



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	Re: HK- 1600859 <<blackcatfirework.com>.
Complainant:	Li & Fung (B.V.I.) Limited
Respondent:	Ben Turner
Disputed Domain Name:	<blackcatfirework.com>.

1. The Parties and Contested Domain Name

The Complainant is Li & Fung (B.V.I.) Limited, a company incorporated in the British Virgin Islands, of PO Box 952 Offshore Incorporations Centre, Road Town, Tortola, British Virgin Islands.

The authorized representative of the Complainant is Bird & Bird of 4/F Three Pacific Place, 1 Queen's Road East, and Hong Kong.

The Respondent is Ben Turner of Jake's Fireworks, Inc., a company incorporated in the United States of America, of 1500 E 27th Terrace, Pittsburg, KS, United States of America, 66762

The domain name at issue is <blackcatfirework.com>. The domain name is registered with Name.com Inc, of 41414th Street, #200, Denver, Colorado 80202, United States of America.

2. Procedural History

On April 6, 2016 the Complaint was filed with the Asian Domain Name Dispute Resolution Centre ("the Centre"). On April 6, 2016 the Complainant paid the appropriate case filing fee by cheque payable to the Hong Kong International Arbitration Centre on behalf of the Centre, with the Hongkong and Shanghai Banking Corporation Limited and the Centre received said filing fee.

On April 5, 2016, the Centre transmitted by email to Name.com Inc a request for Registrar verification in connection with the registrant of the disputed domain name. On April 6, 2016, Name.com Inc transmitted by email its verification response that the registrant of the disputed domain name is Ben Turner of Jake's Fireworks, Inc. and that its email address is ben@jakesfireworks.com. After an amendment to the Complaint the Centre 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"). On April 12, 2016, the Centre served the Complainant by forwarding to it, by email addressed to the Respondent at ben@jakesfireworks.com and to notices@name.com and udrp@icann.org, the Written Notice herein together with the Complaint and the annexures thereto. The Written Notice stated that the date of commencement of the proceedings was April 12, 2016 and that the due date by which the Respondent was required to file its Response was 2nd May 2016.

No Response was filed by the due date or at all and on May 3, 2016 the Centre notified the parties of that fact.

On May 5, 2016, the Centre appointed The Honourable Neil Anthony Brown QC as Panelist in the administrative proceeding. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Centre to ensure compliance with the Rule 7.

The Panel finds that the Asian Domain Name Dispute Resolution Centre has performed its obligations under Rule 2(a) of the Rules "to employ reasonably available means calculated to achieve actual notice to Respondent". Accordingly, the Panel is able to issue its decision based on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, the Asian Domain Name Dispute Resolution Centre Supplemental Rules and any rules and principles of law that the Panel deems applicable, without the benefit of any response from the Respondent.

3. Factual background

The Complainant is a company incorporated pursuant to the laws of the British Virgin Islands. The Complainant ("Li & Fung") operates a global consumer goods design, development, sourcing and logistics business, serving global brands, department stores, hypermarkets, specialty stores, catalogue-led companies and e-commerce platforms including the supply of fireworks.

Li & Fung has been using the BLACK CAT trade mark since it started exporting fireworks and introduced the BLACK CAT trade mark to the United States in the 1940s. The name BLACK CAT was used for Li & Fung's fireworks products, as "black cats" symbolize "luck and good fortune" in China. The BLACK CAT trade mark was first registered for fireworks related goods in 1952 in the United States and was subsequently registered in a number of countries globally. The Complainant is the current registered owner of a series of BLACK CAT trade marks that it uses in its business.

Fireworks products sold under the BLACK CAT Mark are available through more than 1,000 dealers throughout the United States, where the Respondent is domiciled. and for at least the last twenty years, hundreds of thousands of cartons of fireworks bearing the BLACK CAT Mark have been sold each year.

The Complainant's affiliates, Golden Gate Fireworks, Inc. and LF Europe Limited are also the registrants of the following domain names that they use in their business, <blackcatfireworks.com> which was registered on 11 September 1996 and <blackcatfireworks.co.uk> which was registered on 1 September 1999.

As alleged in the Complaint and on the information and belief of the Complainant, the Respondent registered the disputed domain name on June 12, 2013 and is the current registrant.

The website to which the disputed domain name resolves and to which it diverts internet users, competes with the Respondent's business as it offers identical goods to those that are protected by the Complainant's BLACK CAT Mark.

4. Parties' Contentions

A. Complainant

The Complainant's contentions are as follows:

1. The Complainant is the registered owner of over 68 BLACK CAT trade marks. In addition, the Complainant's affiliates, Golden Gate Fireworks, Inc. and LF Europe Limited are the registrants of the following domain names for "BLACKCATFIREWORKS", being <blackcatfireworks.com> which was registered on 11 September 1996 and <blackcatfireworks.co.uk> which was registered on 1 September 1999.
2. Since the 1940s and to date, the BLACK CAT Mark has been used on Li & Fung's fireworks products extensively in the United States, as well as in other countries including the United Kingdom and Germany. The name "Black Cat" was first used by Li & Fung for fireworks products and, prior to Li & Fung, no one had used the name "BLACK CAT" or any other similar name for fireworks products.
3. Fireworks products sold under the BLACK CAT Marks are available through more than 1,000 dealers throughout the United States and for at least the last twenty years, hundreds of thousands of cartons of fireworks bearing the BLACK CAT Marks have been sold each year.
4. The Complainant's Domain Names also incorporate the BLACK CAT Marks and such marks are used on the websites of the Complainant's Domain Names (the "Complainant's Websites").
5. BLACK CAT is currently the oldest and most recognised fireworks brand in the world. Through the longstanding and extensive use of the BLACK CAT Mark, consumers around the world have come to recognise it as signifying the Complainant and its high quality fireworks.

Identical or Confusingly Similar

6. First, the generic Top-Level Domain ".com" element of the Disputed Domain Name should be disregarded as it is non-descriptive and merely instrumental to the use of the Disputed Domain Name on the internet.
7. Next, the first and distinctive part of the identifying element is BLACKCAT, which is identical to the word elements in the Complainant's BLACK CAT Marks. The Disputed Domain Name incorporates the Complainant's BLACK CAT Mark in its entirety, therefore the first part of the Disputed Domain Name is identical and/or confusingly similar to the Complainant's BLACK CAT Mark.
8. The second part of the identifying element "FIREWORK" refers to the goods protected by the Complainant's Black Cat Mark registrations. The word "FIREWORK" does not sufficiently distinguish the Disputed Domain Name from the Complainant's BLACK CAT Mark or reduce the likelihood of confusion. In fact, the addition of the word "FIREWORK" increases the risk of confusion, as the word "FIREWORK" suggests the website of the Disputed Domain Name is

related to fireworks products which are goods protected under the Complainant's BLACK CAT Mark registrations and used by the Complainant/ Li & Fung.

9. Moreover, the Disputed Domain Name "BLACKCATFIREWORK" is nearly identical to the Complainant's Domain Names, except for the omission of the letter "S". This is a common type of typographical omission, but such change does not reduce confusing similarity caused to internet users.

Rights or Legitimate interests

10. None of the circumstances set out in Paragraph 4 (c) of the Policy can be satisfied by the Respondent and the Respondent has no right or legitimate interest in the Disputed Domain Name.

11. The Respondent is unable to show that before notice to it of the dispute it has used or prepared to use the Disputed Domain Name or a name corresponding to the Disputed Domain Name in connection with a bona fide offering of goods or services. This is because the Disputed Domain Name was registered on 12 June 2013, which is later than all the registrations of the BLACK CAT Marks.

12. The Respondent was aware of the Complainant at the time the Disputed Domain Name was registered due to the incorporation of the word "FIREWORK" in the Disputed Domain Name as BLACK CAT is a distinctive and well-known trade mark for fireworks and neither element of the trade mark is descriptive of fireworks.

13. The Respondent is a competitor of the Complainant and its website offers for sale and promotes firework products. The Respondent (or one of its affiliates) was engaged in importing containers of fireworks products bearing the BLACK CAT Mark through one of the Complainant's primary "BLACK CAT" fireworks dealers in the United States from the early 1990's until around 2005. Accordingly, the Respondent is and has been well aware of the Complainant's BLACK CAT Mark.

14. It is clear that the Respondent has registered and used the Disputed Domain Name with the intent to divert internet users to its own website. The adoption and use of a domain name that is substantially similar to the Complainant's trademark and Domain Names was clearly done to confuse consumers who are looking for the Complainant's products and to attract consumers to the Disputed Domain Name and diverting them to the Respondent's Website. As a result, this cannot conceivably constitute a bona fide offering of goods or services.

15. The Respondent (so far as can be ascertained) neither owns nor (given the global reputation of Black Cat) would the Respondent be expected to own, any registered trade marks that correspond to BLACK CAT nor does the Respondent appear to be commonly known by the Disputed Domain Name or use the Disputed Domain Name or a name corresponding to the Disputed Domain Name, therefore the Respondent does not have any rights or legitimate interests to the Disputed Domain Name.

16. There exists no relationship between the Complainant and the Respondent that would give rise to any license, permission or authorisation by which the Respondent could own or use the Disputed Domain Name which incorporates the Complainant's BLACK CAT mark.

17. The Respondent cannot rely on paragraph 4(c)(iii) of the Policy as it is not making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the BLACK CAT mark.

18. The Respondent should have been well aware of the Complainant's rights in the BLACK CAT mark at the time the Disputed Domain Name was registered, which was more than 60 years after the first use of the Black Cat marks by the Complainant, particularly as the BLACK CAT mark had been used extensively prior to the date of registration of the Disputed Domain Name.

19. The registration of the Disputed Domain Name was clearly intentional due to the incorporation of the word "FIREWORK", being a description of the goods offered by the Complainant under the BLACK CAT mark, and it is implausible that the Disputed Domain Name was selected for any other reason than for commercial gain through misleadingly diverting consumers to the Disputed Domain Name. This is particularly so as the website, to which the Disputed Domain Name is diverting internet users, is related to and competes with the Respondent's business. The Respondent's Website offers identical goods to those that are protected by the Complainant's BLACK CAT marks.

20. Accordingly, the Respondent does not satisfy paragraph 4(c)(iii) of the policy.

Bad Faith

21. It is inconceivable for the Respondent never to have heard of the Complainant's BLACK CAT mark when it registered the confusingly similar Disputed Domain Name. The very fact that the Respondent registered the Complainant's BLACK CAT mark in a domain name while having notice of such registered marks amounts to bad faith.

22. Further, the Respondent intentionally registered the Disputed Domain Name, which is a combination of the Complainant's BLACK CAT mark and the word "FIREWORK" (which refers to the Complainant's products), to trade off the reputation of the Complainant for fireworks products and create a likelihood of confusion with the Complainant's BLACK CAT Mark as to the source, sponsorship, affiliation or endorsement of the website at the Disputed Domain Name.

23. The timing of the Disputed Domain Name's registration also supports that the Respondent registered the Disputed Domain Name in bad faith. The only plausible explanation for the registration and use of the Disputed Domain Name is to interfere with the business of the Complainant by diverting internet users seeking the Complainant's Websites to the Respondent's Website with an attempt to attract commercial gain through the practice of typosquatting (missing the letter "s" after "BLACKCATFIREWORK"). The registration of the Disputed Domain Name also prevents the Complainant from registering the singular version of the Complainant's Domain Name.

B. Respondent

The Respondent failed to file a Response in this proceeding.

5. Findings and Discussion of the Issues

The ICANN Uniform Domain Name Dispute Resolution 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 the 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 first question that arises is whether the Complainant has a trademark on which it can rely. The Complainant has adduced evidence which the Panel accepts to the effect that the Complainant has trademark rights in BLACK CAT on which it can rely with respect to the disputed domain name.

The Complainant has established that it has registered trademark rights in a series of 68 registered trademarks for BALCK CAT worldwide and has done this by extensive evidence of the registrations which the Panel accepts, including in the United States, where the Respondent is domiciled, by US trademark 2,999,953 for BLACK CAT, registered with the United States Patent and Trademark Office on September 27, 2005 ("collectively referred to hereafter as "the BLACK CAT mark.").

Accordingly, the Complainant has proved that it has a trademark on which it may rely.

The second question that arises is whether the disputed domain name may be said to be identical or confusingly similar to the BLACK CAT mark. The Panel finds that the disputed domain name is confusingly similar to the BLACK CAT mark as, in making this comparison, the gTLD suffix ".com" is to be ignored and the objective internet user would naturally assume that a domain name incorporating a trademark and adding only the word "firework", the famous product of the equally famous BLACK CAT mark and essentially associated with its activities, is similar and confusingly so to the trademark. Nor can it make any difference that the Respondent chose the singular "firework" instead of the more common plural "fireworks", as that common exercise of engaging in typosquatting is irrelevant.

The Complainant has therefore established the first of the three elements that it must establish.

B) Rights and Legitimate Interests

It is now well established that the Complainant must first make a *prima facie* case that the Respondent lacks rights and legitimate interests in the disputed domain name under paragraph 4(a) (ii) of the Policy and then the onus of proof shifts to the Respondent to show that it does have such rights or legitimate interests. There are many decisions to that effect, one of the most notable of which is *Hanna-Barbera Prods., Inc. v. Entm't Commentaries*, FA 741828 (Nat. Arb. Forum Aug. 18, 2006) where it was held that a complainant must first make a *prima facie* case that the respondent lacks rights and legitimate interests in the disputed domain name under paragraph 4(a)(ii) of the UDRP before the onus of proof shifts to the respondent to show that it does have rights or legitimate interests in the domain name).

Having regard to the detailed and persuasive evidentiary case presented on behalf of the Complainant, the Panel finds that the Complainant has made out a *prima facie* case that arises from the following considerations:

- (a) the Respondent has chosen to take the Complainant's famous BLACK CAT mark and to use it in its domain name making only the addition of the word "firework" to the trademark, which does not reduce the confusing similarity present but, as the Complainant points out, emphasizes it;
- (b) the unchallenged evidence is that the Respondent had no authority to register the domain name and to use it as it has done, namely to sell goods that are in competition with the goods of the Complainant that are sold under its trademark and in circumstances where it must be assumed that this was being done for financial gain;
- (c) the Respondent has engaged in these activities without the consent or approval of the Complainant;
- (d) there is no evidence that the Respondent is commonly known by the Disputed Domain Name;
- (e) it is very apparent from the arguments of the Complainant with all of which the Panel agrees that it would be impossible for the Respondent to make out any of the other grounds specified in the paragraph 4(c) of the Policy for showing a right or legitimate interest and, if there were, the Respondent could have filed a Response, which it has not done.

These matters go to make out the *prima facie* case against the Respondent and, the onus of proof having been reversed, it is then up to the Respondent to rebut that case.

As the Respondent has not filed a Response or attempted by any other means to rebut the *prima facie* case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Complainant has thus made out the second of the three elements that it must establish.

C) Bad Faith

It is clear that to establish bad faith for the purposes of the Policy, the Complainant must show that the disputed domain name was registered in bad faith and has been used in bad faith.

That case may be made out if there are facts coming within the provisions of paragraph 4(b) of the Policy. That paragraph sets out a series of circumstances that are to be taken as evidence of the registration and use of a domain name in bad faith, namely:

"... (i) circumstances indicating that Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to Complainant who is the owner of the trademark or service mark or to a competitor of Complainant, for valuable consideration in excess of Respondent's documented out-of-pocket costs directly related to the disputed domain name; or

(ii) Respondent has registered the disputed domain name in order to prevent Complainant from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or

(iii) Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the disputed domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location.”

However, those criteria are not exclusive and Complainants in UDRP proceedings may also rely on conduct that is bad faith within the generally accepted meaning of that expression and frequently do so.

Having regard to those principles, the Panel finds that the disputed domain name was registered and used in bad faith. That is so for the following reasons.

The Respondent registered the disputed domain name in bad faith because it must have known and on the evidence must be taken to have known at all material times of the existence of the Complainant and its firework products and that it had no right to register the domain name because of the existence of the famous BLACK CAT mark. In particular, the Respondent had done business with the Complainant previously and imported into the United States the Complainant's famous Black Cat fireworks under that name.

The Respondent used the domain name in bad faith by using it to sell goods, namely fireworks that compete with the Complainant's fireworks. The unchallenged evidence to that effect is that the website to which the disputed domain name resolves and to which it diverts internet users competes with the Respondent's business as it offers the same goods, namely fireworks, as those that are protected by the Complainant's BLACK CAT Marks. The Complainant has adduced evidence to that effect contained in Exhibit J to the Complainant which the Panel accepts.

The Respondent did this at a time when it must have known that he had no rights to the domain name at all. It is no exaggeration to say that the Respondent has acted dishonestly by registering and using a domain name that includes the Complainant's BLACK CAT trademark and had no right to obtain and use the domain name in the way it has done or in any other way and has not attempted in a Response to explain its actions.

Moreover, the Respondent had for several years imported either by itself or one of its affiliates, fireworks carrying the Complainant's BLACK CAT brand. Accordingly, it must have known at all material times that it was in breach the Complainant's trademark by doing so.

These facts bring the case squarely within the provisions of paragraphs 4(b) (iii) and 4(b) (iv) of the Policy.

Further, having regard to the totality of the evidence submitted by the Complainant and the persuasive arguments it has advanced, the Panel finds that, in view of Respondent's acquisition of the disputed domain name and using it in the manner described, the Respondent registered and used the disputed domain name in bad faith within the generally accepted meaning of that expression.

Complainant has thus made out the third of the three elements that it must establish.

6. Decision

Having established all three elements required under the Policy, the Panel concludes that relief should be granted. Accordingly, it is ordered that the disputed domain name, **<blackcatfirework.com>** be TRANSFERRED to the Complainant.

The Honourable Neil Anthony Brown QC

Dated: May 8, 2016