



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-1200463

COMPLAINANT: WAY FUNKY COMPANY PTY LTD

RESPONDENT: HUANGLITECH

1. The parties and contested domain name

The Complainant is Way Funky Company Pty Ltd of Suite 2/19-29 Cromwell Street Collingwood, Victoria 3066, Australia, a company incorporated in Australia and represented by Matthew Prescott, Thomsons Lawyers, Level 7, 19 Gouger Street, Adelaide, South Australia 5000, Australia.

The Respondent is HUANGLITECH of Shenzhen Anlian Centre, Level 26, 2222 Jin Tian Road, Shenzhen, Futian District 518026, China.

The contested domain name is <funkita.com>, registered with Above.com Pty Ltd, 8 East Concourse, Beaumaris, VIC., 3193, Australia.

2. Procedural history

The Complaint was filed with the Asian Domain Name Dispute Resolution Centre ("the Centre") on October 4, 2012. On October 10, 2012, the Centre transmitted by email to Above.com Pty Ltd by email a request for registrar verification in connection with the disputed domain name. On October 12, 2012, Above.com Pty Ltd transmitted by email to the Centre its response that the registrant of the disputed domain name was the Respondent, namely HUANGLITECH and that, *inter alia*, the registration of the domain name would expire on October 15, 2012. Pursuant to the registrar's response, on October 30, 2012, the Amended Complaint herein was filed with the Centre, naming the Respondent as HUANGLITECH. On November 29, 2012, the Centre notified the Complainant by email that the registration of the domain name was expired and that pursuant to Paragraph 3.7.5.7 of ICANN's Expired Domain Deletion Policy, the Complainant had the option to renew or restore the name under the same commercial terms as

the registrant. On November 29, 2012 the Centre was advised by email from the registrar that the Complainant had renewed the registration of the domain name until October 15, 2013. The Center verified that the Amended Complaint filed with it on October 30, 2012 satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules"). In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 31, 2012. In accordance with the Rules, paragraph 5(a), the due date for Response was November 20, 2012.

No Response was received from the Respondent by the Centre.

The Center appointed The Honourable Neil Anthony Brown QC as panelist in this matter on December 5, 2012. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

3. Factual Background

Since 2004 the Complainant (and its affiliated entities) have continuously used, and continue to use, the FUNKITA Mark in connection with women's swimwear and related goods and services worldwide. The Complainant has an international sales and marketing network for its Funkita products, selling to retail stores in 15 countries, including Australia, USA, UK, various European countries and Singapore. The Complainant also sells to online retailers worldwide and through its own online retail store. The Complainant has registered 40 domain names containing "funkita", including funkita.com.au, funkita.net and funkita.org (which all redirect to the Complainant's website www.wayfunky.com/funkita/), and a Google search for "funkita" contains results almost exclusively for the Complainant's products. The Complainant promotes its Funkita products through catalogues, media appearances, sponsorship (including the Australian Olympic synchronized swimming team) and, since late 2007, on its "Funkita" facebook page. The Complainant maintains that Funkita swimwear is well known for its unique and vibrant prints, sculptured designs and premium quality. The Complainant has acquired valuable rights and substantial goodwill in the FUNKITA Mark, and has registered it in Australia and the USA.

The Respondent registered the domain name on October 14, 2009.

The domain name resolves to a website displaying mainly sponsored links to third party websites that are predominantly swimwear websites advertising products of the Complainant's competitors.

4. Parties' Contentions

(a) Complainant

The Complainant made the following contentions:

1. The Disputed Domain Name is identical or confusingly similar to the FUNKITA Mark. The only difference versus the Complainant's FUNKITA mark is the inclusion of the generic top-level domain ".com". This inclusion does not prevent the Domain Name from being identical to the FUNKITA mark for the purposes of Paragraph 4(a) (i) of the UDRP. This is confirmed in decisions such as *Arthur Guinness Son & Co. (Dublin) Limited v. Dejan Macesic*, D2000-1698 (WIPO January 25, 2001) and *ChipMOS TECHNOLOGIES INC. v. Charles Yeh* HK-0600083 (ADNDRC July 3, 2006), where the respective Panelist found that the suffix ".com" is of no significance in assessing the identity of a domain name for the purposes of paragraph 4(a)(i) of the UDRP. In the alternative, the Domain Name is confusingly similar to the FUNKITA mark as the Domain Name incorporates the entirety of the mark. This finding is consistent with the decision in *SoftCom Technology Consulting Inc. v. Olariu Romeo/Orv Fin Group S.L.* D2008-0792 (WIPO July 8, 2008), where the Panelist held that a domain name which incorporates the entirety of a Complainant's mark is sufficiently similar to that mark to be confusingly similar.
2. The Domain Name is likely to cause confusion among consumers and Internet users interested in the Complainant's products. It is probable that such consumers will enter "funkita.com" into a web browser, expecting to find information about the Complainant and/or its swimwear products, but instead be brought to the Respondent's website (this could be due to mistakenly entering one of the Complainant's registered domains, such as funkita.net or funkita.com.au). This may mislead consumers into thinking that the Respondent's website is associated with the Complainant, especially as "Funkita" is a distinctive word and the Respondent does not use any terms in the Domain Name to distinguish it from the FUNKITA Mark.
3. The Respondent's use of the Domain Name is not in connection with a bona fide offering of goods or services by the Respondent. Rather, the Respondent is seeking to profit from the Complainant's goodwill by providing sponsored links to third party websites (predominantly swimwear websites);
4. The Respondent has never (to the complainant's knowledge) been commonly known by the Domain Name (if they had, the Complainant would have been aware of this as the Complainant carefully monitors the use of its trade marks by unauthorised third parties);
5. The Respondent is not making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to

tarnish the FUNKITA Mark. The Respondent is intentionally diverting customers to the Respondent's website by misleading them with the Domain Name, which is identical or confusingly similar to the FUNKITA Mark. This is not a legitimate noncommercial or fair use of the Domain Name. Rather, the Respondent is capitalising on the goodwill of the FUNKITA Mark. The Respondent is using the Domain Name, which is identical or confusingly similar to the FUNKITA Mark, solely as a vehicle to mislead and/or draw Internet users to its website in order to profit from sponsored links. The Respondent is creating a likelihood of confusion with the FUNKITA Mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. Use of a website as a parking website containing pay-per-click third-party links (such as the Respondent's website) does not confer rights or legitimate interests arising from a bona fide offering of goods or services. This was found in *Donald J. Trump v. Mediaking LLC d/b/a Mediaking Corporation and Aaftek Domain Corp* D2010-1404 (WIPO October 16, 2010). The Respondent's use of the Funkita Mark in association with these services creates a false association or perception that the Complainant is related to the Respondent, the Respondent's website, or the third parties referenced on the website, when, in fact, no such association exists. The Complainant has not authorised, licensed, endorsed or otherwise permitted the Respondent to register or use the Domain Name or to use the FUNKITA Mark in relation to a business name or otherwise. In addition, the association of these third party sites with the Complainant and the FUNKITA Mark tarnishes the FUNKITA Mark and its associated goodwill.

6. The disputed domain name has been registered and is being used by the Respondent in bad faith. The Complainant submits that the Respondent is using the Domain Name, which is identical or confusingly similar to the FUNKITA Mark, solely as a vehicle to misleadingly draw Internet users to its website in order to profit from the sponsored links. The Complainant also submits that the Respondent is creating a likelihood of confusion with the FUNKITA Mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. Paragraph 4(b) (IV) of the UDRP provides that these circumstances are evidence of the registration and use of a domain name in bad faith. This is also similar to the circumstances in *Choice Hotels International, Inc v Anna Valdieri* FA0607000758830 (NAF August 23, 2006), which found that bad faith is made out where a domain name resolves to a commercial search engine displaying various links to third-party websites and it can be presumed that the Respondent is receiving "click-through" fees for diverting Internet users through these links and is taking advantage of the confusing similarity between the disputed domain name and the Complainant's trade mark in order to profit from the goodwill associated with the trade mark. A similar finding of bad faith was made in *Forest Laboratories, Inc. v. Jeff Brown* D2008-0412 (WIPO May 7, 2008). It can be presumed from the layout and content of the Respondent's website that the Respondent's intention in its registration and use of the Domain Name has been to divert Internet users to the Respondent's website and thereby receive "click-

through" fees. "Funkita" is a distinctive term rather than a descriptive term (and a Google search suggests it is used almost exclusively as the Complainant's trade mark), so the Respondent's choice to use "Funkita" in the Domain Name was most probably motivated by an intention to target the Complainant's FUNKITA Mark.

7. At the time of registration of the Domain Name, the Respondent was on notice, or knew or should have known, of the Complainant's use and registration of the FUNKITA Mark. If the Respondent had performed a basic trade mark investigation at the time of registration of the Domain Name, the Respondent would have been alerted to registrations and pending registration applications for the FUNKITA Mark. Additionally, a basic Google search at the time of registration of the Domain Name for "Funkita" would have alerted the Respondent to the use of the FUNKITA Mark by the Complainant.

8. Accordingly, the Panel should make an order for the transfer of the Disputed Domain name from the Respondent to the Complainant.

(b) Respondent.

The Respondent did not make a submission in this proceeding.

3. Discussion and Findings

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements in respect of the Disputed Domain Name to obtain an order that a domain name should be transferred:

- (i) 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
- (ii) that the Respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) that the domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The first issue that arises is whether the Complainant has a trademark or service mark on which it can rely. The Complainant has adduced evidence, that the Panel accepts, showing that it has trademark rights in the trademark FUNKITA, Registration No. 1176153, registered with IP Australia on May 15, 2007 USPTO ("the FUNKITA mark."). It is not the registered proprietor of the trademark, which is in the name of Way Funky Holdings Pty Ltd, a company that the Complainant has stated is an affiliated entity of the Complainant, giving rise to rights in the

trademark on behalf of the Complainant. The Policy requires that the Complainant “has rights” in the trademark that it relies on, not that it is the registered proprietor of the trademark.

Having regard to the submissions of the Complainant and the evidence, the Panel finds that the Complainant has rights in the FUNKITA trademark. Nor is it required by the Policy that there be evidence that the Complainant has trademark rights in the country where the Respondent is domiciled: *See See Koninklijke KPN N.V. v. Telepathy Inc.*, D2001-0217 (WIPO May 7, 2001) (finding that the Policy does not require that the mark be registered in the country in which the respondent operates and it is sufficient that the complainant can demonstrate a mark in some jurisdiction). The Complainant has also adduced evidence of other trademark registrations for FUNKITA in which the Complainant has rights, but the evidence of the trademark referred to above is sufficient. Therefore, the Panel finds that Complainant has established rights in the FUNKITA mark under paragraph 4(a)(i) of the Policy.

The second question that arises is whether the Disputed Domain Name is identical or confusingly similar to the FUNKITA trademark. The domain name consists of the FUNKITA trademark in its entirety, to which has been added the generic top level domain “.com.” The generic top level domain “.com” is disregarded for the purpose of making this comparison between the Disputed Domain Name and the trademark. In the present case, the objective internet user would find the Disputed Domain Name identical to the FUNKITA mark and the Panel so finds.

The Complainant has therefore made out the first of the three elements that it must establish.

B. Rights or Legitimate Interests

It is now well established that the onus is on the Complainant to make out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. If a *prima facie* case is made out, the onus then shifts to the Respondent to rebut that *prima facie* case: *See Hanna-Barbera Prods., Inc. v. Entm't Commentaries*, FA 741828 (Nat. Arb. Forum Aug. 18, 2006) and *AOL LLC v. Gerberg*, FA 780200 (Nat. Arb. Forum Sept. 25, 2006).

The Panel finds that the Complainant has made out a *prima facie* case which arises from the following considerations:

- (a) Respondent has chosen to take Complainant’s FUNKITA trademark and to use it in its domain name;
- (b) Respondent has then used the domain name to resolve to a website displaying mainly sponsored links to third party websites that are predominantly swimwear websites advertising products of the Complainant’s competitors;

(c) The Respondent has engaged in these activities, including the adoption of the Complainant's trademark, without the consent or approval of the Complainant;

(d) The Complainant submits and the Panel accepts on the evidence that the Respondent's use of the Domain Name is not in connection with a *bona fide* offering of goods or services by the Respondent. Rather, the Respondent is seeking to profit from the Complainant's goodwill by providing sponsored links to third party websites that are predominantly swimwear websites;

(e) The Complainant submits and the Panel accepts on the evidence that the Respondent has never been commonly known by the Disputed Domain Name;

(f) The Complainant submits and the Panel accepts on the evidence that the Respondent is not making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to divert consumers misleadingly or to tarnish the FUNKITA Mark. The Respondent is using the Disputed Domain Name, which is identical or confusingly similar to the FUNKITA Mark, solely as a vehicle to mislead and/or draw Internet users to its website in order to profit from sponsored links.

All of these matters go to make out the *prima facie* case against Respondent. As Respondent has not filed a Response or attempted by any other means to rebut the *prima facie* case against it, the Panel finds that Respondent has no rights or legitimate interests in the disputed domain name.

Complainant has thus made out the second of the three elements that it must establish.

C. Registered and Used in bad faith

It is clear from the provisions of the Policy that the Complainant must establish that the disputed domain name was registered in bad faith and that it is being used in bad faith: *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. 02000-0003. It is also clear that that case must be established on the balance of probabilities.

Further guidance on how to implement this requirement is to be found in paragraph 4(b) of the Policy, which sets out four circumstances, any one of which is evidence of the registration and use of a domain name in bad faith. It is also clear that the criteria set out in paragraph 4 (b) of the Policy for establishing bad faith are not exclusive, but that Complainants in UDRP proceedings may also rely on conduct that is bad faith within the generally accepted meaning of that expression.

The four specified criteria are:

(i) circumstances indicating that [the respondent has] registered or [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] website or other on-line location, by creating a likelihood of confusion with the complainant's trademark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website or location or of a product or service on [the] website or location.

The Complainant relies on the criteria set out in sub-paragraphs (iv) and that the overall conduct of the Respondent in this matter shows bad faith registration and use. The way in which the Complainant makes out its case is set out above and there is no need to repeat it here. The Panel finds that the Complainant has made out its case under sub-paragraph (iv) and also generally. The Panel finds that by using the Disputed Domain Name by linking it to a website that in turn carried links to products in competition with the products of the Complainant, the Respondent intentionally attempted to attract internet users to its website and the websites to which it was linked by creating the likelihood of confusion with the FUNKITA mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website and the other websites and the competing products promoted on them.

The Panel finds also that this was the intention of the Respondent at the time it registered the Disputed Domain Name and that accordingly it registered the Disputed Domain Name in bad faith.

Moreover, there was an obligation on the Respondent before registering the domain name to ensure that it was not trespassing on the intellectual property rights of any other party. That obligation is contained in paragraph 2 of the Policy, which provides as follows:

"2. Your Representations. By applying to register a domain name, or by asking us to maintain or renew a domain name registration, you hereby represent and warrant to us that (a) the

statements that you made in your Registration Agreement are complete and accurate; (b) *to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party*; (c) you are not registering the domain name for an unlawful purpose; and (d) you will not knowingly use the domain name in violation of any applicable laws or regulations. *It is your responsibility to determine whether your domain name registration infringes or violates someone else's rights.*"

That requirement was a provision of the registrar agreement between the Respondent and the registrar it was using to acquire the domain name and the Respondent was bound by it. Clearly, the Disputed Domain Name infringes the rights of the Complainant, as the whole of its trademark FUNKITA is included in the domain name which is as clear a statement as it is possible to contemplate that it is an official domain name of the Complainant and that it will lead to an official website of the Complainant. Accordingly, the Respondent registered the Disputed Domain Name in breach of the registration agreement and thus in bad faith.

As the Complainant submits, if the Respondent had performed a trade mark search at the time of registration of the Domain Name, it would have been alerted to trademark registrations and pending registration applications for the FUNKITA Mark. Additionally, as the Complainant also submits, a Google search at the time of registration of the Domain Name for "Funkita" would have alerted the Respondent to the use of the FUNKITA Mark by the Complainant. The Respondent must therefore be assumed not to have conducted either of these searches or to have conducted them and ignored the results.

Finally, in addition and having regard to the totality of the evidence, the Panel finds that, in view of Respondent's registration of the disputed domain name using the FUNKITA mark and in view of the conduct that Respondent engaged in when using it, the Respondent registered and used the Disputed Domain Name in bad faith within the generally accepted meaning of that expression.

Complainant has thus made out the third of the three elements that it must establish.

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be GRANTED.

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 <funkita.com> be transferred from the Respondent to the Complainant.

Panelist: The Honourable Neil Anthony Brown QC

DATED: December 7, 2012