



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-1100362
Complainants:	Retail Royalty Company & AEO Management Co.
Respondent:	Zhang Han

1. The Parties and Contested Domain Name

The Complainants are Retail Royalty Company, Las Vegas, Nevada, USA and AEO Management Co, Pittsburgh, Pennsylvania, USA (jointly referred to as “the Complainant”).

The Respondent is Zhang Han, Nanjing City, Jiangsu Province, China.

The domain name at issue is <americaneagleboot.com> (“the Disputed Domain Name”), registered by Respondent with Name.com LLC, Denver, Colorado, USA.

2. Procedural History

The Complaint was filed with the Hong Kong Office of the Asian Domain Name Dispute Resolution Center (the “ADNDRC”) on May 12, 2011. On May 16, 2011, the ADNDRC transmitted by email to Name.com, Inc. a request for registrar verification in connection with the Disputed Domain Name. On May 17, 2011, Name.com, LCC transmitted by email to the ADNDRC its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The ADNDRC verified that the Complaint 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 ADNDRC formally notified the Respondent of the Complaint, and the proceedings commenced on May 23, 2011. In accordance with the Rules, paragraph 5(a), the due date for Response was June 12, 2011. No Response was filed with the ADNDRC.

The ADNDRC appointed Jacques de Werra as the sole panelist in this matter on June 13, 2011.

The Panel determines that the appointment was made in accordance with para. 6 of the Rules and Articles 8 and 9 of the Supplemental Rules.

3. Factual background

The Complainant designs, markets and sells casual, current clothing, accessories, basics, and footwear targeting 15 to 25 year-olds under the marks “American Eagle Outfitters” and “American Eagle” at its own retail stores and on its website <ae.com>. Complainant opened its first retail store in the United States in 1977, and now operates over 950 retail stores throughout the United States, Canada, Kuwait and the United Arab Emirates. Complainant currently ships products to more than 75 countries worldwide, including to China where its market presence is established. Sales for various goods by Complainant worldwide over the past ten years are estimated at over USD \$20 Billion, including approximately USD \$3.0 Billion in 2009.

The Complainant is the owner of many trademarks including the terms “American Eagle” or “American Eagle Outfitters” (“the Trademarks”) in various classes, including clothing, in the United States of America (US trademark registrations No.3545443 No.3636963, No.3797646, No. 2050115 and No. 2086693) and is also the owner of other corresponding trademarks (or trademark applications) particularly in Andorra, Argentina, Australia, Bolivia, Brazil, Canada, China, Egypt, European Community, Hong, Kong, Indonesia, Japan, Mongolia, New Zealand, Norway, Peru, Russia, Saudi Arabia, Singapore, South Korea, Switzerland and Vietnam. The Complainant operates various websites including <ae.com> (registered March 17, 1999) and <americaneagleoutfitters.com> (registered February 20, 2002) for selling its products on-line.

The Disputed Domain Name was registered by the Respondent on September 25, 2009. The Disputed Domain Name is used to sell counterfeit “American Eagle” branded boots and kids’ boots to online consumers.

The Complainant sent a cease and desist letter to the Respondent on February 10, 2011, in which the Complainant informed the Respondent of its prior legitimate rights in the Trademarks, and requested Respondent’s voluntary transfer of the Disputed Domain Name and cessation of all misuse of the Trademarks. Respondent did not respond to the cease and desist letter.

4. Parties’ Contentions

A. Complainant

The Complainant’s contentions may be summarized as follows:

- i. The Disputed Domain Name is confusingly to the Trademarks that it owns, whereby the addition of the term “boot” does not affect this finding because this term is descriptive of the products sold on the website associated with the Disputed Domain Name;
- ii. The Respondent has no right or legitimate interest in the Disputed Domain Name and he is not authorized or licensed to use the Trademarks because Respondent is not affiliated with, licensed by, or in privity with the Complainant, and has not been given permission to use any of the Trademarks by the Complainant, and it is not otherwise in any way connected with the Complainant or its affiliates. There

is further no evidence that the Respondent is commonly known by the Disputed Domain Name;

- iii. The Respondent registered the Disputed Domain Name in bad faith because it is not affiliated with or connected in any way with the Complainant. The Respondent further obtained the Disputed Domain Name merely for the purpose of exploiting the rights of the Complainant, and/or to profit from "pirating" Complainant's ability to use a confusingly similar variation of Complainant's Trademarks within the context of a ".com" domain name, and to frustrate Complainant's business opportunities on the Internet by diverting customers away from a legitimate website owned and/or operated by Complainant.

B. Respondent

- i. The Respondent's did not file any response.

5. Findings

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

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

A) Identical / Confusingly Similar

The Panel is satisfied that the Complainant has rights to the Trademarks in various jurisdictions and that its marketing efforts have created a strong brand recognition of the Trademarks in many countries, including in China.

A comparison between the Disputed Domain Name and the Trademarks shows that the Disputed Domain Name is clearly confusingly similar to the Complainant's Trademarks. The addition of the descriptive term "boot" after the words "American Eagle" which correspond to the distinctive part of the Trademarks do not affecting this finding of confusing similarity. See by analogy American Eagle Outfitters, Inc. and Retail Royalty Company v. Admin c/o LaPorte Holdings, NAF Claim No.: FA0505000473826 (where an NAF panel found that the domain name <americaneaglestores.com> was confusingly similar to Complainant's « AMERICAN EAGLE OUTFITTERS » mark).

As a result, based on the rights of the Complainant in the Trademarks and on the confusing similarity between the Trademarks and the Disputed Domain Name, the Panel finds that the conditions of paragraph 4(a)(i) of the Policy are met.

B) Rights and Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights to or legitimate interests in the Disputed Domain Name by demonstrating any of the following:

- (i) before any notice to it 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 has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial 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.

Although the Complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, previous panels have consistently ruled that paragraph 4(c) of the Policy shifts the burden to the Respondent to come forward with evidence of a right or legitimate interest in the domain name, once the Complainant has made a *prima facie* showing. See Document Technologies, Inc. v. International Electronic Communications Inc., WIPO Case No. D2000-0270.

In the Panel's opinion, the Complainant has made a *prima facie* case against the Respondent. The Respondent indeed registered the Disputed Domain Name which replicate the distinctive elements of the Trademarks owned by the Complainant and uses it in connection with a website selling counterfeiting goods imitating the products of the Complainant.

The Complainant has also established that the Respondent has no right in the Disputed Domain Name (i.e. he is not the owner of any trademark corresponding to the Disputed Domain Name in China, which is the country where he is based), that he is not authorized or licensed to use the Trademarks by the Complainant and that the Respondent has not been commonly known by the Disputed Domain Name.

The Panel thus accepts the Complainant's *prima facie* showing and it is consequently up to the Respondent to come forward with evidence of a right to or legitimate interests in the Disputed Domain Name, which has not been done given Respondent's absence of participation in these proceedings.

Accordingly, the Panel finds that the Respondent has no right or legitimate interests in the Disputed Domain Name pursuant to paragraph 4(a)(ii) of the Policy.

C) Bad Faith

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name;
- (ii) circumstances indicating that the respondent 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;

(iii) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) circumstances indicating that the respondent intentionally is using the domain name in an attempt to attract, for commercial gain, Internet users to its 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 the respondent's website or location or of a product or service on its website or location.

The examples of bad faith registration and use set forth in paragraph 4(b) of the Policy are not meant to be exhaustive of all circumstances from which such bad faith may be found. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003. The overriding objective of the Policy is to curb the abusive registration of domain names in circumstances where the registrant is seeking to profit from and exploit the trademark of another. See *Match.com, LP v. Bill Zag and NWLAWS.ORG*, WIPO Case No. D2004-0230.

In this case, the Panel holds that the Respondent registered the Disputed Domain Name in bad faith because the Trademarks are distinctively identifying the Complainant and the Complainant's fashion products so that the choice of the Disputed Domain Name cannot be reasonably explained otherwise than as a reference to the Trademarks of the Complainant. The Respondent's bad faith in the registration and use of the Disputed Domain Name is further confirmed by the fact that the Disputed Domain Name is used exclusively for the promotion and commercialization of products counterfeiting the Complainant's Trademarks.

On this basis, the Panel has formed the view that the Respondent's intention in registering and using the Disputed Domain Name was to divert Internet users looking for information about the Complainant to a website other than the Complainant's in order to take advantage of the reputation that the Complainant has built up in the Trademarks for commercializing fake products under the Complainant's Trademarks. See, by analogy, *Chopard International S.A. v. Vladimit Kozlov*, WIPO Case No. D2007-1544.

For these reasons, the Panel considers that the Complainant has established that the Disputed Domain Name was registered and is being used in bad faith by the Respondent pursuant to paragraph 4(a)(iii) of the Policy.

6. Decision

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 <americaneagleboot.com> be transferred to the Complainant.

Jacques de Werra
Panelist

Dated: June 28, 2011