



Asian Domain Name Dispute Resolution Centre

hong kong

**(Hong Kong Office)**

**ADMINISTRATIVE PANEL DECISION**

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<b>Case No.</b>	HK1500728
<b>Complainant:</b>	Rimowa GmbH
<b>Respondent:</b>	Pisa Yu
<b>Disputed Domain Name(s):</b>	<rimowa.club>

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**1. The Parties and Contested Domain Name**

The Complainant is Rimowa GmbH, of Mathias-Bruggen-Str. 118, D-550829 Köln 30, Germany. The authorized representative of the complainant is Mayer Brown, of JSM, 16th - 19th Floors, Prince's Building 10 Chater Road Central, Hong Kong.

The Respondent is Pisa Yu, of Flat F, 19/F, Tower 7, Up Town, Yuen Long, Hong Kong.

The domain name at issue is <rimowa.club>, registered by Respondent with Name.com Inc., of 2500 East Second Avenue, Second Floor, Denver, Colorado, 80206, United States of America.

**2. Procedural History**

On March 19, 2015, the Complainant submitted the Complaint in English on domain name < rimowa.club> 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. By email message dated March 20, 2015, the Center confirmed the receipt of the Complaint, together with Annexures 1 to 29. 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 March 20, 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.

On March 21, 2015, the Registrar provided its response to the Centre through which it confirmed that: (1) the name was registered with Name.com Inc., (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 is currently locked and is not allowed to transfer pending the initiated proceedings.

On March 31, 2015, the Centre sent the Complaint to the Respondent. The Respondent was then provided with a 20 calendar day period, expiring on April 20, 2015, to file its Response both with the Centre and the Complainant. As of April 21, 2015, the Respondent had not filed any Response with the Centre. Accordingly, on April 21, 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 April 20, 2015 deadline and, as such, the Centre would then proceed to appoint a Panelist for this matter. The Respondent only submitted a Response on 27 April 2015.

Pursuant to the Rules and Supplemental Rules, the Centre, by email dated April 27, 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 April 28, 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 May 12, 2015. Owing to unexpected time conflicts experienced by the Panel all of which constituted unforeseen circumstances, the Centre, at the request of the Panel, extended this due date to May 26, 2015.

### **3. Factual background**

#### **The Complainant: Rimowa GmbH**

##### **A. The Complainant's RIMOWA Marks**

The Complainant currently owns numerous trademark registrations and applications worldwide for marks that consist of the term "RIMOWA", either in block letters and stylized form and for use on conjunction with a variety of goods and services. For instance, the stylized form of the RIMOWA mark was registered in Hong Kong on August 13, 1988. In Annexure 3 to the Complaint, the Complainant provided a list of its registrations and applications in a number of jurisdictions such as Hong Kong, People's Republic of China, United States of America, Republic of China ("Taiwan"), Singapore, and Germany along with copies of the registration certificates for a small sample of its registered marks in all those jurisdictions. The Complainant also provided, though in Annexure 4 to the Complaint, a list of its trademark registrations in Hong Kong, China, United States of

America, Taiwan, Singapore, and Germany which incorporate the word “RIMOWA”. Several of the Complainant’s registrations, and, especially registrations in Hong Kong, were granted in 1988-1994 timeframe and predated the date on which the Respondent registered the disputed domain name, i.e., May 7, 2014. Pertinent details of two illustrative registrations are as follows:

RIMOWA stylized form ()  
Hong Kong registration: 19901586; registered 13 August 1988  
Filed: 13 August 1988  
Class 9  
Applicant/registered owner: Rimowa GmbH

RIMOWA stylized form ()  
Hong Kong registration: 199510378; registered 29 June 1994  
Filed: 29 June 1994  
Class 18  
Applicant/registered owner: Rimowa GmbH

## B. The Complainant and its activities

The Complainant is a globally renowned designer, manufacturer and distributor of premium luggage and suitcases under the “RIMOWA” brand. For the 2010 business year, the RIMOWA Group reported total sales of roughly €100 million, representing a growth of 16% over 2009. For the 2013 business year, the RIMOWA Group reported total sales of around €260 million, an increase of approximately 40% over 2012.

In Annexure 4 to the Complaint, the Complainant provided an overview of the Rimowa business. The business was founded by Paul Morszeck in Cologne, Germany in 1898. At the time, the company was known as *Kofferrabrik Paul Morszeck*. The Complainant began selling its goods under the RIMOWA mark in 1937. The brand name RIMOWA was derived from the words **Richard Morszeck Warenzichen** (Warenzichen being German for “trademark”). 1937 was also the year that the Complainant introduced the first trunks made of aluminium to the market. This was the first time that lightweight metal was used as the main material for trunks - a groundbreaking innovation in luggage production. In 1950, the Complainant began to produce aluminium suitcases with its signature grooves. The iconic grooves are a distinctive mark of RIMOWA luggage. The grooves on RIMOWA cases have been registered as a trademark in Germany, the European Union and the United States of America. In 2000, the Complainant’s current chief executive officer and President, Dieter Morszeck (the founder’s grandson) commissioned the first lightweight luggage series made of recyclable polycarbonate. Polycarbonate is an extremely resilient and lightweight material used for aircraft windows and in vehicle construction. The Complainant was the first manufacturer to use this material in luggage production, resulting in cases that are sleek and lightweight, yet extremely robust and durable.

In Annexure 5 to the Complaint, the Complainant provided its latest product catalogue. Today, the Complainant continues to produce aluminium and polycarbonate luggage of high quality. The cases are constructed in the Complainant’s manufacturing facilities, located in Germany, Canada, the Czech Republic and Brazil. Each RIMOWA case bears the “RIMOWA” mark, and has an additional seal of quality “DESIGN by .

engraved into the suitcase frame. In Annexure 6 to the Complaint, the Complainant provided photographs of Hong Kong and international artists with their RIMOWA luggage. Also, in Annexure 7 to the Complaint, the Complainant provided the list of over 250 films in which the RIMOWA luggage has been featured.

The Complainant now operates its business through a number of subsidiaries and affiliates (collectively referred to as the "RIMOWA Group"). RIMOWA luggage is sold at over 100 stores around the world, 75 of which are in Asia. The market comprising Hong Kong and Macau is among the Complainant's biggest. In Annexure 8 to the Complaint, the Complainant provided the detailed list of six RIMOWA stores and four Lane Crawford outlets where RIMOWA luggage is sold in Hong Kong. Moreover, the Complainant entered the PRC market in 2007 and now has over 25 RIMOWA stores in China as shown in Annexure 9. It also runs an official store on Tmall, China's leading business-to-consumer (B2C) shopping destination for brand-name goods.

Finally, in Annexure 11 to the Complaint, the Complainant provided an overview of the search results from major Internet search engines, Google, Yahoo! and Baidu, indicating that the vast majority of search results returned for searches of "rimowa" relate to the Complainant and its products.

### **The Respondent**

As indicated in the WhoIs registration record provided in Annexure 1 to the Complaint, the Respondent registered the disputed domain name on May 7, 2014. Since March 20, 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 Name.com Inc.. 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 (See UDRP Rules, § 14).

## **4. Parties' Contentions**

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. Identical or Confusingly Similar**

The Complainant has registered numerous trade marks comprising the Rimowa Trade Marks to protect its interests around the world. The Complainant accordingly submits that it has proved that the Disputed Domain Name is identical and/or confusingly similar to its

registered trade marks in which the Complainant has rights or interests for the purposes of paragraph 4(a)(i) of the Policy.

#### ii. Rights or Legitimate Interests

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraphs 4(a) (ii) and particular 4(c) of the Policy.

First, the Rimowa Trade Marks are inherently distinctive, and given also their extensive use by the Complainant since at least 1937 in commerce, Rimowa Trade Marks are immediately recognisable to consumers as being associated with the Complainant, its business and its products.

Second, there is no evidence to suggest that the Respondent has been commonly known by the Disputed Domain Name.

Third, the Respondent does not own any trade mark registrations reflecting or corresponding to the Disputed Domain Name in Hong Kong (where the Respondent is apparently domiciled).

Fourth, the Disputed Domain Name does not currently resolve to an active website.

Fifth, even if the Respondent intends to use the Disputed Domain Name (which is denied), and provides evidence to show that it is making demonstrable preparations for use, any such use can never amount to a bona fide offering of goods or services or a legitimate non-commercial or fair use of the Disputed Domain Name.

#### iii. Registered and Used in Bad Faith

The Complainant contends that the Respondent registered and is now using the disputed domain name in bad faith under paragraph 4(a)(iii) of the Policy.

First, the Disputed Domain Name does not reflect or correspond to the Respondent's own name.

Second, the Respondent has demonstrated a pattern of registering domain names containing prominent brand names, preventing trademark owners from reflecting their marks in the domain names

Third, the Disputed Domain Name is inactive as at the date of this Complaint and there is no evidence that it has ever been used since its registration.

Fourth, due to the confusing similarity between the Disputed Domain Name and the Rimowa Trade Marks, and the fact that the Respondent had to have been aware of the Complainant and its Rimowa Trade Marks, it is inconceivable that the Respondent registered the Disputed Domain Name for any reason other than in bad faith.

#### B. Respondent

As indicated in the procedural history, the Respondent was provided with a 20 calendar day period, expiring on April 20, 2015, to file its Response both with the Centre and the Complainant. The Respondent only submitted a Response on 27 April 2015. 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.

### **i) Identical / Confusingly Similar**

The Panel finds that the disputed domain name is confusing similar to the Complainant's RIMOWA Marks.

The Disputed Domain Name <rimowa.club> incorporates the Complainant's "RIMOWA" mark in its entirety. From a simple comparison of the name and the mark, no doubt exists that the disputed domain name is, for all practical purposes, identical to the Complainant's mark RIMOWA.

The only difference between the name is the appending of the gTLD (generic top level domain) ".club" to the mark, with that difference being totally irrelevant in assessing confusing similarity or identity under paragraph 4(a) of the Policy and thus ignored. It is well-established that in making an enquiry as to whether a trade mark is identical or confusingly similar to a domain name, the domain extension, in this case <.club>, should be disregarded (see *Rohde & Schwarz GmbH & Co. HG v. Pertshire Marketing, Ltd*, WIPO Case No. D2006-0762).

Therefore, the Panel finds that the disputed domain name <rimowa.club> is, for all practical purposes, identical to the mark RIMOWA, which forms one of the Complainant's RIMOWA Marks, so as to cause confusion; hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

### **ii) Rights and Legitimate Interests**

Based on the evidence of record here, the Panel finds that no basis exists which, under the circumstances here, would legitimize a claim to the disputed domain name under paragraph 4(c) of the Policy.

The Rimowa Trade Marks are inherently distinctive, and given also their extensive use by the Complainant since at least 1937 in commerce, Rimowa Trade Marks are immediately recognisable to consumers as being associated with the Complainant, its business and its products. The Respondent registered the Disputed Domain Name on 7 May 2014 – at least 76 years after the "RIMOWA" mark was first used by the Complainant. The fame of the Rimowa Trade Marks, coupled with the fact that the Complainant has not licensed, consented to or otherwise authorised the Respondent's use of the Rimowa Trade Marks, has the practical effect of shifting to the Respondent the burden of proof in establishing that it has rights and/or legitimate interests in the Disputed Domain Name (see *PepsiCo, Inc v. Amilcar Perez Lista d/b/a Cybersor*, WIPO Case No. D2003-0174).

Even if the Respondent intends to use the Disputed Domain Name (which is denied), and provides evidence to show that it is making demonstrable preparations for use, any such use can never amount to a bona fide offering of goods or services or a legitimate non-commercial or fair use of the Disputed Domain Name. This is because the Disputed Domain Name is identical to the Complainant's well-known "RIMOWA" trade mark, a unique word coined by the Complainant and used exclusively by them, and will inevitably mislead users into believing that the Disputed Domain Name is associated with the Complainant and may divert users to the Disputed Domain Name, enabling the Respondent to make an unfair commercial gain. In *Microchip Technology, Inc. v. Milos Krejcik and EDI Corporation, d/b/a Aprilog.com* (WIPO Case No. D2001-0337), the panel held that although the respondent had been offering legitimate goods for sale prior to any notice of dispute, as the respondent used the domain name to resolve to a website where users were likely to be confused as to whether the site was affiliated with the complainant, the respondent could not be bona fide and did not have legitimate rights or interests in the domain name.

Furthermore, there is no evidence to suggest that the Respondent has been commonly known by the Disputed Domain Name. The Respondent's name (Pisa Yu) does not reflect or correspond with the Disputed Domain Name, and there is no justification or apparent need for her to use "RIMOWA" in the Disputed Domain Name.

In the absence of a timely any Response, the Panel infers that the Respondent is not using the name on either a non-commercial or fair use basis without intent to misleadingly divert consumers or tarnish any of the Complainant's marks, or, prior to receiving notice of this dispute, in connection with any bona fide offering of goods or services or demonstrable preparations for making such an offering, thus failing to qualify under either of paragraphs 4(c)(i) and 4(c)(iii) of the Policy.

Accordingly, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain name within paragraph 4(a) (ii) and 4(c) of the Policy.

### **iii) Bad Faith**

After a careful examination of the four, non-exclusive examples enumerated in paragraph 4 (b) of the UDRP, the panel ultimately found, that, based on the available facts and circumstances, the registration and use of the domain name could be said to have been made in bad faith.

In light of the fame of the Rimowa Trade Marks, both in Hong Kong and worldwide, it is inconceivable that the Respondent (who appears to be domiciled in Hong Kong) was not aware of the Complainant and its Rimowa Trade Marks at the time she registered the Disputed Domain Name. As such, the Respondent's registration of the Disputed Domain Name cannot possibly have been for any reason other than to take advantage of the Complainant's reputation in the Rimowa Trade Marks in bad faith for the purposes of selling it for commercial gain; to block any registration by the Complainant and/or to take unfair advantage of the Complainant's reputation in the Rimowa Trade Marks in order to redirect users to the Disputed Domain Name. It is well established that the Respondent's registration and use of the Disputed Domain Name must involve mala fides where the registration and use of it was and continues to be made in the full knowledge of the Complainant's prior rights in the Rimowa Trade Marks, and in circumstances where the Respondent did not seek permission from the Complainant, as the owner of the trade marks, for such registration and use (See *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. D2000-0163).

In addition, the "use in bad faith" is not limited to positive action, and inaction can amount to use of the Disputed Domain Name in bad faith. As stated by the Panel in the *Telstra* case, "the true test is not whether the domain name is being actively used, but rather "whether, in all the facts and circumstances of this case, it can be said that the Respondent is acting in bad faith" (see *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003). See also *Teledesic LLC v. McDougal Design*, WIPO, No. D2000-0620, (Sep. 1, 2000); *Do the Hustle, LLC v. Donald Wilson*, WIPO, No. D2000-0627, (Aug. 18, 2000); *ABF Freight System, Inc. v. American Legal*, WIPO, No. D2000-0185, (May 9, 2000); *CBS Broadcasting Inc. v. Edward Enterprises*, WIPO, No. D2000-0242, (May 24, 2000); *Guerlain S.A. v. Peikang*, WIPO, No. D2000-0055, (Mar. 21, 2000); *Stralfors AB v. P D S AB*, WIPO, No. D2000-0112, (Apr. 13, 2000); *Marconi Data Systems, Inc. v. IRG Coins and Ink Source, Inc.*, WIPO, No. D2000-0090, (Apr. 11, 2000); *Compaq Computer Corporation v. Boris Beric*, WIPO, No. D2000-0042, (Mar. 28, 2000); *Gordon Rush & Co., Ltd. v. Ramon Rono*, NAF, No. FA95495, (Oct. 20, 2000); *Hewlett Packard Company v. Greg Martineau*, NAF, No. FA95359, (Aug. 30, 2000); *Aeroturbine, Inc. v. Domain Leasing Ltd.*, NAF, No. FA93674, (Mar. 23, 2000); *SeekAmerica Networks Inc. v. Tariq Masood and Solo Signs*, WIPO, No. D2000-0131, (Apr. 13, 2000); *CIGNA Corporation v. JIT Consulting, DeC*, No. AF-0174, (Jun. 6, 2000); *Phillips International, Inc. v. Rao Tella*, NAF, No. FA95461, (Sep. 21, 2000); *Association of British Travel Agents Ltd. v. Sterling Hotel Group Ltd.*, WIPO, No. D2000-0086, (Mar. 29, 2000); *Loblaws, Inc. v. Yogen International, DeC*, No. AF-0164, (Jun. 9, 2000); *Sporoptic Pouilloux S.A. v. William H. Wilson*, WIPO, No. D2000-0265, (Jun. 16, 2000). Therefore, the non-use or passive holding of the Disputed Domain Name, in combination with the other evidence of bad faith discussed in this Complaint, amounts to use in bad faith.

Furthermore, due to the confusing similarity between the Disputed Domain Name and the Rimowa Trade Marks, and the fact that the Respondent had to have been aware of the Complainant and its Rimowa Trade Marks (for the reasons stated above), it is inconceivable that the Respondent registered the Disputed Domain Name for any reason other than in bad faith. It is reasonable to infer that the Disputed Domain Name intentionally incorporated the Complainant's "RIMOWA" mark in its entirety for the purposes of misleading and confusing Internet users into believing that the Disputed Domain Name is associated with the Complainant and its Rimowa Trade Marks in order to increase the number of Internet users that access the Website, for commercial gain. The confusion that is relevant here is the confusion that may arise in the minds of Internet users

when they come across the domain name “rimowa.club”, or type this domain name into their internet browser thinking that it will actually direct them to Rimowa GmbH’s website.

As stated in the case of *Alibaba Group Holding Limited v. Alexey Gurov* (ADNDRC Case No. HKS-1400012), *"the fact that the disputed domain names are identical to the Complainant's trademarks will mislead users into believing that they are associated with the Complainant. Good faith registration and use by the Respondent is inconceivable."* In this respect, it is inconceivable that registration and use of the Disputed Domain Name <rimowa.club> could be for any reason other than bad faith, in order to mislead users into believing the Respondent is associated with the Complainant for the purposes of commercial gain; to sell the Disputed Domain Names for profit; and/or to prevent the Complainant from reflecting its Rimowa Trade Marks in a corresponding domain name. This falls squarely within paragraph 4(b) of the Policy as evidence of bad faith.

This plainly constitutes bad faith use and registration. The Panel finds that the Respondent’s actions, with respect to the disputed domain name, constitute bad faith registration and use.

Consequently, the Panel concludes that the Respondent violated paragraph 4(a)(iii) of the Policy and specifically paragraph 4(b)(i) thereof. Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to the disputed domain name, to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

## **6. Decision**

Based on the above analysis, the Panelist decides that: (1) the disputed domain name <rimowa.club> 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, <rimowa.club>, is ordered transferred to the Complainant.

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Prof. Julien Chaisse  
Panelist

Dated: May 25, 2015