



Asian Domain Name Dispute Resolution Centre

hong kong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No:	HK-2001364
Complainant:	voest Alpine High Performance Metals Pacific Pte. Ltd. (formerly ASSAB Pacific Pte Ltd)
Respondent:	彭保方 (Pengbaofang)
Disputed Domain Name:	<assab-8407.com>

1. The Parties and Contested Domain Name

The Complainant is voest Alpine High Performance Metals Pacific Pte. Ltd. (formerly ASSAB Pacific Pte Ltd), of 8 Cross Street, #27-04/05, Manulife Tower, Singapore 048424.

The Respondent is 彭保方 (Pengbaofang), of 中国, 广东省, 云浮市, 广州市南沙区丰泽东路 106 号 (guangzhoushinanshaqufengzedonglu106hao).

The domain name at issue is <assab-8407.com>, registered by the Respondent with XinNet Technology Corporation, at supervision@xinnet.com.

2. Procedural History

On June 11, 2020, the Complainant submitted the Complaint in English on domain name <assab-8407.com> to the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (the "Centre"), in accordance with the Uniform Domain Name Dispute Resolution Policy (the "Policy") adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on October 24, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy Disputes (the "Rules") approved by ICANN on September 28, 2013, and the Asian Domain Name Dispute Resolution Centre Supplemental Rules ("the Supplemental Rules") in effect as of July 31, 2015. The Complainant requested a single person panel.

After receiving the Complaint, the Centre, in accordance with the Supplemental Rules, verified that the Complaint complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on June 15, 2020, the Centre requested the Registrar XinNet Technology Corporation (the "Registrar") to provide following information within five (5) days if possible: 1. whether the domain name <assab-8407.com> is registered with "XinNet Technology Corporation"; 2. The registrant or holder of the disputed domain name <assab-8407.com> ("the disputed domain name"); 3. whether the ICANN Policy is applicable to the current dispute; 4. the language of the disputed domain name's

Registration Agreement; 5. the disputed domain name's registration date and expiration date; 6. Confirmation that the disputed domain name has been locked and will not be transferred to another holder or registrar during the current administrative proceeding or for a period of 15 business days after the proceeding is concluded in accordance with Paragraph 8 of the Policy; and 7. the WHOIS information regarding the disputed domain name. In addition, by email message dated June 15, 2020, the Center confirmed the receipt of the Complaint, together with Annexures.

On June 15, 2020, the Registrar provided its response to the Centre and confirmed that: (1) the disputed domain name is registered with XinNet Technology Corporation (the Registrar); (2) the Respondent is the registrant or holder of the disputed domain name; and (3) the Policy applies to the disputed domain name. The Registrar also stated that (4) the registration agreement is in the Chinese language; (5) the provided name and contact information are pertinent to the disputed domain name as reflected in its WHOIS database; (6) the domain name would remain locked during the pending administrative proceeding.

On July 5, 2020, the Centre sent the Complaint with its annexures to the Respondent. The Respondent was then provided with a 20-calendar day period, expiring on July 25, 2020, to file his/her Response to the Centre and the Complainant. In addition, on July 7, 2020, the Centre also asked the Respondent to respond to the Complainant's request for changing the language of the proceedings from Chinese to English by the date of July 12, 2020. As the Respondent eventually had not filed any responses to the Centre, on July 28, 2020, the Centre advised the parties by email that the Respondent had not filed his/her Response to the Complaint by July 25, 2020, and, as such, the Centre would then continue proceeding and would appoint a Panelist for this matter.

Pursuant to the Rules and the Supplemental Rules, the Centre, by email dated August 10, 2020, contacted the undersigned, Ms. Shirley Lin, requesting her service as a Sole Panelist for this dispute. On the same day, Ms. Shirley Lin responded and affirmed her ability to act completely independently and impartially in this matter. Subsequently, the Centre, via an email dated August 11, 2020, notified the Parties of the appointment of Ms. Shirley Lin as the Sole Panelist. Based on the deadline set forth in paragraph 15 of the Rules, a decision should be issued by the Panel to the Center on or before August 25, 2020.

3. Factual background

The Complainant:

A. The Complainant and its activities

The Complainant is a company that offers a wide range of products such as machinery steels, wear plates, high speed steel, tool steel for plastic molding, and other steel products for engineering components.

As provided in Annexure III to the Complaint, the Complainant, voestalpine High Performance Metals Pacific Pte. Ltd. (formerly ASSAB Pacific Pte Ltd), was formed in 1945 to market high quality tool steel from Sweden, renowned for its quality standards. Headquartered in Singapore, the Complainant operates close to 50 sales offices in the Asia Pacific supplying the best steel available in the market.

Furthermore, the Complainant's presence in China dates back more than 60 years. In the mid-1950s, ASSAB (*a.k.a.* 一胜百/Yi Sheng Bai) tool steels were distributed in southern China. In the early 1990s, the Complainant established its first owned outlet in Shenzhen. Since the start, the Complainant has grown to be the leading foreign distributor of quality tool steels and services in China. Today, the Complainant has more than 500 employees in 22 locations across the mainland and continues to expand its network of services in tandem with the growing needs and precision requirements of the manufacturing industry in China. There are 18 affiliates in Beijing, Changchun, Changzhou, Chongqing, Dalian, Dongguan, Guangzhou, Hong Kong, Hunan, Ningbo, Qingdao, Shanghai, Suzhou, Tianjin, Wuhan, Xiamen, Xi'an, Yantai.

B. The Complainant's ASSAB Marks

The Complainant currently holds trademark registrations for the "ASSAB" trademark and other related trademarks ("ASSAB Marks") in various jurisdictions worldwide, including Hong Kong, Taiwan, and China. The Complainant provided in Annexure II to the Complaint, the lists of the registered trademarks on which the Complainant relies, together with the copies of the registration certificates.

The Respondent

As indicated in the WHOIS registration record provided in Annexure I to the Complaint, the Respondent registered the disputed domain name. Since June 15, 2020, the Disputed Domain Name has been locked by the Registrar and is currently inactive. The Centre confirmed that documents have been sent to the Respondent's address as registered with the registrar. However, the Centre did not receive a Response Form R from the Respondent for the domain name dispute concerning domain name <assab-8407.com> or his/her opinion on the language of the proceedings.

4. Parties' Contentions

Since the Respondent defaults, the Panel understands that the Complainant bears the burden of pleading at least a prima facie case. See, *e.g.*, *Cyro Industries v. Contemporary Design*, WIPO, No. D2000-0336, Jun. 19, 2000 (holding that in cases of default, panels must pay special attention to evaluating the accuracy of Complainant's submissions); *Softquad Software Inc. v. Eleven-Eleven Ltd, DeC*, No. AF-0143 (Jun. 1, 2000) (stressing that in default cases, the burden of proving required elements remains with the Complainant).

A. Complainant

The Complainant's contentions may be summarized as follows:

i. Identical or Confusingly Similar

The Complainant submits that the disputed domain name is identical or confusingly similar to marks in which the Complainant has rights on the basis of its ASSAB trademark registrations. The disputed domain name and the Complainant's registered ASSAB trademark are identical.

The Complainant accordingly submits that it has proved that the disputed domain name is identical and/or confusingly similar to its registered trademarks in which the Complainant has rights or interests for the purposes of paragraph 4(a)(i) of the Policy.

ii. Rights or Legitimate Interests

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraphs 4(a) (ii) and particular 4(c) of the Policy.

In particular, the Respondent registered the disputed domain name on August 7, 2018, long after most of the application and registration dates of the Complainant's ASSAB Marks.

The Complainant accordingly submits that it has proved that the Respondent has no right or legitimate interest in respect of any of the disputed domain name for the purposes of Article 4(a)(ii) of the Policy.

iii. Registered and Used in Bad Faith

The Complainant contends that the Respondent registered and is now using the disputed domain name in bad faith under paragraph 4(a)(iii) of the Policy. According to the Complainant, there are seven grounds for an inference of bad faith based on the following:

- 1) the long history and high degree of fame enjoyed by the Complainant and its trademarks in the world, including 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, ASSAB, 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 Respondent's above-mentioned 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 accordingly submits that it has proved that the Respondent has registered and used the Disputed Domain Name in bad faith for the purposes of Article 4(a)(iii) of the Policy.

B. Respondent

The Centre did not receive a Response Form R from the Respondent for the domain name dispute concerning domain name <assab-8407.com>. The Respondent is in default.

5. Findings

In view of the lack of a response filed by the Respondent as required under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(e), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant's undisputed representations.

The ICANN 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) Language of the Proceedings

The Complainant has requested that English be adopted as the language of the proceeding.

Pursuant to paragraph 11 of the Rules, unless otherwise agreed by the parties, or specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement, *i.e.* Chinese. The Complainant, upon receiving a notification from the Center that the language of the Registration Agreement of the disputed domain name <assab-8407.com> was Chinese, submitted a request for this dispute to proceed in English. The Center made a preliminary determination to accept the Complaint filed in English, subject to a determination by the Panel pursuant to paragraph 11 of Rules.

In adopting a language other than that of the registration agreement, the panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see *GroupeAuchan v. xmxzl*, *WIPO Case No. DCC2006-0004*; *Finter Bank Zurich v. ShuminPeng*, *WIPO Case No. D2006-0432*).

The Panel finds that in the circumstances of this case, paragraph 11 of the Rules is best served by allowing the proceedings to be conducted in English. The Panel was led to this conclusion by reason of the following factors:

- 1) The Complainant is not a Chinese company and most of its exhibits are made in English. Thus, Requiring the Complainant to submit documents in Chinese would lead to delay and cause the Complainant to incur translation expenses.
- 2) The Respondent has been given a fair chance to object to the Complainant's choice of English as the language of the proceeding, but has not done so, nor has it participated in the proceeding generally. And

3) The Complaint has already been submitted in English without a Response having been filed. No foreseeable procedural benefit may be served by requiring Chinese to be used. On the other hand, the proceeding may proceed expeditiously in English.

B) Identical / Confusingly Similar

This element of the Policy requires the Complainant to prove that it has rights in a trademark or service mark, and that the disputed domain name is identical to or confusingly similar to such trademark or service mark.

The Complainant has demonstrated that it owns trademark registrations for the "ASSAB Marks" in various jurisdictions. Details of the Complainant's trademark registrations for the "ASSAB Marks" have been provided in Annexure II. Among all other registrations, the Complainant obtained its registration for the "ASSAB" trademark in Class 6 (Reg. No. 19570513) in Hong Kong in as early as 1957, long before the Respondent applied to register the disputed domain name on August 7, 2018. Therefore, the Complainant owns prior trademark rights in the "ASSAB" trademark.

The disputed domain name <assab-8407.com> contains two elements: "assab-8407" and top-level domain "com". Numerous UDRP precedents have established that the top-level domain ".com" does not have trademark significance, conferring no distinctiveness to the domain name sufficient to avoid user confusion. The distinctive portion of the disputed domain name is therefore "assab-8407", and it obviously includes the Complainant's "ASSAB" trademark.

As mentioned above, the disputed domain name <assab-8407.com> contains the Complainant's "ASSAB" trademark and the Complainant's trade name in its entirety. This striking resemblance will mislead consumers into believing that the related website is operated by or associated with the Complainant.

The Panel finds that the disputed domain name is confusingly similar to the ASSAB trademark in which the Complainant has rights.

C) Rights and Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which, under the circumstances here, would legitimize a claim to the disputed domain name under paragraph 4(c) of the Policy.

After years of extensive use, the ASSAB mark has acquired significant recognition worldwide. The Complainant and the Respondent have no prior connection, and the latter has not been authorized by the former to use its mark in the disputed domain name. Additionally, the mark ASSAB is not a term commonly used in the English language. There is also no evidence that the Respondent has been commonly known by the disputed domain name. It is therefore impossible to conceive of a circumstance in which the Respondent would use the disputed domain name, except in a deliberate attempt to take advantage of the "ASSAB" mark for commercial gain.

In addition, the disputed domain name is not as at the date of this Complaint being used, nor to the Complainant's knowledge has it ever been used, in connection with any *bona fide* offering of goods or services within the meaning of paragraph 4(c)(i) of the Policy. As

stated in *Madonna Ciccone v. Dan Parisi, WIPO Case No. D2000-0847 (October 16, 2000)*, "use which intentionally trades on the fame of another cannot constitute a 'bona fide' offering of goods or services [...] to conclude otherwise would mean that a Respondent could rely on intentional infringement to demonstrate a legitimate interest, an interpretation which is obviously contrary to the intent of the Policy".

The Panel infers from the above that the Respondent is not using the name on either a non-commercial or fair use basis without intent to misleadingly divert consumers or tarnish any of the Complainant's marks, or, prior to receiving notice of this dispute, in connection with any bona fide offering of goods or services or demonstrable preparations for making such an offering, thus failing to qualify under either of paragraphs 4(c)(i) and 4(c)(iii) of the Policy.

Accordingly, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain name within paragraph 4(a) (ii) and 4(c) of the Policy.

D) Bad Faith

In accordance with Paragraph 4(a)(iii) of the Policy, the Complainant must prove that the disputed domain name has been registered and is being used in bad faith.

The requirement of bad faith is distinct from the requirement that the Respondent lacks any right or legitimate interests in the disputed domain name. As expressed by another panel, something more is required because the Policy is not only designed to combat trademark infringement on the Internet or even questionable cases of cybersquatting, but rather abusive, bad faith cybersquatting (*Edward Van Halen v. Deborah Morgan, WIPO Case No D2000-1313*).

Paragraph 4(b) of the Policy sets forth four criteria that are to be considered as evidence of the registration and use of a domain name in bad faith:

“(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product.”

As mentioned above, the Complainant obtained its registration for the "ASSAB" trademark in Class 6 (Reg. No. 19570513) in Hong Kong in as early as 1957. Subsequently, the Complainant has obtained registrations for its "ASSAB Marks" in various jurisdictions. The Complainant's "ASSAB Marks" have become widely known among consumers and relevant public as a result of its long-term promotion and use. The Respondent must have

prior knowledge of the Complainant's "ASSAB Marks" before the registration of the disputed domain name on August 7, 2018.

In the Complaint, the Complainant has claimed that the disputed domain name <assab-8407.com> resolves to a website that is strikingly similar to the Complainant's websites "www.assab.com" and "www.assab-china.com", which indicates the Respondent's clear bad faith attempt to mimic the look and feel of the Complainant's websites and to confuse and deceive consumers. However, when the Panel tried to visit that disputed website on August 15, 2020, it only showed: "The page isn't working. assab-8407.com didn't send any data."

Even so, after a careful examination of the four, non-exclusive examples enumerated in paragraph 4 (b) of the UDRP, the Panel ultimately finds, that, based on the available facts and circumstances especially that, apart from this disputed domain name, the Respondent and his/her related companies have registered various "ASSAB-related" domain names, and thus have been ordered to transfer those domain names to the Complainant in previous decisions, the registration and use of the disputed domain name could be said to have been made in bad faith. The Panel finds that the Respondent's actions, with respect to the disputed domain name, constitute bad faith registration and use. Consequently, the Panel concludes that the Respondent violated paragraph 4(a)(iii) of the Policy and specifically paragraph 4(b)(i) and (ii) thereof. Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to the disputed domain name, to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

6. Decision

Based on the above analysis, the Panelist decides that: (1) the disputed domain name <assab-8407.com> is confusingly similar to Complainant's ASSAB trademark in which the complainant has rights; (2) the Respondent has no right or legitimate interest in respect of the disputed domain name; and (3) the Respondent has registered and is using the domain name in bad faith.

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panelist grants the relief sought by the Complainant. The disputed domain name <assab-8407.com> is ordered transferred to the Complainant.



Shirley Lin
Panelist

Dated: August 17, 2020