domain Name is related to the Complainant in some way. See *Mentor ADI Recruitment Ltd (trading as Mentor Group) v. Teaching Driving Ltd.*, WIPO Case No. D2003-1654.

The Panel accordingly finds that the Domain Name is confusingly similar to the SINO-FOREST mark in which the Complainant has rights, and that element 4(a)(i) of the Policy is satisfied.

**(ii) *Rights or Legitimate Interests***

Paragraph 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions states that once a complainant makes a *prima facie* case in respect of the lack of rights or legitimate interests of the respondent, the respondent carries the burden of demonstrating it has rights or legitimate interests in the disputed domain name. Where the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Panel finds that there is no evidence to show that the Respondent has any rights in any trade marks or service marks which are identical, similar or related to the Domain Name. Therefore, the Panel will assess the Respondent's rights in the Domain Name (or lack thereof) based on the Respondent's use of the Domain Name in accordance with the available record.

The Panel accepts that the Complainant has not authorised the Respondent to use the SINO-FOREST trade mark and that there is otherwise no connection between the Complainant and the Respondent. The Panel further accepts that the Respondent has not become commonly known by the Domain Name.

Accordingly the only way for the Respondent to acquire rights or legitimate rights in the Domain Name for the purposes of 4(a)(ii) of the Policy would be through use of the Domain Name for a legitimate non-commercial purposes or in connection with a bona fide offering of goods or services.

At the time of the Complaint, the Domain Name resolved to a website that contained pictures that were directly related to the Complainant's business. The website consisted solely of pictures sorted by various categories (e.g. company woodlands, maple, bamboo tree, bamboo forest), and did not contain any information that would suggest that the site was being used for legitimate non-commercial purposes. The Panel considers that it is highly unlikely that the Respondent was unaware of the Complainant and its marks when adopting the Domain Name. Conversely, it is clear that the Respondent adopted the Domain Name either to misleadingly divert customers away from the Complainant, or with the intention to create an impression of association or affiliation with the Complainant, its marks and the goodwill attached to them. Using a domain name to intentionally trade on the fame or reputation of another constitutes unfair use, and cannot amount to a bona fide offering of goods or services: *Philip Morris Incorporated v. Alex Tsytkin*, WIPO Case No. D2002-0946; *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. D2000 0847.

The Panel accordingly finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy in respect of the disputed Domain Name.

**(iii) *Registered and Used in Bad Faith***

Evidence of bad faith includes actual or constructive notice of a well known trade mark at the time of registration of a domain name by a respondent. *See Samsonite Corp. v. Colony Holding, FA 94313 (Nat. Arb. Forum Apr 17, 2000.*

Given that the Complainant (or its subsidiaries) owns five trade mark registrations for SINO-FOREST in the jurisdiction where the Respondent is located, i.e. the PRC, the Panel considers that the principle of constructive knowledge may be used to infer that the Respondent was aware of the Complainant's rights in the SINO-FOREST trade mark.

Further, the Panel considers that the Complainant's SINO-FOREST trade mark is sufficiently well-known in relation to forestry, wood and paper products internationally (especially in China, where the Complainant primarily conducts its business and where the Respondent is located), that it must be inferred that the Respondent was aware of the SINO-FOREST trade mark, and of the Complainant's rights in the Domain Name, at the time of registration of the Domain Name.

While the Panel accepts that the Respondent may have registered and used the Domain Name solely for the purpose of attracting to the website customers who the Panel accepts would be drawn to the website on the mistaken assumption that the website was authorised by or connected with the Complainant, the Panel finds that there is insufficient evidence that the Respondent has done so for commercial gain, as required under 4(b)(iv) of the Policy. Similarly, while the Panel accepts that the Respondent may have registered the Domain Name in order to prevent the Complainant (as owner of the SINO-FOREST mark) from reflecting this mark in a corresponding domain name and that the Domain Name may have been registered with a view to disrupting the Complainant's business, the Panel finds that there is insufficient evidence that the Respondent has engaged in a pattern of such conduct, or that the Respondent may be classified as a competitor of the Complainant, as required under paragraphs 4(b)(ii) and 4(b)(iii) of the Policy respectively.

Irrespective of this, the overall objective of the Policy is to prevent abusive domain name registrations, where the respondent is attempting to profit from or exploit a trade mark of another, and the grounds of bad faith set out under paragraph 4(b) of the Policy are not meant to be exhaustive. See *Martha Stewart Living Omnimedia, Inc. v. Josh Gorton*, WIPO Case No. D2005-1109 and *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003.

The Panel accepts that due to the fame of the Complainant's mark in China and the uniqueness of the word "SINO-FOREST", the Respondent knew, or at least should have known, of the Complainant's rights in the SINO-FOREST trade mark prior to registering the Domain Name. This is in itself an indicator of the type of opportunistic bad faith that the Policy is designed to prevent. In these circumstances the Panel finds that there is no basis on which to infer that the Respondent has used the Domain Name in any manner or for any purpose otherwise than in bad faith.

The Panel therefore finds that the Respondent has registered and used the Domain Name in bad faith, and paragraph 4(a)(iii) of the Policy has been satisfied.

## 7. **DECISION**

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name <sino-forest.com> be transferred to the Complainant.

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Gabriela Kennedy  
Presiding Panelist

Tang Guangliang  
Panelist

Arthur Chang  
Panelist

Date: 11 October 2010