ADMINISTRATIVE PANEL DECISION
Case No. DCN-1600703

Complainant: Marshall Amplification Plc
Respondent: Linzhi Mao/ 林智茂
Domain Name: <marshallamps.com.cn>
Registrar: 易介集团北京有限公司

1. Procedural History

On 16 September 2016, the Complainant filed the Complaint with the Hong Kong International Arbitration Centre (the "Centre") and chose to have the dispute considered and decided by a sole panelist, in accordance with the CNNIC ccTLD Dispute Resolution Policy ("CNDRP") issued by the China Internet Network Information Center ("CNNIC") and becoming effective on 21 November 2014, the CNNIC ccTLD Dispute Resolution Policy Rules ("CNDRP Rules") issued by the CNNIC and becoming effective on 21 November 2014, and the HKIAC Supplemental Rules to the CNDRP and the CNDRP Rules ("Supplemental Rules"), issued by the Hong Kong International Arbitration Centre and becoming effective on 21 November 2014.

On 20 September 2016, the Centre, by way of email, sent a request to the Registrar of the domain name, Easy Medium Group Holdings Limited, at service@ejea-inc.com, for verification in connection with the domain name at issue. On the same day, the Registrar replied that they are 易介集团北京有限公司, but not Easy Medium Group Holdings Limited. On 24 September 2016 and 26 September 2016, the Centre has resent the said request for the Registrar's verification. On 27 September 2016, the Registrar made the said verification to the Centre.

On 27 September 2016, the Centre sent a Notification of Deficiencies of the Complainant to the Complainant and requested the Complainant to amend the name of the Registrar to 易介集团北京有限公司 and the name of the respondent to Linzhi Mao/ 林智茂 in the complaint form. On the same day, the Complainant submitted the amended complaint form and on 11 October 2016, the Centre accepted the amended complaint form which was sent by the Complainant on 27 September 2016.

On 11 October 2016, the Centre sent the Notice of Commencement of Proceedings to the Respondent informing the Respondent that the proceedings officially commenced and requested the Respondent to reply within 20 days (i.e. on or prior to 31 October 2016), and forwarded the Complaint and its Attachments as well as the language request to the Respondent.

On 1 November 2016, the Centre issued a Notification of Respondent in Default and confirmed that the Respondent did not file a formal reply with the Centre, within the required time limit.

Page 1
On 4 November 2016, the Centre appointed Dr. Lewis Luk JP as the sole panelist for arbitrating this case. The Panel considered that it was properly constituted and submitted the acceptance notice as well as a statement of impartiality and independence. The Panelist confirmed his appointment on 7 November 2016 and agreed to deliver his decision with respect to the Disputed Domain Name on or prior to 21 November 2016.

On 18 November 2016, the Panelist through the Centre issued an Administrative Panel Order No. 1, in which the Panelist has determined that the language of this proceedings shall be conducted in English and has requested the Complainant to submit supplemental documents on or before 25 November 2016. The date for the Panel to render a decision shall be 2 December 2016.

On 28 November 2016, the Complainant has submitted supplemental documents to the Center. In view of the importance of the supplemental documents as evidence, the Panelist has decided to allow late submission.

2. **Factual background**

   A. **Complainant**

   1. The Complainant, Marshall Amplification PLC, now famously known as “MARSHALL” is a British company that designs and manufactures music amplifiers, speaker cabinets, personal headphones & earphones. The Complainant set up their company on 19 May 1964 and was incorporated as Jim Marshall (Products) Limited. The Complainant changed its name in 1992 to their current name Marshall Amplification PLC.

   2. The Complainant was found by the late Mr. Jim Marshall (1923-2012), who had a successful career as a drummer and teacher of drum techniques. The late Mr. Jim Marshall has been given the honorary title of ‘Father of Loud’. Further, he has also been awarded the ‘Queen’s Award for Export’ in 1984, his hand prints can be found in Hollywood ‘Rock and Roll Walk of Fame’ and he has received an OBE honour in 2003 for ‘services to the music industry and to charity’.

   3. In 1962, the late Mr. Jim Marshall set up his first shop in Hanwell, London selling drums, cymbals and drum related accessories and taught drums to students at the same place. The late Mr. Jim Marshall was approached by some of his customers to make an amplifier for them as the existing ones in the market were very expensive and American. The late Mr. Marshall then started working on the first prototype which was known as the “JTM 45”. The late Mr. Jim Marshall chose to separate the amplifier from the speakers, and placed four 12-inch Celestion speakers in a separate closed-back cabinet instead of the four 10-inch Jensens in an open-back combo. Other crucial differences included the use of higher-gain ECC83 valves throughout the preamp, and the introduction of a capacitor/resistor filter after the volume control. These circuit changes gave the amp more gain so that it broke into overdrive sooner on the volume control than the amplifiers that were available in the market at the time, and boosted the treble frequencies. While working on the prototype and developing it the late Mr. Jim Marshall achieved what would eventually and today famously known as ‘The Marshall Sound’. Soon after this the Complainant Company was incorporated.
4. In 1965, the Complainant made a 15-year distribution deal with Rose-Morris another British Company who invested the money to expand manufacturing operations.

5. The Complaint started experimenting with the type of the amplifiers they manufactured. While the nickname 'Plexi' describes all plexiglass paneled “MARSHALL” amplifiers built between late 1965 and July 1969 are mostly associated with one particular amplifier that changed rock music forever: the 1959 Super Lead. Evolving from the Super 100 head favoured by The Who, the 1959 became the amplifier of choice for Cream, The Jimi Hendrix Experience, Led Zeppelin, Deep Purple and many more to follow. Also, the popularity of the 'Plexi' was aided by the fact that PA systems were still in their infancy - and groups needed louder amps to fill bigger venues.

6. The Complainant celebrated their 30th year anniversary in 1992. Commemorating 35 years in the business, in 1997 250 limited edition amplifiers were produced, clad in stunning white vinyl. The series included the following legendary amplifiers:
   - 1959 WSP head - 100 Watt Super Lead Plexi
   - 1987X WSP head“- re-issue of first 50 watt Super Lead
   - 1962 WSP combo amp - 2x12 'Bluesbreaker' re-issue
   - 1060AX WSP cabinet - 4 x1 2" angled cabinet loaded with Celestion G12, 25 watt Greenback speakers with salt and pepper fret cloth
   - PB100 WSP Power Brake - in white to match the other 35th anniversary models.

7. In 1998 the Complainant released a new compact pedal system model GV-2 Guv'nor, the BB-2 Bluesbreaker II and JH-1 which boasted a sleek chrome look. In 2003, the Marshall ‘Mode Four Series’ was released in response to evolving playing styles in Hard Rock/Metal music in the late 1990s and early 2000s, with more guitarists opting for drop tunings and heavier guitar sounds. In keeping with Mr. Jim Marshall’s ethos of always building what the customer wants, they developed and launched the Mode Four in 2003 - a 350 Watt beast that accompanied taller, 400 Watt speaker cabinets with brushed aluminium script logos. With a valve driven preamp and solid-state power amp, this hybrid beast quickly became the amp of choice for guitarists such as Mike Mushok of Staind, John 5, Dave Navarro and Daron Malakian of System of a Down. 2005 marked 40 years of the “MARSHALL” stack. Still going strong after four decades, the stack had become one of the few genuine rock icons. The Complainant launched the all-valve JVM Series in 2007 and set a new industry standard for tonal and functional versatility. In 2010 the Complainant with years of amplifier design and manufacturing knowledge under its belt, entered the headphones market with the aim of bringing the “MARSHALL” brand quality to a new set of products, and a new audience. The Minor, Major and Monitor headphones have been a huge success, featuring in-ear, over-ear and on-ear options, invoking the spirit of classic Marshall amplifiers, with the white script logo, black vinyl covering and heavy duty hinges & plugs, making them as roadworthy as the amps they are inspired by.

8. In 2012 the Complainant celebrated their 50 years in the music amplifying industry which was commemorated with a mammoth concert held at London’s Wembley Arena, featuring Joe Satriani, Paul Gilbert, Yngwie Malmsteen, Zakk Wylde, Kerry King, Doug Aldrich, Billy Duffy, Phil Campbell, Glenn Hughes, Corey Taylor, Nicko McBrain, Mike Portnoy and Brian Tichy among others.
9. The Complainant in 2014 offered their loyal customers customized designs for their amplifiers by launching their ‘Design Store’.


11. The Complainant is the registered proprietor of trademarks and other intellectual property rights worldwide consisting of or containing “MARSHALL”, “MARSHALL in stylized fonts”, “MARSHALL AMPS” and “MARSHALL AMPLIFICATION”. The Complainant’s mark “MARSHALL AMPLIFICATION” has been in use over the last 50 years and has been also known as “MARSHALL AMPS”; acquired distinctiveness through use over five decades and is protected both as a word mark and as text in a figure mark.

12. The Complainant registered www.marshallamps.com on 27 June 1997 and have had web presence since then. The Complainant’s website has had a total of 2,103,188 sessions and 8,430,698 visits in the last 12 months. They also use their website to provide detailed information about their products and information about stockists globally. The Complainant has extensively used and promoted its brand “MARSHALL AMPS” worldwide in respect of, inter alia, music amplifiers and expanded their product range to cover cabinets, pedals, designing and customized amplifiers, headphones, home speaker systems, portable amplifiers etc. The Complainant’s products have been used by a number of famous musicians over the last 50 years.

13. The Complainant’s trade mark “MARSHALL AMPS” has been extensively and prominently used prior to the Disputed Domain Name’s registration date, and was as of those dates (and continue to be) highly distinctive trademarks that symbolize substantial goodwill.

14. The Complainant has gained a huge customer and fan base due to their product lines. There is a vast amount of information through blogs, online articles, music forums etc. where the technicalities of the “MARSHALL” amplifiers is discussed.

15. The Complainant has spent considerable amount of time and money to advertise their products over the years and with the advent of the internet their popularity has multiplied and this is evident from the huge amount of following on social media.

16. The Complainant sells their products in more than 70 countries which can be accessed at www.marshallamps.com/stockists/. The Complainant’s valve amps and cabs are made in Britain and it is made with passion and precision, with a human touch that’s rare in today’s manufacturing processes: precision wiring, speaker fitting and amp and cabinet covering are all done by human hands. It is this attention to detail that sets the “MARSHALL” products apart.
B. **Respondent**

The Respondent, 林智茂 / Linzhi Mao, is an individual with an email address domain.for.sale.xxf@gmail.com. The Respondent registered the Disputed Domain Name on 27 December 2014. The Respondent did not file any Reply or materials with the Centre.

3. **Parties’ Contentions**

A. **Complainant**

The Complainant’s contentions are as follows:

I. The Disputed Domain Name is Identical or Confusing Similarity to a trademark or service mark in which the Complainant has rights:

1. The Disputed Domain Name, <marshallamps.com.cn> is identical to the registered trademarks in which the Complainant has rights.

2. The applicable country code top-level suffix in the domain name ".com.cn" would usually be disregarded under the confusing similarity test (as it is a technical requirement of registration), except in certain cases where the applicable top-level suffix may itself form part of the relevant trademark (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition - WIPO Overview 2.0). In this complaint the Disputed Domain Name <marshallamps.com.cn> is identical to the Complainant’s registered Trademark, the above mentioned principle should apply mutatis mutandis (See HKIAC case China Resources Snow Brewery Company Ltd v William Coam/ Germanium Inc, HK-1600857).

3. The Complainant further contends that in registering the Disputed Domain Name <marshallamps.com.cn>, the respondent incorporated the Complainant’s trademarks “MARSHALL”, “MARSHALL AMPLIFICATION” and “MARSHALL AMPS”. The Complaint therefore, has a prima facie case due to their registered trademarks listed above all of which predate the registration date of the Disputed Domain Name.

II. The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name

1. The Respondent does not have any rights or legitimate issues in the Disputed Domain Name.

2. The Respondent registered the Disputed Domain Name <marshallamps.com.cn> on 27.12.2014 which is approximately 45 years after the Complainant established their brand “MARSHALL”/ "MARSHALL AMPS". The Complainant registered their domain www.marshallamps.com, which is also the official website on 27.6.1997. The Respondent has registered the Disputed Domain Name only to ensure that
the Complainant does not have access to this domain considering it is identical to the Complainant’s official website with the new ccTLD ‘.com.cn’.

3. The Respondent is holding the domain passively and this domain has never been active.

4. The Disputed Domain Name has also not been used in any website and no demonstrable preparations were shown for such use. The Respondent is not known by a name consisting in whole or in part of the word “MARSHALL” and/or “MARSHALL AMPS”, and the Respondent is not an agent or licensee of the Complainant.

III. The Disputed Domain Name is registered in bad faith

1. The Respondent had registered and used the Disputed Domain Name in bad faith.

2. The Disputed Domain Name was only registered on 27.12.2014, which is more than four decades after the Complainant’s use of the registered trademarks of “MARSHALL” and “MARSHALL AMPS” in trade globally. The Complainant has a huge customer base worldwide and sell through their stockists who are listed on their website www.marshallamps.com. All of the Complainant’s products sold globally are branded as “MARSHALL” and/or “MARSHALL AMPS”.

3. The Complainant submits that they have a strong presence in China and trade through their exclusive distributor ‘Algam China’ for amplifiers. The Complainant’s sales figures in China, Hong Kong and Singapore are:
   - £516,188.68 in 2013
   - £848,352.31 in 2014
   - £835,927.62 in 2015
   - £249,314.84 from Jan to June 2016

4. The Complainant’s advertise and promote heavily in Asia and China specifically about their products. The Complainant is popular as illustrated by their exposure in the news, which is available to the general public and through the internet. Therefore, the Respondent “knew or should have known” of the Complainant’s presence in China.

5. The Complainant is a leader in the speaker and music amplifiers industry. They are well known for their style and quality of sound. The Complainant has been using the brand “MARSHALL” and “MARSHALL AMPS” since the 1960s and registered the brand as trademark as early as 1998 and a global brand. The respondent is aware of the success of “MARSHALL” and “MARSHALL AMPS” brand before registering the Disputed Domain Name. In fact, the respondent registered the Disputed Domain Names because of the Complainant’s worldwide reputation and goodwill. The respondent has thus listed the Disputed Domain Name <marshallamps.com.cn> on sale for USD $19,000.
6. The Complainant's legal representative, in the current complaint, issued a Cease and Desist letter to the respondent on 13 June 2016 after which through ongoing communications the respondent demanded a price of USD $4000 for transferring the Disputed Domain Name to the Complainant. It clearly indicates that the Complainant have rejected this offer and in turn offered to cover only administrative costs. Further, historical data for the domain from Wayback machine indicates that the Disputed Domain Name has been listed for sale since when the respondent bought it. The Complainant submits that this is evidence of bad faith.

7. The respondent seems to be currently engaged in a pattern of registering domain names identical to common trademarks owned by other entities and owns approximately 2000 domains. Evidence shows that the respondent seems to have a pattern of registering famous trademarks with the '.cn' and '.cm.cn' ccTLD.

B. Respondent

The Respondent did not submit any Reply.

4. Findings

According to Article 8 of CNDRP, it 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.

Identical or Confusing Similarity

The Panel finds from the trademark registration certificates and its renewal certificates that the Complainant has trademark rights in "MARSHALL" acquired through registration in the PRC and other countries including the USA and EU.

It should be noted that the Panel did not find any documentary proof in relation to the trademark registrations for "MARSHALL AMPS" from the Complaint or documents submitted by the Complainant.

However, the Panel noted that the Complainant, was first established in the United Kingdom in 1964 in the name of Jim Marshall (Products) Limited and subsequently changed
its name to Marshall Amplification PLC in 1992. The Complainant has been using "Marshall Amplification" as its company name and trade name since 1992. In addition, the Complainant has registered the domain name <marshallamps.com> as its company's website since 1997 for promoting its brand "MARSHALL AMPS" worldwide in respect of, inter alia, music amplifiers.

For the purposes of comparing the trademark "MARSHALL" with the Disputed Domain Name <marshallamps.com.cn>, it has been long held that applicable country code top-level suffix in the domain name, ".com.cn" in this case, can be ignored under the confusing similarity test. The terms differ then merely by addition of the word "amps" to the trade mark, which could be interpreted as amplifiers, being the goods sold under the trade mark.

Furthermore, the earliest trademark registration for "MARSHALL" in the PRC is in 1984, which is approximately 45 years earlier than the registration date of the Disputed Domain Name.

The Panel finds that the Disputed Domain Name to be confusingly similar to the trade mark and therefore finds that the Complainant has fulfilled the first condition of Article 8 of the CNDRP.

 Rights or Legitimate Interests of the Respondent

In accordance with Article 10 of the CNDRP, it provides a non-exhaustive list of circumstances which may be evidence of the rights to and legitimate interests in the domain name:

i. Before any notice to the respondent of the dispute, the respondent's use of the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services;
ii. The respondent has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights;
iii. The respondent is making a legitimate noncommercial or fair use of the domain name, without intent of or commercial gain to misleadingly divert consumers.

The Complainant has confirmed that it has no connection with the Respondent, nor has licensed or authorized the Respondent to use "MARSHALL" and/or "MARSHALL AMPS" in its Disputed Domain Name.

The Complainant has prior rights in the trademark "MARSHALL" which precede the Respondent's registration of the Disputed Domain Name. Therefore, there is a prima facie case that the Respondent has no rights or legitimate interests in the Disputed Domain Name and the burden is thus on the Respondent to produce evidence to rebut this presumption.

In the website under the Disputed Domain Name, only these sentences are shown:

- "[marshallamps.com.cn] is for sale";
"if you would like to purchase this domain, please click here to make an offer."; and
the Chinese translation of the above two sentences, “域名[marshallamps.com.cn]
正在出售中，如果您对该域名感兴趣，请电击这里提供您的报价。”

It is clear that the sole purpose for the Respondent to register the Disputed Domain Name
is to seek profit through sale.

When registration and sale of a domain name that is confusingly similar to a third party's
registered trademark rights is made with the intention of exploiting the frame and value of
the said rights and in the suspicious of infringing the right, then such registration does not
create any legal rights and interest for the registrant, nor the sale thereof could be count
for "bona fide offering of goods or services".

Furthermore, the Respondent did not submit any reply or evidence to prove that he has
been commonly known by the Disputed Domain Name, or has been making a legitimate
noncommercial or fair use thereof.

In conclusion, the Panel finds that the Complainant has fulfilled the second condition of
Article 8 of the CNDRP.

**Bad Faith**

According to **Article 9 of the CNDRP**, any of the following circumstances may be the
evidence of the registration and use of a domain name in bad faith:

i. The purpose for registering or acquiring the domain name is to sell, rent or
otherwise transfer the domain name registration to the complainant who is the
owner of the name or mark or to a competitor of that complainant, and to obtain
unjustified benefits;

ii. The disputed domain name holder, on many occasions, registers domain names in
order to prevent owners of the names or marks from reflecting the names or the
marks in corresponding domain names;

iii. The disputed domain name holder has registered or acquired the domain name
for the purpose of damaging the Complainant's reputation, disrupting the
Complainant's normal business or creating confusion with the Complainant's
name or mark so as to mislead the public; or

iv. Other circumstances which may prove the bad faith.

The Panel finds registration and use in bad faith pursuant to Article 9 (i) and (ii) above.
Evidence has showed that the registration of the Disputed Domain Name by the
Respondent is to sell for profit. The content of the website under the Disputed Domain
Name has showed the Respondent's intention to sale, but also evidenced in the email
communications between the legal representative of the Complainant and the Respondent.
It is submitted by the Complainant that the Respondent demanded a price of USD4000 for
transferring the Disputed Domain Name to the Complainant after a Cease and Desist letter
has been sent to the Respondent in 13 June 2016.

Further, the Respondent has not actively used the Disputed Domain Name since the date of
registration. It is submitted by the Complainant that the Disputed Domain Name has been
listed for sale since when the Respondent bought it. The Panel finds that the Respondent’s passive use of the Disputed Domain Name has prevented trademark owners from reflecting their names or the marks in the corresponding domain names.

In conclusion, the Panel finds that the Complainant has fulfilled the third condition of Article 8 of the Policy.

5. Decision

Pursuant to Article 40 of the CNDRP Rules, the Panel orders that the Disputed Domain Name <marshallamps.com.cn> be transferred to the Complainant.

Panelist: Dr. Lewis Luk JP
Date: 2 December 2016