



Asian Domain Name Dispute Resolution Centre

hong kong

(Hong Kong Office)

## ADMINISTRATIVE PANEL DECISION

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**Case No.** HK-2201703  
**Complainant:** Donna Wilson Limited  
**Respondent:** Tao Feng  
**Disputed Domain Name(s):** <usdonnawilson.com>

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### 1. The Parties and Contested Domain Name

The Complainant is, **Donna Wilson Limited**, of 17, Pundersons Gardens. Unit 8a, London E2 9 QG, UK. The Complainant is a Company incorporated in England with its place of business in London, UK. The Complainant is represented by **S & P Legal Limited**, of 29, Austen Road, Guildford, Surrey, GU1 3NP, UK.

The Respondent is **Tao Feng**, of Block Y, Guiyang Street, Xiuying, Lanying County, Anhui Province, 349135, China. The Respondent is not represented.

### 2. Domain Name and Registrar

The domain name at issue is [usdonnawilson.com](http://usdonnawilson.com); (the “**Domain Name**”), registered by the Respondent with **Name.com, Inc, (the “Registrar”)**, of 414, 14th Street #200, Denver, Colorado 80202, USA.

### 3. Procedural History

3.1 The Complaint dated 8 December 2022 was filed with the Hong Kong Office of Asian Domain Name Dispute Resolution Centre (“**ADNDRC**” the “**Centre**”) on 15 December 2022.

3.2 On 16 December 2022 the Centre sent an email requesting the Registrar to provide information related to the Domain Name registration verification, by 21 December 2022.

- 3.3 On 22 December 2022 the Centre sent a follow-up email requesting the Registrar to provide the Domain Name registration verification.
- 3.4 On 23 December 2022 the Registrar replied by email to the Centre its verification response with details of the information, which was withheld under Privacy Service of the Domain Name. The information included the Contact ID, Administrative, Technical, and Billing Contact details of the Named Registrant. The Registrar confirmed that the language of the Registration Agreement was English.
- 3.5 On 23 December 2022 the Centre provided the Complainant by email, the information about the Registrant as received from the Registrar. The Centre invited the Complainant to rectify the deficiencies found in the Complaint Form C, in accordance with Article 4 of the Rules for the ICANN Uniform Domain Name Dispute Resolution Policy (the "**Rules**"), and submit an amendment to the Complaint Form C on or before 28 December 2022.
- 3.6 On 29 December 2022 the Centre notified the Complainant that the amended Complaint was not received on 28 December 2022. In view of the Christmas Holidays, the Centre allowed the Complainant additional time to confirm if it wishes to proceed with the complaint, or to submit the amended Complaint Form on or before 2 January 2023.
- 3.7 On 31 December 2022 the Complainant submitted the amended Complaint Form C.
- 3.8 The Centre verified that the Amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "**Policy**" or "**UDRP**"), the Rules for UDRP, and the ADNDRC Supplemental Rules for UDRP (the "**Supplemental Rules**"). Accordingly, on 3 January 2023 the Centre notified the Complainant that the Complaint is in administrative compliance.
- 3.9 On 3 January 2023 the Centre in accordance with the Rules, Paragraph 2 and 4, notified the Respondent of the Complaint, and the proceedings commenced on 3 January 2023. In accordance with the Rules Paragraph 5, the Centre fixed the due date for the response as on or before 23 January 2023. The Respondent did not submit any response. Accordingly, on 24 January 2023 the Centre notified the Respondent's default to the Parties.
- 3.10 On 24 January 2023 the Centre invited Jayems, Dhingra Jag Mohan, to confirm availability to be the Sole Panellist for this matter. The Panellist confirmed availability and submitted the Statement of Acceptance and Declaration of Impartiality, and Independence, as required by the Centre for ensuring compliance with the Paragraph 7 of the Rules.

3.11 On 26 January 2023 the Centre confirmed the appointment of the Sole Panellist and notified the Parties. Therefore, the Panel finds that it was properly constituted.

#### **4. Factual background**

4.1 The Complainant is a Company incorporated in England with its place of business and address in England. The Complainant is in the business of designing, manufacturing, and distributing merchandise related to fashion clothing, homewares and accessories. The Complainant sells its goods under "DONNA WILSON" mark through its retail outlets in the UK and abroad.

4.2 The Complainant is the registered owner of the Trademark "DONNA WILSON" as evidenced from the Certificates provided by the Complainant, and issued by the following Trademark Registries:

4.2.1 European Intellectual Property Office (EUIPO) Certificate No. 017875485 dated 26/10/2018 – for goods under Classes 11, 16, 18, 20, 21, 24, 25, 28, 35, 41 and 42.

4.2.2 Japan Patent Office (JPO) Certificate No. 1459657 dated 19 February 2021 – for goods under Classes 21, 24, 25, and 35.

4.2.3 United States of America Patent and Trademark Office (USPTO) Certificate No. 5,778,983 dated 18 June 2019 - for goods under Classes 21, 24, 25, and 35.

4.2.4 Trademarks Registry of Great Britain and Northern Ireland Certificate No. UK00003297234 effective from 15 March 2018 – for goods under Classes 16, 18, 20, 21, 24, 25, 28, 35, 41 and 42.

4.2.5 WIPO Certificate of Registration No. 1459657 dated 13 September 2018 under the Madrid Protocol for China, Japan, and Republic of Korea - for goods under Classes 21, 24, 25, and 35.

4.3 The Respondent did not submit a response and its factual background is not known. However, it is confirmed by the Registrar that the Respondent is the registrant of the Domain Name [usdonnawilson.com](http://usdonnawilson.com) which was registered on 8 July 2022. The Domain resolves to an active website.

#### **5. Parties' Contentions**

##### **A. Complainant**

5.1 The Complainant seeks that the Domain Name be transferred to the Complainant. The Complainant's contentions and the Complaint is made on the following factual and legal grounds:

- 5.1.1 The Domain Name is identical or confusingly similar to its well-known trademarks under which various Classes of goods are being distributed for sale worldwide.
- 5.1.2 The Complainant has registered the trademark in UK on 17 August 2018 and subsequently in USA, Japan, China, Republic of Korea and European Union (EUIPO), long before the disputed Domain Name was registered on 8 July 2022.
- 5.1.3 The disputed Domain Name is confusingly similar to the Complainant's trademarks *DONNA WILSON* and **DONNA WILSON**. Since the ".com" is not taken into account in the comparison, "www.usdonnawilson" is the main part of the disputed Domain Names, of which "donnawilson" is identical to the Complainant's worldwide reputed DONNA WILSON trademarks. This is the central and distinguishing element of the disputed Domain Name, as it will give the impression to the relevant public of being same as the Complainant's website.
- 5.1.4 The Complainant contends that, the images and models used on the disputed Domain Name websites are substantially similar to those used by the Complainant's trademarks DONNA WILSON and **DONNA WILSON**. This is also evidence that the Respondent is promoting this website as the official Donna Wilson website for buying goods, and thus misleading the consumers.
- 5.1.5 The Complainant submitted that the Respondent has no rights or legitimate interests in the Domain Name. The Respondent is not commonly known under the Domain Name and holds no form of authorization from the Complainant to use the Trademarks or has any business relation with the Complainant. Thus, the Respondent has no rights with regard to the trademark DONNA WILSON.
- 5.1.6 The Complainant contends that, the Respondent has registered and used the Domain Name in bad faith. In light of the well-known character of the Complainant's Trademarks, it is inconceivable that the Respondent was not aware of the Complainant's Trademarks when it registered the Domain Name. Also, the Respondent used the Domain Name in bad faith by displaying the Complainant's Trademarks on the website to which the Domain Name resolved, thus creating the impression of an official website operated by the Complainant, while the Respondent is using the Domain Name to sell fake counterfeit products bearing the Complainant's prior registered trademarks.
- 5.1.7 The Complainant submitted the screenshots of the Respondent's website using the disputed Domain Name and products bearing the trademarks of the Complainant, to show that the Domain Name is registered and being used in bad faith.

## **B. Respondent**

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

## 6. Findings

- 6.1 The Complainant requested that the language of the proceedings to be in English. The Respondent did not provide any response. Therefore, the Panel finds that in accordance with Paragraph 11(a) of the Rules, the language of this administrative proceeding shall be English, as it is the language of the Registration Agreement.
- 6.2 In view of the lack of a response filed by the Respondent as required under Paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(f), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant's undisputed factual submissions.

For the Complainant to succeed, the Complainant must prove as per Paragraph 4(a), of the ICANN Uniform Domain Name Dispute Resolution Policy (“**UDRP**”) that, each of three findings must be made in order for the 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.

Therefore, only if all three elements above have been fulfilled, the Panel is able to grant the remedies requested by the Complainant. The Panel deals with each of the requirements in turn hereafter.

### **A) Identical or Confusingly Similar**

- 6.3 Pursuant to Paragraph 4(a)(i) of the Policy, the Complainant must show that the Domain Name is (1) identical or confusingly similar to a trademark or service mark, (2) in which the Complainant has rights. With respect to having rights, the Complainant has submitted Trademark Registration Certificates from five Registries, namely, UK, EUIPO, WIPO, USA and Japan, as per the details above in paragraph §4.2 of this Decision. It is noted from the review of the Trademark Certificates, that the Complainant is the registered owner of the Trademarks.
- 6.4 Pursuant to section 1.2.1 of the *WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”)*, this satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. Accordingly, the Panel finds that the Complainant has proved that it has rights in the Trademarks.

- 6.5 On the first element part (1) for assessment of identical or confusing similarity of the Domain Name with the Trademarks, it is generally accepted that this test involves a reasoned but relatively straightforward comparison between the Complainant's Trademarks and the disputed Domain Name. In cases where a domain name incorporates the entirety of a trademark, the domain name will normally be considered confusingly similar to that mark (see *section 1.7 of the WIPO Overview 3.0*). Further, section 1.8, WIPO Overview 3.0 states, "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element."
- 6.6 In the present case, the Complainant's Trademarks are incorporated in their entirety in the disputed Domain Name after adding the letters "us" and making it as "usdonnawilson." It is well established that the addition of the generic Top-Level Domain ("gTLD") ".com" and the letters like "us" before the Complainant's Trademark, does not prevent a finding of confusing similarity with the Trademarks (see *section 1.11 of the WIPO Overview 3.0*).
- 6.7 Therefore, having considered the above reasons, the Panel finds that the requirement under paragraph 4(a)(i) of the Policy has been satisfied.

## **B) Rights or Legitimate Interests**

- 6.8 Pursuant to paragraph 4(c) of the Policy, any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on the evidence, shall demonstrate a respondent's rights or legitimate interests to a domain name for the purposes of paragraph 4(a)(ii) of the Policy:
- (i) before any notice 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 (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark 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 trademark or service mark at issue.
- 6.9 The Complainant must prove that the Respondent has no rights or legitimate interests in the Domain Name. It is usually sufficient for a complainant to make out a prima facie case that a respondent lacks rights or legitimate interests. If a complainant does establish a prima facie case, the burden of production of evidence shifts to the respondent (section 2.1 of WIPO Overview 3.0).

- 6.10 The Complainant's contentions and the evidence on file shows that the Respondent has not been linked or commonly known by the Domain Name. The Complainant also contends, and the Respondent did not submit any response to deny, that the Complainant did not authorize the Respondent's use of the Complainant's trademark in the Domain Name or has any relationship with the Complainant. Based on the evidence of the Respondent's use of the Domain Name, it does not satisfy requirements of bona fide offering of goods and services. The Respondent used the Domain Name to point to a website offering products substantially similar to the products that the Complainant offers under its DONNA WILSON trademarks.
- 6.11 Based on the use of the Complainant's trademark in the Domain Name, and substantial similarity between the Complainant's and the Respondent's products, the Panel concludes that the Domain Name suggested affiliation between the Complainant and the Respondent, which did not amount to bona fide offering of services or to a legitimate fair use. Once a complainant makes a *prima facie* case, 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.
- 6.12 However, by defaulting the Respondent has therefore failed to rebut the Complainant's *prima facie* case and to demonstrate its rights or legitimate interests in the Domain Name. The Panel finds that the Complainant has satisfied the second element of the UDRP.
- 6.13 Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name and the requirement of Paragraph 4(a)(ii) is fulfilled.

### **C) Registered and being Used in Bad Faith**

- 6.14 Under paragraph 4(a)(iii) of the Policy, a complainant must show that the disputed domain name has been registered and is being used in bad faith. Paragraph 4(b) of the Policy lists non-exhaustive four circumstances, which may be considered as evidence of registration and use in bad faith of a domain name.
- 6.15 In the Complaint, the Complainant has provided screenshots of Google Search of its Trademark, and the website linked to the disputed Domain Name by which the Respondent fraudulently impersonates the Complainant, by mimicking its Trademark, and selling comparable products of the Complainant; which would amount to bad faith. The Paragraph 4(b)(iv) of the Policy gives an example of similar circumstances of bad faith as:
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site 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 web site or location or of a product or service on your web site or location.

- 6.16 In view of the substantial similarity of products offered on the website linked to the disputed Domain Name and the registration date (8 July 2022) of the disputed Domain Name, the Panel is persuaded by the Complainant's contention that, "it can be reasonably inferred that the Respondent was aware of the Complainant's prior trademarks on DONNA WILSON and ~~DOMMA WILSON~~ trademarks well before registering the Disputed Domain Names."
- 6.17 There is extensive evidence of the range of goods under different Classes for Trademark and being produced by the Complainant in this case, demonstrating the reputation of the Complainant, which has been operating long before the Respondent registered the disputed Domain Name. The Panel is persuaded by the Complainant's contention that it is likely that the Respondent registered the Domain Name to trade on the goodwill of the Complainant's trademark. The website at the Domain Name, which is similar to the Complainant's trademark, is used to offer counterfeit goods, which were similar to the Complainant's goods. The evidence shows that the Respondent has no rights or legitimate interests in the Domain Name and is using it in bad faith.
- 6.18 In view of the above, the Panel finds that the Respondent has registered and is using the Domain Name in bad faith. Thus, the Complainant has proved the third element of Paragraph 4(a)(iii) of the Policy.

## 7. Decision

For the foregoing reasons, and in accordance with the Paragraphs 4(i) of the Policy and Paragraph 15 of the Rules, the Panel orders that the Domain Name <[usdonnawilson.com](http://usdonnawilson.com)> be transferred to the Complainant, forthwith.



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**Jayems, Dhingra Jag Mohan**

Panellist

Dated: 30 January 2023