



# ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

— A charitable institution limited by guarantee registered in Hong Kong

(Hong Kong Office)

## ADMINISTRATIVE PANEL DECISION

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<b>Case No.</b>	HK-1100335
<b>Complainant:</b>	Emerson Electric Co.
<b>Respondents:</b>	(a)Emersonn Network Communication Inc. (b)Amex Corporation Limited (c)Amex Digital Corporation Limited

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### 1. The Parties and Contested Domain Name

The Complainant is, Emerson Electric Co, of 8000 West Florissant Avenue, P.O.Box 4100, St. Louis MO 63136 United States (the Complainant).

The Respondents are, (a) Emersonn Network Communication Inc.; (b) Amex Corporation Limited; and (c) Amex Digital Corporation Limited all of A17, 2/F, Kin Tak Fung Bldg, 174 Wai Yip St. Kwun Tong Hong Kong (the Respondent).

The domain name in dispute is <emersonn.com>, registered by the first Respondent with Dotster Inc (the Registrar), of P.O.Box 821066 Vancouver, WA US.

### 2. Procedural History

On March03, 2011, pursuant to the Uniform Domain Name Dispute Resolution Policy (“the Policy”), the Rules of the Uniform Domain Name Dispute Resolution Policy (“the Rules”) and the Asian Domain Name Dispute Resolution Centre Supplemental Rules (the ADNDRC Supplemental Rules), the Complainant submitted a complaint to the office of the Asian Domain Name Dispute Resolution Centre and elected that this case be dealt with by a sole panelist. On March 08, 2011, the Asian Domain Name Dispute Resolution Centre sent to the Complainant by email an acknowledgement of the receipt of the complaint together with the filing fee and on the same date sent the Registrar a request for verification. On March 09 2011, the Registrar confirmed that it was the Registrar of the domain name in dispute and that the first Respondent was the registrant of the domain name in dispute.

On May 16, 2011, the ADNRC advised both the Complainant and the Respondents of the failure of the Respondents to file a response to the Domain Name Dispute concerning the Domain Name, <emersonn.com>.

On May 18, 2011 the ADNRC notified the parties that the Panel in this case had been selected with Ike Ehiribe acting as sole panelist. The Panel appointment was made in accordance with Rules 6 and Articles 8 and 9 of the Supplemental Rules.

### 3. Factual Background

#### *For the Complainant*

The Complainant is the world’s largest manufacturer of industrial electrical equipment based in St. Louis, Missouri USA and is the proprietor of over 1,200 registrations for trademarks containing the term

“EMERSON” in well over 110 countries including Hong Kong. The Complainant also owns 17 trademark registrations for marks comprising of “EMERSON” in a number of classes of goods and services in Hong Kong where all the Respondents are based. The 17 trademarks registrations were all obtained from the Hong Kong Trade Marks Registry well before the Respondents decided to register the disputed domain name on February 04, 2010. The Complainant has approximately 129,000 employees and 250 manufacturing locations worldwide. The Complainant’s sales figures for the year 2009 exceeded US\$20 Billion. The Complainant has also more than 800 subsidiaries and affiliates around the world and in Hong Kong where the Respondents are based is where the Complainant’s headquarters in the Asia Pacific region is situated. The Complaint has been using the very distinctive “Emerson” name in Hong Kong to identify its group of companies for nearly 35 years.

*For the Respondents*

The Respondents have not filed any response to these proceedings.

**4. Parties’ Contentions**

A. Complainant

The Complainant’s contentions may be summarized as follows:

- i. The Disputed Domain Name “emersonn.com” is identical and or confusingly similar to the Complainant’s trademark and service mark “EMERSON” in which the Complainant has long standing registered rights. The Complainant contends further that since the principal element in the Disputed Domain Name “emersonn” is the word “emerson” and the letter “n” and given that the former word element “EMERSON” is the widely known trade name and trademark of the Complainant while the latter element a single letter “n” has no specific meaning and is identical to the last letter of the former word element “emerson”, the Disputed Domain Name is therefore confusingly similar to the Complainant’s trademark “EMERSON” and infringes upon the Complainant’s prior legal rights. The Complainant in this regard contends that a disputed domain name is undoubtedly confusingly similar to a complainant’s mark if the two only differ by one letter. In this regard, support is drawn from two UDRP decisions where similar confusing and identical domain names have been held to be confusingly similar to the complainant’s mark where the difference in spelling has been down to one letter; the decisions are: (a) *3M v. Chen RuGang*, ADNDRC Decision No. DE-0600065 and (b) *Advanced Comfort Inc. v. Frank Grillo*, WIPO Case No. D2002-0762.
- ii. The Complainant further contends that the likelihood of confusion is further heightened since the Complainant owns and does use a large number of “.com” domain names incorporating “emerson” as the principal element such as: (a) <emerson.com>, (b) <emersonnetwork.com>, (c) <emersonnetworkpower.com>, (d) <emersonprocess.com> and (e) <emerson-ap.com> all registered well before February 04, 2010 the registration date of the disputed Domain Name. As it is highly likely that the Disputed Domain Name will be perceived as one of the Complainant’s domain names. Accordingly it is argued that the Complainant satisfies the first requirement under Paragraph 4(a) of the Policy.
- iii. The Respondents have no rights or legitimate interests in respect of the Disputed Domain Name, in that the Respondents do not have any business relationship with the Complainant. Secondly, the Complainant has never authorized any of the Respondents to use “EMERSON” or “EMERSONN” as a domain name for any purpose, accordingly the Respondents do not qualify for the second circumstance provided for under Paragraph 4(a) of the Policy, i.e. they do not have rights or interest in the disputed Domain Name.
- iv. The Respondents are said not to have ever used the Disputed Domain Name in good faith or with good reasons as according to the WHOIS search records the Respondents’ name “Emersonn Network Communication Inc.” is likely to be an alias adopted by the Respondents to facilitate various wrongful activities. Therefore, the Respondents are unable to satisfy either the first or

third circumstances provided for under Paragraph 4(a) of the Policy, i.e. they do not have rights or interest in the Disputed Domain Name or any principal elements thereof. The Complainant is therefore said to have satisfied the second requirement stipulated under Paragraph 4 (a) of the Policy.

- v. The Respondents have registered the Disputed Domain Name “<emersonn.com>” and are using it in bad faith. The Respondents registered the Disputed Domain Name with full knowledge of the Complainant’s rights in the mark “EMERSON”. The Respondents’ other acts of bad faith use of the Disputed Domain Name are recounted as follows: (i) the “Contact us” section of the website associated with the Disputed Domain Name referred to the website of Amex Digital [www.amexdigital.com](http://www.amexdigital.com) , the third Respondent; (ii) the front webpage associated with the Disputed Domain Name features a Blu-ray disc recorder bearing a trademark of Amex Digital, the third Respondent; (iii) the company profile of “Emersonn” under the “About US” section of the website associated with the Disputed Domain Name is identical to that appearing in the website of the third Respondent, Amex Digital; (iv) the third Respondent without the Complainant’s consent or authorization filed an application in Hong Kong seeking to register the trademark “EMERSONN NETWORK COMMUNICATION” which bears a strong resemblance to a number of the Complainant’s trademarks; (v) the second and third Respondents manufactured, distributed, offered for sale, sold, and/or otherwise dealt in or with wireless broadband routers and computer cases bearing marks confusingly similar to one or more of the Complainant’s trademarks; (vi) the Respondents advertised caused or facilitated the publication of at least one product review article on Wireless Broadband Routers in the June 22, 2010 Issue of the PCM magazine.
- vi. It is also submitted that the Respondents registered the Disputed Domain Name primarily for the purposes of disrupting the business of the Complainant. The Complainant states that the website associated with the Disputed Domain Name and that of the third Respondent indicate that they engage in the manufacturing of computer equipments, including Wireless Broadband Routers and Computer cases. Since the Complainant also engages in the design and development of embedded computing products for the telecommunications industry including wireless service routers and computer racks and cabinets, it is contended that the Respondents’ primary reason for registering the Disputed Domain Name was to pass off and misdirect internet users to visit the website associated with the Disputed Domain Name. The Complainant therefore asserts that these activities are disruptive to the Complainant’s business and constitute acts of bad faith clearly prohibited under Paragraph 4(b) (iii) of the Policy.

B. Respondents

The Respondents did not submit a response.

**5. Findings**

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

- i. Respondents’ domain name must be identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- ii. Respondents have no rights or legitimate interests in respect of the domain name; and
- iii. Respondents’ domain name has been registered and is being used in bad faith.

**A) Identical / Confusingly Similar**

The Panel without any hesitation, finds on the facts as submitted by the Complainant and undisputed by the Respondent, that the domain name <emersonn.com> is identical or confusingly similar to the Complainant’s registered “EMERSON” trademark. By the sheer number of previously registered trademarks, the Complainant being the proprietor of 1200 trademark registrations worldwide including the 17 registration certificates obtained from the Hong Kong Trade Marks Registry as exhibited to these proceedings it is abundantly clear to the Panel that the Complainant has long enjoyed prior rights in the “Emerson” mark not just in Hong Kong where the Respondents are all based but also worldwide. The Panel is satisfied as the

Complainant contends that the Respondents' addition of another letter "n" to the Disputed Domain Name does not defeat the Complainant's first claim of confusing similarity. The Panel is satisfied that the Complainant's reliance on the two previous UDRP decisions in (a) *3M v. Chen RuGang* ADNDRC Decision No. de-060065 where the disputed domain name <3mm.net> was found to be confusingly similar to the complainant's mark "3m" and (b) *Advanced Comfort Inc. v. Frank Grillo* WIPO Case No. D2002-0762 where the disputed domain name <abeds.com> was held to be confusingly similar to the complainant's mark "abed" to be most relevant to this case. The Panel further accepts as the Complainant contends that the likelihood of confusion is further heightened by the fact that the Complainant owns and uses a number of ".com" domain names incorporating the "EMERSON" mark. The Panel observes that the Complainant's five domain names as listed in the Complaint were all registered between July 1995 and August 2002, well before the Respondents decided to register the Disputed Domain Name on February 04, 2010 and therefore the Disputed Domain Name could be perceived by the relevant consumer public and internet visitors as one of the Complainant's domain names.

## **B) Rights and Legitimate Interests**

This Panel is equally satisfied that the Respondents have failed to provide any evidence or circumstances required to establish that it has rights or legitimate interests in the disputed domain name within the ambit of Paragraph 4 (c) of the Policy. The Complainant in the Panel's view has successfully established that the Respondents who have no business relationship with the Complainant have never obtained consent or authority from the Complainant to use the Complainant's registered trade mark or service marks as a domain name for any purpose. See generally *Croatia Airlines d.d. v. Modern Empire Internet Ltd* WIPO Case No. D2003-0455.

As the Complainant asserts that the Respondents have been using the Disputed Domain Name to facilitate various wrongful activities, either by reason of infringing upon the Complainant's prior legal rights or by disrupting the Complainant's business it follows as the Complainant contends that the Respondents have never used the Disputed Domain Name in good faith or with good reasons. The Panel is therefore satisfied that the Respondents have failed to comply with the stipulated requirements necessary to establish bona fide offering of goods and services as stipulated in the decision of *Oki Data Americas Inc. v. ASD Inc.* WIPO Case No. D2001-0903.

## **C) Bad Faith**

The Panel equally finds without hesitation that the Respondents registered the Disputed Domain Name in bad faith. In arriving at this conclusion, the Panel has taken into account the fact that the Complainant to the knowledge of the Respondents is the proprietor of over 1,200 registered trademarks in over 110 countries containing the term "EMERSON". In Hong Kong where the Respondents are based the Complainant to the knowledge of the Respondents owns 17 trademark registrations also containing the term "EMERSON". In addition the Complainant does use a number of ".com" domain names registered between July 1995 and August 2002; all such registrations well before the Respondents registered the Disputed Domain Name in February 2010. Accordingly, the Panel finds that the Respondents are duty bound to ensure that, the Disputed Domain name is not used to infringe upon the Complainant's long held registered trademark rights.

More significantly, the Panel has taken into account a number of illegitimate activities which the Respondents have embarked upon which further demonstrate bad faith registration and use as listed by the Complainant with supporting exhibits (see exhibits 8- 12) attached to these proceedings as follows: (i) the Respondents have used a false name "Emersonn Network Communication Inc" to register the disputed domain name <emersonn.com>; (ii) the Respondents without consent or authority have filed an application in the Hong Kong Trade Marks Registry seeking to register the trademark "EMERSONN Network Communication" which is said to bear a strong resemblance to a number of the Complainant's trademarks; (iii) the Respondents have manufactured or distributed or caused to be offered for sale wireless broadband routers and computer cases bearing marks confusingly similar to one or more of the Complainant's trademarks particularly, the URL associated with the disputed Domain Name ([www.emersonn.com](http://www.emersonn.com)) was printed on the packaging of the wireless broadband router; (iv) the Respondents have advertised or facilitated the publication of at least one product review article on the wireless band routers in the June 22, 2010 issue of the PCM magazine; (v) the website associated with the Disputed Domain Name and that of the third Respondent indicate that they engage in the manufacture of computer equipment, including wireless broadband routers and computer cases just as the Complainant also engages in the design and development of computing products such as wireless service provider routers and cabinets for the telecommunications industry.

The Panel accepts as the Complainant contends that these acts either considered together or singularly constitute unequivocal acts of passing off as well as willful infringement of the Complainant's trade names and trademarks. Accordingly, the Panel finds undoubtedly that the Respondents deliberately registered the Disputed Domain Name in bad faith by targeting the Complainant with a view to confusing the public and taking advantage of the reputation of the Complainant to pass off and misdirect internet users to visit the website associated with the Disputed Domain Name. The Panel has drawn adverse inferences from the conduct of the Respondents insofar as the Complainant has issued cease and desist letters to several computer shops in Hong Kong demanding that they refrain from selling the objectionable wireless broadband routers and computer cases, who in turn accuse the third Respondent in particular, of supplying these objectionable products; and the Respondents' failure to file a response to these proceedings.

## 6. Decision

For all the foregoing reasons, the Panel decides that the Disputed Domain Name <emersonn.com> should be transferred to the Complainant forthwith.



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Ike Ehiribe  
Sole Panelist

Dated: May 31, 2011