

Decision for dispute CAC-UDRP-104378

Case number	CAC-UDRP-104378
Time of filing	2022-03-02 09:45:41
Domain names	surface-shanghai.com, surface-shenzhen.com, sh-surface.com, surface-ser.com, ifixsurface.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
--------------	---------------------------------

Complainant

Organization	Microsoft Corporation
--------------	-----------------------

Complainant representative

Organization	Convey srl
--------------	------------

Respondent

Name	xiao song qi
------	--------------

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the SURFACE trademark including but not limited to the followings:

- International Trademark No. 1321384 – SURFACE - Classes 9, designating also China;
- International Trademark No. 1135373 – SURFACE - Classes 9, 15, designating also China;
- International Trademark No. 1508162- SURFACE DUO – Classes 9 designating also China;
- International Trademark No. 1525697- SURFACE NEO – Classes 9 designating also China;
- European Union Trademark No. 005955018 – MICROSOFT SURFACE - Classes 9 and 42; and
- European Union Trademark No. 006340152 – SURFACE - Classes 9 and 42.

Microsoft Surface is a series of touchscreen-based personal computers, tablets and interactive whiteboards designed. The trademark “SURFACE”, registered and used since many years, is distinctive and well known all around the world in the sector of IT.

FACTUAL BACKGROUND

The Complainant, Microsoft Corporation, is a company founded on April 4, 1975 and headquartered in Redmond, Washington, USA. It develops, manufactures, licenses, supports, and sells computer software, consumer electronics, personal computers, and related services. The name Microsoft derives from the words microcomputer and software. The Complainant was founded by Bill Gates and Paul Allen.

Today, Microsoft is amongst the leading players in the world hi-tech, with about 120 subsidiaries and 160,000 employees worldwide. In 2021 the revenues were more than USD 168 billion and its ranked number 21 in the 2021 Fortune 500 rankings of the largest United States corporations by total revenue.

The Respondents, Xiao Song Qi and Wan Lu Lu, are both located in Shanghai.

The Registration Date of the disputed domain names are as below:

- <surface-shanghai.com>: 2020-02-21
 - <surface-shenzhen.com>: 2020-07-26
 - <sh-surface.com>: 2017-09-05
 - <surface-ser.com>: 2018-01-02
-

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

First, the Complainant claims rights in the SURFACE marks through its trademark registrations. By virtue of its trademark registrations, Complainant has proved that it has rights in the mark under paragraph 4(a) of the Policy. See Avast Software s. r. o. v Milen Radumilo, 102384, (CAC 2019-03-12).

Second, the Complaint contends that addition of generic terms as “sh”, “ser”, and the geographical terms “shanghai” and “shenzhen” in the disputed domain names increase the confusing similarity. In addition, the “.com” generic top-level domain (“gTLD”) is irrelevant when establishing whether or not a mark is identical or confusingly similar for the purposes of paragraph 4(a)(i) of the Policy.

For the foregoing reasons, the Panel finds the Complainant has satisfied paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a)(ii) of the Policy). More specifically, the Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name, and the burden of prove then shifts to the Respondent to show it does have rights or legitimate interests. See PepsiCo, Inc. v Smith power production, 102378, (CAC 2019-03-08) ("The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.").

First, the Complainant claims that the Respondents are not licensees, authorized agents of the Complainant or in any other way authorized to use Complainant’s trademark. Specifically, the Respondents are not authorized resellers of the Complainant and have not been authorized to register and use the disputed domain names. In addition, the Complainant further claims that the Respondents are not commonly known by the disputed domain names as individuals, business or other organization and their family name do not correspond to MICROSOFT or the disputed domain names.

Second, the Complainant further asserts that the use of the disputed domain names cannot be deemed in connection with the bona fide offering of goods or services, according to the Oki Data Test. In the case at hand, Respondent's websites, corresponding the disputed domain names, do not comply with the third and fourth requirement of the Oki Data criteria:

- the site must accurately disclose the registrant's relationship with the trademark owner;
- 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 Respondent has registered five domain names including the Complainant's trademark).

The Panel finds that the Complainant has established a prima facie case that the Respondents have no rights or legitimate interests in the disputed domain names. The burden of proof has been shifted to the Respondents to prove that they have right or legitimate interests to the disputed domain names. However, the Respondents have not submitted an official response to rebut the assertion and only sent an email to CAC stating that the disputed domain names are no longer needed.

For the foregoing reasons, the Panel finds the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

First, the Complainant reaffirms that the trademark SURFACE is widely known in the sector of hi-tech and, in light of its use, has become known worldwide. The disputed domain name <sh-surface.com> redirected traffics to an active website but the use could not be deemed in good faith and therefore there is no evidence of contemplated good faith use. Actual knowledge of a complainant's rights in a mark prior to registering a confusingly similar domain name evinces bad faith under paragraph 4(a)(iii) of the Policy. See ARCELORMITTAL (SA) v. acero, 102399 (CAC 2019-04-22). The Panel is of the view that at the time of registration of the disputed domain names, the Respondents knew, or at least should have known, of the existence of the Complainant's trademark and that registration of domain names containing well-known trademarks constitutes bad faith per se. The Panel also notes that the disputed domain names were registered at least 10 years after the registration of Complainant's first SURFACE trademark. The Respondents passively holding other disputed domain names <surface-shanghai.com>, <surface-shenzhen.com> and <surface-ser.com> constitutes bad faith. The Panel agrees with Complainant and finds that Respondents should have actual knowledge of Complainant's mark, demonstrating bad faith registration under Policy paragraph 4(a)(iii).

Second, the Complainant asserts that the Respondents failed to respond to the previous cease and desist letter which can be an additional evidence of bad faith. The Panel agrees with the previous panels that failure to respond to a cease-and-desist letter may properly be considered a factor in finding bad faith registration and use of a domain name, see Novartis AG vs. Cairo, 104265 (CAC 2022-02-15).

For the foregoing reasons, the Panel finds the Complainant has satisfied paragraph 4(a)(iii) of the Policy.

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRELIMINARY FINDINGS - CONSOLIDATION:

Pursuant to Paragraph 10(c) of the Rules that a Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules. The Rules further state that Respondent means the holder of a domain-name registration against which a complaint is initiated. The Panel issued Procedural Order No. 1 in related to the disputed domain names.

1. The Complainant is required to clarify that (i) the disputed domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. The revised complaint and/or annexes shall be

submitted on or before April 14, 2022.

2. The Respondent shall submit a Response on or before April 17, 2022.

The Complainant submitted a timely supplemental complaint about the common features that:

- the disputed domain names are having the same extension of the domain names. i.e. .com;
- the Registrants are all located in the same country, i.e. China;
- the Registrants are all located in the same [city] (except for <ifixsurface.com>: Guangzhou), i.e. Shang Hai;
- the trademark SURFACE is included in each of the disputed domain names;
- the disputed domain names are having the same registrar, i.e. Alibaba Cloud Computing (Beijing) Co., Ltd.;
- the disputed domain names are having the same name server, i.e. HICHINA.COM (aka Alibaba Cloud).

The Respondent did not respond to Complainant's supplemental complaint within the required period of time.

The Panel agrees that Complainant's SURFACE trademark appears in each of the 5 disputed domain names and 4 out of the 5 disputed domain names are under control by the Registrants in Shanghai. The Panel also notes that all of the disputed domain names are being managed by the same Registrar and using the same name servers. However, the Panel notes a key differentiation from the WHOIS information of the disputed domain names that the Registrant of <ifixsurface.com> is located in Guangzhou which is more than 1,200 kilometers away from the other Registrants in Shanghai. There is no clear and convincing evidence showing that <ifixsurface.com> is also under common control with the other disputed domain names.

Having reviewed the submitted information and also considered the key considerations listed out under Article 4.11.2 of the WIPO Overview 3.0, the Panel agrees that <surface-shanghai.com>, <surface-shenzhen.com>, <sh-surface.com> and <surface-ser.com> are under common control by the Respondents Xiao Song Qi and Wan Lu Lu. The disputes between the Complainant and these 2 Respondents regarding to the 4 disputed domain names shall be consolidated. <ifixsurface.com> shall be removed from the present complaint without a detailed review of the 3 elements under paragraph 4(a) of the Policy. See TOD'S S.p.A. vs. Gerald Penkler, 102841, CAC 2020-02-06 ("The Panel further concludes in the circumstances of this case that consolidation would be fair and equitable to all parties and procedurally efficient, and therefore will allow the consolidation for only 2 of the disputed domain names, namely <todsshoesondiscount.com> and <todsturkeyoutlet.com> pursuant to paragraphs 3 and 10 (e) of the Rules.")

PRELIMINARY FINDINGS - LANGUAGE OF PROCEEDING:

The Panel notes that the language of the Registration Agreement is Chinese as confirmed by the Registrar, Alibaba Cloud. The official Complaint was submitted in English and the Respondents did not submit an official response. Pursuant to paragraph 11 of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

The Complainant requests to use English as the language of proceeding, with the arguments that the disputed domain names are composed of Latin script and it would be disproportionate to require the Complainant to submit the Complaint in Chinese, as this would result in additional expense and unnecessary delay for the Complainants for translation. The Respondents have not declined to use English as the language of proceeding of the current case.

The Panel is bilingual and is well equipped to deal with the proceeding in both Chinese and English. Having considered the circumstances, Panel believes that it would be fair to both parties to use English as the language of proceeding and it can also uphold the principle of UDRP being a swift dispute resolution process. On this basis, the Panel determines that the language requirement has been satisfied through the English language Complaint and bilingual notices served by CAC, and decides that the language of proceeding to be English.

Having established all three elements required under the UDRP Policy, the Panel concludes that the disputed domain names <surface-shanghai.com>, <surface-shenzhen.com>, <sh-surface.com> and <surface-ser.com> be transferred from the Respondents to the Complainant.

The consolidation request of the dispute related to <ifixsurface.com> is hereby rejected and the dispute may be refiled and decided in another case.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Partially Accepted/Partially Rejected

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **SURFACE-SHANGHAI.COM**: Transferred
2. **SURFACE-SHENZHEN.COM**: Transferred
3. **SH-SURFACE.COM**: Transferred
4. **SURFACE-SER.COM**: Transferred
5. **IFIXSURFACE.COM**: Remaining with the Respondent

PANELLISTS

Name	Mr Paddy TAM
------	---------------------

DATE OF PANEL DECISION	2022-04-20
------------------------	------------

Publish the Decision