

**ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE**  
**(Beijing Office)**  
**ADMINISTRATIVE PANEL DECISION**  
**Case No. CN-1200595**

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**Complainant: C. & J. CLARK INTERNATIONAL LIMITED**

**Respondent: Lao She**

**Domain Name: clarks-hk.com**

**Registrar: ENOM, INC**

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### **1. Procedural History**

On 7 August 2012, the Complainant submitted its Complaint to the Beijing Office of the Asian Domain Name Dispute Resolution Centre (the "Centre"), in accordance with the Uniform Domain Name Dispute Resolution Policy (the "Policy") adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN") on August 26, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy Disputes (the "Rules"), and ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy Disputes (the "ADNDRC Supplemental Rules").

On 9 August 2012, the Centre confirmed the receipt of the Complaint and forwarded a copy of the Complaint to ICANN and the Registrar of the domain name in dispute, ENOM, INC.

On 11 August 2012, the Centre received the Registrar's confirmation of registration information of the domain name in dispute.

On 29 August 2012, The Centre notified the Complainant that the Complaint has been confirmed and transmitted to the Respondent and the case officially commenced on 29 August 2012. On the same day, the Centre transmitted the Written Notice of the Complaint to the Respondent, which informed that the Complainant had filed a Complaint against the Respondent over the disputed domain name and the Centre had sent the Complaint and its attachments to the Respondent through email according to the Rules and the Supplemental Rules. On the same day,

the Centre notified ICANN and registrar of the commencement of the proceedings.

On 15 October 2012, the Centre sent the Notification of No Response Received and Hearing by Default.

Having received a Declaration of Impartiality and Independence and a Statement of Acceptance from Ms. Xue Hong, on 26 October 2012, the Centre informed the Complainant and the Respondent of the appointment of the Panelist, and transferred the case file to the Panelist on 29 October 2012.

The Panel finds that it was properly constituted and appointed in accordance with the Rules and the ADNDRC Supplemental Rules.

The language of the proceeding is English, as being the language of the Domain Name Registration and Service Agreement, pursuant to Paragraph 11(a) of the Rules, and also in consideration of the fact that there is no express agreement to the contrary by the Parties.

## **2. Factual Background**

### **For the Complainant**

The Complainant is C. & J. Clark International Limited, The registered address is 40 HIGH STREET, STREET, SOMERSET, BA160YA ENGLAND UNITED KINGDOM. The authorized representative in this case is Wei Wenye and Ji Liyan from Haoliwen Partners.

The Complainant is primarily in the business of leather shoes and owns the trademark "CLARKS" that has been registered in more than 100 countries or regions, including China since 1983.

### **For the Respondent**

According to the record in the Whois database, the Respondent is Lao She. The registered address is no.365 erlou xiedongjie, xiamen, fujian, China. The disputed domain name "clarks-hk.com" was registered on 7 February 2012 through the registrar ENOM, INC.

### **3. Parties' Contentions**

#### **The Complainant**

[Directly quoted from the Complaint with only formality slighted edited]

(1)The disputed domain name is confusingly similar to the registered trademark "Clarks" in which the Complainant has prior rights.

The Complainant was founded by British Brother Cyrus Clark and James Clark in 1825 and the brand "Clarks" has been used ever since then. The Clarks Group is the largest leisure shoes retailer in Britain and one of the largest leather shoes manufacturers in the world. The brand "Clarks" was first registered in Britain as a trademark and has been registered in 162 countries up to date. It has become a sign of high-ranking leather shoes due to the high quality material with stylish and comfortable design. Shoes bearing the Complainant's trademark "Clarks" have been sold in more than 160 countries and the Complainant profited £130 million on sales of £1,400 million Clarks shoes in 2011.

The sales of Clarks shoes have boosted since the opening of the first Clarks retail store in China in 1992. In July 2004, C. & J. Clark China Trading Co., Ltd. was established in China to develop the sales of Clarks products. Subsequently in October 2009, Clarks (Dongguan) Footwear Service Company was set up to further consolidate and strengthen the sales in Chinese market. With over 10 years' endeavor, the Complainant has opened and operated more than 259 Clarks retail stores in more than 72 major cities including Beijing, Shanghai and Guangzhou, etc. Clarks shoes are taking the leading position in the market of casual shoes in China and have been highly acknowledged by Chinese consumers.

The Complainant has spent heavily and continuously on promotion of its "Clarks" brand. In addition to advertising on the press and mainstream portal websites such as Sina and Sohu, the Complainant has put online its official Chinese website [www.clarks.com.cn](http://www.clarks.com.cn) to promote the trademark "Clarks" and its products. Thanks to years of use and promotion, the "Clarks" brand has been well recognized in China with high reputation

and great influence among the public.

Suffering repeated infringements on its trademarks, the Complainant has taken many legal actions with a considerable amount of efforts to crack counterfeited “Clarks” shoes. In an earlier case filed by the Complainant with the Center against the domain name [www.shoes-clarks.com](http://www.shoes-clarks.com) in 2011, the Panel of Center has made its decision in favor of the Complainant. Such legal actions initiated by the Complainant also in a sense indicate the high reputation of the brand “Clarks” among Chinese consumers.

The disputed domain name is confusingly similar to the Complainant’s trademark “Clarks”. The distinguishing part of the disputed domain name “clarks-hk.com” is “clarks-hk”, which is composed of three sub-parts, i.e. “clarks”, “-” and “hk.” The first sub-part is almost identical to the Complainant’s registered trademark “Clarks” except that the first letter of the trademark “Clarks” is capitalized. The second part is a connector which does not make any difference for the comparison. The last part “hk” is an abbreviation of the geographic area “Hong Kong”. The addition of this generic word is insufficient to remove the confusion among the consumers. On the contrary, it would lead the consumers to believe that the disputed domain name is related to the Complainant’s activity in Hong Kong. Furthermore, the dispute domain name resolves to the website [www.clarks-hk.com](http://www.clarks-hk.com) on which it is claimed that the website [www.clarks-hk.com](http://www.clarks-hk.com) is the official website of Clarks, and all the products sold on this website are shoes bearing the Complainant’s trademark “Clarks”. In view of the above, consumers will easily assume that the disputed domain name is owned by or related to the owner of the trademark “Clarks”. Consequently it can be concluded that the disputed domain name is confusingly similar to the trademark “Clarks”.

In fact, the registration and use of the disputed domain name has already caused the consumer’s confusion. After the website [www.clarks-hk.com](http://www.clarks-hk.com) was put into operation, the Complainant’s affiliated company, C. & J. Clark China Trading Co., Ltd., has received an email from a consumer who contended that the name and content of such website had made him/her believe that the website is an online store selling Clarks products

and is owned by the Complainant.

(2)The Respondent has no right or legitimate interests in respect of the disputed domain name.

The Respondent does not have prior rights or other legitimate interests in the mark “Clarks”. Moreover, the Respondent is not a licensee of the Complainant nor is it in any way associated with the Complainant. The Complainant has never authorized, licensed, endorsed or otherwise permitted the Respondent to use the mark “Clarks” in relation to its business as a business name or otherwise to register or use the domain name containing the mark “Clarks”.

(3)The Respondent has registered and is using the disputed domain name in bad faith.

The Respondent has registered the disputed domain name in bad faith. As stated in the previous part, the trademark “Clarks” owned by the Complainant is of great fame and good reputation in China and in the world, and has being used and registered in China and many other countries for a very long time. It is unlikely that the Respondent did not have knowledge of the trademark when it registered the disputed domain name. This can also be proved by the use of the disputed domain name by the Respondent described below.

The Respondent is using the disputed domain name in bad faith. As showed on the notarization document presented by the Complainant, the disputes domain name resolves to the website “www.clarks-hk.com”(“Website”) and the information contained in such Website revealing the Respondent’s bad faith in using the disputed domain name includes:

(A) The topic of the Website contains the words “the official website of clarks/ the biggest online store of genuine Clarks shoes”.

(B)The trademark “Clarks” is displayed in a very obvious way on the upper left side of the homepage of the Website. Meanwhile, at the bottom of each page of the Website there is a link named “Clarks official

website". If the customers click the link, the page will jump to the homepage of the Website.

(C) All products displayed on the Website are shoes and have the word "Clarks" or "Clarks Genuine" in their names.

(D) Two promotion pictures on the top of the homepage of the Website are identical as the ones displayed on the webpage of [www.clarks.com.cn](http://www.clarks.com.cn), the Complainant's official website in China. The page of "clarks Un Spore 20332707 women casual sandals" also contains a lot of promotion pictures from the Complainant, and the advertising words on the pictures also come from the Complainant.

(E) All the articles in the column "Latest News" on the upper right side of the homepage give the customers an expression that the shoes offered by the Website are designed and produced by the Complainant.

The notarization documents presented by the Complainant also prove that the Respondent is actually engaged in the sales of shoes bearing the trademark "Clarks" to customers by the Website.

The above facts and analysis all demonstrate the Respondent's intention to mislead the public to believe that the Website is operated or authorized by the owner of the trademark "Clarks" or someone affiliated with the owner. By creating confusion with the Complainant's trademark as to the source of the products and the owner of the Website, the Respondent attempts to attract customers to buy products displayed on the Website for commercial gains. According to Paragraph 4 (b) (iv) of the Policy, the disputed domain name is registered and used in bad faith by the Respondent.

The Complainant requests the disputed domain name "clarks-hk.com" be transferred from Respondent to Complainant.

### **The Respondent**

The Respondent did not submit the Response.

## **4. Findings**

### **Identity or Confusing Similarity**

Pursuant to the Policy, paragraph 4(a)(i), a complainant must prove that the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights. In line with such requirement, a complainant must prove its trademark rights and the similarity between the disputed domain name and its trademark.

The Panel notes that the Complainant is the registrant of the trademark “CLARKS” in China as well as in many other countries or regions. The disputed domain name is “clarks-hk.com”. Apart from the generic top-level domain suffix “.com”, the disputed domain name consists of “clarks” and “-hk”, former part of which is identical to the Complainant’s mark “CLARKS” in non-case-sensitive way and the latter part of which is the regional code for Hong Kong in the domain name system plus a dash. Given that the disputed domain name embraces the Complainant’s registered trademark in its entirety, addition of non-distinguishable suffixes, i.e. “-hk”, can hardly diminish the likelihood of confusion between the disputed domain name and the Complainant’s mark.

The Panel therefore finds that the disputed domain name “clarks-hk.com” is confusingly similar to the Complainant’s registered trademark “CLARKS”. Accordingly, the Complainant has proven the first element required by paragraph 4(a) of the Policy.

### **Rights or Legitimate Interests of the Respondent**

The Complainant asserts that the Respondent has no rights or legitimate interests in the disputed domain name and, as stated above, the Respondent did not provide any information to the Panel asserting any right or legitimate interest it may have in the disputed domain name.

The Complainant proves that the Respondent does not have any trademark registration in China and confirms that the Respondent has no connection with the Complainant or its business. Paragraph 4(c) of the Policy lists a number of circumstances which can be taken to demonstrate a respondent’s rights or legitimate interests in a domain

name. However, there is no evidence before the Panel that any of the situations described in paragraph 4(c) of the Policy apply here. To the contrary, the lack of a Response leads the Panel to draw a negative inference.

Therefore, and also in light of the Panel's findings below, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name "clarks-hk.com". Accordingly, the Complainant has proven the second element required by paragraph 4(a) of the Policy.

### **Bad Faith**

The Complainant contends that the Respondent had bad faith. The Respondent did not respond.

The evidence submitted by the Complainant shows that "CLARKS" has acquired considerable reputation and recognition in the Chinese shoes market through consistent use and promotion for two decades. The Complainant submitted notarized evidence to show that the Respondent, on the disputed domain name website "www.clarks-hk.com", not only claims itself "the official website of clarks" but publicly offers to sell shoe products marked with the mark "CLARKS".

The Panel finds that the Respondent registered and is using the disputed domain name "clarks-hk.com" to intentionally attract, for commercial gain, Internet users to the website "www.clarks-hk.com", by creating a likelihood of confusion with the Complainant's mark "CLARKS" as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or of products offered on that website.

The Panel therefore rules that this is adequate to conclude that the Respondent has bad faith under the Policy, paragraph 4(b)(iv). Therefore, the Complainant has successfully proven the third element required by paragraph 4(a) of the Policy.

### **5. Decision**

For all the foregoing reasons, in accordance with paragraphs 4(i) of the

Policy and 15 of the Rules, the Panel orders that the domain name “clarks-hk.com” be transferred to the Complainant C. & J. CLARK INTERNATIONAL LIMITED.

Panelist: 薛虹

Dated: 12 November 2012