

ADMINISTRATIVE PANEL DECISION

Công ty Cổ phần Công nghiệp Vĩnh Tường (Vinh Tuong Industrial Corporation) v. Vinh Tuong, Công ty TNHH TM - DV Vĩnh Tường
Case No. D2022-0105

1. The Parties

The Complainant is Công ty Cổ phần Công nghiệp Vĩnh Tường (Vinh Tuong Industrial Corporation), Viet Nam, represented by IP-Mark Asia Law Firm (Công ty Luật TNHH Thăng Phạm & Cộng sự), Viet Nam.

The Respondent is Vinh Tuong, Công ty TNHH TM - DV Vĩnh Tường, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <thachcaovinhtuong.com> is registered with OnlineNic, Inc. d/b/a China-Channel.com (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on January 13, 2022. On January 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 14, 2022, 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.

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 January 21, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 10, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 11, 2022.

The Center appointed John Swinson as the sole panelist in this matter on February 15, 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 was established in Viet Nam in 2005 under the name of “Công ty Cổ phần Công nghiệp Vĩnh Tường” (Vinh Tuong Industrial Corporation).

The Complainant is a comprehensive solutions provider for ceilings and partitions and provides products such as concealed ceiling frames, suspended ceiling frames, partitions, and products suitable for all types of gypsum boards, decorative and functional panels and the like.

The Complainant owns the registered trademarks in Viet Nam, including the following:

- A logo that includes the word VĨNH TUỜNG, Registration No. 40214008000, filed on December 9, 2011 and registered on October 9, 2013.
- A word mark for VĨNH TUỜNG, Registration No. 40250960000, filed on March 27, 2012 and registered on September 10, 2015.

The Complainant also owned a registration for a logo that includes the word VĨNH TUỜNG, Registration No. 40031987000, that was filed on May 15, 1998 and registered on September 3, 1999, but this registration expired on May 15, 2018.

The disputed domain name was registered on May 9, 2010.

The Respondent did not file a Response, so little is known about the Respondent.

The website at the disputed domain name offers for sale building and decorative products, including those of the Complainant and the Complainant’s competitors. This website appears to be directed to consumers in Viet Nam.

5. Parties’ Contentions

A. Complainant

In summary, the Complainant makes the following submissions:

The Complainant was established in 2005 and is well-known in Viet Nam and the region. Many top buildings include the Complainant’s products, such as Taipei 101 in Taiwan Province of China and the Venetian Hotel in Macao, China.

The Complainant has registered trademarks in Viet Nam, including those listed in Section 4 above.

The Complainant’s trademark VĨNH TUỜNG is incorporated into the disputed domain name. The disputed domain name also includes a descriptive term which means “gypsum” in English.

The Complainant relies upon a prior case in which the Complainant was a successful party and that has similar facts: *Công ty Cổ phần Công nghiệp Vĩnh Tường (Vinh Tuong Industrial Corporation) v. Công ty TNHH Vietnamarch (Vietnamarch Co., Ltd)*, WIPO Case No. [D2020-2743](#).

Thus, the disputed domain name is confusingly similar to the Complainant’s trademark VĨNH TUỜNG.

The Complainant has a website located at <vinhtuong.com>.

The disputed domain name was registered without consent of the Complainant. The disputed domain name resolves to a website offering building and decorative products for sale, including the Complainant's products and the products of the Complainant's competitors. This website also includes a link to the Complainant's holding company's website at <gyproc.vn>. This redirection may mislead Internet users as to the business relationship between the Respondent and the Complainant's holding company.

The Respondent is not a licensee or authorized agent of the Complainant and has not been authorized by the Complainant to register the disputed domain name or use the Complainant's VĨNH TU'ỜNG trademark. The Respondent has no registered trademarks corresponding to the disputed domain name.

The *Ok! Data* test does not apply here.

Thus, the Respondent has no rights or legitimate interests in the disputed domain name.

The Respondent is acting in bad faith, and paragraph 4(b)(iv) of the Policy applies. The Respondent's purpose in registering the disputed domain name was to deceive Internet users into believing that the website at the disputed domain name was devoted to the Complainant's product.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

- (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.

The *onus* of proving these elements is on the Complainant.

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 it deems applicable.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy provides that the Complainant must establish that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant owns a trademark registration for VĨNH TU'ỜNG.

The disputed domain name includes the VĨNH TU'ỜNG trademark in its entirety. The disputed domain name also includes "thachcao" at the beginning of the disputed domain name.

The phrase "thach cao" means "gypsum" in English, which is a product sold by the Complainant.

Where the relevant trademark is recognizable within the disputed domain name, the addition of other words or terms does not prevent a finding of confusing similarity under the first element.

Hostelworld.com Limited v. Contact Privacy Inc. / Shamlee Pingle, WIPO Case No. [D2021-1849](#).

The Complainant succeeds on the first element of the Policy in relation to the disputed domain name.

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 can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

(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.

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 UDRP 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 sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden of production will shift to the respondent to rebut that *prima facie* case.

The Complainant asserts that the Respondent is not a licensee or authorized agent of the Complainant and has not been authorized by the Complainant to register the disputed domain name or use the Complainant's VĨNH TU'ÔNG trademark. Contrary to this, the incorporation of the Complainant's trademark, along with a term descriptive of a product sold by the Complainant, carries a risk of implied affiliation to the Complainant that cannot constitute fair use. The Complainant also asserts that the Respondent has no registered trademarks corresponding to the disputed domain name.

The Respondent appears to be selling the Complainant's products. In relation to this, the Complainant asserts that the use of the disputed domain name by the Respondent is not in connection with a *bona fide* offering of goods or services. This is because the Respondent is also offering products for sale that compete with the Complainant. Further, the Respondent's website does not include any statement clearly setting out the relationship between the Complainant and the Respondent. The Complainant thus asserts that the *Oki Data* test does not apply. See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). The Complainant also relies on the prior case of *Pfizer Inc v. The Magic Islands*, WIPO Case No. [D2003-0870](#).

The Panel considers that, based upon the above, the Complainant has established a *prima facie* case that the Respondent does not have any rights or legitimate interests in the disputed domain name and thereby the burden shifts to the Respondent to produce evidence demonstrating rights or legitimate interests in respect of the disputed domain name.

The Respondent has chosen not to file any Response. The Panel finds that the Respondent has failed to produce any evidence to establish its rights or legitimate interests in the disputed domain name.

Based on the evidence before the Panel, none of the circumstances listed in paragraph 4(c) apply in the present circumstances. Accordingly, the Panel finds that the Respondent has no rights or any legitimate interests in the disputed domain name.

The Complainant succeeds on the second element of the Policy in relation to the disputed domain name.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that the Complainant must establish that the Respondent registered and subsequently used the disputed domain name in bad faith.

In the present circumstances, the fact that the disputed domain name is similar to the Complainant's VĨNH TUỜNG trademark (with only a product name added) and resolves to a website which promotes products which are in competition to the products of the Complainant, leads the Panel to conclude the registration and use of the disputed domain name is in bad faith.

The Complainant had registered trademark rights prior to the Respondent registering the disputed domain name. The Complainant provided evidence that it is well known in Viet Nam.

The Respondent's conduct demonstrates the Respondent's knowledge of the Complainant and the Complainant's trademark.

The disputed domain name has been registered for more than 10 years. The Complainant did not explain when the Complainant learnt of the disputed domain name. However, the mere fact that the disputed domain name has been used by the Respondent for 10 years does not, without more, prevent the Complainant from prevailing on the merits.

The Respondent has not filed a Response and hence has not availed itself of the opportunity to present any case of good faith that it might have. The Panel infers that none exists. *Regal Funds Management Pty Limited v. WhoisGuard Protected, WhoisGuard, Inc. / John Clerk*, WIPO Case No. [D2020-2773](#).

The Panel finds that the Respondent has intentionally attempted to attract for commercial gain Internet users to its website by creating likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the website under paragraph 4(b)(iv) of the Policy. This website also could disrupt the business of the Complainant.

The Panel finds that the Respondent has both registered and used the disputed domain name in bad faith.

The Complainant succeeds on the third element of the Policy in relation to the disputed domain name.

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 <thachcaovinhtuong.com> be transferred to the Complainant.

/John Swinson/

John Swinson

Sole Panelist

Date: March 1, 2022