

## **ADMINISTRATIVE PANEL DECISION**

Sullair LLC v. zhang wu wang, wangzhang wu  
Case No. D2023-0137

### **1. The Parties**

The Complainant is Sullair LLC, United States of America (“US”), represented by Fieldfisher LLP, United Kingdom.

The Respondent is zhang wu wang, wangzhang wu, Hong Kong, China.

### **2. The Domain Name and Registrar**

The disputed domain name <hnsullair.com> (the “Disputed Domain Name”) is registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on January 11, 2023. On January 12, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On January 13, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Name which differed from the named Respondent (Whois Privacy Protection Service by onamae.com) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 13, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint in English on January 18, 2023.

On January 13, 2023, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. On January 16, 2023, the Complainant submitted a request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

The Center verified that the Complaint together with the amendment to 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 in English and Japanese of the Complaint, and the proceedings commenced on January 19, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 8, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 9, 2023.

The Center appointed Haig Oghigian as the sole panelist in this matter on February 27, 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 US corporation founded in 1965 and active in the field of compressed air solutions for more than 50 years. It namely manufactures and distributes portable stationary rotary screw air compressors. It is headquartered in Chicago, US. The Complainant advertises and markets its business through its website at "www.sullair.com".

The Complainant owns numerous trademark registrations for the word mark SULLAIR in several jurisdictions. Among those registrations, the Panel notes the following trademarks registered in China:

- SULLAIR, No. 759366, registered on August 7, 1995, for goods in class 7;
- SULLAIR, No. 6588312, registered on April 28, 2010, for goods in class 9.

The Complainant also owns a trademark registration in Japan, for the SULLAIR mark, No. 1422539, registered June 27, 1980, for goods in classes 7 and 11.

According to the Whois records, the Disputed Domain Name was registered on February 9, 2022.

At the time the Panel wrote this decision, the Disputed Domain Name resolves to an inactive website. According to the records submitted by the Complainant, the Disputed Domain Name resolved to a website displaying adult content and gambling or betting advertisements.

#### **5. Parties' Contentions**

##### **A. Complainant**

Put briefly, the Complainant contends as follows:

First, the Complainant submits that the Disputed Domain Name is identical or confusingly similar to a trademark in which the Complainant has rights because the Disputed Domain Name contains the word element "sullair," preceded by the two letters "hn." The Complainant submits that these two letters lack distinctiveness and add little to the distinctive "sullair" word element. The Complainant submits that such use of the word "sullair" is confusingly similar to the Complainant's trademarks and confusingly similar to the Complainant's own domain name <sullair.com>.

Second, the Complainant submits that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name, is not related to a *bona fide* offering of goods and services, and that the Respondent is not commonly known by the Disputed Domain Name and is not making any legitimate noncommercial use of the Disputed Domain Name.

Finally, the Complainant submits that the Disputed Domain Name was registered and is being used in bad faith. The Complainant submits that the registration primarily intended to disrupt the business of the Complainant, as evidenced by the fact that the Disputed Domain Name contains the word "sullair." The

Complainant also submits that the Respondent intended to tarnish the Complainant's trademarks because the Disputed Domain Name redirects to a website presenting pornographic content and gambling advertisements (the screen captures at Annex 6 to the Complaint). The Complainant further submits that the Respondent intentionally attempts to attract Internet users for commercial gain by using a domain name which is likely to cause confusion with the Complainant's own domain name.

## **B. Respondent**

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

## **6. Discussion and Findings**

Even in the absence of a substantive response from the Respondent, and in accordance with paragraph 4(a) of the Policy, the Complainant bears the burden to prove to the Panel, each of the following elements:

- (i) The Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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 Panel will successively rule on each of these elements.

### **A. Language of the Proceeding**

Paragraph 11(a) of the Rules provides that, 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 regards to the circumstances of the administrative proceeding. The Registrar has confirmed that the language of the Registration Agreement of the Disputed Domain Name is Japanese. The Complainant sets forth a number of arguments as to why the proceeding should be held in English, including that the Disputed Domain Name is not in Japanese script, and in order to proceed with the Complaint in Japanese, the Complainant would have to arrange for translations which would put the Complainant to great and disproportionate disadvantage due to the time and expense involved and would delay the proceeding. The Respondent did not comment on the language of the proceeding or object to the Complainant's request.

Considering the above, in accordance with paragraph 11(a) of the Rules, the Panel determines that the language of the proceeding should be English.

### **B. Identical or Confusingly Similar**

The Complainant satisfactorily established its rights in the SULLAIR trademark and that the Disputed Domain Name is confusingly similar to the SULLAIR trademark.

The Complainant has shown its rights in the SULLAIR trademark through the above-cited valid Chinese registrations as well as through the list of other trademark registrations included at Annex 3 to the Complaint. Evidence of such registrations is sufficient to *prima facie* satisfy the threshold requirement of having trademark rights in the SULLAIR trademark, according to section 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

As stated in section 1.7 of the [WIPO Overview 3.0](#), a domain name which incorporates the entirety of a trademark, or where at least a dominant feature of the relevant trademark is recognizable in the domain name will normally be considered confusingly similar to that trademark. The test for identity or confusing

similarity typically involves a side-by-side comparison of the domain name, to assess whether the trademark is recognizable within the domain name.

In this case, the Disputed Domain Name is composed of two elements: (1) the word “sullair” preceded by (2) the two letters “hn.” The first element is identical to the SULLAIR trademark of the Complainant and the second element is two letters of unknown meaning. The SULLAIR trademark of the Complainant remains clearly recognizable within the Disputed Domain Name, despite the presence of the “hn” letters, which is consistent with section 1.8 of the [WIPO Overview 3.0](#). In fact, the Panel agrees that the letters “hn” do not prevent a finding of confusing similarity. Further, the Panel is permitted to ignore the generic Top-Level Domain “.com”, in accordance with section 1.11 of the [WIPO Overview 3.0](#).

Therefore, the Panel finds that the Disputed Domain Name is confusingly similar to the SULLAIR trademark and thus the Complainant has discharged its burden under paragraph 4(a)(i) of the Policy.

### **C. Rights or Legitimate Interests**

The Complainant satisfactorily established that the Respondent has no rights or legitimate interests in the Disputed Domain Name.

Following section 2.1 of the [WIPO Overview 3.0](#), the Complainant must demonstrate, *prima facie*, that the Respondent has no rights to or legitimate interests in the Disputed Domain Name. If the Complainant succeeds, the burden of production of this second element under paragraph 4(a)(ii) of the Policy shifts to the Respondent. Here, the Respondent must now produce relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name. Such a right or legitimate interest is defined, non-exhaustively at paragraph 4(c) of the Policy, as use of the Disputed Domain Name in connection with a *bona fide* offering of goods or services, the Respondent being commonly known by the Disputed Domain Name, or a legitimate noncommercial fair use of the Disputed Domain Name, without misleading the consumers or tarnishing the trademark at issue.

In the present case, the Respondent did not file a response and thus provided no evidence that he holds any such rights or legitimate interests in the Disputed Domain Name, namely that he has used or made preparation to use the Disputed Domain Name in connection with a *bona fide* offering of goods and services.

The SULLAIR trademark is clearly present in the Disputed Domain Name, and in the absence of evidence from the Respondent to the contrary, this is sufficient for the Panel to find that there is no conceivable basis upon which the Respondent could possibly claim to have any rights or legitimate interests to use the SULLAIR trademark in the Disputed Domain Name to redirect users to a website displaying pornographic content and gambling or betting advertisements.

The Panel agrees with the disposition of the case *ABB Asea Brown Boveri Ltd. v. Quicknet*, WIPO Case No. [D2003-0215](#) (thereafter, “ABB Case”), which held that the use of a disputed domain name in connection with pornographic images and links tarnished and diluted the Complainant’s trademarks. Such is the case as well for the Disputed Domain Name which the Panel does not consider to be used in connection with a *bona fide* offering of goods and services or for legitimate noncommercial fair use.

Therefore, the Panel finds that the Respondent does not hold any rights or legitimate interests in the Disputed Domain Name and that the Complainant has discharged its burden under paragraph 4(a)(ii) of the Policy.

### **D. Registered and Used in Bad Faith**

The Complainant satisfactorily established that the Respondent is using and registered the Disputed Domain Name in bad faith.

Paragraph 4(a)(iii) of the Policy states this double requirement. According to section 3.1 of the [WIPO Overview 3.0](#), bad faith occurs if the Respondent takes unfair advantage of or otherwise abuses the Complainant's trademark. Paragraph 4(b) of the Policy lists non-exhaustive scenarios which could constitute evidence of bad faith.

The Panel notes that the trademark registrations for the SULLAIR trademark in China date back to the mid-1990s or the early 2010s and as far back as the 1980s in Japan. The Panel also notes that the Complainant has been active worldwide since the 1960s. Therefore, the Complainant's reputation is well established. The Complainant has thus demonstrated that the SULLAIR trademark is well known in association with its products and services. Given the extensive notoriety of the SULLAIR trademark, the Panel is of the view that the Respondent knew or should have been aware of the SULLAIR trademark and the Complainant's reputation when registering the Disputed Domain Name.

The Panel notes from Annex 6 to the Complaint, the screen captures showing that the Disputed Domain Name redirects users to a website displaying pornographic content and gambling or betting advertisements. This Panel concludes from the above that there are no conceivable grounds upon which the Respondent could claim a right or legitimate interest in the Disputed Domain Name for use in association with a website of such nature. As such, the Panel agrees with the holding of the *ABB* Case cited by the Complainant which concluded that the use of a complainant's trademark to offer pornographic material tarnished the complainant's existing trademarks, which was evidence of bad faith.

Even in the absence of contrary evidence from the Respondent, the Panel cannot conceive of any *bona fide* purpose for the incorporation of the Complainant's SULLAIR trademark in the Disputed Domain Name other than for the Respondent to use the Disputed Domain Name in a confusingly similar way so as to trade upon the goodwill of the Complainant and to tarnish its reputation for his own commercial gain.

Therefore, the Panel finds that the Respondent registered and is using the Disputed Domain Name in bad faith and that the Complainant has established the third element under paragraph 4(a)(iii) 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 Name <hnsullair.com> be transferred to the Complainant.

*/Haig Oghigian/*

**Haig Oghigian**

Sole Panelist

Date: March 14, 2023