

## Asian Domain Name Dispute Resolution Centre

### 行政专家组裁决

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案件编号： HK-1300475  
投诉人： 波普有限公司 ( BOP, LLC )  
投诉人代理人： 北京铸成联合知识产权代理有限公司 ( 上海办公室 )  
被投诉人： huang shifeng

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#### 1. 当事人及争议域名

本案投诉人为波普有限公司 ( BOP, LLC ) ( 「投诉人」 ) ，其通讯地址为美国威斯康星州麦迪逊市东贝吉尔路 101 号，邮编 53713 ( 101 East Badger Road Madison, Wisconsin 53713 U.S.A. ) 。

被投诉人为 huang shifeng ，电话号码是 +86.1012345678 ，其电邮地址是 foradulonly2000@yahoo.com 。

本案的争议域名为 < shopyop.com > 及 < shopyop.net > 。

域名 < shopyop.com > 原由被投诉人通过 Beijing Innovative Linkage Technology Ltd. DBA.DNS.COM.CN 注册，地址为北京市海淀区清华科技园科技大厦 A 座 20 层。目前依据路易·威登马利蒂公司对 < shopyop.com > 提起的诉讼，美国德克萨斯州法院颁下临时禁令，争议域名 < shopyop.com > 的注册商现已转由 Safenames Ltd. 托管，其地址为 401 East Las Olas Boulevard, Suite 130-453, Ft. Lauderdale, FL 33301, US 。

域名 < shopyop.net > 由被投诉人通过 BIZCN.COM, INC. 注册，地址为厦门软件园 ( 二期 ) 望海路 59 号 702 。

#### 2. 案件程序

2013 年 1 月 6 日，亚州域名争议解决中心香港秘书处 ( 以下简称「中心香港秘书处」 ) 收到投诉人根据互联网名称及数码分配公司 ( ICANN ) 1999 年 10 月 24 日生效实施的《统一域名争议解决政策》 ( 以下简称为 “《政策》” ) 、《统一域名争议解决

政策规则》(以下简称为“《规则》”)及亚洲域名争议解决中心(ADNDRC)《统一域名争议解决政策补充规则》(以下简称「补充规则」)提交的投诉书,并选择由独任专家组审理本案。

2013年1月7日,中心香港秘书处以电子邮件向<shopyop.com>的域名注册机构 Safenames Ltd. 及<shopyop.net>的域名注册机构 BIZCN.COM, INC. 传送内附投诉书的注册信息确认,要求其确认本案争议域名是由其提供注册服务,及提供其域名登记的数据。

2013年1月7日,中心香港秘书处收到 BIZCN.COM INC 以电子邮件发送关于域名的注册数据。确认本案争议域名是由其提供注册服务,争议域名的注册人为 huang shifeng。争议域名注册协议使用的语言为中文。

2013年1月18日,中心香港秘书处再次以电子邮件向域名注册机构 Safenames Ltd., 传送内附已更新的投诉书的注册信息确认,要求其确认本案争议域名是由其提供注册服务,及提供其域名登记的数据。

2013年1月18日,中心香港秘书处收到 Safenames Ltd. 以电子邮件发送关于域名的注册数据。确认本案争议域名是由其提供注册服务,争议域名由2012年8月22日起的注册人为 In trust for the United States District Court, D.D. Fla., Case No. 12-21778-CIV-SEITZ/SIMONTON。争议域名注册协议使用的语言为英文。

2013年1月30日,中心香港秘书处收到域名注册机构以电子邮件发送关于域名于2012年8月14日的注册数据。确认本案争议域名是由其提供注册服务,争议域名于2012年8月14日的注册人为 huang shifeng。

2013年2月6日,中心香港秘书处收到投诉人提交的更新仲裁投诉书。

2013年2月19日,中心香港秘书处以电子邮件向被投诉人传送程序开始的通知及附件材料,要求被投诉人在2013年3月11日或之前根据「政策」、「规则」及「补充规则」提交答辩。

2013年3月12日,中心香港秘书处以电子邮件向双方发出缺席审理通知,表示因被投诉人未在规定期限内提交针对本案所提交之答辩,中心香港秘书处将尽快指定专家审理本案。

2013 年 3 月 14 日，中心香港秘书处以电子邮件向双方及独任专家王则左先生发送通知，告知有关各方由王则左先生组成独任专家组审理本案，将案件移交专家组，并依据相关规定要求专家组于 2013 年 3 月 28 日或之前做出裁决。

### 3. 事实背景

#### For Complainant

投诉人：

投诉人是国际女性服装和配饰网上零售商。投诉人通过其官方网站 [www.shopbop.com](http://www.shopbop.com) 向消费者提供诸多品牌商品，尤其是著名设计师品牌的牛仔服饰系列。投诉人网站目前也设立了中文语言界面 (中文接口链接地址 <http://cn.shopbop.com>)。

自 2000 年以来，投诉人已经发展成为世界领先的时尚服饰零售商之一。在 2006 年，投诉人成为世界上最大的网上零售商亚马逊公司的子公司。

根据投诉人提交的证据显示，投诉人在广告营销上进行了大量投资，采用方式包括印刷刊物、电视、网络、户外广告和产品图册等。通过广泛使用与大量的品牌营销投资，投诉人的“SHOPBOP”商标获得了一定的知名度、市场声誉和品牌显着性，其“SHOPBOP”商标亦彰显着投诉人提供的优质零售服务。

本案投诉人委托北京铸成(上海)律师事务所代表参与本案程序。

#### For Respondent

被投诉人：huang shifeng

被投诉人未在规定期限内提交答辩书。

### 4. 当事人主张

#### For Complainant

投诉人：

(1) 投诉人为“SHOPBOP”商标和域名 < shopbop.com > 、 < shopbop.org > 及 < shopbop.net > 的持有人

- i. 投诉人在美国、中国大陆和中国香港，分别在服装商品、服装与服饰配件网上零售店服务类别上拥有“SHOPBOP”注册商标。另投诉人亦在多个国家和地区申请并成功注册了“SHOPBOP”商标，这些国家和地区包括但不限于澳大利亚、巴西、加拿大、中国、欧盟、香港、印度、日本、科威特、菲律宾、俄罗斯、新加坡、韩国、美国等。
- ii. 投诉人分别在 1999 年、2004 年及 2012 年注册了域名 < shopbop.com > 、 < shopbop.org > 及 < shopbop.net > 。
- iii. 自 2000 年投诉人一直使用 < shopbop.com > 及该域名直接指向的网站 www.shopbop.com 作为投诉人的官方网站。该官方网站为诸多品牌牛仔服饰系列提供网上零售服务。
- iv. 在 2010 年，投诉人曾被第 32 届美国服饰和鞋类协会美国形象奖评选为年度电子商务零售商 ( the E-tailer of the Year at the 32<sup>nd</sup> Annual AAFA American Image Awards ) 。投诉人曾被《Daily Candy》誉为“时尚编辑”，亦被《华尔街日报》誉为拥有“最出色的客户服务”。

(2) 争议域名与投诉人拥有的“SHOPBOP”商标构成混淆性相似

- i. 投诉人在美国、中国大陆、中国香港和其他众多国家和地区注册并拥有“SHOPBOP”商标专用权，投诉人在其官方网站 www.shopbop.com 及相关网上零售服务中有使用“SHOPBOP”商标。
- ii. 投诉人的“SHOPBOP”商标是一个创造性词语，具有高度的内在显着性。通过投诉人对该商标的广泛使用和持续的品牌保护，该商标已经在全球广泛获得了极高的知名度，具有显着指示投诉人商品和服务来源的功能。实际上，投诉人通过在全球一系列的法律行动，已经成功制止了多起“SHOPBOP”商标侵权和域名抢注行为(例如在菲律宾和澳大利亚)。

- iii. 争议域名 < shopyob.com > 和 < shopyob.net > 是对投诉人注册的域名 < shopbop.com > 、 < shopbop.net > 及 “SHOPBOP” 商标的刻意模仿。被投诉人域名主体部分 “shopyob” 仅将投诉人域名和商标 “shopbop” / “SHOPBOP” 中间的 “b/B” 取代为 “y/Y” 。

### (3) 被投诉人对争议域名缺少合法权利与法律依据

- i. 被投诉人分别在 2007 年 6 月 29 日和 2008 年 1 月 10 日注册了争议域名 <shopyob.com> 和 <shopyob.net>，争议域名注册时间明显晚于投诉人的 “SHOPBOP” 商标注册及其商誉的建立。
- ii. 中国商标局官方网站上显示，被投诉人没有申请、注册任何全部或部分 “SHOPYOP” 的商标，同时被投诉人名称也并未显示其对 “SHOPYOP” 标识或改争议域名拥有任何权利或合法利益。
- iii. 被投诉人与投诉人没有任何关联、许可或其他商业联系，被投诉人对任何与商标 “SHOPBOP” 相同或近似的标识的使用均未得到投诉人的许可，而且被投诉人与投诉人均无任何商业联系。被投诉人亦没有以任何方式向投诉人请求许可使用 “SHOPBOP” 商标或与 “SHOPBOP” 近似的商标。

### (4) 恶意注册与使用

- i. 投诉人指出，被投诉人曾将争议域名用于建立其官方网站并在官方网站上公开向消费者销售与投诉人官方网站 [www.shopbop.com](http://www.shopbop.com) 上销售的款式和类型相同的商品 (即女士服装、鞋子和配饰并提供相同网络销售服务)，被投诉人注册该争议域名的目的是掠夺投诉人的商机，令到消费者在网上搜索投诉人企业、商品或服务时产生混淆。
- ii. 被投诉人曾在其网站公开使用 “SHOPYOB” 标识，其 “SHOPYOB” 标识、网页颜色和布局均与投诉人的网站 [www.shopbop.com](http://www.shopbop.com) 十分相似，例如被投诉人网站页面上使用了与投诉人官方网站相同的一个橙色横幅广告、被投诉人在其争议网站上所使用的网站图示(favicon)也与投诉人的网站图示十分相似。

## For Respondent

被投诉人：huang shifeng

被投诉人未在规定期限内提交答辩书。

### 5. 专家组意见

根据《政策》第 4 ( a ) 条规定，符合下列案件的投诉应当得到支持：

- (i) 争议域名与投诉人享有权利的商品商标或服务商标相同或混淆性相似，且
- (ii) 被投诉人对争议域名并不享有权利或合法利益，且
- (iii) 被投诉人对争议域名的注册和使用有恶意。

投诉人在行政程序中必须举证证明以上三种情形同时具备。

#### A. 关于争议域名与投诉人享有权利的商品商标或服务商标相同或混淆性相似

投诉人提出了其拥有“SHOPBOP” 商标在中国及世界多地商标注册的文件。投诉人在全球各地注册了“SHOPBOP” 商标，自 2003 年便在美国首获注册，亦于 2011 年开始在中国在服装商品与服饰配件类别(第 25 类)上进行了注册。相反，根据中国商标局官方网站上显示，被投诉人并没有申请、注册任何包含全部或部分“SHOPYOP” 的商标，同时被投诉人名称也并未显示其对“SHOPYOP” 标识或该争议域名拥有任何权利或合法利益。

另外，投诉人自 2000 年一直使用 < shopbop.com > 及该域名直接指向的网站 www.shopbop.com 作为投诉人的官方网站。根据 *Lucasfilm Ltd. and Lucas Licensing Ltd. v. Cupcake City and John Zuccarini* ( WIPO 案号 D2001-0700 ) , 投诉人对“SHOPBOP” 这个商标享有优先使用及民事权益。

该争议域名 < shopyop.com > 和 < shopyop.net > 与投诉人的注册商标“SHOPBOP” 和注册域名 < shopbop.com > 十分相似，被投诉人对该域名的使用很可能造成消费者的混淆或误认，或导致消费者产生错误认为被投诉人的网站为投



诉人所有，或者其网站经过投诉人的授权或赞助，或者其营运与投诉人存在其他联系。被投诉人将争议域名用于营销其“SHOPYOP”商标的网上零售服务，刻意模仿投诉人官网上以“SHOPBOP”为品牌的网上零售服务模式，增加了消费者混淆的可能性。

投诉人亦从 1999 年起注册和持有顶级域名 < shopbop.com > 以及其它含有“SHOPBOP”字样的域名，包括 < shopbop.org > 及 < shopbop.net >。专家组注意到被投诉人争议域名 < shopyop.com > 及 < shopyop.net >，其主体部份“SHOPYOP”与投诉人域名和商标“SHOPBOP”只差一个字母，与投诉人的注册域名和商标混淆性近似。专家组认为争议域名主体部份“SHOPYOP”的形象及读音与“SHOPBOP”几乎一样，区别就在于以字母“Y”取代了字母“B”，并不能令争议域名与有关商标主体所给予人的整体形象区分开来，亦不足以避免引起公众的混淆。在 *Pomellato S.p.A. v. Richard Tonetti* 案中 ( WIPO 案号 D2000-0493 )，结论是添加了通用顶级域名“.com”或“.net”与认定混淆近似与否并无关系。

据此，专家组裁定争议域名的主要识别部分与投诉人的商标及商号几乎完全相同，具有足以导致混淆的近似性。投诉人已满足了「政策」第 4 ( a ) ( i ) 条规定的条件。

#### B. 关于被投诉人对争议域名并不享有权利或合法利益

如上述，被投诉人与投诉人概无关联，投诉人亦从未授权被投诉人使用“SHOPBOP”商标为域名或作其它使用。就此，专家组参考了案例 *Six Continents Hotels. Inc. v. IQ Management Corporation* ( WIPO 案号 D2004-0272 )，同意该专家组的意见，即是若被投诉人在未获权下使用投诉人的注册商标，足以证明被投诉人对争议域名及其主要识别部份不享有合法权益。

专家注意到被投诉人分别于 2007 年 6 月 29 和 2008 年 1 月 10 日注册了争议域名 < shopyop.com > 和 < shopyop.net >，时间明显晚于投诉人的“SHOPBOP”商标注册和其对 < shopbop.com > 的使用。依据先申请先注册的原则，投诉人对争议域名的主要部份有优先权。

根据 *Document Technologies, Inc. v. International Electronic Communications, Inc.* ( WIPO 案号 D2000-0270 )，*Neusiedler Aktiengesellschaft v. Kulkarni* ( WIPO 案号 D2000-1769 ) 及 *PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.) and*

EMS Computer Industry (a/k/a EMS) ( WIPO 案号 D2003-0696 ) , 当投诉人提出被投诉人对争议域名的主要识别部份不享有合法权益的表面证据, 被投诉人便有举证责任 ( Burden of Proof ) , 证明对该域名的主要识别部份享有合法权益。本案被投诉人没有提交答辩书, 因此没有对此举证。

故此, 专家组裁定被投诉人对争议域名或者其主要部分不享有合法权益, 投诉人已满足了「政策」第 4 ( a ) ( ii ) 条规定的条件。

### C. 关于被投诉人对争议域名的注册和使用有恶意

根据「政策」第 4(b) 条, 如专家组发现存在以下情况, 则可将其作为恶意注册和使用域名的证据:

- (i) 该情形表明, 被投诉方注册或获取域名的主要目的是为了向作为商品商标或服务商标所有人的投诉人或其竞争对手出售、出租或转让该域名, 以获取直接与域名注册相关费用之外的额外收益者; 或者,
- (ii) 被投诉方注册行为本身即表明, 被投诉方注册该域名的目的是为了阻止商品商标和服务商标的所有人以相应的域名反映其上述商标标者; 或者,
- (iii) 被投诉方注册域名的主要目的是为了破坏竞争对手的正常业务者; 或者,
- (iv) 以使用域名的手段, 为商业利益目的, 被投诉方通过制造被投诉方网站或网址上所出售的商品或提供的服务与投诉人商标之间在来源者、赞助者、附属者或保证者方面的混淆, 故意引诱网络用户访问你方网站或其他联机地址者。

专家组紧记, 要证明被投诉人对域名的注册或使用具有恶意, 投诉人不单需要证明被投诉人恶意注册争议域名, 亦需证明被投诉人使用争议域名时亦怀有恶意, 见 Telstra Corporation Limited v. Nuclear Marshmallows ( WIPO 案号 D200-00003 ) 。

专家组考虑了投诉人的主张以及于投诉书内“本案相关背景介绍”的资料, 包括以下各点:



- (1) 被投诉人曾将争议域名用于建立其官方网站并在官方网站上公开向消费者销售与投诉人官方网站 [www.shopbop.com](http://www.shopbop.com) 上销售的款式和类型相同的商品;
- (2) 被投诉人与投诉人没有任何关联、许可或其他商业联系, 被投诉人仅仅是为了不当利用投诉人在先取得的权利和商誉, 使用与投诉人“SHOPBOP” 商标混淆性相近似的变形体“SHOPYOP” 误导消费者访问被投诉人的网站;
- (3) 关于「政策」第 4 ( c ) ( ii ) 条, 无证据表明被投诉人因争议域名而广为人知。Whois 域名查询结果中也未能显示被投诉人可以凭借“SHOPYOP” 而广为人知。(参见 *Tercent Inc. v. Yi, FA 139720* ( Nat. Arb. Forum Feb. 10, 2003), 注: “被投诉人的 Whois 域名查询结果不含信息显示被投诉人因争议域名而广为人知” 是决定「政策」第 4 ( c ) ( ii ) 不能适用的一个因素; 并见 *Gallup Inc. V. Amish Country Store, FA 96209* ( Nat. Arb. Forum Jan. 23, 3001 ) , 如果被投诉人不能凭该标识而广为人知, 则被投诉人无权拥有该争议域名。)
- (4) 仅仅注册域名, 不足以使被投诉人获得权利或合法利益。(参见 *Educational Testing Service v. TOEFL* (WIPO 案号 D2000-0044))。
- (5) 被投诉人在同一商业领域的网站服务中使用与投诉人商标构成混淆性近似的域名, 不能合理认定为该域名是善意使用 ( 参见 *American Online, Inc. V. Xianfeng Fu* (WIPO 案号 D2000-1374) ) 。

考虑过投诉人提供的事实, 专家组认为被投诉人对争议域名的注册或者使用明显是为了破坏投诉人的正当业务, 混淆公众视听, 引诱网络用户于争议域名所连结的网上零售店购物, 即投诉人的其中一项业务。因此裁定被投诉人对争议域名的注册或者使用具有恶意。投诉人已满足了「政策」第 4 ( a ) ( iii ) 条规定的条件。

## 6. 裁决

基于以上分析, 专家组认为:

- (1) 争议域名 <shopyop.com> 及 <shopyop.net> 与投诉人享有民事权益的名称或标志混淆性地近似;
- (2) 被投诉人对争议域名或者其主要部份不享有权利或合法利益; 和

(3) 被投诉人对争议域名的注册及使用具有恶意。

据此，专家组裁定投诉人的投诉成立，争议域名裁定转移给投诉人。



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独任专家组：王则左 Samuel Wong

日期：2013 年 3 月 25 日于香港



## Asian Domain Name Dispute Resolution Centre

### ADMINISTRATIVE PANEL DECISION

Decision ID : HK-1300475  
Complainant : BOP, LLC  
Authorized Representative of Complainant : Chang Tsi & Partners  
Respondent : huang shifeng

#### 1 Introduction

The complainant in this administrative proceeding is BOP, LLC (“**the Complainant**”), having its correspondence address at 101 East Badger Road Madison, Wisconsin 53713 U.S.A.

The respondent in this administrative proceeding is huang shifeng (“**the Respondent**”), whose telephone number is +86.1012345678 and email address is foradulonly2000@yahoo.com.

The domain names in dispute are <shopyop.com> and <shopyop.net>.

The domain name <shopyop.com> was originally registered by the Respondent with Beijing Innovative Linkage Technology Ltd. DBA.DNS.COM.CN, whose address is 20/F, Block A, Tsinghua Science Park Building, Haidian, Beijing. In view of a progressing legal proceeding brought by Louis Vuitton Malletier, S.A. in connection with <shopyop.com>, the United States District Court for the Southern District of Texas handed down a preliminary injunction and the said domain name is now transferred to be registered with Safenames Ltd., whose address is 401 East Las Olas Boulevard, Suite 130-453, Ft. Lauderdale, FL 33301, U.S.

The domain name <shopyop.net> is registered by the Respondent with BIZCN.COM, INC., whose address is Room 702, No.59, Wanghai Road, Second Phase of Xiamen Software Park.

#### 2 Procedural History

On 6 January 2013, the Asian Domain Name Dispute Resolution Centre (Hong Kong Office) (“**the Centre**”) received the Complainant’s complaint (“**the Complaint**”) made in accordance with the provisions under ICANN Uniform Domain Name Dispute Resolution Policy (“**the Policy**”), ICANN Rules for Uniform Domain Name Dispute Resolution Policy (“**the Rules**”) and ADNDRC

Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (“**the Supplemental Rules**”). The Complainant elected to have the Complaint decided by one panelist.

On 7 January 2013, pursuant to the Policy, the Centre requested Safenames Ltd. and BIZCN.COM, INC, the registrars of <shopyop.com> and <shopyop.net> respectively, to confirm whether it had received a copy of the Complaint and whether the domain names in dispute were registered by the registrars, and to provide the WHOIS information regarding the disputed domain names.

On 7 January 2013, the Centre received the registration information of <shopyop.net> from BIZCN.COM INC by email. It was confirmed that BIZCN.COM INC was the registrar of the disputed domain name, and the registrant was huang shifeng. It was also confirmed that the language of the Registration Agreement of <shopyop.net> was Chinese.

On 18 January 2013, the Centre again requested Safenames Ltd., the registrar of <shopyop.com>, to confirm whether it had received a copy of the Complaint and whether the domain name in dispute was registered by it, and to provide the WHOIS information regarding the disputed domain name.

On 18 January 2013, the Centre received the registration information of <shopyop.com> from Safenames Ltd. by email. It was confirmed that Safenames Ltd. was the registrar of the disputed domain name, and the registrant was In trust for the United States District Court, D.D. Fla., Case No. 12-21778-CIV-SEITZ/SIMONTON from 22 August 2012 onwards. It was also confirmed that the language of the Registration Agreement of <shopyop.com> was English.

On 30 January 2013, the Centre was informed by Safenames Ltd. that the registrant of <shopyop.com> was huang shifeng as at 14 August 2012.

On 6 February 2013, the Complainant filed with the Centre an amended complaint.

On 19 February 2013, the Centre notified the Respondent of the proceedings by email, and requested him to reply to the Complaint in accordance with the Policy, the Rules and the Supplemental Rules on or before 11 March 2013.

On 12 March 2013, the Centre notified both parties that a panel would be elected shortly to adjudicate this matter in view of the absence of any response from the Respondent.

On 14 March 2013, the Centre notified both parties that Mr. Samuel Wong was appointed as the sole panelist (“**the Panel**”) in this matter, and a decision would be handed down on or before 28 March 2013 by the Panel.

### 3 Factual Background

## **For Complainant**

The Complainant is a leading online retailer of women's apparel and accessories. It has been selling its goods from a variety of brands, especially designer denims, on its website at [www.shopbop.com](http://www.shopbop.com). The Chinese language version of the online store is at <http://cn.shopbop.com>.

Since the year of 2000, the Complainant has grown to become one of the leading fashion retailers in the world. In 2006, the Complainant operated as a subsidiary of Amazon.com, the world's largest online retailer.

As shown by the evidence submitted by the Complainant, the Complainant has invested significantly in marketing via various channels such as press media, TV, the internet, billboards and catalogues. As a result of its promotion, the SHOPBOP mark has acquired a high degree of public recognition which embodies the Complainant's goodwill.

Chang Tsi & Partners (a law firm) is the Complainant's authorised representative in this proceeding.

## **For Respondent**

Respondent : huang shifeng

The Respondent did not to respond to the Complaint.

## **4 Parties' Contentions**

### **For Complainant**

#### **1 Ownership**

- i The Complainant is the registrant of the SHOPBOP trademark in the USA, the Mainland of China and Hong Kong in connection with clothing and online retail services featuring clothing and clothing accessories. The Complainant is also the registrant of numerous trademark registrations and applicant for its SHOPBOP trademark in other jurisdictions. These jurisdictions include, but are not limited to: Australia, Brazil, Canada, the EU, India, Japan, Kuwait, the Philippines, Russia, Singapore, Korea, etc.
- ii The Complainant registered the domain names <shopbop.com>, <shopbop.org> and <shopbop.net> in 1999, 2004 and 2012 respectively.
- iii Since 2000, the Complainant has been using the domain name <shopbop.com> which directs Internet users to its website at [www.shopbop.com](http://www.shopbop.com) which offers online retail services for a variety of brands, especially designer denims.

- iv In 2010, the Complainant was awarded the E-tailer of the Year Award at the 32<sup>nd</sup> Annual AAFA American Image Awards. The Complainant has been called “the editors of what’s cool” by Daily Candy as well as recognised by the Wall Street Journal as having “the best customer service.”

## 2 Identical or Confusingly Similar

- i The Complainant is the registrant and owner of the SHOPBOP trademark in the USA, the Mainland of China, Hong Kong and other jurisdictions. It uses its SHOPBOP trademark in its website at [www.shopbop.com](http://www.shopbop.com) and other related online retail services.
- ii The Complainant’s SHOPBOP trademark is a created term which gave it a high level of inherent distinctiveness. It has become widely recognised through extensive use and IPR protection activities. The Complainant has curbed trademark infringement and cybersquatting upon its SHOPBOP trademark in countries such as Australia and the Philippines.
- iii The domain names in dispute <shopyob.com> and <shopyob.net> are close imitation of the Complainant’s <shopbop.com>, <shopbop.net> and SHOPBOP trademark. The Respondent has merely replaced the “b/B” in “shopbop/SHOPBOP” with “y/Y”.

## 3 Rights and Legitimate Interests

- i The domain names in dispute <shopyob.com> and <shopyob.net> were registered by the Respondent on 29 June 2007 and 10 January 2008 respectively, which was later than the registration of the SHOPBOP trademark and the establishment of the Complainant’s goodwill and reputation.
- ii The official website of the China Trademark Office indicates that the Respondent has neither applied for nor registered any trademark consisting in whole or in part of the term SHOPYOP. The Respondent has no rights or legitimate interests in the SHOPYOP mark or in the domain names in dispute.
- iii The Respondent is not affiliated with, licensed by, or in privity with the Complainant. He has neither sought nor been given any permission by the Complainant to use any marks identical or similar to the SHOPBOP mark, and he is not otherwise in any way connected to the Complainant or its affiliates.

## 4 Bad Faith



- i The Respondent has used the disputed domain names to offer the same type of merchandise/service as the Complainant does (i.e. online retail sale of women's clothing, shoes and accessories). The intent of the Respondent's registration appears to be diverting business away from the Complainant and confusing consumers who are looking for the Complainant's company, goods or services on the Internet.
- ii The Respondent's SHOPYOB mark, his websites' color scheme and layout are similar to that of the Complainant's [www.shopbop.com](http://www.shopbop.com) website. For instance, the orange banner and favicon in the Respondent's web pages are very similar to that of the Complainant.

### **For Respondent**

Respondent : huang shifeng

The Respondent did not respond to the Complaint.

## **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 Respondent's domain name must be 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 or Confusingly Similar**

The trademark registration documents as submitted by the Complainant show the Complainant's ownership of the SHOPBOP trademark in the Mainland of China and other parts of the world. In 2003, the Complainant registered the SHOPBOP trademark in the USA. In 2011, the Complainant commenced an application to register its trademark in the Mainland of China in Class 25 (Clothing, Footwear, Headgear). As to the Respondent's SHOPYOP mark, the official website of the China Trademark Office indicates that the Respondent has neither applied for nor registered any trademark consisting in whole or in part of the term SHOPYOP. The Respondent has no rights or legitimate interests in the SHOPYOP mark or in the domain names in dispute.

Moreover, the Complainant has been using the domain name <shopbop.com> and the website [www.shopbop.com](http://www.shopbop.com) since 2000. The Complainant has established a prima facie case that it has rights and legitimate interests in the use of the SHOPBOP mark. See *Lucasfilm Ltd. and Lucas Licensing Ltd. v. Cupcake City and John Zuccarini* (WIPO Case No. D2001-0700).

The disputed domain names <shopyop.com> and <shopyop.net> are similar to the Complainant's SHOPBOP trademark and domain names <shopbop.com> and <shopbop.net>. The Respondent's use of the disputed domain names will likely confuse or mislead consumers, or induce consumers to form the impression that the Respondent's websites are owned, authorised or sponsored by the Complainant, or in any way affiliated with the Complainant. The Respondent's use of the SHOPYOP mark in his websites is an intentional imitation of the Complainant's online business which bears the SHOPBOP trademark.

Since 1999, the Complainant has been a registrant of <shopbop.com> as well as other domain names containing the SHOPBOP mark, e.g. <shopbop.org> and <shopbop.net>. The Panel notices that the only difference between the disputed domain names and the Complainant's SHOPBOP mark is the alphabet "y/Y" replacing "b/B". Moreover, the SHOPYOP mark and the SHOPBOP mark are highly similar in terms of pronunciation and visual impression. The difference in spelling is not sufficient to distinguish the two or eliminate the confusion that may arise. The Panel is also aware of *Pomellato S.p.A. v. Richard Tonetti* (WIPO Case No. D2000-0493) which held that the addition of ".com" or ".net" (generic top level domains, gTLD) is irrelevant when determining the similarity between domain names in dispute.

For these reasons, the Panel finds that the disputed domain names are confusingly similar to the Complainant's trademark. The Panel is satisfied that paragraph 4(a)(i) of the Policy has been established.

## B Rights and Legitimate Interests

- iv As mentioned above, the Complainant has never assigned, granted, licensed, sold, transferred or in any way authorized the Respondent to register or use the SHOPBOP trademark in any manner. The Panel agrees with the panel in *Six Continents Hotels. Inc. v. IQ Management Corporation* (WIPO Case No. D2004-0272) that this fact, on its own, can be sufficient to prove the second criterion of the Policy, i.e. the Respondent has no rights or legitimate interests in respect of the domain names.

The Panel is aware of the fact that the Respondent registered the disputed domain names <shopyop.com> and <shopyop.net> on 29 June 2007 and 10 January 2008 respectively. This is clearly later than the Complainant's registration of the SHOPBOP trademark and use of the domain name <shopbop.com>. The first-to-register principle shall apply in this case meaning

that the Complainant has priority in registering and using the disputed domain names over the Respondent.

Once a *prima facie* case is shown, the burden of proof then shifts to the Respondent who must demonstrate its rights or legitimate interests to the Panel. (See *Document Technologies, Inc. v. International Electronic Communications, Inc.* (WIPO Case No. D2000-0270), *Neusiedler Aktiengesellschaft v. Kulkarni* (WIPO Case No. D2000-1769) and *PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.) and EMS Computer Industry (a/k/a EMS)* (WIPO Case No. D2003-0696)). The Respondent in this case has failed to discharge the burden of proof as he did not respond to the Complaint at all.

For the above reasons, the Panel concludes that the Respondent does not have any rights and legitimate interests in the disputed domain names under paragraph 4(a)(ii) of the Policy.

### C Bad Faith

Under paragraph 4(b) of the Policy, the following are relevant examples a Panel may take as evidence of registration and use in bad faith:

- i Circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- ii You have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- iii You have registered the domain name primarily for the purpose disrupting the business of a competitor; or
- iv By using the domain name, you have intentionally attempted to attract, for commercial gain, internet users to your website 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 website or location or of a product or service on your website or location.

In order to establish a claim under the head of bad faith, the Complainant must prove that the domain names were registered **AND** used in bad faith. See *Telstra Corporation Limited v. Nuclear Marshmallows* (WIPO Case No. D2000-0003).

The Panel has duly considered the following points as contended by the Complainant:

- 1 The Respondent has used the disputed domain names to set up websites which offer to Internet users the same type of merchandise as the Complainant's official website (www.shopbop.com);
- 2 The Respondent is not affiliated with the Complainant in any manner. The mere motive of the Respondent in registering and using the confusingly similar SHOPYOP mark in his websites was to mislead Internet users who visit his websites and thereby abuse the goodwill established by the Complainant.
- 3 The WHOIS contact information does not indicate that Respondent is commonly known by the disputed domain names or the SHOPYOP mark. The disputed domain names are very similar to the Complainant's official website (www.shopbop.com). Thus, the Panel finds that paragraph 4(c)(ii) of the Policy does not apply to the Respondent. See *Tercent Inc. v. Lee Yi*, FA 139720 (Nat. Arb. Forum, Feb 10, 2003), which states that "nothing in Respondent's WHOIS information implies that Respondent is 'commonly known by' the disputed domain name" as one factor in determining that Policy paragraph 4(c)(ii) does not apply; see also *Gallup Inc. v. Amish Country Store*, FA 96209 (Nat. Arb. Forum Jan. 23, 2001), which finds that when a respondent was not known by a mark it did not have rights in a domain name incorporating that mark.
- 4 The Respondent can derive no rights or legitimate interests from the disputed domain names by merely registering them. See *Educational Testing Service v. TOEFL* (WIPO Case No. D2000-0044).
- 5 The Respondent registered the domain names so to create a likelihood of confusion between his domain names and the Complainant's website. This act cannot reasonably be construed as *bona fide*. See *America Online, Inc. v. Xianfeng Fu* (WIPO Case No. D2000-1374).

In light of the evidence submitted by the Complainant, the Panel opines that the Respondent's intentions in registering and using the disputed domain names are to disrupt the normal course of business of the Complainant, confuse Internet users and attract them to shop on his websites (i.e. to offer the same type of online retail service as the Complainant). Therefore, the Panel concludes that the Respondent has registered and used the disputed domain names in bad faith. Accordingly, the Panel finds that the Complaint satisfies the condition provided in paragraph 4(a)(iii) of the Policy.

## 6 Decision

For the foregoing reasons, the Panel concludes that:

- 1 The disputed domain names <shopyop.com> and <shopyop.net> are confusingly similar to the Complainant's trademark or service mark in which the Complainant has rights;
- 2 The Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- 3 The Respondent's domain names have been registered and are being used in bad faith.

Therefore, the Complaint is allowed and the disputed domain names are to be transferred to the Complainant.

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Panelist: Samuel Wong

Dated : 25 March 2013 (Hong Kong)