

.nz Dispute Resolution Service

DRS Reference: 1239

**Huawei Technologies Co.,
Ltd.**

v

Freda

Key words -

Domain name: Huawei.nz – Identical or Similar Trade Mark – registered mark – well-known mark – unfair registration – unfairly disrupting the business of the complainant – blocking registration – pattern of registration – remedies – transfer.

1. Parties

Complainant:

Huawei Technologies Co., Ltd.
B1-3A-126S,
Huawei Industrial Base Bantian
Longgang
Shenzhen 518129
P.R. China

Represented by: Zak Muscovitch, Muscovitch
Law Firm

Respondent:

Freda
16 Mallard Place
Auckland
New Zealand

2. Domain Name/s

Huawei.nz

3. Procedural history

- 3.1 The Complaint was lodged on 03 August 2017 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 07 August 2017. The domain/s were locked on 07 August 2017, preventing any changes to the record until the conclusion of these proceedings.
- 3.2 The Respondent filed a Response to the Complaint on 29 August 2017 and the DNC so informed the Complainant on 4 September 2017. The Complainant filed a Reply to the Response on 08 September 2017. The DNC informed the parties on 17 October 2017 that informal mediation had failed to achieve a resolution to the dispute.

- 3.3 The Complainant paid Domain Name Commission Limited the appropriate fee on 10 November 2017 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy (“the Policy”).
- 3.4 Andrew Brown, the undersigned, (“the Expert”) confirmed to the DNC on 22 November 2017 that he knew of no reason why he could not properly accept the invitation to act as expert in this case and that he knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality.

4. Factual background

- 4.1 The Complainant is Huawei Technologies Co., Ltd (the Complainant). The Complainant is a corporation incorporated under the laws of the People’s Republic of China, and is headquartered in Shenzhen, China with over 106 corporate offices throughout the world.
- 4.2 Founded in 1987, the Complainant claims to be the largest telecommunications equipment manufacturer in the world and to be a global provider of information and communications technology under the trade mark, HUAWEI and other related brands. The Complainant’s products are deployed in 170 countries, serving more than a third of the world’s population.
- 4.3 In addition to its substantial manufacturing of industrial and commercial telecommunications technology, the Complainant claims to be the world’s third largest mobile phone handset manufacturer.
- 4.4 The Complainant is the owner in New Zealand of trade mark registration 747727 “HUAWEI LOGO” in class 9 and trade mark registration 1010742 for the mark “HUAWEI” in class 9 (the Marks).
- 4.5 The Respondent is Freda, surname unknown (the Respondent). He or she is the registrant of the domain name Huawei.nz (the Disputed Domain Name). That domain was registered on **29 June 2016** (the Relevant Date).
- 4.6 Prior to notice of the Dispute, the Respondent had not established a website associated with the Disputed Domain Name. Following receipt of the Complaint, it appears the Respondent has established such a website. The website itself is a skeletal website entitled “Huawei Bridge Memory”. The Respondent claims server failures as the reason that he or she had no website up at the time the Complaint was lodged. No evidence in support of this server failure has been provided.
- 4.7 Prior to lodging the Complaint, the Complainant, through its counsel, wrote to the Respondent on 22 June 2017 and demanded the transfer of the Disputed Domain Name. The Respondent did not respond.

5. Parties’ contentions

a. Complainant

- 5.1 The Complainant has submitted in its Complaint that the Disputed Domain Name is identical or similar to a name or mark in which the Complainant has rights.

- 5.2 As noted above, the Complainant is the owner in New Zealand of trade mark registration 747727 "HUAWEI LOGO". "HUAWEI LOGO" has been registered since 13 September 2007. The specification for "HUAWEI LOGO" in class 9 includes: *"computer hardware, firmware, and software, namely computers, peripherals, computer networks and networking components, and components for managing and interconnecting telecommunications networks, for providing computer and computer network security, and for providing network management and enhanced services development and deployment, and for managing and interconnecting multimedia, audio and video data equipment, namely, wired and wireless network interface devices, switching devices, gateways for use in wireless communications systems' computer network bridges, hubs, routers, modems, electric cabling, integrated circuits, electrical power supplies, remote access equipment for use in the field of computer networking and telephony, telephones, and related software for all of the foregoing, namely, computer software for diagnosing, installing, supporting, managing, configuring, connecting, interoperating, upgrading and controlling computer hardware, firmware, and software; computer software for diagnosing, installing, supporting, managing, configuring, connecting, interoperating, upgrading and controlling computer hardware, firmware, and software; computer software for use in the field of education, namely, for data communications among users; telecommunication equipment, namely, wireless radio frequency switches; radio transmitters and receivers for telecommunication; wireless local loop access apparatus for radio signal transmission comprised of base station controllers, antennas, subscriber units that transmit and receive signals, and network management switches for use in managing radio signals and voice transfer between subscriber terminals and local exchanges; wireless switching platforms for selection of optical channel connections for voice and signals, call processing and system maintenance; access network apparatus, namely base station controllers; directional and omni antennas; subscriber terminals; mobile phones, wireless telephones; wireless base stations, wireless antennas; transceivers for telecommunication purposes; and telecommunication trunk circuits and trunk line assemblies comprising trunk line cables and trunk line amplifiers; stored program controlled switching system, namely, stored program controlled switching machine for use in processing the information from incoming calls to outgoing terminals in the public service telephone network; radio apparatus, namely, data, voice, and image switching equipment for mobile communications; optical telecommunications apparatus, namely, optical line terminal for use in receiving, transmitting and analyzing the optical signal, optical network unit, also known as an optical line terminal which manages the optical network; fiber optical Cable Television (CATV) transmissions equipment, namely, electric light switches, optic fibers, fiber optic cables; Integrated Service Digital Network (ISDN) access adapter, telecommunication system, namely, intelligent high frequency network comprised of computer workstations telecommunication terminal equipment, namely, telephone isdn phones, visual phones, digital enhanced cordless telecommunications (DECT) phones, mobile phones and digital phones; wireless local loop equipment, namely, connections for mobile subscribers to access switching systems"*.
- 5.3 The Complainant is also the owner in New Zealand of trade mark registration 1010742 "HUAWEI" in class 9. The word mark "HUAWEI" has been registered since 1 May 2015. The specification for "HUAWEI" in class 9 includes: *"Smart mobile phones; tablet computers; batteries for mobile phones; batteries for wireless routers; batteries for modems; batteries for tablet computers; solar*

batteries; batteries for communication equipment; cameras; headphones; portable power sources for mobile phones or tablet computers; apparatus for remote video conference; protective cases for mobile phones; protective cases for tablet computers; digital photo frames; set-top boxes; inverters (electricity); monitoring apparatus; chips (integrated circuits); low voltage power source; audio and video receivers; electric cables; submarine electrical cables; photoelectric switches (batteries); automatic teller machines (ATM); data processing apparatus used for managing the queue of customers in the field of window service industries; computer software for updating and saving information, photographs and video of mobile phone contacts; computer software for the protection of the privacy of mobile phone owners; screens for mobile phones; protective films for mobile phones; shell for mobile phones; protective films for tablet computers; uninterrupted power supply for machine room; regulated voltage supply; smart bracelets for use with mobile phones; smart watches for use with mobile phones; data lines for mobile phones, tablet computers and communication apparatus; operating system software for mobile phones; chargers for mobile phones or tablet computers; servers for computer room (computer hardware); software for servers for computer room; monitors (computer hardware); monitors (computer programs); instant messaging software; adapters”.

5.4 The Complainant claims to have acquired substantial goodwill in its HUAWEI brand, such that it also enjoys common law trade mark rights in addition to its registered trade mark rights.

5.5 The Complainant has also submitted that the Disputed Domain Name is an unfair registration. In support, the Complainant submits that:

- a. There is no logical nor conceivable explanation for the Respondent to have registered the Domain Name, other than for the purposes of selling it to the Complainant for a profit. The Complainant notes that the Respondent is the registrant of a number of domain names corresponding to famous brands. These include Fiat.nz, Gopro.nz, Mtv.nz, Pepsi.nz, Reebok.nz, Skype.nz, Volvo.nz, and Coca-cola.nz;
- b. The Respondent registered the Disputed Domain Name primarily to block the Complainant from reflecting its Marks in a corresponding .nz domain name;
- c. The Respondent has unfairly disrupted the Complainant’s ability to have an effective and suitable online presence in association with the most apt and appropriate domain name for its business;
- d. The Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names which correspond to well-known names or trade marks in which the Respondent has no apparent rights, and the Disputed Domain Name is a part of that pattern; and
- e. The Respondent provided only a first name and no surname, thereby providing incomplete, and possibly false contact details to the DNC.

b. Respondent

5.6. The Respondent denied that the Disputed Domain Name is an unfair registration. The Respondent claims that “Huawei” is a generic or descriptive

term and that he or she is making fair use of it in a way which is consistent with its generic or descriptive character.

- 5.7 The Respondent also responded that he or she has been known by the name Huawei for 'many years', that Huawei is the name of a famous bridge in Beijing city and that he or she worked at Beijing Hongjia Certified Public Accountants, a company which is located near the Huawei Bridge.
- 5.8 The Respondent claims that he or she has made legitimate non-commercial or fair use of the Disputed Domain Name, and that this use has been in the form of a blog. The Respondent claims that due to DNS or a server failure the blog cannot be accessed occasionally.
- 5.9 The Respondent acknowledged that he or she is also the registrant of other domain names but claims that the Disputed Domain Name is a significantly different type of character to those other domain names.
- 5.10 The Respondent provided a number of website addresses for the Expert to view in support of his or her response. No other evidence in support was provided.

c. Complainant's Reply

- 5.11 The Complainant filed a Reply to the Respondent's Response on 08 September 2017 noting that:
 - a. The Respondent does not provide a real name which is conduct that is inconsistent with an innocent person;
 - b. The Respondent claims to have been known by the name 'Huawei' for many years but provides no evidence in support or why a person known as Freda would also be known as "Huawei";
 - c. The Respondent provides no evidence to support the assertion that 'Huawei' is the name of a famous bridge in Beijing;
 - d. The Respondent does not provide any indication as to why he or she wished to register a domain name corresponding to a bridge in Beijing;
 - e. The Respondent does not explain why he or she is also the registrant of eight other .nz domain names incorporating other famous brands;
 - f. The Respondent does not deny awareness of the Complainant's Marks suggesting it is likely he or she is aware of the Complainant's brand;
 - g. The Respondent therefore registered the Disputed Domain Name to unfairly interfere with or extort the Complainant; and
 - h. The Respondent provides no evidence to show that prior to notice of the dispute, he or she ever had an active website associated with the Disputed Domain Name and also provides no evidence to support the claim that server failures were the reason he or she failed to establish a website. The Complainant states that the Respondent "appears to have erected this website after receipt of the Complaint."

6. Discussion and findings

6.1 The Complainant is required to satisfy the Expert on the balance of probabilities that it has met the requirements of paragraph 4 of the Policy, namely that:

“4.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

4.1.2 The Domain Name, in the hands of the Respondent, is an Unfair Registration.”

a. Rights

6.2 The term “Rights” is defined in paragraph 3 of the Policy as follows:

“**Rights** includes, but is not limited to, rights enforceable under New Zealand law. However, a Complainant will be unable to rely on rights in a name or term which is wholly descriptive of the Complainant’s business.”

6.3 In the present case, the Expert is satisfied that the Complainant has Rights enforceable under New Zealand law, being the Marks registered in class 9 described above. The mark “HUAWEI LOGO” was registered with effect from 10 May 2006, 10 years before the Disputed Domain Name was registered. The word mark “HUAWEI” was registered with effect from 19 March 2014, two years before the Disputed Domain Name was registered. The word mark “HUAWEI” is encompassed entirely within the Disputed Domain Name so the Complainant has Rights in a mark which is identical to the Disputed Domain Name.

6.4 Accordingly, the Expert finds that paragraph 4.1.1 of the Policy is satisfied in favour of the Complainant.

b. Unfair Registration

6.5 Unfair Registration is defined in paragraph 3 of the Policy as follows:

“**Unfair Registration** means a Domain Name which either:

(i) was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant’s Rights; or

(ii) has been, or is likely to be, used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights.”

6.6 Paragraph 5.1 of the Policy provides a non-exhaustive list of factors which may be evidence that the Domain Name is an Unfair Registration. Relevantly, paragraphs 5.1.1, 5.1.3 and 5.1.4 provide as circumstances indicating Unfair Registration as follows:

“5.1.1. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

(a) for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the

Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

- (b) as a blocking registration against a name or mark in which the Complainant has Rights; or
- (c) for the purpose of unfairly disrupting the business of the Complainant; or

...

5.1.3. The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .nz or otherwise) which correspond to well-known names or trademarks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern.

5.1.4 The Complainant can demonstrate that the Respondent has knowingly given false contact details to a Registrar and/or to the DNC.”

- 6.7 The issue for consideration is whether under paragraph 3(i) of the Policy, the Complainant has shown Unfair Registration at the time registration took place.
- 6.8 The use of the suffix “.nz” in the Disputed Domain Name indicates that the Respondent intended the website to be directed to a New Zealand audience.
- 6.9 The Complainant is well known in New Zealand as a leading global information and communications technology (ICT) solutions provider. The Complainant has provided evidence of sales volume, advertising, media reports, marketing and revenue all of which support a finding that the Complainant is well known in New Zealand.
- 6.10 As noted above, the Respondent did not deny any knowledge of the Complainant in his or her Response to the Complaint on 29 August 2017. Further (as noted in para 6.14 below) the Respondent has not provided any evidence to justify the claim that he or she has been known by the name ‘Huawei’ “for many years”.
- 6.11 The Expert finds that the Disputed Domain Name was an Unfair Registration because it took advantage of **and** was unfairly detrimental to the Complainant’s rights in its “HUAWEI” and “HUAWEI LOGO” trade marks. By registering the Disputed Domain Name, the Respondent effectively prevented the Complainant from registering the most apt and corresponding domain name in the .nz registry. Therefore, the Respondent disrupted the Complainant’s ability to have an effective and suitable online presence in association with Huawei.nz. Even the most cursory internet and trade mark search by the Respondent before registration would have revealed the Complainant’s Marks.
- 6.12 Accordingly, the Expert finds that paragraph 4.1.1 is satisfied in favour of the Complainant on the ground of both unfair advantage and unfair detriment to the Complainant’s Rights (namely its HUAWEI and HUAWEI LOGO Marks) at the time of registration.
- 6.13 The Expert also finds that the Complainant has demonstrated that the disputed domain name is an Unfair Registration under 5.1.3 of the Policy in that the Respondent has engaged in a pattern of registrations under .nz which correspond to well known names or trade marks in which the Respondent has no apparent rights and the Disputed Domain Name is part of that pattern.

6.14 The Respondent has not provided any evidence:

- a. To support his or her claim to have been known by the name 'Huawei'. It would have been easy for the Respondent to have supplied as part of the Response some form of ID or documentation to confirm the claim being made. No supporting or confirmatory material has been provided.
- b. Further the Respondent also makes the claim that 'Huawei' is "generic or descriptive" and that he or she is "making fair use of it in a way which is consistent with its generic or descriptive character". Yet this claim is inconsistent with the Respondent's earlier claim that he or she is known by the name. If the Respondent is known by the name "Huawei", why also claim that the use being made of 'Huawei' in the disputed domain name is of a generic or descriptive character?

6.15 The Respondent has registered the eight other domain names noted earlier in this decision which clearly on their face correspond to the well-known brands Fiat, GoPro, MTV, Pepsi, Reebok, Skype, Volvo and Coca-Cola. Confronted with the Complaint pointing to this pattern, the Respondent's response is that "Huawei is not part of a wider pattern or series of registrations because the domain name is a significantly different type or character to the other domain names registered by me."

6.16 For the reasons already given by the Expert has found no justification to the Respondent's claim to be known as "Huawei" nor is the name or mark of a different type of character to the other domain names registered by the Respondent. Significantly the Respondent provides no explanation as to why he or she has registered the eight other domain names containing well-known names or trade marks in the .nz space.

6.17 The Expert is therefore satisfied that the Respondent is engaged in a pattern of registration of Domain Names which correspond to well-known names or trade marks and that this Disputed Domain Name is an Unfair Registration for this further reason.

7. Decision

7.1 For the foregoing reasons, the Expert orders the transfer of the Disputed Domain Name Huawei.nz to the Complainant.

Place of decision Auckland

Date 30 November 2017

Expert Name Andrew Brown QC

Signature