



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

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| Case No. | HK-1600891 |
| Complainant: | ASSAB Pacific Pte.Ltd. |
| Respondent: | Chen Yan Qing |
| Disputed Domain Name(s): | <assab-tool.com> |

1. The Parties and Contested Domain Name

The Complainant is ASSAB Pacific Pte. Ltd., of 8 Cross Street, #27-04/05 PWC Building Singapore 048424.

The Respondent is Chen Yan Qing, of Dong Guan Shi Chang An Zhen Shang Sha Ming He Dian Zi Guang Chang B301.

The domain name at issue is < assab-tool.com >, registered by Respondent with Foshan YiDong Network Co., Ltd., of Room 1801, 18th Floor, No. 1 of Jun Ning Building, No.213 Fu Ning Road, Foshan City, Guangdong Province.

2. Procedural History

The Complaint was filed with the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (the “Centre”) on August 29, 2016 and the Complainant chose a sole panelist to review this case in accordance with the Uniform Domain Name Dispute Resolution Policy (“the Policy”) which was adopted by the ICANN and came into effect on October 24, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”) which became effective on September 28, 2013 and the Supplemental Rules thereof which came into effect on July 31, 2015.

On August 30, 2016, the Centre confirmed the receipt of the Complaint and Annexes thereof, and transmitted by email to Foshan YiDong Network Co., Ltd. (the Registrar of the domain name) a request for registrar verification in connection with the domain name at issue. On the same day, the Registrar made the verification to the Centre, and pointed out that the language used in the Registration Agreement is Chinese.

On September 5, 2016, the Centre confirmed the receipt of the case filing fee from the Complainant, and sent the Complainant the Notification of Deficiencies of the Complaint to request that submitting the Complaint in Chinese on or prior to September 10, 2016. On September 8, 2016, the Complainant submitted to the Centre the revised Complaint

Form as well as a Supplemental Complaint requesting that English be used as the language of the administrative proceeding.

On September 9, 2016, the Centre sent the formal Complaint Notice to the Respondent and requested the Respondent to reply within 20 days (on or prior to September 29, 2016) in accordance with the Rules and Supplement Rules, and forwarded the Complaint, all the Annexes thereof as well as the language request from the Complainant. The procedures for this case were formally commenced on September 9, 2016.

On September 30, 2016, the Centre issued a Default Notice and confirmed that the Respondent did not file a formal reply with the Centre, within the required time limit for filing a reply.

On September 30, 2016, the Centre sent a Notice of Panelist Appointment to Mr. Matthew Murphy as Panel candidate for the current case, and the Panel candidate considered that it was properly constituted and submitted the acceptance notice as well as a statement of impartiality and independence. On October 3, 2016, the Centre notified both parties and the Panel Mr. Matthew Murphy by email that Mr. Matthew Murphy be the sole panelist for arbitrating this case. The Centre then formally transferred the case to the Panelist. The Panelist agreed to deliver his decision with respect to the Disputed Domain Name on or prior to October 17, 2016.

3. Factual background

For the Complainant

The Complainant, ASSAB Pacific Pte. Ltd., claims that, it was formed in 1945 to market high quality tool steel from Sweden and is renowned for its quality standards. With its headquarters in Singapore, the Complainant claims that it operates around 50 offices in Asia Pacific supplying steel, metallurgical tooling services and technical knowhow. It further claims that, through anchoring the distribution network for Uddeholm, a well known tool steel company, they together service leading multinational companies across practically all key industrial sectors in more than 90 countries.

The Complainant claims that in the Greater China region, it is called Yi Sheng Bai (一胜百) which means “One beats One Hundred” and underlines its position as an industry leader. It claims that its history in China can be dated back more than 60 years, and its tool steel has been distributed in southern China in the mid 1950s. Furthermore, the Complainant claims that it established its first wholly owned outlet in Shenzhen in early 1990s; and since then it has grown to be the leading foreign distributor of quality tool steels and services in China, with more than 500 employees in 22 locations and 18 affiliates across China.

In addition, the Complainant claims that it holds trademark registrations for the “ASSAB” trademark and other related trademarks (“ASSAB trademark”) in various jurisdictions worldwide. Among the ASSAB trademarks, the Complainant registered its “ASSAB” mark in class 6 in Hong Kong on July 13, 1957, under Registration No. 19570513. It also owns many ASSAB trademarks in Mainland China, such as No. 1055408 for the “一勝百 ASSAB” trademark in class 6, registered on July 14, 1997.

For the Respondent

The Respondent, Chen Yan Qing, is an individual allegedly residing or working at B301, Dian Zi Guang Chang, Shang Sha Ming He, Changan Town, Dongguan City, 523800 China. The Respondent registered the Disputed Domain Name on August 5, 2013. The Respondent did not file any Reply or other materials with the Centre.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights:

The Complainant claims that it owns prior trademark rights in the "ASSAB" trademark in various jurisdictions worldwide. For instance, it obtained its registration for the "ASSAB" trademark in class 6 in Hong Kong (Reg. No. 19570513) on July 13, 1957, long before the registration date of the Disputed Domain Name.

The Complainant claims that the Disputed Domain Name <assab-tool.com> contains two elements, "assab-tool" and top-level domain ".com". Since the top-level ".com" does not have trademark significance and the word "tool" is the product name which is not distinctive in itself, the only distinctive part of the Disputed Domain Name should be considered to be "assab" and it is identical to the Complainant's "ASSAB" trademark. Thus, the Complainant contends that the Disputed Domain Name contains its "ASSAB" trademark as well as its trade name in its entirety, and such resemblance will no doubt mislead consumers into believing that the website is operated by or associated with the Complainant.

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

The Complainant claims that the Disputed Domain Name was registered by the Respondent long after most of the application and registration dates of its ASSAB trademarks. It contends that its ASSAB trademarks has acquired significant recognition worldwide after years of extensive use. The Complainant claims that it has no prior connection with the Respondent, nor has it authorized the Respondent to use its trademark in the Disputed Domain Name. Since the mark ASSAB is not a commonly used English term and there is no evidence showing that the Respondent has been commonly known by the Disputed Domain Name, the Complainant considers that it indicates the Respondent's deliberate attempt to take advantage of the "ASSAB" mark for commercial gain.

- iii. The disputed domain name has been registered and is being used in bad faith:

The Complainant claims that the bad faith can be shown as follows: 1) the long history and high degree of fame enjoyed by the Complainant and its trademarks in the world, including in China; 2) the filing dates of the Complainant's marks long before the registration date of the Disputed Domain Name; 3) the

incorporation of the Complainant's famous trademark in its entirety in the Disputed Domain Name; 4) the various additional infringing domain names associated with the Respondent targeting the Complainant's ASSAB trademark; 5) the striking similarity of the Complainant's and the Respondent's websites; 6) the false and misleading claims regarding its history on the Disputed Domain Name website; and 7) the use of the Complainant's Chinese mark “一胜百 (ASSAB in Chinese)” in the Respondent's Chinese company name. The Complainant also mentions that in a recent UDRP case, where a disputed domain name <china-assab.com> registered by using the same contact email address (pig620@139.com) as that of the Disputed Domain Name, which is similar to the Disputed Domain Name herein, was transferred to the Complainant.

B. Respondent

The Respondent did not submit any Reply.

5. Findings

The ICANN Uniform Domain Name Dispute Resolution 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.

Language of the Proceedings

The Complaint was filed with the Centre in English, whereas the Registrar of the Disputed Domain Name confirmed to the Centre that the language used in the Registration Agreement is Chinese. When the Complainant was requested to submit the Complaint in Chinese, the Complainant submitted a request that English be the language of the administrative proceedings instead, based on the following reasons: 1) the Complainant is a foreign company which is not familiar with the Chinese language; 2) it would cause tremendous costs, time and unfair prejudice to the Complainant by requiring it to provide Chinese translations of all of the evidence; and 3) the Disputed Domain Name <assab-tooling.com> is in the English language and it consists of a trademark “ASSAB” and a word “tool”. To further support its language request, the Complainant also lists numerous UDRP precedents as supportive material, such as D2006-0432, D2010-1589, D2010-2170, D2010-1569 and so on.

As is stated in a previous case, when deciding “whether to allow the proceedings to be conducted in a language other than the language of the Registration Agreement, and to require the Complainant in an appropriate case to translate the Complaint into the language of that agreement, the Panel must have regard to all ‘the relevant circumstances’”. And such circumstances include “whether the Respondent is able to understand and effectively communicate in the language in which the Complaint has been made and would suffer no real prejudice, and whether the expenses of requiring translation and the delay in the

proceedings can be avoided without at the same time causing injustice to the parties” - *See WIPO Case SWX Swiss Exchange v. SWX Financial LTD, D2008-0400.*

Accordingly, the Panel notes circumstances that may affect the determination of the language of the proceedings in the current case as follows:

- (1) The Respondent had been notified of the Complaint against it and invited to provide comments on the Complainant’s language request through email communications written in both Chinese and English by the Centre.
- (2) The Respondent did not raise any objection with respect to the Complainant’s language request, nor make any comments.
- (3) The Disputed Domain Name contains English words.
- (4) The Complainant, as a foreign company, is not able to understand Chinese at all, and most of the materials presented thereby are in English, which would take a lot of time and additional cost for such Chinese translation, and therefore, a delay in the proceedings will be inevitable.

Based on the above, the Panel considers that: it is reasonable to infer that the Respondent probably has the ability to read and understand English, and therefore, should be able to understand English used in the proceedings. Even if the Respondent might have any difficulty of understanding English, since all the email communications were written in both Chinese and English, the Respondent must have been fully aware of the language request raised by the Complainant, and should have understood what would happen if it was determined to conduct the proceedings in English. However, with sufficient time and opportunity to comment on or object to such language request, the Respondent was completely silent and did nothing.

Thus, upon weighing all relevant circumstances, the Panel considers that it is appropriate to exercise its discretion and conduct the proceedings in English.

A) Identical / Confusingly Similar

The Complainant has established its right to the “ASSAB” trademarks by submitting trademark registration certificates and records from various jurisdictions, such as Hong Kong, Mainland China and so on.

There is no doubt that the Disputed Domain Name < assab-tool.com > completely incorporates the Complainant’s “ASSAB” trademark which is the only distinctive part of the whole Disputed Domain Name, and such incorporation makes the Disputed Domain Name confusingly similar with the Complainant’s trademark. With respect to the added word “tool”, since the website located at the address of the Disputed Domain Name has been set up to be an associated website of the Complainant, given that the Complainant’s logo and introduction have been substantially copied, and that the business conducted at the website seems to be one of engaging in the sale of tool steel and so on; it must be concluded that the word “tool” in the Disputed Domain Name can only be recognized as an indication of the content of the Disputed Domain Name website, and it does not alleviate any possible confusion when the Disputed Domain Name is considered as a whole. As to the hyphen “-” added between the words of the Disputed Domain Names and the gLTD “.com” attached at the end thereof, such additions do not confer to the whole a new meaning involving the absence of risk of confusion with the trademarks - *See WIPO Case France Telecom SA v. France Telecom Users Group, D2000-0074.*

In conclusion, the Panel finds that the Complainant has satisfied Paragraph 4(a)(i).

B) Rights and Legitimate Interests

As the rights owner of the “ASSAB” trademark, the Complainant has confirmed that it has no prior connection with the Respondent, nor has authorized the Respondent to use its trademark in the Disputed Domain Name.

When it comes to determine whether the Respondent has any legal right and interest to the Disputed Domain Name or not, the mere registration of the Disputed Domain Name by the Respondent itself is not sufficient to prove that it owns legal right and interest thereof; otherwise, “all registrants would have such rights or interests, and no complainant could succeed on a claim of abusive registration” - *See: Adobe Systems Incorporated v. Domain OZ, WIPO Case No.: D2000-0057*.

The Panel notes that the Respondent failed to prove and there is no evidence indicating that it has been commonly known by the Disputed Domain Name, nor has making a legitimate noncommercial or fair use thereof. On the contrary, the Complainant pointed out with screenshots of the website located at the address of the Disputed Domain Name, that, the Disputed Domain Name has been resolving to a website that contains logos and introductions that are identical with (or very similar to) those on the Complainant’s official websites <www.assab.com> and <www.assab-china.com>. Such high similarity between the two in terms of website logo and introduction will certainly given consumers the wrong impression that the operator of the Disputed Domain Name website may be associated with the Complainant, causing obvious confusion. Obviously, using the Disputed Domain Name to attract visitors to a website that copies the look and feel of the Complainant’s websites and business, does not count for any “bona fide offering of goods or services”. Not to mention, the operator of the Disputed Domain Name website called itself Yi Sheng Bai Mould (Dongguan) Co., Ltd, which the distinctive part “Yi Sheng Bai(一胜百)” therein is not a common Chinese term and happens to be exact the same as the Chinese trade name and Chinese trademark of the Complainant. Therefore, such use is an indication of bad faith use.

In conclusion, the Panel finds that the Complainant has satisfied the Paragraph 4(a)(ii).

C) Bad Faith

In considering bad faith, the following issues need to be considered:

- (1) the registration dates of the Complainant’s trademarks is much earlier than that of the Disputed Domain Name;
- (2) the nature of the Complainant’s core business, which is tool steel;
- (3) the fame of the Complainant and its “ASSAB” trademarks accumulated in the steel industry;
- (4) In a reverse WHOIS search using the Respondent’s email pig620@139.com conducted by the Complainant, the said email address was found in association with 82 domain names;
- (5) The same result shows the Respondent registered three other domain names that contain the Complainant’s trademark: <assab-17.com.cn>, <assab-cn.com> and <assab-zg.cn> as well;

(6) the way the Disputed Domain Name was used, which was to attract visitors to a misleading site which copies the Complainant's website content and logo, without authorization from the Complainant.

Apart from issues (1)-(3) provided above which indicates the Respondent's prior knowledge the Complainant's trademark while registering the Disputed Domain Name, it can also be seen from the issues (4)-(5) that the Respondent has a pattern of registering numerous domain names, including those containing other parties' trademarks. With respect to the four domain names incorporating the Complainant's trademarks, such as <assab-tool.com>, the way the Respondent combined the "assab" and the corresponding suffix together actually indicates that he/she must almost certainly be aware of the Complainant's "ASSAB" trademark and its value when he/she registered the Disputed Domain Name. Accordingly, it is reasonable for the Panel to infer that the Respondent must have been aware of the Complainant and its "ASSAB" trademark whilst registering the Disputed Domain Name, and such registration with prior knowledge of the Complainant's trademark, indicates bad faith registration.

Moreover, such bad faith registration is further supported by the way the Disputed Domain Name was used as it is stated in the factor (6) above: when internet users were attracted to and clicked the Disputed Domain Name due to the confusingly similarity between the said domain name and the Complainant's trademarks, they would be immediately led to the misleading website discussed above. The fact that such website has been unauthorized using the Complainant's trademarks and copying the Complainant's history and introduction to promote itself, would probably mislead consumers to believe that they were visiting the website of an affiliate of the Complainant, or the Complainant itself. Thus, the Panel concludes that the Disputed Domain Name has been used in bad faith as well.

In conclusion, the Panel finds that the Complainant has satisfied the Paragraph 4(a)(iii).

6. Decision

Pursuant to Paragraph 4(i) of the Policy and Article 15 of the Rules, the Panel orders that the disputed domain name < assab-tool.com > be transferred to the Complainant.

Matthew Murphy
Sole Panelist

Dated: October 12, 2016