



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1200465
Complainants:	1) Retail Royalty Company 2) AEO Management Co.
Respondent:	Xie Ao Ke

1. The Parties and Contested Domain Name

The Complainants are: (i) Retail Royalty Company, of 101 Convention Center Drive, Las Vegas, Nevada 89109, USA and (ii) AEO Management Co. of 77 Hot Metal Street, Pittsburgh, Pennsylvania 15203, USA (the Complainant).

The Respondent is, Xie Ao Ke of Putian Meiyuan, Putian Fujian Province China 351100 (the Respondent).

The domain name in dispute is <american-eagle-boots.com>, registered by the Respondent with Name.com LLC (the Registrar), of 2500 East Second Avenue, Denver Colorado 80206, USA.

2. Short Procedural History

On or around October 15, 2012, pursuant to the Uniform Domain Name Dispute Resolution Policy (“the Policy”), the Rules of the Uniform Domain Name Dispute Resolution Policy (“the Rules”) and the Asian Domain Name Dispute Resolution Centre Supplemental Rules (the ADNDRC Supplemental Rules), the Complainant submitted a complaint in English Language to the office of the Asian Domain Name Dispute Resolution Centre in Hong Kong and elected that this case be dealt with by a sole panelist. In addition to the complaint the Complainant enclosed the appropriate fees in accordance with Article 15 of the Supplemental Rules. The Respondent failed to file a Response within the time stipulated by the ADNDRC Supplemental Rules and is therefore in default. The Registration Agreement which applies to the disputed domain name is in the English language.

On December 05, 2012 the ADNDRC notified the parties that the Panel in this case had been selected with Ike Ehiribe acting as sole panelist. The Panel appointment was made in accordance with Rules 6 and Articles 8 and 9 of the Supplemental Rules. By a Procedural Order issued on or around 01 January 2013 the time within which to deliver the decision was extended to 04 January 2013, as the previous scheduled date for the delivery of the decision being 19 December 2012 coincided with the xmas and new year holiday period of the year 2012.

3. Factual Background

For the Complainant

The Complainant offers for sale in the US and in numerous countries abroad well-designed, high quality merchandise consisting of casual clothing, accessories, and footwear targeting 15 to 25 year olds under the marks American Eagle Outfitters and American Eagle (the “American Eagle Marks”) at its American Eagle Outfitters retail stores and on its website <ae.com>. The Complainant is said to be one of the top ranking

youth lifestyle brands having opened its first retail store in the United States in 1977 and with as many as 930 stores in many other countries. Since 1977, the Complainant is said to have sold billions of dollars' worth of products under the Eagle Marks. The Complainant is also said to have spent hundreds of millions of dollars in advertising and promoting goods and services under the American Eagle Marks and on the Internet. As a result of such extensive advertisement and promotion, the American Eagle Marks is said to have acquired a high degree of public recognition, fame and distinctive ness as a symbol of the source of high quality goods offered by the Complainant. The Complainant has also registered the mark "AMERICAN EAGLE" in China in international Classes 25 and 35 with the designated goods being hats, shoes and sports shoes etc. Since 2010, the Complainant has opened seven American Eagle Outfitters retail stores in mainland China and in the Hong Kong Special Administrative Region. The Complainant's rights in and to the American Eagle Marks have been recognized by numerous other UDRP Panels transferring disputed domain names consisting of American Eagle –variant marks to the Complainant. For instance see the decisions in: (i) *American Eagle Outfitters Inc. and Retail Royalty Company v. Tony Leung a/k/a Kam Vam*, NAF Claim No.: FA0206000114647 a decision in which the Panel recognized the famous nature of the Complainant's American Eagle Outfitters Marks; (ii) *American Eagle Outfitters Inc. and Retail Royalty Company v. John Zuccarini a/k/a Country Walk*, NAF Claim No.: FA 0304000155178 another decision in which the Panel found that the Complainant had established rights in the American Eagle Outfitters mark through registration with the USPTO and by continuous use in commerce since 1977.

The Complainant also owns numerous trademark registrations for the American Eagle Marks in connection with clothing, accessories and retail and online services as evidenced by numerous copies of trademark registration certificates from the USPTO attached to these proceedings. The Complainant is also the owner of numerous trademark registrations in over 100 countries throughout the world including countries in the European Community, Hong Kong and in China where the Respondent is based.

For the Respondent

The Respondent did not file any response to these proceedings.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

1) The disputed Domain Name is Identical or Confusingly Similar to the Complainant's American Eagle Marks.

- i. The Complainant noticed in 2011 that the Respondent had registered and was using the disputed Domain Name on the website www.american-eagle-boots.com. The Complaint also asserts that the Respondent without any authorization from the Complainant openly sells a number of counterfeit "AMERICAN EAGLE" branded boots and kids' boots to online consumers, and the said counterfeit "AMERICAN EAGLE" branded boots and kids boots also featured Complainant's registered eagle design.
- ii. The disputed Domain Name <american-eagle-boots.com> is identical to and fully incorporates one or more of the Complainant's federally registered American Eagle Marks in which the Complainant has long standing well established rights. The Complainant contends further that the disputed Domain Name should be considered confusingly similar to the Complainant's American Eagle Marks because it incorporates the Complainant's American Eagle Marks in their entirety with the difference being the addition of the descriptive term "boots" to the Complainant's American Eagle Marks and the hyphens in between. The Complainant in this regard further contends that the disputed Domain Name is undoubtedly confusingly similar to the Complainant's marks regardless of the inclusion of generic or descriptive terms such as "boots". The Complainant in this regard relies on a number of previous decisions including *American Eagle Outfitters, Inc. and Retail Royalty Company v. Admin C/O La Porte Holdings*, NAF Claim

No.: FA 0505000473826 where the panel found that the disputed domain name in that case <americaneaglestores.com> was confusingly similar to the Complainant's American Eagle Outfitters Mark if the two only differ by one letter.

- iii. The Complainant further contends that the addition of the generic top level domain (gTLD) “.com” was found to be irrelevant as held in a previous WIPO case in *Pomellato S.p.A. v. Richard Tonetti*, WIPO Case No. D2000-0493.
- iv. The Complainant also argues that the Respondent's continued registration and use of the disputed Domain Name without the consent or permission of the Complainant infringes the Complainant's rights under the United States Federal Trademark Act namely 15 U.S.C. Section 1114 and 15 U.S.C. Section 1125 (a)(1)(A) of the Lanham Act.

2) The Respondent's lack of rights or legitimate interest in respect of the disputed Domain Name.

- v. It is also contended that the Respondent has no rights or legitimate interests in respect of the disputed Domain Name, in that the Respondent an individual residing in mainland China has neither applied for nor registered any trademark in whole or in part of the term “AMERICAN EAGLE”. The Respondent is said not to be affiliated with, licensed by or in privity with the Complainant and has not been given permission to use any of the American Eagle Marks by the Complainant or its affiliates. Equally, it is argued that there is no evidence that the Respondent is commonly known by the disputed Domain Name, therefore, the Complainant asserts that the Respondent registered the disputed Domain Name for the sole purpose of directing Internet visitors to his own website on which numerous counterfeit American Eagle boots are sold. The Complainant submits that this is neither a bona fide offering of goods or services nor a legitimate non-commercial or fair use pursuant to paragraph 4 (c)(iii) of the Policy as held in *State Farm Mut. Auto Ins. Co. v. LaFaive*, FA 95407 (Nat. Arb. Forum Sept.27, 2000).

3) The Respondent's Bad faith registration and use.

- vi. The Complainant contends that the Panel must look at the totality of the circumstances to determine the Respondent's bad faith in registering a disputed Domain Name and argues that the following circumstances listed below must compel the transfer of the disputed Domain Name to the Complainant.
- vii. The Respondent registered the disputed Domain Name with the intention of diverting business away from the Complainant, and or to confuse customers who seek out the Complainant's business concerns or goods and services on the Internet. The Complainant argues that due to the ubiquitous nature of the Internet the public will inevitably be confused as to source, or identity of the provider of services offered under the same or essentially similar names.
- viii. It is also submitted that the Respondent registered the disputed Domain Name primarily for the purposes of exploiting the rights of the Complainant and or to profit from “pirating” the Respondent's ability to use a confusingly similar variation of the Complainant's American Eagle Marks within the context of a “.com” domain name and to frustrate the Complainant's business opportunities on the Internet by diverting customers away from a legitimate website owned and operated by the Complainant. In this respect the Complainant relies on the case of *Oly Holigon L.P. v. Private*, FA 95940 (Nat. Arb. Forum Dec. 4, 2000) where the a finding of bad faith use was made in that the respondent used the disputed domain name to redirect complainant's consumers and potential consumers to commercial websites which were not affiliated with the complainant.
- ix. The Complainant asserts that whatever may have been the intentions of the Respondent, the fact remains that the Respondent's actions have been injurious to the Complainant as the Respondent may attempt to attract for Respondent's own commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's Marks as to source, sponsorship, affiliation, or endorsement of Respondent's website or location or a product or service on Respondent's website or location. In addition the Respondent's sale of counterfeit American Eagle and copyright pirated products on the disputed website would definitely damage the business and reputation of the Complainant. Furthermore, as a consequence of the global fame

of the Complainant and large volume of business activities in China, the Respondent who is in the same business as the Complainant ought to have known of the registered trademark rights of the Complainant in the AMERICAN EAGLE trademark see in this regard the case of *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. 2003-0455. Accordingly, it is submitted that the Respondent who ought to have known of the Complainant's distinctive and famous trademark and still registered the disputed Domain Name has acted in bad faith as he is deemed to have constructive notice of the Complainant's established rights in the AMERICAN EAGLE trademark as held in *Phat Fashions LLC v. Kevin Kruger*, NAF Case. No. FA 0012000096193.

B. Respondent

The Respondent did not submit a response.

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 must be 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 Panel without any hesitation, finds on the facts as submitted by the Complainant and undisputed by the Respondent, that the disputed Domain name <american-eagle-boots.com.> is identical or confusingly similar to the Complainant's globally registered "AMERICAN EAGLE" trademark. By the sheer number of previously registered trademarks, the Complainant being the proprietor of numerous trademark registrations in well over 100 countries including in the European Community and in China, as exhibited to these proceedings, it is abundantly clear to the Panel that the Complainant has long enjoyed prior rights in the "AMERICAN EAGLE" mark not just in China where the Respondent is based but also worldwide. The Panel is satisfied as the Complainant contends that the Respondent's addition of (i) a generic term "boots"; (ii) hyphens in between the words 'american', 'eagle' and 'boots' and (iii) the generic top level domain (gTLD) ".com" to the disputed Domain Name does not defeat the Complainant's first claim of confusing similarity. The Panel is satisfied that the Complainant's reliance on the two previous UDRP decisions in (a) *American Eagle Outfitters, Inc and Retail Royalty Company v. Admin c/o La Porte Holdings*, NAF Claim No.: FA05000473826 where the disputed domain name <americaneaglestores.com> was found to be confusingly similar to the complainant's "AMERICAN EAGLE OUTFITTERS" mark and (b) *Pomellato S.p. A. v. Richard Tonetti*, WIPO Case No. D2000-0493 where the mere addition of a generic top level domain was found to be irrelevant in deciding confusing similarity features of a disputed domain name. The Panel further accepts that the likelihood of confusion is further heightened by the fact that the Complainant owns and uses a number of domain names incorporating the "AMERICAN EAGLE" mark such as the domain name <ae.com> registered on March 17, 1999 and <americaneagleoutfitters.com> registered on February 20, 2002. The Panel observes and finds that the Complainant's domain names as listed in the WhoIs printout as attached to the Complaint were all registered way before the Respondent decided to register the disputed Domain Name on September 26, 2009 and therefore the disputed Domain Name could be perceived by the relevant consumer public and Internet visitors as one of the Complainant's domain names.

B) Rights and Legitimate Interests

This Panel is equally satisfied that the Respondent has failed to provide any evidence or circumstances required to establish that it has rights or legitimate interests in the disputed Domain Name within the ambit of Paragraph 4 (c) of the Policy. The Complainant in the Panel's view has successfully established that the Respondent who has no business relationship with the Complainant has never obtained consent or authority from the Complainant to use the Complainant's registered trade mark or service marks as a domain name

for any purpose .See generally *Croatia Airlines d.d. v. Modern Empire Internet Ltd*, WIPO Case No. D2003-0455. In addition, this Panel finds that the open sale of counterfeit American Eagle branded boots to online consumers on the Respondent's website linked to the disputed Domain Name or the diversion of Internet users from the Complainant's website cannot be described as legitimate use within the ambit of paragraph 4(c) (iii) of the Policy. See in this regard, *Vapor Blast Mfg. Co.v. R&S Tech., Inc.*, FA 96577 (Nat. Arb. Forum Feb.27, 2001) where it was held that the commercial use of a disputed domain name to confuse and divert Internet traffic is not a legitimate use of the disputed domain name.

As the Complainant asserts that the Respondent has been using the disputed Domain Name to facilitate various wrongful activities, either by reason of infringing upon the Complainant's prior legal rights or by disrupting the Complainant's business it follows as the Complainant contends that the Respondent has never used the disputed Domain Name in good faith or with good reasons. The Panel is therefore satisfied that the Respondent has failed to comply with the stipulated requirements necessary to establish bona fide offering of goods and services as stipulated in the decision of *Okidata Americas Inc. v. ASD Inc.* WIPO Case No.D2001-0903.

C) Bad Faith

The Panel equally finds without hesitation that the Respondent registered the disputed Domain Name in bad faith. In arriving at this conclusion, the Panel has taken into account the fact that the Complainant to the actual and or constructive knowledge of the Respondent is the proprietor of numerous trademark registrations in over 100 countries, since 1977 containing the mark "AMERICAN EAGLE". The Complainant being an entity that is said to have sold billions of dollars' worth of merchandise estimated at over USD \$20 Billion in the past ten years. Apart from registering the "AMERICAN EAGLE" mark in International Classes 25 and 35, in China, in mainland China where the Respondent is based and in Hong Kong, the Complainant to the knowledge of the Respondent has opened seven American Eagle Outfitters retail stores since 2010. The Complainant has provided overwhelming evidence of extensive brand promotion and advertisement in both the Chinese print and electronic media and outdoor promotions within China.

More significantly, the Panel has taken into account a number of illegitimate activities undertaken by the Respondent which further demonstrates bad faith registration and use as listed by the Complainant with supporting exhibits attached to these proceedings as follows: (i) the Respondent has openly engaged in the sale of counterfeit "American Eagle" branded boots and kids' boots to online consumers on the website www.american-eagle-boots.com linked to the disputed Domain Name as evidenced by a large number of webpages from the website attached to these proceedings; (ii) the Respondent registered the disputed Domain Name with the sole aim of diverting customers away from the Complainant's legitimate website and following the decision in *Oly Holigan, L.P. v. Private*, FA95940 Nat. Arb. Forum Dec.4, 2000 bad faith registration and use must be found where the respondent has used the disputed domain name to redirect complainant's consumer and potential consumers to commercial websites not affiliated to the complainant; and (iii) as alluded to above the Respondent's knowledge of the Complainant's globally famous trademark and subsequent registration and use of the disputed Domain Name is deemed to be bad faith registration and use as held in *Phat Fashions LLC v. Kevin Kruger*, NAF Case No. ; FA001200096193 and *Victoria's Secret et al v. Atchinson Investments Ltd*, NAF Case No. FA 0101000096496.

In conclusion, the Panel accepts as the Complainant contends that these acts either considered together or singularly constitute unequivocal acts of deliberate infringement of the Complainant's trade names and trademarks. Accordingly, the Panel finds undoubtedly that the Respondent deliberately registered the disputed Domain Name in bad faith by targeting the Complainant with a view to confusing the public and taking advantage of the reputation of the Complainant to misdirect Internet users to visit the website associated with the disputed Domain Name. In addition, the Panel has drawn adverse inferences from the conduct of the Respondent insofar as the Respondent failed to file a response to these proceedings.

6. Decision

For all the foregoing reasons, the Panel decides that the disputed Domain Name <american-eagle-boots.com> should be transferred to the Complainant forthwith.

Ehiribe.

Ike Ehiribe
Sole Panelist

Dated: January 04, 2013