



**(Hong Kong Office)**

**ADMINISTRATIVE PANEL DECISION**

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<b>Case No.</b>	<b>HK-1400646</b>
<b>Complainant:</b>	<b>SGG LISCO LLC</b>
<b>Respondent:</b>	<b>Ying Yihong</b>
<b>Disputed Domain Name:</b>	<b>&lt;spalding-ch.com&gt;</b>

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**1. The Parties and Contested Domain Name**

The Complainant is SGG LISCO LLC of 3330 Cumberland Blvd Suite 800 Atlanta, Georgia 30339, USA.

The authorized representative of the Complainant is Beijing Lusheng ( Shanghai) Law Firm, Room 536, 207 North Urumqi, Jing' An District, Shanghai, China 200040.

The Respondent is Ying Yihong of 3330 Cumberland Blvd Suite 800 Atlanta, Georgia 30339, USA.

The domain name at issue is <spalding-ch.com>.The domain name is registered with Go Daddy.com, LLC of 14455 North Hayden Road, Suite 219, Scottsdale AZ 85260, USA.

**2. Procedural History**

On September 18, 2014 the Complaint was filed with the Asian Domain Name Dispute Resolution Centre ("the Centre"). The Centre received the appropriate case filing fee by bank transfer on September 18, 2014.

On September 22, 2014, the Centre transmitted by email to Go Daddy.com, LLC a request for registrar verification in connection with the registrant of the disputed domain name.

On September 23, 2014, Go Daddy.com, LLC transmitted by email to the Centre its verification response that the registrant of the disputed domain was Ying Yihong of 3330 Cumberland Blvd Suite 800 Atlanta, Georgia 30339, USA, that the registrant's email address was nocontactsfound@secureserver.net and that the email address for the Administrative Contact was spaldingch@yahoo.com.

The Centre 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").

On September 23, 2014 the Complaint and its annexures were served by email on the Respondent at nocontactsfound@secureserver.net, spaldingch@yahoo.com and postmaster@spalding-ch.com together with the Written Notice of Complaint dated September 23, 2014 notifying the Respondent that the proceeding commenced on September 23, 2014 and that the due date for the submission of the Response was October 13, 2014.

A Response was not received by the Centre within the required period of time or at all.

On October 20, 2014, the Centre appointed The Honourable Neil Anthony Brown QC as Panelist in the administrative proceeding. 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 Centre to ensure compliance with the Rule 7.

The Panel finds that the Asian Domain Name Dispute Resolution Centre has performed its obligations under Rule 2(a) of the Rules "to employ reasonably available means calculated to achieve actual notice to Respondent". Accordingly, the Panel is able to issue its decision based on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, the Asian Domain Name Dispute Resolution Centre Supplemental Rules and any rules and principles of law that the Panel deems applicable, without the benefit of any response from Respondent.

### **3. Factual background**

The Complainant is a United States company engaged in the production of sports equipment and clothing and related goods and services in China and elsewhere. The Complainant holds numerous trademark registrations for SPALDING internationally, including with the Chinese authorities, for example the Chinese registration No. 781698 for various items of clothing and No. 799387 for various items of sporting equipment. The Complainant has adduced evidence of these trademark registrations which the Panel accepts and they establish the Complainant's trademark rights to the SPALDING trademark (referred to hereafter collectively as "the SPALDING trademark").

The disputed domain name appears on counterfeit SPALDING basketballs, making it clear that while the domain name is being used to purport to offer legitimate authenticating services for SPALDING products, in fact it is soliciting authentication for counterfeit products.

#### Parties' Contentions

##### A. Complainant

The Complainant's contentions are as follows:

1. The Complainant claims registered trademark rights in the SPALDING trademark.
2. The disputed domain name is confusingly similar to the SPALDING trademarks.
3. That is so because the internet user would assume that the domain name was related to the Complainant and that it was being used to authenticate genuine SPALDING products.
4. The disputed domain name was registered by the Respondent on October 21, 2010.
5. The Respondent has no rights or legitimate interests in the disputed domain name as the Respondent has been using it to purport to offer genuine verification services for genuine SPALDING products whereas in fact it is being used to offer false verification services for counterfeit SPALDING products and thus to promote the sale of those counterfeit products.
6. The disputed domain name was registered and is being used in bad faith as the Respondent has been engaged in selling counterfeit SPALDING goods and using the domain name to further that objective and was aware of the Complainant's ownership of the SPALDING trademark before the domain name was registered.

**B. Respondent**

The Respondent failed to file a Response in this proceeding.

**5. Findings and Discussion of the Issues**

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 must be identical or confusingly similar to a trademark or service mark in which the 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 first question that arises is whether the Complainant has a trademark on which it can rely. The Complainant has adduced evidence that the Panel accepts to the effect that the Complainant has trademark rights on which it can rely with respect to the disputed domain name.

The Complainant holds numerous trademark registrations for SPALDING internationally, including with the Chinese authorities, for example the Chinese registration No. 781698 for various items of clothing and No. 799387 for various items of sporting equipment. The Complainant has adduced evidence of these trademark registrations which the Panel accepts and they establish the Complainant's trademark rights to SPALDING (referred to hereafter collectively as "the SPALDING trademark").

Accordingly, the Complainant has proved that it has a trademark on which it may rely.

The second question that arises is whether the disputed domain name may be said to be identical or confusingly similar to the SPALDING trademark. The Panel finds that the disputed domain name is confusingly similar to the SPALDING trademark as, in making this comparison between the domain name and the trademark, the gTLD suffix “.com” is to be ignored and the objective internet user would naturally assume that as the domain name embodies the entire trademark with only the addition of the letters ”-ch”, it is intended to give the impression that it is a domain name relating to the activities of the Complainant in China and that it will lead to a genuine website dealing with that subject, neither of which is true.

The Complainant has therefore established the first of the three elements that it must establish.

## **B) Rights and Legitimate Interests**

It is now well established that the Complainant must first make a *prima facie* case that Respondent lacks rights and legitimate interests in the disputed domain name under paragraph 4(a) (ii) of the Policy and then the onus of proof shifts to the Respondent to show it does have rights or legitimate interests. There are many decisions to that effect, one of the most notable of which is *Hanna-Barbera Prods., Inc. v. Entm't Commentaries*, FA 741828 (Nat. Arb. Forum Aug. 18, 2006) where it was held that a complainant must first make a *prima facie* case that the respondent lacks rights and legitimate interests in the disputed domain name under paragraph 4(a) (ii) of the UDRP before the onus of proof shifts to the respondent to show that it does have rights or legitimate interests in the domain name).

Having regard to the evidentiary case presented on behalf of the Complainant, the Panel finds that the Complainant has made out a *prima facie* case that arises from the following considerations:

- (a) The Respondent has chosen to take the Complainant's very prominent SPALDING trademark and to use it in its domain name by making only the addition of the letters “-ch”, thus giving rise to a confusing similarity between the domain name and the trademark;
- (b) the unchallenged evidence is that the Respondent had no authority to register the domain name and to use it as it has done, namely to promote the sale of counterfeit goods by offering false authentication of those products when they are counterfeit and to try to pass its website off as the website the Complainant's or as being authorized by the Complainant;
- (c) The Respondent has engaged in these activities without the consent or approval of the Complainant.

These matters go to make out the *prima facie* case against the Respondent and it is then up to the Respondent to rebut that case.

As the Respondent has not filed a Response or attempted by any other means to rebut the *prima facie* case against him, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Nor, in the light of the unchallenged evidence, could the Respondent conceivably show that it has such a right or legitimate interest in the domain name.

Complainant has thus made out the second of the three elements that it must establish.

### **C) Bad Faith**

It is clear that to establish bad faith for the purposes of the Policy, the Complainant must show that the disputed domain name was registered in bad faith and has been used in bad faith.

That case may be made out if there are facts coming within the provisions of paragraph 4(b) of the Policy. That paragraph sets out a series of circumstances that are to be taken as evidence of the registration and use of a domain name in bad faith, namely:

“... (i) circumstances indicating that Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to Complainant who is the owner of the trademark or service mark or to a competitor of Complainant, for valuable consideration in excess of Respondent’s documented out-of-pocket costs directly related to the disputed domain name; or

(ii) Respondent has registered the disputed domain name in order to prevent Complainant from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or

(iii) Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the disputed domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location.”

However, those criteria are not exclusive and Complainants in UDRP proceedings may also rely on conduct that is bad faith within the generally accepted meaning of that expression and frequently do so.

Having regard to those principles, the Panel finds that the disputed domain name was registered and used in bad faith. That is so for the following reasons.

First, the Respondent registered the disputed domain name in bad faith because he must have known at all times that he had no right to register it because of the existence of the famous SPALDING trademark. That trademark can only be described as famous as that is what it is; it is a household name associated with sport and has been so for many years and in many countries. It is therefore inconceivable to imagine that the Respondent believed on reasonable grounds that he was entitled to take the SPALDING trademark without permission, use it to register a domain name and to use the domain name for such an illegitimate and illegal purpose as has been demonstrated.

The Respondent used the domain name in bad faith by using it to promote the sale of counterfeit SPALDING goods by setting up a false authentication service for allegedly genuine SPALDING goods when in fact the so-called authentication was to be of counterfeit SPALDING goods to promote their sale and clearly to earn revenue for the Respondent. The Respondent encouraged this mistaken belief in internet users by describing his website as “Spalding-TRUE Community-

Authentication of the Genuine.” The Respondent did this at a time when he must have known that he had no rights to the domain name at all. It is no exaggeration to say that the Respondent has acted dishonestly and had no right to register or use the domain name in the way it has done or in any other way and has not attempted in a Response to explain his actions. This conduct constitutes both bad faith registration and use.

These facts bring the case squarely within the provisions of paragraphs 4(b) (iii) and 4(b) (iv) of the Policy. Clearly, the case comes within paragraphs 4(b) (iii) of the Policy because the prime reason for the entire process engaged in by the Respondent must have been to disrupt the business of the Complainant; reducing the sales of genuine SPALDING products, doing long term harm to the Complainant’s reputation and facilitating the sale of counterfeit products must all contribute to disrupting the Complainant’s business. Engaging in this process is also clearly intended to create confusion as to whether the Respondent’s website is genuine or not, bringing the case within paragraph (b) (iv) of the Policy.

Moreover, the evidence shows that the Respondent sought to conceal his identity in registering the domain name and that act is also evidence of bad faith. One of the worst aspects of the Respondent’s conduct was to give the Complainant’s address as his, i.e. the Respondent’s, address, so that the WHOIS record would give the false impression that the domain name had been registered for or on behalf of the Complainant.

Finally, having regard to the totality of the evidence, the Panel finds that, in view of Respondent’s acquisition of the disputed domain name and using it in the manner described, the Respondent registered and used it in bad faith within the generally accepted meaning of that expression.

Complainant has thus made out the third of the three elements that it must establish.

## **6. Decision**

Having established all three elements required under the Policy, the Panel concludes that relief should be granted. Accordingly, it is ordered that the disputed domain name, <spalding-ch.com> be TRANSFERRED to the Complainant.

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The Honourable Neil Anthony Brown QC

Dated: October 24, 2014