



Asian Domain Name Dispute Resolution Centre

hong kong

(Hong Kong Office)

## ADMINISTRATIVE PANEL DECISION

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<b>Case No.</b>	<b>HK-2201664</b>
<b>Complainant:</b>	<b>APM MONACO S.A.M.</b>
<b>Respondent:</b>	<b>alex usu</b>
<b>Disputed Domain Name(s):</b>	<b>&lt;apmoutlet.com&gt;</b>

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### 1. The Parties and Contested Domain Name

The Complainant is APM MONACO S.A.M. of 3,rue de l'Industrie, 9 ETG 98000 MONACO, Monaco.

The Respondent is alex usu, of 234 22 St W, Foothills AB/P T1S 3N2 Canada.

The domain name at issue is <apmoutlet.com> (“**Domain Name**”) registered by the Respondent with NameCheap, Inc, of Namecheap, Inc. of 4600 East Washington Street, Suite 305,Phoenix, AZ 85034.

### 2. Procedural History

On 16 September 2022, the Complainant filed a Complaint with the Hong Kong Office of Asian Domain Name Dispute Resolution Centre (“**ADNDRC**”), pursuant to the Uniform Domain Name Dispute Resolution Policy (“**Policy**”) approved by the Internet Corporation for Assigned Names and Numbers (“**ICANN**”) on 24 October 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (“**Rules**”), approved by ICANN Board of Directors on 28 September 2013 and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (“**Supplemental Rules**”) effective from 31 July 2015. The Complainant chose to have a sole panelist to handle the dispute.

On 16 September 2022, the ADNDRC transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On the same day, the Registrar transmitted by email to the ADNDRC its verification response confirming that the Respondent is listed as the registrant and providing the contact details. On the same day, the ADNDRC notified the Complainant of the deficiencies in the Complaint. On 19 September 2022, the Complainant filed a rectified Complaint. The ADNDRC formally notified the Respondent of the Complaint and the proceedings commenced on 28 September 2022. The ADNDRC did not receive any formal response from the

Respondent within 20 calendar days as required under paragraph 5 of the Rules. Accordingly, on 19 October 2022, the ADNDRC informed the parties that no response has been received and it would shortly appoint a single panelist.

On 19 October 2022, the ADNDRC appointed Ms. Karen Fong as sole Panelist in this matter. The Panelist accepted the appointment and has submitted a statement to the ADNDRC that she is able to act independently and impartially between the parties.

### **3. Factual background**

The Complainant, founded in 1982, is a luxury jewelry company which designs, produces and sells its line of jewelry under the brand APM MONACO. The Complainant has a portfolio of registered trade marks in a large number of countries for the mark APM, APM MONACO and the APM MONACO logo. These include the United States, China, Hong Kong, the European Union, Australia, Japan, Turkey, Morocco and Singapore. The earliest trade mark registration for APM submitted in evidence is International Registration Number 1042577 registered on 11 June 2010 (“**Trade Mark**”). The Complainant’s official website is found at [www.apm.mc](http://www.apm.mc). It has boutiques in many countries

The Respondent, an individual based in Canada, registered the Domain Name on 15 June 2022. The Domain Name resolved to a website which was visually similar to the Complainant’s website. The website featured the Complainant’s logo as well as photographs of the Complainant’s boutiques and sold products purported to be made by the Complainant (“**Website**”). The Domain Name is now inactive.

### **4. Parties’ Contention**

## **A. Complainant**

The Complainant's contentions may be summarized as follows:

The Domain Name is identical or confusingly similar to the Trade Mark, that the Respondent has no rights or legitimate interests with respect to the Domain Name, and that the Domain Name has been registered and is being used in bad faith. The Complainant requests transfer of the Domain Name.

## **B. Respondent**

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

## **5. Findings**

### **A. General**

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 is 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.

### **B. Identical / Confusingly Similar**

The Panel is satisfied that the Complainant has established that it has rights to the Trade Mark.

The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the trade mark and the domain name to determine whether the domain name is confusingly similar to the trade mark. The test involves a side-by-side comparison of the domain name and the textual components of the relevant trade mark to assess whether the mark is recognizable within the domain name.

In this case the Domain Name contains the Trade Mark in its entirety plus the descriptive term "outlet". The addition of this term does not negate the confusing similarity encouraged by the Respondent's complete integration of the Trade Mark in the Domain Name. E.g., *N.V. Organon Corp. v. Vitalline Trading Ltd., Dragic Veselin / PrivacyProtect.org*, WIPO Case No. D2011-0260; *Oakley, Inc. v. Wu bingjie aka bingjie wu/Whois Privacy Protection Service*, WIPO Case No. D2010-0093; *X-ONE B.V. v. Robert Modic*, WIPO Case No. D2010-0207.

For the purposes of assessing identity or confusing similarity under paragraph 4(a)(i) of the Policy, it is permissible for the Panel to ignore the generic Top-Level Domain which in this case is ".com". It is viewed as a standard registration requirement.

The Panel finds that the Domain Name is identical to trade marks in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy therefore are fulfilled.

### **C. Rights or Legitimate Interests**

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights 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 trade mark 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 trade mark or service mark at issue.

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name, it is well established that, as it is put in section 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("**WIPO Overview 3.0**"), that a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent does come forward with some allegations of evidence of relevant rights or legitimate interests, the panel weighs all the evidence, with the burden of proof always remaining on the complainant.

Section 2.13 of the WIPO Overview 3.0, states that UDRP panels have categorically held that the use of a domain name for illegal activity like the sale of counterfeit goods can never confer rights or legitimate interests on a respondent. The products offered for sale on the Website were disproportionately below market value. Further, the Complainant has not licensed, authorized or otherwise permitted the Respondent to use the Trade Mark or apply for any domain name that incorporates the Trade Mark. Neither is the Respondent an authorized dealer of the Complainant nor has he ever had any business relationship with the Complainant. Such circumstances have been accepted as evidence that the goods in question were counterfeits.

The Panel finds that the Complainant has made out a prima facie case, a case calling for an answer from the Respondent. The Respondent has not provided any reasons why it chose to register the Domain Name comprising a trade mark with which it has no connection. The Panel is unable to conceive of any basis upon which the Respondent could sensibly be said to have any rights or legitimate interests in respect of the Domain Name.

The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name.

#### **D. Registered and Used in Bad Faith**

To succeed under the Policy, the Complainant must show that the Domain Name has been registered and is being used in bad faith.

The Panel is satisfied that the Respondent must have been aware of the Complainant's trade mark when he registered the Domain Name. It is implausible that he was unaware of the Complainant when he registered the Domain Name especially since the Website displayed the Trade Mark, and the products offered for sale are likely to be counterfeit APM MONACO products.

In the WIPO Overview 3.0, section 3.2.2 states as follows:

“Noting the near instantaneous and global reach of the Internet and search engines, and particularly in circumstances where the complainant's mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant's mark. Further factors including the nature of the domain name, the chosen top-level domain, any use of the domain name, or any respondent pattern, may obviate a respondent's claim not to have been aware of the complainant's mark.”

The Panel also finds that the actual use of the Domain Name is in bad faith. The products offered for sale on the Website appeared to be counterfeit APM MONACO products. The use by a respondent of a domain name which includes a well-known trade mark to resolve to a website which offers and sells counterfeit products under that trade mark may be evidence of bad faith registration and use. (See *Burberry Limited v Jonathan Schefren*, WIPO Case No. D2008-1546; and *Prada SA v. Domains for Life*, WIPO Case No. D2004-1019). There is a clear intention to attract for commercial gain by confusing and misleading Internet users into believing that the Website was and the products sold on it are authorised or endorsed by the Complainant. This is clearly bad faith under paragraph 4(b)(iv) of the Policy.

The Panel finds that the Domain Name was registered and is being used in bad faith.

#### **6. Decision**

For the foregoing reasons, and in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name <apmoutlet.com> be transferred to the Complainant



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Karen Fong  
Panelist

Dated: 3 November 2022