



# ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

— A charitable institution limited by guarantee registered in Hong Kong

(Hong Kong Office)

## ADMINISTRATIVE PANEL DECISION

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<b>Case No.</b>	<b>HK-1100354</b>
<b>Complainant:</b>	<b>Jean Cassegrain S.A.A.</b>
<b>Respondent :</b>	<b>Widegates Inc.</b>

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### 1. The Parties and Contested Domain Name

The Complainant is Jean Cassegrain S.A.S. of 12, Rue Saint - Florentin, 75001 Paris, FRANCE, represented by Reed Smith Richards Butler of 20/F Alexandra House, 18 Chater Road, Central, Hong Kong.

The Respondent is Widegates Inc. of Tianjiuwan 1004tianyi Putian NA 351100 CHINA.

The domain name at issue is <longchamp1948.com>, registered by Respondent with Tucows Inc. of 96 Mowat Avenue, Toronto, Ontario M6K 3M1 CANADA

### 2. Procedural History

On April 27, 2011, the Complainant submitted the Complaint in English on domain name <longchamp1948.com> to the Hong Kong 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") approved by ICANN on October 24, 1999, and the Asian Domain Name Dispute Resolution Centre Supplemental Rules in effect as of February 28, 2002.

By email message dated April 29, 2011, the Center confirmed the online receipt of the Complaint, together with, as sent through separate e-mail messages, accompanying Annexes I-XIV. The Complainant requested a single-person panel.

After receiving the original Complaint, the Centre, in accordance with the Supplemental Rules, verified that the Complaint complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on April 29, 2011, the Centre requested the Registrar to confirm: (a) that the disputed domain name was registered with the Registrar, (b) whether the Respondent is the registrant or holder of the name, and (c) whether the Policy applies to the name; and to specify: (d) the language of the registration agreement, (e) WhoIs information for the name, and (f) the current status of the name.

On May 10, 2011, the Registrar provided its response to the Centre through which it confirmed that: the name was registered with Tucows Inc., the Respondent is the registrant or holder of the name, and the Policy applies to the name. The Registrar also stated that the registration agreement is in the English language, provided name and contact information pertinent to the name as reflected in its WhoIs database, and stated that the name is currently locked.

On May 13, 2011, the Centre sent the Complaint to the Respondent. The Respondent was then provided with a 20 calendar day period, expiring on June 2, 2011, to file its Response both with the Centre and the Complainant.

As of June 3, 2011, the Respondent had not filed any Response with the Centre.

Accordingly, on June 3, 2011, the Centre advised the parties by email that the Respondent had not filed any Response to the Complaint with the Centre on or before the June 2nd deadline and, as such, the Centre would then proceed to appoint a Panelist for this matter.

Pursuant to the Rules and Supplemental Rules, the Centre, by email dated June 13, 2011, contacted the undersigned, Mr. Peter L. Michaelson, Esq., requesting his service as a Sole Panelist for this dispute. Subsequently, on June 14, 2011, Mr. Michaelson responded and affirmed his ability to act completely independently and impartially in this matter. The Centre, through an email dated June 14, 2011, notified the Parties of the appointment of Mr. Michaelson as the Sole Panelist.

Based on the deadline set forth in paragraph 15 of the Rules, a decision was to be issued by the Panel to the Center on or before June 28, 2011.

### **3. Factual background**

As indicated in the WhoIs registration record provided in Annex I to the Complaint, the Respondent registered the disputed domain name on March 5, 2011.

#### **A. The Complainant's LONGCHAMP Marks**

The Complainant currently owns numerous trademark registrations worldwide for marks that consist of the term "LONGCHAMP", both in block letters by itself and also together with a horse and rider design element. The Complainant provided, in Annex II of the Complaint, copies of official database entries of its trademark registrations in China, and, in Annex III to the Complaint, copies of its registration certificates for its marks in Europe (CTM), France, Sweden, Andorra, United Kingdom, Denmark and Norway. Pertinent details of two illustrative Chinese registrations are as follows:

1. LONGCHAMP (block letters)  
PRC registration: 7103273; registered: June 6, 2010  
goods: Leather, unworked or semi-worked; imitations of leather, animal skins, hides; trunks (luggages) and traveling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery, handbags, wallets, purses, key-bags (of leather), shopping bags, school bag, briefcases, fur, rucksacks (for mountaineering or travelling), suitcases, garment bags for travel; leather sheet, attaché cases, card cases made of leather, cheque book cover made of leather, credit card cases (pocket book) made of

leather, key cases (leatherware), passport holders (made of leather), luggage, multi-use cases/bags made of leather, all in international class 18.

2. LONGCHAMP (block letters) together with the horse and rider design element  
PRC registration: 242939; registered January 30, 1986  
goods: Matches, cigarette lighters and smokers' articles, all in international class 34.

## **B. The Complainant and its activities**

During 1948, Mr. Jean Cassegrain founded the Complainant, as S.A. Jean Cassegrain, in France. Subsequently, on December 2, 1958, the Complainant was incorporated under the laws of France.

At its inception, the Complainant was geared towards producing leather-covering for pipes. At about 1950, the Complainant broadened its business to produce other articles for smokers and from 1955 onwards also produced small leather goods. By 1957, the Complainant opened its first factory in France. Through the 1960s and 70s, the Complainant continuously created and launched new products, all under its mark LONGCHAMP (both in block letters and with its accompanying horse and rider design element), in particular handbags, travel bags and luggage cases.

Currently, the Complainant designs, manufactures, distributes and sells worldwide, through itself, its associated companies and authorized distributors, a wide variety of fashionable products, including, e.g., handbags, clothing, footwear, headgear, travelling bags and wallets for men and women.

In 1979, the Complainant established its first retail sales location in the Far East, specifically in Hong Kong and also began developing its Japanese market. During 1990 or so, the Complainant's leather goods included gloves and belts. During 1992, the Complainant added silk scarves and ties to its product mix.

In 1993, the Complainant launched a range of bags, known as "Le Pliage" bags. The "Le Pliage" bags have been extremely successful for the Complainant. In each of the years 2002-2006, the Complainant sold over 1 million "Le Pliage" bags internationally, including significant sales to customers in China to the point of possibly, at the end of that time, that particular bag having become one of the best-selling bags of any brand in that country.

In 1996, the Complainant further expanded its branded product line of fashion products to include men's and women's ready-to-wear clothing like, T-shirts, shirts, suits and other clothing items.

As of January 2011, the Complainant had 130 retail stores worldwide selling its branded fashion products under its LONGCHAMP Marks. Further, the Complainant has extensively advertised its products worldwide in various fashion magazines throughout its market. Copies of illustrative magazine advertisements in China, France, Finland, Russia, Korean, Greece, Portugal, Spain, US, Thailand, Japan, Turkey, Hong Kong, Indonesia, Germany, Middle East and the United Kingdom appear in Annex VIII to the Complaint. In 2001, the Complainant's worldwide sales of its products branded with LONGCHAMPS Marks were approximately Euros 144.4 Million and have increased every year thereafter to a 2010 worldwide sales level of approximately Euros 321 Million. In China alone, its

annual sales increased from a 2000 year level of approximately RMB 7.9 Million to 2010 year level of RMB 13.5M.

Since 2001, the Complainant has been and continues to be a member of Comite Colbert (a print-out of the Comite Colbert website appears in Annex IX to the Complaint) Comite Colbert was started in 1954 by a group of 12 French companies with a common purpose of promoting the excellence and quality of their member's brands to the worldwide community. Admission to Comite Colbert occurs through agreement of at least 75% of its then existing members. In 2007, Comite Colbert had 68 member and thereafter, in March 2011, 75 members. Other widely-known members of Comite Colbert currently include, e.g., Cartier, Celine, Champagne Krug, Chanel, Christian Dior, Cognac Remy Martin, Givenchy, Guerlain, Hermes, La Chemise Lacoste, Lancome, Van Cleef & Arpels, Louis Vuitton and Yves Saint Laurent.

Fighting counterfeiting is one of the major tasks of Comite Colbert. It and its members have taken and continue to take action at various levels, local and internationally, setting up anti-counterfeiting committees, intervening in the "source" countries, and calling on the national, European and international justice systems to assist in the fight against piracy.

### **C. The Respondent's activities**

The Respondent's website, resolvable through the disputed domain name, depicts the Complainant's "LONGCHAMP" Marks. A banner on the top of the home page of that site (a hard-copy print-out of the home page appears in Annex XIII to the Complaint) depicts the word "LONGCHAMP" with the word "PARIS", in smaller type directly beneath it. Underneath the banner, the page depicts pictures of various bags, together with word "LONGCHAMP". Further, through that website, Internet users can purchase various new bags that depict the Complainant's mark LONGCHAMP but at posted prices on the order of US \$ 70. These prices are significantly lower than the official prices at which the Complainant sells genuine corresponding versions of its branded bags.

Further, subsequent pages of the Respondent's website (a copy of those pages appears in Annex XIV to the Complaint) provides pictures of bags of different colors and sizes, each with a corresponding name that contains the Complainant's mark LONGCHAMP, and some of which indicate an available quantity of over 800 items.

## **4. Parties' Contentions**

### **A. Complainant**

#### **(i) Identical or Confusingly Similar**

The Complainant contends that the disputed domain name is either identical or confusingly similar to the Complainant's mark LONGCHAMP.

Specifically, the name includes the number 1948 after the mark LONGCHAMP, with that number adding no distinctiveness to the overall domain name. Hence, Internet users who encounter the name would be confused into believing that the Respondent and/or its business are somehow associated with the Complainant when, in fact, neither one is.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

**(ii) Rights or Legitimate Interests**

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraphs 4(a)(ii) and particular 4(c) of the Policy.

In particular, the Respondent is not affiliated with the Complainant, is not a licensee of the Complainant and is not authorized by the Complainant to use "LONGCHAMP" or any other similar marks as a domain name or otherwise. Yet, in spite of a lack of authorization, the Respondent, through its website, is apparently presenting itself as an authorized retail outlet of the Complainant's goods, when in fact it is not.

Given: (a) the Respondent's unauthorized use of the Complainant's mark LONGCHAMPS on its website and in conjunction with each of the bags offered for purchase through that site, (b) the large color selection of those bags apparently available through that site, (c) the significant price disparity between each of the Respondent's bags and the same, but genuine, version provided by the Complainant, and (d) the inability of the Respondent to legitimately obtain large quantities of those bags for sale -- as it is not authorized by the Complainant to sell its products, then all of the Respondent's bags must be counterfeit. Hence, the Respondent's use of both the mark LONGCHAMP and corresponding the disputed domain name must be illegitimate.

**(iii) Registered and Used in Bad Faith**

The Complainant contends that the Respondent registered and is now using the disputed domain name in bad faith under paragraph 4(a)(iii) of the Policy.

Specifically, the Respondent deliberately registered a name that included the Complainant's mark LONGCHAMP in order to intentionally create confusion in Internet users as to source, sponsorship, affiliation or endorsement between it and the Complainant -- where, in fact, no such attribute existed at all, and thus unfairly benefit from the Complainant's reputation. This constitutes bad faith registration.

Further, the Respondent's actions in subsequently using that name as an address of its website through which it offered counterfeit versions of the Complainant's products for sale to those users constitutes bad faith use.

**B. Respondent**

The Respondent failed to file any Response to the contentions raised in the Complaint.

**5. Findings**

In view of the lack of a Response filed by the Respondent as required under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(e), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant's undisputed representations.

The Policy provides, at Paragraph 4(a), that each of three findings must be made in order for the Complainant to prevail:

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

#### **A) Identical or Confusingly Similar**

The Panel finds that the disputed domain name is confusingly similar to the Complainant's LONGCHAMP Marks.

The disputed domain name contains the term LONGCHAMP along with, as a suffix to that term, the number 1948 to yield a corresponding composite term "longchamp1948" to which the gTLD (generic top level domain) ".com" was then appended to form the disputed domain name -- with the last addition being irrelevant in assessing confusing similarity or identity under paragraph 4(a) of the Policy and thus ignored.

It is now very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that a minor variation, such as adding short letter or number groups or even common, generic or highly descriptive words is usually insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that name to avoid user confusion. Here, the number "1948" simply adds no distinctive element whatsoever to the mark LONGCHAMP, particularly in light of the substantial, worldwide recognition and reputation of that mark, to preclude any such confusion from occurring. See, e.g., *Oakley, Inc. v. Kate Elsberry, Elsberry Castro*, Case No. D2009-1286 (November 18, 2009); *Burberry Limited v. Domain Admin*, WIPO Case No. D2009-0703 (August 11, 2009); *Krispy Kreme Doughnuts, Inc. v. John Sharp*, WIPO Case No. D2009-0099 (April 20, 2009); *MasterCard International Incorporated v. Global Prepaid*, WIPO Case No. D2008-2008 (March 25, 2009); *HRB Innovations Inc., Express Tax Service Inc. v. Calvin Brown*, WIPO Case No. D2008-1072 (September 4, 2008); *Dreamworks Animation, LLC v. Creahq, Mike Furlong*, WIPO Case No. D2008-0505 (May 28, 2008); *Marvel Manufacturing Company Inc. v. Koba Internet Sales, LP*, WIPO Case No. D2008-0265 (May 5, 2008); *MySpace, Inc. v. Edwin De Jesus, EDJ Associates Inc.*, WIPO Case No. D2007-1878 (March 12, 2008); *Blackrock, Inc. v. blackrockfinancialservices.com*, WIPO Case No. D2007-1627 (January 4, 2008); *F. Hoffmann-La Roche AG v. Transliner Consultants*, WIPO Case No. D2007-1359 (November 14, 2007); *National Football League v. Peter Blucher d/b/a BluTech Tickets*, WIPO Case No. D2007-1064 (September 24, 2007); *Toilets.com, Inc. v. Rons Porta Johns*, WIPO Case No. D2007-0952 (August 27, 2007); *Associated Bank Corp. v. Texas International Property Associates*, WIPO Case No. D2007-0334 (June 28, 2007); *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317 (April 24, 2007); *SPX Corporation v. Hevun Diversified Corporation*, NAF Claim No. 791657 (November 13, 2006); *Google Inc. v. Jennifer Burns*, NAF Claim No. 726096 (August 16, 2006); *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766 (September 12, 2005); *Napster, Inc. v. Giovanni Vinscani*, WIPO Case No. D2005-0531 (July 19, 2005); *Caesars Entertainment, Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411 (June 22, 2005);

*Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824 (January 18, 2005); *Lockheed Martin Corporation v. Deborah Teramani*, WIPO Case No. D2004-0836 (December 1, 2004); *National Collegiate Athletic Association v. Dusty Brown*, WIPO Case No. D2004-0491 (August 30, 2004); *Lane-Labs USA, Inc. v. Powell Productions*, NAF Claim No. 155896 (July 1, 2003); and particularly *Cable News Network LP, LLP v. Elie Khouri d/b/a Channel News Network et al.*, NAF Claim No. 117876 (December 16, 2002).

Moreover, the likelihood that such confusion is occurring here is not only beyond any credible challenge but also may very well be exacerbated simply because Internet users, who are familiar with the Complainant's history, may well recognize that 1948 was the year in which the Complainant was founded. Such heightened confusion unquestionably benefits the Respondent at the ultimate detriment to the Complainant both in terms of its business and reputation.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's LONGCHAMP Marks; hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

## **B) Rights or Legitimate Interests**

Based on the evidence of record here, the Panel finds that no basis whatsoever exists which would appear to legitimize a claim by the Respondent, were it to have made one, to the disputed domain name under paragraph 4(c) of the Policy.

The Complainant has never authorized the Respondent to utilize any of its LONGCHAMP Marks in conjunction with any of the goods and services with which the Complainant uses those marks, nor does the Complainant apparently have any relationship, affiliation or association whatsoever with the Respondent. As such, any use to which the Respondent were to put the Complainant's LONGCHAMP marks or one confusingly similar thereto - as in the disputed domain name - in connection with the identical or even similar goods and services to those currently provided by the Complainant, as recited in any of its trademark registrations, would very likely (particularly in circumstances as are present here) violate the exclusive trademark rights now residing with the Complainant. See, e.g., *Burberry*, *HRB Innovations Inc.*, *Dreamworks*, *MySpace*, *Blackrock*, *F. Hoffmann-La Roche AG*, *National Football League*, *Toilets.com, Inc.*, and *Associated Bank*, all cited *supra*; also *Starline Publications, Inc. v. Unity*, WIPO Case No. D2008-1823 (February 2, 2009); *GoDaddy.com, Inc., v. GoDaddysDomain.com*, *Clark Signs*, *Graham Clark*, WIPO Case No. D2007-0303 (May 7, 2007); *Citgo Petroleum Corporation v. Richard Antinore*, WIPO Case No. D2006-1576 (March 14, 2007); *New Destiny Internet Group, LLC and Xplor Media, Inc. v. SouthNetworks*, WIPO Case No. D2005-0884 (October 14, 2005); *The Cheesecake Factory Inc.*, *Napster and Caesars Entertainment, Inc.*, all cited *supra*; *Pelmorex Communications Inc. v. weathernetwork*, WIPO Case No. D2004-0898 (December 28, 2004); *Sybase, Inc. v. Analytical Systems*, WIPO Case No. D2004-0360 (June 24, 2004); *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615 (September 30, 2003); *Leiner Health Services Corp. v. ESJ Nutritional Products*, NAF Claim No. 173362 (September 16, 2003); *AT&T Corp. v. Roman Abreu d/b/a Smartalk Wireless*, cited *supra*; *MPL Communications, Limited et al v. IWebAddress.com*, NAF Claim No. 97092 (June 4, 2001); *Treeforms, Inc. v. Cayne Industrial Sales, Corp.*, NAF Claim No. 95856 (December 18, 2000); and *America Online, Inc. v. Xianfeng Fu*,

WIPO Case No. D2000-1374 (December 11, 2000). Consequently, in the Panel's view, the Respondent could not legitimately acquire any public association between it and any of the LONGCHAMP Marks or one similar thereto, and certainly not for any of the goods and services provided by the Complainant under its marks.

Further, there is absolutely no evidence of record that the Respondent has ever been commonly known by the disputed domain name or more generally the term "LONGCHAMP" or a mark containing that term. Nor realistically, in the Panel's view, could the Respondent ever become commonly known by the disputed domain name without likely infringing on the exclusive trademark rights of the Complainant particularly given the longevity of the Complainant's LONGCHAMP Marks and the substantial worldwide recognition, reputation and fame which those marks have garnered well before - - decades before -- the March 5, 2011 date on which the Respondent registered the name. See, e.g., *Burberry*, *Starline Publications*, *HRB Innovations Inc.*, *MySpace* and *Treeforms, Inc.*, all cited *supra*.

Hence, based on the evidence before the Panel, the Respondent does not fall within paragraph 4(c)(ii) of the Policy.

Moreover, it is beyond any credible doubt whatsoever that the Respondent had actual knowledge of the Complainant's mark LONGCHAMP and the Complainant's exclusive rights in that mark at the time the Respondent registered the disputed domain name containing that mark. Yet, in spite of that knowledge, the Respondent proceeded to register the domain name and then offer counterfeit versions of the Complainant's products via a website resolvable through that name. The Panel infers, from the lack of any Response, that the Respondent's primary motivation in doing so was to create and then opportunistically exploit, for its own financial gain, inevitable user confusion by suggesting that an association, affiliation, sponsorship or other legitimate relationship existed between the parties and thus deceiving Internet users into believing that its products were, in some fashion, authorized versions of the Complainant's corresponding goods -- when, in fact, they were not and no legitimate connection existed between the parties. Inasmuch as such use is likely to directly infringe the Complainant's marks, it does not constitute a *bona fide* offering of goods or services, let alone one that occurred prior to receiving any notice of this dispute.

Consequently, the Respondent's conduct does not fall within paragraph 4(c)(i) or 4(c)(iii) of the Policy either.

Accordingly, the Panel concludes that the Respondent has no rights or legitimate interests in disputed domain name within paragraph 4(a)(ii) and 4(c) of the Policy.

### **C) Bad Faith Registration and Use**

The Panel finds that the Respondent's actions, with respect to the disputed domain name, constitute bad faith registration and use.

As noted above, it is beyond any credible doubt, from the Panel's perspective, that the Respondent was well aware of the Complainant's LONGCHAMP Marks when the former registered the disputed domain name. Yet, in spite of that knowledge, the Respondent intentionally registered the name as part of a deliberate, concerted effort to create ensuing confusion of Internet users and then opportunistically exploit that confusion by

misappropriating the Complainant's substantial, worldwide, long-term reputation it gained, through its marks, as a source of extremely high-quality consumer goods. This is plainly evident in the Respondent then having used the name as an address of its website, without any authorization and having no relationship whatsoever with the Complainant, through which the Respondent offered counterfeit versions of the Complainant's products for sale. Obviously, the Respondent did so for its own financial gain and the ultimate detriment of the Complainant, both in terms of causing it direct financial damage due to lost sales as well as injury to both its reputation and recognition in the marketplace. These actions clearly constitute bad faith registration and use.

Hence, the Panel concludes that the Respondent violated paragraph 4(a)(iii) of the Policy including specifically paragraphs 4(b)(iii) and 4b(iv) thereof.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to the disputed domain name, to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

## **6. Decision**

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant.

The disputed domain name, <longchamp1948.com>, is ordered transferred to the Complainant.

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Peter L. Michaelson, Esq.  
Panelist

Dated: June 27, 2011