# Decision for dispute CAC-UDRP-106687

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| Case number | CAC-UDRP-106687 |
| Time of filing | 2024-07-18 09:26:02 |
| Domain names | ZOOMLIONAUSTRALIA.COM |

## Case administrator

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| Name | Olga Slanařová (Case admin) |

## Complainant

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

## Complainant representative

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| Organization | Beijing Chofn Intellectual Property Agency Co., Ltd. |

## Respondent

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| Name | joe chaya |

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant has adduced evidence showing that it is the owner of the following protected marks for the brand and corporate name ZOOMLION:

1. Australian trademark No.1197054 (word), registered on 4 September 2007 in Nice Classification List class 7;

2. Australian trademark No. 1197074 (figurative), registered on 4 September 2007 in Nice class 7;

3. Australian trademark No. 1221106 (figurative), registered on 25 January 2008 in Nice classes 7 and 12;

4. US trademark No. 4898596, registered on 9 February 2016 in Nice class 7;

5. US trademark No. 4898597, registered on 9 February 2016 in Nice class 12;

6. US trademark No. 4898803, registered on 9 February 2016 in Nice class 11; and

7. International trademark No. 1312443, registered on 29 March 2016 in Nice classes 7, 11 and 12 on the basis of a Chinese trademark.

The Complainant claims that it has filed for or obtained other trademarks for its brand in countries and regions in which it has frequent business activities, but it has not submitted evidence in their regard or in respect of domain names for which it is

registrant.

The Respondent registered the disputed domain name <zoomlionaustralia.com> on 28 June 2021 according to the Registrar Verification performed by the CAC Case Administrator.

## FACTUAL BACKGROUND

Zoomlion Heavy Industry Science and Technology Co Ltd, the Complainant, was founded in 1992 in China. Its primary activity is in the area of research and development on and manufacturing of engineering equipment and agriculturale machinery. It also develops and manufactures new types of construction materials. Its main products encompass 18 categories with 105 product series and 636 models. The type of machinery concerned includes tower cranes, crawler cranes, concrete pump trucks and wheeled cranes, for all of which the Complainant has won China's Manufacturing Industry Individual Champion award several times. Its products for the agricultural sector include dry-field and paddy-field tillage machinery and machinery designed for cash-crops and post-harvest handling. The Complainant exports to and is active in over a hundred countries with a permanent presence in half of them. It participates in the Belt and Road initiative and is listed on both the Hong Kong and Chinese stock markets. Its registered capital is RMB 8.7 billion, its total assets are worth RMB 136.7 billion, and it had a worldwide turnover in 2022 of RMB 41.6 billion. It is ranked by Fortune magazine as being one of China's top 500 companies.

The Complainant provided historical screenshot evidence showing a web page resolving to the disputed domain name. This is a parking page provided by the internet service provider which hosts the disputed domain name and it displays that name.

The Case File in this proceeding shows, as regards communication with the Respondent, that e-mail notice of the proceeding was sent to the disputed domain name's postmaster address and to another address which was given for the Respondent at registration. The CAC Case Administrator reports that no proof of delivery was received by the CAC Case Administrator for either of the e-mail notices or for a notice sent by letter.

The Panel's scrutiny of the Case File included a routine check of the registrant contact details as determined in the Registrar Verification. This check revealed that the Respondent had registered the disputed domain name by giving a fanciful e-mail address and had inputted contact details, including the Respondent's name, in a textually inconsistent manner. The telephone number given furthermore incorrectly combines the international country code for Australia with an internal access numbering code. In view of these discrepancies, and of the non-delivery of notices reported by the CAC Case Administrator, the Panel therefore decided to exercise its general powers to investigate the street address given by the Respondent, which was on its face credible. The investigation compared two online sources, a popular online map service and an official cadastral database for the federal state concerned. Both sources showed that the street number given corresponds to no current address. Further information, from an online City of Melbourne source, indicates that street numbers in the part of the city concerned (the main business district) had been reorganized, but that this had only occurred several years before registration of the disputed domain name.

## PARTIES CONTENTIONS

THE COMPLAINANT:

The Complainant refers to its corporate name and core product trademark, ZOOMLION, which has been in use and promoted over many years with the result that it is highly recognizable around the world and enjoys a strong reputation. For the purposes of UDRP Paragraph 4(a)(i), it follows that the term ZOOMLION has a unique correspondence to the Complainant. Comparing the disputed domain with the Complainant's trademark, its identifying portion is the stem <zoomlionaustralia>, which consists exclusively of ZOOMLION combined with the country Australia – a purely generic term. The name of that country, like the TLD extension <.com>, can hence be disregarded in establishing whether the disputed domain name gives rise to confusion with the Complainant's trademark. Doing so leaves the relevant identifying part of the disputed domain name to be exactly the same as the trademark ZOOMLION in pronunciation and spelling.

As to the test under UDRP Paragraph 4(a)(ii), the Complainant believes that the Respondent does not meet any of the following conditions:

(i) use by the Respondent of, or demonstrable preparations to use, the disputed domain name or a name corresponding to it for a bona fide offering of goods or services prior to notice of the present proceeding;

(ii) being commonly known by the domain name; or

(iii) making a legitimate non-commercial or fair use of the disputed domain name, without intention of commercial gain or of misleadingly diverting consumers or tarnishing the Complainant’s trademark.

Rather, the factual situation is that the Respondent is not identified with the Complainant and is not a distributor or partner of the Complainant. As to any trademark rights the Respondent might possibly have acquired, the Complainant has searched various national and regional trademark databases for the name of the Respondent and found none for the term ZOOMLION. The Complainant has furthermore never directly or indirectly authorized the Respondent to use its protected brand.

Moreover, whereas the disputed domain name was registered more than three years ago, there appears to have been no active use in that time and there is consenquently no question that the Respondent might have been able to acquire any legal right or interest in ZOOMLION during that period.

As regards the final test, under UDRP Paragraph 4(a)(iii), there is in this proceeding no reasonable explanation to show that the long-term registration of the domain name might be in good faith. The disputed domain name was registered in June 2021, by which time the distinctive ZOOMLION brand had already achieved a high level of global recognition including on the internet. Accordingly, the Complainant submits that the Respondent was aware of the existence of the Complainant's ZOOMLION trademark prior to registering the disputed domain name. As to bad faith use, insofar as the disputed domain name may not have been used since registration, the Complainant argues that such use can be active or passive, and here, the Complainant believes that the ZOOMLION trademark is sufficiently well known and influential for an inference to be drawn from the Respondent's having so far failed to engage in any bona fide use. It substantiates this argument by asserting that the direct effect of the Respondent's registration itself prevents the Complainant from registering the same domain name with the same combination of letters. The Complainant refers here in particular to Decision HK-2301790 (regarding <.zendure.net>) of 11 October 2023 by a panel of the Asian Domain Name Dispute Resolution Centre in support of a passive holding doctrine.

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

## RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name is identical or confusingly similar to trademarks 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 that 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

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

The Panel notes that its résumé of the Parties' contentions includes for the Complainant only its arguments pertinent to reaching a decision in this proceeding; it in particular omits references to some past ADR Panels' Decisions. One past Decision referred to is included in the résumé of the Complainant's contentions and is considered in the Principal Reasons for the Decision.

## PRINCIPAL REASONS FOR THE DECISION

The Panel for the purposes of the application of the UDRP cumulative three-part test finds that:

(1) The Complainant has comprehensively demonstrated its ownership of trademarks for its ZOOMLION corporate and brand name. It has also shown that inclusion in the disputed domain name's stem of the Complainant's brand name in its entirety with addition of a generic term -- the name of the country of Australia (a country in which the Complainant moreover does business) -- creates confusing similarity with its protected mark. The Panel declines to disregard addition of the top-level domain name extension <.com> in this proceeding since it increases the effect of such confusing similarity in view of the Complainant being a well-known commercial entity. The first part of the test is therefore met;

(2) The Complainant has both explained the lack of any relationship between it and the Respondent and demonstrated the absence of any credible other basis for believing that the Respondent may have a right or legitimate interest in the disputed domain name. Rather, strong indications are present in this proceeding's Case File to suggest that the Respondent's interest is illegitimate, notably the composition of the disputed domain name itself in conjunction with surreptitious contact details given for the Respondent at

registration (see Factual Background). The second part of the test is hence met;

(3) The circumstances mentioned under (2) suggest that the disputed domain name was registered for the purpose of cybersquatting, specifically by impersonating an industrial player having a globally renowned and distinctive brand by linking it to one of the countries in which it operates, i.e. Australia. The Case File does not reveal how far the Respondent has actually then gone in exploiting the resource it has had in its hands for three years. But an inference can fairly be drawn here that the Respondent's cost and trouble in registering and maintaining the disputed domain name -- which has no other evident purpose than to impersonate the Complainant -- will not have been undertaken idly. The parking page to which the disputed domain name resolves shows notably that DNS servers have been activated, meaning that e-mail functions for the disputed domain name should also be available to the Respondent, entailing a risk in the circumstances of this case that phishing in particular may be involved. The third and final part of the UDRP test is in all the circumstances thus also met.

The Panel accordingly ORDERS transfer of the disputed domain name to the Complainant.

Lastly, the Panel takes note of the Complainant's reference to ADR Decision HK-2301790. It, however, differs from the Complainant's reading of it and observes that the panelist in that case expressly based its finding of bad faith use on the specific circumstances of the case, as the Panel does in the present administrative proceeding.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ZOOMLIONAUSTRALIA.COM**: Transferred

## PANELLISTS

| Name | **Kevin Madders** |
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DATE OF PANEL DECISION 2024-08-31

Publish the Decision