



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

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| Case No. | HK-1500757 |
| Complainant: | Promgirl LLC |
| Respondent: | Weddingwhoo.com, Beijing Touchtel Tech. Co., Ltd |
| Disputed Domain Name(s): | <promgirlshop.com> |

1. The Parties and Contested Domain Name

The Complainant is Promgirl LLC, of 105 Sleepy Hollow Dr., Ste C Middletown, DE 19709.

The Respondent is Weddingwhoo.com, Beijing Touchtel Tech. Co., Ltd, of Room 709, D# Building, SOHO Modern City, Chaoyang District, Beijing, China 100022.

The domain name at issue is promgirlshop.com, registered by the Respondent with GoDaddy.com, LLC of 14455 North Hayden Rd, Suite 219, Scottsdale AZ 85260, United States of America.

2. Procedural History

The Complaint was filed with the Asian Domain Name Dispute Resolution Centre (the “Centre”) on May 29, 2015. On June 1, 2015, the Centre confirmed the receipt of the Complaint and transmitted by email to GoDaddy.com, LLC (the Registrar of the domain name) a request for registrar verification in connection with the domain name at issue. On June 2, 2015, the Registrar made the said verification to the Centre.

The Centre verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the Centre’s Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

On June 4, 2015, the Centre formally sent the Written Notice of Complaint to the Respondent and requested the Respondent to reply within 20 days (prior to June 24) in accordance with the Rules and Supplemental Rules, and forwarded the Complaint as well as all the Annexures thereof. The procedures for this case formally commenced on June 4, 2015. On June 5, 2015, the Registrar notified the Centre that the Disputed Domain Name would remain locked during the pending legal proceeding.

On June 12, 2015, the Respondent sent the Response in Chinese to the Centre. On the same day, the Centre confirmed the receipt of the said Chinese Response and requested the Respondent to submit the Response in English on or prior to June 24. Later that day, the Respondent confirmed the receipt of the Centre's request and sent the Response in English. On June 16, 2015, the Respondent sent an Email to the Centre to inquire as to the progress of the case. On June 17, 2015, the Centre confirmed the receipt of the Response in English, and notified the Respondent that in case the Respondent does not choose the number of Panelist(s) under Section 9 of the Response Form prior to June 19, the Centre will proceed to appoint a single-member Panel to decide the case.

On June 22, 2015, the Centre notified both Parties that no confirmation was received from the Respondent regarding the number of Panelist(s) for this case within the requested period, and proceeded to appoint a single-member Panel in due course. On June 23, 2015, the Centre appointed Mr. Matthew Murphy as the sole panelist in this matter. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence.

On June 26, 2015, the Complainant submitted additional materials for consideration by the Panel. On the same day, the Panelist issued Administrative Panel Order No. 1 to both Parties, and allowed the Complainant to submit supplemental opinions and/or evidence prior to 5:00pm on July 9, 2015. The said Order also allowed the Respondent to reply to the supplemental submission of the Complainant prior to 5:00pm on July 23, 2015.

On July 10, 2015, the Centre affirmed the receipt of the submitted supplemental submission and evidence by the Complainant within the said period. On July 22, 2015, the Respondent submitted a supplemental filing within the said period as well. On the same day, the Centre affirmed the receipt thereof.

3. Factual background

For the Complainant

The Complainant - Promgirl LLC - claims that it was founded in 1998 as a store for special occasion dresses and fashions, primarily for teenage girls. After the Complainant launched its domain name Promgirl.com in 1999, it claims that its business expanded and is now a premiere online retail destination well-known for stocking special occasion styles for all ages, shapes and sizes, as well as styles for every occasion from proms to dances to everyday events. The Complainant claims that it shipped over 300,000 orders to customers in 2014 and exceeded US\$50 million in global sales. In 2012, the Complainant was listed at #42 on Inc. Magazine's fastest growing retailers and in its busiest time of year, saw millions of monthly unique visitors to its website. The Complainant further claims that it is listed on the Internet Retailer's top 500 list of ecommerce sites and regularly partners with larger brands such as Sephora, Jos A Bank, and Disney.

The Complainant, by submitting US Trademark Registration Certificates and a Trademark License Agreement, has attempted to prove that it is a Licensee of the service trademark PROMGIRL (US Trademark Registration No. 4112378, class 35) by the Licensor, Prom LLC. In accordance with the Trademark License Agreement, the Complainant may take appropriate action against "to assure the discontinuance of the use of the allegedly infringing mark." Furthermore, the Complainant owns the Trademark and the Design plus words, letters and/or numbers for PROMGIRL under US Trademark Registration No.

4109452 in class 25. The Complainant also registered the domain name “promgirl.com” on January 22, 1999. (Annex 2-5)

For the Respondent

The Respondent is Weddingwhoo.com, Beijing Touchtel Tech. Co., Ltd, and has listed its address as Room 709, D# Building, SOHO Modern City, Chaoyang District, Beijing, China 100022. The Respondent registered the Disputed Domain Name on February 20, 2014. The Respondent did not provide any further background information or evidence about why it registered the Disputed Domain Name in the Response or supplemental filing.

4. Parties’ Contentions

A. Complainant

The Complainant’s contentions may be summarized as follows:

- i. The Respondent’s domain name is confusingly similar to trademarks in which the Complainant has rights

The Complainant claims that the Disputed Domain Name and its PROMGIRL trademark are confusingly similar, both from a visual and conceptual perspective, on the grounds that the prominent and distinctive part of the Disputed Domain Name “promgirl” are identical to the said mark, whereas the latter part “shop” achieves little to lessen the confusion of online visitors.

Moreover, the Complainant claims that an online retail store selling special occasion dresses is operated at the site attached to the Disputed Domain Name, a business in which the Complainant claims that it has a strong reputation. The Complainant also claims that the Respondent used stolen copyrighted images from the Complainant, in which the Complainant claims to have copyright, on the website attached to the Disputed Domain Name (Annexure 6), which proves that the Respondent is promoting the website as an official PROMGIRL website. The Complainant considers that the Disputed Domain Name is confusingly similar to its 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 right or legitimate interest in respect of the Disputed Domain Name

The Complainant claims that it has never authorized, licensed or otherwise permitted the Respondent to use the mark PROMGIRL under any circumstances; nor has any business relationship with the Respondent. In addition, it claims that the Respondent’s name, address and other information cannot be linked with PROMGIRL, and PROMGIRL is not a common term in usage and has no meaning except as a well-known registered mark.

The Complainant also claims that the Respondent is operating with intent to misleadingly divert consumers for commercial gain, on the grounds that it is stealing Promgirl LLC owned images and selling similar products using them.

The Complainant has submitted screenshots of images from both the website located at the Disputed Domain Name and the Complainant's website (Annexure 6) and the copyright removal request in the Google Transparency Report (Annexure 7) as evidence for the said point.

- iii. The Respondent has shown bad faith in registering and using the domain name.

The Complainant claims that the Respondent was aware of the mark PROMGIRL well before registering the Disputed Domain Name, since it was registered 15 years after the Complainant's domain name and the Complainant's mark had become already well-known in the business of providing special occasion clothing to consumers.

The Complainant further claims that the Respondent intentionally attempted to attract, for commercial gain, online customers to promgirlshop.com by creating a likelihood of confusion with Promgirl LLC's marks as to source, sponsorship, affiliation, or endorsement of the Respondent's website. Apart from the information provided in Annexures 6 and 7 to the Complaint as mentioned above, the relevant evidence for the said point submitted by the Complainant, also includes Google advertisements of the Respondent and DMCA Google Adwords infringement notices that show Google reviewed these copyright infringements and "disapproved" the advertisements from their system (Annexures 8 and 9).

B. Respondent

The Respondent's contentions may be summarized as follows:

- i. The Respondent claims that a large difference exists in terms of spelling between the Disputed Domain Name <promgirlshop.com> and the Complainant's domain name <promgirl.com>; and the logos and trademarks of the two domain names are completely different.
- ii. The Respondent claims that the design and layout of the Disputed Domain Name shares no similarities with the Complainant's domain name. The Respondent further claims that it has stated at the "Contact us" and "About us" pages of the website attached to the Disputed Domain Name, that it is owned by QANDIES LIMITED; and the billing address is listed as being in the UK, which implies that the Website is not an American company and has no connection with promgirl.com.
- iii. The Respondent claims that a clear notice placed on the front page and each page of the website located at the Disputed Domain Name that the website has no relationship with promgirl.com, reminds online customers of this issue when they visit the website. In addition, the Respondent claims that Disputed Domain Name was legally purchased from the Registrar.
- iv. The Respondent also claims that the words – "Prom", "girl", "shop" are just common terms of language which do not imply that they are trademarks. The combination of promgirlshop.com explains its business scope, which is different

from promgirl.com and they are an integrated online shop selling prom dresses, wedding dresses, shoes and accessories.

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.

A) Identical / Confusingly Similar

The Complainant has established its right to the "PROMGIRL" trademarks by submitting the U.S. Trademark Registration of No. 4109452 and the Trademark Agreement with the PROM, LLC, which granted the Complainant a non-exclusive license to use the "PROMGIRL" service mark.

There is no doubt that the Disputed Domain Name <promgirlshop.com> completely incorporates the Complainant's "PROMGIRL" trademark as 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.*

One the other hand, the suffix of the common English word "shop" after the "promgirl" does not help to reduce the confusing similarity, on the grounds that 1) the word "shop" merely implies the nature of the website located at the Disputed Domain Name, which is an online retail shop; and 2) the Complainant operates an online retail shop that sells products similar to those sold by the website located at the Disputed Domain Name.

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

B) Rights and Legitimate Interests

The Complainant has stated that it has never authorized, licensed or otherwise permitted the Respondent to use the mark PROMGIRL under any circumstances; nor has any business relationship with the Respondent.

In accordance with Paragraph 4(c) of the Policy, the Respondent may demonstrate its legal right or interest in the Disputed Domain Name by proving that:

- (i) before any notice to it of the dispute, its 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) it (as an individual, business, or other organization) has been commonly known by the domain name, even if it acquired no trademark or service mark rights; or
- (iii) it is making a legitimate noncommercial 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.

The Panel noticed that the Respondent did not provide any evidence to demonstrate its legal rights or interests in the Disputed Domain Name, except submissions laid out in its Response. On the other hand, the evidence (Annexures 6-9) provided by the Complainant indicated that there may be continuous infringements of the Complainant and others' copyright during the operation of the website located at the Disputed Domain Name by the Respondent. The Panel considers that, the website located at the Disputed Domain Name has been consistently, without obtaining prior consent, using the Complainant's images to describe the goods sold on the Respondent's website located at the Disputed Domain Name, and that such use could not be deemed as "bona fide offering of goods" since the offering of goods has involved copyright infringement activities involving the Complainant's copyright.

In the Response, the Respondent has challenged that "Prom", "girl", "shop" are just common terms of language, which makes sense to some extent under the normal circumstance. However, such mere explanation is not sufficient to be the basis of proving legal rights and interests in this case due to following reasons: 1) both the website located at the Disputed Domain Name and the Complainant's website are selling occasional dresses and accessories, such as dresses for weddings, parties and dances etc.; and 2) the Complainant and its "PROMGIRL" trademarks are well-known for its business due to its long time operation and global sales. Therefore, it is more likely that average online customers/users who intend to visit the Complainant's website, will be attracted and diverted to the website located at the Disputed Domain Name due to the similarity between the Disputed Domain Name and the Complainant's trademarks, other than simply considering the Respondent's website as an online shop that is selling prom dresses for girls. In fact, the Google Ads paid for by the Respondent, which were placed high in the sponsored search results for "promgirl", further increase the possibility of confusing the website located at the Disputed Domain Name with the Complainant's website and business.

The Respondent has also argued that the design and layout of the website located at the Disputed Domain Name shares no similarities with the Complainant's website, and it has stated in the "Contact us" and "About us" parts of the website, that it is owned by QANDIES LIMITED, as well as adding a clear notice on every page of its website to this effect. As discussed above, the Disputed Domain Name itself is very much likely confusing online customers/users who intend to visit the Complainant's website in the first place. When such users are clicking and being diverted to the website located at the Disputed Domain Name, they may be still under the impression that they are visiting the Complainant's website, thus, they may not even consider nor "have the opportunity to 'compare' the two sites" - *See WIPO Case Société pour l'œuvre et la mémoire d'Antoine de Saint Exupéry-Succession Saint Exupéry - D'Agay v. The Holding Company, D2005-0165.*

As to the disclaimer on the Respondent's website, after visiting the Disputed Domain Name Website on June 25, 2015, the Panel found that both the said "About us" parts and the notice located at the bottom of the homepage, may not be found easily when a consumer first visits the website. Further, it is noted that "the consumer may realize, once at the website, that the site is

not operated by the Complainant, but the consumer may continue and purchase the Respondent's similar goods, thus profiting from use of the Respondent's confusingly similar domain name". See *WIPO Case Sharman License Holdings, Limited v. KazaaLite.com Inc., D2004-0402*.

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

C) Bad Faith

As discussed above, since the Complainant and the Respondent are competitors that are using the same business model within the same industry, it is highly possible that the Respondent had knowledge of the existence of the Complainant and its "PROMGIRL" brand when registering the Disputed Domain Name. In addition, the continuous infringements of the Complainant's and others' copyright, do not only indicate a lack of "bona fide" offering, but also indicate bad faith on behalf of the Respondent in terms of registration and use of the Disputed Domain Name.

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

6. Decision

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

Matthew Murphy
Sole Panelist

Dated: July 27, 2015