

ADMINISTRATIVE PANEL DECISION

Alstom v. Cong ty Co phan Xuat nhap khau Duoc Mat troi
Case No. D2023-2507

1. The Parties

The Complainant is Alstom, France, represented by Lynde & Associates, France.

The Respondent is Cong ty Co phan Xuat nhap khau Duoc Mat Troi, Viet Nam.

2. The Domain Name and Registrar

The Disputed Domain Name <alstomhk.com> is registered with iNET Corporation (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on June 9, 2023. On June 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On June 10, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

On June 10, 2023, the Registrar informed the Center that the language of the registration agreement was Vietnamese. On June 27, 2023, the Center informed the Parties and requested the Complainant to provide (a) satisfactory evidence of an agreement between the Complainant and the Respondent to the effect that the proceedings should be in English; or (b) to submit the Complaint translated into Vietnamese; or (c) submit a request for English to be the language of the administrative proceedings. The Complainant confirmed its request that English be the language of proceedings on July 3, 2023. The Respondent did not comment on the language of the proceeding.

The Center 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 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 of the Complaint, and the proceedings commenced on July 4, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 24, 2023. The Respondent sent two communications on July 24, 2023, and July 29, 2023. The Center notified the commencement of the Panel appointment process on August 7, 2023.

The Center appointed Pham Nghiem Xuan Bac as the sole panelist in this matter on August 11, 2023. 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 a French company that has been in business since 1928. It is a global leader in the power generation and rail transport industries, with over 34,000 employees in more than 60 countries. Between April 1, 2022, and December 31, 2022, the Complainant's order intake was 15.1 billion Euros.

In Viet Nam, the Complainant has provided signaling and telecommunication system modernization services for the Hanoi-Vinh regional line phase one and phase two and has offered signaling and telecommunication systems for Ninh Binh station. Additionally, the Complainant manufactured recently 10 trains for Hanoi Metro Line 3. Besides, the Complainant also has been present in Hong Kong, China for over 40 years.

The Complainant holds many trademark registrations that consist of or contain the word ALSTOM (the "ALSTOM trademarks") in numerous jurisdictions around the world, including, but not limited to the International Trademark Registration No. 706292 registered on August 28, 1998, designating, *inter alia*, Viet Nam, where the Respondent locates, in classes 1, 2, 4, 6, 7, 9, 11, 12, 13, 16, 17, 19, 24, 35, 36, 37, 38, 39, 40, 41, and 42, and the Hong Kong Registration No. 199916326AA registered on April 10, 1998, in classes 1, 2, 4, 6, 7, 9, 11, 12, 13, 16, 17, 19, 24, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, and 45.

In addition, the Complainant is the owner of numerous domain names featuring the ALSTOM trademarks, among which the notable one is <alstom.com> registered on January 20, 1998.

The Disputed Domain Name was registered on July 14, 2022. As of the date of this Decision, the Disputed Domain Name is resolving to an inactive website. However, the Disputed Domain Name previously resolved to a website that displayed the activities of the entity "ALSTOM POWER TECH", which claimed to import and export various products, including pharmaceuticals.

As indicated in the Complaint, the Complainant sent to the Respondent and its Registrar two claims with regard to the Disputed Domain Name on August 3, 2022, in which the Complainant asked for, amongst others, a voluntary transfer of such Disputed Domain Name. On August 4, 2022, the Registrar responded to the Complainant that it had suspended the Disputed Domain Name, so the website thereunder was not available.

On the other hand, the Respondent did not file a formal response, but just two communications on July 24, 2023 and July 29, 2023.

5. Parties' Contentions

A. Complainant

The Complainant contends that each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case, as follows:

- (i) The Disputed Domain Name is identical or confusingly similar to a trademark or service mark, in which the Complainant has rights.

First, the Complainant contends that the Complainant is the registered owner of the ALSTOM trademarks in numerous jurisdictions around the world. Further, the Complainant asserts that the ALSTOM trademarks are well-known, which has been confirmed in previous UDRP decisions.

Second, the Complainant argues that the Disputed Domain Name is confusingly similar to the ALSTOM trademarks because it fully incorporates such trademarks in their entirety. The addition of the letters “hk”, which is the abbreviation used to designate Hong Kong, does not dispel any likelihood of confusion.

Third, the Complainant submits that the addition of the generic Top-Level Domain (“gTLD”) suffix “.com” in the Disputed Domain Name should be disregarded under the first element.

(ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

First, the Complainant alleges that the Respondent is not affiliated in any way with ALSTOM trademarks, and the Complainant never authorized the Respondent to register the Disputed Domain Name reproducing the ALSTOM trademarks.

Second, the Complainant contends that the Respondent does not use the Disputed Domain Name for a *bona fide* purpose. Particularly, the Complainant submits its searches of the Hong Kong, Singaporean, and Seychelles company registries, which reveal no company incorporated under the name “ALSTOM POWER TECH” in reality.

Further, the Complainant argues that since the Respondent did not answer the Complainant’s claims filed with the Registrar, the Respondent has refused all opportunities to discuss matters with the Complainant and has not in any way attempted to justify the reproduction of ALSTOM trademarks.

(iii) The Disputed Domain Name was registered and is being used in bad faith.

First, the Complainant asserts that panel decisions under the Policy regularly recognize the well-known status of the ALSTOM trademarks. Therefore, given the reputable status of the Complainant’s trademarks, which were acquired long before the registration of the Disputed Domain Name, the Respondent cannot claim to have been using the ALSTOM trademarks without being aware of the Complainant’s rights to them.

Second, the Complainant submits that the website under the Disputed Domain Name (“Website”) has prominently displayed the activities of a nonexistent company called “ALSTOM POWER TECH”, where the reproduction of the ALSTOM trademarks is confusingly similar to those of the Complainant. Additionally, the Website presented false and inconsistent contact details of the Respondent, which prevents the Complainant from identifying them and taking action against their unlawful behavior.

Third, the Complainant also contends that the Respondent’s failure to respond to the Complainant’s trademark claims but continued using the Disputed Domain Name is further evidence of the Respondent’s bad faith.

With the said arguments, the Complainant requests that the Disputed Domain Name be transferred to the Complainant.

B. Respondent

The Respondent neither provides a formal reply nor submits the Response to the Complainant’s contentions, but sent two emails in English on July 24, 2023 and July 29, 2023. In those communications, the Respondent submits that it is a trading company that only buys and sells unbranded pharmaceutical raw materials, which is completely different from those of the Complainant. Also, the Respondent contends that the Website was closed. The Respondent further gives an apology for the inconvenience caused and hopes the Complainant will withdraw the Complaint so that both parties can handle this case in a peaceful way.

6. Discussion and Findings

A. Procedural Issue: Language of the Proceeding

The Complaint was filed in English. However, the Registrar confirmed that the language of the Registration Agreement is Vietnamese.

As the Complaint was filed in English, the Center, in its email of the language of proceeding dated June 27, 2023, invited the Complainant to submit either (i) satisfactory evidence of an agreement between the Complainant and the Respondent to the effect that the proceeding should be in English, or (ii) the Complaint translated into Vietnamese, or (iii) a substantiated request for English to be the language of the proceeding.

On July 3, 2023, the Complainant confirmed its request that English be the language of proceedings. The Respondent did not give any comment on this issue.

According to paragraph 11(a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the 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.

Similar to previous UDRP decisions, the Panel finds that the spirit of paragraph 11(a) is to ensure fairness in the selection of language by giving full consideration to the Parties' level of comfortability with each language, the expenses to be incurred, and the possibility of delay in the proceeding in the event translations are required and other relevant factors (see, e.g., *Deutsche Messe AG v. Kim Hyungho*, WIPO Case No. [D2003-0679](#)).

In the present case, the Panel takes into account the circumstances of the proceeding, including, but not limited to:

- (i) the fact that the Complainant, a French entity, does not appear to be able to communicate in Vietnamese, and therefore if the Complainant was required to have the documents translated into Vietnamese, the proceeding would be unduly delayed, and the Complainant would have to incur substantial expenses for translation; and
- (ii) the emails sent by the Respondent on July 24, 2023, and July 29, 2023 are in English; this suggests that the Respondent has knowledge of the English language and would be able to communicate in English.

Therefore, for easy comprehension of the Complainant (ultimately, the Party solely taking part in the proceeding) of the Panel's decision without any necessity of translations, and in the interest of fairness to both Parties as well as the Panel's obligation under paragraph 10(c) of the Rules, which provides that "the Panel shall ensure that the administrative proceeding takes place with due expedition", the Panel hereby decides, under paragraph 11(a) of the Rules, that the language of the proceeding shall be English and shall render its decision in English.

B. Identical or Confusingly Similar

The Complainant is required to establish the two following elements: (i) that it has trademark rights, and, if so, (ii) that the Disputed Domain Name is identical or confusingly similar to its trademark.

First, the Complainant has clearly established that it has trademark rights in the ALSTOM trademarks, which have been registered since as early as 1998 in numerous countries all over the world, including Viet Nam, where the Respondent is located. These registrations are well before the registration date of the Disputed Domain Name.

The Disputed Domain Name incorporates the Complainant's ALSTOM trademarks, whose fame has been confirmed in numerous previous UDRP decisions. The only difference between the Disputed Domain Name and the Complainant's trademarks is the addition of the letters "hk" at the end of the Disputed Domain Name. In this regard, as submitted by the Complainant, the website under the Disputed Domain Name is used to indicate the Respondent's representative office in Hong Kong. So, the Panel agrees with the Complainant's argument that the letters "hk" in the Disputed Domain Name are the geographical identifier for "Hong Kong", which is a geographical term. Accordingly, the Panel finds that the element "alstom" remains clearly recognizable in the Disputed Domain Name, and the addition of the term "hk" does not prevent confusing similarity for the purposes of the Policy (see section 1.8 of the [WIPO Overview 3.0](#)).

Third, the Panel finds, similarly to other UDRP panels, that the gTLD, in this case, ".com", does not affect the determination that the Disputed Domain Name is confusingly similar to the ALSTOM trademarks (see section 1.11 of the [WIPO Overview 3.0](#)).

Based on the foregoing findings, the Panel finds that the Disputed Domain Name is confusingly similar to the ALSTOM trademarks, and paragraph 4(a)(i) of the Policy is established.

C. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists circumstances, in particular, but without limitation, which, if found by the Panel to be proved, demonstrate the Respondent's rights or legitimate interests in the Disputed Domain Name for the purposes of paragraph 4(a)(ii) of the Policy, including:

"(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

The Panel finds that the Complainant had made a *prima facie* case that the Respondent had no rights or legitimate interests in the Disputed Domain Name. The Respondent's email communications are insufficient to refute the Complainant's contentions, as discussed further below.

The consensus of previous UDRP decisions is that while the overall burden of proof in UDRP proceedings is on the complainant, once a *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating its rights or legitimate interests in the Disputed Domain Name (see section 2.1 of the [WIPO Overview 3.0](#)). In the present case, the Respondent failed to make such demonstration.

Regarding paragraph 4(c)(i) of the Policy, the Panel finds, in light of the Complainant's asserted facts, that the Respondent was not given any license, permission, or authorization to register or use the ALSTOM trademarks or the Disputed Domain Name. Further, there is no indication that the Respondent possesses any registered or unregistered trademark rights in any jurisdiction pertaining to the ALSTOM trademarks or the Disputed Domain Name. Therefore, the Panel determines that the Respondent has no trademark rights or other legitimate interests in the ALSTOM trademarks.

Further, the Panel finds that: (i) "alstom" is a coined word, having no dictionary meaning in English (the popular language of international trade), French (the language of the Complainant's home country), or Vietnamese (the language of the country where the Respondent locates), and (ii) the ALSTOM trademarks have been widely used and become well-known by the Complainant in numerous countries including in Viet Nam before the registration of the Disputed Domain Name. Further, the Responding was using the Disputed

Domain Name in its Website without any accurate and prominent disclaimer of relationship with the Complainant. In this regard, the Panel is of the view that the Respondent intended to ride on the reputation of the ALSTOM trademarks.

Regarding the company named "ALSTOM POWER TECH" as introduced on the website under the Disputed Domain Name, the Complainant further submitted evidence that the company "ALSTOM POWER TECH" did not exist, while the Respondent did not provide sufficient evidence to the contrary, *i.e.* proving the existence of the company "ALSTOM POWER TECH" in reality, the business of such company in the field of pharmaceuticals, and the relationship between the Respondent and the company "ALSTOM POWER TECH". Therefore, the Panel is not convinced that the use of the mark "ALSTOM" by the Respondent was derived from the fact that the Respondent was the local importer or distributor of the said company.

From the foregoing, the Panel finds no evidence that the Respondent used or prepared to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services under paragraph 4(c)(i) of the Policy.

Regarding paragraph 4(c)(ii) of the Policy, the Panel finds no evidence demonstrating that the Respondent has been commonly known by the Disputed Domain Name due to the limited and unpersuasive information about the Respondent's business under the "ALSTOM" and the existence of the company named "ALSTOM POWER TECH".

Regarding paragraph 4(c)(iii) of the Policy, the Panel finds that the Respondent was not making a legitimate noncommercial or fair use of the Disputed Domain Name. Instead, it appears following the Complainant's assertions and evidence with regard to the Respondent's registration of the Disputed Domain Name that the Respondent had full knowledge of the ALSTOM trademarks and had the intention to gain profit by riding on the goodwill and reputation of the Complainant.

Accordingly, the Panel finds on balance that the Respondent has no rights or legitimate interests regarding the Disputed Domain Name, and the second element, paragraph 4(a)(ii) of the Policy, is established.

D. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy identifies, in particular, but without limitation, four circumstances which, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith, including:

"(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 on-line 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 above four circumstances are not exhaustive, and the Panel may find bad faith alternatively.

The Panel finds that the Complainant has put forth evidence that the Respondent has registered and used the Disputed Domain Name in bad faith. The Respondent did not formally reply to the Complainant's contentions and, therefore, did not refute the Complainant's contentions.

The Panel further finds that the ALSTOM trademarks have been registered on a worldwide basis, and enjoy certain fame in numerous countries around the world as recognized in previous UDRP decisions (see, e.g., *ALSTOM v. Name Redacted*, WIPO No. [D2023-0158](#); *ALSTOM v. Contact Privacy Inc. Customer 1244065242 / Michelle Chung, Chung Limited Co*, WIPO No. [D2019-2718](#); *Alstom S.A. and General Electric Company v. Sichuan Electricity Transmission and Distribution Engineering*, WIPO No. [DCO2016-0032](#)). Given the fame and wide use of the ALSTOM trademarks by the Complainant, which occurs in numerous countries, including in Viet Nam, where the Respondent is located, and well predated the registration dates of the Disputed Domain Name, it is very unlikely that the Respondent registered the Disputed Domain Name in a fortuity. Further, the Respondent failed to submit a formal response and to provide any evidence of actual or contemplated good faith use of the Disputed Domain Name. Therefore, the Panel considers the registration an attempt by the Respondent to take advantage of the Complainant's goodwill and reputation, and thus, was made in bad faith (see section 3.2.1 of the [WIPO Overview 3.0](#)).

Regarding the use of the Disputed Domain Name, the Panel shares the same views with other Panels that the use of trademarks, to which the Respondent's lack legitimate rights and interests, is indicative of bad faith use.

On the date of this Decision, the Panel accesses the Disputed Domain Name and finds that it resolves to an inactive website. However, the Disputed Domain Name previously resolved to a website that displayed the entity name "ALSTOM POWER TECH", the existence of the said company is questionable. It is further noted that the Respondent did not make any statement or disclosure about its actual connection with either the Complainant or the entity "ALSTOM POWER TECH". Hence, the Panel takes the view that the Respondent has intentionally attempted to ride on the reputation of the ALSTOM trademarks by providing Internet users with vague and unverified information about the trademark holders, creating a likelihood of confusion, to attract, for commercial gain, Internet users to its website. This supports a finding of bad faith use under paragraph 4(b)(iv) of the Policy.

Taking into account all of the above and the available record, the Panel finds that the Disputed Domain Name was registered and is being used by the Respondent in bad faith, and the third element under paragraph 4(a)(iii) of the Policy is established.

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 <alstomhk.com> be transferred to the Complainant.

/Pham Nghiem Xuan Bac/

Pham Nghiem Xuan Bac

Sole Panelist

Date: August 25, 2023