ADMINISTRATIVE PANEL DECISION  
Case No. DCN-1700756

Complainant: voestalpine High Performance Metals Pacific Pte. Ltd.  
Respondent: 陈文武  
Domain Name: assabdongg.cn  
Registrar: 阿里云计算有限公司（万网）

1. Procedural History

The Complainant filed the Complaint with the Hong Kong International Arbitration Centre (the “Centre”) and chose to have a sole panelist handle the dispute on July 19, 2017, in accordance with the CNNIC Domain Name Dispute Resolution Policy ("CNDRP") issued by the China Internet Network Information Center ("CNNIC") and effective as of November 21, 2014, the Rules for CNNIC Domain Name Dispute Resolution Policy ("Rules of CNDRP") issued by the CNNIC and effective as of November 21, 2014, and the HKIAC Supplemental Rules for CNDRP and Rules of CNDRP ("Supplemental Rules"), issued by the Hong Kong International Arbitration Centre and effective as of November 21, 2014.

On July 19, 2017, the Centre transmitted by email to 阿里云计算有限公司（万网） (the Registrar of the domain name) a request for registrar verification in connection with the domain name at issue. On the same day, the Centre confirmed receipt of the said Complaint. On July 20, 2017, the said Registrar made the said verification to the Centre.

On July 27, 2017, the Centre sent the Complainant the Notification of Deficiencies of the Complainant, and notified the Complainant that the language of the domain name dispute resolution proceedings shall be Chinese. The Complainant was requested to rectify the said deficiencies on or before August 1, 2017. On July 28, 2017, the Centre confirmed the receipt of the filing fee. On August 1, 2017, the Centre noted the Complainant’s request of adopting English as the language of the proceedings with reasons, and confirmed that the complaint was in compliance with the Policy.

On August 2, 2017, the Centre sent the Notification of Commencement of Proceedings to the Respondent and requested the Respondent to reply within 20 days (on or prior to August 22, 2017), and forwarded the Complaint and its Attachments as well as the language request to the Respondent, in accordance with the Rules of CNDRP and the Supplemental Rules. The Respondent was also requested to submit a reply on the Complainant’s request of adopting English as the language of the proceedings within 5 calendar days (on or before August 7, 2017). The procedure for handling this case formally commenced on August 2, 2017. On August 24, 2017, the Centre issued a Default Notice and confirmed the Respondent had failed to file a formal reply with the Centre within the required time limit.
On August 30, 2017, the Centre appointed Mr. Matthew Murphy as the sole panelist for arbitrating this case. The Panel considered its constitution to be proper, and subsequently submitted an acceptance notice as well as a statement of impartiality and independence. The Centre formally transferred the case to the Panelist on the same day. The Panelist agreed to deliver his decision with respect to the Disputed Domain Name on or prior to September 13, 2017.

2. Factual background

For the Complainant

The Complainant, voestalpine High Performance Metals Pacific Pte. Ltd. (formerly ASSAB Pacific Pte Ltd), claims that it was formed in 1945 to market high quality tool steel from Sweden and renowned for its quality standards. With its headquarters in Singapore, the Complainant claims that it operates almost 50 offices in the Asia Pacific region, supplying steel, metallurgical tooling services and technical know-how. It further claims that, through anchoring the distribution networks for Uddeholm, they together, service leading multinational companies across practically all key industrial sectors in more than 90 countries.

The Complainant claims that in the greater China region, it is called Yi Sheng Bai (一胜百) which means “One beats One Hundred” and this underlines its position as an industry leader. It claims that its history in China can be dated back more than 60 years, and its tool steel were distributed in southern China in the mid-1950s. The Complainant claims that it established its first wholly owned outlet in Shenzhen in the early 1990s; and since then it has grown to be the leading foreign distributor of quality tool steels and services in China, with more than 500 employees in 22 locations and 18 affiliates across China, including but not limited to Beijing, Chongqing, Dalian, Dongguan and so on. The Complainant further claims that the total amount of sales of its products in China reached 1.36 billion (no currency was specified) from 2006 to 2011, and it has also participated in several trade fairs/exhibitions in China (from 2007 to 2011) including several that held in Dongguan, Guangdong Province.

In addition, the Complainant claims that it holds trademark registrations for the “ASSAB” trademark and other related trademarks (“ASSAB Marks”) in various jurisdictions worldwide. Among the ASSAB Marks, the Complainant registered its No. 19570513 “ASSAB” mark in class 6 in Hong Kong on July 31, 1957. It also owns many ASSAB Marks in Mainland China, such as No. 1055408 for “一胜百 ASSAB” in class 6 registered on July 14, 1997, No. 13443140 for “ASSAB” in class 6 registered on February 28, 2015, No. 13443138 for “ASSAB” in class 8 registered on January 21, 2015 and No. 13443137 for “ASSAB” in class 40 registered on January 21, 2015.

For the Respondent

The Respondent, 陈文武, is an individual with an Email contact of 13640936239@163.com. The Respondent registered the Disputed Domain Name on
January 14, 2017. The Respondent did not file any Reply or any other materials with the Centre within the required time limit.

3. Parties’ Contentions

A. Complainant

The Complainant’s contentions may be summarized as follows:

i. The disputed domain name(s) is/are identical or confusingly similar to a trademark or service mark in which the Complainant has rights

The Complainant claims that the disputed domain name <assabdongg.cn> contains two elements: "assabdongg" and top-level domain "cn"; and since the top-level domain "cn" does not confer distinctiveness to the domain name, the only distinctive part of the disputed domain should be "assab", which is identical to its "ASSAB" trademark. The Complainant claims that "dongg" may indicate the city of "Dongguan" in Guangdong Province which cannot be recognized distinctive, on the grounds that it has a Dongguan subsidiary named ASSAB Tooling (Dongguan) Co., Ltd and it had also participated in several trade fairs and exhibitions in Dongguan. The Complainant considers that the consumers will be confused by the use of "dongg" in the disputed domain, as they may believe that it is an entity or subsidiary affiliated with the Complainant in some way. Thus, the Complainant claims that the disputed domain name <assabdongg.cn> contains the Complainant’s “ASSAB” trademark and the Complainant's trade name in its entirety, and such striking resemblance will no doubt mislead consumers into believing that the website is operated by or associated with the Complainant.

ii. The Respondent has no rights or legitimate interests in respect of the domain name

The Complainant claims that the disputed domain name was registered on January 14, 2017, long after most of the application and registration dates of the Complainant's "ASSAB Marks". The Complainant claims that it has no prior connection with the Respondent, nor authorizing the latter to use its mark in the disputed domain name. The Complainant contends that ASSAB is not a term commonly used in the English language and there is no evidence that the Respondent has been commonly known by the disputed domain. It considers that the Respondent uses the disputed domain name as a deliberate attempt to take advantage of the "ASSAB" mark for commercial gain. The Complainant further contends that it has established a prima facie case that the Respondent has no rights and legitimate interests in the disputed domain name and thereby the burden of proof shifts to the Respondent to produce evidence demonstrating rights or legitimate interests in respect of the disputed domain name.

iii. The disputed domain name(s) has/have been registered and is/are being used in bad faith
The Complainant claims that the disputed domain name has been registered and is being used in bad faith, on the basis of following: 1) the long history and high degree of fame enjoyed by the Complainant and its trademarks in the world, including in 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 in its entirety in the disputed domain name; 4) the striking similarity of the Complainant's and the Respondent's websites; 5) the false and misleading claims regarding its history on the website; and 6) the use of the Complainant's Chinese mark “一胜百 (ASSAB in Chinese)” in its Chinese company name.

iv. In the Supplement to the Complainant submitted on August 1, 2017, the Complainant requested to adopt English as the language of the proceedings, whereas according to the CNDRP Rules the language of the domain name dispute resolution proceedings herein shall be Chinese. The Complainant argues that using English as the language of the proceedings herein does not contravene the principle of justice and fairness when the Respondent has demonstrated that it is proficient in English (by registering the Disputed Domain Name in English) and is capable of presenting its case in English. The Complainant further argues that it would be unfair if the Complainant (a Singaporean company) is burdened with the costs to translate the Complaint and Exhibits, when the Respondent is clearly proficient in English.

B. Respondent

The Respondent did not submit any Reply.

4. Findings

Language of the Proceedings

The Complainant filed the Complaint with the Centre in English, and later requested English be the language of the proceeding based on the following reasons: 1) the Complainant is a foreign company and the materials submitted are mostly in English. The translation of all the evidence would cause tremendous costs, time and be unfair to the Complainant; 2) the Disputed Domain Name is in English and contains the Complainant’s trademark “ASSAB”; and 3) the Disputed Domain Name is resolved to a website in Chinese and English; as such the Respondent should have knowledge of the English language.

Following the line of reasoning in previous cases, when deciding “whether to allow the proceedings to be conducted in a language other than the language of the Registration Agreement, and to require the Complainant in an appropriate case to translate the Complaint into the language of that agreement, the Panel must have regard to all ‘the relevant circumstances’”. And such circumstances include “whether the Respondent is able to understand and effectively communicate in the language in which the Complaint has been made and would suffer no real prejudice, and whether the expenses of requiring translation
and the delay in the proceedings can be avoided without at the same time causing injustice to the parties” - See WIPO Case SWX Swiss Exchange v. SWX Financial LTD, D2008-0400.

Accordingly, the Panel notes the following circumstances in this case that may affect the determination of the language of the proceedings:

(1) The Disputed Domain Name Website presents contents in both English and Chinese.
(2) The Respondent had been notified of the Complaint against him/her and was invited to provide comments on the Complainant’s language request through email communications written in both Chinese and English by the Centre.
(3) The Respondent did not raise any objection with respect to the Complainant’s language request, nor make any comments.
(4) The Complainant, as a foreign entity, is not able to understand Chinese at all, and most of the materials presented thereby are in English, which would take a lot of time and additional cost for such Chinese translation, and therefore, a delay in the proceedings will be inevitable.

Based on the above, as well as CNDRP precedents that conducted in English (e.g. Case No. DCN-1500624), the Panel considers that: it is reasonable to infer that the Respondent probably has the language ability of English, and therefore, should be able to understand the English used in the proceedings. Even if the Respondent might have any difficulties of understanding English, since all the email communications were written in both Chinese and English, the Respondent must have been fully aware of the language request raised by the Complainant, and should have understood that what would happen if the proceeding is determined to be conducted in English. However, with sufficient time and opportunity to comment on or object to such language request, the Respondent did nothing.

Thus, upon weighing relevant circumstances on both sides, the Panel considers it would be appropriate to exercise its discretion and conduct the proceedings in English.

As to the case, 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 considers that:

**Identical or Confusing Similarity**
The Complainant has established its right to the “ASSAB” trademarks by submitting trademark registration certificates and records across various jurisdictions, such as Hong Kong, mainland China and so on.

There is no doubt that the Disputed Domain Name <assabdongg.cn> completely incorporates the Complainant’s “ASSAB” trademark. The first and immediately striking element in the Domain Name is the Complainant’s name (Note, in the current case, it is also the Complainant’s trademark). Adoption of it in the Domain Name is inherently likely to lead people to believe that the Complainant is connected with it - See: Dixons Group Plc v. Mr. Abu Abdullaah, WIPO Case No. D2000-0146.

With respect to the “dongg”, the Panel notes that the Disputed Domain Name is resolved to a website operated under a “company”, located in Dongguan, named “东莞一胜百模具钢有限公司 (Dongguan ASSAB Tooling Steel Co., Ltd)”, which is coincidently very similar to the name of the Complainant’s Dongguan affiliate “ASSAB Tooling (Dong Guan) Co., Ltd.”. Thus, it would be reasonable for the Panel to infer that the “dongg” part indicates the Dongguan city where the operating company of the Disputed Domain Name Website is located. In other words, the “dongg” in the Disputed Domain Name can be deemed as a geographical term, which does not help much to reduce the confusing similarity. Even if it cannot be inferred as a disguised form of “Dongguan”, considering the great fame possessed by the Complainant’s “ASSAB” mark, the addition of such part will not affect the distinctiveness of the “ASSAB” trademark in the Disputed Domain Name much. As to the gTLD “.cn” in the Disputed Domain Name, it should be ignored when it comes to decide confusingly similarity - See: Rohde & Schwarz GmbH & Co. HG v. Pertshire Marketing, Ltd., WIPO Case No. D2006-0762. Thus, the Disputed Domain Name and the Complainant’s “ASSAB” trademark possess the similarity that is sufficient to cause confusion.

Accordingly, the Panel concludes that the Domain Name is confusingly similar to Complainant's mark and the Complainant has satisfied Article 8.1 of the CNDRP.

Rights or Legitimate Interests of the Respondent

The Complainant claimed that the burden of proof with respect to the Respondent’s rights and/or legal interest in the Disputed Domain Name should be shifted to the Respondent, based on the fact that it has been owning the exclusive right of the “ASSAB” trademark years before the registration of the Disputed Domain Name by the Respondent. “Once a Complainant makes out a prima facie showing, the burden of production on this factor shifts to the Respondent to rebut the showing by providing concrete evidence that it has rights to or legitimate interests in the Domain Name.” - See: Document Technologies, Inc. v. International Electronic Communications Inc., WIPO Case No.: D2000-0270. Thus, the Panel finds that it is appropriate to shift the burden of proof to the Respondent.

Upon comprehensively considering the circumstances of the case, the Panel considers that the Respondent does not have legal right and interest to the Disputed Domain Name on the grounds that:
1) Without submitting any evidence to prove that the Respondent has any legal right and interest to the Disputed Domain Name, the Respondent could not sufficiently prove that it “owns legal right and interest thereof” by the mere registration of the Disputed Domain Name - See: Adobe Systems Incorporated v. Domain OZ, WIPO Case No.: D2000-0057.

2) The Complainant has confirmed that it has no prior connection with the Respondent in any way, nor has authorized the Respondent to use its trademarks in the Disputed Domain Name.

3) The Respondent failed to prove and there is no evidence indicating that it has been commonly known by the Disputed Domain Name, nor has making a legitimate noncommercial or fair use thereof, as it is provided in the Article 10.2.

4) Instead, the Complainant has provided evidence to show that the Respondent has been using the Disputed Domain Name to mislead the consumers in bad faith, other than providing bona fide goods or services, which does not only fail to fulfill circumstances of having legal right and interest provided in the Article 10.2, but also in the suspicious of violating relevant laws and regulations.

Accordingly, the Panel concludes that the Complainant has satisfied Article 8.2 of the CNDRP.

**Bad Faith**

The Complainant, by submitting sufficient material, tried to prove that it has operated in China for years by using its “ASSAB” trademark; and therefore, it has obtained high reputation in its professional field. The Complainant also claimed that the Respondent must have had prior knowledge of its trademarks before the registration of the Disputed Domain Name on January 14, 2017.

Although the Respondent did not submit any response with respect to the said claim, upon comprehensively considering following circumstances, it is reasonable for the Panel to infer, based on the following, that the Respondent had known of the existence of the Complainant and “ASSAB” trademarks thereof, when registering the Disputed Domain Name, and such registration was therefore in bad faith:

1) the fame of the Complainant and its “ASSAB” trademarks in the relevant field;
2) similarity between the Disputed Domain Name and the Complainant’s trademarks;
3) similarity between the Disputed Domain Name and domain names (www.assab.com and www.assab-china.com) owned by the Complainant;
4) there is no legal nor factual relation or connection between the Respondent and the Disputed Domain Name and/or the ASSAB trademarks, nor any other justification for the registration or use of the Disputed Domain Name by the Respondent;
5) the content of the Disputed Domain Name Website, which indicates that the Respondent had acknowledged the Complainant as well as its brand/product.

With respect to the use of the Disputed Domain Name, the Panel has noted that 1) the Respondent has been using the Complainant’s “ASSAB” trademarks at a prominent location in the Disputed Domain Name Website without authorization; 2) the Website claims itself as “东莞一胜百模具钢有限公司 (Dongguan ASSAB Tooling Steel Co., Ltd)” which has almost the identical name of the Complainant’s Dongguan affiliate “ASSAB
Tooling (Dong Guan) Co., Ltd.”; and 3) the Website contains the Complainant’s “ASSAB” series trademarks, product photos, company history and the like.

“Using the disputed domain name with intention of creating a likelihood of confusion with that of the Complainant’s mark as to source, sponsorship, affiliation or endorsement of the Respondent’s services by using an identical name or a close approximation for commercial gain from the goodwill and fame associated with the Complainant's mark indicates that the Respondent is deliberately trying to free ride on the Complainant's mark.” - See WIPO Case Info Edge (India) Limited v. Abs, Abs IT Solution, D2014-1688.

Obviously, due to the confusingly similarity between the Disputed Domain Name and the Complainant’s trademarks as well as the content in the Disputed Domain Name Website, the Respondent intends to create a false impression that it has been operated by an affiliate of the Complainant located in Dongguan, in order to attract Internet users who intend to visit the Complainant’s website. When such users are visiting the Respondent’s website due to the false impression mentioned above, they may click the links contained therein which results in profit gaining by the Respondent. Thus, the use of the Disputed Domain Name Website by the Respondent does not only constitute free-ride of the Complainant’s trademarks, but also in the suspicious of infringing of the Complainant’s trademark right as well as unfair competition, which means that the use of the Disputed Domain Name by the Respondent is in bad faith.

Accordingly, the Panel concludes that the Complainant has satisfied Article 8.3 of the CNDRP.

5. Decision

Pursuant to Article 40 of the CNDRP Rules, this Panel orders that the domain name <assabdongg.cn > be transferred to the Complainant.

Panelist: Matthew Murphy
Date: September 11, 2017