

ADMINISTRATIVE PANEL DECISION

Edaw, Inc. v. 弓英 (Gong Ying), 易道环境规划设计南京有限公司 (yi dao huan jing gui hua she ji nan jing you xian gong si)
Case No. D2022-3424

1. The Parties

The Complainant is Edaw, Inc., United States of America (“United States”), represented by Simmons & Simmons, Hong Kong, China (“Hong Kong”).

The Respondent is 弓英 (Gong Ying), 易道环境规划设计南京有限公司 (yi dao huan jing gui hua she ji nan jing you xian gong si), China, self-represented.

2. The Domain Name and Registrar

The disputed domain name <edaw-hk.com> is registered with Alibaba Cloud Computing (Beijing) Co., Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on September 15, 2022. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 16, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. On the same day, the Center sent an email communication to the Complainant providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint in English on September 20, 2022.

On September 16, 2022, the Center sent an email in English and Chinese to the Parties regarding the language of the proceeding. On the same day, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

On September 21, 2022, the Respondent sent an email communication to the Complainant copied to the Center in which the Respondent offered to sell the disputed domain name. On the same day, the Center sent an email communication to the Parties regarding a possible settlement. On September 22, 2022, the Respondent sent another informal email communication twice in which it offered to sell the disputed domain name. The Complainant did not request suspension of the proceeding.

The Center verified that the Complaint together with the amended 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 WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent in English and Chinese of the Complaint, and the proceedings commenced on September 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 19, 2022. The Respondent sent two informal email communications on September 29, 2022 and filed the Response in Chinese with the Center on October 10, 2022.

The Center appointed Matthew Kennedy as the sole panelist in this matter on October 21, 2022. 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 Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is an international landscape architecture, urban and environmental design firm incorporated in 1939 and acquired by AECOM, a global infrastructure firm, in 2005. The Complainant’s name “EDAW” is composed of the initials of each of the surnames of four of its early partners. It operated under that name until 2009, including in China since as early as the 1980s. It holds multiple trademark registrations, including Chinese trademark registration number 3210120 for EDAW and device, registered on July 28, 2003 in class 44 and renewed in 2013. An application to cancel the registration for EDAW and device for non-use was denied in September 2020 based on evidence of use in the previous three-year period. The Complainant formerly held Chinese trademark registration number 3637788 for 易道 (its transcription of EDAW, pronounced “yìdào”), registered on August 21, 2005 in class 44, but this registration was cancelled for non-use in 2020. The Complainant also holds Chinese trademark registration number 41626648 for EDAW and device, registered on September 14, 2021 in class 44, which also remains current.

The Respondent is an individual named 弓英 (Gong Ying) and a Chinese company named 易道环境规划设计南京有限公司 (yì dào huán jīng guì huà shè jì nán jīng yǒu xiǎn gōng sī) (meaning “EDAW Environmental Planning and Design Nanjing Co., Ltd”). The Respondent company was incorporated on December 3, 2013 and adopted its present name on November 12, 2014. It has two shareholders: 弓英 (Gong Ying) and 卢之杰 (Lu Zhijie). Gong Ying is its legal representative and executive director while Lu Zhijie is the administrative contact for the disputed domain name. The Respondent company holds Chinese trademark registration number 12489029 for ED U+D and device, registered on September 28, 2014 in class 44. That trademark registration remains current. The Respondent company holds Chinese trademark registration number 40254146 for EDWAECOM, registered on April 14, 2021 in class 44 but subject to an invalidation proceeding, in which the China National Intellectual Property Administration (“CNIPA”) made a decision on June 20, 2022. The Respondent company formerly held Chinese trademark registration number 42995810 for 易道艾奕康 (a phonetic transcription of EDWAECOM), registered on August 14, 2020 in class 42, but that registration was invalidated on March 2, 2022 by CNIPA.

The disputed domain name was registered on September 19, 2015. At the time when the Complaint was filed, it resolved to a website in Chinese and English for “EDAW HK Urban Design” offering planning, landscape and architecture services. The website prominently displayed the words “易道 官网” (meaning EDAW official website). The site made references to EDAW and AECOM and presented the corporate history of the Complainant. It asserted the Respondent company’s rights in Chinese trademark registration number 12489029 (referred to above). The contact email addresses on the website used the domain name <edaw.hk>. At the time of this Decision, the disputed domain name resolves to a webpage for Internet information services.

The domain name <edaw.hk> was registered on March 19, 2013 and is held by 卢之杰 (Lu Zhijie). It also resolved to a website in Chinese and English for “EDAW HK Urban Design” offering landscape, planning and

architecture services. The “About Us” information was the same as on the website associated with the disputed domain name.

Lu Zhijie and Gong Ying are the shareholders (with a third individual) in another Chinese company named 易道国际设计有限公司 (which may be translated as “EDAW International Design Co., Ltd”, referred to below as the “related company”), which was incorporated on September 22, 2017 and adopted its present name on October 22, 2018. Gong Ying is its executive director. On March 19, 2019, the related company filed Chinese trademark applications numbers 36914977, 36914959, and 36914960 for 易道·艾奕康 (a transcription of EDAW·AECOM) and EDAW.HK and device, in classes 42 and 44, but all were successfully opposed by the Complainant.¹ The CNIPA found that two of these trademark applications were made in bad faith while the other was too similar to the Complainant’s prior EDAW and device mark. The related company unsuccessfully opposed the Complainant’s trademark application number 41626648 for EDAW and device (referred to above). In its June 2020 opposition submission, the related company provided evidence that it was the then-registrant of the disputed domain name. It later filed Chinese trademark application number 53926899 for EDAW.HK in class 42, which was successfully opposed by the Complainant.

A Hong Kong company was incorporated in 2013 as 易道规划设计有限公司 / EDAW Urban Design Limited and, after several name changes, became 易道国际设计有限公司 / AECOM (EDAW) Environmental Design Limited. Following a request in 2019 by the Complainant’s parent company that the Hong Kong Companies Registrar direct a name change, the Hong Kong company changed its name to 易道园景规划设计有限公司 / EDU-D Environmental Design Limited, with effect from October 10, 2019. After further changes to its name, the Hong Kong company adopted its current name 易道国际设计有限公司 / EDASIA Environmental Design Limited with effect from December 8, 2020.

5. Parties’ Contentions

A. Complainant

The disputed domain name is confusingly similar to the Complainant’s EDAW mark.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent and its related company 易道国际设计有限公司 (meaning EDAW International Design Co., Ltd) have filed trademark applications encompassing the disputed domain name in China in bad faith, which have been successfully opposed or invalidated or are currently subject to opposition or invalidation by the Complainant or AECOM. The Respondent and its related company are not commonly known by the disputed domain name and are not making a legitimate noncommercial or fair use of the disputed domain name. The Complainant has no relationship with the Respondent, and the Complainant has not given the Respondent permission to use the Complainant’s marks, including the EDAW mark. The Complainant used its EDAW mark to indicate the source of its services continuously for many years, which led to residual goodwill. The disputed domain name resolves to a website containing numerous references to the Complainant and AECOM that would clearly mislead visitors to the website into believing that the website is operated by the Complainant or AECOM.

The disputed domain name was registered and is being used in bad faith. It was registered in 2015, well after the date on which the Complainant acquired trademark rights in EDAW in China. The Respondent intentionally registered and use the disputed domain name to exploit confusion with the Complainant’s EDAW mark and fraudulently to deceive customers into doing business with the Respondent on the basis that such customers would think they were doing business with the Complainant or AECOM. It is clear from the content hosted on the websites associated with the disputed domain name and <edaw.hk> that the sole purpose for registration and use of these domain names is to deceive the public into believing that the operator of the websites is the Complainant or otherwise associated with it, which is also evident from the outcome of the rulings of the CNIPA and the Hong Kong Companies Registrar (see Section 4 above).

¹ The related company also filed Chinese trademark application number 30288493 for AECOM in class 44 in 2018, which was also successfully opposed by the Complainant’s parent company.

B. Respondent

The Hong Kong-registered company cannot receive projects and the Respondent proposed to cancel its registration in August. A third party website providing company registration information shows that its activities were suspended on September 6, 2022. The <edaw.hk> website was originally operated by other investors and shareholders who found it difficult to obtain projects via the website. The website has been out of operation since the Respondent took it over. The Respondent took it over mainly to provide design academy training and it has been basically closed since the start of the Covid-19 pandemic. “EDAW-HK.com” has already changed its name to U+D and has owned its own U+D trademark for eight years.

Since AECOM acquired EDAAW, the Complainant has been renamed AECOM (艾奕康) and operates in an integrated manner. The Complainant’s official <edaw.com> website is constantly closed and its 易道 trademark was cancelled for non-use which means that the Complainant did not use its 易道 trademark for the past three years. It is inevitable that other parties will continue to file applications to cancel for non-use. The Complainant has abandoned its trademark and brand 易道. Moreover, the CNIPA website shows that the AECOM trademark has also been cancelled for non-use.

The disputed domain name <edaw-hk.com> has nothing to do with EDAAW; one is 4 letters and the other is 6 letters plus a hyphen. In any case, the Respondent’s new brand is U+D. The Respondent has not had any disputes with AECOM for a long time. If AECOM is willing to purchase, that can be discussed separately.

6. Discussion and Findings

6.1 Language of the Proceeding

Paragraph 11(a) of the Rules provides that “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 Registrar confirmed that the Registration Agreement for the disputed domain name is in Chinese.

The Complainant requests that the language of the proceeding be English. Its main arguments are that the Complainant is not a Chinese company; given the Complainant’s history in dealing with the Respondent and related parties, it does not expect the Respondent to participate in this proceeding; and translation of the Complaint into Chinese would lead to significant translation expenses.

Paragraph 10(b) and (c) of the Rules require the Panel to ensure that the Parties are treated with equality, that each Party is given a fair opportunity to present its case and that the administrative proceeding take place with due expedition. Prior UDRP panels have decided that the choice of language of the proceeding should not create an undue burden for the parties (see, for example, *Solvay S.A. v. Hyun-Jun Shin*, WIPO Case No. [D2006-0593](#); *Whirlpool Corporation, Whirlpool Properties, Inc. v. Hui'erpu (HK) electrical appliance co. Ltd.*, WIPO Case No. [D2008-0293](#)).

In the present case, the Complaint and the amended Complaint were filed in English with relevant exhibits shown in the original language (either Chinese or English) and bilingual references where applicable to corporate names. The Response was filed in Chinese but the website to which the disputed domain name resolves is in both Chinese and English, from which it is reasonable to infer that the Respondent is able to communicate in that language. Moreover, the content of the Response shows that the Respondent has in fact understood the Complaint and it did not comment on the language of the proceeding. Therefore, the Panel considers that requiring the Complainant to translate the Complaint into Chinese would create an undue burden and delay whereas accepting all submissions as filed in their original language without a translation does not cause prejudice to either Party.

Having considered all the circumstances above, the Panel determines under paragraph 11(a) of the Rules that the language of this proceeding is English but that the Panel will accept the Response in Chinese, and

any annexes to the Complaint and the amended Complaint in Chinese without translation.

6.2 Substantive Issues

Paragraph 4(a) of the Policy provides that the Complainant must prove each of the following elements:

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

A. Identical or Confusingly Similar

Based on the evidence submitted, the Panel finds that the Complainant has registered rights in the EDAW mark.

The Respondent argues that the Complainant has abandoned its trademark and brand, noting that the Complainant's 易道 trademark registration was cancelled for three years' non-use and that its <edaw.com> website denies access. It suffices for the Panel to observe that the Complainant's registered rights in the EDAW trademark remain current.

The disputed domain name wholly incorporates the textual element of the EDAW mark. It adds a hyphen and the letters "hk", which are an abbreviation of "Hong Kong". The Panel does not consider that the addition of this geographical reference avoids a finding of confusing similarity with the mark. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8. Given that the figurative elements of the mark are incapable of being reflected in a domain name, the Panel will disregard them in the comparison for the purposes of the first element of paragraph 4(a) of the Policy. See [WIPO Overview 3.0](#), section 1.10.

The only other element in the disputed domain name is a generic Top-Level Domain ("gTLD") (".com"). As a standard requirement of domain name registration, this element may be disregarded in the comparison between the disputed domain name and the EDAW trademark. See [WIPO Overview 3.0](#), section 1.11.

The Respondent argues that the disputed domain name has nothing to do with EDAW because it contains additional letters and a hyphen. However, the Panel notes that the initial element of the disputed domain name is identical to the trademark and that, on the side-by-side comparison, the additional elements do not dispel confusing similarity to the mark, for the reasons given above.

Therefore, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights. The Complainant has satisfied the first element in paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out the following circumstances which, without limitation, if found by the Panel, shall demonstrate that the Respondent has rights to, or legitimate interests in, a disputed domain name, for the purposes of paragraph 4(a)(ii) of the Policy:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the Respondent has] acquired no trademark or service mark rights; or

(iii) [the Respondent is] making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

As regards the first and third circumstances set out above, at the initiation of this proceeding the disputed domain name resolved to a website for “EDAW HK Urban Design” offering planning, landscape and architecture services. It was presented as “易道 官网 / EDAW official website”. The site made references to EDAW and AECOM and presented the corporate history of the Complainant. It was clearly intended to be presented as the website of a Hong Kong office of the Complainant. However, the Complainant submits that it has no relationship with the Respondent, and the Complainant has not given the Respondent permission to use the Complainant’s marks, including the EDAW mark. At the present time, the disputed domain name resolves to an Internet information services page. In the Panel’s view, this evidence constitutes a *prima facie* case that the disputed domain name is not being used in connection with a *bona fide* offering of goods or services and that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name.

As regards the second circumstance, the Respondent’s name is listed in the Registrar’s Whois database as “弓英 (Gong Ying), 易道环境规划设计南京有限公司 (yi dao huan jing gui hua she ji nan jing you xian gong si)”, not the disputed domain name. Although its company name begins with the characters 易道, which are the Complainant’s phonetic transcription of EDAW, there is no evidence on record apart from the Respondent’s own website that it is known by the English name “Edaw” or “Edaw-hk”.

The Panel takes note that the Respondent company holds a trademark registration for EDWAECOM registered in 2021 that appears to be current, although a decision has recently been rendered regarding its invalidation. It suffices for the purposes of this Decision to note that the disputed domain name does not contain that trademark. Rather, the disputed domain name contains one part of that mark, which it combines with a geographic element. The disputed domain name does not contain the Respondent’s ED U+D and device mark either. Accordingly, these trademarks do not provide a justification for registration of the disputed domain name <edaw-hk.com>. Further, the Chinese trademark applications for EDAW.HK and device and another trademark application for EDAW.HK filed by the Respondent’s related company have been refused.

In summary, the Panel considers that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Turning to the Respondent’s arguments, it notes that the similar website associated with the domain name <edaw.hk> is out of operation. However, archived screenshots on the record show that the disputed domain name still resolved to the “EDAW HK Urban Design” website at the initiation of this proceeding. Even though the disputed domain name no longer resolves to that website at the time of this Decision, its continued registration by the Respondent creates the potential for it to resolve to that website again. The Respondent points out that it holds its own trademark and that a related Hong Kong company has changed its name to omit “易道” and “EDAW”. The Panel does not consider these facts a sufficient resolution of the present dispute as the disputed domain name continues to incorporate the EDAW trademark. Accordingly, the Panel finds that the Respondent has failed to rebut the Complainant’s *prima facie* case.

Moreover, the nature of the disputed domain name is inherently misleading because it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See [WIPO Overview 3.0](#), section 2.5.1.

Therefore, based on the record of this proceeding, the Complainant has satisfied the second element in paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that certain circumstances shall be evidence of the registration and use of a domain name in bad faith. The fourth of these is as follows:

(iv) by using the [disputed] domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] 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 [the respondent's] web site or location or of a product or service on [the respondent's] website or location.

As regards registration, the disputed domain name was registered in 2015, years after the earlier registration of the Complainant's EDAW mark, including in China, where the Respondent is located. The evidence implies that the Respondent company acquired the registration of the disputed domain name from its related company no earlier than June 2020 but it makes no material difference whether bad faith is assessed as of 2015, 2020 or later. The Complainant's earlier trademark registration in China was in force at all relevant times, having been renewed in 2013 and been declared effective in 2020. The disputed domain name wholly incorporates the EDAW mark, combining it with a reference to "Hong Kong". The website to which the disputed domain name formerly resolved as recently as May 2022 was presented as the official Hong Kong website of the Complainant and offered the same type of planning, landscape and architecture services as the Complainant's. The website presented the corporate history of the Complainant. Accordingly, the Panel finds that the Respondent had the Complainant and its EDAW mark in mind at the time that it registered the disputed domain name.

As regards use, the disputed domain name resolved at the time when the Complaint was filed to a website for "EDAW HK Urban Design" that was falsely presented as the website of a Hong Kong office of the Complainant, offering the same type of services as the Complainant. The Respondent was clearly seeking to trade on the reputation of the Complainant to attract business for its own services. Even though the Complainant may not trade as EDAW any more, its trademark registration remains in force and it previously made longstanding use of its mark in China as a result of which Internet users in the architectural and design sectors are likely to continue to associate the mark with the Complainant and not realize that the disputed domain name and associated website are held and operated by an unrelated party. Given the findings in Section 6.2B above, the Panel finds that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or of services on that website within the terms of paragraph 4(b)(iv) of the Policy.

The Panel notes that the use of the disputed domain name has changed and that it now resolves to an Internet information services page. This recent change in use does not alter the Panel's conclusion; it may constitute a further indication of bad faith.

Therefore, the Panel finds that the disputed domain name has been registered and is being used in bad faith. The Complainant has satisfied the third element in paragraph 4(a) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <edaw-hk.com> be transferred to the Complainant.

/Matthew Kennedy/

Matthew Kennedy

Sole Panelist

Date: November 4, 2022