



Asian Domain Name Dispute Resolution Centre
hongkong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1600887
Complainant:	ASSAB Pacific Pte. Ltd.
Respondent:	深圳市一胜百模具有限公司 Shenzhen Assab Tooling Co., Ltd.
Disputed Domain Name(s):	<assab-tooling.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 深圳市一胜百模具有限公司 Shenzhen Assab Tooling Co., Ltd., of Chengde Hebei, Chengde 068350, China.

The domain name at issue is < assab-tooling.com >, registered by the Respondent with Guangdong JinWanBang Technology Investment Co., Ltd., of 17th Floor, Guo Ji Yin Hang Zhong Xin, No. 191, Dong Feng Xi Road, Guangzhou, China.

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 Annexures thereof, and transmitted by email to Guangdong JinWanBang Technology Investment 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 case fee from the Complainant, and sent the Complainant the Notification of Deficiencies of the Complaint to request that amending the Respondent's information in the Complaint Form and submitting the Complainant 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 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 the same day, 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 14, 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 the Asia Pacific supplying the 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 have been distributed in Southern China from 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 owns trademark registrations for the “ASSAB” trademark and other related trademarks (“ASSAB trademarks”) in various jurisdictions worldwide. Among the ASSAB Marks, the Complainant registered its No. 19570513 “ASSAB” trademark in class 6 in Hong Kong in July 13, 1957 under number 19570513. It also owns many ASSAB trademark registrations in Mainland China, such as No. 1055408 for “一勝百 ASSAB” in class 6 registered on July 14, 1997.

For the Respondent

The Respondent, 深圳市一胜百模具有限公司 Shenzhen Assab Tooling Co., Ltd., a company at Chengde, Hebei, Chengde 068350 China. The Respondent registered the Disputed Domain Name on January 12, 2011. 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-tooling.com> contains two elements, "assab-tooling" and top-level domain "com". Since the top-level ".com" does not have trademark significance and the word "tooling" is the products name which is not distinctive in itself, the only distinctive part of the Disputed Domain Name should 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 application and registration dates of its ASSAB Marks. It contends that its ASSAB Marks has acquired significant recognition worldwide after years of extensive use. The Complainant claims that it has no prior connection with the Respondent, nor authorizing the Respondent to use its mark 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 based on the sufficient grounds 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 striking similarity of the Complainant's and the Respondent's websites; 5) the false and misleading claims regarding its history on the Disputed Domain Name website; and 6) 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 (HK-1600872), a disputed domain name <china-assab.com> 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 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 “tooling”. 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 it 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) Both the Disputed Domain Name and the Disputed Domain Name Website 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 language ability of 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 of 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 that what would happen if the proceeding is determined to be conducted in English. However, with sufficient time and opportunity to comment on or object to such language request, the Respondent did not object and did nothing.

Thus, upon weighing relevant circumstances from both sides, the Panel considers that it would be 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 registrations 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-tooling.com > completely incorporates the Complainant’s “ASSAB” trademark which is the distinctive part of the Disputed Domain Name viewed as a whole, and such incorporation makes the Disputed Domain Name confusingly similar with the Complainant’s trademark. With respect to the added word “tooling”, since the Disputed Domain Name website appears to be an “official website” of a company engaging in products such as tool steel and so on, the word “tooling” in the Disputed Domain Name can only be recognized as indication of the content of the website located at the Disputed Domain Name, other than possessing any distinctiveness therein. On the other hand, it is worth of mentioning that the “ASSAB” trademark of the Complainant is actually a brand that is well known for “tool” steel products, and it is selling similar products as those of the website connected to the Disputed Domain Name. In other words, the descriptive term “tooling” added after the Complainant’s mark in the Disputed Domain Name, contributes nothing to distinguish the Disputed Domain Name from the Complainant’s mark, but merely describes the nature of

the Complainant's core business/brand. 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 the Paragraph 4(a)(i).

B) Rights and Legitimate Interests

As the rights owner of the "ASSAB" trademarks, the Complainant has confirmed that it has no prior connection with the Respondent in any way, nor has authorized the Respondent to use its trademarks 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 Disputed Domain Name website that, the Disputed Domain Name has been resolving to a website that is almost identical to the Complainant's official websites <www.assab.com> and <www.assab-china.com> in every aspect, from the webpage design, layout of the website content, company history and introduction text. Obviously, using the Disputed Domain Name to attract visitors to a copycat website does not count for any "bona fide offering of goods or services". Not to mention, such use is also 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 looking at bad faith, the following issues are considered:

- (1) the registration date of the Complainant's trademark 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 business;
- (4) the way the Disputed Domain Name is composed, which combines the Complainant's "ASSAB" trademark with a descriptive term that describing the nature of the Complainant's business/brand;
- (5) the way the Disputed Domain Name was used, which was to attract visitor to a copycat website that duplicates the Complainant's website design and content, without authorization thereof.

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 based on the issues (1)-(4) above, 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 issue (5) 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 immediately enter the copycat website mentioned above. The fact that such copycat website has been unauthorized using the Complainant’s trademarks, website design and content to promote itself, would no doubt mislead consumers to believe that they were visiting the “real” website. 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-tooling.com > be transferred to the Complainant.

Matthew Murphy
Sole Panelist

Dated: October 12, 2016