

## WIPO Arbitration and Mediation Center

### ADMINISTRATIVE PANEL DECISION

#### SRAM, LLC v. Li Qing

#### Case No. D2016-1172

##### 1. The Parties

The Complainant is SRAM, LLC of Chicago, Illinois, United States of America, represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, United States of America.

The Respondent is Li Qing of Beijing, China.

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

The disputed domain name <sram.red> is registered with Alibaba Cloud Computing Ltd. d/b/a HiChina (www.net.cn) (the "Registrar").

##### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on June 10, 2016. On June 10, 2016, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 12, 2016, 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.

On June 14, 2016, the Center sent an email communication to the parties in both Chinese and English regarding the language of the proceeding. On June 16, 2016, the Complainant submitted a request that English be the language of the proceeding. On June 18, 2016, the Respondent submitted a request that Chinese be the language of the proceeding.

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 in both Chinese and English of the Complaint, and the proceedings commenced on June 21, 2016. In accordance with the Rules, paragraph 5, the due date for Response was July 11, 2016. The Respondent did not file a formal Response by the specified due date. On July 12, 2016, the Center informed the parties that it would proceed with panel appointment shortly.

The Center appointed Douglas Clark as the sole panelist in this matter on July 18, 2016. 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.

As explained below, the Panel issued Procedural Order No. 1 on July 22, 2016, ordering the Complainant to translate its substantive submissions, that is Section VI., Factual and Legal Grounds, in the Complaint into Chinese within 14 days, the Respondent was given 14 days to respond from receipt of the translation. On July 25, 2016, the Complainant inquired as to which form of Chinese the Complaint should be translated into, and the possibility of an extension to the deadline for providing the requested translation. Upon receipt of the Panel's instruction, the Center informed the Complainant on July 26, 2016 that the translation should be submitted in simplified Chinese and stated that translation should be provided within 14 days of receipt of the clarification.

The Complainant submitted the limited translation on August 1, 2016. The Respondent did not file a Response by the time provided, that is August 15, 2016.

##### 4. Factual Background

The Complainant is American maker of gear shifters for bicycles. The Complainant is the registered proprietor of the trademarks SRAM and SRAM RED in various countries, including in China.

The disputed domain name was registered on April 19, 2016. The website under the disputed domain name re-directed to "www.shimano-china.com", the Chinese language homepage of a Japanese bicycle part manufacturer, Shimano.

On May 19, 2016, the Complainant filed a Uniform Rapid Suspension ("URS") complaint against the Respondent with an ICANN-designated URS provider. The Respondent defaulted. The complaint was upheld and the disputed domain name suspended by a decision dated June 6, 2016.

##### 5. Parties' Contentions

###### A. Complainant

Identical or confusingly similar

The Complainant argues that the disputed domain name <sram.red> is made entirely up of the registered trademark SRAM to which the generic Top-Level Domain ("gTLD") ".red" has been added. Other than the dot between the words, the disputed domain name is identical to the trademark SRAM RED. It is therefore identical or confusingly similar to the Complainant's registered trademarks SRAM and SRAM RED.

No rights or legitimate interests

The Complainant submits that the Respondent has not been known by the disputed domain name and the Respondent has no connection with the Complainant or any of its affiliates and has never sought or obtained any trademark registrations for SRAM or SRAM RED. The redirection of the site under the disputed domain name to a competitor is not a legitimate use.

Registered and used in bad faith

The Complainant submits that the redirection of the disputed domain name to a competitor of the Complainant is clear evidence of registration and use in bad faith by creating a likelihood of confusion. Further, the Complainant submits there should be doubt that before registration of the disputed domain name the Respondent knew of the Complainant's rights in the SRAM and SRAM RED trademarks due to their fame.

###### B. Respondent

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

The Respondent did reply in relation to the language of the proceeding, as discussed immediately below.

##### 6. Discussion and Findings

###### 6.1. Language of the Proceeding

The language of the Registration Agreement is in Chinese. 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 administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding."

The Complainant requested the language of the proceeding to be English on grounds that included that the disputed domain name consists entirely of letters from the English alphabet, that the email address associated with the Respondent comprises entirely of Latin characters, that the disputed domain name contains the English word "red" as the gTLD, that translating the Complaint would put an undue burden on the Complainant and that some English words were used on the website to which the disputed domain name re-directed.

The Respondent filed a substantive response to the language request. This was written in Chinese with a translation into English by Google translate. The Respondent stated that it had a basic English education but otherwise was not proficient in English to deal with a serious legal matter. It also pointed out that "www.shimano-china.com" was not its website and any English used on it was not created by the Respondent.

The Center made a preliminary determination to:

- 1) accept the Complaint as filed in English;
- 2) accept a Response in either English or Chinese;
- 3) appoint a Panel familiar with both languages mentioned above, if available.

The final determination of the language of the proceeding lies with this Panel.

The Panel is well aware that translating a Complaint increases the expense of bringing domain name dispute proceedings and can cause unnecessary delay in a matter. Nevertheless, the Respondent had made a considered response to the language request that made reasonable points. Because the disputed domain name had already been suspended pursuant to the URS proceeding, delay of the proceedings is not as great a concern in the circumstances of this particular proceeding. The Respondent had shown a general understanding of the nature of UDRP proceedings and the subject of the Complaint.

The Panel therefore determined that the fairest way of dealing with the language issue was to issue a Procedural Order requiring the Complainant to translate Section VI., Factual and Legal Grounds, in the Complaint into Chinese. This Section sets out the substance of the Complaint to which the Respondent needed to respond. It did not appear necessary to translate the remainder of the Complaint which deals principally with formal matters.

The Procedural Order was issued in English and Chinese. The Complainant duly filed the Complaint with Section VI. translated. The Respondent did not respond.

As the only pleading before the Panel is in English, the Panel will render its decision in English.

###### 6.2. Effect of URS Determination

The Complainant submitted, effectively, that the URS Determination should be binding on the Panel.

The Complaint stated:

"In the URS proceeding cited above, *SRAM, LLC v. Li Qing*, NAF Claim No. 1675840 (Annex 7), an expert found that Complainant has rights in the SRAM Trademark and that the Disputed Domain Name is identical or confusingly similar to the SRAM Trademark. Accordingly, because URS proceedings have a higher burden of proof ("clear and convincing evidence," URS, para. 8.2) than UDRP proceedings ("preponderance of the evidence," *WIPO Overview 2.0*, para.4.7), the Panel here should reach the same conclusion."

The Panel simply cannot accept a statement that a UDRP panel should accept a finding that has been made in a URS proceeding. Most importantly, paragraph 13 of the URS provides specifically:

"A URS Determination for or against a party shall not prejudice the party in UDRP or any other proceedings."

There are good reasons for this. While the URS requires a finding on "clear and convincing evidence" the URS is a vastly simplified form of proceeding with a proportional and corresponding remedy that does not deprive the respondent of its domain name but merely suspends it and moreover provides several avenues for *de novo* appeals (for example paragraphs 6.4 and 12.1 of the URS Policy). Complaints are filed in English only (paragraph 9(a) of the URS Rules) meaning as far as due process is concerned a respondent who does not understand English may be at a disadvantage in URS proceedings. Full legal reasoning of the expert is also not given in a URS determination. While a UDRP panel should certainly be made aware (by the complainant) of a URS determination, there can be no question that it is bound by a URS determination or should necessarily reach the same conclusion.

###### 6.3. Substantive Issues

###### A. Identical or Confusingly Similar

The disputed domain name <sram.red> is made up of the registered trademark SRAM, and the gTLD ".red". It may also be seen as being made up of the registered trademark SRAM RED. See *project.me GmbH v. Alan Lin*, *WIPO Case No. DME2009-0008*. The disputed domain name is identical to the registered trademark SRAM. The first part of the paragraph 4(a) of the Policy is therefore satisfied.

###### B. Rights or Legitimate Interests

The Respondent has not responded to the Complaint to assert any rights or legitimate interests. Paragraph 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0") provides:

"While the overall burden of proof rests with the complainant, panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is often primarily within the knowledge of the respondent. Therefore a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP."

The Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. None of the circumstances in paragraph 4(c) of the Policy, which sets out how a respondent can prove its rights or legitimate interests, are present in this case.

The second part of the paragraph 4(a) of the Policy is therefore satisfied.

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

For the same reasons as those above, the Panel has no hesitation in finding that the disputed domain name <sram.red> was registered in bad faith and is being used in bad faith.

While the disputed domain name has only been used to re-direct to the Chinese webpage of Shimano, a competitor of the Complainant, and not used itself, the fact the page was re-directed to another bicycle parts company's website shows the Respondent was aware the Complainant was in the bicycle parts business. The Panel finds that the Respondent registered the disputed domain name in full awareness of the Complainant and its trademark rights. Further, the fact that the disputed domain name incorporates the trademark SRAM RED in its entirety strongly suggests the Respondent knew of the Complainant. The Panel finds that the use made of the disputed domain name in re-directing it to Shimano's Chinese website was intended to disrupt the business of the Complainant and is therefore in bad faith.

The Panel notes that the Complainant has not made any suggestion that Shimano had anything to do with the registration or re-direction of the disputed domain name. There is no evidence before the Panel to suggest any involvement of Shimano. The Panel has only based its decision on the acts of the Respondent re-directing the disputed domain name to Shimano's website,

The third part of the paragraph 4(a) of the Policy is therefore satisfied.

##### 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 <sram.red> be transferred to the Complainant.

Douglas Clark  
Date: August 26, 2016