



Asian Domain Name Dispute Resolution Centre

hong kong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-2101422
Complainant:	China United Network Communications Group Co. Ltd
Respondent:	Johnny lai
Disputed Domain Name(s):	<u-magic.com>

1. The Parties and Contested Domain Name

The Complainant is China United Network Communications Group Co. Ltd (“**Complainant**”), of 21 Financial Street, Xicheng District, Beijing, China.

The Respondent is Johnny lai (“**Respondent**”), of 798, Guangfu Road, Hsinchu City.

The domain name at issue is <u-magic.com> (“**disputed domain name**”), registered by Respondent with GoDaddy.com, LLC. of 14455 North Hayden Rd. Suite 219 Scottsdale, AZ 85260.

2. Procedural History

The Complainant filed the Complaint with the Asian Domain Name Dispute Resolution Centre (ADNDRC) (Hong Kong Office) on 25 January 2021. On 26 January 2021, ADNDRC sent a New Case Notification email to Godaddy.com, LLC, the registrar of the disputed domain name (“**Registrar**”).

The Registrar responded by email on 26 January 2021 disclosing details of the registrant of the domain name at issue and that the domain name at issue was created on 4 March 2010. A Notification of Deficiencies of the Complaint was sent by ADNDRC to the Complainant on 8 February 2021. The Complainant amended the Complaint accordingly and the duly amended Complaint was sent to ADNDRC on 8 February 2021.

The Respondent was formally notified of the Complaint on 9 February 2021 and was told to submit a Response on or before 1 March 2021 pursuant to Article 5 of the Rules. ADNDRC indicated to the parties on 2 March 2021 that it did not receive a Response from the Respondent.

ADNDRC informed the parties on 8 March 2021 that Ms. Dora Chow had been appointed as the Panelist. In accordance with the Rules, a decision would be rendered by the Panelist on or before 22 March 2021 unless there is exceptional circumstance.

The Panelist issued the Administrative Panel Order No.1 on 11 March 2021, giving the Complainant 7 days to clarify certain issues in the Complaint and if it deemed appropriate, amend the Complaint; the Respondent would have 7 days to file a Response and the deadline to render the decision to be extended by 14 days. The Complainant submitted a revised Complaint on 15 March 2021 and the Respondent did not file any Response.

3. Factual background

In order to protect the brand, the Complainant in 2003 began to submit to the State Trademark Office "u-magic" series of trademark applications.

Up to now, the Complainant has the exclusive right to use the trademark "u-magic" in the Class 9, Class 37 and other fields. The details are as follows:

trademark	Application date	Trademark number	Class
<i>U-Magic</i>	2003-04-03	3512131	9
<i>U-Magic</i>	2006-08-16	5545743	9
<i>U-Magic</i>	2006-08-16	5546170	37
<i>U-Magic</i>	2006-08-16	5545757	41
<i>U-Magic</i>	2009-10-07	5545946	42

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

The disputed domain name(s) is/are identical or confusingly similar to a trademark or service mark in which the Complainant has rights:

- i) The disputed domain name(s) is/are identical or confusingly similar to a trademark or service mark in which the Complainant has rights:

China United Network Communications Group Co., Ltd. was founded in 1994, which has branches in 31 provinces (autonomous regions and municipalities directly under the Central Government) in China and many foreign countries and regions. The complainant owns a modern communication network covering the whole country and accessing the world. The complainant mainly engages in fixed communication services, mobile communication services, domestic and international communication facilities services, data communication services, network access services, various value-added telecommunications services, and system integration services related to communication and information services.

The complainant is the only Chinese telecom operator listed on the stock exchanges of New York, Hong Kong, and Shanghai and the only central State-owned enterprise (SOE) to adopt group-wide mixed-ownership reform among all pilot-run central SOEs. It ranked at No. 262 in Fortune 500 in 2019.

Due to the fierce competition among operators, the profit space of the traditional voice service is compressed. Therefore, operators hope to increase the user's network utilization rate by developing wireless network for the third party.

Thus, mobile value-added services have emerged. Twenty years ago, traditional smartphones (typically running Palm, Windows Pocket PC, Symbian) were not widely used due to their relatively high price, limited battery life, and the need for a cable to connect to a computer. Qualcomm BREW overcomes the drawback of appeals. BREW is thin, fast, open, scalable, secure and can run on low-end mobile phones, so it has been favored by many operators around the world since its launch.

The complainant has introduced BREW technology since 2003, and named the mobile value-added service based on this technology as U-Magic, which has achieved great success in the market. "U-Max" is the unified brand of data value-added service launched by the complainant. In addition to "U-Map", the brand also has "U-Info", "U-Magic", "U-Mail", "U-Net" and "Uni-Info". And recently, the complainant named its first 5G phone "U-Magic" and released a new product launch.

As can be seen from the foregoing, the complainant likes to name its brand with the habit of "U-" + noun. The complainant believes that " u-magic " has formed a unique corresponding relationship with the complainant objectively, and this conclusion was further confirmed by the translation software. Apart from the suffix ".com ", the disputed domain name " u-magic.com " is mainly identified as " u-magic ", and "-" doesn't have any meaning. The remainder of the name is identical to the complainant's core trademark " u-magic ". In this case, the complainant's trademark "U-Magic" has already gained a high profile and the major features of the trademark can be identified in the disputed domain name, which, in the opinion of the complainant, is likely to cause confusion among consumers.

- ii) The Respondent has no rights or legitimate interests in respect of the domain name(s):

The complainant investigated on the official website of China Trademark Office in the name of the respondent " Johnny lai " in this case, but no trademark application was found under the name of the respondent.

According to complainant's feedback, Complainant has never directly or indirectly authorized respondent to use the "u-magic" trademark and domain name in any form.

The respondent is referred to as " Johnny lai ", and obviously it is impossible for him to have the relevant right of name with respect to "u-magic".

In summary, the respondent does not have any legitimate interest in the domain name.

- iii) The disputed domain name(s) has/have been registered and is/are being used in bad faith:

The domain name in question "u-magic.com" was registered on March 4, 2010, well after the complainant filed and used the trademark "u-magic" .

In the opinion of the Complainant, in determining whether the Respondent has bad faith, full consideration should be given to the originality, distinctiveness and popularity of the name or mark associated with the Complainant.

The stronger the originality and significance of the logo, the smaller the chance of its coincidence, and the higher the popularity of the logo, it means that the logo contains huge commercial value, and the intention of others to seize the domain name to obtain improper interests is stronger.

As mentioned above, the complainant likes to name its brand with the habit of "U-" + noun. "U" represents the meaning of the complainant (China Unicom), and "-" represents its association. The complainant used the combination of "U - " + "MAGIC" in mobile value-added business for the first time, and it has accumulated a high reputation after long-term use and a lot of publicity. Combined with the complainant's other brands, such as "U-Info", "U-Mail", "U-Net", "Uni-Info", etc., The Respondent's exposure to any of these may have exposed him to the "U-Magic" brand and considering that the complainant is a mobile communication operator whose brand communication is not restricted by geographical, cultural, industrial and other factors, The Complainant concluded that the Respondent could easily obtain the Complainant's brand. The Complainant inferred that the Respondent was a programmer in the IT industry by inquiring the history of the domain name in dispute(Annex 10: Screenshot of history usage in 2010, no usage since then).As mentioned above, The complainant has introduced BREW technology since 2003, and named the mobile value-added service based on this technology as "U-Magic" ,Therefore, it is easy to infer that the respondent has access to the complainant's brand.

There is little chance of a contested domain name being coupled to it, Complainant contended that Respondent knew or should have known about the trademark "U-MAGIC" and that its application for the domain name was done in bad faith. For the above purposes only, the Complainant believes that the act of applying for a domain name by the Respondent is subject to clause 4.b of the Policy, namely, the fact that the disputed domain name has been "maliciously registered".

Under normal circumstances, the registration of a domain name is for the use of the domain name, including the registrant or permit others to normal use or reasonable transfer and other acts. From the perspective of "consistency of motive and effect", if the respondent registration of the disputed domain name does not have "bad faith", then he should have the "good faith" use of the disputed domain name consistent with the "motive".

At the same time, the complainant believes that "malicious use" can be either active or passive in view of the fact that the disputed domain name registration has not been used normally up to now. As for the former, it mainly refers to the active use of the registered domain name by the registrant or the assignee in commercial activities or cultural publicity and other fields; As for the latter, the act of "registering domain name without using" itself can be regarded as a kind of "passive use". The immediate effect of passive use is to prevent complainants from registering the same domain name using the same letter combination. The complainant contends that this is consistent with the circumstances described in article 4, paragraph b (ii), of the UDRP.

To sum up, the main identification part of the disputed domain name is very similar to the complainant's "u-magic" trademark, which is enough to cause confusion among consumers; The respondent does not have a legitimate interest in the disputed domain name; And the respondent has bad faith in the registration or use of the disputed domain name. The behavior of the respondent has seriously violated the legitimate rights and interests of the complainant. In accordance with the relevant provisions and for the above reasons, the Complainant requests the panel to determine that the domain name in question "u-magic.com" shall be transferred to the Complainant.

B. Respondent

The Respondent did not file a Response, nor did he file a response to the revised Complaint.

5. Findings

The Complainant submitted copies of its "U-Magic" Chinese trademark certificates, showing their respective effective dates. Four out of five "U-Magic" registrations took effect earlier than the creation of the disputed domain name on 4 March 2010. The dates of the following "U-Magic" registrations are as follows:

trademark	Trademark number	Class	Date of Registration	Expiration date
<i>U-Magic</i>	3512131	9	2004-09-14	2024-09-13
<i>U-Magic</i>	5545743	9	2009-11-21	2029-11-20
<i>U-Magic</i>	5546170	37	2010-03-28	2030-03-27
<i>U-Magic</i>	5545757	41	2009-10-07	2029-10-06
<i>U-Magic</i>	5545946	42	2009-10-07	2029-10-06

The ICANN Uniform Domain Name Dispute Resolution Policy (“the Policy”) provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

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

A) Identical / Confusingly Similar

The disputed domain name was registered by the Respondent on 4 March 2010 and the earliest “U-Magic” trademark registration belonging to the Complainant took effect on 14 September 2004. The disputed domain name is identical to the Complainant’s “U-Magic” - the mobile value-added service based on the BREW technology introduced in 2003. For all practical purposes, it has been clearly established that “.com” will not be considered while comparing the disputed domain name and the Complainant’s trade mark. “U-Magic” is a made up word and is part of the Complainant’s series of trade marks all starting with the prefix “U”. The Complainant’s series of “U” marks includes “U-Max”, “U-Info”. “U-Net” and “U-Mail”. “U-Magic” is also the Complainant’s mobile value-added service based on BREW technology.

The Panel finds the Respondent’s domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights under Paragraph 4 (a) (i) of the Policy.

B) Rights and Legitimate Interests

The Respondent did not file any Response to the Complaint notified on 9 February 2021 and the revised Complaint filed on 15 March 2021. The Panel is satisfied that the Respondent has no rights or legitimate interests in respect of the disputed domain name under Paragraph 4 (a) (ii) of the Policy.

C) Bad Faith

According to Paragraph 4 (a) (iii) of the Policy, the Complainant must prove that the disputed domain name was registered in bad faith and that it was being used by the Respondent in bad faith.

On the use of the disputed domain name by the Respondent, the Complainant submitted evidence namely (a) the appearance of the disputed domain name in the banner of a blog which was in use from 1 January 2010 to 8 April 2010 and (b) the appearance of 35 times from 23 December 2002 to 8 June 2019 according to the Internet Archive, Way Back Machine. Since the Respondent did not register the disputed domain name until 4 March 2010, the Panel can only guess that the disputed domain name had been registered by an unknown third party from 23 December 2002 up to 3 March 2010. The Panel can only conclude that the disputed domain name had been used by the Respondent less than 35 times since its registration on 4 March 2010 to 8 June 2019, the date shown in the Way Back Machine. The Panel therefore finds that the Respondent was passively holding the disputed domain name.

The Complainant also submitted that it had tried to contact the Respondent by calling the telephone no of the Respondent. The Complainant was put through to the Second Precinct of the Police department of Hsinchu City, Taiwan Province. The person answering the phone said there was no one there called “Johnny Lai”.

It has been well established by many decided cases under the Policy that the inactivity or the passive holding of a domain name can also amount to “use in bad faith”.

For instance, the Presiding Panelist in WIPO decision of Telstra Corporation Ltd v. Nuclear Marshmallows (D2000-0003) said in paragraph 7.9 “... the concept of a domain name “being used in bad faith” is not limited to positive action; inaction is within the concept. That is to say, it is possible, in certain circumstances, for inactivity by the Respondent to amount to the domain name being used in bad faith.” He went on to say in paragraph 7.10 “... the point is that paragraph 4 (b) [of the Policy] recognizes that inaction (e.g. passive holding) in relation to a domain name registration can, in certain circumstances, constitute a domain name being used in bad faith. Furthermore, it must be recalled that the circumstances identified in paragraph 4 (b) are “without limitation” – that is, paragraph 4 (b) expressly recognizes that other circumstances can be evidence that a domain name was registered and is being used in bad faith.”

Having considered that:

- (a) the Complainant’s “U-Magic” is a made up word;
- (b) the Complainant is a listed company in Hong Kong, Shanghai and New York and it was listed 262 in Fortune 500 in 2019;
- (c) the Complainant obtained trademark registration of “U-Magic” as early as 2004 in China well before the registration of the disputed domain name by the Respondent;
- (d) “U-Magic” is part of a series of trademarks belonging to the Complainant all sharing the prefix “U”;
- (e) the Respondent has given an incorrect telephone number in breach of the registration agreement; and

- (f) the Respondent has failed to respond to the Complaint and the revised Complaint; the Panel finds the passive holding of the disputed domain name by the Respondent amounts to bad faith.

The Panel is satisfied that the disputed domain name has been registered by the Respondent and is being used in bad faith under Paragraph 4 (a) (iii) of the Policy.

6. Decision

To conclude, the Panel has found sufficient proofs to satisfy Paragraph 4 (a) (i), 4 (a) (ii) and 4 (a) (iii) of the Policy. The Panel therefore orders that the remedy as sought by the Complainant is to be granted. The disputed domain name <u-magic.com> is to be transferred to the Complainant.



Dora Chow
Panelist

Dated: 2 April 2021