ADMINISTRATIVE PANEL DECISION
Case No. DCN-1700730

Complainant: Marshall Amplification PLC
Respondent: 曹孝云 (Pan Xiaoyun)
Domain Name: marshallheadphones.com.cn
Registrar: 厦门博名科技股份有限公司
(Xiamen Yi Ming Technology Co., Ltd)

1. Procedural History

A. Complaint and Correspondence History

On March 7, 2017, the Complainant filed the Complaint with the Hong Kong International Arbitration Centre (the “Centre”) in accordance with the CNNIC ccTLD Dispute Resolution Policy ("CNDRP") as approved and implemented by the China Internet Network Information Center ("CNNIC") on November 21, 2014, the CNNIC ccTLD Dispute Resolution Policy Rules ("Rules of CNDRP") as approved and implemented by the CNNIC on November 21, 2014, and the HKIAC Supplemental Rules to CNNIC ccTLD Dispute Resolution Policy ("Supplemental Rules"), issued by the Centre and effective as of November 21, 2014. The Complaint includes a request that English be used as the language of administrative proceedings.

On March 8, 2017, the Centre transmitted by e-mail to 厦门博名科技股份有限公司 (Xiamen Yi Ming Technology Co., Ltd), the Registrar of the disputed domain name, a request for registrar verification in connection with the disputed domain name. On the same day, the Centre confirmed receipt of the Complaint by e-mail to the Complainant, and the Registrar responded to the request for registrar verification, clarifying that the identity of the current domain name holder / registrant of the domain name was not 厦门博名科技服务有限公司 (Xiamen Privacy Services Ltd), as initially alleged by the Complainant in its Complaint, but 曹孝云 (Pan Xiaoyun). The Centre sent the Complainant a "Notification of Deficiencies of the Complaint" by e-mail, stating that the Complaint was found to have been administratively deficient given that (i) the domain name holder / registrant was not 厦门博名科技服务有限公司 (Xiamen Privacy Services Ltd) but 曹孝云 (Pan Xiaoyun), and (ii) the number of words in Part VI "Facts and Reasons" of the complaint form exceed the word limit of 3,000, contrary to Article 18(a) of the Rules of CNDRP and Article 13(1) of the Supplemental Rules. On the same day (March 8, 2017), the Complainant amended the Complaint to address the two deficiencies identified by the Centre and included an additional Annex. On March 9, 2017, the Centre acknowledged receipt of the rectified complaint form within the required period of time.
Also on March 9, 2017, the Centre sent the Notification of Commencement of Proceedings to the Respondent and requested the Respondent to reply within 20 days (on or before March 29, 2017), and forwarded the Complaint and its Annexes as well as the language request to the Respondent, in accordance with the Rules of the CNDRP and the Supplemental Rules. On 30 March, 2017, the Centre issued a “Respondent in Default” notice by e-mail to the parties confirming that it had not received a response from the Respondent within the required period of time.

On April 6, 2017, the Centre appointed Mr. Loke-Khoon Tan as the sole panelist for this case. On April 27, 2017, the Panel issued Administrative Panel Order No. 1, in which the Panel, in response to the Complainant’s request that English be used as the language of administrative proceedings, decided that the language of proceedings in the present case shall be English. In the meantime, the Panel ordered the Complainant to furnish supplemental evidence in accordance with paragraph 1 of Article 32 of the Rules of CNDRP. The Complainant was requested to respond by May 10 2017. On May 9 2017, the Complainant submitted further supporting documents in response to Administrative Panel Order No. 1. The Respondent was notified of its right to submit comments to the Complainant’s supplemental submissions by May 24 2017. In an e-mail dated May 26 2017 to all parties, the Centre confirmed that the Respondent did not send any comments to the Complainant’s supplemental submissions.

B. Language of the Proceedings

As indicated above, the Panel decided that the language of the present proceedings shall be English in Administrative Panel Order No. 1, based on reasons that were set out in brief. The full reasoning for this decision is now set out as follows.

Article 6 of the CNDRP provides:

“The language of the domain name dispute resolution proceedings shall be Chinese, unless otherwise agreed by the parties or determined by the Panel.”

Article 8 of the Rules of CNDRP provides:

“Unless otherwise agreed by the Parties or determined in exceptional cases by the Panel, the language of the domain name dispute resolution proceedings shall be Chinese. The Panel may order that any documents submitted in languages other than Chinese be wholly or partially translated into Chinese.”

The Complainant filed the Complaint with the Centre in English, and requested that the language of the proceedings be in English on the grounds that (i) the Respondent is able to read and understand English or is at least competent with the English language; and (ii) translating the Complaint would lead to undue delay and substantial expenses which goes against the spirit of the HKIAC.

In support of (i), the Complainant submits that the fact that the Respondent is able to read and understand English can be seen from the domain itself and from the content of <marshallheadphones.com.cn>, namely “HEADPHONES”, “HEADPHONES OVER-EAR”,

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"MARSHALL PHONES". The Complainant also asserted that the Respondent has registered other domain names which feature English words and brand names, including but not limited to <fenderchina.cn>, <gospelguitar.org> and <guitarsquare.com.cn>.

In reviewing this request, the Panel tried to access the website under the domain name <marshallheadphones.com.cn> to verify the language of its contents. However, as of the day of this decision, the Panel has not been able to access any such webpage. On the other hand, the Panel notes that Annex 16 of the Complaint shows a webpage alleged to be captured from the website under the domain name <marshallheadphones.com.cn>. According to Annex 16, the website contains both English words and Chinese characters.

The Panel has conducted WHOIS searches of <fenderchina.cn>, <gospelguitar.org> and <guitarsquare.com.cn>. Contrary to the Complainant's argument, although listed under the same e-mail address admin@ylcool.net, only <guitarsquare.com.cn> lists the Respondent's name as its registrant.

The Panel notes that the Respondent had been notified of the Complaint against him/her and was invited to provide comments on the Complainant’s language request through e-mail communications written in both English and Chinese by the Centre. The Respondent did not raise any objections with respect to the Complainant’s request for proceedings to be conducted in English. The Panel therefore considers that it is reasonable to infer that the Respondent has an English language ability based on the content of the disputed domain name. Since all e-mail communications were written in English and Chinese, the Respondent must have been aware of the language request, and yet made no objection or any response at all. Similar considerations were applied in BASF SE v 金大军 HKIAC Administrative Panel Decision, Case No. DCN-1600674.

The Panel therefore considers it is appropriate to exercise its discretion and conduct the proceedings in English.

2. **Factual background**

   **A. For the Complainant**

   The Complainant is a company incorporated in the United Kingdom. It was incorporated on 19 May 1964 as Jim Marshall (Products) Limited. The Complainant changed its name in 1992 to Marshall Amplification PLC. According to the Complainant's claims, it designs and manufactures music amplifiers, speaker cabinets, personal headphones & earphones.

   The Complainant claims that it is the owner of the following trademarks globally:
<table>
<thead>
<tr>
<th>Registration/Application no.</th>
<th>Country</th>
<th>Date of registration</th>
<th>Trade mark</th>
<th>Class</th>
</tr>
</thead>
<tbody>
<tr>
<td>000058065</td>
<td>EU</td>
<td>17.02.1998</td>
<td>Marshall</td>
<td>9</td>
</tr>
<tr>
<td>J940239</td>
<td>US</td>
<td>27.05.2010</td>
<td>MARSHALL AMPLIFICATION</td>
<td>25</td>
</tr>
<tr>
<td>TN/E/2010/2535</td>
<td>Tunisia</td>
<td>29.11.2011</td>
<td>MARSHALL AMPLIFICATION</td>
<td>25</td>
</tr>
<tr>
<td>012995404</td>
<td>EU</td>
<td>04.11.2014</td>
<td>Marshall</td>
<td>9</td>
</tr>
<tr>
<td>1059647</td>
<td>International Registration</td>
<td>05.11.2010</td>
<td>Marshall</td>
<td>25</td>
</tr>
<tr>
<td>00967732</td>
<td>EU</td>
<td>27.05.2010</td>
<td>Marshall</td>
<td>16, 18, 25</td>
</tr>
<tr>
<td>1230802</td>
<td>International Registration</td>
<td>26.06.2014</td>
<td>Marshall</td>
<td>9</td>
</tr>
<tr>
<td>010357201</td>
<td>EU</td>
<td>10.04.2012</td>
<td>MARSHALL</td>
<td>9, 11</td>
</tr>
<tr>
<td>010707073</td>
<td>EU</td>
<td>19.07.2012</td>
<td>Marshall</td>
<td>9, 11</td>
</tr>
<tr>
<td>012996419</td>
<td>EU</td>
<td>23.03.2015</td>
<td>Marshall</td>
<td>9, 10, 15, 38, 41</td>
</tr>
<tr>
<td>015249601</td>
<td>EU</td>
<td>Pending</td>
<td>Marshall</td>
<td>9, 35, 38, 41</td>
</tr>
</tbody>
</table>

And that it has registered trademarks in China as below:

<table>
<thead>
<tr>
<th>Registration Number</th>
<th>Registration Date</th>
<th>Trade mark</th>
<th>Class</th>
</tr>
</thead>
<tbody>
<tr>
<td>216918</td>
<td>15.12.1984</td>
<td>MARSHALL</td>
<td>9</td>
</tr>
<tr>
<td>880053</td>
<td>13.10.2005</td>
<td>Marshall</td>
<td>16</td>
</tr>
<tr>
<td>1155292</td>
<td>08.03.2013</td>
<td>Marshall</td>
<td>32, 33 and 43</td>
</tr>
<tr>
<td>8820776</td>
<td>14.01.2012</td>
<td>Marshall</td>
<td>25</td>
</tr>
</tbody>
</table>


The Complainant claims that it has gained a huge customer and fan base due to their product lines. It claims that there is a vast amount of information through blogs, online articles, music forums etc. where the technicalities of the “MARSHALL” amplifiers are discussed. To support these claims, the Complainant submitted an Annex 9 to the Complaint.
The Complainant claims that it has spent a considerable amount of time, money and effort to advertise their products over the years and that, with the advent of the internet, their popularity has multiplied and that this is evident from their popularity on social media. To support these arguments, the Complainant submitted an Annex 10 to the Complaint.

The Complainant claims that it advertises and promotes heavily in Asia and China specifically about their products. It claims that it is popular and has had coverage in the news, which is available to the general public and through the internet. To support this argument, the Complainant submitted an Annex 11 to the Complaint.

The Complainant also claims the following facts in its Complaint. However, none of them were supported by documentary evidence:

- the Complainant was founded by the late Mr. Jim Marshall who has received various honours;
- Mr. Jim Marshall set up his first shop in 1962 and achieved certain success in its business before the Complainant was incorporated;
- the Complainant registered the "marshallamps.com" domain name on 27th June 1997 and have had web presence since then;
- the Complainant’s MARSHALL trademark has been extensively and prominently used prior to the Respondent’s registration of <marshallheadphones.com.cn> and was as of those dates (and continue to be) highly distinctive and famous trade marks that symbolize substantial goodwill; and
- the Complainant has a strong presence in China and trade through their exclusive distributor Algam China for amplifiers.

B. For the Respondent

Given that the Respondent has not filed any responses or any other materials with the Centre, the only source for the Panelist to obtain the Respondent’s information is from the information provided by the domain name registrar. The Respondent, 潘孝云, is an individual with an e-mail contact of admin@yicool.net. The Respondent registered the disputed domain name, <marshallheadphones.com.cn>, on February 14, 2016.

3. Parties’ Contentions

A. Complainant

The Complainant’s contentions can be summarized as follows:

i. The Respondent’s domain name is identical or confusingly similar to a trade mark in which the Complainant has rights

The Complainant contends that the disputed domain name <marshallheadphones.com.cn> is confusingly similar to the registered trade marks in which the Complainant has rights. It contends that the domain incorporates the well-known MARSHALL trade mark, with that of the word
“HEADPHONES”, which makes a direct association with the Complainant and some of the Complainant’s products i.e. headphones.

To support this argument, the Complainant has submitted copies of the trade mark registration certificates for “MARSHALL” in China in Annex 5.

The Complainant submits that their rights in and to the term “MARSHALL” have been recognized in a prior CNDRP dispute concerning Marshall Amplification Plc v. Linzhi Mao Case No. DCN-1600703, provided in Annex 12.

Further, the Complainant submits that the applicable country code top-level suffix in the domain name ".com.cn" should 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 trade mark. It submits that in this complaint although <marshallheadphones.com.cn> is confusingly similar to that of the Complainant’s registered trade mark, the above mentioned principle should still apply.

The Complainant also submits that the HKIAC in China Resources Snow Brewery Company Ltd v William Coam/Germanium Inc Case No. HK-1600857 attached as Annex 13 confirms the above principle and states: “For the purposes of comparing the trademark with the disputed domain name, it has long been held that ... top-level domains, such as, ‘.com’ in this case, can be ignored......”.

Based on the above submissions, the Complainant requests that the Panel agree that the domain, <marshallheadphones.com.cn>, is confusingly similar to the “MARSHALL” trade mark.

ii. The Respondent does not have any right or legitimate interests in respect of the domain name

The Complainant submits that the Respondent does not have any rights or legitimate interests in <marshallheadphones.com.cn>. Under Article 10 of the CNDRP, the Complainant acknowledges that a Respondent may demonstrate a right or legitimate interest in the domain name only if it can be established that:

- Your use of the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services;
- You have been commonly known by the domain name, even if you have acquired no trademark or service mark rights;
- You are making a legitimate non-commercial or fair use of the domain name, without intent of or commercial gain to misleadingly divert consumers.

The Complainant submits that, following the comments made in this section of the dispute, the burden will then shift to the Respondent to put forward
evidence that they do have rights or legitimate interests in the <marshallheadphones.com.cn> domain.

The Complainant firstly contends that it maintains its legal right to <marshallheadphones.com.cn>, based on the statutory protection of the "MARSHALL" word by way of trade marks in several jurisdictions, including that of the People's Republic of China (to support this, the Complainant has submitted evidence in Annex 5). The Complainant stated that any individual who has access to the internet can find the MARSHALL trade marks on public trade mark databases, including that of the Chinese Trade Mark Office (to support this, the Complainant has submitted evidence in Annex 14). The Complainant also stated that it relies on the goodwill that has been associated with the "MARSHALL" brand for over 50 years, which predates the registration of <marshallheadphones.com.cn> on the 14th February 2016. The Complainant stated that to date, "MARSHALL" is solely associated with that of the Complainant's services on popular Chinese search engines, such as Baidu with the main domain name, <marshallamps.com>, ranked as the first hit (in support of which the Complainant has submitted evidence in Annex 15).

In order to rebut any possible legitimate interest held by the Respondent in this matter, it is submitted, the Complainant outlines objections to each of the above referenced provisions laid out under Article 10 of the CNDRP:

Your use of the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services;

The Complainant submits that <marshallheadphones.com.cn> is being used to resolve to a "MARSHALL" themed website, which is confusingly similar in appearance and design to that of the Complainant’s website, <marshallamps.com>, including the use of an identical "MARSHALL" brand logo (for which the Complainant submitted evidence in Annex 16). The Complainant contends that the overall layout of the domain gives the impression that it is licensed, sponsored or somehow associated with the Complainant, and further contends that in fact it is not.

The Complainant states that it is aware of previous Panelist views on the use of domain names for unauthorised resellers/distributors, which is particularly noted in the established UDRP case of Oki Data Americas, Inc. v. ASD, Inc. D2001-0903, where the Panelist, David H. Bernstein, established that there are four conditions that must be established in order to lawfully become an unauthorised reseller/distributor:

a. Respondent must actually be offering the goods or services at issue;

b. Respondent must use the site to sell only the trademarked goods; otherwise, it could be using the trademark to bait Internet users and then switch them to other goods.

c. The site must accurately disclose the registrant's relationship with the trademark owner; it may not, for example, falsely suggest that it is the
trademark owner, or that the website is the official site, if, in fact, it is only one of many sales agents; and
d. The Respondent must not try to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in a domain name.

The Complainant contends that the Respondent’s use fails the Oki Data test as per the requirements of a UDRP, which, the Complainant stated, has also been confirmed in Houghton Mifflin Co. v. The Weathermen, Inc. Case No. D2001-0211, where the Panel there held that:

"Respondent used "curiousgeorge.net" to offer "Curious George" merchandise for sale. As noted above, Respondent prominently featured the "Curious George" mark, with its distinctive lettering style and a drawing of Curious George himself, as the title of its site, but did not at any point identify itself as a separate entity from Complainant. Consumers were therefore likely to be confused into thinking that the merchandise offered therein was being offered by Complainant".

The Complainant requests that the Panel consider this principle from Oki Data, as the lack of a disclaimer on the Respondent’s domain name increases the risk of confusion in the eyes of an innocent consumer, who is likely to purchase headphones from <marshallheadphones.com.cn>, believing that they are licensed by the Complainant and under the Complainant’s warranty, which they are not. Such confusion, the Complainant submits, is highly detrimental to the Complainant and thus, cannot satisfy this exception under Article 10 of the CNDRP.

You have been commonly known by the domain name, even if you have acquired no trademark or service mark rights;

The Complainant submits that to the best of their knowledge, the Respondent has never been known as “MARSHALL” at any point in time, despite their use of the “MARSHALL” trade marks and “MARSHALL” products on <marshallheadphones.com.cn>. The Complainant submits that, as stated in the UDRP case of Vestel Elektronik Sanayi ve Ticaret AS v. Kahveci, D2000-1244, Panelist R. Eric Gaum held that: “merely registering the domain name is not sufficient to establish rights or legitimate interests for purposes of paragraph 4(a)(ii) of the Policy”. These facts led the Complainant to conclude that the only reason why the Respondent registered <marshallheadphones.com.cn>, was to take advantage of the well-known “MARSHALL” brand and pass off as an authorised reseller/distributor of “MARSHALL” products. Therefore, the Complainant contends, the Respondent cannot make a claim under this exception.
You are making a legitimate non-commercial or fair use of the domain name, without intent of or commercial gain to misleadingly divert consumers.

In addition to the above, the Complainant submits that <marshallheadphones.com.cn> has been created with the main intention of passing off as an official reseller/distributor of “MARSHALL” products, specifically “MARSHALL” headphones. Through selling “MARSHALL” products, without permission from the Complainant, the Respondent is making a “commercial gain” and further intends to divert consumers away from the Complainant’s official domain names, such as <marshallamps.com>. As such, there is no evidence to suggest a legitimate non-commercial or fair use. However, the Complainant has not submitted any evidence to support this contention.

The Complainant contends that, in light of the comments submitted by it, the Respondent did not satisfy any of the above mentioned grounds under Article 10 and that it has made a prima facie case that the Respondent has no rights or legitimate interests in the domain <marshallheadphones.com.cn>.

In addition to the above, the Complainant, in support of its contentions in relation to condition (ii), also argued that on these facts, although the Respondent is only offering “MARSHALL” headphones, there is nothing on the domain which clearly explains the relationship between the Complainant and the Respondent, but there was no clear evidence to support this.

iii. The disputed domain name has been registered and is being used in bad faith

The Complainant contends that the disputed domain name is registered or is being used in bad faith.

It submits that, for the purposes of Article 9 of the CNDRP, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(a) 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;
(b) 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;
(c) 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;
(d) Other circumstances which may prove the bad faith.
The Complainant submits that <marshallheadphones.com.cn> was registered on 14th February 2016 which is after more than 4 decades of the Complainant using their MARSHALL trade mark. The Complainant further submits that it has a huge customer base worldwide and sell through their stockists who are listed on their website <marshallamps.com>.

The Complainant submits that it relies on the provision in Article 9 that the Respondent has registered <marshallheadphones.com.cn> for the purpose of disrupting the Complainant’s normal business and is creating confusion with the Complainant’s MARSHALL brand, so as to mislead the public into thinking that they are authorized or somehow associated with the Complainant and their acclaimed products, which, the Complainant submits, they are not. As evidence to support this case, the Complainant reiterates their submissions in paragraphs 24-26 of the Complaint that the Respondent is passing off as an authorised reseller/distributor of “MARSHALL” products, specifically headphones, which leads customers to believe that <marshallheadphones.com.cn> is an official “MARSHALL” reseller/distributor in China, which, the Complainant submits, it is not, as the only exclusive distributor for “MARSHALL” products is Algam China.

The Complainant further submits that it relies on national law in China, specifically that of Article (2) and (3) of the Chinese Unfair Competition Law (1st December 1993). Specifically, the Complainant stated, a violation will occur when the Respondent is:

- **Article 5(2)** using for a commodity without authorization a unique name, package, or decoration of another’s famous commodity, or using a name, package or decoration similar to that of another’s famous commodity, thereby confusing the commodity with that famous commodity and leading the purchasers to mistake the former for the latter; and

- **Article 5(3)** using without authorization the name of another enterprise or person, thereby leading people to mistake their commodities for those of the said enterprise or person.

Following the above mentioned provisions, the Complainant submits that it reiterates that the manner in which Respondent is using <marshallheadphones.com.cn>, is with the sole purpose of misleading purchasers to believe they are acquiring the goods of the Complainant. The Complainant submits that this is clearly evident from the website which prominently features the Complainant’s “MARSHALL” logo and copyrighted images, further stating that such use cannot be deemed legitimate, especially as the Complainant cannot guarantee the quality of the commodities provided on the website, based on the fact that they are not from an authorized dealer.
The Complainant submits that the Respondent has a propensity to register domain names that correspond to popular guitar brands, including but not limited to other “MARSHALL” themed domain names (<marshall.hk> and <marshallheadphones.hk>) and also “FENDER” guitar domain names (<fenderchina.cn> and <fenderguitars.cn>) (for which the Complainant submitted evidence in Annex 4). As such, the Complainant contends, the Respondent clearly has a working knowledge of leading guitar brands and has chosen to register variations of these 3rd party trade marks in domain names for their own benefit and to take advantage of the brand owners goodwill and valuable reputation.

Based on the above submissions, the Complainant requests the Panel to make a finding against the Respondent, that the domain, <marshallheadphones.com.cn> has both been registered and use in bad faith, which satisfies all grounds under Article 8 of the CNDRP.

In response to Administrative Panel Order No. 1, the Complainant, by way of a letter dated May 9, 2017, has submitted supplementary evidence to support its contentions that the disputed domain name has been registered in bad faith. In particular, screenshots of the website using the disputed domain name were submitted.

B. Respondent

The Respondent did not submit any Reply within the required time limit.

4. Findings

Article 8 of CNDRP 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:

A. Identical or Confusing Similarity

According to the Complainant's submissions, the Complainant has registered the following trademarks covering "headphones" in the jurisdiction of the People's
Republic of China ("PRC"): 

- a "Marshall" trademark in Class 9 (International Registration No. 866766; registered on October 13, 2005 and then extended to the PRC on November 24, 2005)
- a "Marshall" trademark in Class 9 (International Registration No. 1230802; registered on June 26, 2014 and then extended to the PRC on February 2, 2016)

In addition, the following PRC trademark registration covers "electronic megaphones":

- a “MARSHALL” trademark in Class 9 (PRC Registration No. 216918; registered on December 15, 1984)

Under the PRC Trademark Office's Index of Similar Goods and Services (version 2017), "megaphones" are assumed to be similar to "headphones". In other words, without the Complainant's consent, a third party shall not use the trademark "MARSHALL" on the headphones.

In light of the above, the Panel finds that the Complainant has obtained exclusive rights in using the trademarks "MARSHALL", "Marshall" or "Marshall" on headphones in the territory of the PRC. This fact is important because the ".com.cn" domain name, as a ccTLD domain name, has its natural connection with the jurisdiction and market of China. In addition, the Complainant has submitted evidence proving that (a) headphones are included among the products that it offers (as shown in Annex 8 to the Complaint), (b) the Complainant has an internet presence for its headphones (as shown in Annex 10 to the Complaint), and (c) the Complainant has advertised its headphone products in the PRC (as shown in Annex 11 to the Complaint).

Given the above, the remaining issue is whether the domain name "marshallheadphones.com.cn" is confusingly similar to the abovementioned trademarks.

First, the parts of ".com.cn" of the disputed domain name are widely known as abbreviations of "commercial" and "China". There is no need to consider them in a determination of the similarity issue.

Second, it is necessary to note that, while this case did relate to the "MARSHALL" trademark, the CNDRP dispute case Marshall Amplification Plc v. Linzhi Mao (Case No. DCN-1600703) cannot be used to support the finding of similarity between "MARSHALL" and "marshallheadphones.com.cn".

That being said, the Panel still feels comfortable to find that the term
"marshallheadphones" is confusingly similar with the Complainant's trademark registrations for "MARSHALL" or "Marshall" over the goods items "headphones" or "electronic megaphones". This is because an ordinary English speaker would reasonably recognize the term "marshallheadphones" as a combination of "Marshall" and "headphones". In other words, the first word of the main body of the disputed domain name is identical to the trademark registered by the Complainant in China, while the second word of the disputed domain name is one of the designated goods items on which the Complainant has obtained exclusive right to use the said trademarks. In an earlier HKIAC Administrative Panel Decision DCN-1500665, ENTERPRISE HOLDING, INC. v Internet Media, the panel has applied the same logic and held that there was a close relationship between the trade mark “ENTERPRISE”, which belonged to the complainant of that case, and the disputed domain name <enterprisecar.com.cn>.

In this connection, the Panel finds that the first condition set out in Article 8 of CNDRP is fulfilled in this case.

B. Rights or Legitimate Interests of the Respondent

The Complainant submits that the Respondent does not have any rights or legitimate interests in <marshallheadphones.com.cn>.

Article 10 of the CNDRP provides a non-exhaustive list of circumstances that can be brought forward by the Respondent in order to demonstrate its rights or legitimate interests in the disputed domain name. Such circumstances are:

- the Respondent has used the domain name in good faith when it provides goods or services;
- the Respondent’s registered domain name has been well-known;
- 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 Panel notes that, while the Complainant bears the overall burden of proof, the element of possible rights or legitimate interests of the Respondent in the disputed domain name involves the Complainant proving matters which are peculiarly within the knowledge of Respondent. As such, the burden of proof shifts to the Respondent once the Complainant makes out a prima facie case showing that the Respondent lacks rights or legitimate interests. If the Respondent fails to come forward with such appropriate allegations or evidence, a Complainant is generally deemed to have satisfied Article 10 of the CNDRP. See: Neusiedler Aktiengesellschaft v. Kulkarni, WIPO Case No. D2000-1769, Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO Case No. D2003-0455, and Xi’an NovaStar Tech Co., Ltd. v SHENZHEN UNIT LED CO., LTD., ADNDRC Case No. HK-1600854.

The Panel accepts the Complainant’s submission that the Respondent has not been commonly known by the disputed domain name and the Complainant has never
licensed the “MARSHALL” trademark to the Respondent. Mere registration of the
domain name is not sufficient to establish rights or legitimate interests. See UDRP

Further, in the Complainant’s supplemental submission of evidence in response to
Administrative Panel Order No. 1, the Complainant has submitted evidence of a
trade mark registration for “Marshall Headphones” with the EU Intellectual
Property Office (Registration Number 013972039). This submission further supports
the conclusion that the Complainant has rights over the disputed domain name.

Therefore, the Panel finds that the Complainant has made a prima facie case
showing that Respondent does not have rights or legitimate interests in respect of
the Disputed Domain Name.

C. Bad Faith

Article 9 of the CNDRP provides an open list of circumstances where a Respondent
can be found to have registered a domain name in bad faith:

(a) 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;
(b) 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;
(c) 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 between the
Complainant and the Respondent so as to mislead the public; or
(d) Other circumstances which may prove the bad faith.

**With regard to scenario (a),** the Complainant did not argue that scenario (a) is
applicable to this case and did not provide evidence in relation to this item.

**With regard to scenario (b),** the Complainant argues that the Respondent has a
propensity to register domain names that correspond to popular guitar brands,
including but not limited to other “MARSHALL” themed domain names
(<marshall.hk> and <marshallheadphones.hk>) and also “FENDER” guitar domain
names (<fenderchina.cn> and <fenderguitars.cn>) (see para. 35 of the
Complaint). In total, according to Annex 4 provided by the Complainant, 13 domain
names have been registered under the Respondent’s e-mail address.

However, by conducting WHOIS searches, this Panel finds that, although registered
with the same e-mail address, the Respondent is not listed as the registrant of the
domain names mentioned by the Complainant, with the exception of the domain
name <guitarsquare.com.cn>. Instead, the registrants of these domain names are
set out in the following table. The possibilities are that (i) the same e-mail address
has been used by different registrants, or (ii) the same person has been using different names to register the above domain names. If the latter scenario is true, then one may conclude that the Respondent has registered multiple trade marks as domain names and this would violate Article 9(b) of the CNDRP.

<table>
<thead>
<tr>
<th>Domain Name</th>
<th>Registation</th>
</tr>
</thead>
<tbody>
<tr>
<td>&lt;marshall.hk&gt;</td>
<td>Holder Name (English): LI JIN DONG</td>
</tr>
<tr>
<td></td>
<td>Holder Name (Chinese): 温州瑞祥剪纸有限公司</td>
</tr>
<tr>
<td>&lt;marshallheadphones.hk&gt;</td>
<td>Holder Name (English): LI JIN DONG</td>
</tr>
<tr>
<td></td>
<td>Holder Name (Chinese): 温州瑞祥剪纸有限公司</td>
</tr>
<tr>
<td>&lt;fenderchina.cn&gt;</td>
<td>李圣千</td>
</tr>
<tr>
<td>&lt;fenderguitars.cn&gt;</td>
<td>李圣千</td>
</tr>
<tr>
<td>&lt;guitarsquare.com.cn&gt;</td>
<td>潘孝云</td>
</tr>
</tbody>
</table>

The Panel is of the view that <guitarsquare.com.cn> is irrelevant to this case. Also, this one additional domain name registration would not be sufficient to prove that the Respondent has tried to prevent trademark owners from reflecting the names or the marks in corresponding domain names "on many occasions". Even if the Complainant's search method is accepted (using the Respondent's email address, instead of the Respondent's name, to conduct the reverse search), the total amount of identified domain names is still just 13. Comparing with the precedent cases in which hundreds of domains are registered, e.g., SnoopyBy Co Ltd. v Zhou Yan, Case No. DCN-1600698 (nearly 300 domain names), BASF SE v 金大军, Case No. DCN-1600674 (222 domain names), GiGlio S.P.A. v 林智茂, Case No. DCN-1500658 (596 domain names), the number of domain names using the Respondent's email address cannot be held to amount to "many occasions" as required by the Article 9(b) of the CNDRP.

**With regard to scenario (c):**

The Complainant argues that the Respondent:

"... registered <marshallheadphones.com.cn> for the purpose of disrupting the Complainant's normal business and is creating confusion with the Complainant's MARSHALL brand, so as to mislead the public into thinking that they are authorized or somehow associated with the Complainant and their acclaimed products".

To support this argument, the Complainant stated that it "reiterates their submissions in paragraphs 24-26" of its Complaint "as evidence..." (see para. 32 of the Complaint).

However, the Panel finds that "paragraphs 24-26" of the Complaint are largely legal arguments and quotations of precedent case decisions. The only factual element in these paragraphs is:
"...although the Respondent is only offering “MARSHALL” headphones, there is nothing on the domain which clearly explains the relationship between the Complainant and the Respondent." (See para. 25 of the Complaint.)

This statement appears to be based on the Complainant’s observation over the webpages under the disputed domain name. The Panel notes that the Complainant has submitted an Annex 16 showing a screenshot of the homepage of the said website under the disputed domain name. However, the screenshot merely shows a small part of the webpage, so Annex 16 is insufficient to support the above statement. In the meantime, as of the time of this decision, the domain name <marshallheadphones.com.cn> has not been accessible for independent verification of the above.

Before the Panel can make a decision, it is necessary to clarify whether the website under the disputed domain name had taken any measure (i) to explain the relationship between it and the Complainant or (ii) to distinguish itself from the Complainant’s website, so that Chinese consumers would not be confused about the owner of the disputed domain name.

To clarify this issue, the Panel requested the Complainant, in its Administrative Panel Order No. 1, to provide more comprehensive and clearer full screenshots taken from the website under the disputed domain name to supplement the partial screenshot of the home page of the disputed domain name currently provided in Annex 16. The Panel also requested the Complainant to submit any other factual evidence to support the Complainant’s contentions at paragraph 32 of the Complaint.

In response to Administrative Panel Order No. 1, The Complainant submitted further evidence showing screenshots of the website using the disputed domain name, as alleged by the Complainant. These screenshots present the following facts:

(i) the Respondent did not explicitly clarify or describe its relationship with the Complainant;

(ii) in the “About” page of the website under the disputed domain name, the Respondent stated that the website is selling Marshall headphones “exclusively” and is a "shopping guide" of Marshall headphones;

(iii) the website used a stylized “Marshall” mark to be its logo, which is exactly the same as the Complainant’s registered trademark.

The Panel notes that the Respondent failed to submit any comment to the supplemental evidence.

By reviewing the supplemental evidence, the Panel is of the view that, before its closure, the website under the disputed domain name may easily confuse Chinese
consumers regarding the operator. Such confusion may give consumers the impression that the disputed domain name has a connection with the Complainant, such that the website is selling Marshall headphones exclusively. Without any response from the Respondent as to its motives for registering the disputed domain name, despite requests to do so on two occasions in the course of these proceedings, it can be assumed that there is an element of bad faith. The fact that the disputed domain name is registered but has now been shut down and inaccessible to the public constitutes behavior that amounts to cybersquatting, which is also an indication of bad faith. Based on the above, and the failure of the Respondent to make any response to the Complainant’s contentions, it is reasonable for the Panel to conclude that the disputed domain name was registered by the Respondent for the purpose of "creating confusion between the Complainant and the Respondent so as to mislead the public", and therefore was registered in bad faith.

Comments to the Complainant’s Other Arguments:

While the Panel has found bad faith through the above analysis, it is necessary to clarify that the finding was based on facts as shown in the evidence submitted by the Complainant and the rules in relation to the parties’ burdens of proof. In fact, the Panel does NOT agree that the following arguments raised by the Complainant are helpful in establishing the element of "bad faith" in a domain name dispute conducted under the CNDRP procedure:

(1) "...the Respondent is passing off as an authorised reseller/distributor of "MARSHALL" products..." (see para. 32 of the Complaint)

(2) an "Algarn China" is "the only exclusive distributor for 'MARSHALL' products" in China (see paras. 11 and 32 of the Complaint); and

(3) the PRC national law in relation to unfair competition supports its Complaint (see para. 33 of the Complaint).

As stated in Oki Data Americas, Inc. v. ASD, Inc. (WIPO Case No. D2001-0903), it is important to keep in mind that the administrative dispute resolution proceedings for domain name disputes was designed to prevent the extortionate behavior commonly known as cybersquatting. It cannot be used to litigate all disputes involving domain names. If trademark owners wish to prevent the use of their marks at a webpage, they should seek recovery in classic trademark infringement or unfair competition litigations.

In this case, the Complaint submits many arguments that are irrelevant to the purpose of the domain name dispute. It does not focus on proving that the Respondent’s registration and use of the disputed domain name may disrupt the Complainant’s normal business or create confusion with the Complainant’s mark so as to mislead the public, but instead dedicated many paragraphs to discuss issues beyond the purpose of CNDRP proceedings. Briefly, the Panel explains why these arguments are irrelevant to the subject domain name case:
• "Passing off" is a cause of action (and not applicable in China) in some common law jurisdictions but not a piece of factual evidence; not only is it irrelevant to the determination of bad faith of a domain name registrant, it is a separate and totally irrelevant legal issue.

• The fact that a third party is the "exclusive distributor for 'MARSHALL' products" (bearing in mind that the Complainant has not actually submitted any evidence to prove this fact) is also irrelevant to the finding of bad faith. This is because, according to the laws in most jurisdictions (including China), so long as the Respondent is re-selling genuine products obtained from a legal source (e.g., from an authorized distributor overseas), the Respondent will not necessarily be found to have infringed upon the Complainant’s trademark rights.

• Article 5(2) and Article 5(3) of the PRC Anti-unfair Competition Law (the Complainant mistakenly presented the title as “the Chinese Unfair Competition Law”) are also other legal mechanisms governing other situations that are totally irrelevant to the domain name issue.

In sum, the Complaint has raised many irrelevant arguments and has not focused on submitting evidence to prove certain key facts, which has made the domain name resolution proceeding lengthy and contrary to the basic aim of alternative dispute resolution mechanisms.

5. Decision

The Panel accepts the Complainant’s request that the domain name <marshallheadphones.com.cn> be transferred.

Panelist: Loke-Khoon Tan

Date: June 12, 2017