



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

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Decision Submission

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| Decision ID | DE-0600085 |
| Case ID | HK-0600098 |
| Disputed Domain Name | www.yafriro.com |
| Case Administrator | Dennis CAI |
| Submitted By | M Scott Donahey |
| Participated Panelist | M Scott Donahey |

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| Date of Decision | 11-11-2006 |
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The Parties Information

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|-------------------|--------------------------------|
| Claimant | Yafriro International PTE Ltd. |
| Respondent | Pierce |

Procedural History

The complainant in this case is Yafriro International PTE Ltd., a corporation organized under the laws of the Singapore, whose address is 290 Orchard Road #18-11/12 Singapore (“Complainant”). Their authorized representative in these proceedings is Lau Kok Keng, Chen Xinping, Rajah & Tann.

The respondent is Pierce, whose address in Whois is Suite 8-7A, 8th Floor, Bangunan Lim 803-817, Batu 4 ½ Kuala Lumpur, Kuala Lumpur, Malaysia 51200 (“Respondent”). Respondent has not appointed any representative in these proceedings.

The domain name in dispute is <yafriro.com>. The Registrar of the domain name is Web Commerce Communications Limited, d/b/a Webnic.CC, which is located in Kuala Lumpur, Malaysia (the Registrar.)

On 14 August 2006, pursuant to the Uniform Domain Name Dispute Resolution Policy (“the Policy”), the Rules for the Uniform Domain Name Dispute Resolution Policy (“the Rules”) and Hong Kong International Arbitration Centre Supplemental Rules (“the HKIAC Supplemental Rules”), the Complainant submitted a complaint in the English language to the Hong Kong International Arbitration Centre (the “HKIAC”), an office of the Asian Domain Name Dispute Resolution Centre and elected this case to be dealt with by a one-person panel. On 14 August 2006, the HKIAC 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 HKIAC Supplemental Rules. All correspondence to and from the HKIAC described herein was in the English language.

On 19 August 2006 the HKIAC forwarded a copy of the complaint to the Respondent and to the Registrar for verification that the Whois information regarding the Respondent was correct. On 21 August 2006 HKIAC received confirmation from the registrar that the Whois information was correct.

On 2 September 2006 the HKIAC notified the Respondent of the commencement of the action.

On 29 September 2006 HKIAC notified the parties of Respondent’ s failure to submit a Response.

Since the Respondent did not file a response in accordance with the time specified in the Rules the HKIAC Supplemental Rules, and the Notification, the HKIAC informed Complainant and Respondent by email about the default, stating that, as Respondent did not file a response within the required time, the HKIAC would appoint the panelist to proceed to render the decision, in the absence of a response by Respondent.

On 12 October 2006, the HKIAC notified the parties that the Panel in this case had been selected, with M. Scott Donahey 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 13 October 2006, the Panel received the file from HKIAC.

Factual Background

For Claimant

Complainant has been operating as a business since 1995 and started in the business of retailing luxury watches in 1999. Complainant has outlets in Singapore, Kuala Lumpur, Jakarta and Bangkok. Complainant holds registered trademarks dating back to July 1, 2003 for the marks YAFRIRO WATCH BAND and YAFRIRO below which is CELEBRER LE TEMPS in much smaller letters. The marks have been registered in Hong Kong, Japan, Singapore, Australia, Brunei, China, and Indonesia. Complaint, Annex B. Despite the fact that the first of Complainant's trademarks did not issue until July of 2003, Complainant's business was well known enough to have two articles written on the derivation of the name "Yafriro," the earliest of which was published on 30 July 2002. Complaint, Annex J.

Complainant has used the business name YAFRIRO continuously since 1995. The mark is a fanciful one, created by the proprietor of the company from parts of the first names of three individuals who played a prominent role in his development as a businessman. Complainant has expended significant amounts on advertising and marketing to promote the YAFRIRO mark. Complainant submitted copies color full paged advertisements which appeared in magazines targeted for the affluent consumer market. Complaint, Annex G.

Respondent registered the domain name at issue on 1 February 2003. Complaint, Annex C. The domain name at issue does not, and apparently has not, resolve to a web site. The address and telephone number listed in the Whois corresponded to the address of Exxlenet Solutions Pte Ltd ("ESPL") in Singapore. In October 2005, Claimant wrote to ESPL requesting that the domain name at issue be transferred to Complainant. Complainant received no response.

When Complainant conducted a further search on or about 1 November 2005, Complainant discovered that the address had been changed. On 2 November 2005, requesting that the domain name at issue be voluntarily transferred to it. It made additional requests in emails dated 16 March 2006 and 20 March 2006. Complaint, Annex D. No response was ever received to these communications.

Complainant had his solicitors send a letter dated 19 May 2006 to the new address. Complaint, Annex A. This time Complainant received a responsive letter dated 23 May 2006 from MBBC Solutions Sdn Bhd ("MBBC"), stating that that entity was not the registrant of the domain name at issue, but that it was registered by a client of MBBC. MBBC volunteered to serve as a conduit for communications from Complainant concerning the domain name. Id.

On or about 8 June 2006, Complainant's solicitors again wrote MBBC, requesting contact information for the MBBC client who had registered the domain name at issue. MBBC replied by email dated 17 June 2006 stating that MBBC was not obligated to disclose its client's contact details and that MBBC's client had instructed that it not provide the details. Complaint, Annex A.

For Respondent

Respondent has failed to file a response in this matter.

Parties' Contentions

Claimant

Complainant asserts that the domain name at issue is identical or confusingly similar to Complainant's marks in that YAFRIRO is the dominant element in Complainant's mark and the domain name at issue is comprised of the YAFRIRO mark with the addition of the gTLD .com.

Complainant further alleges that Respondent has no rights or legitimate interests in respect of the domain name in that Claimant has not authorized Respondent to use its trademark in any way and that Respondent could have no rights or legitimate interests in YAFRIRO, since the name was created by Complainant from parts of the names of three people known personally to him and is completely fanciful.

Respondent's domain name has been registered in bad faith and is being passively used in bad faith.

Respondent

The respondent did not file a response within the stipulated time.

Findings

Identical / Confusingly Similar

Paragraph 15(a) of the Uniform 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 directs that the Complainant must prove each of the following:

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

Identical or Confusing Similarity

The Panel finds that the domain name is confusingly similar to the Complainant's registered marks. The dominant and most important element in Complainant's mark is YAFRIRO. *Eltec Elektronik AG v. Eltec Domain Hostmaster*, WIPO Case No. D2000-0406.

Rights and Legitimate Interests

Complainant has in a credible way alleged that Respondent has no rights or legitimate interests in respect of the domain name at issue. Respondent has failed to show that Respondent has any rights or legitimate interests in respect of the domain name at issue. This entitles the Panel to infer that Respondent has no rights or legitimate interests in respect of the domain name at issue. *Alcoholics Anonymous World Services, Inc. v. Lauren Raymond*, WIPO Case No. D2000 0007; *Ronson Plc v. Unimetal Sanayi ve Tic. A.S.*, WIPO Case No. D2000 0011. Accordingly, the Panel finds that Respondent has no rights or legitimate interests in respect of the domain name.

Bad Faith

Complainant's allegations fail to come within any of the four examples of bad faith registration and use set out in Paragraph 4(b) of the Policy. However, the Examples in Paragraph 4(b) are intended to be illustrative, rather than exclusive. *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003.

In *Telstra* it was established that "inaction" can constitute bad faith use, and the *Telstra* decision has since been cited for that proposition and followed by subsequent Panels. *Ingersoll-Rand v. Frank Gully, d/b/a Advcomren*, WIPO Case No. D2000-0021; *Guerlain, S.A. v. Peikang*, WIPO Case No. D2000-0055; *Compaq Computer Corp. v. Boris Beric*, WIPO Case No. D2000-0042; *Association of British Travel Agents Ltd. v. Sterling Hotel Group Ltd.*, WIPO Case No. D2000-0086; *Sanrio Co. Ltd. and Sanrio, Inc. v. Lau*, WIPO Case No. D2000-0172; *3636275 Canada, dba eResolution v. eResolution.com*, WIPO Case No. D2000-0110; *Marconi Data Systems, Inc. v. IRG Coins and Ink Source, Inc.*, WIPO Case No. D2000-0090; *Stralfors AB v. P D S AB*, WIPO Case No. D2000-0112; *InfoSpace.com, Inc. v. Ofer*, WIPO Case No. D2000-0075.

Telstra established that whether "inaction" could constitute bad faith registration and use could only be determined by analyzing the facts in a given case.

In the present case Respondent changed the address shortly after Complainant sent a demand letter to the previous address, when responding to several demand letters, the entity responding denied it was the registrant of the domain name at issue, said that the domain name at issue had been registered by a client, and refused to give Complainant's the contact information for the client who allegedly registered the domain name at issue. Respondent gave two addresses to Whois, an address in Singapore and an address in Kuala Lumpur, cities in which Complainant has two of its outlets. In the more than three years since Respondent registered the domain name at issue, Respondent has not used it to resolve to a web site. Under facts such as these, the Panel finds that Respondent has registered and is using the domain name at issue in bad faith.

Status

www.yafriro.com

Domain Name Transfer

Decision

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

M. Scott Donahey
Sole Panelist

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