



Asian Domain Name Dispute Resolution Centre

hong kong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1500803
Complainant:	PANDORA A/S
Respondent:	LiQiong Zheng
Disputed Domain Name(s):	< pandorabijouxfr.net >

1. The Parties and Contested Domain Name

The Complainant is PANDORA A/S, of Hovedvejen 2 DK-2600 Glostrup Denmark.

The Respondent is LiQiong Zheng, of Li Chen Qu Zhen Hai Jie Dao Zhen Hai Nan Jie 116 Hao, PuTian Shi, Fujian Sheng, 351100 China.

The domain name at issue is pandorabijouxfr.net, registered by the Respondent with Zhengzhou Zitian Network Technology Co., Ltd. (IANA#1742), of 90D, Fortune Plaza 4, Jingsan Road, Zhengzhou City, China.

2. Procedural History

The Complaint was filed with the Asian Domain Name Dispute Resolution Centre (the "Centre") on October 22, 2015 and the Complainant chose a sole panelist to review this case in accordance with the Uniform Domain Name Dispute Resolution Policy (the "Policy") which was adopted by the ICANN and came into effect on October 24, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") that became effective on September 28, 2013 and the Supplemental Rules thereof which became effective on July 31, 2015.

On October 22, 2015, the Centre confirmed the receipt of the Complaint and Annexes thereof, and transmitted by email to Zhengzhou Zitian Network Technology Co., Ltd. (the Registrar of the domain name) a request for registrar verification in connection with the domain name at issue. On the same day, the said Registrar made the said verification to the Centre, and pointed out that the language used in the Registration Agreement is Chinese.

On November 3, 2015, the Centre confirmed the receipt of case fee from the Complainant. On November 9, the Centre sent the Complainant a request to translate the Complainant into Chinese on or prior to November 14, 2015. On November 12, 2015, the Complainant submitted to the Centre a request that English be used as the language of the administrative proceeding. On November 23, 2015, the Centre confirmed the receipt of the language

request from the Complainant, and expressed that it shall forward the request to the Respondent and refer the language issue to be decided by the Panelist.

On November 23, 2015, the Centre sent the formal Complaint Notice to the Respondent and requested the Respondent to reply within 20 days (on or prior to December 13) in accordance with the Rules and Supplement Rules, and forwarded the Complaint, all the Annexes thereof as well as the language request from the Complainant. The procedures for this case formally commenced on November 23, 2015.

On December 15, 2015, the Centre issued a Default Notice and confirmed that the Respondent did not file a formal reply with the Centre, within the required time limit for filing a reply.

On December 15, 2015, the Panel candidate considered that it was properly constituted and submitted the acceptance notice as well as a statement of impartiality and independence. On the same day, the Centre notified both parties and the Panel Mr. Matthew Murphy by email that Mr. Matthew Murphy be the sole panelist for arbitrating this case. The Centre then formally transferred the case to the Panelist. The Panelist agreed to deliver his decision with respect to the Disputed Domain Name on or prior to December 29, 2015.

3. Factual background

For the Complainant

The Complainant, PANDORA A/S, claims that, it was founded in 1982 in Copenhagen by Danish goldsmith Per Enevoldsen and his wife Winnie, and was initially emphasized on importing jewelry from Thailand for resale and wholesale in Denmark. It further claims that, starting from 1987, the Complainant shifted its business from retail activities to design and manufacture its own jewelry, and it even hired in-house designers and established a manufacturing site in Thailand in 1989.

The Complainant claims that it launched its popular charm bracelet concept in the Danish market in 2000, and then introduced its jewelry to the United States and Canada, Germany and Australia in the following years, and had become an international company since then. The Complainant further claims that its products are sold in more than 90 countries on six continents through approximately 9,600 points of sale including 1,400 concept stores. In addition to stores that are selling the Complainant's charm bracelets along with rings, necklaces and customizable earrings, the Complainant also claims that it had opened 4 manufacturing facilities in Thailand from 2005 to 2010.

The Complainant claims that its success can be attributed to its vertically integrated business model from in-house design and manufacturing to global marketing and direct distribution in most markets, and it employs more than 12, 400 people worldwide. It is said that it is publicly listed on the NASDAQ Copenhagen stock exchange in Denmark and its total revenue was DKK 11.9 billion (Approximately EUR 1.6 billion) in 2014.

The Complainant claims that, it (along with its subsidiaries) is the owner of "PANDORA" trademark registrations across various jurisdictions, including but not limited to, No. 7530638 in class 3, No. 7530640, No. 7530741, G979859 in class 14 registered in China, No. 000653519 (class 22, 24, 25, 26), No. 003397858 (class 14) and 006646491 (class 14, 18, 25) registered at the Office for Harmonization in the Internal Market (OHIM). The

Complainant further claims that its two primary domain names including www.pandora.net and www.pandoragroup.com.

For the Respondent

The Respondent, LiQiong Zheng (郑丽琼), an individual at Li Chen Qu Zhen Hai Jie Dao Zhen Hai Nan Jie 116 Hao, PuTian Shi, Fujian Sheng, 351100 China. The Respondent registered the Disputed Domain Name on September 6, 2015. The Respondent did not file any Reply or other materials with the Centre.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights:

The Complainant claims that the trademark registrations has shown that it is the true owner of the trademarks mentioned above, and the Disputed Domain Name can be considered as capturing, in its entirety, its PANDORA trademark and simply adding the French generic term "bijoux" (which means "jewelry") and the term "fr" (which denotes "France") to the end of the trademark. The Complainant argues that the addition of generic or descriptive terms is not sufficient to overcome a finding of confusingly similarity. So does the addition of a geographic term or place name. As to the gTLD ".net" of the Disputed Domain Name, the Complainant considers that such part shall not affect the domain name for the purpose of determining whether it is identical or confusingly similar.

The Complainant contends that the Respondent's use of "bijoux" and "fr" along with its trademarks only serves to underscore and increase the confusing similarity between the Disputed Domain Name and its trademarks, on the grounds that 1) the Complainant is famous for its "PANDORA" jewelry; 2) the Complainant maintains a physical presence in France and operates a French version of its website selling jewelry at <http://www.pandora.net/fr-fr>. Therefore, the addition of the said terms creates the impression that the Disputed Domain Name is somehow connected to the Complainant and its trademarks and brand, which enhances the confusing similarity with the Complainant's trademarks.

In addition, the Complainant further argues that the Respondent's use of the Disputed Domain Name also contributes to the confusion: the Respondent uses the Disputed Domain Name to redirect Internet users to the websites <pandorabijouxfra.com> and <fr-pandora.org>, which give the impression of being associated with the Complainant by displaying its PANDORA trademark and logo on their websites. Furthermore, the Complainant claims that the said two redirected websites are not only visually similar to the Complainant's official website, but also selling, what appears to be, the Complainant's jewelry products when in fact they are counterfeit goods. Thus, the Complainant considers that the Respondent intended to the Disputed Domain Name to be confusingly similar to

the Complainant's trademarks as a means of furthering consumer confusion and as part and parcel of the Respondent's counterfeiting scheme.

- ii. The Respondent has no rights or legitimate interests in respect of the domain name:

The Complainant claims that the trademark registrations mentioned above are prima facie evidence of its ownership to the valid "PANDORA" trademarks and its exclusive right to use the said trademarks. The Complainant contends that the Respondent is not sponsored by or affiliated with it in any way by the Complainant, nor having been given permission to use its trademarks in any manner, including in domain names.

The Complainant argues that the Respondent is not commonly known by the Disputed Domain Name, nor using it for a bona fide offering, or for a legitimate noncommercial or fair use. Instead, the Complainant points out that the Respondent uses the Disputed Domain Name to redirect Internet users to two commercial websites which imitate as the Complainant's official France website by displaying the PANDORA trademarks and logo thereof and offer counterfeit goods.

- iii. The disputed domain name has been registered and is being used in bad faith:

The Complainant claims that it and its PANDORA trademarks are internationally known; and the way the Disputed Domain Name was registered by capturing its trademark as well as adding the said terms above, has demonstrated the Respondent's knowledge of and familiarity with the Complainant's brand and business. Thus, the Complainant concludes that the Respondent would have been aware of the Complainant's brands when the Disputed Domain Name was registered.

The Complainant claims that the use of the Disputed Domain Name by the Respondent does not only create a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the Complainant by using the fame of the Complainant's trademarks for the Respondent's own commercial gain, but also constituting a disruption of the Complainant's business and qualifying as bad faith registration and use.

In addition, the Complainant claims that it complained to Respondent's Internet Service Provider (ISP) about the Disputed Domain Name through REACT by email on 21 September 2015, which resulted in the Disputed Domain Name being temporarily disabled. The Complainant considers that it indicates that the Respondent at least turned a blind eye to a source of objection to his domain name.

B. Respondent

The Respondent did not submit any Reply.

5. Findings

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 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.

Language of the Proceedings

The Complaint was filed with the Centre in English, whereas the Registrar of the Disputed Domain Name confirmed to the Centre that the language used in the Registration Agreement is Chinese. When the Complainant was requested to submit Chinese translation of the Complaint, the Complainant submitted a request that English be the language of the administrative proceedings instead, based on the following reasons: 1) The Respondent has the ability to understand English; 2) Translation would incur expense and delay filing; and 3) English is the most widely spoken language in the world and having the proceedings administered in English would make the proceedings easy for both of the parties.

As it is stated in a previous case, when deciding "whether to allow the proceedings to be conducted in a language other than the language of the Registration Agreement, and to require the Complainant in an appropriate case to translate the Complaint into the language of that agreement, the Panel must have regard to all 'relevant circumstances'". And such circumstances include "whether the Respondent is able to understand and effectively communicate in the language in which the Complaint has been made and would suffer no real prejudice, and whether the expenses of requiring translation and the delay in the proceedings can be avoided without at the same time causing injustice to the parties". *See WIPO Case SWX Swiss Exchange v. SWX Financial LTD, D2008-0400.*

Accordingly, the Panel notes circumstances that may affect the determination of the language of the proceedings in the current case as followings:

- (1) The website connected to the Disputed Domain Name is a French website; nevertheless, it also contains English description of the goods sold on the said website.
- (2) The Respondent had been notified of the Complaint against him/her and invited to provide comments on the Complainant's language request through emails communications written in both Chinese and English by the Centre.
- (3) The Respondent did not raise any objection with respect to the Complainant's language request, nor make any comments.
- (4) The Complainant, as a Danish company, is not able to understand Chinese at all, and all the materials (including hundreds of pages of Annexure) presented thereby are in English, which would take a lot of time and additional cost for such Chinese translation, and therefore, a delay in the proceedings will be inevitable.

Based on the above, the Panel considers that: it is reasonable to infer that the Respondent probably has the language ability of both French and English, and therefore, should be able

to understand English used in the proceedings. Even if the Respondent might have any difficulty in understanding English, since all the email communications were written in both Chinese and English, the Respondent must have been fully aware of the language request raised by the Complainant, and should have understood that what would happen if the proceeding is determined to be conducted in English. However, with sufficient time and opportunity to comment on or object to such language request, the Respondent did nothing.

Thus, upon weighing relevant circumstances from both sides, the Panel considers that it would be appropriate to exercise its discretion and conduct the proceedings in English.

A) Identical / Confusingly Similar

The Complainant has established its right to the “PANDORA” trademarks by submitting trademark registrations across various jurisdictions, such as China, OHIM and so on.

There is no doubt that the Disputed Domain Name <pandorabijouxfr.net> completely incorporates the Complainant’s “PANDORA” trademark at its first part, and such incorporation makes the Disputed Domain Name confusingly similar with the Complainant’s trademark. That is because “the first and immediately striking element in the Domain Name is the Complainant’s name. Adoption of it in the Domain Name is inherently likely to lead people to believe that the Complainant is connected with it.” See *WIPO Case Dixons Group Plc v Mr. Abu Abdullaah, D2000-0146*.

With respect to the addition of the French word “bijoux” as well as alphabet combination “fr” after the “pandora”, the word “bijoux” means “jewelry”, which implies the content of the website connected to the Disputed Domain Name, an online jewelry shop; whereas the “PANDORA” of the Complainant is actually a jewelry brand, which is selling similar products as those of the website connected to the Disputed Domain Name. In other words, the descriptive term “bijoux” added after the Complainant’s mark in the Disputed Domain Name, contributes nothing to distinguish the Disputed Domain Name from the Complainant’s mark, but merely describes the nature of the Complainant’s core business/brand. As to the “fr”, considering that the website connected to the Disputed Domain Name is a mainly a French website and aims at French speaking customers, it is reasonable to infer that the “fr” is referred to “France”. Thus, it means that the added “fr” can be deemed as a geographical term, which does not help much to reduce the confusing similarity.

In conclusion, the Panel finds that the Complainant has satisfied the Policy 4 (a)(i).

B) Rights and Legitimate Interests

As the right owner of the “PANDORA” trademarks, the Complainant has confirmed that it is not a sponsor of or affiliated with the Respondent in any way, nor has given the Respondent permission to use its trademarks in any manner, including in domain name.

When it comes to determine whether the Respondent has any legal right and interest to the Disputed Domain Name or not, the mere registration of the Disputed Domain Name by the Respondent itself is not sufficient to prove that it owns legal right and interest thereof; otherwise, “all registrants would have such rights or interests, and no complainant could

succeed on a claim of abusive registration”. See: Adobe Systems Incorporated v. Domain OZ, WIPO Case No.: D2000-0057.

The Panel notes that the Respondent failed to prove and there is no evidence indicating that he/she has been commonly known by the Disputed Domain Name, nor has making a legitimate noncommercial or fair use thereof, as it is provided in the Policy 4 (c). On the contrary, the Complainant pointed out that, Disputed Domain Name was used to redirect visitors to a website that has not only been using the Complainant’s trademarks and logo without authorization, but also selling, what appears to be, counterfeit jewelry under the Complainant’s brand. Obviously, using the Disputed Domain Name to redirect visitors to a copycat website of the Complainant does not count for “bona fide offering of goods or services”. Not to mention, such use is also indication of bad faith use.

In conclusion, the Panelist finds that the Complainant has satisfied the Policy 4 (a)(ii).

C) Bad Faith

Upon taking factors as followings into consideration:

- (1) the nature of the Complainant’s core business, which is jewelry;
- (2) the fame of the Complainant and its “PANDORA” trademarks accumulated in the jewelry business;
- (3) the way the Disputed Domain Name is composed, which combines the Complainant’s “PANDORA” trademark with a descriptive term that describing the nature of the Complainant’s business/brand, as well as a geographical term that indicating its potential Internet users;
- (4) the way the Disputed Domain Name was used, prior to being disabled upon a complaint made to the Respondent’s ISP by the Complainant, which was to redirect visitor to a copycat website of the Complainant that uses the Complainant’s trademarks and logo, without authorization thereof, to sell counterfeit jewelry.

Accordingly, it is reasonable for the Panel to infer that the Respondent must have been aware of the Complainant and its “PANDORA” trademark while registering the Disputed Domain Name based on the factor (1)-(3) above, and such registration with prior knowledge of the Complainant’s trademark indicates bad faith registration.

Moreover, such bad faith registration is further supported by the way the Disputed Domain Name was used as it is stated in the factor (4) above: when internet users were attracted to and clicked the Disputed Domain Name due to the confusing similarity between the said domain name and the Complainant’s trademarks, they would be immediately redirected to the said copycat website. The fact that the said copycat website has been unauthorized using the Complainant’s trademarks and logo to sell counterfeit goods, would increase the confusion among the consumers and mislead them to believe that they were visiting the “real” website. Thus, the Panel concludes that the Disputed Domain Name has been used in bad faith as well.

In conclusion, the Panel finds that the Complainant has satisfied the Policy 4 (a)(iii).

6. Decision

Pursuant to paragraphs 4(i) of the Policy and Article 15 of the Rules, the Panelist orders that the disputed domain name <pandorabijouxfr.net> be transferred to the Complainant.

Matthew Murphy
Sole Panelist

Dated: December 23, 2015