



**(Hong Kong Office)**

**ADMINISTRATIVE PANEL DECISION**

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<b>Case No.</b>	<b>HK-1500790</b>
<b>Complainant:</b>	<b>Promgirl LLC</b>
<b>Respondent:</b>	<b>Changkang Wen</b>
<b>Disputed Domain Name:</b>	<b>&lt;thepromgirls.com&gt;</b>

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**1. The Parties and the Disputed Domain Name**

The Complainant is Promgirl LLC of Delaware, USA, represented by Kelly Hay of New York, USA.

The Respondent is Changkang Wen of Suzhou, China, represented by Kevin Xiao, of Beijing, China.

The domain name at issue is <thepromgirls.com>, registered by the Respondent with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

**2. Procedural History**

The Complaint was filed with the Hong Kong office of the Asian Domain Name Dispute Resolution Center (the “Center”) on September 18, 2015. On September 18, 2015, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 18, 2015, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant of the disputed domain name and providing the Respondent’s contact details.

The Center has verified that the Complaint satisfies the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy”), the Rules of Procedure under the Policy (the “Rules”) and the Center’s Supplemental Rules.

In accordance with the Rules, the Center formally notified the Respondent of the Complaint, and the proceeding commenced, on September 25, 2015. In accordance with the Rules, the due date for the Response was October 15, 2015. The Response was filed on October 9, 2015.

The Center appointed Sebastian Hughes as the Panelist in this matter on October 30, 2015. The Panel finds that it was properly constituted and has acted impartially in reaching its conclusion.

On November 1, 2015, the Respondent's representative, Kevin Xiao, sent a unilateral unsolicited email to the Panel, without copying in the Complainant's representative and the Center. On November 3, 2015, the Center forwarded a copy of the Respondent's unilateral email to the Complainant's representative and, on November 3, 2015, the Respondent's representative sent an email in response (this time copied to the Center and to the Complainant's representative).

### **3. Factual background**

#### **A. Complainant**

The Complainant is a company incorporated in Delaware in the USA and the licensee of the trade mark PROMGIRL registered in the name of Prom, LLC in the USA under registration number 4,112,378. The Complainant is also the owner of registration number 4,109,452 in the USA for the trade mark PROMGIRL and device. Both of these marks (the "Trade Marks") were filed on May 3, 2006 with dates of first use in commerce of January 21, 1999.

The Complainant is also the owner of the domain name <promgirl.com>, registered since January 22, 1999.

#### **B. Respondent**

The Respondent is an individual with an address in Suzhou, China.

#### **C. The Disputed Domain Name**

The disputed domain name was registered on November 29, 2012.

#### **D. The Website at the Disputed Domain Name**

The disputed domain name has been used in respect of a website offering for sale prom dresses, homecoming dresses and wedding dresses (the "Website").

### **4. Parties' Contentions**

#### **A. Complainant**

The Complainant contends that the disputed domain name is confusingly similar to the Trade Marks, the Respondent has no rights or legitimate interests in respect of the disputed domain name, and the disputed domain name was registered and is being used in bad faith.

## **B. Respondent**

The Respondent contends that the disputed domain name is not confusingly similar to the Trade Marks, the Respondent has the legal ownership of and the right to use the disputed domain name, and the disputed domain name has not been registered and used in bad faith.

## **5. Findings**

### **5.1 Unsolicited Email Filing**

Under paragraph 8 of the Rules, no party or anyone acting on its behalf may have any unilateral communication with the Panel.

Paragraph 10(d) of the Rules provides the Panel with the full discretion to determine the admissibility, relevance, materiality and weight of the evidence.

The unsolicited unilateral email communication was sent to the Panel, without being copied in on the Complainant's representative and the Center, after the proceeding had commenced, and after the Response had been filed.

In its email to the Center of November 3, 2015, the Respondent's representative stated as follows:

*I am sorry for not reading the Rules carefully, we are afraid that we didn't express our opinion very well in the Response Form, because English is not our mother language, we are not very confident with our English ability, so I send email to Panelist to underscore our standpoint.*

The unsolicited unilateral email dated November 1, 2015 sought to reiterate some of the arguments already contained in the Response.

In all the circumstances, the Panel can see no reason why it should exercise its discretion to admit the contents of the email into evidence, in particular given the express prohibition on unilateral communications with the Panel contained in paragraph 8 of the Rules. The Panel is also mindful of its obligation under paragraph 10(c) of the Rules to ensure that the administrative proceeding takes place with due expedition.

Furthermore, the Panel does not find the explanation of the Respondent's representatives at all convincing. The Panel considers that parties and their representatives should be strongly discouraged from seeking to rely on unilateral communications sent directly to the Panel in breach of the Rules.

### **5.2 Substantive Elements of the Policy**

The Complainant must prove each of the three elements in paragraph 4(a) of the Policy in order to prevail.

## **A. Identical or Confusingly Similar**

The Panel finds that the Complainant has rights in the Trade Mark acquired through registration and use which incidentally predate the date of registration of the disputed domain name.

UDRP panels have consistently held that domain names are identical or confusingly similar to a trade mark for purposes of the Policy “when the domain name includes the trade mark, or a confusingly similar approximation, regardless of the other terms in the domain name”.

The disputed domain name comprises the Trade Marks in their entirety together with the non-distinctive prefix “the” and the letter “s” as a suffix. The use of the word “the” and the plural of “girls” instead of the singular, “girl”, does not serve to distinguish the disputed domain name from the Trade Marks in any significant way, particularly given the content of the Website.

The Panel therefore finds that the disputed domain name is confusingly similar to the Trade Marks and holds that the Complaint fulfills the first condition of paragraph 4(a) of the Policy.

## **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a list of non-exhaustive circumstances any of which is sufficient to demonstrate that a respondent has rights or legitimate interests in the disputed domain name:

- (i) before any notice to the respondent of the dispute, the respondent’s use of, or demonstrable preparations 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; or
- (ii) the respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name even if the respondent has acquired no trade mark or service mark rights; or
- (iii) the respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.

There is no evidence that the Complainant has authorised, licensed, or permitted the Respondent to register or use the disputed domain name or to use the Trade Marks. The Complainant has prior rights in the Trade Marks which precede the Respondent’s registration of the disputed domain name by several years. The Panel finds on the record that there is therefore a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name, and the burden is thus on the Respondent to produce evidence to rebut this presumption.

The Respondent has failed to show that the Respondent has acquired any trade mark rights in respect of the disputed domain name or that the disputed domain name has been used in

connection with a *bona fide* offering of goods or services. To the contrary, the evidence shows that the disputed domain name has been used in respect of the Website, which promotes and offers for sale discounted prom dresses, homecoming dresses and wedding dresses, in direct competition with those offered by the Complainant under the Trade Marks, and which reproduces the images and models used by the Complainant, in clear infringement of the Complainant's copyright.

The Respondent asserts that it did not become aware of the Complainant until 2014. The Panel considers this bare assertion is not supported by the evidence. The uncontested evidence of the Complainant is that it is a well-known and growing global Internet retailer of dresses – the Complainant shipped over 300,000 orders to customers across the USA, Canada, Europe, Asia and South America in 2014 and exceeded US\$50 million in global sales.

On the Respondent's own case, the Respondent has gained lots of customers in the USA and Canada from 2004-2012. In light of this evidence, and given the flagrant infringement of the Complainant's copyright on the Website, the Panel has no hesitation in concluding that the Respondent must have been aware of the Complainant and of its trade mark rights at the time of registration of the disputed domain name.

There has been no evidence adduced to show that the Respondent has been commonly known by the disputed domain name.

There has been no evidence adduced to show that the Respondent is making a legitimate non-commercial or fair use of the disputed domain name.

The Panel finds that the Respondent has failed to produce any evidence to establish rights or legitimate interests in the disputed domain name.

The Panel therefore finds that the Complaint fulfils the second condition of paragraph 4(a) of the Policy.

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

Pursuant to paragraph 4(b)(iv) of the Policy, the following conduct amounts to registration and use in bad faith on the part of a respondent:

“By using the disputed domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's website 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 the respondent's website or location or of a product or service on the respondent's website or location.”

The undisputed evidence of the Complainant demonstrates that the Website is being used to attract Internet users for commercial gain, by reproducing without authorisation the Complainant's copyright images and models, and offering for sale discounted dresses in direct competition with those offered for sale by the Complainant under the Trade Marks.

The uncontested evidence of the Complainant is that the Respondent has paid for Google advertisements in order to intentionally appear first in search results, using language

promoting the Website such as “prom girl dresses” and “Official Site – Buy Cheap Now”. In all the circumstances, and in light of the content of the Website, the Panel considers that the unauthorised use of the disputed domain name in this manner, effectively to pass off the Website as an official authorised online sales outlet of the Complainant and/or of the Complainant’s goods, amounts to further evidence of bad faith.

The Panel therefore finds, in all the circumstances, the requisite element of bad faith has been satisfied, under paragraph 4(b)(iv) of the Policy.

For all the foregoing reasons, the Panel concludes that the disputed domain name has been registered and is being used in bad faith. Accordingly, the third condition of paragraph 4(a) of the Policy has been fulfilled.

## **6. Decision**

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

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Sebastian Hughes  
Sole Panelist

Dated: November 3, 2015