

NATIONAL ARBITRATION FORUM

DECISION

The Valspar Company v. Gao Ping
Claim Number: FA0809001226468

PARTIES

Complainant is **The Valspar Company** ("Complainant"), represented by **Andrew Ehard**, of **Merchant & Gould, P.C.**, Minnesota, USA. Respondent is **Gao Ping** ("Respondent"), China.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**cn-valspar.com**>, registered with **Xin Net Technology Corporation**.

PANEL

The undersigned certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as Panelist in this proceeding.

James A. Carmody, Esq., as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on September 26, 2008; the National Arbitration Forum received a hard copy of the Complaint on September 29, 2008. The Complaint was submitted in both Chinese and English.

On September 26, 2008, Xin Net Technology Corporation confirmed by e-mail to the National Arbitration Forum that the <**cn-valspar.com**> domain name is registered with Xin Net Technology Corporation and that Respondent is the current registrant of the name. Xin Net Technology Corporation has verified that Respondent is bound by the Xin Net Technology Corporation registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On October 9, 2008, a Chinese language Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of October 29, 2008 by which Respondent could file a response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to postmaster@cn-valspar.com by e-mail.

Having received no response from Respondent, the National Arbitration Forum transmitted to the parties a Notification of Respondent Default.

On November 4, 2008, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed James A. Carmody, Esq., as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the National Arbitration Forum has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent." Therefore, the Panel may issue its decision based on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, the National Arbitration Forum's Supplemental Rules and any rules and principles of law that the Panel deems applicable, without the benefit of any response from Respondent.

Pursuant to Rule 11(a) the Panel determines that the language requirement has been satisfied through the Chinese language Complaint and Commencement Notification and, absent a Response, determines that the remainder of the proceedings may be conducted in English.

RELIEF SOUGHT

Complainant requests that the domain name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant makes the following assertions:

1. Respondent's <**cn-valspar.com**> domain name is confusingly similar to Complainant's VALSPAR mark.
2. Respondent does not have any rights or legitimate interests in the <**cn-valspar.com**> domain name.
3. Respondent registered and used the <**cn-valspar.com**> domain name in bad faith.

B. Respondent failed to submit a Response in this proceeding.

FINDINGS

Complainant owns the trademark VALSPAR in connection with a variety of paints and coating products and services. Complainant has registered the VALSPAR mark in numerous jurisdictions across the globe, including with the United States Patent and Trademark Office ("USPTO") (Reg. No. 97,293 issued May 26, 1914) and the Chinese trademark authorities (Reg. No. 1,132,020 issued December 7, 1997).

Respondent's <cn-valspar.com> domain name redirects Internet users to a commercial website for "Zhongshan Huazibo Chemical Industrial Company Ltd." This company is a direct competitor of Complainant in the Chinese market, offering products and services in competition with those offered under Complainant's mark. The disputed domain name was registered on February 28, 2005.

DISCUSSION

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

In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(e), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. *See Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (Nat. Arb. Forum July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); *see also Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

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

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

Identical and/or Confusingly Similar

The Panel finds that Complainant has sufficiently established rights in the VALSPAR mark for the purposes of Policy ¶ 4(a)(i) through registration of the mark with the USPTO and the Chinese trademark authorities. *See Honeywell Int'l Inc. v. r9.net*, FA 445594 (Nat. Arb. Forum May 23, 2005) ("Complainant's numerous registrations for its HONEYWELL mark throughout the world are sufficient to establish Complainant's rights in the HONEYWELL mark under the Policy ¶ 4(a)(i)."); *see also Am. Int'l Group, Inc. v. Morris*, FA 569033 (Nat. Arb. Forum Dec. 6, 2005) ("Complainant has established rights in the AIG mark through registration of the mark with several trademark authorities throughout the world, including the United States Patent and Trademark office ('USPTO')...").

The <cn-valspar.com> domain name contains Complainant's VALSPAR mark in its entirety preceded by a hyphen and the letters "cn," which are a common geographic indicator and initials for "China." China is a country in which Complainant has a commercial presence. The disputed domain name also contains the generic top-level domain ("gTLD") ".com." First, the Panel recognizes gTLDs are generally considered irrelevant to a Policy ¶ 4(a)(i) analysis. Second, the inclusion of a hyphen does not sufficiently differentiate a disputed domain name. And third, the Panel is persuaded that the inclusion of geographic indicator, especially one of where Complainant engages in business, does not negate a finding of confusing similarity. As a consequence of these findings, the Panel determines that the <cn-valspar.com> domain name is confusingly similar to Complainant's VALSPAR mark pursuant to Policy ¶ 4(a)(i). See *Trip Network Inc. v. Alviera*, FA 914943 (Nat. Arb. Forum Mar. 27, 2007) (concluding that the addition of a gTLD, whether it be ".com," ".net," ".biz," or ".org," is irrelevant to a Policy ¶ 4(a)(i) analysis); see also *Health Devices Corp. v. Aspen S T C*, FA 158254 (Nat. Arb. Forum July 1, 2003) ("[T]he addition of punctuation marks such as hyphens is irrelevant in the determination of confusing similarity pursuant to Policy ¶ 4(a)(i)."); see also *Gannett Co. v. Chan*, D2004-0117 (WIPO Apr. 8, 2004) ("...it is well established that a domain name consisting of a well-known mark, combined with a geographically descriptive term or phrase, is confusingly similar to the mark."); see also *Hess Corp. v. GR*, FA 770909 (Nat. Arb. Forum Sept. 19, 2006) (finding that the respondent's <hess-uk.com> domain name was confusingly similar to the complainant's HESS mark, as the mere addition of "uk" and a hyphen failed to sufficiently differentiate the disputed domain name from the registered mark).

The Panel concludes that Complainant has satisfied Policy ¶ 4(a)(i).

Rights or Legitimate Interests

Before the Panel may proceed to examine the record under Policy ¶ 4(a)(ii), it must first consider whether or not Complainant has established a *prima facie* case that Respondent lacks rights and legitimate interests in the disputed domain name. See *VeriSign Inc. v. VeneSign C.A.*, D2000-0303 (WIPO June 28, 2000) ("Respondent's default, however, does not lead to an automatic ruling for Complainant. Complainant still must establish a *prima facie* case showing that under the Uniform Domain Name Dispute Resolution Policy it is entitled to a transfer of the domain name."). The Panel finds that Complainant has met this threshold, and that the burden is now upon Respondent to show that it does have rights or a legitimate interest in the disputed domain name. See *Swedish Match UK Ltd. v. Admin, Domain*, FA 873137 (Nat. Arb. Forum Feb. 13, 2007) (finding that once a *prima facie* case has been established by the complainant under Policy ¶ 4(c), the burden then shifts to the respondent to demonstrate its rights or legitimate interests in the disputed domain name).

No response has been received. Therefore, the Panel may presume that Respondent lacks rights and legitimate interests in the disputed domain name. However, for the purposes of clarity and assuredness, the Panel will nonetheless proceed to examine the record in

consideration of the elements listed under Policy ¶ 4(c). *See CMGI, Inc. v. Reyes*, D2000-0572 (WIPO Aug. 8, 2000) (finding that the respondent’s failure to produce requested documentation supports a finding for the complainant); *see also Vanguard Group, Inc. v. Collazo*, FA 349074 (Nat. Arb. Forum Dec. 1, 2004) (finding that because Respondent failed to submit a Response, “Complainant’s submission has gone unopposed and its arguments undisputed. In the absence of a Response, the Panel accepts as true all reasonable allegations . . . unless clearly contradicted by the evidence.”).

The WHOIS information lists Respondent under the alias “Gao Ping.” This provides no indication of a relationship between the disputed domain name and Respondent. Furthermore, Complainant makes it clear that it has at no time authorized or otherwise granted permission to Respondent to use the VALSPAR mark in any way. Without any additional information in the record, the Panel finds that Respondent is not commonly known by the <cn-valspar.com> domain name pursuant to Policy ¶ 4(c)(ii). *See Tercent Inc. v. Lee Yi*, FA 139720 (Nat. Arb. Forum Feb. 10, 2003) (stating “nothing in Respondent’s WHOIS information implies that Respondent is ‘commonly known by’ the disputed domain name” as one factor in determining that Policy ¶ 4(c)(ii) does not apply); *see also IndyMac Bank F.S.B. v. Eshback*, FA 830934 (Nat. Arb. Forum Dec. 7, 2006) (finding that the respondent failed to establish rights and legitimate interests in the <emitmortgage.com> domain name as the respondent was not authorized to register domain names featuring the complainant’s mark and failed to submit evidence of that it is commonly known by the disputed domain name).

The <cn-valspar.com> domain name redirects Internet users to the website of a direct competitor of Complainant. This website offers products and services that compete with Complainant. The Panel considers this use of the <cn-valspar.com> domain name to constitute neither a *bona fide* offering of goods or services pursuant to Policy ¶ 4(c)(i) nor a legitimate noncommercial or fair use pursuant to Policy ¶ 4(c)(iii). *See Am. Int’l Group, Inc. v. Benjamin*, FA 944242 (Nat. Arb. Forum May 11, 2007) (finding that the respondent’s use of a confusingly similar domain name to advertise real estate services which competed with the complainant’s business did not constitute a *bona fide* offering of goods or services under Policy ¶ 4(c)(i), or a legitimate noncommercial or fair use under Policy ¶ 4(c)(iii)); *see also Computerized Sec. Sys., Inc. v. Hu*, FA 157321 (Nat. Arb. Forum June 23, 2003) (“Respondent’s appropriation of [Complainant’s] SAFLOK mark to market products that compete with Complainant’s goods does not constitute a *bona fide* offering of goods and services.”).

The Panel concludes that Complainant has satisfied Policy ¶ 4(a)(ii).

Registration and Use in Bad Faith

The <cn-valspar.com> domain name resolves to the website of a direct competitor of Complainant. The Panel finds that Respondent’s intent in registering and using the disputed domain name is to disrupt the business of Complainant. Accordingly, the Panel determines that Respondent registered and is using the <cn-valspar.com> domain name

in bad faith pursuant to Policy ¶ 4(b)(iii). *See Classic Metal Roofs, LLC v. Interlock Indus., Ltd.*, FA 724554 (Nat. Arb. Forum Aug. 1, 2006) (finding that the respondent registered and used the <classicmetalroofing.com> domain name in bad faith pursuant to Policy ¶ 4(b)(iii) by redirecting Internet users to the respondent's competing website); *see also Jerie v. Burian*, FA 795430 (Nat. Arb. Forum Oct. 30, 2006) (concluding that the respondent registered and used the <sportlivescore.com> domain name in order to disrupt the complainant's business under the LIVESCORE mark because the respondent was maintaining a website in direct competition with the complainant).

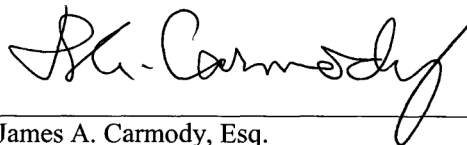
Moreover, Complainant contends that the Panel may presume that Respondent is commercially benefiting from this use. The Panel agrees. When a respondent uses a confusing similar domain name to resolve to a competitor of the complainant, the panel may presume that Respondent has done this for its own commercial benefit. In view of these circumstances, the Panel finds further evidence under Policy ¶ 4(b)(iv) that Respondent registered and is using the <cn-valspar.com> domain name in bad faith. *See Dell Inc. v. Innervision Web Solutions*, FA 445601 (Nat. Arb. Forum May 23, 2005) (finding evidence of bad faith under Policy ¶ 4(b)(iv) where the respondent was using the <dellcomputerssuck.com> domain name to divert Internet users to respondent's website offering competing computer products and services); *see also Amazon.com, Inc. v. Shafir*, FA 196119 (Nat. Arb. Forum Nov. 10, 2003) ("As Respondent is using the domain name at issue in direct competition with Complainant, and giving the impression of being affiliated with or sponsored by Complainant, this circumstance qualifies as bad faith registration and use of the domain name pursuant to Policy ¶ 4(b)(iv).").

The Panel concludes that Complainant has satisfied Policy ¶ 4(a)(iii).

DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <cn-valspar.com> domain name be **TRANSFERRED** from Respondent to Complainant.



James A. Carmody, Esq.
Arbitrator

James A. Carmody, Esq., Panelist
Dated: November 18, 2008

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