



Asian Domain Name Dispute Resolution Centre

hongkong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1700944
Complainant:	NBA PROPERTIES, INC.
Respondent:	Adam Zhang
Disputed Domain Name(s):	<nbachina.com>; <nbacn.com>

1. The Parties and Contested Domain Name

The Complainant is NBA Properties, Inc., of Olympic Tower, 645 Fifth Avenue, New York, NY 10022, USA.

The Respondent is Adam Zhang, of Dobbinsstraat 123, the Hague, ZH, 2518 PR, NL.

The 1st domain name at issue is <nbachina.com>, registered by Respondent with NAME.COM, INC. of P.O. Box 6197, Denver Co 80206, United States.

The 2nd domain name at issue is <nbacn.com>, registered by Respondent with NAME.COM, INC. of P.O. Box 6197, Denver Co 80206, United States.

2. Procedural History

This Complaint has been filed with the Hong Kong Office of Asian Domain Name Dispute Resolution Centre (ADNDRC) pursuant to the Uniform Policy for Domain Name Dispute Resolution (“the Policy”), the Rules for ICANN Uniform Domain Name Dispute Resolution Policy approved by ICANN on 24 October 1999 (the “Rules”) and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy effective from 31 July 2015 (the “Supplemental Rules”).

The Complaint was filed by email on 22 January 2017 to hkiac@adndrc.org. On 24 January 2017 Written Notice of the Complaint was sent to the Respondent at three email addresses including ataholland@hotmail.com and the Respondent was directed to submit a Response on or before 13 February 2017. A Response was filed in time.

In the Complaint, the Complainant elected to the dispute decided by one panelist and so did the Respondent in the Response. I was appointed by ADNDRC as the sole panelist on 17

February 2017 and in accordance with the Rules a decision for the captioned dispute is to be rendered by 3 March 2017.

On 17 February 2017 and without being invited to do so, the Respondent filed a supplemental response and the Complainant filed a Supplemental Reply to the Response with annexes. On 22 February 2017, the Respondent by email filed additional evidence by way of a letter dated 22 February 2017 issued by China Literature and Art Foundation of Western Europe. On 24 February 2017, the Complainant also without being directed filed its further supplemental evidence.

I have considered the matter of unsolicited supplemental filings and have decided to exercise my discretion to allow the supplemental filings of both the Complainant and the Respondent.

Further, the Respondent also confirmed agreement to have the Administrative Panel Decision drafted in English. Since I am fully bi-lingual, the fact the Response was in Chinese posed no difficulty for me.

3. Factual background

The Complainant established in 1967 is the marketing and licensing agent of National Basketball Association, Inc (NBA). It is well known that NBA is the pre-eminent men's basketball league in North America and NBA basketball events are viewed by millions worldwide. The NBA trademark (classes 25 and 41) was registered in China in 1998 and the NBA service mark under various classes was registered variously in 1969, 1988, 1997 and 1999. The disputed domain names were registered on 24 February 2000 and 23 April 2006.

The Respondent is the registrant of the disputed domain names. However the Registrant Organization was Chinese Literature and Art Foundation of Western Europe. A main contention of the Respondent is that the Registrant is not the beneficial owner of the disputed domain names. As a result, the Response was filed by Chinese Literature and Art Foundation of Western Europe ("CLAFWE") and not by the Respondent. I find it does not matter in the end as both the Respondent and Chinese Literature and Art Foundation of Western Europe had notice of the Complaint and reasonable opportunity to file submissions with evidence. It is my considered decision that my conclusion applies equally even though the Registrant may not be the beneficial owner of the disputed domain names. Prior UDRP decisions, such as Six Continents Hotels, Inc. v. Seweryn Nowak, WIPO Case No. D2003-0022, indicate that a domain name registrant represents and warrants to the concerned registrar that the registration of the disputed domain name will not infringe the rights of any third party. The Respondent registered the disputed names and the Panel is convinced, given the notoriety of NBA, that the Respondent must have been aware of the registered mark <NBA>. Had the Respondent registered and held the disputed domain names for the Chinese Literature and Art Foundation of Western Europe, knowledge is imputed to CLAFWE and the conclusion would have been the same. As there is no need, I do not make any findings whether the Registrant Organization is the beneficial owner of the disputed domain names as alleged.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. The addition of "china" or "cn" to the trade name or trade mark <NBA> does not prevent it from being confusingly similar to the Complainant's mark. The Complainant cited paragraphs from ABB Asea Brown Boveri Ltd v. A.B.B. Transmission Engineering Co. Ltd., WIPO Case No. D2007-1466 and Oki Data Americas v. ASD Inc., WIPO Case No. D2001-0903 and when a domain name incorporates the entirety of a distinct mark that creates sufficient similarity to be confusingly similar.
- ii. The Respondent has never licensed or authorized the Respondent to use the NBA mark or to use it to register the disputed domain names and mere registration does not establish rights or legitimate interests in a domain name. The Complainant cited in support Potomac Mills Limited Partnership v. Gambit Capital Management, WIPO Case No. D2000-0062. The Respondent also does not hold any registration in respect of the mark "NBA". Hence, the Respondent has no rights or legitimate interests in respect of the disputed domain names.
- iii. It is inconceivable that the Respondent had not had notice of the NBA mark when it registered the disputed domain names. The Complainant suggested it was opportunistic bad faith registration, See Deutsche Bank AG v. Diego-Arturo Bruckner, WIPO Case No. D2000-0277. The Complainant submits there is no plausible explanation why the Respondent incorporated and exploited the NBA mark. The Complainant submits that the disputed domain names are devolved at the material time to a website www.fang.eu which caused de facto confusion and misdirection. The registrant of www.fang.eu is Zhang Zhigang, the same person who is associated with CLAFWE. The Claimant's position is that the disputed domain names had been registered and are being used in bad faith.

B. Respondent

The Respondent's contentions may be summarized as follows:

- i. The Respondent is not the beneficial owner of the disputed domain names and therefore should not be the party to this action. The Respondent alleges that CLAFWE, an alleged non-profit making organization, is the beneficial owner.
- ii. The Response contends that views expressed by the passages of Oki Data Americas v. ASD Inc. and other WIPO cases cited by the Complainant are not applicable as the decisions did not support the transfer of the domain names.
- iii. The Response also alleges that NBA China was incorporated later than the registration of <nbachina.com> and <nbacn.com> and there was no previous complaint as to wrongful infringement of the trademark of the Complainant.

- iv. It is also alleged that CLAFWE is in cooperation with de Stichting Nederlands Centrum voor Handelsbevordering (NCH) in preparation to set up a website for Netherlands Brands Association. The Respondent also cited other instances where the term NBA is the short form for organizations such as Nederlandse Beroepsorganisaties van Accountants.
- v. It is suggested that the disputed domain names are only targeted for Dutch businesses.

5. Findings

Having read and considered the Complaint, the Response and the further supplemental submissions and evidence produced by the parties, I shall proceed to render my decision.

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. Respondent's domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- ii. Respondent has no rights or legitimate interests in respect of the domain name; and
- iii. Respondent's domain name has been registered and is being used in bad faith.

A) Identical / Confusingly Similar

The Complainant has produced evidence probative of the fact that the trademark and trade name <NBA> had been registered in the USA and in China before the registration of the disputed domain names.

It is also obvious that shorn of the geographic description "china" or "cn", the distinguishing part of the disputed domain names comprised the entirety of the Complainant's trademark. Numerous panels have recognized that the incorporation of another's trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to a registered mark. See Microsoft Corporation v. J. Holiday Co., WIPO Case No. D2000-1493 in which it was written: "*Generally, a user of a mark may not avoid likely confusion by appropriating another's entire mark and adding descriptive or non descriptive matter to it*". This comment is echoed in the case Oki Data Americas v ASD Inc.: "*As numerous prior panels have held, the fact that a domain name wholly incorporates a complainant's registered mark is sufficient to establish identity or confusingly similar for purposes of the Policy despite the addition of other words to such marks.*" In Oki Data Americas, the complainant did not succeed not because it was not confusingly similar, but due to the complainant's failure to establish that the respondent (in that case) had no rights or legitimate interest in <okidata>, as the respondent was an authorized dealer and repair center using okidata parts.

In this case, the panel finds that the Complainant has fulfilled the first element under paragraph 4(a) of the Policy.

B) Rights and Legitimate Interests

Based on the materials and submissions, the panel finds that the Complainant has right and legitimate interest in <NBA> as it is the Complainant's registered trademark and trade name. It is the consensus view of many panels that once a complainant has made out prima facie that it has rights and legitimate interests, burden shift to the respondent to prove by evidence of the circumstances specified in paragraph 4(c) of the Policy or of other circumstances giving rise to right or legitimate interest on the part of the respondent. See paragraph 2.1 of the WIPO Overview 2.0 and *Ustream.TV, Inc. v. Vertical Axis, Inc*, WIPO Case No. D2008-0598. The Respondent in this case is neither affiliated with the Complainant nor does it have a license to use the mark <NBA>. The Respondent has also failed to show: (i) pursuant to 4(c)(i) that the disputed domain names were used in connection with the bona fide offering of goods or services; or (ii) pursuant to 4(c)(ii) that the Respondent has been commonly known by the domain name; or (iii) pursuant to 4(c)(iii) the Respondent has legitimate noncommercial or fair use of the disputed domain names.

The panel finds that the Respondent does not have right or legitimate interest in the disputed domain names and the Complainant has fulfilled the second element under paragraph 4(a) of the Policy.

C) Bad Faith

The panel agrees it is inconceivable that the Respondent did not have actual notice of the NBA mark or NBA before the registration of disputed domain names. See paragraph 3.4 of WIPO Overview 2.0 on "Knew or Should Have Known" and "Willful Blindness". The NBA trademark was registered in China in 1998 and NBA basketball competitions are and were watched worldwide including in China. In short, the mark NBA is notorious. Knowingly registered the disputed domain names may constitute bad faith registration.

Evidence has also been adduced that the Respondent made a phone call to the Complainant on 25 January 2017 to seek to trade the disputed domain names after the commencement of the Complaint (See the Supplemental Reply dated 17 February 2017). This averment was not denied. In fact, in CLAFWE's letter dated 22 February 2017, it is admitted that it had asked for gifts including ball game tickets, arguably valuable and in excess of the Respondent's out of pocket costs directly related to its registration of the disputed domain names, in return for its transfer of the disputed domain names to the Complainant. From a search, the Complainant has also shown that the disputed domain name <nbachina.com> was listed for sale in 2005.

The panel finds that there was no reason for Adam Zhang to register the disputed domain names either for himself or on behalf of CLAFWE with the Complainant's registered mark <NBA> as the distinguishing part. No active use had been made of either disputed domain names, with <nbacn.com> registered six years after the registration of <nbachina.com>. Hence, the Respondent must have had knowledge of

the mark NBA at the time of its later registration of <nbacn.com>. Further, all that the disputed domain names do in October 2016 is to redirect query to www.fang.eu and thereafter to websites with pay-per-click advertisements.

It should also be noted that the China Literature and Art Foundation of Western Europe also has website named www.claf.eu and contact email clafeu@hotmail.com. The panel finds that the disputed domain names had been registered and used in bad faith pursuant to paragraphs 4(b)(i) and (iv) of the Policy and the Complainant has fulfilled the third element under paragraph 4(a) of the Policy. As this panel has come to this conclusion, there is no need to deal with the relationship between China Literature and Art Foundation of Western Europe and www.fang.eu and the other bad faith allegations in the Supplemental Reply to the Response.

6. Decision

For the foregoing reasons, in accordance with paragraph 4(a) of the Policy and 15 of the Rules, the Panel orders that the disputed domain names <nbachina.com> and <nbacn.com> be transferred to the Complainant.



Samuel Wong
Sole Panelist

Date: 2 March 2017