

# ADMINISTRATIVE PANEL DECISION

Abt Electronics Inc. v. 薛荧坤 (Xue YingKun) and 孙浩杰 Case No. D2023-0497

# 1. The Parties

Complainant is Abt Electronics Inc., United States of America ("US"), represented by Patzik, Frank & Samotny Ltd., US.

Respondents are 薛荧坤 (Xue YingKun), China ("Respondent 1"), and 孙浩杰, China ("Respondent 2").

## 2. The Domain Names and Registrar

The disputed domain names <abtsdiscount.com>, <abtappliancess.com>, <abtaudios.com>, <abtdiscountshop.com>, <abtonlineshop.com>, <abtspecials.com>, <abttvsonline.com>, and <abtwatchess.com> are registered with DNSPod, Inc. (the "Registrar").

# 3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on January 26, 2023 regarding the disputed domain names <abtonlineshop.com>, <abtwoonline.com>, <abtwoorline.com>, <abr/><abtwoorline.com</a>, <abtwoorline.com>, <

On February 3 and February 4, 2023, Respondent 1 sent three emails to the Center claiming that he did not register the disputed domain names and providing the contact information for Respondent 2. On February 9, 2023, the Center sent an email in English and Chinese to Respondent 2 requesting for confirmation regarding whether he is the owner of the disputed domain names <abtonlineshop.com>, <abtvsonline.com>, <abtvsonline.com>, <abtvsonline.com>, and <abtdiscountshop.com>, yet received no reply.

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 Respondent 1 in Chinese and English of the Complaint, and the proceedings commenced on February 14, 2023. In accordance with the Rules, paragraph 5(a), the due date for Response was March 6, 2023. Respondent 1 did not submit any formal response.

On February 16, February 17, February 24, and February 25, 2023, respectively, the Center received several emails from two third parties claiming that their personal contact information had been misappropriated by Respondents on the websites connected with the disputed domain names <a href="https://www.abtonline.com">abtonline.com</a>, and <a href="https://www.abtonline.com">abtonline.com</a

On February 17 and February 21, 2023, respectively, Complainant submitted a second and a third amended Complaints requesting to add the disputed domain names <a branches/abtappliancess.com> and <a branches/abtables/abtabbles/abtables/abt

On March 7, 2023, the Center informed the Parties that it would proceed with panel appointment.

The Center appointed Yijun Tian, Henry Perritt, Jr., and 陈长杰 Jacob (Changjie) Chen as panelists in this matter on March 22, 2023. The Panel finds that it was properly constituted. Each member of 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.

On April 6, 2023, the Panel instructed the Center to send the email of Request for Registrar Verification in connection with the disputed domain names <abtappliancess.com> and <abtsdiscount.com>. On April 11, 2023, the Registrar transmitted by email to the Center its verification response disclosing that the registrant for the disputed domain name <abtsdiscount.com> is Respondent 2 and the registrant for the disputed domain name <abtsdiscount.com> is Respondent 2 and the registrant for the disputed domain name <abtsdiscount.com> is Respondent 2 and the registrant for the disputed domain name <abtsdiscourt.com> is Respondent 1. The Panel instructed the Center to issue the Procedural Order No.1 on April 12, 2023, inviting Complainant to amend the Complaint to provide consolidation arguments by April 17, 2023, and inviting Respondents to comment on Complainant's submission including the consolidation of multiple registrants, and the language of the proceeding, and/or to file a Response by April 27, 2023. Complainant submitted a fourth amended Complaint in English on April 16, 2023 in response to the Procedural Order No.1. Respondents did not submit any response.

### 4. Factual Background

### A. Complainant

Complainant is Abt Electronics Inc., incorporated in Illinois, US. It has offered retail store services under the ABT mark since 1936, has offered online retail store services under the ABT mark since 2007, and continues to offer such services today. Complainant has prominently and extensively used, promoted, and advertised the ABT mark for over 86 years, and the domain name <a href="https://www.abt.com">abt.com</a> for over 15 years.

Complainant is the owner of numerous ABT trademarks worldwide, including the US trademark ABT registered on November 12, 2002 (the US trademark registration number 2,648,019) for "[r]etail stores featuring consumer electronics and appliances" services, and the US trademark ABT registered on December 15, 2009 (the US trademark registration number 3,725,369) for "[o]n-line retail store services featuring consumer electronics and appliances" services. Complainant also owns domain names that include the ABT marks, such as <a href="https://www.abt.com">abt.com</a>> and <a href="https://www.abt.com">abt.com</a>>.

## B. Respondents

Respondent 1 is 薛荧坤 (Xue YingKun), China. The disputed domain names <abtappliancess.com>, <abtaudios.com>, <abtdiscountshop.com>, <abtonlineshop.com>, <abtspecials.com>, <abtdiscountshop.com>, <abtspecials.com>, <abtdiscountshop.com>, <abtspecials.com>, <abtduscountshop.com>, <abtspecials.com>, <abtduscountshop.com>, <abtspecials.com>, <abtspecials.com>, <abtduscountshop.com>, <abtspecials.com>, <abtduscountshop.com>, <abtspecials.com>, <abtduscountshop.com>, <abtspecials.com>, <abtspecials.com</a>, <abtspecials.com>, <abtspecials.com</a>, <abtspecials.com</a>, <abtspecials.com</a>, <abtspecials.com</a>, <abtspecials.com</a>, <abtspecials.com</a>, <abtspecials.com</a>, <abtspecials.com</

### 5. Parties' Contentions

## A. Complainant

Complainant contends that all of the disputed domain names are confusingly similar to the ABT mark and the <abt.com> domain name. The disputed domain names merely combine the ABT mark with generic or descriptive terms that identify Complainant's products or services, such as "discount", "appliancess" (a misspelling of "appliances"), "online shop", "TVs online", "specials", "audios", "watchess" (a misspelling of "watchess"), and "discount shop". These terms do not distinguish the disputed domain names from the ABT mark.

Complainant contends that Respondent has no rights or legitimate interests in the disputed domain names.

Complainant contends that the disputed domain names were registered and are being used in bad faith.

Complainant requests that the disputed domain names be transferred to it.

### B. Respondents

Respondents did not formally reply to Complainant's contentions. In his email reply on February 3, and February 4, 2023, Respondent 1 contended that the disputed domain names were not registered by Respondent 1, provided the contact information for Respondent 2, and indicated that the Complaint needs to be amended.

### 6. Discussion and Findings

### 6.1. Addition of Domain Names

On February 17 and February 21, 2023, respectively, Complainant submitted a second and a third amended Complaints requesting to add the disputed domain names <a brack complaincess.com > and <a brack com > to the proceeding.

Considering the relationship between Respondent 1 and Respondent 2 as discussed under section 6.2. below, and the disputed domain name <abtsdiscount.com> was registered by Respondent 2 on February 14, 2023 – the very same day that the Center notified the Complaint to Respondent 1, the Panel exceptionally accept Complainant's request to add the disputed domain names <abtappliancess.com> and <abtsdiscount.com> to the current proceeding. See section 4.12.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0").

### 6.2. Consolidation of Multiple Respondents

The Panel notes that the present Complaint has been filed against multiple Respondents and Complainant has submitted a request for consolidation. On this subject, section 4.11 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("<u>WIPO Overview 3.0</u>") provides *inter alia* as follows:

"The WIPO Center may accept, on a preliminary basis, a consolidated complaint where the criteria described below are prima facie met. Any final determination on consolidation would be made by the appointed panel, which may apply its discretion in certain circumstances to order the separation of a filed complaint."

The Panel finds that Complainant has provided sufficient evidence to establish that the disputed domain names or corresponding websites are subject to common control, for the following reasons:

- (a) all of the disputed domain names used to direct users to websites resembling Complainant's "www.abt.com" website, with the ABT trademarks prominently displayed at the top of the page and a main menu including Appliances, TVs & Electronics, Audio, Home Essentials, Furniture & Mattresses, Watches & Travel, and Specials.
- (b) the disputed domain names were registered with the same Registrar in an approximate six-month timeframe - between September 7, 2022 and February 14, 2023 (seven of eight disputed domain names were registered by the same person on the same day);
- (c) the disputed domain names have been registered in a similar naming pattern, *i.e.*, incorporating Complainant's well-known ABT mark in its entirety with other terms related to Complainant's businesses;
- (d) both Respondents are located in China;
- (e) while the disputed domain name <abtsdiscount.com> was more recently registered than the other disputed domain names, Complainant claims, to which Respondent has not rebutted, that its "contact us" page at "https://abtsdiscount.com/contact-us/" displays the same email, telephone number, and location as the websites associated with the disputed domain names <abttvsonline.com>, <abtspecials.com>, and <abtwatchess.com>;</a>
- (f) Respondent 1 appears to have implied in one of his emails to the Center that Respondent 2 is the owner of the disputed domain names the disputed domain names <abtonlineshop.com>, <abtvsonline.com>, <abtvsonline.com>, <abtvsonline.com>, <abtvsonline.com>, <abtvsonline.com>, <abtvsonline.com>, <abtvsonline.com>, and <abtvsonline.com>;</a>
- (g) Seven disputed domain names were registered by Respondent 1 while Respondent 2 registered the eighth disputed domain name on the day that the Center notified the Complaint to Respondent 1.

Respondent has not objected to Complainant's request for consolidation of multiple registrants.

In all of these circumstances, the Panel finds that all of the disputed domain names are subject to the common control of Respondents. Therefore, the Panel considers that it is procedurally efficient to allow Complainant to proceed with the single Complaint as filed and is satisfied that such consolidation is fair and equitable to all of the Parties. Accordingly, Respondents are hereinafter referred to as "Respondent".

### 6.3. Language of the Proceeding

The language of the Registration Agreements for the disputed domain names is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the

Registration Agreement. From the evidence presented on the record, no agreement appears to have been entered into between Complainant and Respondent to the effect that the language of the proceeding should be English. Complainant filed initially the Complaint in English, and has requested that English be the language of the proceeding for the following main reasons:

- a) The websites to which the disputed domain names resolved are entirely in English.
- b) The contact information on the websites indicates headquarters and business addresses in the US and provides telephone numbers associated with the US.
- c) Respondent is fluent in English as it regularly conducts business in English.

Respondent did not make any submissions with respect to the language of the proceeding and did not object to the use of English as the language of the proceeding.

Paragraph 11(a) of the Rules allows the panel to determine the language of the proceeding having regard to all the circumstances. In particular, it is established practice to take paragraphs 10(b) and (c) of the Rules into consideration for the purpose of determining the language of the proceeding. In other words, it is important to ensure fairness to the parties and the maintenance of an inexpensive and expeditious avenue for resolving domain name disputes (*Whirlpool Corporation, Whirlpool Properties, Inc. v. Hui'erpu (HK) electrical appliance co. Itd.*, WIPO Case No. D2008-0293; *Solvay S.A. v. Hyun-Jun Shin*, WIPO Case No. D2006-0593). The language finally decided by the panel for the proceeding should not be prejudicial to either one of the parties in its abilities to articulate the arguments for the case (*Groupe Auchan v. xmxzI*, WIPO Case No. DCC2006-0004). Section 4.5.1 of the <u>WIPO Overview 3.0</u> further states:

"Noting the aim of conducting the proceedings with due expedition, paragraph 10 of the UDRP Rules vests a panel with authority to conduct the proceedings in a manner it considers appropriate while also ensuring both that the parties are treated with equality, and that each party is given a fair opportunity to present its case.

Against this background, panels have found that certain scenarios may warrant proceeding in a language other than that of the registration agreement. Such scenarios include (i) evidence showing that the respondent can understand the language of the complaint, (ii) the language/script of the domain name particularly where the same as that of the complainant's mark, (iii) any content on the webpage under the disputed domain name, (iv) prior cases involving the respondent in a particular language, (v) prior correspondence between the parties, (vi) potential unfairness or unwarranted delay in ordering the complainant to translate the complaint, (vii) evidence of other respondent-controlled domain names registered, used, or corresponding to a particular language, (viii) in cases involving multiple domain names, the use of a particular language agreement for some (but not all) of the disputed domain names, (ix) currencies accepted on the webpage under the disputed domain name, or (x) other indicia tending to show that it would not be unfair to proceed in a language other than that of the registration agreement." (See also *L'Oreal S.A. v. MUNHYUNJA*, WIPO Case No. <u>D2003-0585</u>).

On the record, Respondent is located in China and is thus presumably not a native English speaker. However, considering the following factors, the Panel has decided that English should be the language of the proceeding: (a) all of the disputed domain names include Latin characters and English words, rather than Chinese scripts; (b) the disputed domain names previously resolved to websites in English rather than in Chinese; (c) the Center has notified Respondent of the proceeding in both Chinese and English; and (d) the Center informed the Parties, in English and Chinese, that it would accept a Response in either English or Chinese, but none was filed.

Accordingly, the Panel finds the choice of English as the language of the present proceeding is fair to both Parties and is not prejudicial to either one of the Parties in its ability to articulate the arguments for this case. Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that English shall be the language of the proceeding, and the decision will be rendered in English.

### 6.4. Substantive Issues

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

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

On the basis of the evidence introduced by Complainant and in particular with regard to the content of the relevant provisions of the Policy (paragraphs 4(a)-(c)), the Panel concludes as follows:

## A. Identical or Confusingly Similar

The Panel finds that Complainant has rights in the ABT mark acquired through registration and use. The ABT marks have been registered in the US since 2002. The Panel further finds that all of the disputed domain names incorporate the ABT mark in its entirety. The only difference between the disputed domain names and Complainant's ABT trademark is the addition of the terms "discount", "appliancess" (a misspelling of "appliances"), "online shop", "tvs online", "specials", "audios", "watchess" (a misspelling of "watches"), or "discount shop", as well as the generic Top-Level Domain ("gTLD") ".com". However, these differences do not compromise the recognizability of Complainant's mark within the disputed domain names, nor do they prevent a finding of confusing similarity between Complainant's registered trademark and the disputed domain names (*Decathlon v. Zheng Jianmeng*, WIPO Case No. <u>D2019-0234</u>).

Further, in relation to the gTLD suffix, <u>WIPO Overview 3.0</u> further states: "The applicable Top-Level Domain ('TLD') in a domain name (*e.g.*, '.com', '.club', '.nyc') is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test." (<u>WIPO Overview 3.0</u>, section 1.11.1.)

The Panel, therefore, holds that the Complaint fulfils the first condition of paragraph 4(a) of the Policy.

### B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances any of which is sufficient to demonstrate that Respondent has rights or legitimate interests in the disputed domain names:

- (i) before any notice to Respondent of the dispute, the use by Respondent of, or demonstrable preparations to use, the disputed domain names or a name corresponding to the disputed domain names in connection with a *bona fide* offering of goods or services; or
- (ii) Respondent has been commonly known by the disputed domain names, even if Respondent has acquired no trademark or service mark rights; or
- (iii) Respondent is making a legitimate noncommercial or fair use of the disputed domain names, without intent for commercial gain to misleadingly divert consumers or to tarnish Complainant's trademarks.

The overall burden of proof on this element rests with Complainant. However, it is well established by previous UDRP panel decisions that once a complainant establishes a *prima facie* case that a respondent lacks rights or legitimate interests in a domain name, the burden of production shifts to the respondent to rebut complainant's contentions. If the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. (*Danzas Holding AG, DHL Operations B.V. v. Ma Shikai*, WIPO Case No. D2008-0441; WIPO Overview 3.0, section 2.1, and cases cited therein).

Complainant has rights in the ABT marks in the US since 2002, which long precede Respondent's registrations of the disputed domain names (2022 or 2023). According to the Complaint, Complainant has offered these retail store services under the ABT mark since 1936, has offered online retail store services under the ABT mark since 2007, and continues to offer such services today. Complainant has prominently and extensively used, promoted, and advertised the ABT mark for over 86 years, and the domain name <abt.com> for over 15 years.

Complainant asserts that they have not authorized Respondent to use their ABT marks, and Respondent is not the licensee of Complainant. Complainant has therefore established a *prima facie* case that Respondent has no rights or legitimate interests in the disputed domain names and thereby shifted the burden to Respondent to produce evidence to rebut this presumption (*The Argento Wine Company Limited v. Argento Beijing Trading Company*, WIPO Case No. <u>D2009-0610</u>; *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. <u>D2000-0624</u>; *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. <u>D2003-0455</u>).

Based on the following reasons, the Panel finds that Respondent has no rights or legitimate interests in the disputed domain names:

- (a) There has been no evidence adduced to show that Respondent is using the disputed domain names in connection with a *bona fide* offering of goods or services. Respondent has not provided evidence of legitimate use of the disputed domain names or reasons to justify the choice of the term "abt" in the disputed domain names. There has been no evidence to show that Complainant has licensed or otherwise permitted Respondent to use the ABT marks or to apply for or use any domain names incorporating the ABT marks;
- (b) There has been no evidence adduced to show that Respondent has been commonly known by the disputed domain names. There has been no evidence adduced to show that Respondent has any registered trademark rights with respect to the disputed domain names. Respondent registered the disputed domain names in 2022 or 2023, long after the ABT marks became internationally known. The disputed domain names are confusingly similar to Complainant's ABT marks; and
- (c) There has been no evidence adduced to show that Respondent is making a legitimate noncommercial or fair use of the disputed domain names. By contrast, as mentioned above, according to the information provided by Complainant, all of the disputed domain names used to direct users to websites resembling Complainant's "www.abt.com" website, with the ABT trademarks prominently displayed at the top of the page and a main menu including Appliances, TVs & Electronics, Audio, Home Essentials, Furniture & Mattresses, Watches & Travel, and Specials.

The Panel finds that Respondent has failed to produce any evidence to rebut Complainant's *prima facie* case. The Panel, therefore, holds that the Complaint fulfils the second condition of paragraph 4(a) of the Policy.

#### C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out four circumstances which, without limitation, shall be evidence of the registration and use of the disputed domain names in bad faith, namely:

- (i) circumstances indicating that Respondent has registered or acquired the disputed domain names primarily for the purpose of selling, renting, or otherwise transferring the domain name registrations to Complainant who are 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 names; or
- (ii) Respondent has registered the disputed domain names in order to prevent the owner of the trademark or service mark 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 names primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed domain names, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's websites or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's websites or location or of a product or service on the websites or location.

The Panel concludes that the circumstances referred to in paragraph 4(b)(iv) of the Policy are applicable to the present case and upon the evidence of these circumstances and other relevant circumstances, it is adequate to conclude that Respondent has registered and used the disputed domain names in bad faith.

#### (a) Registration in Bad Faith

The Panel finds that Complainant has a widespread reputation in the ABT marks with regard to their products or services. Complainant has registered its ABT marks in the US since 2002. As introduced above, Complainant has offered these retail store services under the ABT mark since 1936, has offered online retail store services under the ABT mark since 2007, and continues to offer such services today. Complainant has prominently and extensively used, promoted, and advertised the ABT mark for over 86 years, and the domain name <a href="https://www.abt.com">abt.com</a> for over 15 years.

All of the disputed domain names were registered in 2022 or 2023, long after Complainant's trademark registrations in the US (2002). It is not conceivable that Respondent would not have had actual notice of Complainant's trademark rights at the time of the registration of the disputed domain names.

Moreover, Respondent has chosen not to respond to Complainant's allegations. According to the UDRP decision in *The Argento Wine Company Limited v. Argento Beijing Trading Company, supra*, "the failure of Respondent to respond to the Complaint further supports an inference of bad faith". See also *Bayerische Motoren Werke AG v. (This Domain is For Sale) Joshuathan Investments, Inc.*, WIPO Case No. <u>D2002-0787</u>.

Thus, the Panel concludes that the disputed domain names were registered in bad faith.

### (b) Use in Bad Faith

As introduced above, the disputed domain names previously resolved to substantially identical websites that prominently featured Complainant's ABT trademarks and provided services similar to those of Complainant. These websites used to resemble Complainant's "www.abt.com" website, with the ABT trademarks prominently displayed at the top of the page and a main menu including Appliances, TVs & Electronics, Audio, Home Essentials, Furniture & Mattresses, Watches & Travel, and Specials. Thus, the Panel concludes that Respondent is using the confusingly similar disputed domain names with the intention to attract, for commercial gain, Internet users to Respondent's websites.

Given the reputation of the ABT marks, the Panel finds that the public is likely to be confused into thinking that the disputed domain names have a connection with Complainant, contrary to the fact. There is a strong likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the websites to which the disputed domain names resolved. In other words, Respondent has through the use of the confusingly similar disputed domain names created a likelihood of confusion with the ABT marks.

The Panel, therefore, concludes that the disputed domain names were registered and are being used in bad faith. Such use of the disputed domain names is also disruptive in relation to the interests of Complainant.

In summary, Respondent, by choosing to register and use the disputed domain names, which are confusingly similar to the ABT mark, intended to ride on the goodwill of this trademark in an attempt to

exploit, for commercial gain, Internet users destined for Complainant. In the absence of evidence to the contrary and rebuttal from Respondent, the choice of the disputed domain names and the conducts of Respondent as far as the websites to which the disputed domain names resolved are indicative of registration and use of the disputed domain names in bad faith. The current non-use of some of the disputed domain names would not change the Panel's finding of Respondent's bad faith.

Moreover, Respondent seems to have used contact details of third parties on some of the websites associated with the disputed domain names which constitutes further evidence of Respondent's bad faith.

The Panel, therefore, holds that the Complaint fulfils the third condition of 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 names, <abtsdiscount.com>, <abtappliancess.com>, <abtaudios.com>, <abtdiscountshop.com>, <abtonlineshop.com>, <abtspecials.com>, <abtwordspecials.com>, <abtwordspecials.com>, and <abtwatchess.com>, be transferred to Complainant.

/Yijun Tian/ Yijun Tian Presiding Panelist

/Henry Perritt, Jr./ Henry Perritt, Jr. Panelist

/陈长杰 Jacob (Changjie) Chen/ **陈长杰 Jacob (Changjie) Chen** Panelist Date: May 9, 2023