



# **ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)**

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## Decision Submission

English

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Decision ID	DE-0300009
Case ID	HK-0300022
Disputed Domain Name	www.paiho.com
Case Administrator	Iris Wong
Submitted By	Anthony Wu
Participated Panelist	Anthony Wu
Date of Decision	24-04-2003

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## The Parties Information

**Claimant** Taiwan Paiho Co. Ltd.  
**Respondent** Alliance Footwear S.L.

## Procedural History

On February 10, 2003, the Hong Kong office of Asian Domain Name Dispute Resolution Centre ( “ADNDRC” ) received the Complaint form in electronic format filed by the Taiwan Paiho Co. Ltd. (the “Complainant” ). On February 15, 2003, the Hong Kong Office of ADNDRC received payment in the correct amount for a single-person panel. The Registrar and the Alliance Footwear S.L. (the “Respondent” ) was also notified of the Complaint on the same day. On February 26, 2003, the Hong Kong Office of ADNDRC served a notification of Commencement of the Proceedings on the Respondent and the Respondent was asked to submit a Response to the Complainant.

On February 20, 2003, the Hong Kong Office of ADNDRC requested Core to confirm that the domain name at issue was registered by the Respondent. On March 5, 2003, the Registrar confirmed that it is the registrar of the domain name and that the domain name was registered by the Respondent. On March 19, 2003, the Hong Kong Office of ADNDRC requested that the parties to rank the five candidates for Panelist in order of preference. On March 20, 2003, the Hong Kong Office of ADNDRC received from the Complainant the rankings of the five candidates in order of preference. The Respondent did not respond to the letter.

On March 26, 2003, pursuant to the Hong Kong Office of ADNDRC Supplemental Rules, Art. 8(5), the Hong Kong Office of ADNDRC appointed Mr Anthony Wu to serve as Panelist and notified the parties of the Panel's appointment. All documents submitted by both the Complainant and the Respondent were sent to Panelist by email and courier.

On April 15, 2003, by email to the Hong Kong Office of ADNDRC, the Panel asked for further information and evidence from the Complainant on the following :

(1) to provide particulars (in particular date & place of registration) and evidence on the registration of Paiho as a trademark. It appears from the brochures that Paiho has been so registered.

(2) to confirm how much €200,000 would amount to in US dollars, and what was the estimated costs in US dollars of the Respondent directly related to the domain name.

The Panel also asked for a week's extension to render its decision. On April 15, 2003, the Complainant submitted further information on Question (2) : that €200,000 equals to US\$214,000.

On April 17, 2003, the Hong Kong Office of ADNDRC by email extended the due date for decision to April 23, 2003.

On further clarification of Question (1) on April 17, 2003 by the Panel, the Complainant confirmed on April 22, 2003 that Paiho is registered as a trademark with the Economics Department of Taiwan (together with evidence of the registration).

## Factual Background

### For Claimant

The Complainant was established in 1979, changed to its present name in 1990 and became a public limited company incorporated in Taiwan in 2001. Paiho International Limited was established in 1997 with factories in Dongguan and Wuxiui of PRC, and in Vietnam. The Paiho Group is a manufacturer of touch fastener, elastic, webbing, shoelace, braded fabric and is a converter of 3M reflective material. It is a vendor of Nike, Reebok, Adidas ... and etc. Paiho is famous in sporting goods. Paiho is also registered as a trademark with the Economics Department of Taiwan.

### For Respondent

The Respondent is company of Valencia, Spain. The Respondent registered the domain name in issue in June 2000. When the Complainant learned that the Respondent had registered the domain name in issue, it contacted the Respondent. It found that the Respondent has a company in Taiwan and it is a customer of the Complainant.

## Parties' Contentions

### Claimant

The Complainant contends that the domain name in issue is identical or confusingly similar to the trademark or tradename to which the Complainant has rights. The Complainant contends that the Respondent has no rights or legitimate interests in respect of the domain name in issue. The Complainant contends that the Respondent registered and is using the domain name in bad faith. Details of the allegations are set out in the Findings Section.

### Respondent

Despite having been given notice on February 15, 2003, and February 26, 2003 by the Hong Kong Office of ADNDRC, the latter notifying the Respondent that it has 20 calendar days to respond to the Complaint, the Respondent did not respond to the Complaint at all. The only communication from the Respondent that is known to the Panel is an email dated March 6, 2003 from Aleijandro of the Respondent to the Complainant agreeing to transfer the domain name.

## Findings

### Identical / Confusingly Similar

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") instructs the Panel as to the principles the Panel is to use in determining the dispute: "A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules, and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Uniform Domain Name Dispute Resolution Policy (the "Policy") directs that the Complainant must prove each of the following:

- 1) that the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- 2) that the Respondent has no rights or legitimate interests in respect of the domain name; and
- 3) that the domain name has been registered and is being used in bad faith.

### Identical or Confusing Similarity

It is the allegations of the Complainant that Paiho Group manufacturers touch fastener, elastic, webbing, shoelace and braded fabric and is a converter of 3M reflective material. It is famous in sporting goods and is the vendor to such famous sporting wears as Nike, Reebok and Addidas. The domain name is identical or confusingly similar to the

tradename of the Complainant.

As later confirmed with the Complainant, Paiho is also registered as a trademark. From the materials provided, it is clear that the Paiho tradename and trademark has been widely advertised by the Complainant on its goods. Clearly, the Complainant has rights over the tradename and trademark of Paiho.

The Panel finds that the domain name “paiho.com” is identical to the tradename and trademark of Paiho of the Complainant.

### **Rights and Legitimate Interests**

It is the allegation of the Complainant that the Respondent and its authorised representative, Alejandro Monzó Tadeo do not have any related interest to the disputed domain name, Paiho, and the Respondent do not have any trademark or any service mark of the name. Also, the Complainant did not have any plan to use the web site to sell or serve. So the Complainant has no right or legitimate interest in respect of the domain name. As noted above, the Respondent did not respond to the allegations of the Complainant and there is no evidence to contradict these allegations.

Furthermore, in order to show rights or legitimate interests by use or preparation to use, the Respondent must show “demonstrable preparations” or actual use occurring “before any notice... of the dispute.” Again, the Respondent's failure to respond means there is no evidence of any such demonstrable preparations.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the domain name.

### **Bad Faith**

It is the allegation of the Respondent that because the Respondent had a company making shoes in Taiwan and had business relationship with the Complainant, it must have known about Paiho. About the content, it shows only one thing in the homepage of the disputed website which is that the domain was for sale. Allegedly, when talking face to face, and the Defendant asked for €200,000 to sell the domain name. €200,000 is equivalent to US\$214,000. As the Respondent did not respond to the Complaint, there was no evidence to contradict the allegations.

On the copy of the web page produced by the Complainant, it shows that the domain name had indeed been acquired for the purpose of selling the domain name registration. Further, the Complainant alleged that the Respondent had asked for valuable consideration (€200,000) from the Complainant. It appears that this consideration would be much in excess of the Respondent's out-of-pocket costs directly related to the domain name.

Accordingly, the Panel finds that the evidence shows, in particular having regard to Art. 4(b)(i) of the Policy, that the registration and use by the Respondent was in bad faith.

### **Status**

www.paiho.com

Domain Name Transfer

### **Decision**

For all of the foregoing reasons, the Panel decides that the domain name registered by the Respondent is identical to the tradename and trademark in which the Complainant has rights, that the Respondent has no rights or legitimate interests in respect of the domain name at issue, and that the Respondent's domain name has been registered and is being used in bad faith. Accordingly, pursuant to Paragraph 4(i) of the Policy, the Panel requires that the registration of the domain name “paiho.com” be transferred to the Complainant.