

(Kuala Lumpur Office)

**ADMINISTRATIVE PANEL DECISION**

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<b>Case No.</b>	<b>KLRCA/ADNDRC-165-2014/KL 1400013</b>
<b>Complainant:</b>	<b>Cong Ty TNHH Welding Alloys Viet Nam</b>
<b>Respondent:</b>	<b>Viet Cuong Nguyen</b>
<b>Disputed Domain Name:</b>	<b>&lt;wa-vietnam.com&gt;</b>

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**1. The Parties and Contested Domain Name**

The Complainant is Cong Ty TNHH Welding Alloys Viet Nam of Suite 701, Detech Tower, No.08, Ton That Thuyet, My Dinh, Tu Liem Dist, Hanoi, Vietnam.

The authorized representative of the Complainant is Welding Alloys Far East Sdn Bhd, No.28 Jalan Riang 21, Taman Gembira, Jahor Baru 81200, Johor, Malaysia.

The Respondent is Viet Cuong Nguyen, Hanoi, Vietnam.

The domain name at issue is <wa-vietnam.com>.The domain name is registered with Enom, Inc. of 5808 Lake Washington Blvd. NE, Ste.300, Kirkland, WA 98033, USA.

**2. Procedural History**

On March 7, 2014 the Complainant sent to the Respondent by email at cuongnet@gmail.com the Complaint dated March 5, 2014 and its annexures and notified the Asian Domain Name Dispute Resolution Centre ("the Centre") to that effect.

The Complaint was filed with the Centre on March 17, 2014. The Centre received the appropriate case filing fee.

On March 17 and 24, 2014, the Centre transmitted by email to Enom, Inc a request for registrar verification in connection with the registrant of the disputed domain name.

On March 26, 2014, Enom, Inc. transmitted by email to the Centre its verification response that the registrant of the disputed domain was the Respondent as listed, Viet Cuong Nguyn of 33 Pham Ngu, Hoan, Hanoi, 220000 VN and that the registrant's email address was cuongnet@gmail.com.

The Centre verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

On March 26, 2014 the Centre forwarded to the Respondent and to Enom, Inc. the Complaint and the annexures thereto, together with the required Written Notice of Complaint by which it gave notice that the formal date for the commencement of the

administrative proceeding was March 26, 2014 and that the date by which the Respondent was required to file a Response was April 15, 2014.

On April 14, 2014 the Centre received an email from the Respondent confirming that he had received "all the required documents" sent to him and that he would send "all feedback documents before April 21." On April 14, 2014, the Centre forwarded to the Respondent a further email stating *inter alia* that the due date for submitting his response was on or before April 15, 2014.

A Response was not received by the Centre within the required period of time or at all.

On April 16, 2014, the Centre appointed The Honourable Neil Anthony Brown QC as Panelist in the administrative proceeding. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Centre to ensure compliance with the Rule 7.

The Panel finds that the Asian Domain Name Dispute Resolution Centre has performed its obligations under Rule 2(a) of the Rules "to employ reasonably available means calculated to achieve actual notice to Respondent". Accordingly, the Panel is able to issue its decision based on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, the Asian Domain Name Dispute Resolution Centre Supplemental Rules and any rules and principles of law that the Panel deems applicable, without the benefit of any response from Respondent.

### **3. Factual background**

The Complainant is a company incorporated pursuant to the laws of Vietnam and is engaged in the provision of goods and services related to welding. It is part of the prominent worldwide group The Welding Alloys Group, the principle member of which is Welding Alloys Limited of the United Kingdom. The Complainant is a subsidiary of Welding Alloys Limited.

The Respondent was an employee of the Complainant and whilst he was an employee he registered the disputed domain name in his own name on September 12, 2008 whereas his only authority was to register the domain name in the name of his employer the Complainant. Since leaving its employment, he has failed and refused to transfer the disputed domain name to the Complainant or to provide it with the log-in details for the domain name.

#### **Parties' Contentions**

##### **A. Complainant**

The Complainant's contentions are as follows:

1. The Complainant claims registered trademark rights in the following registered trademark: Trademark for WA, registered with the IP Office of the United Kingdom on July 6, 2001 in the name of Welding Alloys Limited, of The Way,

Fowlmere, Nr Royston. Herts SG8 7QS, United Kingdom, a company associated with the Complainant.

2. The Complainant also claims unregistered trademark rights in <wa-vietnam.com> (“the WA-VIETNAM mark”) which is also the domain name at issue, as that expression has been used as the source of the goods and services of the Complainant since its registration as a domain name on September 12, 2008. Since that date, the Complainant has used the WA-VIETNAM mark as the means of contacting the Complainant to purchase its goods and services both within Vietnam and internationally.
3. For several years after its registration, the disputed domain name was used by the Complainant as its domain name and hence as its main email address. Subsequently, the Complainant registered a new domain name, <welding-alloys.com>. However, because of the conduct of the Respondent and his refusal to transfer the <wa-vietnam.com> domain name to the Complainant, it is still open and can be used as a domain name. Moreover, it is used by some customers and suppliers of the Complainant who wish to contact the Complainant by using that domain name as the Complainant’s email address. The Complainant believes that it may be losing business through this lack of control of the disputed domain name.
4. The disputed domain name was registered by the Respondent on September 12, 2008 on behalf of the Complainant. At that time the Respondent was employed by the Complainant in IT Support and he had authority to register the Domain name on behalf of the Complainant but not on his own account or personally. Having registered the disputed domain name, the Respondent had it resolve to a website that he set up for the Complainant and it was also used as a Gmail email account. At that time all employees used that domain name as their email address, but the Complainant’s policy was that all users should migrate to its new email address at <welding-alloys.com>. They did this and the Respondent closed the website at www.wa-vietnam.com. However, the email accounts using the disputed domain name remained active.
5. The Complainant demanded of the Respondent that he provide the log-in details and transfer the domain name to the Complainant.
6. This he has refused to do and has demanded up to \$20,000 as his price to transfer the domain name to the Complainant.
7. The disputed domain name is identical to the Complainant’s unregistered or common law trademark WA-VIETNAM.
8. The Respondent has no rights or legitimate interests in the disputed domain name.
9. The disputed domain name is registered and being used in bad faith.

B. Respondent

The Respondent failed to file a Response in this proceeding.

## 5. Findings and Discussion of the Issues

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

- i. Respondent's domain name must be identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- ii. Respondent has no rights or legitimate interests in respect of the domain name; and
- iii. Respondent's domain name has been registered and is being used in bad faith.

### A) Identical / Confusingly Similar

The first question that arises is whether the Complainant has a trademark on which it can rely. The Complainant has adduced evidence that the Panel accepts to the effect that the Complainant has trademark rights on which it can rely with respect to the disputed domain name.

One of the trademarks relied on is a registered trademark and the other is an unregistered trademark that the Complainant has used in its business.

The Complainant claims registered trademark rights in the following registered trademark: Trademark for WA, registered with the IP Office of the United Kingdom on July 6, 2001 in the name of Welding Alloys Limited, of The Way, Fowlmere, Nr Royston. The Panel accepts that, although the trademark is registered in the name of Welding Alloys Limited and not in the name of the Complainant, the Complainant is a subsidiary of that company and by virtue of that fact it has trademark rights, through Welding Alloys Limited, in the trademark.

However, as it may be difficult to establish that the disputed domain name is either identical or confusingly similar to the WA trademark, it would be wise to see if the Complainant can rely on an unregistered trademark.

Complainants in UDRP proceedings such as the present are able to rely on an unregistered trademark as it is now well established that if a Complainant has a common law or unregistered trademark, that is sufficient for the purposes of the proceeding as the Policy only requires a Complainant to have a trademark, irrespective of whether it is registered or unregistered.

In the present case, the Complainant has adduced evidence and made submissions to the effect that it claims unregistered trademark rights in <wa-vietnam.com>, ("the WA-VIETNAM mark") which is also the domain name at issue, as that expression has been used as the source of the goods and services of the Complainant since its registration as a domain name on September 12, 2008. The evidence is that since that date, the Complainant has used the WA-VIETNAM mark as the means of contacting the Complainant in Vietnam and internationally for clients and customers to purchase its goods and services and the name has been widely associated with the Complainant as the means of contacting the Complainant to purchase its goods and services both within Vietnam and internationally. It has also been widely used and accepted by suppliers to the Complainant as the source of the Complainant's goods and services in Vietnam.

The Panel accepts, on the submissions of the Complainant and its authorized representative, that WA-VIETNAM mark has generally been accepted as the source of goods and services of the Complainant in Vietnam and internationally and that it thus qualifies as a common law trademark.

Accordingly, the Complainant has proved that it has a trademark on which it may rely.

The second question that arises is whether the disputed domain name may be said to be identical or confusingly similar to the WA-VIETNAM mark. The Panel finds that the disputed domain name is identical to the corresponding mark as, in making this comparison, the gTLD suffix “.com” is to be ignored. The disputed domain name is also confusingly similar to the WA-VIETNAM mark, as the objective bystander, at least in those fields where welding goods and services are being dealt with, would probably understand that the domain name was invoking the name of the prominent Welding Alloys Group and that it was referring to the activities of that group in Vietnam and carried out by the Complainant.

The Complainant has therefore established the first of the three elements that it must establish.

### **B) Rights and Legitimate Interests**

It is now well established that the Complainant must first make a *prima facie* case that Respondent lacks rights and legitimate interests in the disputed domain name under paragraph 4(a) (ii) of the Policy and then the onus of proof shifts to the Respondent to show it does have rights or legitimate interests. There are many decisions to that effect, one of the most notable of which is *Hanna-Barbera Prods., Inc. v. Entm't Commentaries*, FA 741828 (Nat. Arb. Forum Aug. 18, 2006) where it was held that a complainant must first make a *prima facie* case that the respondent lacks rights and legitimate interests in the disputed domain name under paragraph 4(a)(ii) of the UDRP before the onus of proof shifts to the respondent to show that it does have rights or legitimate interests in the domain name).

Having regard to the evidentiary case presented on behalf of the Complainant, the Panel finds that the Complainant has made out a *prima facie* case that arises from the following considerations:

- (a) the Respondent has chosen to take the Complainant's trademark, which reflects the initials of the prominent Welding Alloys Group and its activities and to use in its domain name in Vietnam which was registered by the Respondent at the time when he was an employee of the Complainant;
- (b) the unchallenged evidence is that the Respondent had no authority to register the domain name in his own name or to confer on himself any right to register the domain name in his own name or personal capacity or to retain it after he ceased his employment with the Complainant and to refuse to provide the log-in details of the domain name and transfer it to the Complainant;
- (c) the Respondent has demanded up to \$20,000 to transfer the domain name to the Complainant;
- (d) the Respondent has engaged in these activities without the consent or approval of Complainant.

These matters go to make out the *prima facie* case against the Respondent and it is then up to the Respondent to rebut that case.

As the Respondent has not filed a Response or attempted by any other means to rebut the *prima facie* case against him, despite admitting that the documents instituting the proceeding were received by him, the Panel finds that the 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

### **C) Bad Faith**

It is clear that to establish bad faith for the purposes of the Policy, the Complainant must show that the disputed domain name was registered in bad faith and has been used in bad faith.

That case may be made out if there are facts coming within the provisions of paragraph 4(b) of the Policy. That paragraph sets out a series of circumstances that are to be taken as evidence of the registration and use of a domain name in bad faith, namely:

“... (i) circumstances indicating that Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to Complainant who is the owner of the trademark or service mark or to a competitor of Complainant, for valuable consideration in excess of Respondent’s documented out-of-pocket costs directly related to the disputed domain name; or

(ii) Respondent has registered the disputed domain name in order to prevent Complainant from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or

(iii) Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the disputed domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location.”

However, those criteria are not exclusive and Complainants in UDRP proceedings may also rely on conduct that is bad faith within the generally accepted meaning of that expression and frequently do so.

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.

The Respondent registered the disputed domain name in bad faith because he must have known at all times that he had no right to register it in his own name and no right to do so to the exclusion of the right of the Complainant to have access to the log-in details, control of the domain name and to be the registrant of the domain name whenever it wanted it, given that the Respondent clearly knew that it was to be used solely in the Complainant’s business and was not for the private ownership or use by the Respondent in his private capacity.

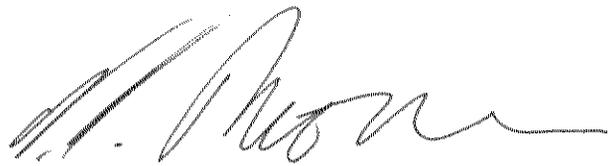
The Respondent used the domain name in bad faith by refusing to transfer it to the Complainant, refusing to provide the log-in details and demanding a substantial sum of money before he would transfer it to the Complainant. The Respondent did this at a time when he must have known that he had no rights to the domain name at all. It is no exaggeration to say that the Respondent has acted dishonestly, had no right to retain the domain name and has not attempted in a Response to explain his actions.

Having regard to the totality of the evidence, the Panel finds that, in view of Respondent's acquisition of the disputed domain name using his own name instead of the name of his employer who had trusted him to act honourably and in its interests at all times, refusing to transfer the domain name to his former employer when requested, refusing to provide it with the log-in details and demanding money before he would transfer it to the Complainant, the 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.

## 6. Decision

Having established all three elements required under the Policy, the Panel concludes that relief should be granted. Accordingly, it is ordered that the disputed domain name, <wa-vietnam.com> be TRANSFERRED to the Complainant.



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The Honourable Neil Anthony Brown QC

Dated: April 17, 2014