



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 - 1100367

Complainant: The Procter & Gamble Company

Respondent: olayclub

1. The Parties and the Disputed Domain Name

The Complainant is The Procter & Gamble Company of One Procter & Gamble Plaza, Cincinnati, Ohio, the United States of America, represented by Beijing Ding Cheng Xin Bang Intellectual Property Agency Ltd.

The Respondent is olayclub, of Wuhan, Hubei Province, the People's Republic of China.

The contested domain name is <olayclub.net >, registered by the Respondent with Melbourne IT, Ltd. dba Internet Names Worldwide.

2. Procedural History

The Complaint was filed with the Hong Kong office of the Asian Domain Name Dispute Resolution Center (the "Center") on June 6, 2011. On June 20, 2011 the Center transmitted by email to Melbourne IT Ltd. dba Internet Names Worldwide a request for registrar verification in connection with the disputed domain name. On June 21, 2011 Melbourne IT Ltd. dba Internet Names Worldwide transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant of the disputed domain name and providing the Respondent's contact details. The Center has verified that the Complaint satisfies the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules of Procedure under the Policy (the "Rules") and the Center's Supplemental Rules.

In accordance with the Rules, the Center formally notified the Respondent of the Complaint and the proceeding commenced on July 8, 2011. In accordance with the Rules, the due date for the Response was July 28, 2011.

No Response was received by the Center.

The Center appointed Sebastian Matthew White Hughes as the Panelist in this matter on August 3, 2011. The Panel finds that it was properly constituted and has acted impartially in reaching its conclusion.

3. Factual background

A. Complainant

The Complainant is a company incorporated in the United States of America and the owner of numerous trade mark registrations worldwide for the trade mark OLAY (the “Trade Mark”), including several registrations in China, the earliest dating from August 14, 1996.

B. Respondent

The Respondent is an individual apparently with an address in the People’s Republic of China.

C. The Disputed Domain Name

The Respondent registered the disputed domain name on September 24, 2010.

4. Parties’ Contentions

A. Complainant

The Complainant made the following submissions in the Complaint.

Since 1951, the Trade Mark has taken a leading role within the cosmetics and skin care industry. Through long-term product promotion and development, the Trade Mark has attracted more than 80 million female consumers in more than 25 countries, which establishes it as one of the most influential and well-known of skin care trade marks.

After decades of promotion in China, the Trade Mark has attained a very high level of recognition in the Chinese market. Internet searches of the word OLAY on Google and Baidu reveal more than 40,100,000 and 5,850,000 links respectively.

The Complainant uses the wording CLUB OLAY on the Complainant’s official global website, in order to register club members and offer special membership privileges. The Complainant began using its corresponding club for mainland Chinese consumers in 2007. The first twenty search results on Google for CLUB OLAY all relate to the Trade Mark. Therefore, the Complainant is the lawful owner of the CLUB OLAY name in China, and its exclusive rights in the name CLUB OLAY should be duly protected under PRC law.

The disputed domain name is confusingly similar to the Trade Mark. Considering the distinctiveness and well-known status of the Trade Mark, the disputed domain name will mislead consumers into assuming that it has been registered by the Complainant or that there

is some connection between the Complainant and the disputed domain name, thereby causing confusion.

The Respondent does not have any rights or legitimate interests in respect of the disputed domain name. The Respondent is not an authorised distributor of the Complainant, nor does the Complainant have any business with the Respondent. The Complainant has never authorised the Respondent to use the Trade Mark or register the disputed domain name.

The disputed domain name has been registered and used in bad faith. Because the Trade Mark is highly distinctive and well-known, the disputed domain name cannot be deemed as a registration for regular business or personal reasons. More likely, the Respondent's real aim is making improper profits from the resemblance between the disputed domain name and the Trade Mark.

In addition, the Respondent has never put the disputed mark into actual use after registering it eight months ago. However, the disputed mark has meanwhile disrupted the Complainant's business in China and prevented the Complainant from reflecting the Trade Mark in a corresponding domain name. Also, by registering the disputed domain name, the Respondent has created a false association in the minds of consumers between the disputed domain name and the Trade Mark, and thereby the Respondent is able to attract consumers of OLAY products to visit its website for its own commercial gain.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

5. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that the Complainant has rights in the Trade Mark acquired through use and registration which predate by many decades the date of registration of the disputed domain name. The Panel also has no hesitation in finding that the Trade Mark is well-known in China and worldwide.

UDRP panels have consistently held that domain names are identical or confusingly similar to a trade mark for purposes of the Policy "when the domain name includes the trade mark, or a confusingly similar approximation, regardless of the other terms in the domain name" (*Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. D2000-0662).

The disputed domain name comprises the identical Trade Mark in its entirety together with the word "club". The Panel finds that the use of the generic word "club" in the disputed domain name does not serve to obviate the confusing similarity between the disputed domain name and the Trade Mark and does not serve to distinguish the disputed domain name from the Trade Mark (*LEGO Juris A/S v. crt000, chen rui ting / PrivacyProtect.org*, WIPO Case No. D2010-1520).

The Panel finds that the disputed domain name is confusingly similar to the Trade Mark.

The Panel therefore holds that the Complaint fulfills the first condition of paragraph 4(a) of the Policy.

The Panel would however take issue with the assertions of the Complaint's representatives that the Complainant is the lawful owner of the name CLUB OLAY in China, and that the name CLUB OLAY is duly protected under PRC law. It is the Panel's understanding that "common law" or unregistered trade mark rights, as exist in certain common law jurisdictions, do not exist in China. Absent any trade mark registrations in China in respect of CLUB OLAY, the Panel would suggest it is unlikely the Complainant has any rights under PRC law in respect of its unregistered CLUB OLAY name.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances any of which is sufficient to demonstrate that the Respondent has rights or legitimate interests in the disputed domain name:

- (i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organisation) have been commonly known by the domain name even if you have acquired no trade mark or service mark rights; or
- (iii) you are 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 trade mark or service mark at issue.

There is no evidence that the Complainant has authorised, licensed, or permitted the Respondent to register or use the disputed domain name or to use the Trade Mark. The Complainant has prior rights in the Trade Mark which precede the Respondent's registration of the disputed domain name by decades. There is therefore a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name, and the burden is thus on the Respondent to produce evidence to rebut this presumption (*Do The Hustle, LLC v. Tropic Web*, WIPO Case No. D2000-0624; *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. D2003-0455).

The Respondent has failed to show that it has acquired any trade mark rights in respect of the disputed domain name or that the disputed domain name is used in connection with a *bona fide* offering of goods or services.

There has been no evidence adduced to show that the Respondent has been commonly known by the disputed domain name.

There has been no evidence adduced to show that the Respondent is making a legitimate non-commercial or fair use of the disputed domain name.

The Panel finds that the Respondent has failed to produce any evidence to establish rights or legitimate interests in the disputed domain name. The Panel therefore finds that the Complaint fulfills the second condition of paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Pursuant to paragraph 4(b)(ii) of the Policy, the following conduct amounts to registration and use in bad faith on the part of the Respondent:

You have registered the domain name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct.

The Complainant has not submitted any evidence to suggest the Respondent has engaged in a pattern of registering domain names in order to prevent trade mark owners from reflecting their marks in corresponding domain names. The Panel therefore finds the Complainant has failed to establish bad faith under this paragraph of the Policy.

Pursuant to paragraph 4(b)(iv) of the Policy, the following conduct amounts to registration and use in bad faith on the part of the Respondent:

By using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location.

Yet it is apparent the Respondent has not made any active use of the disputed domain name and that its registration of the disputed domain name is merely being held passively. The Panel therefore concludes the Complainant has failed to establish bad faith under this paragraph of the Policy.

Pursuant to paragraph 4(b)(iii) of the Policy, the following conduct amounts to registration and use in bad faith on the part of the Respondent:

You have registered the domain name primarily for the purpose of disrupting the business of a competitor.

The Panel finds the Complainant has failed to adduce sufficient evidence to suggest that mere registration, absent use, of the disputed domain name by the Respondent amounts to registration for the purpose of disrupting the business of the Complainant.

It has however been established in many UDRP cases that passive holding under the appropriate circumstances falls within the concept of the domain name being used in bad faith (*Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003; *Action S.A. v. Robert Gozdowski*, WIPO Case No. D2008-0028).

Given the circumstances of this case, in particular the repute of the Trade Mark in China and worldwide, and the failure of the Respondent to file a Response (*Bayerische Motoren Werke AG v. (This Domain is For Sale) Joshuathan Investments, Inc.*, WIPO Case No. D2002-0787), the Panel determines that, whilst the Complainant has failed to establish any of the specific non-exclusive heads of bad faith under paragraph 4(b) of the Policy, the requisite element of bad faith has been satisfied on general grounds.

For all the foregoing reasons, the Panel concludes that the disputed domain name has been registered and is being used in bad faith. Accordingly the third condition of paragraph 4(a) of the Policy has been fulfilled.

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 disputed domain name <olayclub.net> be transferred to the Complainant.

Sebastian Hughes

Sole Panelist

Dated: August 5, 2011