



# Asian Domain Name Dispute Resolution Centre

hong kong

(Hong Kong Office)

## ADMINISTRATIVE PANEL DECISION

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<b>Case No.</b>	HK-1400616
<b>Complainant:</b>	Tracy Kwok (Blitz Asia Ltd)
<b>Respondent:</b>	Fast Retailing Co., Ltd.
<b>Disputed Domain Name(s):</b>	<uniqlothes.com>

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### 1. The Parties and Contested Domain Name

The Complainant is Fast Retailing Co., Ltd., 717-1, Sayama, Yamaguchi City - Yamaguchi 754-0894 - Japan.

The Respondent is Tracy Kwok (Blitz Asia Ltd), 1704 Fu Fai Commercial Center, 27 Hillier Street, Central – Hong Kong.

The Domain Name at issue is <uniqlothes.com>, registered by Respondent with GoDaddy Operating Company LLC, of 14455 Hayden Road, Suite 219, Scottsdale AZ 85260, United States

### 2. Procedural History

The Complaint has been filed with the Hong Kong office of the Asian Domain Name Dispute Resolution Centre (ADNDRC) on May 23, 2014.

The ADNDRC Hong Kong office transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. Also on May 24, 2014, the Registrar transmitted by email to the Center its verification response disclosing the identity and the contact details of the registrant, since he had used a privacy service.

Pursuant to the disclosure of the registrant's identity, an amended complaint has been filed on May 27, 2014.

In accordance with the Rules, paragraphs 2(a) and 4(a), the ADNDRC Hong Kong office notified the Respondent of the Complaint on May 30, 2014. In accordance with the Rules, paragraph 5(a), the due date for Response was June 19, 2014. The Respondent submitted a response on June 18, 2014.

On June 19, 2014, the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (ADNDRC) duly informed the parties that Marie-Emmanuelle Haas had been appointed to serve as a Panelist pursuant to the Internet Corporation for Assigned Names and Numbers (ICANN) Uniform Domain Name Dispute Resolution Policy, the Rules for ICANN Uniform Domain Name Dispute Resolution Policy, and the ADNDRC Supplemental Rules in respect of the above domain name.

The deadline for rendering the decision has been set for July 3, 2014.

### **3. Factual background**

The Complainant owns numerous UNIQLO trademarks that are protected on a worldwide basis since 1994, notably in Hong Kong, Japan and the United States.

The Complainant opened the first UNIQLO store in Japan in 1984. In 2001, the first UNIQLO international stores opened in the United Kingdom. By the end of August 2013, UNIQLO had 853 stores nationwide in Japan and 446 stores in other countries around the world, including 280 stores in Greater China, 105 in South Korea and 39 elsewhere in Asia.

The Respondent registered the Domain Name <uniqlothes.com> on May 11, 2013 and used it to resolve to an ecommerce website offering clothes for sale.

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

#### **A. Complainant**

The Complainant's contentions may be summarized as follows:

##### **i. Likelihood of confusion**

The prominent and distinctive part of the Domain Name at issue is UNIQLO, which is identical to the trademark. The other part is "THES", which has no meaning, unless combined with "KLO", to form "KLOTHES" which pronunciation is the same as "CLOTHES".

Hence, the Domain Names is confusingly similar to the UNIQLO trademark.

##### **ii. Absence of rights and legitimate interests**

The Respondent has never been licensed, authorized or otherwise permitted to use the UNIQLO trademark.

The Respondent's name is "Tracy Kwok" and the Registrant's organization is "Blitz Asia Ltd". There is no evidence that the Domain Name is the name of the Respondent or that the Respondent has been commonly known by the Domain Name at issue.

The Complainant contends that the Domain Name at issue directs to a website which is clearly used to pass off his business and to create confusion. Hence he has no legitimate right or interest.

iii. Bad faith registration and use

The Domain Name at issue was registered in 2013, when the Complainant had established a strong reputation in the UNIQLO trademark. Referring to the Respondent's activity, he was clearly aware of the UNIQLO trademark when registering the Domain Name at issue.

Moreover UNIQLO is a coined word and has no meaning.

The Respondent is using the Domain Name at issue for an online store selling UNIQLO clothing products. All advertisements and products photos displayed on the website are copied from the Complainant's websites without any authorization.

On the website [www.uniqlclothes.com](http://www.uniqlclothes.com), the Respondent is using a red and white color scheme which is identical to the red-and-white color scheme of the Complainant's website. He is also using the same logo "FREE SHIPPING"

The Respondent has deliberately registered and is using the Domain Name with an intention to cause confusion and for illicit commercial gain. It caused a disruption of the Complainant's activities.

Another domain name <uniqlclothes.es> resolves to the same website as the Respondent's website. The Complainant's believes that it is operated by the same company.

The Complainant comes to the conclusion that the Domain Name at issue "is clearly part of a bad-faith campaign by the Registrant to cause confusion to the public for illicit commercial gain"

Using a Whois privacy service to hide the contact information is also a clear evidence of bad faith.

The Complainant further explains that the website [www.uniqlclothes.com](http://www.uniqlclothes.com) is not accessible in China, Hong Kong, Japan and Taiwan, whereas the Respondent is based in Hong Kong.

He believes that the Respondent tries to avoid liability for operating the litigious website in Hong Kong.

iv. Remedy

The requested remedy is the transfer of the Domain Name to the Complainants.

B. Respondent

The Respondent's contentions were submitted in the following terms.

i. "Two parts, "Uni" and "Qlothes" constituted the idea of the domain name UniQlothes.com . "UniQ" is a common short form of unique whilst "Qlothes" is a modern innovative word that sounds same as "Clothes" but spell differently.

The differences between the websites of Complainant and Respondent are clear and not confusingly similar. - Respondent's single line "UniQlothes" heading (remark: "Q" is not presented completely and intentionally with a gap to look like "C" for intelligence) in rectangular shape [refer to Complainant's Annex K], which is almost four times wider than Complainant's square shape with two rows text [refer to Complainant's Annex L] impressed visitors the differences at first glance.

ii. The main business of UniQlothes.com in selling collaboration series is presented from the website design, layout & contents throughout and the most importantly, "About us" on the website, it is a brief introduction page to deliver the mission, vision and the team about UniQlothes.com, there's no statement misleading others that there's any relationship or linkage between Respondent and Complainant. UniQlothes.com is a unique domain name and Respondent has its legitimate right and interest to own it. As mentioned before the domain name was coined out of a wordplay of two common words "unique" and "clothes".

iii. Selling clothes is a legal business activity and UniQlothes.com is doing it in good faith. Though Complainant has not grant any business partnership or franchise to Respondent in selling its products, purchasing from Complainant and then resell is not illegal and parallel importation is permitted in Hong Kong.

It is frustrating that owning UniQlothes.com which is a very unique domain name causes so much trouble. The losses of giving up the domain name UniQlothes.com is limited to the Respondent and the Respondent is willing to give up its ownership on her own accord".

## **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 rights in the UNIQLO trademarks, which are worldwide well-known.

The Respondent chose to register a domain name that consists of the distinctive UNIQLO Complainants' trademarks to which he merely added the letters THES to mean "clothes".

The Panel thus finds that the Domain Name is confusingly similar to the UL trademark and that paragraph 4(a) (i) of the Policy is satisfied.

### **B) Rights and Legitimate Interests**

Paragraph 4(c) of the Policy enumerates several ways in which the Respondent may

demonstrate rights or legitimate interests in the Domain Name:

“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for the purposes of paragraph 4(a)(ii):

(i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are 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 notes that the Respondent is not a licensee of, or otherwise affiliated with, the Complainant, and has not provided any evidence that it has been commonly known by the Domain Name. According to the available record, the Respondent has neither used the Domain Name in connection with a *bona fide* offering of goods or services, nor used the Domain Name for a legitimate noncommercial or fair use.

In his response to the Complaint, the Respondent proposed to transfer the Domain Name at issue.

Accordingly, the Panel finds that paragraph 4(a)(ii) of the Policy is satisfied.

### **C) Bad Faith**

Paragraph 4(b) of the Policy enumerates four, non-exhaustive, circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

“(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site 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 your web site or location or of a product or service on your web site or location.”

The Respondent chose to register a domain name that consists of the distinctive worldwide

well-known UNIQLO Complainants' trademarks, to which it merely added the letters "THES" to mean "clothes".

When registering the Domain Name at issue, the Respondent chose to hide his name and contact details.

In light of the above, the Respondent cannot have ignored the Complainants' trademark rights when he registered the Domain Name.

Therefore, the Panel believes that the Respondent has registered the Domain Name in bad faith, in the meaning of paragraph 4(b) (i) and (iii) of the Policy.

The Respondent used the Domain Name to resolve to a website selling clothes and he does not deny having copied all displayed pictures from the Complainant's websites.

In his response to the Complaint proposed to transfer the Domain Name.

Accordingly, the Panel finds that paragraph 4(b)(iv) of the Policy is satisfied.

For the above reasons, the Panel finds that paragraph 4(a)(iii) is satisfied in this case and that the registration and use of the Domain Name has been made in bad faith.

## 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 Domain Name <uniqlothes.com> be transferred to the Complainant.

  
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Marie-Emmanuelle HAAS  
Panelist

Dated: July 3, 2014