Decision for dispute CAC-UDRP-106523

Case number	CAC-UDRP-106523
Time of filing	2024-05-27 09:13:13
Domain names	zoomlion-rus.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Zoomlion Heavy Industry Science and Technology Co., Ltd.

Complainant representative

Organization	Chofn Intellectual Property

Respondent

Name	Artem Vayntraub

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 name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of a number of trademark registrations for “ZOOMLION” (the ”ZOOMLION trademark”), including the following:

- the Russian trademark ZOOMLION with registration No. 364793, registered on 14 November 2008 for goods in International Class 7; and

- the Russian trademark ZOOMLION with registration No. 374761, registered on 18 March 2009 for goods in International Class 12.

FACTUAL BACKGROUND

The Complainant was founded in 1992. It develops and manufactures high-tech equipment such as engineering machinery and agriculture machinery, as well as new types of construction materials. In 2009, the Complainant’s ZOOMLION trademark was recognised as a well-known trademark in China. The Complainant has been included in the list of Fortune China’s top 500 companies since 2010.

The Complainant is the owner of the domain name <zoomlion.com>, registered on 29 June 2001.

The disputed domain name <zoomlion-rus.com> was registered on 24 September 2021. It currently resolves to a Russian language online shop that offers the Complainant's ZOOMLION products.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant submits that the disputed domain name is confusingly similar to its ZOOMLION trademark, as it incorporates the trademark entirely, and the addition of the sequence "rus" (abbreviation for "Russian") is not sufficient to escape the confusing similarity to the ZOOMLION trademark.

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name, because it is not commonly known by it, has no relevant trademark rights, and is not related to the Complainant or authorized by it to register and use a domain name that includes the ZOOMLION trademark. The Complainant maintains that the Respondent's use of the disputed domain name is not fair, because it reflects an intent to trade on the reputation of the Complainant's trademark and falsely suggests to Internet users that the associated website belongs to or is affiliated with the Complainant.

The Complainant states that the disputed domain name was registered and is being used in bad faith. It claims that its ZOOMLION trademark had already achieved a high level of global recognition at the time when the Respondent registered the disputed domain name, so it must have had knowledge of the trademark at this time. The Complainant adds that the Respondent's knowledge is confirmed by the fact that the Respondent's website has the same content as the Complainant's official website.

The Complainant notes that the website at the disputed domain name is related to the Complainant's business and features the ZOOMLION trademark. According to the Complainant, this shows that the Respondent uses the disputed domain name to intentionally attempt to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the ZOOMLION trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or of the products and services offered there.

RESPONDENT:

The Respondent did not submit a Response in this proceeding.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is 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).

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 name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

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

PROCEDURAL FACTORS

Language of the proceeding

The language of the Registration Agreement for the disputed domain name is Russian. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless 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.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion

judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 4.5.1).

The Complainant requests that the language of the present administrative proceeding to be English. The Respondent has not taken any position on this issue and has otherwise remained inactive throughout the proceeding. The Respondent was informed about the proceedings in Russian language and also accessed the online case file on June 20, 2024, but never replied nor requested translations.

Having considered the above, the Panel decides that it is more likely than not that the Respondent would not be prejudiced if the language of the administrative proceeding was English, and that using this language would contribute to the efficiency of the proceeding. On this basis, the Panel decides that the language of the administrative proceeding shall be English.

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.

PRINCIPAL REASONS FOR THE DECISION

Pursuant to the Policy, paragraph 4(a), a complainant must prove each of the following to justify the transfer of a domain name:

(i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;

(ii) the respondent has no rights or legitimate interests in respect of the domain name; and

(iii) the domain name was registered and is being used in bad faith.

In this case, the Provider has employed the required measures to achieve actual notice of the Complaint to the Respondent, and the Respondent was given a fair opportunity to present its case.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: "[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name …"

In this proceeding, the Respondent has not used the opportunity provided to it under the Rules and has not submitted a substantive Response addressing the contentions of the Complainant and the evidence submitted by it.

Identical or confusingly similar

The Complainant has provided evidence and has thus established its rights in the ZOOMLION trademark.

The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the general Top-Level Domain ("gTLD") section of domain names for the purposes of the comparison under the Policy, paragraph 4(a)(i). The Panel sees no reason not to follow the same approach here, so it will disregard the ".com" gTLD section of the disputed domain name.

The disputed domain name reproduces the ZOOMLION trademark entirely with the addition of a hyphen and of the element "rus". As noted by the Complainant, this is a commonly used abbreviation for "Russia" or "Russian". The addition of this non-distinctive element has a low effect on the overall impression made by the disputed domain name, in which the ZOOMLION trademark dominates and is easily recognizable. As discussed in section 1.8 of the WIPO Overview 3.0, in cases where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.

In view of the above, the Panel finds that the disputed domain name is confusingly similar to the ZOOMLION trademark in which the Complainant has rights.

Rights and legitimate interests

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, because there is no relationship between the Parties and the Respondent is not commonly known under the disputed domain name. The

Complainant points out that the disputed domain name is not used for a bona fide activity, because it resolves to a website that copies the website of the Complainant and displays the ZOOMLION trademark. Thus, the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not submitted a Response and has not disputed the Complainant's prima facie case or provided a plausible explanation for the registration and use of the disputed domain name.

The Panel considers that the circumstances of this case do not support a finding that the Respondent has rights or legitimate interests in it. The disputed domain name fully incorporates the Complainant's ZOOMLION trademark in combination with an abbreviation for "Russia", which creates a risk of implied affiliation, more so taking into account its use for a Russian language website offering goods under the ZOOMLION trademark and containing no disclaimer for the lack of relationship with the Complainant, but including a statement that appears as an official endorsement of the Respondent's website by the Complainant.

The Respondent's website includes the header "Зумлион Рус – официальный поставщик техники Zoomlion", translated in English as "Zoomlion Rus – official supplier of Zoomlion equipment". The website also claims that "Зумлион в России и СНГ – единственный официальный дистрибьютор Подьемников Zoomlion в России", which translates in English as "Zoomlion in Russia and the CIS - the only official distributor of Zoomlion lifts in Russia".

Perhaps most importantly, the website also contains a statement purportedly by the General Manager of the Complainant:

"Рад приветствовать на сайте zoomlion-rus.com, где Вашему вниманию представлен полный ассортимент подъемного оборудования (MEWP), производимого Компанией Zoomlion Heavy Industry Science & Technology Co., Ltd.

Мы рады, что продукция ZOOMLION, хорошо известная в более чем 100 странах мира, теперь, с помощью zoomlionrus.com, еще шире представлена в Российской Федерации и наши MEWP стали доступнее взыскательным российским потребителям.

Tan Zhong

General Manager Zoomlion Heavy Industry Science & Technology Co., Ltd."

This statement is translated in English as:

"Welcome to zoomlion-rus.com, where you will find a full range of Zoomlion Heavy Industry Science & Technology Co., Ltd. lifting equipment (MEWP).

We are pleased that ZOOMLION products, well known in more than 100 countries around the world, are now even more widely available in the Russian Federation through zoomlionrus.com and that our MEWPs are now more accessible to discerning Russian customers.

Tan Zhong

General Manager Zoomlion Heavy Industry Science & Technology Co., Ltd."

The design and content of the Respondent's website featuring the ZOOMLION trademark and including the above statements and images of the Complainant's Zoomlion lifting equipment creates a strong impression that the website at the disputed domain name is officially authorized by the Complainant and operates as the online location of its exclusive distributor for the Russian Federation. This is contrary to the cumulative requirements of the Oki Data test (see section 2.8 of the WIPO Overview 3.0), namely that the Respondent's website should accurately and prominently disclose the lack of relationship between the Parties, and thus cannot give rise to rights or legitimate interests of the Respondent in the disputed domain name.

On this basis, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name.

Bad faith

Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

"(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location."

The registration of the Complainant's ZOOMLION trademark predates with fourteen years the registration of the disputed domain name, which is confusingly similar to it. The associated website is deceptively designed to appear as belonging to the Complainant's authorized distributor for the Russian Federation and includes no disclaimer for the lack of relationship between the Parties. This leads the Panel to the conclusion that the Respondent has registered and is using the disputed domain name with knowledge of the Complainant's ZOOMLION trademark and with the intention to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademark as to the affiliation or endorsement of the Respondent's website and of the products and services offered there. This satisfies the Panel that the disputed domain name has been registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **zoomlion-rus.com**: Transferred

PANELLISTS

Name	**Assen Alexiev**

DATE OF PANEL DECISION 2024-06-24

Publish the Decision