



香港國際仲裁中心
Hong Kong International Arbitration Centre

ADMINISTRATIVE PANEL DECISION

行政专家组裁决

Case No. DHK-0900046

案件编号: DHK-0900046

Complainant:	Wuxi Suntech Power Co., Ltd.
Respondent:	Jiang Lei
Disputed domain name:	<suntechpower.hk>
Registrar:	Hong Kong Domain Name Registration Company Ltd.

1. Procedural History

The Complainant of this case is Wuxi Suntech Power Co., Ltd.; its address is at 17-6 Changjiang South Road, New District, Wuxi, Jiangsu Province 214028, China. The authorized representatives of the Complainant in the proceedings are Coral Toh and Joerg Sosna of Ella Cheong (HK); their address is at 3701, Central Plaza, 18 Harbour Road, Hong Kong.

The Respondent is an individual called Jiang Lei.

The disputed domain name is <suntechpower.hk>. The registrar/agency of the disputed domain name is Hong Kong Domain Name Registration Company Ltd.

A complaint made pursuant to the HKDNR Domain Name Dispute Resolution Policy, adopted by the Hong Kong Domain Name Registration Company Limited (“HKDNR”) on 30 November, 2006 (“the Policy”), the HKDNR

Domain Name Dispute Resolution Policy Rules of Procedure, approved by HKDNR on 30 November, 2004 (“the Rules of Procedure”), and the Hong Kong International Arbitration Centre (“HKIAC”) Supplemental Rules, was filed with HKIAC dated 2 April 2009 in the prescribed form, and was received by HKIAC on 8 April 2009.

The HKIAC notified the Registrar of the Disputed Domain of the proceedings by email on 8 April 2009.

The Complaint was served upon the Respondent by the HKIAC by email on 9 April 2009 to the addresses, domain@now.net.cn and ceofriend@gmail.com provided by the Respondent as his contact email, according to the Complainant’s WHOIS search on 12 January 2008. The Complaint was re-sent to the Respondent by the HKIAC by email on 17 June 2009 per request of the Three Member Arbitration Panel to the addresses that appeared on one of the annexes to the Complaint, namely: sdujl@hotmail.com, europa_II@yahoo.de and ninaliz2000@hotmail.com, and to the postmaster@suntechpower.hk email address as specified in the Policy, in order to ensure that the HKIAC took reasonable steps to try to notify the Respondent of this Complaint.

This constitutes valid service of these proceedings upon the Respondent.

No Response was filed with the HKIAC within the allotted time. The Three Member Arbitration Panel was appointed on 10 June 2009, with the papers being delivered to the Panelists on the same day. In accordance with the HKDNR, in the absence of exceptional circumstances as determined by the Panel in its sole discretion, the Arbitration Panel shall forward its decision on the Complaint to the Provider within fifteen (15) business days of its appointment.

2. Factual Background

For the Complainant

The Complainant's company name is "Suntech Power"; the further part "Wuxi" and "Co., Ltd.", indicates only the geographic and legal status of the Complainant. The Complainant is a company which belongs to Suntech Power Holdings and is active in the development and manufacturing of solar cells and solar modules. Suntech Power Holdings is a global leader in this market with revenues in 2007 totaling 1.3 billion US Dollars and a 2008 annual production output of 1 gigawatt. The Complainant and Suntech Power Holdings were featured as the cover story of the February 2009 issue of Fortune Magazine, which is a magazine widely available at bookshops and newsstands and through subscriber deliveries in Hong Kong. The relevant pages 76 to 79 were attached to the Complaint (Annex 5). Suntech Power Holdings has been continuously listed on the New York Stock Exchange since December 2005, and operates from its headquarters in China and through local subsidiaries in the United States, Australia, Germany, Japan, Korea, Spain and the United Kingdom. In Hong Kong, the Complainant has established its subsidiary Suntech Power Hong Kong Limited. A print-out obtained from the Hong Kong Companies' Registry is attached to the Complaint (Annex 6).

The Complainant is the proprietor of the trade marks SUNTECH and SUNTECH POWER and their variants throughout the world, and it owns trade mark applications and registrations for its trade marks in, inter alia, Hong Kong, Australia, China, Denmark, the European Community, Finland, Germany, Greece, Singapore, Thailand and the United States in respect of goods in Class 9, i.e. essentially solar cells and modules, solar panels, photovoltaic cells and other related goods.

The Complainant included with its Complaint a table showing the more relevant particulars of the Complainant's trade mark applications and registrations for its trade marks and a set of photocopies of the registration certificates for its trade marks (Annex 3).

In Hong Kong, the Complainant is the proprietor of the Hong Kong Trade Mark Application No. 301127925 for  **SUNTECH** designating the following goods and services:-

Class 9

Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; photovoltaic solar cells and modules, photovoltaic cells also including a solar thermal collector sold as a unit, solar batteries.

Class 11

Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes; solar collectors, solar energy based cooling apparatus, solar heat collection panels, solar thermal modules.

Class 42

Scientific and technological services and research and design relating thereto;

industrial analysis and research services; design and development of computer hardware and software; technology planning and consulting in the field of solar energy, specifically specializing in substrates primarily of ceramic, silicon and non-metals for electrical or thermal insulation of solar cells, photovoltaic cells, and solar collectors; technical planning of solar thermal installations; technical planning of photovoltaic/solar thermal hybrid installations.

A print-out obtained from the Hong Kong Trade Marks Registry's online database showing the full particulars of this trade mark application was attached to the Complaint (Annex 4).

Due to the Complainant's extensive international use of its "SUNTECH" and "SUNTECH POWER" trademarks, the Complainant's marks have become internationally "well-known", providing ample evidence of Complainant's marks' notoriety.

For the Respondent

No Responses was filed by the Respondent, even after the Panel provided Respondent with a second opportunity to file a Response.

3. Parties' Contentions

The Complainant

The Complainant asserts that the Disputed Domain <suntechpower.hk> is identical to the Complainant's registered trade mark "SUNTECH POWER".

The Complainant is the main operating company of the SUNTECH corporate

group and a wholly owned subsidiary of Suntech Power Holdings. It was publicly listed on the New York Stock Exchange in 2005 and currently owns and manages companies and numerous manufacturing and distribution facilities located in more than 9 countries. The Complainant is a global leader in the solar cell and solar panel market with revenues in 2007 totaling 1.3 billion US Dollars and an annual production output of 1 gigawatt in 2008.

The Complainant has traded under the name “SUNTECH” since its foundation, and “SUNTECH” has become the most relevant of its trademarks. The Complainant states that it has registered more than 100 “SUNTECH” and “SUNTECH POWER” trademarks in Europe, Asia, Africa, Australia, North and South America and Near and Middle East.

Due to the extensive international use of its “SUNTECH” and “SUNTECH POWER” trademarks, the Complainant’s marks have become internationally “well-known”, providing ample evidence of the Complainant’s marks’ notoriety.

The Complainant is also the owner of more than 100 domain names based on the “SUNTECH” designation, covering both generic (gTLDs) and country-code (ccTLDs) top level domain names.

The Complainant is the owner of the domain name “suntech-power” with the generic TLD “.com”.

The Complaint is made on the basis that:-

The Complainant enjoys trade mark rights in respect of the terms “suntech” and “suntech power”.

It is clear from the Administrative Panel's decision in *Outblaze Limited v. Wah Cheung Leatherware Company Limited* [HKIAC Case No. 0106-0001] which cited the decisions *SeekAmerica Networks Inc. v. Tariq Masood and Solo Signs* [WIPO Case No. D2000-0131], *MatchNet plc v. MAC Trading* [WIPO Case No. D2000-0205], *British Broadcasting Corp. v. Renteria* [WIPO Case No. D2000-0050], which were issued on the basis of the WIPO Uniform Domain Name Dispute Resolution Policy (UDRP) which in turn parallels the Policy, that it is not necessary for the relevant trade mark rights to be registered before the Complainant can rely on its trade marks for the purpose of challenging a domain name abusively registered by a respondent in a domain name proceeding. As the Panel explained in *Outblaze Limited v. Wah Cheung Leatherware Company Limited* [HKIAC Case No. 0106-0001], at paragraph 5.A., quoting from the cases of *Bennett Coleman & Co. Ltd. v. Steven S. Lalwani* and *Bennett Coleman & Co. Ltd. v. Long Distance Telephone Company* [WIPO Consolidated Cases Nos. D2000-0014 and D2000-0015], 'it is the reputation from actual use which is the nub of the complaint, not the fact of registration as trademarks.'"

In this case, the Complainant has continuously and extensively used its trade marks **SUNTECHPOWER** and **SUNTECH** and their variants, including  **SUNTECH**, in relation to solar cells and modules, solar panels, photovoltaic cells and other related goods in Hong Kong and worldwide for the marketing, distribution and sales of its products. The Complainant's use of its trade marks began earlier than the registration date of the domain name **suntechpower.hk**. The Complaint included a selection of invoices and advertisement material showing the Complainant's use of its trade marks (Annex 7).

The domain name **suntechpower.hk** is confusingly similar to the Complainant's trade marks **SUNTECHPOWER** and **SUNTECH** and their

variants, including .

The Respondent has no rights or legitimate interest in the captioned domain name.

There is no evidence of the Respondent's 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. The Respondent has no connection or affiliation with the Complainant, the Respondent is not a licensee of any of the Complainant's trade marks SUNTECHPOWER and SUNTECH and their variants, including .

In the past, and at least in June 2008, the Respondent operated a website linked to the domain name to advertise and sell solar panels using the Complainant's trade marks SUNTECHPOWER and SUNTECH and their variants, including  and/or confusingly similar trade marks without authorization from the Complainant. The Complainant attached a copy comprising the notarized document of print-outs of the website at <http://www.suntechpower.hk> on 11 June 2008 (Annex 8).

The Respondent's activities in respect of the unauthorized use of the trade marks SUNTECHPOWER and SUNTECH and their variants, including  and/or confusingly similar trade marks have extended to at least China, Hong Kong, Germany and Spain.

By way of example of the Respondent's infringing activities, the Complainant submitted a copy of a preliminary injunction (Annex 9) obtained against the Respondent's company in which the Respondent's company was prohibited

from using the trade mark SUNTECH in relation to solar modules. The value of that dispute was in the region of Euro 200,000 (approximately HK\$2,000,000) which shows that the Respondent's trade mark infringement had reached a substantial volume. Further, by way of example to show actual confusion on the part of the Complainant's customers caused by the Respondent's activities including Respondent's operating a website at <http://www.suntechpower.hk>, the Complainant submitted a copy of its US counsel's Cease-and-Desist letter directed to Euroenergia Group, a distributor of solar modules in Spain. Complainant also submitted Euroenergia Group's reply confirming its actual confusion between the Complainant's products and the Respondent's products, which were misleadingly labeled and passed off as originating from the Complainant (Annex 10).

As a further example of the Respondent's infringing activities, Complainant enclosed a copy of a letter referencing a website at <http://www.suntechpower.hk> in which the Respondent untruthfully claimed to be authorized by the Complainant (Annex 11). This letter was received by staff (Ms Anja Kleye and Mr Thomas Steinke) of the Complainant's German customer, Landmark Alternative Energien & Consulting of Matzwinkel 9, 06118 Halle/ Saale, Germany, on 4 March 2009. The Complainant also attached an e-mail it has received from the said German customer (Annex 12).

The Respondent has registered and used the captioned domain name in bad faith.

The Respondent registered the domain name with the primary purpose of diverting potential customers of Complainant to the Respondent's website, and thus disrupting the business of a competitor, the Complainant. The Respondent first registered the domain name in January 2008, long after the Complainant

established rights and web publicity in its trade marks SUNTECHPOWER and SUNTECH and their variants, including , for solar panels and related products. The Respondent knew of or should have known of the Complainant's trade marks and goods at the time it registered the domain name suntechpower.hk, given that the Complainant's other domain names were registered earlier (i.e. the domain name suntech-power.com was first registered on 14 May 2001, suntech-power.cn on 23 September 2003, suntech-power.com.cn on 17 March 2005 and suntech-power.hk on 30 October 2007), and given the widespread use of the Complainant's own website available at these domain names.

The Complainant enclosed a set of print-outs showing the WHOIS records of its domain name registrations and the start page of the website at <http://www.suntech-power.com> (Annex 14).

Further, in registering the domain name suntechpower.hk and creating its website at that domain name, the Respondent's aim was to divert those computer users who were familiar with the Complainant and its trade marks, and who were looking for the official SUNTECH website. The Complainant included notarized print-outs of the Respondent's earlier website, the aforesaid instances of trade mark infringement and instances of actual confusion created among the Complainant's costumers.

As for the fact that the Respondent may not always have used the domain name, the principles laid out in *Telstra Corporation Limited v. Nuclear Marshmallows* (WIPO Case No. 2000-0003) should be applied. The Policy essentially parallels the WIPO Uniform Domain Name Resolution Policy, which was the basis for Case No. 2000-0003. Accordingly, the Complainant argued that in Case No. 2000-0003, the Panel established that the passive

holding of the disputed domain name amounted to acting in bad faith.

The Complainant also argued that the contact details provided by the Respondent are incomplete as a proper postal address has been omitted and no sufficient information was provided to truly identify the Respondent.

The Respondent

No Response was filed.

4. Findings

Pursuant to paragraph 4(a) of the Hong Kong Domain Name Registration Company Limited Domain Name Dispute Resolution Policy (“the Policy”), in order to prevail the Complainant must prove that:

i. the domain name is identical or confusingly similar to a trademark or service mark in Hong Kong in which the Complainant has rights; and

ii. Respondent has no rights or legitimate interests in respect of the domain name; and

iii. the domain name has been registered and is being used in bad faith.

i) The domain name is identical or confusingly similar to a trademark or service mark in Hong Kong in which the Complainant has rights.

The Panel finds that the disputed domain name is identical to the “SUNTECH POWER” trademarks as the only difference between the trade marks and the domain name at issue is the suffix “.hk”. The difference “.hk” is not relevant since it is derived from the specific configuration of the Domain Name System. The relevant part of a domain name for purposes of the similarity analysis is the second-level-domain (see OSRAM GmbH, v. web4COMM SRL Romania (WIPO Case No. DRO2005-0004)).

The Complainant has applied for or registered SUNTECHPOWER and SUNTECH trademarks throughout the world and has specifically registered SUNTECH with the Intellectual Property Department of the Government of the Hong Kong Special Administrative Region.

ii) Respondent has no rights or legitimate interest in respect of the domain name.

The Panel accepts that the Complainant has amply demonstrated that Respondent lacks any rights or legitimate interests, and by virtue of its default, the Respondent has failed to come forward with any evidence to rebut that finding (including the examples listed in paragraph 4(c) of the Policy).

The Respondent has not used or made preparations to use the domain name in connection with a bona fide offering of goods and services in Hong Kong. The domain name currently serves as a landing page. Prior to its current state, the domain name went through a period of inactivity and, prior to that, a period when Jiang Lei held out himself and his company, Suntech Power Holdings (Hongkong) Co., Ltd. (“SPH”), as a seller of Suntech brand solar modules (Annex 8). Although the website at one point purported to sell solar modules, this bait-and-switch cannot be considered a bona fide offering of goods and services. In fact, SPH, with Jiang Lei as its representative, was enjoined from using the SUNTECH trademark by a German court (Annex 9). The injunction

makes clear that Respondent has no current rights or legitimate interests in the <suntechpower.hk> domain name. See *Ameripay, LLC v. Paylocity Corp.* (WIPO Case No. D2007-0452).

The Respondent was never commonly known as “suntechpower.” A Google search turns up no results relating to SPH except in reference to the lawsuit resulting in the injunction. On the other hand, Google results turn up many hits related to the Complainant, who owns the trademark in SUNTECH and trades on the New York Stock Exchange under STH, standing for “Suntech Holdings.”

There is similarly no evidence that the Respondent is making a legitimate non-commercial or fair use of the domain name without intent for commercial gain.

Accordingly, the Panel finds that the Complainant has satisfied the second condition under paragraph 4(a)(ii) of the Policy.

iii) The domain name has been registered and is being used in bad faith.

The Respondent’s conduct falls under paragraph 4(b)(iv) of the Policy, which states that “by using the Domain Name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site, or other on-line location, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.” In fact, Suntech Power has submitted evidence of actual consumer confusion between Suntech Power and Respondent’s use of the Suntech name (Annex 12).

The purported use of <suntechpower.hk> to sell knock-off Suntech solar panels is

obvious bad faith. The Panel also believe that the site's current use as a landing site with pay-per-click advertising provides an independent basis for finding bad faith use. See *Asian World of Martial Arts Inc. v. Texas Int'l Property Assocs.*(WIPO Case No. D2007-1415) (describing the phenomena of landing pages and finding that the use of "landing pages at which competitive services are offered" establishes bad faith). The purpose of both uses of the domain name are to attract Suntech Power's customers by causing confusion with Suntech Power's trademarks in order to either sell confused customers fake Suntech products or to generate revenue through traffic to the landing site.

5. Decision

Based on the above analysis, the Panel decides that:

- (1) the domain name is identical or confusingly similar to a trademark or service mark in Hong Kong in which the Complainant has rights; and
- (2) the 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.

Accordingly, pursuant to paragraph 4(a) of the Policy, and at the Complainant's request, the Panel decides that the Disputed Domain <suntechpower.hk> should be transferred to the Complainant.

Presiding Panelist: Dr. Timothy Sze
Co-Panelist: Mr. Arthur Chang
Co-Panelist: Mr. David H. Bernstein

Dated: 25 June, 2009