

ADMINISTRATIVE PANEL DECISION

Ecovacs Robotics Co., Ltd. v. Ningning International Trading Company Pty Ltd

Case No. DAU2022-0036

1. The Parties

The Complainant is Ecovacs Robotics Co., Ltd., China, represented by Beijing Chofn Intellectual Property Agency Co. Ltd, China.

The Respondent is Ningning International Trading Company Pty Ltd, Australia, internally represented.

2. The Domain Name and Registrar

The disputed domain name <ecovacs.com.au> is registered with Web Address Registration Pty Ltd.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 16, 2022. On November 16, 2022, the Center transmitted by email to Web Address Registration Pty Ltd a request for registrar verification in connection with the disputed domain name. On November 18, 2022, Web Address Registration Pty Ltd transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the .au Dispute Resolution Policy (the “Policy”), the Rules for .au Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .au Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 24, 2022. In accordance with the Rules, paragraph 5(a), the due date for Response was December 14, 2022. The Response was filed with the Center on November 29, 2022.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on January 10, 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 was founded in China in 1998. Its main business involves the research and development, design, production and sale of intelligent household equipment including, in particular, home service robots. These products are offered for sale under and by reference to the trade marks ECOVACS and ECOVACS ROBOTICS. On May 28, 2018, the Complainant was listed on the Shanghai Stock Exchange.

According to the Complaint, the Complainant employs nearly 1,000 people in its R&D team alone.

Its products are now in use in over 145 countries including Australia, Japan, Spain, Switzerland, France, Canada, Czech Republic, Poland, Germany, Iran (Islamic Republic of), and Malaysia.

The Complainant is registered on the Australian Business Register.

By 2020, the Complainant had revenues of RMB 7.2 billion. Of which approximately 30 per cent was derived from overseas sales. In 2016, its annual revenues were RMB 3.2 billion. By 2017, "IFR" data disclosed that the Complainant had an online market share in the field of home service robots of almost 50 per cent in China and it was ranked first in sales of household electrical appliances. In the period from 2013 to 2017, the compound annual growth rate of the Complainant's overseas revenue from service robot sales reached 111 per cent.

In 2017, one of the Complainant's products won the prestigious Good Design Award at the Global Design Awards in Japan – for the second time. In subsequent years, the Complainant's products have received numerous awards including from CES, the German Red Dot Award, and IROS amongst others.

The Complaint includes evidence that the Complainant holds a number of registered trade marks including:

- (1) United States Registered Trademark No. 3,537,599, ECOVACS, which has been registered in the Principal Register in respect of products in International Class 7 since November 25, 2008;
- (2) United States Registered Trademark No. 3,540,773, ECOVACS, which has been registered in the Principal Register in respect of products in International Class 11 since December 2, 2008;
- (3) a number of registrations in Australia, China, and the European Union for a slightly stylised version of ECOVACS with the device of two arcs over and underneath the letter "e" which were registered in 2020 and 2021.

The Response also includes evidence that the Complainant is the registered owner in Australia of Australian Registered Trade Mark No. 1265027, ECOVAC, which has been registered with effect from September 30, 2008, in respect of goods and services in International Classes 7 and 37.

The disputed domain name was registered on May 26, 2015.

On May 27, 2015, the Respondent also applied to register in Australia Trade Mark Application No. 1696219, ECOVACS, in respect of goods in International Class 7. According to the Response, this application was subsequently withdrawn due to "unforeseen circumstances". It appears from IP Australia's online database, however, this application received an adverse examination report on September 5, 2015, and subsequently lapsed on December 5, 2016.

When the Complaint was filed, the disputed domain name resolved to a "parking page" which simply stated "Premium Web Domain for sale" and, after setting out the disputed domain name, stated "It's a strong, memorable domain name". Adjacent to these text elements was dialog box inviting the viewer to "Make an offer".

5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (i) the disputed domain name is identical or confusingly similar to a name, trade mark 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 or subsequently used in bad faith.

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

A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's name, trade mark or service mark.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trade mark at the date the Complaint was filed and, if so, the disputed domain name must be identical or confusingly similar to the trade mark.

The Complainant has proven that it owns, amongst other things, the registered trade marks for ECOVAC, ECOVACS, and ECOVACS (stylised) referred to in section 4 above.

Typically and as is appropriate in this case, it is permissible to disregard the Second-Level Domain, ".com.au", as a functional component of the domain naming system. See for example auDA Overview of Panel Views on Selected auDRP Questions First Edition ("auDRP Overview 1.0"), section 1.2. It is also usual to disregard the design elements of a trade mark under the first element as such elements are generally incapable of representation in a domain name. See for example, auDRP Overview 1.0, section 1.11. Accordingly, the Panel finds that the disputed domain name is identical to the Complainant's trade marks for ECOVACS and ECOVACS (stylised).

The disputed domain name also differs from the Complainant's ECOVAC trade mark solely by the addition of the letter "s" at the end. That difference can be seen as simply making a plural of the Complainant's trade mark. Such a misspelling is readily found to be confusingly similar to the Complainant's trade mark. See e.g. auDRP Overview 1.0, section 1.10.

The Respondent says he registered the disputed domain name before the Complainant acquired its trade mark rights in Australia and, in any event, the disputed domain name consists of a combination of two "common" words: "eco" and "vacs".

On the question of identity or confusing similarity, however, what is required is simply a visual and aural comparison and assessment of the disputed domain name itself to the Complainant's trade marks: see for example, *GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd.*, WIPO Case No. [DAU2002-0001](#). This test is narrower than and thus different to the question of "likelihood of confusion" under trade mark law which can require an assessment of the nature of the goods or services protected and those for which any impugned use is involved, geographical location or timing.

So, the Respondent's arguments based on timing or jurisdiction of the registered rights, to the extent they are factually correct, are irrelevant under this aspect of the Policy. Such matters, if relevant however, may fall for consideration under the other elements of the Policy.

Therefore, the Complainant has established the first requirement under the Policy.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances may be situations in which a respondent has rights or legitimate interests in a disputed domain name:

- (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 (not being the offering or domain names that the respondent has acquired for the purpose of selling, renting or otherwise transferring); or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trade mark 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 trade mark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The *onus* of proving this requirement, like each element, falls on the Complainant. Previous panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden will shift to the respondent to rebut that *prima facie* case. The ultimate burden of proof, however, remains with the Complainant. See *e.g.*, *GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd*, WIPO Case No. [DAU2002-0001](#).

The disputed domain name is not derived from the Respondent's name, or the name of the individual who is the contact for the Respondent identified by the Registrar. While the Respondent attempted to register the Third-Level Domain component of the disputed domain name as a trade mark, that application failed and so the Respondent does not hold any registered trade marks from which the disputed domain name could be derived.

It is not in dispute between the parties that the Complainant has not authorised the Respondent to use its trade marks or register the disputed domain name. Nor is the Respondent otherwise affiliated with the Complainant.

So far as the record in this proceeding shows, the only use apparently made of the disputed domain name is to offer it for sale. That conduct would not ordinarily qualify as legitimate noncommercial or fair use. Registering a descriptive term as a domain name to offer it for sale for its intrinsic value may be a legitimate use under the Policy provided it is not really a pretext to trade on another's rights. However, the Panel is not convinced that the portmanteau term in the present case qualifies as a descriptive term and, in any event, that is not the only reason why the Respondent claims to have registered the disputed domain name.

Accordingly, the Complainant has established the required *prima facie* case.

The Respondent states that it registered the disputed domain name in preparation for a business for "eco-friendly" vacuum cleaners. As noted above, the Respondent claims it chose the disputed domain name as a combination of two descriptive words "eco" (for ecology or ecological and so "eco-friendly") and "vacs" as the

plural of “vac” for vacation or vacuum cleaner. Claiming that the Complainant had not used or registered its trade mark ECOVACS in Australia before the Respondent registered the disputed domain name, the Respondent says the disputed domain name will be seen as a combination of common terms which will not cause confusion.

The Respondent has not submitted any evidence to support its claims of preparations for a business in environmentally friendly vacuum cleaners. Generally speaking, bare assertions of this kind without some form of corroborating evidence are not sufficient to sustain a claim of demonstrable preparations for use in connection with a good faith offering of goods and services. See e.g. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 2.2. As this requirement under the Policy is relevantly identical to the corresponding provision in the Uniform Domain Name Dispute Resolution Policy (from which the Policy was derived with some modifications not presently relevant), it is appropriate to apply the same approach under the Policy.

The Respondent does claim that the Complainant’s trade mark was not very well-known in Australia in 2015 and, further, alleges the Complainant did not start operations in Australia until 2017. That does not assist the Respondent, even if true.

First, the question under the Policy is whether or not the disputed domain name has been registered opportunistically to take advantage of the Complainant’s trade mark. Having regard to the global nature of the Internet, that issue is not automatically limited by national or jurisdictional boundaries. Secondly, in any event, the Complainant does have a registered trade mark in Australia which pre-dates the registration of the disputed domain name.

Furthermore, and contrary to the Respondent’s claims that “Ecovacs” is not confusing with “Ecovac”, the disputed domain name, particularly if used in connection with the claimed vacuum cleaner business, is in direct conflict with at least the Complainant’s ECOVAC registration. The Complainant’s ECOVAC registration pre-dates the Respondent’s registration of the disputed domain name by a number of years. Accordingly, the Panel does not accept this claimed justification.

Accordingly, the Respondent has failed to rebut the *prima facie* case established by the Complainant that the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered or Subsequently Used in Bad Faith

In contrast to the Uniform Dispute Resolution Policy, the Complainant must establish only that the disputed domain name has been either registered or subsequently used in bad faith by the Respondent under the third requirement of the Policy.

Paragraph 4(b) of the Policy provides that:

For the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (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 another person 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 a name, trademark or service mark from reflecting that name or mark in a corresponding domain name; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business or activities of another person; or

- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of that website or location or of a product or service on that website or location; or
- (v) if any of your representations or warranties as to eligibility or third party rights given on application or renewal are, or subsequently become, false or misleading in any manner.

As the wording of paragraph 4(b) makes plain, the instances of bad faith set out in paragraph 4(b) of the Policy are examples only, intended to illustrate types of conduct which is caught by the Policy.

In the present case, the Panel has been unable to accept the Respondent's claimed purpose in registering the disputed domain name. The Respondent therefore has been found not to have rights or legitimate interests in the disputed domain name.

Further, while the Respondent claims the disputed domain name is a descriptive combination, both trade marks ECOVAC and ECOVACS have been registered in circumstances where they must be considered at the very least *prima facie* distinctive for at least purposes of the national registration offices' examinations.

In these circumstances, and bearing in mind the very substantial scale of the Complainant's business (even allowing for the fact that only revenue figures for 2016 and later have been provided), it appears more likely than not that the Respondent registered the disputed domain name to take advantage of its significance as the Complainant's trade mark.

For the reasons outlined in section 5.B above, the Respondent's claims that the Complainant's trade mark was not very well-known in Australia in 2015 and did not start operations in Australia until 2017 are not to the point.

Fourthly, having regard to these matters and bearing in mind that the only use apparently made of the disputed domain name for some seven years has been to offer it for sale, the Panel finds that the disputed domain name has also been used in bad faith.

Accordingly, the Complainant has established all three requirements under the Policy.

6. Decision

For all 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, <ecovacs.com.au>, be transferred to the Complainant.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: January 24, 2023