



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

— A charitable institution limited by guarantee registered in Hong Kong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.: HK-1100378

Complainant : Autumnpaper Limited

Respondent : Wang Jinhua

Domain Name : (1) <alexander-mcqueen-shoes.com>
(2) <alexander-mcqueen-clutch.com>

1. THE PARTIES AND CONTESTED DOMAIN NAME

The Complainant is Autumnpaper Limited of Minerva House, Montague Close, London, SE1 9BB, United Kingdom. The authorised representative of the complainant in this matter is Mr Benjamin Cheong / Mr David Ma of Baker & McKenzie at 14th Floor, Hutchison House, 10 Harcourt Road, Hong Kong.

The Respondent is Wang Jinhua of hongqiao of shanghi, ShangHai City, ShangHai, CN 251008.

The domain names at issue (the “Disputed Domain Names”) are < alexander-mcqueen-shoes.com> and <alexander-mcqueen-clutch.com> registered on 18 May 2010 and 23 July 2010 respectively by the Respondent with China Springboard Inc.

2. PROCEDURAL HISTORY

A complaint in English in respect of the Disputed Domain Names (the “Complaint”) was filed with the Asian Domain Name Dispute Resolution Centre – Hong Kong Office (“ADNDRC-HK”) in terms of the prescribed Form C on 12 July 2011 pursuant to the Uniform Policy for Domain Name Dispute Resolution, approved by the Internet Corporation for Assigned Names and Numbers (“ICANN”) on 24 October 1999 (the “Policy”), the Rules for Uniform Domain Name Dispute Resolution Policy, approved by ICANN Board of Directors on 30 October 2009 (the “Rules”) and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

On 13 July 2011, ADNDRC-HK acknowledged the receipt of the Complaint and the relevant annexes. On the same day, the ADNDRC-HK sought and received confirmation on the registrant details from the registrar China Springboard Inc. with respect to the Disputed Domain Names.

According to the information from the registrar, the language of registration agreement is Chinese. Accordingly, on 14 July 2011, ADNDRC-HK requested the Complainant for the submission of a Chinese translation of the Complaint.

On 18 July 2011, the Complainant submitted the Supplement to Complaint (the “Supplement”) and Complaint Transmittal Coversheets in English and Chinese, requesting that the language of the proceedings be in English. In the Supplement, the Complainant drew the Panelist’s attention to the *WIPO Overview of WIPO Panel Views on Selected UDRP Questions*, Second Edition and the cases of *Beiersdorf AG v. Good Deal Communications* (WIPO Case No. D2000-1759), *Lacoste Alligator S.A. v. Xinpeng Liu* (WIPO Case No. D2009-0629), *Finter Bank Zurich v. Shumin Peng* (WIPO Case No. D2006-0432), *Guccio Gucci S.p.A. v. Domain Administrato - Domain Administrator* (WIPO Case No. D2010-1589), *Dr. Martens" International Trading GmbH, "Dr. Maertens" Marketing GmbH v. Lin Xiaodu* (WIPO Case No. D2010-2170), *Luxottica Group S.p.A. and Luxottica Fashion Brillen Vertriebs GmbH v. kaoe Monia aka / Mania Kaoe* (WIPO Case No. D2010-1569) and *Consitex S.A., Lanificio Ermenegildo Zegna & Figli S.p.A., Ermenegildo Zegna Corporation v. Jean Shi aka Jaye Corporation* (Case No. D2010-1466). In gist, the Complainant submits that:

- (i) the requirement of communicating the proposal of using English as the language in proceedings to the Respondent has been met by the Supplement through the availability of the Complaint Transmittal Coversheet in both English and Chinese;
- (ii) the Registration Agreement is published in both English and Chinese and the terms in the Registration Agreement do not stipulate that the Registration Agreement is in Chinese and that the English version is a translation only;
- (iii) the Disputed Domain Names are in the English language and the contents of the Websites at the infringing Disputed Domain Names are entirely in English, representing strong evidence that the Respondent is conversant and proficient in the English language; and

(iv) the Complainant is a foreign company not familiar with the Chinese language. As the exhibits are mostly in English, it would cause tremendous costs, time and unfair prejudice to the Complainant by requiring it to provide Chinese translations of all the evidence.

Subsequently, ADNDRC-HK wrote to the Complainant on 19 July 2011 to confirm that the Complaint process would continue and proceed. On the same day, the Complaint was sent to the Respondent by email and fax at the addresses as per the WHOIS database, notifying the Respondent about the commencement of the proceedings and requesting the Respondent to submit a response within 20 days, that is to say on or before 8 August 2011. However, no response was received within the required period of time.

On 18 August 2011, ADNDRC-HK confirmed with the parties that no response to the Complaint had been received and that panelist(s) would be appointed shortly to adjudicate on the matter. On the same day, Mr. Kenneth Chung, the candidate for the panelist, confirmed that he was available to act as a panelist in this matter and would be in a position to act independently and impartially between the parties.

On 19 August 2011, ADNDRC-HK informed the parties that Mr. Kenneth Chung had been appointed as the Sole Panelist in the case for the Disputed Domain Names. On the same day, ADNDRC-HK transferred the documents to the Panelist and requested a decision to be rendered by 2 September 2011.

3. FACTUAL BACKGROUND

For Complainant

The “Alexander McQueen” brand was founded by Lee Alexander McQueen in 1992. McQueen's collections combine an in-depth working knowledge of bespoke British tailoring, the fine workmanship of the French Haute Couture atelier and the impeccable finish of Italian manufacturing. In less than 10 years, McQueen became one of the most respected fashion designers in the world. Alexander McQueen has received widespread recognition and accolades.

In 2004 or thereabouts, Alexander McQueen assigned the “ALEXANDER MCQUEEN” trademarks to the Complainant. Alexander McQueen now operates various stores, including flagship stores, in New York, London, Milan, Las Vegas, Los Angeles and Japan, and franchise stores in the Middle East. Its products are also widely available in Hong Kong and the PRC, with annual sales of €1,500,000-3,500,000 and €320,000-960,000 respectively for each of 2008, 2009 and 2010.

Alexander McQueen has invested significant resources to promote its brand and products. Its products are often featured in top-notch fashion magazines and newspapers. Furthermore, Alexander McQueen operates an official website <www.alexandermcqueen.com> to market its latest products online. It has also launched an e-commerce section selling its products on its website to allow internet users to purchase genuine Alexander McQueen products online.

The Complainant has registered the “ALEXANDER MCQUEEN” trademarks in various classes worldwide including PRC and Hong Kong. In the Complaint, the Complainant has produced copies of some articles published in Hong Kong

and the PRC featuring the Complainant's products and the "Alexander McQueen" trademarks to serve as evidence of the fame of Alexander McQueen products and trademarks.

For Respondent

The Respondent registered the Disputed Domain Names <alexander-mcqueen-shoes.com> on 18 May 2010 for a duration of 2 years and <alexander-mcqueen-clutch.com> on 23 July 2010 for a duration of 1 year. Apart from the information shown on the WHOIS database, no further information about the Respondent is available.

4. PARTIES' CONTENTIONS

For Complainant

In September 2010, the Complainant discovered that a PRC individual named "Wang Tuo" has registered the Disputed Domain Names without its authorization. The Disputed Domain Names resolve to websites (the "Websites") featuring the Complainant's registered "ALEXANDER MCQUEEN" and "©" trademarks and also offering Alexander McQueen products for sale. The Complainant is of the view that the products offered therein are counterfeits. Despite the requests by the Complainant's agent, the Respondent did not respond to or comply with the Complainant's demand of transferring the Disputed Domain Names to the Complainant.

The Complainant submits that the Disputed Domain Names are identical or confusingly similar to the “Alexander McQueen” trademarks in which the Complainant has rights for the following reasons:

- (i) The Complainant has registered the “Alexander McQueen” trademark in various classes in Hong Kong and the PRC. The Complainant’s “Alexander McQueen” trademarks are famous and have acquired substantial goodwill through extensive promotion and use by Alexander McQueen and the Complainant;
- (ii) The Disputed Domain Names, “Alexander-McQueen-Shoes.com” and “Alexander-McQueen-Clutch.com”, consist of three parts:
 - (a) The first part of the Disputed Domain Names, “Alexander-McQueen”, is identical to the Complainant’s registered trademark “Alexander McQueen”. A hyphen in the domain name does not render it different from the trademark. The Complainant invites the Panelist to consider *France Telecom SA v. France Telecom Users Group* (WIPO Case No D2002-0144), in which “france-telecom” was found to be identical to “France Telecom”).
 - (b) The second part of the Disputed Domain Names is the English word “Shoes” and “Clutch” respectively. Taken in conjunction with a fashion brand, the meaning of “Shoes” and “Clutch” obviously refer to footwear and handbags. These are generic words related to fashion retail, which is an industry that the Complainant operates in. The Complainant relies on the Merriam-Webster online dictionary. According to the Complainant, it is well-established that a domain name composed of a trademark coupled with a generic term is still confusingly similar to the trademark. Further, the addition of generic words is especially confusing where the generic words bear an obvious relationship to Complainant's business. The Complainant relies on a list of cases to support its submission namely *Yahoo! Inc.*

v. Hangzhou Hi2000 InfoTech Co. Ltd. a/k/a Hangzhou Shixin Info Tech Co. Ltd. (NAF Claim Number: FA0301000141825), *Foot Locker, Inc. v. Blezin Widmaer*, (NAF Claim Number: FA0205000113283), *FEIYUE v. Ren qijian* (WIPO Case No. D2010-0023), *Lacoste Alligator S.A. v. Major Shopping Network Ltd* (WIPO Case No. D2006-1599), *Christian Dior Couture v. Carl Lim* (WIPO Case No. D2008-1038) and *Chanel Inc. v. Bontempo* (WIPO Case No. D2002-0721). The Complainant submits that the words “shoes” and “clutch” are insufficient to distinguish the Disputed Domain Names from the Complainant’s registered trademark. In fact, the word words “shoes” and “clutch” are generic words that bear an obvious relationship to the Complainant’s business and may mislead internet users into believing that the Disputed Domain Names resolve to websites which offers genuine Alexander McQueen products for sale.

- (c) The third part of the Disputed Domain Names, “.com”, is a generic top-level domain name (gTLD) suffix. It is non-distinctive and is incapable of differentiating the Disputed Domain Names from the Complainant’s registered trademark. The Complainant attached the case of *Pomellato S.p.A v. Tonetti*, (WIPO Case No. D2000-0493) for the Panelist’s reference.

Further, the Complainant submits that the Respondent has no legitimate rights or interests in the Disputed Domain Names. In gist, the Complainant argues that:

- (i) The Respondent’s name is “wang jinhua” but not “Alexander McQueen”. Therefore, the Respondent is not commonly known by the Disputed Domain Names.
- (ii) The Respondent’s use of the Alexander McQueen trademark in the Disputed Domain Names is unauthorized because the Respondent:

- (a) has never been authorized as a sales representative of Alexander McQueen;
 - (b) has never been licensed to use the “Alexander McQueen” trademark or any other trademarks belonging to the Complainant;
 - (c) has never been expressly or impliedly approved to resell Alexander McQueen products on the Websites; and
 - (d) is using the Complainant’s trademark as a domain name to bring people to the website that offers counterfeit Alexander McQueen products. The Complainant refers the Panelist to the case *Pitney Bowes Inc. v. Mike Ostanik*, (WIPO Case No. D2000-1611)
- (iii) Furthermore, the Respondent has not used the Disputed Domain Names in connection with a bona fide offering or goods or services as the websites offer products which are identified to be counterfeits. The Disputed Domain Names and the design of the Websites, including use of marks identical to the Complainant’s trademarks are very likely to mislead users into believing that the Websites are operated or authorized by the Complainant, or that they are buying genuine products originating from Complainant. The Complainant relies on *Microsoft Corporation v. Microsof.com aka Tarek Ahmed*, (WIPO Case No. D2000-0548).
- (iv) The Complainant submits that the Respondent has deliberately used the Complainant’s trademarks in a domain name to attract users to the Websites through confusion for commercial gain and not using the Disputed Domain Names in a bona fide way. The Complainant invites the Panelist to consider *AltaVista Company v. Saeid Yomtobian* (WIPO Case No. D2000-0937).

The Complainant submits that the Disputed Domain Names have been registered and are being used in bad faith. The Complainant's "Alexander McQueen" trademarks have been registered, advertised and used widely and intensively, and have become well-known amongst the consumers globally and in Hong Kong and the PRC. The Respondent has nevertheless chosen to register the Complainant's well-known "Alexander McQueen" trademark as the distinctive part of a domain name with no authorization and no legitimate purpose. The Complainant relies on *The Caravan Club v. Mrgsale* (NAF Case No. FA0007000095314) that this reveals a sign of bad faith.

The Complainant further says the Respondent was using telephone number and supplied false information for registration of the Disputed Domain Names, in contravention of the Policy and the Registration Agreement. By relying on *Telstra Corporation Limited v. Nuclear Marshmallows*, (WIPO Case No. D2000-0003), the Complainant submits that the Disputed Domain Names have been registered in bad faith.

The Complainant also says that the Disputed Domain Names resolve to the Websites offering counterfeit Alexander McQueen products for sale and the Respondent clearly has intended to attract, for commercial gain, internet users to the Websites by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the Websites and related products. Relying on *ZRT Laboratory, LLC v. Texas International Property Associates*, (NAF Claim Number: FA0701000907499).

By WHOIS search, the Complainant has also found that the Respondent has registered at least 40 other domain names with other trademarks such as "Christian Louboutin" and infers that the Respondent has registered the domain

name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name.

The Complainant goes further to say that the Respondent has deliberately ignored the cease and desist letter sent by the Complainant's agent and has failed, neglected and/or refused to take steps to transfer the Disputed Domain Names to the Complainant. It relies on *Advance Magazine Publishers Inc. v. Moniker Privacy Services, Registrant, Registrant info@fashionid.com / Registrant*, (WIPO Case No. D2009-0801) to say that it is a sign of bad faith.

In the circumstances, the Complainant asked for the transfer of the Disputed Domain Names to the Complainant.

For Respondent

The Respondent did not file in any response within the stipulated period of time.

5. DISCUSSION AND FINDINGS

Language of the Proceedings

Article 11 of the Rules provides that, 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 Panel may order that any documents submitted in languages other than the language of the administrative

proceeding be accompanied by a translation in whole or in part into the language of the administrative proceeding.

Article 10 of the Rules provides that the Panel shall conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and these Rules.

In the present case, the Complainant is a foreign company not familiar with the Chinese language. All communications between the parties and ADNDRC-HK and the ADNDRC-HK and the sole Panelist were also in English. The complaint was made in English. No response was filed from the Respondent after it was informed with the Complaint Transmittal Coversheet in both English and Chinese. Further, the Disputed Domain Names are in the English language and the contents of the Websites are also entirely in English. The Panel agrees that it is a strong evidence that the Respondent is conversant and proficient in the English language. For the reasons above, the Panel finds that these facts make it appropriate to adopt English as the language of the proceedings.

Merits of Complaint

According to Article 4(a) of the Policy, it is the complainant who bears the burden of proving that:

- (i) the respondent's domain name is 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.

Further, Article 14 of the Rules provides that:

- (a) in the event that a Party, in the absence of exceptional circumstances, does not comply with any of the time periods established by these Rules or the Panel, the Panel shall proceed to a decision on the complaint;
- (b) if a Party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, these Rules or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate.

The Respondent has not filed or submitted any response to the Complaint. In this case, the Panel can find no exceptional circumstances under Article 14(a) or Article 14(b) of the Rules present. Accordingly, the Panel shall proceed to determine the dispute and draw such inferences therefrom as it considers appropriate.

Whether Identical Or Confusingly Similar To A Trademark Or Service Mark In Which The Complainant Has Rights

The Complainant submits that the Disputed Domain Names are identical or confusingly similar to the "Alexander McQueen" trademarks in which the Complainant has rights.

The Complainant has registered the “ALEXANDER MCQUEEN” trademarks in various classes worldwide including PRC and Hong Kong. The Panel accepts that, from the documents of the Complainant, the Complainant was with rights over the “Alexander McQueen” mark or name. There were trademark registrations back in 1997 and 2000 and some valid through 2020. The Respondent has neither made any submission nor produced any evidence to the contrary.

The Panel has considered the name or mark “alexander-mcqueen” and is satisfied that it is not in the daily use of the language but a very specific name instead. While “shoes” and “clutch” are generic words and in common daily use of the language, their association with the name or mark “alexander-mcqueen” does not in any way distinguish it from the trademark. The Panel agrees that a domain name composed of a trademark coupled with a generic term is still confusingly similar to the trademark. In particular, the words “shoes” and “clutch” are obviously referring to footwear and handbags when they are taken in conjunction with a fashion brand in a fashion retail which the Complainant operates in. The Panel agrees that the addition of generic words is especially confusing where the generic words bear an obvious relationship to Complainant's business.

Therefore, the distinctive part of the Disputed Domain Names is “alexander-mcqueen” and the Panel finds it identical or confusingly similar to the name or the mark of “Alexander McQueen”. Further, the Panel does not see that the adding of the hyphen “-” between the two words in the Disputed Domain Names would suffice to render it as distinctive from the “Alexander McQueen” mark or name.

The Panel also agrees that the part of the Disputed Domain Name “.com” is a generic top-level domain name (gTLD) and it is non-distinctive and is incapable of differentiating the Disputed Domain Names from the Complainant’s registered trademark.

In the circumstances, the Panel finds that the Complainant has proved that it has acquired rights over the name or mark of “Alexander McQueen” as required under the Policy and the Complainant has discharged the burden on its part to establish this element under Article 4(a)(i) of the Policy.

Whether The Respondent Has No Rights Or Legitimate Interests In Respect Of The Domain Name

The Complainant submits that the Respondent has no legitimate rights or interests in the Disputed Domain Names.

Article 4(c) of the Policy provides that the respondent may demonstrate its rights or legitimate interests to the domain name for purposes of Article 4(a) (ii) by the following:

- (i) before any notice to the respondent of the dispute, the respondent’s use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

- (ii) the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent is an individual whose name is “wang jinhua”. From the Respondent’s name, the Panel notices no direct link between it and the distinctive part of the Disputed Domain Names.

The Complainant also alleges that the Respondent has never been authorized or licensed or approved to use the “Alexander McQueen” trademark as part of its domain name or to resell Alexander McQueen products on its website. To all the various allegations from the Complainant regarding the Respondent having no right in the Disputed Domain Name, the Respondent makes no submission at all or produces no evidence to the contrary.

The Complainant goes further to allege that the Websites offer products which are identified to be counterfeits and therefore the Respondent has not used the Disputed Domain Names in connection with a bona fide offering of goods or services. To this serious allegation, again there is no submission or evidence to the contrary from the Respondent.

Considering the overall evidence in front of the Panel, the Panel can find no evidence to support a finding of any of the circumstances in Article 4(c) of the

Policy. Therefore, the Panel accepts that the Complainant has proved that the Respondent has no right or legitimate interests in respect of the Disputed Domain Names as required under Article 4(a)(ii) of the Policy.

Whether The Respondent's Domain Name Has Been Registered And Is Being Used In Bad Faith

Article 4(b) of the Policy, for the purposes of Article 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent has registered or the respondent has 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 the respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has 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 the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, internet users to the respondent's web site 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 the respondent's web site or location or of a product or service on the respondent's web site or location.

From the evidence in front of the Panel, the Panel notices that the Complainant has registered the "Alexander McQueen" trademark in Hong Kong and PRC over some 10 years before the Disputed Domain Names were registered. According to the Complainant, the "Alexander McQueen" trademarks have been registered, advertised and used intensively and become well-known globally and in Hong Kong and the PRC. The Respondent has nevertheless registered the well-known trademark while it has with no connection to the owner of the trademark and no authorization and no legitimate purpose to utilize the mark. The Panel agrees that this reveals a sign of bad faith.

With respect to the Complainant's allegation that the Disputed Domain Names resolve to the Websites which offer counterfeit Alexander McQueen products for sale, there is no submission or evidence to the contrary from the Respondent. Similarly, the Respondent offers no response to the Complainant's allegation that the Respondent has intended to attract, for commercial gain, internet users to the Websites by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the Websites and related products.

Overall, in the absence of contrary submission or evidence from the Respondent and explanation from the Respondent as regards why it chose the Disputed Domain Names while having no rights over it, the Panel finds that, in all the circumstances, the Respondent was with knowledge of the Complainant's name or mark when it registered the Disputed Domain Names. The Panel accepts that

the Respondent has clear intention to attract, for commercial gain, internet users to the Websites by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the Websites and related products as described in Article 4(b)(iv) of the Policy. Accordingly, the Panel is satisfied that the Complainant has discharged its burden of proof for the Respondent's bad faith as required in Article 4(a)(iii) of the Policy.

6. PANEL DECISION

Having considered the evidence before the Panel and for the reasons of the findings as set out above, the Panel finds that the Complainant has succeeded in proving the presence of all of the 3 elements of Paragraph 4(a) of the Policy. Therefore, the Complaint succeeds and the Panel hereby directs the transfer of the Disputed Domain Names, namely < alexander-mcqueen-shoes.com > and <alexander-mcqueen-clutch.com>, to the Complainant.

A handwritten signature in black ink, appearing to be 'Kenneth Chung', written in a cursive style.

Kenneth Chung

Sole Panelist

Date: 29 August 2011

Hong Kong