

**.nz Dispute Resolution Service**

**DRS Reference: 1283**

**ALSTOM**

**v**

**Zhu Xumei**

**Key Words**

*Identical or similar trade mark or name*

Registered mark - well-known mark - identical

*Unfair registration*

Offer to sell, rent or otherwise transfer – monetary demands – likely to confuse, mislead or deceive - pattern of registration

**1. Parties**

**Complainant:**

ALSTOM  
48, Rue Albert Dhalenne  
ST OUEN CEDEX  
France

**Represented by:** Lynde & Associates

**Respondent:**

Zhu Xumei  
Tiaoxi Jiayuan  
3-502 Huzhou, Zhejiang  
313000 CHINA

**2. Domain Name/s**

alstom.nz (the “Domain Name”)

**3. Procedural history**

- 3.1. The Complaint was lodged on 12 February 2018 and Domain Name Commission (DNC), notified Respondent of the validated Complaint on 22 February 2018. The domain was locked on 22 February 2018, preventing any changes to the record until the conclusion of these proceedings.
- 3.2. No Response was received from Respondent.

- 3.3. Complainant paid Domain Name Commission Limited the appropriate fee on 11 April 2018 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy (“the Policy”).
- 3.4. Clive Elliott QC, the undersigned, (“the Expert”) confirmed to the DNC on April 23, 2018 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. Complainant is a French company that was set up in 1928. It is a global leader in the world of transport infrastructures, employing 32,800 professionals in more than 60 countries, with sales of 7.3 billion euros in the 2016/17 fiscal year.
- 4.2. Complainant holds a wide range of rights worldwide which cover the word ALSTOM (“Complainant’s Mark”). These include the following trade mark registrations:
  - New Zealand Trade Mark No. 298449 ALSTOM, filed on September 18th 1998;
  - New Zealand Trade Mark No. 299258, filed on October 2nd 1998
- 4.3. Complainant is also the registrant of numerous domain names under various generic and country code TLDs that reflect Complainant’s Mark, including:
  - <alstom.com> registered January 20, 1998;
  - <alstom.co.uk> registered June 15, 1998;
  - <alstom.org> registered April 1, 2000;
  - <alstom.net> registered April 1, 2000;
  - <alstom.info> registered July 31, 2001.
- 4.4. The above domain names all redirect to the ALSTOM group website “www.alstom.com”.
- 4.5. According to WhoIs the Domain Name was registered on March 14, 2017.

#### **5. Parties’ contentions**

##### **5.1. Complainant**

- 5.2. Complainant asserts that the goods and services it produces are well-known throughout the world, including in New Zealand. It has been present in New Zealand for 100 years, providing sustainable infrastructure solutions.

- 5.3. Complainant points out that its presence in New Zealand was affirmed in 2001 when it was awarded a 7-year maintenance and overhaul contract by Tranz Rail, and consequently took over the Hutt Workshops in Wellington.
- 5.4. Complainant states that it has rights in respect of Complainant's Mark, and that it owns a number of companies and trade name rights which include the ALSTOM denomination, such as: ALSTOM Transport, ALSTOM Power, ALSTOM Hydro, ALSTOM Grid, ALSTOM Holdings, ALSTOM Power Turbomachines, ALSTOM Management, ALSTOM Wind or ALSTOM UBUNYE.
- 5.5. Complainant asserts that Complainant's Mark is identically reproduced within the Domain Name and registration of the Domain Names infringes its rights over Complainant's Mark.
- 5.6. Complainant advises that the registration of the Domain Name initially came to its attention when it was informed that the Registrar Nameshield had on May 18, 2017 received a sales proposal from Mr. Zhu, the Registrant of the Domain Name. This was a month after the registration of the Domain Name.
- 5.7. On June 20, 2017, in response to this proposal, Complainant's representative, Lynde & Associates, requested Respondent stop using the Domain Name and to agree to transfer the Domain Name to Complainant.
- 5.8. Respondent has refused to transfer the Domain Name. After being sent a reminder on June 13, 2017, Respondent stated that the transfer of the Domain Name to Complainant would only be possible for a price of \$1,000 US. On November 8<sup>th</sup>, 2017 Respondent reiterated his price of \$1,000 US.
- 5.9. Complainant argues that the registration by Respondent of the Domain Name constitutes an unfair registration as it appears that the Domain Name was registered primarily for the purpose of selling the Domain Name to Complainant for valuable consideration in excess of Respondent's documented out of pocket costs directly associated with acquiring the Domain Name.
- 5.10. The Domain Name currently refers to a generic parking page composed of a number of commercial links which are relatively misleading in that they are unrelated to Complainant. Even though some links named, for example, GE Electric and Alstom Transport, appear to be related to Complainant, these links do not actually refer to the companies' official websites, but to other unrelated commercial pages.
- 5.11. It is therefore contended that it is likely that users will become confused by this reference to Complainant's business partners and sister companies. Further, it is argued that other links, such as luggage and travelling accessories, short breaks and plumbers, may lead users to believe that particular products and services are sponsored by Complainant.
- 5.12. Complainant asserts that Respondent is using the Domain Name in a way which is likely to confuse, mislead and deceive people or businesses into believing that the Domain Name is operated by or connected to Complainant.
- 5.13. Complainant contends that Respondent has engaged in a pattern of registering domain names which correspond to well-known names or trade marks. According to the DomainBigData site, Respondent has registered 64 domain

names in the last five years, all of which correspond to well-known names and trade marks. For example, Respondent has registered the following domain names:

- <hamleys.us> - 2016;
- <deichmann.fr> - 2017;
- <wayfair.cz> - 2014;
- <cirquedusoleil.in> - 2013;
- <haribo.in> - 2013;
- <rrdonnelley.info> - 2014;
- <americaneagle.us> - 2015.

5.14. **Respondent**

5.14.1. No formal response was received from Respondent

**6. Discussion and finding**

6.1. In terms of paragraph 4.1 of the Policy, where a Complainant asserts that:

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

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

6.2. Pursuant to paragraph 4.2 of the Policy Complainant is required to prove to the Expert that, on the balance of probabilities, both elements are present.

6.3. Paragraph 3 of the Policy (Definitions) defines “Unfair Registration” as:

“... 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.

6.4. As noted above, Respondent filed no formal response. The Expert is only able to assess the information and submissions filed by Complainant. In the absence of any dispute as to the accuracy and correctness of that information, the Expert will decide this proceeding on the basis of Complainant's undisputed representations and draw appropriate inferences from them.

## **7. Rights**

- 7.1. Complainant has the necessary rights. It has operated since 1928. It is a global leader in the provision of transport infrastructures, and currently trades in more than 60 countries around the world. Relevantly, for purposes of the present complaint, it has at least one trade mark registration in New Zealand containing or comprising the word ALSTOM.
- 7.2. Respondent did not submit a response. On that basis, it is found that:
  - 7.2.1. Complainant has rights in respect of Complainant's Mark.
  - 7.2.2. The Domain Name contains as a dominant element the word ALSTOM and is at least confusingly similar to Complainant's Mark.
- 7.3. Accordingly, the Expert is satisfied that the first element of the Policy has been met.

## **8. Unfair Registration**

- 8.1. Paragraph 3 of the Policy requires Complainant to establish that at least one of the necessary requirements is established, namely that the domain names in issue were registered or otherwise acquired in a particular way or have been used in a manner which is unfair or unfairly detrimental to Complainant's Rights. These requirements are stated in the alternative, meaning that in order to succeed a complainant need establish one or the other.
- 8.2. Paragraph 5.1 of the Policy sets out a non-exhaustive list of factors which may be regarded as evidence that the domain name is an Unfair Registration. This paragraph includes the following.

### **Evidence of Unfair Registration**

Circumstances indicating the Respondent has registered or otherwise acquired the Domain Name primarily:

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;

as a blocking registration against a name or mark in which the Complainant has rights;  
or

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 trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;

### ***Selling, renting or otherwise transferring the Domain Name***

- 8.3. Complainant asserts that Respondent has agreed to transfer the Domain Name but only on the basis that he is paid \$1,000 US. While hardly an exorbitant amount, this amount does exceed the cost of registering a domain name.

8.4. Complainant argues that the registration by Respondent of the Domain Name constitutes an unfair registration, in that the Domain Name was registered primarily for the purpose of selling the Domain Name to Complainant for valuable consideration in excess of Respondent's documented out of pocket costs directly associated with acquiring the Domain Name.

8.5. While the amount sought from Complainant is relatively modest, on the face of it, it is still in excess of the out-of-pocket cost of acquiring the Domain Name.

*Blocking Registration*

8.6. Respondent has used the Domain Name to attempt to negotiate a satisfactory commercial arrangement with Complainant. To that extent, unless and until the Domain Name was handed over, in Respondent's hands the Domain Name amounted to a blocking registration. That is, insofar as it prevented in practical terms, Complainant from registering and using the Domain Name.

8.7. Under the circumstances, the Domain Name amounts to a blocking registration

*Pattern of Registrations*

8.8. Complainant further submits that the registration of 64 domain names in the past five years points to a pattern of improper registrations on Respondent's part. These domain names are said to correspond to well-known names and trade marks, examples of which are set out in paragraph 5.13 above.


8.9. There appears to be merit in this submission and in the absence of an attempt to refute the allegations the Expert infers that Respondent has a pattern of registering well-known names and trade marks for purposes of trading for commercial gain in those names/trade marks.

8.10. The Expert is therefore satisfied that Respondent has engaged in an improper pattern of registrations.

8.11. On that basis, it is found that the second element of the Policy has been met.

**9. Decision**

9.1. Complainant has thus established both parts of paragraph 4.1 of the Policy and is entitled to the relief sought. In the result, the Expert orders that the Domain Name be transferred from Respondent to Complainant.



**Signature:**

**Expert Name** Clive Elliott QC

**Place of decision** Auckland, New Zealand

**Date** May 16, 2018