ADMINISTRATIVE PANEL DECISION
Case No. DCN-1200503

Complainant: OSRAM GmbH
Respondent: Bo King (Tianjin) Lighting Engineering Co. Ltd.
Domain Name: “osramlighting.cn”, “osramlighting.com.cn”
Registrar: 北京万网志成科技有限公司
(HICHINA ZHICHENG TECHNOLOGY LTD.)

1. Procedural History

The Complaint was filed with the Hong Kong International Arbitration Centre (the “Centre”) on 13 December, 2012. The Complaint was made in accordance with the provisions under the CNNIC Domain Name Dispute Resolution Policy (the “Policy”) issued by the China Internet Network Information Centre (“CNNIC”), the Rules for CNNIC Domain Name Dispute Resolution Policy (the “Rules”) issued by the CNNIC and the Hong Kong International Arbitration Centre Supplemental Rules to CNNIC Domain Name Dispute Resolution Policy (the “Supplemental Rules”) issued by the Centre. The Policy, the Rules and the Supplemental Rules are all effective as of 28 June 2012.

On 14 December 2012, the Centre transmitted by email to the Registrar, 北京万网志成科技有限公司 whose English name is indicated as HiChina Zhicheng Technology Ltd. on www.baidu.com, a request for verification of the registered particulars of the disputed domain names “osramlighting.cn” and “osramlighting.com.cn (the “Disputed Domain Names””). On the same date, the Registrar replied to the Centre by email, confirming the registration particulars of “osramlighting.cn”, including the information that the registration date of the domain name is February 26, 2012. On 8 January 2013, the Registrar replied to the Centre’s reminder email of the same date regarding “osramlighting.com.cn”, confirming the registration particulars of “osramlighting.com.cn”, including the information that the registration date of the domain name is February 26, 2012.

On 9 January 2013, the Centre notified the Complainant, Osram GmbH, that the Policy provides that the language of the domain name dispute resolution proceedings shall be Chinese, unless otherwise agreed by the parties or determined by the Panel, and hence requested the Complainant either provide its Complaint in Chinese or furnish reasons for request that English be used as the language of these proceedings by 16 January 2013. The Complainant replied via email on 10 January 2013 serving reasons for requesting English as the language of the proceedings.
On 21 January 2013, the Centre transmitted by email to the Respondent, Bo King (Tianjin) Lighting Engineering Co. Ltd., the Notification of Commencement of Proceedings (the “Notification”), which gives the Respondent 20 days to submit a Response. The Centre also notified the Respondent on the same date that Complainant submitted and requested that English be used as the language of the proceedings and the Respondent was invited to provide with the Centre any comment on the Complainant’s request for consideration by the Panel.

No Response was submitted to the Centre by the Respondent in relation to either of the Disputed Domain Names. The Centre accordingly sent notices of default to the parties by email on 19 February 2013.

The Centre appointed Tao Li as the sole panelist in this matter on 6 March 2013 and notified the parties of the same on the same date.

The Policy and Rules allow the Panel to determine the language of the proceedings by taking into consideration all the circumstances. The Complainant requested that English be used as the language of the proceedings by arguing that it is important to ensure fairness to the parties and the maintenance of an inexpensive and expeditious avenue for resolving disputed domain name disputes, and that language requirements shall not lead to undue burden being placed on the parties and undue delay to the proceedings. Complainant does not understand Chinese, whilst the Respondent evidently is familiar with English language as indicated by the use of English words on the website in connection with the Disputed Domain Names. Moreover, the Disputed Domain Names are registered in Roman language.

Having considered all the circumstances of the instant proceedings, the Panel finds merit in the Complainant’s request and decides, as an exception to the general mandate of Article 6 and the Policy and Article 8 of the Rules, that the instant proceedings shall be conducted in English, rather than in Chinese.

During the review of the case file, the Panel issued an administrative panel order on March 13, 2013 to both parties, requesting the Complainant to provide the following information to the Centre with a copy to the Respondent, within ten calendar days from the receipt of the Order:

1. Explicitly indicate whether any of the international trademark registrations in respect of the OSRAM trademark as listed in Attachment 4 of the Complaint has extended to China;

2. Provide information on trademark registrations Complainant owns in China, if any; and

3. Explain the relationship between OSRAM AG and OSRAM GmbH in light that certain trademark registrations as listed in Attachment 4 seem to be in the name of OSRAM AG.

On March 21, the Centre received the Complainant’s supplemental documents. The administrative panel order allows the Respondent to respond within ten calendar days upon the receipt of the Complainant’s supplemental documents, but the Respondent
failed to respond within the prescribed period.

2. Factual background

The Complainant, OSRAM GmbH, is a German company with limited liability, with its principal place of business located at Hellabrunner Str. 1, Munich, Germany. Ms. Nina Wittich of Patent Attorneys and Lawyers Hofstetter, Schurack & Partner, whose offices are located at Balanstr. 57, 81451 Munich, Germany, represents the Complainant in these administrative proceedings.

As advised by the Registrar, 博景（天津）照明工程有限公司 (HiChina Zhicheng Technology Ltd.) in its email dated December 14 and January 8 respectively, the registrant of the Disputed Domain Names is the Respondent, Bo King (Tianjin) Lighting Engineering Co. Ltd., with its registered address at 天津市东丽区华明示范镇景湖苑 14 号楼 164 室, translated by this Panel as “Unit 164, No. 14 Building, Jing Hu Yuan, Hua Ming Shi Fan Town, Dongli District, Tianjin City”. Registrar confirms the contact information of Registrant is bianyingjie@163.com.

3. Parties’ Contentions

A. Complainant

The Complainant’s contentions may be summarized as follows:

i. The Disputed Domain Names are confusingly similar to a trademark in which the Complainant has rights;

The Complainant claims that it is one of the two largest lighting manufacturing companies in and well-known around the world. It was founded in 1919 by the merger of the lighting businesses of Auergesellschaft, Siemens & Halske and Allgemeine Elektrizitats-Gesellschaft (AEG). The “OSRAM” name is derived from osmium and wolfram as both these elements were commonly used for lighting filaments at the time of the company was founded. It has registered more than 500 “OSRAM” trademarks and service marks in over 150 countries and regions. The Madrid Express Database contains 112 international “OSRAM” trademarks owned by the Complainant. In support of this claim, Complainant produced a printed copy of the Madrid Express Database which contains 100 trademarks that either are comprised of the word “OSRAM” or include the word “OSRAM”. The Complainant further claimed that the Complainant’s company name is “OSRAM”; the further part “GmbH” indicates the legal status of the Complainant as a so called “Gesellschaft mit beschränkter Haftung”, a German company with limited liability. The Complainant further alleges that, due to the extensive international use of its “OSRAM” trademarks they have become internationally well-known; in China the Complainant has regularly prosecuted trademark violations, the OSRAM mark virtually has also become famous. Complainant produced a list of over 160 domain names which it has registered based on the denomination “OSRAM”, covering both gTLDs and ccTLDs.
The Disputed Domain Names, as so contends by the Complainant, are in their relevant distinguishing parts identical to its “OSRAM” trademark and company name. The dominant and distinctive feature of the Disputed Domain Names is the word “OSRAM”. The only difference between the Disputed Domain Names and the Complainant’s trademark resides in the adjunction of “lighting” placed at the end of the Disputed Domain Names. The expression “Lighting” is defined as the arrangement of lights used in a room, house, theatre etc. Therefore this part is only descriptive for all the goods offered by the Complainant as well as by the Registrar of the Disputed Domain Names. So it is not suitable to outweigh the strong similarity between the domains and the Complainant’s mark and its company name. Hence there is a risk of confusion between the Disputed Domain Names and the Complainant’s company name and the lightning products offered by the Complainant.

ii. The Respondent has no rights or legitimate interests in respect of the Disputed Domain Names

Complainant claims that, to its best knowledge the Respondent is not holder of any trademark “OSRAM”. Respondent is not an authorized dealer, distributor or licensor of the Complainant, nor is the Respondent in any way associated with the Complainant. Additionally, the Respondent is not making a legitimate non-commercial or fair use of the domain name.

iii. The Disputed Domain Names were registered and are being used in bad faith

The Complainant holds the view that the Respondent must have knowledge about the worldwide well-known Complainant, but the Respondent chooses to use the domains which include Complainant’s world wide well-known trademark “OSRAM” to mislead consumers who are searching for OSRAM products to his website which displays competing products. That is, the Respondent uses domain names that are similar to Complainant’s trademark and company name to attract Internet users to the Respondent’s website for commercial gain.

A cease & desist letter was issued by Hofstetter, Schurack & Partner on behalf of OSRAM AG via email on October 12, 2012 to the Respondent’s email address, demanding the Respondent to cancel the Disputed Domain Names. But no response is received.

Hence, the Complainant requests the panel to decide that the Disputed Domain Names shall be transferred to the Complainant.

B. Respondent

The Respondent has defaulted in these proceedings. It does not file a Response to the Complainant’s Complaint, nor has it responded to Complainant’s supplemental documents.
4. Findings

As to the case, Article 8 of the Policy provides that a complaint against a registered domain name shall be supported if the following conditions are fulfilled:

i. The disputed domain name is identical with or confusingly similar to the Complainant's name or mark in which the Complainant has civil rights or interests;

ii. The disputed domain name holder has no right or legitimate interest in respect of the domain name or major part of the domain name;

iii. The disputed domain name holder has registered or has been using the domain name in bad faith.

Article 7 of CNDRP states that the complainant and the respondent shall bear the burden of proof for their own claims. With reference to the complaint and the attached documents, the Panel of this case considers that:

**Identical or Confusing Similarity**

The Complainant contends that the Disputed Domain Names are identical to its company name and trademark “OSRAM”. The Complainant provides internet information (from Wikipedia and its own website www.osram.com) to support the creation of the word “OSRAM” and the formation of the company OSRAM. The Complainant also produces a list of domain names to support its claims that it owns over 160 domain names based on the denomination “OSRAM” covering both gTLDs and ccTLDs.

Complainant produced a printed copy of the Madrid Express Database which contains 100 trademarks that either are comprised of the word “OSRAM” or include the word “OSRAM”. However, the print-out does not specify whether any of these international registrations have designated China, nor does it contain any information as to the owner of these registrations. The panelist noticed through her own research, that some of the registrations are in the name of OSRAM AG, not the Complainant’s name, which is OSRAM GmbH. Hence, the panelist issued an administrative panel order to request the Complainant to submit the following information, if any:

1. Explicitly indicate whether any of the international trademark registrations in respect of the OSRAM trademark as listed in Attachment 4 of the Complaint has extended to China;

2. Provide information on trademark registrations Complainant owns in China, if any; and

3. Explain the relationship between OSRAM AG and OSRAM GmbH in light that certain trademark registrations as listed in Attachment 4 seem to be in the name of OSRAM AG.

In response to the order, Complainant has furnished the panel with the following:

1. a list of international trademark registrations including the word “OSRAM” designating China. The list comprises 54 trademarks. These registrations are in the name of OSRAM
2. A list of 15 national trademark registrations including the word “OSRAM” in China, and as an example, a copy of the registration certificate for the trademark “OSRAM” in class 9 under registration number 6669277 is provided. These trademarks are in the name of the Complainant.

3. In respect of the relationship between OSRAM AG and OSRAM GmbH, Complainant explains that the Complainant in 1965 turned from its prior entity into a limited liability company, OSRAM GmbH. In 2011 it turned into a joint stock company, OSRAM AG. On October 25, 2012 the Complainant changed into OSRAM GmbH again. The Complainant refers to its evidence, Attachment 6 of the Complaint, for support. According to the Complainant, the international trademark registrations are owned by the Complainant, although the registrant’s name has not been updated from OSRAM AG to OSRAM GmbH.

Based on the Complaint and the supplemental documents which are prima facie evidence, the Panel finds Complainant owns, 15 “OSRAM” and “OSRAM”-related trademark registrations in China in respect of, among others, lighting and electricity related goods. Such evidence, absence of any counter argument from Respondent, is sufficient to prove that Complainant has legitimate rights over the mark and its company name “OSRAM”. The Panel also notes the long company history of Complainant, its leading role in the lighting industry and the citation of the OSRAM mark among other famous trademarks in an official publication by Shanghai Customs in respect of intellectual property protection in China.

Regarding Complainant’s claim that OSRAM AG is the former name of OSRAM GmbH, since Attachment 6 of the Complaint, which is a list of historical events of Complainant, does not provide any event beyond April 17, 2006, there is no evidence to prove that there was a name change in 2012, and therefore OSRAM AG and OSRAM GmbH are the same entity. Hence, the Panel will not rely on the list of international trademark registrations, which are in the name of OSRAM AG, in reaching its decision.

The Panel agrees with the Complainant’s argument that the Disputed Domain Names are in their relevant distinguishing parts identical to Complainant’s “OSRAM” trademark and company name. The dominant and distinctive feature of the Disputed Domain Names is the word “OSRAM”; the only difference between the disputed domain name and the Complainant’s trademark resides in the adjunction of “lighting” placed at the end of the Disputed Domain Names, which is a generic word.

Therefore, the Panel concludes that the Disputed Domain Names are confusingly similar to Complainant’s trademark and company name, in which Complainant has civil rights or interests.

**Rights or Legitimate Interests of the Respondent**

There is no evidence showing that the Respondent owns any trademark registrations or other legitimate interest in respect of “OSRAM”. According to Complainant, Respondent is not an authorized dealer, distributor or licensor of the Complainant, nor is the
Respondent in any way associated with the Complainant. The website that the Disputed Domain Names correspond to is used to promote the Respondent’s products and services. Therefore, it is clear the Respondent is not making a legitimate non-commercial or fair use of the Disputed Domain Names.

Hence, the Panel finds the Respondent does not have any rights or legitimate interest in the Disputed Domain Names.

**Bad Faith**

The website that the Disputed Domain Names correspond to indicates that the Respondent is a company in the lighting industry. The website displays, as a demo of its engineering and design services, a variety of lighting products including the brands such as “Philips”, “OSRAM”, “SITECO”, although after clicking on the OSRAM logo, which is displayed on the right side of the home page as well as on the left side of the “product” sub-page along with other brands, no OSRAM product shows up. Near the bottom of the home page of the website, it provides “friendly link” to the above brands. When clicking on the third link which is the Chinese translation of “OSRAM”, the viewer will be led to www.osram.com.cn, the Complainant’s China site. There are also a couple of news stories on the right side of the home page of Respondent’s website about OSRAM; when the viewer clicks on them, the viewer will again be led to Complainant’s China website. This indicates that Respondent has knowledge of the Complainant, its product and its brand “OSRAM”.

Complainant does not indicate anywhere of its website that it is not an authorized dealer, distributor or licensor of the Complainant or in any way associated with the Complainant. The similarity of the Disputed Domain Names with the trademark “OSRAM” and the reference to the Complainant on its website tend to mislead people into thinking that there is certain connection between the Respondent and the Complainant. The Respondent’s website indicates that the Respondent’s English name is “Bo King” and it owns a domain name bokinglighting.com. Actually this domain name and the Disputed Domain Names lead to the same website. In addition to the domain name that corresponds to its English name, the Respondent chooses to use two extra domain names that are similar to Complainant’s trademark and company name to lead internet users to the same website. It indicates that the Respondent intends to take advantage of the fame of Complainant’s trademark to attract internet traffic to the Respondent’s website for commercial gain. It falls within the circumstances described under Article 9(iii) of the Policy.

The Panel holds, therefore, that the third requirement of Article 8 of the Policy has been satisfied, i.e. the Respondent has registered and has been using the Disputed Domain Names in bad faith.

5. **Decision**

For the foregoing reasons, the Panel is satisfied that the Complainant has proved its case against the Respondent under Article 8 of the Policy.
The Panel hereby orders that the Disputed Domain Names be transferred to the Complainant under Article 14 of the Policy.

Sole Panelist: Li Tao

9th April, 2013
Hong Kong