



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

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Decision Submission

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Version
 Decision ID DE-0800158
 Case ID HK-0800164
 Disputed Domain Name www.duoleshi.net.net
 Case Administrator Dennis CAI
 Submitted By Yun Zhao
 Participated Panelist

Date of Decision 04-10-2008

Language Version : English

The Parties Information

Claimant Imperial Chemical Industries Plc
Respondent YingGuo DuoLeShi Paint Co., Ltd.

Procedural History

On 9 May 2008, the Complainant submitted a Complaint in the Chinese language to the Hong Kong Office of the Asian Domain Name Dispute Resolution Center (the ADNDRC) and elected this case to be dealt with by a one-person panel, in accordance with the Uniform Domain Name Dispute Resolution Policy (the Policy) approved by the Internet Corporation for Assigned Names and Numbers (ICANN), the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules), and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the ADNDRC Supplemental Rules). On 16 May 2008, the ADNDRC sent to the complainant by email an acknowledgement of the receipt of the complaint and reviewed the format of the complaint for compliance with the Policy, the Rules and the ADNDRC Supplemental Rules.

On 16 May 2008, the ADNDRC transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On 3 June 2008, the Registrar transmitted by email to the ADNDRC its verification response, confirming that the Respondent is listed as the registrant and that the language of the registration agreement is English.

On 4 June 2008, the ADNDRC requested the Complainant to submit an English translation of the Complaint in Chinese by 11 June 2008. On 10 June 2008, the Complainant submitted the English translation of the Complaint.

On 24 July 2008, the ADNDRC transmitted the Complaint to the Respondent and notified the Respondent of the commencement of the action. The Respondent failed to submit a Response within the specified period of time. Accordingly, the ADNDRC notified the Respondent's default on 26 September 2008.

Since the Respondent did not mention the Panel selection in accordance with the time specified in the Rules, the ADNDRC Supplemental Rules, and the Notification, the ADNDRC informed the Complainant and Respondent that the ADNDRC would appoint a one-person panel to proceed to render the decision.

Having received a Declaration of Impartiality and Independence and a Statement of Acceptance, the ADNDRC notified the parties that the Panel in this case had been selected, with Dr ZHAO Yun acting as the sole panelist. The Panel determines that the appointment was made in accordance with Rules 6 and Articles 8 and 9 of the Supplemental Rules.

On 26 September 2008, the Panel received the file from the ADNDRC and should render the Decision within 14 days, i.e., on or before 13 October 2008.

Pursuant to Paragraph 11 (a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding. The language of the current disputed domain name Registration Agreement is English, thus the Panel determines English as the language of the proceedings.

Factual Background

For Claimant

The Complainant in this case is Imperial Chemical Industries Plc. The registered address of the Complainant is 20 Manchester Square, London W1U 3AN, England.

For Respondent

The Respondent, YingGuo DuoLeShi Paint Co., Ltd., is the current registrant of the disputed domain name <duoleshi.net> according to the Whois information. The registered address of the Respondent is Room 304, No. 6, ShengLi Road, Jiangmen, Guangdong, China CN 529000.

Parties' Contentions

Claimant

The Complainant was incorporated on 7th December 1926 in the United Kingdom. It is now a public limited company. The Complainant Group now has manufacturing units and offices in 55 countries and regions all over the world and employs over 30,000 employees. It sells over 50,000 types of products and its products are sold in 100 countries and regions. The Complainant Group's paint business has around 21 brands and "DULUX" is one of the well-known brands of the Complainant Group. As early as 1898, the predecessor of the Complainant Group started its business in China. The Complainant Group manufactures over 500 types of interior and exterior emulsion paint products, and most of them have used "DULUX" as their brand. In China and Hong Kong, the Complainant Group has around 224 and 71 authorized shops respectively. In China and Hong Kong, the turnover of "DULUX" products in 2004 and 2005 was HK\$825,500,000 and HK\$1,100,000,000 respectively.

The Complainant has registered 13 and 6 trademarks containing "DULUX" in China and Hong Kong respectively. The Complainant Group has also registered over 849 marks containing "DULUX" all over the world. Further, the Complainant Group has registered over 79 domain names containing "dulux". Among the domain names owned by the Complainant Group, 8 domain names divert to the main websites. As demonstrated by the above, "DULUX" is widely used and well known throughout the world. Therefore, the Complainant has rights in the mark "DULUX".

1. The Disputed Domain Name is identical or confusingly similar to the mark "DULUX"

The disputed domain name "Duo Le Shi" and the Complainant's Chinese trademark "多乐士" when pronounced are identical. The English transliteration of the Complainant's trademark "多乐士" is "DULUX". The Complainant's trademark "多乐士" is the official Chinese translation of the "DULUX" and is also a registered trademark of the Complainant in China. From the disputed domain name www.duoleshi.net, the major and dominant part of the disputed domain name is clearly confusingly similar to either "多乐士" or "DULUX". Further, any third party can be easily misled, thinking that the Respondent belong to the branch of the Complainant Group. Therefore, the Complainant considers that the disputed domain name is apparently identical or confusingly similar to the Complainant's "DULUX" mark.

2. The Respondent has no rights or legitimate interests in the disputed domain name

The Respondent, who registered the disputed domain name, has no connection whatsoever with "DULUX". The Complainant Group has no business connection whatsoever with the Respondent, nor has the Complainant ever authorized the Respondent to use "DULUX" as its domain name or for any other use. Further, the Respondent has not registered any marks containing "DULUX" in China and Hong Kong. In view of the fact that the Complainant has not licensed or otherwise permitted the Respondent to use "DULUX" or to apply for or use any domain name incorporating "DULUX", the circumstances here are sufficient to constitute a prima facie showing by the Complainant of absence of rights or legitimate interests in the disputed domain name and to shift the evidentiary burden to the Respondent to show that it does have rights or legitimate interests in "DULUX".

Without prejudice to the above points, the Complainant alternatively points out that despite the fact that a company called "英国多乐士涂料(中国)有限公司" appears in the website of the disputed domain name, the Complainant based on the following reasons considers that the Respondent cannot rely on any circumstances to prove that its has legitimate interests.

(1) The Complainant does not only have trademark rights in "DULUX", it also has common law rights in "DULUX" as a result of its goodwill and reputation therein. The Respondent's use of "多乐士" as part of the company name appeared on the subject website sufficiently proves the Respondent's acts of trademark infringement and passing off of the Complainant's rights. Further, the packaging of the subject product where the company name with "Dulux" appeared thereon is highly similar to the packaging of the Complainant's "DULUX" products. Further, the packaging of other products where the company name with "多乐士" and the roundel mark appeared thereon are apparently identical and highly similar to the packaging of the Complainant's "DULUX" products and other trademarks. In

the company information of the subject website, the Respondent on purpose provides false information, misleading the public to believe that the company described is the Complainant. The above clearly demonstrates that the Respondent has absolute intention to mislead the consumers, making them to believe that the Respondent or its products are related to the Complainant, using the fame of “DULUX” to explore commercial benefits.

(2) From the website of the disputed domain name, it can be seen that the Respondent has used the domain name for commercial use. The business carried on by the Respondent is paint business, it apparently is a competitor of the Complainant.

(3) Despite the fact that the company name shown on the website of the disputed domain name contains “多乐士”, the Respondent does not have any rights or legitimate interests in the domain name. Further, the Complainant points out that it is very common for companies to have famous trademark different from the Complainant’s company name. If any third party makes use of trademark which is different from the Complainant’s company name to incorporate a company, using the said newly incorporated company name to register a domain name, and is allowed to use its intentional infringement to prove that it has rights and interests in the domain name, this is apparently contrary to the intent of the Policy.

(4) “DULUX” is very well known in China, it can therefore be inferred that the Respondent knows the existence of the registered mark “DULUX” when registering the disputed domain name. Based on the fact “DULUX” is not a word that is used in daily language, it shows that the Respondent intentionally chooses the fictitious word as its domain name to make use of the fame of “DULUX” to mislead the public.

3. The Respondent registers or uses the disputed domain name in bad faith

“DULUX” is not a word used in daily language, but a fictitious word. In view of the fact that the Respondent chose the same as its domain name on purpose, and the said mark enjoys good reputation worldwide, it shows that the Respondent registered the disputed domain name after knowing the subject mark. Such conduct is sufficient to prove that the Respondent registers or uses the disputed domain name in bad faith.

In accordance with Paragraph 4(b)(i) of the Policy, the Complainants request the Panel to issue a decision to transfer the Disputed Domain Name to the Complainant.

Respondent

The Respondent failed to submit a Response within the specified time period.

Findings

Paragraph 15(a) of 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 Policy requires that the Complainant should prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- 1) 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) the Respondent has no rights or legitimate interests in respect of the domain name; and
- 3) the domain name has been registered and is being used in bad faith.

Identical / Confusingly Similar

The evidence submitted by the Complainant shows that the Complainant owns the trademarks “DULUX” and “多乐士” and thus holds legitimate trademark rights in the trademarks.

As the suffix “.net” only indicates that the domain name is registered under this gTLD and is not distinctive, the Panel needs to consider whether the main part of the disputed domain name (“duoleshi”) is confusingly similar to the trademarks. The Chinese trademark “多乐士”, with the pinyin “Duo Le Shi”, is the same as “duoleshi”. However, the Panel needs to further consider whether “duoleshi”, in the circumstance, corresponds only to the Chinese term “多乐士”, and no other Chinese terms. In this case, the evidence submitted by the Complainant has sufficiently shown that the trademark “多乐士” is a famous mark, those who are familiar with the Chinese language will most probably connect “duoleshi” with the trademark “多乐士”. The term “duoleshi”, to be meaningful, refers only to the Complainant’s Chinese trademark. The Panel finds that the disputed domain name is confusingly similar to the trademark “多乐士”.

The Panel therefore holds that the Complaint fulfills the condition provided in Paragraph 4 (a)(i) of the Policy

Rights and Legitimate Interests

The Complainants contend that the Respondent does not have rights to or legitimate interests in the disputed domain name. The Complainants’ assertion is sufficient to establish a prima facie case under Policy 4 (a)(ii), thereby shifting the burden to the Respondent to present evidence of its rights or legitimate interests. The Respondent failed to file a Response and did not dispute the above contention. The Respondent has thus failed to show that the Respondent has any rights or legitimate interests in respect of the Disputed Domain Name. The Panel therefore finds that the Complaint fulfills the condition provided in Paragraph 4(a)(ii) of the Policy.

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.

Evidence has sufficiently shown that the Complainant's trademark has achieved a strong reputation through extensive use. As such, the public has come to recognize and associate the Complainant's mark as originating from the Complainant and no other. Moreover, the trademark “多乐士” is not a common word in daily life. This entitles the Panel to infer that the Respondent should be aware of the existence of the Complainant. This inference has been further substantiated by the fact that the website of the disputed domain name contains the trademark “多乐士”. The action of registering the disputed domain name per se has constituted bad faith.

Furthermore, the website of the disputed domain name clearly shows that the Respondent carries out the same business as the Complainant. By using the disputed domain name, the Respondent has attempted to attract, for commercial gain, internet users to the website by creating a likelihood of confusion with the complainant's mark. This is use of the domain name of the typical type contemplated by Paragraph 4(b) (iv) of the Policy, and accordingly is evidence of the registration and use of the domain name in bad faith.

In conclusion, the Panel finds that the Respondent has registered and used the domain name in bad faith. Accordingly, the Panel finds that the Complaint satisfies the condition provided in Paragraph 4 (a) (iii) of the Policy.

Status

www.duoleshi.net Domain Name Transfer

Decision

Having established all three elements required under the ICANN Policy, the Panel concludes that relief should be granted. Accordingly, it is ordered that the <duoleshi.net> domain name should be TRANSFERRED from the Respondent to the Complainant.

ZHAO Yun
Sole Panelist

DATED: 29 September 2008