



Asian Domain Name Dispute Resolution Centre

hong kong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1500800
Complainant:	Promgirl LLC
Respondent:	Ma Gang
Disputed Domain Name(s):	<fabulouspromgirl.com>

1. The Parties and Contested Domain Name

The Complainant is Promgirl LLC, of 105 Sleepy Hollow Dr., Ste C, Middletown, Delaware 19709, United States of America (USA). The authorized representative of the complainant is Kelly Hay, of 1441 Broadway, 21st Floor, New York, NY 10018, USA.

The Respondent is Ma Gang, of Daxiyangxincheng, Beijing 100102, People's Republic of China (PRC).

The domain name at issue is <fabulouspromgirl.com>, registered by Respondent with GoDaddy.com LLC, of 14455, Hayden Rd Suite 219, Scottsdale, Arizona, 85260, USA.

2. Procedural History

On October 16, 2015, the Complainant submitted the Complaint in English on domain name <fabulouspromgirl.com> to the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (the "Centre"), in accordance with the Uniform Domain Name Dispute Resolution Policy (the "Policy") adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy Disputes (the "Rules") approved by ICANN on October 24, 1999, and the Asian Domain Name Dispute Resolution Centre Supplemental Rules in effect as of February 28, 2002. The Complainant requested a single person panel.

After receiving the Complaint, the Centre, in accordance with the Supplemental Rules, verified that the Complaint complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on October 16, 2015, the Centre requested the Registrar to confirm: (1) that the disputed domain name was registered with the Registrar, (2) whether the Respondent is the registrant or holder of the name, and (3) whether the Policy applies to the name; and to specify: (4) the language of the Registration Agreement of the disputed domain name, (5) WhoIs information for the disputed domain name, and (6) the current status of the domain name. Also, by email message dated October 16, 2015, the Center confirmed the receipt of the Complaint, together with Annexures 1 to 11.

By email message dated October 23, 2015, the Center reiterated its request made to the registrar on October 16, 2015.

On October 24, 2015, the Registrar provided its response to the Centre through which it confirmed that: (1) the name was registered with GoDaddy.com LLC, (2) the Respondent is the registrant or holder of the name, and (3) the Policy applies to the name. The Registrar also stated that (4) the registration agreement is in the English language, (5) provided name and contact information pertinent to the name as reflected in its WhoIs database, and stated that (6) the domain name was locked and would remain locked during the pending administrative proceeding.

On October 30, 2015, the Centre sent the Complaint to the Respondent. The Respondent was then provided with a 20 calendar day period, expiring on November 19, 2015, to file its Response both with the Centre and the Complainant. As of November 20, 2015, the Respondent had not filed any Response with the Centre. Accordingly, on November 24, 2015, the Centre advised the parties by email that the Respondent had not filed any Response to the Complaint with the Centre on or before the November 19, 2015 deadline and, as such, the Centre would then proceed to appoint a Panelist for this matter.

Pursuant to the Rules and Supplemental Rules, the Centre, by email dated November 30, 2015, contacted the undersigned, Prof. Dr. Julien Chaisse, requesting his service as a Sole Panelist for this dispute. Subsequently, on the same day, Prof. Chaisse responded and affirmed his ability to act completely independently and impartially in this matter. Subsequently, the Centre, through an email dated November 30, 2015, notified the Parties of the appointment of Prof. Chaisse as the Sole Panelist. The Panel finds that the Administrative Panel was properly constituted and appointed in accordance with the Rules and the Supplemental Rules. Based on the deadline set forth in paragraph 15 of the Rules, a decision was to be issued by the Panel to the Center on or before December 14, 2015.

3. Factual background

The Complainant: Promgirl LLC

A. The Complainant's Promgirl Marks

The Complainant, Promgirl LLC, is a Licensee of the trademark PROMGIRL by the Licensor "Prom LLC". In Annexure 3 to the Complaint, the Complainant provided its trademark registration in the USA where "Prom LLC" holds the Service Mark for the word PROMGIRL under registration number 4112378 since March 13, 2012.

Furthermore, in Annexure 4 to the Complaint, the Complainant provided evidence that Promgirl LLC owns the Trademark on the Design plus words, letters and/or numbers for PROMGIRL under registration number 4109452. The registered PROMGIRL Service and Trademarks designate online retail store services featuring clothing, namely dresses, blouses, skirts, shirts, pants, jeans, jumpsuits, overalls, and accessories, namely, shoes and handbags. The PROMGIRL mark has gained a worldwide reputation after continuous extensive use and marketing throughout the world.

The Complainant also provided in Annexure 5 to the Complaint the Trademark License Agreement. Under section 7.2 of the Trademark License Agreement, it is stated that “[I]f anyone else is using a mark which is the same as or confusingly similar to the mark, Licensee may take whatever action it deems appropriate, including the institution of any action or proceeding against the user, to assure the discontinuance of the use of the allegedly infringing mark.”

B. The Complainant and its activities

Promgirl LLC was founded in 1998 as a small store for special occasion dresses and fashions, primarily for teenage girls. In 1999, Promgirl LLC launched the domain name Promgirl.com. In Annexure 2 to the Complaint, the Complainant provided evidence that Promgirl LLC registered the domain name “promgirl.com” on January 22, 1999 with the business purpose of being an online retailer, specializing in special occasion dresses. Since then, Promgirl LLC business has expanded significantly and is now a premiere online retail destination well-known for stocking special occasion styles for all ages, shapes and sizes from over 100 different designers and manufacturers.

Promgirl LLC has gone on to offer styles for every occasion from proms to dances to everyday events. The company shipped over 300,000 orders to customers across the U.S.A, Canada, Europe, Asia and South America in 2014 and exceeded US\$50 million in global sales. In 2012, Promgirl LLC was listed at #42 on Inc. Magazine's fastest growing retailers and in its busiest time of year, see millions of monthly unique visitors to its website. Promgirl LLC is listed on the Internet Retailer's top 500 list of ecommerce sites and regularly partner with larger brands such as Sephora, Jos A Bank, and Disney. Promgirl LLC operates its business under the PROMGIRL marks and has registered a number of domain names in addition to several trademarks around the name PROMGIRL and PROM in general.

The Respondent

As indicated in the WhoIs registration record provided in Annexure 1 to the Complaint, the Respondent registered the disputed domain name on April 7, 2012. Since October 24, 2015, the Disputed Domain Name has been locked by the Registrar and is currently inactive. The Centre confirmed that documents have been sent to the Respondent's address as registered with the registrar. However, the Centre did not receive a Response from the Respondent for the Domain Name Dispute within the required period of time. The Respondent is to be considered in default.

4. Parties' Contentions

The Respondent is using the domain fabulouspromgirl.com to sell similar products to the ones sold by the Complainant and they are doing so using a name that violates Promgirl LLC's trademark rights.

Since the Respondent defaults, the Panel understands that the Complainant bears the burden of pleading at least a prima facie case. See, e.g., *Cyro Industries v. Contemporary Design*, WIPO, No. D2000-0336, Jun. 19, 2000 (holding that in cases of default, panels must pay special attention to evaluating the accuracy of Complainant's submissions); *Softquad Software Inc. v. Eleven-Eleven Ltd, DeC*, No. AF-0143 (Jun. 1, 2000) (stressing

that in default cases, the burden of proving required elements remains with the Complainant).

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. The disputed domain name(s) is/are identical or confusingly similar to a trademark or service mark in which the Complainant has rights

The Complainant submits that Disputed Domain Name *fabulouspromgirl.com* is confusingly similar to the Complainant's trademark PROMGIRL because the visual and conceptual similarities:

With regard to the visual Similarity, the prominent and distinctive part of the Disputed Domain Name *fabulouspromgirl.com* is the word "promgirl", which is identical to the Complainant's mark PROMGIRL. The work "promgirl" has strong visual impact.

With regard to the conceptual Similarity, the Complainant argues that since ".com" is not taken into account in the comparison, internet users would easily separate "fabulous" + "promgirl" when identifying the Disputed Domain Name. Since the word "fabulous" can be defined as a "very good", it only adds to the confusion. Therefore, "fabulouspromgirl" as a domain name can easily be understood as "a very good PROMGIRL website". It is obvious that "promgirl" is the central and distinguishing element of the Disputed Domain Name and will undoubtedly cause confusion.

Moreover, the Disputed Domain Name currently operates an online retail store selling special occasion dresses, a business in which Promgirl LLC has a strong reputation. The images used on *fabulouspromgirl.com* are stolen copyrighted images from Promgirl LLC (Annex 6). This is further evidence that the Respondent is promoting this website as an official PROMGIRL website. Thus, the Disputed Domain Name can easily mislead consumers to believe that *fabulouspromgirl.com* is owned or operated by Promgirl LLC, or the Respondent has certain relations with Promgirl LLC.

From these facts, it is argued that it is apparent that the Disputed Domain Name is confusingly similar to the Complainant's PROMGIRL marks and that the respondent intended to, and is currently, riding on the reputation of Promgirl LLC's business.

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

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because of the Unauthorized Use of mark PROMGIRL, the meaning of PROMGIRL in ordinary language, the illegitimate use of domain for commercial gain, and the absence of *bona fide* offering of goods or services.

Firstly, the Respondent has never been authorized, licensed or otherwise permitted by the Complainant or its Licensor to use the mark PROMGIRL under any circumstances. The Respondent has no business relationship with the Complainant or its Licensor. The Respondent's name, address and other information cannot be linked with PROMGIRL.

Further searches by the Complainant do not prove that the Respondent has any other rights with regard to the PROMGIRL mark.

Secondly, PROMGIRL is not a common term in usage and has no meaning except as a well-known registered mark. The respondent does not have any legitimate interests in registering or using part or the whole of the Disputed Domain Name. The Complainant and its PROMGIRL trademarks are well-known for its business due to its long time operation and global sales. Therefore, it is likely that average online users searching for “PROMGIRL” are intending to visit the Complainant’s website, and will be attracted and diverted to the Respondent’s website, due to the similarity between the Disputed Domain Name and the Complainant’s trademarks.

Thirdly, the Respondent is operating with intent to misleadingly divert consumers for commercial gain. They are stealing Promgirl LLC owned images and selling similar products using them (Annex 6). They are not authorized retailers of the dresses advertised on their site. This is evidenced by the infringing use of Promgirl LLC and multiple other manufacturer images, shown by the copyright removal requests in the Google Transparency Report (Annex 7). In addition, they are tarnishing the reputation of the PROMGIRL mark as customers often confuse the two websites and disgruntled customers of fabulouspromgirl.com write negative reviews for the PROMGIRL mark in general.

Fourthly, the Respondent has been consistently, without obtaining prior consent, using the Complainant’s images and other manufacturers’ images to describe the goods sold on the Respondent’s website, and such use could not be deemed as a “bona fide offering of goods” since the offering of goods has involved copyright infringement activities involving the Complainant’s copyright (Annex 6-9).

- iii. The disputed domain name(s) has/have been registered and is/are being used in bad faith:

The Complainant submits that the Respondent has shown bad faith in registering and using fabulouspromgirl.com because of two essential reasons: on the one hand, the Respondent was aware of PROMGIRL trademark and activities, and, on the other hand, there is an intent to cause confusion.

Firstly, the Respondent was aware of the mark PROMGIRL well before registering <fabulouspromgirl.com>. The Disputed Domain Name was registered on April 7, 2012 while the Complainant’s domain name was registered 13 years prior on January 22, 1999. The Disputed Domain Name was registered long after PROMGIRL attained a reputable, worldwide name and brand after continuous extensive uses and marketing throughout the world. Given the well-known worldwide presence of the PROMGIRL mark and given that the respondent runs an online store selling special occasion dresses, the exact business of the Complainant, it is most unlikely that the respondent is unaware of the Complainant’s marks. It cannot be mere coincidence that the respondent has chosen the disputed domain name, which is confusingly similar to the Complainant’s marks and it is registered and actively used domain name <promgirl.com>. The Respondent is using stolen copyrighted images from Promgirl LLC to sell dresses (Annex 6), which additionally proves the Respondent’s awareness of the PROMGIRL mark.

Secondly, the Complainant argues that the Respondent has intentionally attempted to attract, for commercial gain, internet users to <fabulouspromgirl.com> by creating a

likelihood of confusion with Promgirl LLC's marks as to the source, sponsorship, affiliation, or endorsement of the respondent's website. A Google search result for the term "promgirl prom dress" and "promgirl" shows that the Respondent has paid for Google advertisements in order to intentionally appear first in search results before the Complainant's <promgirl.com>, disrupting the business of <promgirl.com> and misleadingly diverting customers with intent for commercial gain by creating a likelihood of confusion with the PROMGIRL mark.

Furthermore, the Complainant provided evidence that these paid advertisements use language such as "prom girl dresses" to promote their site, deliberately leading customers to believe that Respondent's site is an official PROMGIRL site (Annex 8). Also the Complainant brought to the Panel attention emails containing DMCA Google Adwords infringement notices that show Google has reviewed these copyright infringements and disapproved their advertisements from their system (Annex 9). The Respondent's website <fabulouspromgirl.com> is visually similar to Complainant website promgirl.com (Annex 10). Both feature a pink and white motif along with a pink navigation banner at the top and many similar icons/links. The respondent is also using a logo similar to the PROMGIRL logo, featuring a crown over the lettering, a signature design feature of the trademarked PROMGIRL logo (Annex 4). Their homepage also features many of Promgirl LLC's copyrighted photographs that are for exclusive use on promgirl.com only, further adding to the visual confusion between the two sites.

In essence, the customer is being led to believe that they are purchasing an authentic dress when Respondent is not an authorized retailer for any of these dresses so therefore cannot actually be selling advertised dress (Annex 7). A Google Transparency Report for fabulouspromgirl.com contains 596 copyright removal requests from various copyright owners/companies including Promgirl LLC, proving that the respondent is stealing copyrighted photos from Promgirl LLC as well as multiple other dress manufacturer vendor partners of Promgirl LLC and is not an authorized retailer of any of these manufacturers. If respondent were an authorized retailer, they would have authorization to use manufacturer's photos and would not have Google copyright violations against them (Annex 7).

For the foregoing reasons, it can be reasonably inferred that the Respondent was aware of the Complainant's PROMGIRL marks well before registering the Disputed Domain Name and that they are intentionally attempting to attract users for commercial gain by creating a likelihood of confusion.

B. Respondent

The Respondent's contentions may be summarized as follows:

As indicated in the procedural history, the Respondent was provided with a 20 calendar day period, expiring on November 19, 2015, to file its Response both with the Centre and the Complainant.

In this connection, the Respondent is to be considered in default and the Panel will decide the dispute based on the information available to it and may draw such inferences as it deems appropriate from the Respondent's failure to submit a timely Response.

5. Findings

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(e), 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 representations.

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.

A) Identical / Confusingly Similar

The Complainant has established its rights in the trademark "PROMGIRL" with various registrations for such a name (See Annexes 3, 4 and 5 to the Complaint).

The Complainant has submitted conclusive evidence that the domain name <fabulouspromgirl.com> is confusingly similar to its trademark "PROMGIRL".

The main differences between the disputed domain name and the Complainant's mark is the addition of the adjective "fabulous" before the Complainant's mark.

This does not render the said domain name totally distinctive from the Complainant's trademark. Previous UDRP panels have consistently held that a domain name is identical or confusingly similar to a trademark for purposes of the Policy "when the domain name includes the trademark, 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).

In effect, UDRP panels have found domain names to be identical or at least confusingly similar when based on "close variant" or "close misspelling" of the mark in question (e.g. *AltaVista Company v. Grandtotal Finances Limited et al.*, WIPO Case No. D2000-0848; *Yahoo!Inc. v. Eitan Zviely et al.*, WIPO Case No. D2000-0273; *Société des Bains de Mer et du Cercle des Etrangers à Monaco v. Integrity Ltd.*, WIPO Case No. D2005-0404; *Guccio Gucci S.p.A. v. Huangwensheng, Shirley, wangliang, xiaomeng xiexun, jiangxiuchun*, WIPO Case No. D2012-0342).

There is no reason in the instant matter to depart from these decisions under the circumstances described above, not rebutted by the Respondent.

Thus, the Panel finds that the use of the word "fabulous" is not sufficient to negate the confusing similarity between the disputed domain names and the trademark. By contrast, the addition of certain words can "exacerbate [...] the confusing similarity between the [Complainant's] trademark and the Domain Name and increase [...] the risk of confusion between the Domain Name and the... trademarks". (*B & H Foto & Electronics Corp. v. Joel Deutsch*, WIPO Case No. D2010-2121). The Panel therefore holds that Complaint fulfils the first condition of paragraph 4(a) of the Policy.

B) Rights and Legitimate Interests

Given the finding that the disputed domain name is confusingly similar to the PROMGIRL mark, the Panel concludes that Respondent cannot be found to be using the domain name in connection with a *bona fide* offering of goods, within the meaning of paragraph 4(c)(i) of the Policy. Nor is there any evidence in the case file that any of the other circumstances set forth in paragraph 4(c) of the Policy is applicable.

C) Bad Faith

Complainant has adduced evidence to prove that by using confusingly similar disputed domain names, Respondents have intentionally attempted to attract, for commercial gain, Internet users to Respondents' websites offering Complainant's Promgirl products.

The Panel finds that it is not conceivable that Respondent would not have had actual notice of Complainant's trademark rights at the time of the registration of the disputed domain name. The Panel also finds that the trademarks are not one that traders could legitimately adopt other than for the purpose of creating an impression of an association with Complainant. (*The Argento Wine Company Limited v. Argento Beijing Trading Company*, WIPO Case No. D2009-0610). Moreover, Respondent has chosen not to respond to Complainant's allegations in the Complaint. According to the panel's decision in *The Argento Wine Company Limited v. Argento Beijing Trading Company*, supra, "the failure of Respondents to respond to the Complaint further supports an inference of bad faith". (see also *Bayerische Motoren Werke AG v. (This Domain is For Sale) Joshuathan Investments, Inc.*, WIPO Case No. D2002-0787).

Complainant claimed that the Respondent attempted to sell counterfeit Promgirl branded products on their websites. Also, screenshots of Google (annex 8) search results for "promgirl prom dress" and "promgirl" show that Respondent has paid for Google advertisements in order to intentionally appear first in search results before promgirl.com, disrupting the business of promgirl.com and misleadingly diverting customers with intent for commercial gain by creating a likelihood of confusion with the PROMGIRL mark. They are further creating a likelihood of confusion by using the text "prom girl dresses" in their advertisement, deliberately leading customers to believe that Respondents site is an official PROMGIRL site.

Given the widespread reputation of the trademarks, the Panel finds that the public is likely to be confused into thinking that the disputed domain name has a connection with Complainant, contrary to the fact. There is a strong likelihood of confusion as to source, sponsorship, affiliation or endorsement of the website to which the disputed domain name resolve (see Annexes 3 to 11 to the Complaint). In other words, the Respondent has through the use of confusingly similar disputed domain name created a likelihood of confusion with Complainant's trademarks. Moreover, the Respondent has not responded to the Complaint. The Panel therefore concludes that the disputed domain name is being used by Respondent in bad faith. The passive holding of some of the disputed domain name also amounts to use in bad faith in the circumstances of this case.

In summary, Respondent, by choosing to register and use the disputed domain name which is confusingly similar to Complainant's well-known trademarks, intended to ride on the goodwill of Complainant's trademarks in an attempt to exploit, for commercial gain,

Internet users destined for Complainant. In the absence of evidence to the contrary and rebuttal from Respondent, the choice of the disputed domain name and the conduct of Respondent as far as the website to which the disputed domain name resolve is indicative of registration and use of the disputed domain names in bad faith. The Panel therefore holds that the Complaint fulfils the third condition of paragraph 4(a) of the Policy.

6. Decision

Based on the above analysis, the Panelist decides that: (1) the disputed domain name <fabulouspromgirl.com> is confusingly similar to the Complainant's name or mark in which the complaint has rights; (2) the Respondent has no right or legitimate interest in respect of the disputed domain names; (3) the Respondent has registered and is using the domain name in bad faith.

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panelist grants the relief sought by the Complainant. The disputed domain name, <fabulouspromgirl.com>, is ordered transferred to the Complainant.

Prof. Julien Chaisse
Panelist

Dated: December 13, 2015