



## DECISION

Huawei Technologies Co., Ltd. v. BO LIU

Claim Number: FA1503001609344

### PARTIES

Complainant is **Huawei Technologies Co., Ltd.** (“Complainant”), represented by **Zak Muscovitch** of **The Muscovitch Law Firm**, Canada. Respondent is **BO LIU** (“Respondent”), International.

### REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<huaweimobileshop.com>**, registered with **GoDaddy.com, LLC**.

### PANEL

The undersigned certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as Panelist in this proceeding.

The Honourable Neil Anthony Brown QC as Panelist.

### PROCEDURAL HISTORY

Complainant submitted a Complaint to the FORUM electronically on March 13, 2015; the FORUM received payment on March 13, 2015.

On March 16, 2015, GoDaddy.com, LLC confirmed by e-mail to the FORUM that the **<huaweimobileshop.com>** domain name is registered with GoDaddy.com, LLC and that Respondent is the current registrant of the name. GoDaddy.com,

LLC has verified that Respondent is bound by the GoDaddy.com, LLC registration agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On March 20, 2015, the FORUM served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of April 9, 2015 by which Respondent could file a Response to the Complaint, via e-mail to all entities and persons listed on Respondent's registration as technical, administrative, and billing contacts, and to postmaster@huaweimobileshop.com. Also on March 20, 2015, the Written Notice of the Complaint, notifying Respondent of the e-mail addresses served and the deadline for a Response, was transmitted to Respondent via post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts.

Having received no response from Respondent, the FORUM transmitted to the parties a Notification of Respondent Default.

On April 15, 2015, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the FORUM appointed The Honourable Neil Anthony Brown QC as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the FORUM has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent" through submission of Electronic and Written Notices, as defined in Rule 1 and Rule 2. Therefore, the Panel may issue its decision based on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, the FORUM'S Supplemental Rules and any rules and principles of law that

the Panel deems applicable, without the benefit of any response from Respondent.

## **RELIEF SOUGHT**

Complainant requests that the domain name be transferred from Respondent to Complainant.

## **PARTIES' CONTENTIONS**

### **A. Complainant**

Complainant made the following contentions.

1. Complainant is a corporation incorporated under the laws of the People's Republic of China, and is headquartered in Shenzhen, China. It is the largest telecommunications equipment manufacturer in the world including mobile devices and is a global provider of information and communications technology under the trademark HUAWEI. Complainant is also the world's third largest manufacturer of mobile phone handsets.

2. Complainant is the registered owner of 279 registered trademarks in 154 countries (See Annex F), including:

a) WIPO International Trademark for HUAWEI, Registration No. 748648, registered December 4, 2000;

b) Peoples Republic of China Trademark for HUAWEI, Registration No. 4641033, registered February 21, 2008;

c) Peoples Republic of China Trademark for HUAWEI & Design, Registration No. 10010262, Registered June 21, 2013;

(collectively referred to herein as "the HUAWEI trademarks").

3. The disputed domain name was registered by the Respondent on October 16, 2013.

4. The disputed domain name is confusingly similar to the HUAWEI trademarks because the addition to the HUYAWEI trademarks of the generic expression “mobileshop” serves only to create the impression that the domain name is an official domain name of Complainant and does not distinguish between the domain name and the HUAWEI trademarks.

5. Respondent has no rights or legitimate interests in the disputed domain name because:

(a) Respondent is not commonly known as HUAWEI or by the Domain Name;

(b) Respondent has no right or the authorization to use the HUAWEI trademarks in a domain name;

(c) Respondent brazenly and expressly attempts to pass off its website as being owned and operated by the Complainant;

(d) Respondent expressly misrepresents to the public, that it is the Complainant’s “official mobile shop”;

(e) Respondent was fully aware of the Huawei trademarks when it registered the domain name;

(f) The Respondent has consistently and suspiciously hidden its identity as registrant of the domain name;

(g) Through the website associated with the Domain Name, Respondent offers “China Inspection Services” (See Annex N), via a link on the website and when a user to HuaweiMobileShop.com clicks on the link to “China Inspection Services”, the user is redirected to another service offered by the Respondent;

(h) Respondent has not used the domain name for a *bona fide* offering of goods or services pursuant to Policy ¶ 4(c)(i), nor a legitimate non-commercial or fair use under Policy ¶ 4(c)(iii).

6. Respondent has registered and used the disputed domain name in bad faith, because of:

- (a) Respondent's use of a privacy service to conceal its identity;
- (b) Respondent used the Domain Name to intentionally attract for commercial gain, Internet users to Respondent's web site by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, and endorsement of Respondent's website;
- (c) Respondent is attempting to pass off its website as an official website of Complainant;
- (d) Respondent is also using the domain name to redirect users to its own unrelated "China Inspection" service business, being further evidence of bad faith use ;
- (e) Use of the Complainant's copyrighted images including images wherein the Complainant's trademarks are prominently displayed to further confuse users in combination with other acts of passing off, constitutes evidence of bad faith registration and use.

#### B. Respondent

Respondent failed to submit a Response in this proceeding.

### **FINDINGS**

1. Complainant is a very prominent Chinese telecommunications equipment manufacturer.
2. Complainant is the registered owner of 279 registered trademarks in 154 countries including:
  - a) WIPO International trademark for HUAWEI, Registration No. 748648, registered December 4, 2000;
  - b) Peoples Republic of China trademark for HUAWEI, Registration No. 4641033, registered February 21, 2008;

c) Peoples Republic of China trademark for HUAWEI & Design, Registration No. 10010262, Registered June 21, 2013.

3. The disputed domain name was registered by the Respondent on October 16, 2013.

4. The disputed domain name resolves to a website purporting to be a website of or sponsored by Complainant and promoting telecommunication equipment purporting to be Complainant's products and other services not associated with Complainant.

## DISCUSSION

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (2) Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(e), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory.

*See Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (Nat. Arb. Forum July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); *see also Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

### Identical and/or Confusingly Similar

The first question that arises is whether Complainant has rights in a trademark or service mark on which it can rely. Complainant contends that it is the largest telecommunications equipment manufacturer in the world including of mobile devices, a global provider of information and communications technology under the trademark HUAWEI and that it is also the world's third largest manufacturer of mobile phone handsets. The Panel has considered the extensive evidence submitted by Complainant to that effect and accepts that it establishes those propositions. Complainant also submits that it is the registered owner of 279 registered trademarks in 154 countries including the following:

- (a) WIPO International trademark for HUAWEI, Registration No. 748648, registered December 4, 2000;
- (b) Peoples Republic of China trademark for HUAWEI, Registration No. 4641033, registered February 21, 2008;
- (c) Peoples Republic of China trademark for HUAWEI & Design, Registration No. 10010262, Registered June 21, 2013. Complainant has submitted evidence which the Panel accepts to establish those trademarks. (*See Compl.*, at Annex F). Prior UDRP panels have found that, regardless of the location of the parties, the registration of a mark with a federal trademark authority is evidence of having rights in that mark. (*See Miller Brewing Co. v. Miller Family*, FA 104177 (Nat. Arb. Forum Apr. 15, 2002) (finding that the complainant had established rights to the MILLER TIME mark through its federal trademark registrations); *see also Koninklijke KPN N.V. v. Telepathy Inc.*, D2001-0217 (WIPO May 7, 2001) (finding

that it is sufficient that the complainant can demonstrate a mark in some jurisdiction). In the present case it has been shown that the HUAWEI trademarks are registered with WIPO and with the authorities of the Peoples Republic of China as more particularly identified above. Therefore, the Panel finds that Complainant has rights in the HUAWEI mark under Policy ¶ 4(a)(i).

The next question that arises is whether the disputed domain name is identical or confusingly similar to Complainant's HUAWEI trademarks. Complainant contends that Respondent's <huaweimobileshop.com> domain name is confusingly similar to Complainant's HUAWEI trademark. Complainant notes that Respondent adds the generic term "mobileshop" to the trademark, along with the gTLD ".com." Respondent's addition of a gTLD is irrelevant to a Policy ¶ 4(a)(i) analysis, according to previous panels. (*See Bond & Co. Jewelers, Inc. v. Tex. Int'l Prop. Assocs.*, FA 937650 (Nat. Arb. Forum Apr. 30, 2007) (finding *inter alia* that the addition of a gTLD does not establish distinctiveness from the complainant's mark under Policy ¶ 4(a)(i)). Further, Respondent's addition of the term "mobileshop" to the trademark does not differentiate the disputed domain name from the trademark as it encourages the impression that the domain name relates to the services of Complainant, as it is well known, especially in China, that Complainant's business included the manufacture of mobile devices and their purchase through shops. (*See Warner Bros. Entm't Inc. v. Rana*, FA 304696 (Nat. Arb. Forum Sept. 21, 2004) (finding that the addition of the generic term "collection" to Complainant's HARRY POTTER mark failed to distinguish the domain name from the mark); *see also Sports Auth. Mich. Inc. v. Batu 5*, FA 176541 (Nat. Arb. Forum Sept. 23, 2003)). The Panel therefore concludes that Respondent's <huaweimobileshop.com> domain name is confusingly similar to Complainant's HUAWEI trademark.

Complainant has thus made out the first of the three elements that it must establish.

### Rights or Legitimate Interests

It is now well established that Complainant must first make a *prima facie* case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy ¶ 4(a)(ii), and then the burden shifts to Respondent to show it does have rights or legitimate interests. (See *Hanna-Barbera Prods., Inc. v. Entm't Commentaries*, FA 741828 (Nat. Arb. Forum Aug. 18, 2006) (holding that the complainant must first make a *prima facie* case that the respondent lacks rights and legitimate interests in the disputed domain name under UDRP ¶ 4(a)(ii) before the burden shifts to the respondent to show that it does have rights or legitimate interests in a domain name); see also *AOL LLC v. Gerberg*, FA 780200 (Nat. Arb. Forum Sept. 25, 2006) (“Complainant must first make a *prima facie* showing that Respondent does not have rights or legitimate interest in the subject domain names, which burden is light. As Complainant satisfies its burden, then the burden shifts to Respondent to show that it does have rights or legitimate interests in the subject domain names.”).

The Panel finds that Complainant has made out a *prima facie* case that arises from the following considerations:

- (a) Respondent has chosen to take Complainant’s HUAWEI trademark and to use it in its domain name, adding only the generic expression “mobileshop”, a term that does not negate a finding of confusing similarity;
- (b) Respondent has then used the domain name to direct Internet users to a website which purports to be a website of Complainant and which is clearly being used to pass Respondent off as Complainant and which promotes the mobile telephone devices of Complainant;
- (c) Respondent engaged in these activities without the consent or approval of Complainant;
- (d) Complainant then submits that Respondent is not commonly known as

HUAWEI or by the Domain Name. The Panel notes the WHOIS information lists "Registration Private Registrant Organization: Domains By Proxy, LLC" as the registrant of record for the disputed domain name. The Panel agrees that the information available is unable to show any meaningful evidence that Respondent has ever been commonly known by the <huaweimobileshop.com> domain name. Nor has Respondent filed a Response or sought to establish that issue. (*See Compaq Info. Techs. Group, L.P. v. Express Tech., Inc.*, FA 104186 (Nat. Arb. Forum Mar. 13, 2002) ("The Panel finds that due to the distinct nature of Complainant's COMPAQ mark it is not possible for Respondent to be commonly known as <compaqspares.com> pursuant to Policy 4(c)(ii)."); (see also *M. Shanken Commc'ns v. WORLDTRAVELERSONLINE.COM*, FA 740335 (Nat. Arb. Forum Aug. 3, 2006)), where the panel found that the respondent was not commonly known by the disputed domain name under Policy ¶ 4(c)(ii) based on the WHOIS information and other evidence in the record;

(e) Complainant has also submitted that Respondent has attempted to pass off its website as being owned and operated by the Complainant and that it has expressly misrepresented to the public that it is the Complainant's "official mobile shop". The Panel has examined the evidence submitted by Complainant to that effect. It shows that Respondent's website to which the domain name resolves carries the statement "The Best Huawei Mobile Phone and Tablet PC Online Shopping Store" which is a clear but false representation that the site is an official Huawei site. It also carries photographs and comments on several Huawei mobile products and news items about such products and a statement that the domain name is an official Huawei shop. The evidence is also to the effect that in the course of establishing and maintaining its website Respondent has taken and used on its website hundreds of images from Complainant's website. Complainant has described Respondent's conduct in this regard as "brazen" and in the opinion of the Panel that is a singularly appropriate word to use. Clearly the use of a

domain name incorporating without consent the trademark of another party and attempting to pass itself off as the other party cannot give rise to a right or legitimate in the domain name;

(f) Complainant has also submitted that Respondent has not used the domain name for a *bona fide* offering of goods or services pursuant to Policy ¶ 4(c)(i), nor a legitimate non-commercial or fair use under Policy ¶ 4(c)(iii). The Panel agrees with that submission and the evidence on which it is based and so finds. In particular the Panel agrees with Complainant's submission that prior panels have failed to find a *bona fide* offering of goods or services where the respondent passes itself off as the complainant or diverts Internet traffic from the complainant to the respondent's own website. (See for example, *Kmart of Mich., Inc. v. Cone*, FA 655014 (Nat. Arb. Forum April 25, 2006) (Finding that the respondent's attempt to pass itself off as the complainant was not a *bona fide* offering of goods or services pursuant to Policy ¶ 4(c)(i)); see also *Am. Int'l Group, Inc. v. Busby*, FA 156251 (Nat. Arb. Forum May 30, 2003) (finding that the respondent attempts to pass itself off as the complainant online, which is blatant unauthorized use of the complainant's mark and is evidence that the respondent has no rights or legitimate interests in the disputed domain name);

(g) Moreover, through its website the Respondent has offered users "China Inspection Services" (See Compl., Annex N). When a user to the disputed domain name HuaweiMobileShop.com clicks on the link to "China Inspection Services", the user is redirected to a service offered by Respondent and unrelated to Huawei mobile telephones, which is a wholly illegitimate activity; (see Compl., Annex N).

All of these matters go to make out the *prima facie* case against Respondent. As Respondent has not filed a Response or attempted by any other means to rebut the *prima facie* case against it, the Panel finds that Respondent has no rights or legitimate interests in the disputed domain name.

Complainant has thus made out the second of the three elements that it must establish.

### **Registration and Use in Bad Faith**

It is clear that to establish bad faith for the purposes of the Policy, Complainant must show that the disputed domain name was registered in bad faith and has been used in bad faith. It is also clear that the criteria set out in Policy ¶ 4(b) for establishing bad faith are not exclusive, but that Complainants in UDRP proceedings may also rely on conduct that is bad faith within the generally accepted meaning of that expression.

Having regard to those principles, the Panel finds that the disputed domain name was registered and used in bad faith. That is so for the following reasons.

First, Complainant submits that in appropriate circumstances the use of a privacy service by a registrant to conceal its identity, particularly where the domain name infringes upon a complainant's trademark, can be evidence of bad faith. The Panel agrees with that submission. (See *Fifth Third Bancorp v. Secure Whois Information Service*, WIPO Case No. D2006-0696). In the present case the Respondent has taken an extremely prominent trademark known the world over and used it to engage in retail dealings with the public and yet has concealed its name and contact details from the public. That can only be for improper motives unless there is evidence to the contrary, which in the present case there is not. The Respondent's efforts to hide its identity through the Whois privacy service and by omitting any contact details enables the Panel to draw the inference that the Respondent has reason to hide its identity, which is that it is engaging in illegal and deceptive conduct by trading on Complainant's goodwill and reputation and that it wants to keep its identity a secret. That was bad faith when Respondent registered the domain name and is bad faith in using it.

Secondly, as has already been noted, at the time Respondent registered the disputed domain name, Complainant's HUAWEI trademark was registered and was so well known to many consumers around the world that it can only be described as famous. Indeed, its fame has been recognised in previous UDRP proceedings; (*see Huawei Technologies Co Ltd v. Xiao Tianping*, FA0112000102793 (*Nat. Arb. Forum Feb. 14, 2002*)). Respondent must therefore be presumed to have had actual knowledge of the mark. The mark was well known as was the corporate name of Complainant. Moreover, the fact that Respondent chose the name at all calls for an explanation and the fact that one has not been forthcoming suggests that anything Respondent could say on this subject would not be of advantage to it. It is clear that Respondent deliberately chose the name and used it without any entitlement to do so, which again raises the inference that this has been done for questionable motives which can only be described as bad faith.

Thirdly, Respondent has used the disputed domain name to attract Internet users by creating a likelihood of confusion with Complainant's HUAWEI trademark for financial gain, bringing the case squarely within the provisions of Policy ¶ 4(b)(iv). Respondent's use of the disputed domain name in the manner described which is established by the evidence that it advertised Complainant's products and offered them for sale, shows that Respondent used the disputed domain name to suggest that its website was in fact Complainant's website or that it was sponsored by Complainant. Panels have previously found bad faith registration and use where, as in the present case, a respondent uses a confusingly similar domain name to attract Internet users to a website that causes confusion as to the complainant's affiliation with the disputed domain name, thus potentially creating revenue for respondent. (*See Target Brands, Inc. v. JK Internet Servs.*, FA 349108 (*Nat. Arb. Forum Dec. 14, 2004*)) (finding bad faith because the respondent not only registered Complainant's famous TARGET mark, but

“reproduced . . . Complainant’s TARGET mark . . . [and] added Complainant’s distinctive red bull’s eye [at the domain name] . . . to a point of being indistinguishable from the original.”). Moreover, Respondent’s use on its website of Complainant’s trademarks which are prominently displayed to further confuse users in combination with other acts of passing off, constitutes additional evidence of bad faith registration and use. (*See Stormy Entertainment, Inc. v. George Thomas*, FA0811001235235, (Nat. Arb. Forum, June 1, 2009). The Panel therefore concludes that Respondent’s use of the domain name indicates bad faith use and registration under Policy ¶ 4(b)(iv).

Fourthly, the Panel agrees on the evidence that Respondent is also using the domain name and hence Complainant’s good name and trademark to redirect users to its own unrelated “China Inspection” service business, being further evidence of bad faith use. (*See Microsoft Corporation v. DevHolden LLC / Dustin Holden*, FA1307001509834, (Nat. Arb. Forum, August 16, 2013).

Finally, in addition and having regard to the totality of the evidence, the Panel finds that, in view of Respondent’s registration of the disputed domain name using Complainant’s HUAWEI trademark and in view of the conduct that Respondent engaged in when using it, Respondent registered and used the disputed domain name in bad faith within the generally accepted meaning of that expression.

Complainant has thus made out the third of the three elements that it must establish.

## DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <huaweimobileshop.com> domain name be **TRANSFERRED** from Respondent to Complainant.



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Honorable Neil Anthony Brown, Q.C.  
Arbitrator

The Honourable Neil Anthony Brown QC,

Panelist

Dated: April 17, 2015