



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

— A charitable institution limited by guarantee registered in Hong Kong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case Number : HK-1100376

Complainant : Stella McCartney Limited

Respondent : sdf hfdhdfg, ah fsdh

1. The Parties and Disputed Domain Name

The Complainant is Stella McCartney Limited of 4 Grafton Street London W1X 4EF United Kingdom.

The Respondent is sdf hfdhdfg, ah fsdh of dsfsgdfhsdhh, dsfsgdfhsdhh, aerawrewfr, YN, 876345, CN.

The Disputed Domain Name is “stellamccartneyoutlet.com”.

The Registrar is HiChina Zhicheng Technology Ltd. of 3/F., HiChina Mansion, No. 27 Gulouwai Avenue, Dongcheng District, Beijing, China.

2. Procedural History

On 12 July 2011, 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 Supplemental Rules”), the Complainant submitted a Complaint to the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (“ADNDRC-HKO”) and elected that this case be dealt with by a sole panelist.

On 13 July 2011, the ADNDRC-HKO sent to the Complainant by email an acknowledgement of the receipt of the Complaint and on the same date sent the Registrar a request for verification. On the same date, the Registrar confirmed that it was the Registrar of the domain name in dispute and that the Respondent was the registrant of the domain name in dispute.

On 14 July 2011, the ADNDRC-HKO sent a Notification of Commencement of Proceedings (“the Notification”) to the Respondent. The Notification gave the Respondent 20 calendar days to submit a Response (i.e. on or before 3 August 2011).

On 4 August 2011, the ADNDRC-HKO advised both the parties of the failure of the Respondent to submit a Response to the Complaint within the stipulated time period and that a Panelist for the case would shortly be appointed by the ADNDRC-HKO.

On 5 August 2011, the ADNDRC-HKO notified the parties that FONG Ho Yin had been appointed as a sole panelist by the ADNDRC-HKO.

3. Factual Background

For the Complainant

1. Born and raised between London and the English countryside, Stella McCartney graduated from Central St. Martins in 1995. A signature style of sharp tailoring, natural confidence and sexy femininity was immediately apparent in her first collection and after only two collections, in 1997, she was appointed the Creative Director of Chloe in Paris and enjoyed great success during her tenure. In 2001, Stella McCartney left Chloe to form Stella McCartney Limited and launched her own eponymous fashion house in a joint venture with the Gucci Group, debuting her first collection in October 2001 in Paris. Under the Stella McCartney label, her collections include women's ready-to-wear, accessories, lingerie, eyewear, fragrance and organic skincare. Her first perfume, "Stella", launched successfully in 2003.

2. In addition to the main line collection, a long-term partnership with adidas was introduced in September 2004. The critically acclaimed sports performance collection, "adidas by Stella McCartney", has since successfully grown to include several athletic disciplines including running, gym, yoga, tennis, swimming, golf, winter sports and the triathlon. In September 2010, Stella McCartney was appointed Team Great Britain's Creative Director for the 2012 Olympics by adidas – the first time in the history of the games that a leading fashion designer has designed the apparel for a country's team across all competitions for both the Olympic and the Paralympic Games.

3. In November 2005, the hugely successful one-off collection "Stella McCartney for H&M" sold out worldwide in record time. In 2007, Stella McCartney unveiled CARE by Stella McCartney, a luxury organic skincare line and in 2008, a new lingerie line was launched. In November 2009, Stella McCartney collaborated with the Gap on a baby and children's wear collection which was extended into a second season in March 2010. November 2010 marks the launch of Stella McCartney Kids, a collection catering for newborns and children up to the age of 12.

4. In order to protect its IP rights, the Complainant has registered the "Stella McCartney" trademarks in various classes worldwide, including but not limited to the following trademark registrations in PRC and Hong Kong:-

Country / District	Trademark	Registration No.	Date of Registration/	Class of Goods/ Services
PRC	STELLA McCARTNEY	1248668	21 February 1999	25
PRC	STELLA MCCARTNEY	4206114	7 August 2007	16
PRC	STELLA McCARTNEY	G796258	27 January 2003	3, 9
HK	STELLA McCARTNEY	199813252	20 May 1997	25
HK	STELLA McCARTNEY	200309833AA	7 January 2003	3, 9
HK	STELLA McCARTNEY	300870804AA	15 May 2007	14, 18, 35

5. The Complainant has invested significant resources to promote its brand and products. Its products are often featured in top-notch fashion magazines and newspapers.

6. The Complainant's "Stella McCartney" trademarks has been registered, advertised and used widely and intensively, and have become well known amongst the consumers globally as well as in Hong Kong and the PRC as a result. These consumers have come to associate these trademarks with Stella McCartney (and the Complainant) and no other.

For the Respondent

On 10 November 2010, the Respondent through the Registrar HiChina Zhicheng Technology Ltd. registered the Disputed Domain Name.

The Respondent has not filed 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 a trademark or service mark in which Stella McCartney has rights

As noted above, the Complainant has registered the "Stella McCartney" trademarks in various classes in Hong Kong and the PRC. The Complainant's "Stella McCartney" trademarks are famous and have acquired substantial goodwill through extensive promotion and use by the Complainant.

The Disputed Domain Name, "StellaMcCartneyOutlet.com", consists of three parts, namely, "StellaMcCartney", "Outlet" and ".com":

- (a) The first part of the Disputed Domain Name, "StellaMcCartney", is identical to the Complainant's registered trademark "Stella McCartney".
- (b) The second part of the Disputed Domain Name is the English word "Outlet". The English word "Outlet" has a few meanings but when taken in the context of fashion and retail it means "a market for a commodity" or "an agency (as a store) through which a product is marketed". It is thus a generic word related to fashion retail, which is an industry that the Complainant operates in.

It is well-established that "a domain name composed of a trademark coupled with a generic term is still confusingly similar to the trademark (see: Yahoo! Inc. v. Hangzhou Hi2000 InfoTech Co. Ltd. a/k/a Hangzhou Shixin Info Tech Co. Ltd., Claim Number: FA0301000141825).

Further, "the addition of generic words is especially confusing where the generic words bear an obvious relationship to Complainant's business" (see: Foot Locker, Inc. v. Blezin Widmaer, Claim Number: FA0205000113283).

In the case of Victoria's Secret v. Erno Lokhorst, the inclusion of the word "Outlet" in a domain name "VictoriasSecretOutlet.com" did not prevent the administrative panel from finding that the domain name was confusingly similar to the complainant's trademark "Victoria's Secret", and that the respondent had registered the domain name to intentionally attract for commercial gain Internet users to its website by creating a likelihood of confusion with the complainant's well-established mark as to the source, sponsorship, affiliation and endorsement of respondent's website. There is a long line of cases which held that domain names of a similar nature (i.e. registered trademark + outlet) are confusingly similar to the registered trademarks of the brand owners (see: Case search index at WIPO; Victoria's Secret v. Erno Lokhorst, Claim No. FA0101000096556).

- (c) The third part of the Disputed Domain Name, ".com", is a generic top-level domain name (gTLD) suffix. It is non-distinctive and is incapable of differentiating the Disputed Domain Name from the Complainant's registered trademark (see: Pomellato S.p.A v. Tonetti, Case No. D2000-0493).

In light of the above, the Complainant respectfully submits that the Disputed Domain Name is identical or confusingly similar to the "Stella McCartney" trademark in which the Complainant has rights.

2. The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Respondent registered the Disputed Domain Name using a false identity, "sdf hfdhdfg". It is clear that the Respondent is not "Stella McCartney". Therefore, the Respondent is not commonly known by the Disputed Domain Name.

The Respondent's use of the Stella McCartney trademark in the Disputed Domain Name is unauthorized. In particular, the Respondent:

- (a) has never been an authorized sales representative of Stella McCartney;
- (b) has never been licensed to use the "Stella McCartney" trademarks or any other trademarks belonging to the Complainant;
- (c) has never received any approval, whether express or implied, to use the "Stella McCartney" trademarks in or as part of a domain name;
- (d) has never received any approval, expressed or implied, to resell Stella McCartney products on its website; and
- (e) is using the Complainant's trademarks as a domain name to bring people to the Website that offers counterfeit Stella McCartney products.

(see: Pitney Bowes Inc. v. Mike Ostanik, Case No. D2000-1611).

Third, the Respondent has not used the Disputed Domain Name in connection with a bona fide offering of goods or services. The Respondent offers products on the Website which are identified to be counterfeits. The Disputed Domain Name and the design of the Website is very likely to mislead users into believing that the Website is operated or authorized by the Complainant, or that they are buying genuine products originating from Complainant: “Consumers have a right to purchase goods and services from the seller of their own choosing. Respondent offered to sell goods and services under a domain name confusingly similar to Complainant’s mark. That domain name directed Internet users to a website designed to perpetuate confusion to suggest to consumers that they were purchasing goods and services directly from Complainant. This was not a bona fide offering of goods and services by Respondent” (see: Microsoft Corporation v. Microsoft.com aka Tarek Ahmed, Case No. D2000-0548).

The Respondent would no doubt be aware of the fame of the Complainant’s trademark “Stella McCartney” and its products. Internet users who visit the Website may be misled into believing that the counterfeit products offered are genuine Stella McCartney products, that the Website is associated with and/or licensed by Stella McCartney and purchase these products as a result. Given the fact that the products offered for sale are identified to be counterfeit Stella McCartney products, this is exceptionally detrimental to the Complainant’s reputation and this will certainly tarnish the Complainant’s “Stella McCartney” trademarks.

The Complainant respectfully submits that the Respondent has deliberately used the Complainant’s trademark in a domain name to attract users to the Website which offers counterfeit Stella McCartney products for sale through confusion for commercial gain. In such circumstances, it is clear that the Respondent has not used the Disputed Domain Name in connection with a bona fide offering of goods or services (see: AltaVista Company v. Saeid Yomtobian, Case No. D2000-0937).

In light of the above, the Complainant respectfully submits that the Respondent has no legitimate rights or interests in the Disputed Domain Name.

3. The Disputed Domain Name has been registered and being used in bad faith

First and foremost, it should be noted that the Complainant has registered the “Stella McCartney” trademarks in Hong Kong and the PRC in 1997 and 1999 respectively, that is to say, over 10 years before the Disputed Domain Name was registered. In addition, the Complainant’s “Stella McCartney” trademarks have been registered, advertised and used widely and intensively, and have become well-known amongst the consumers globally and in Hong Kong and the PRC. The Respondent has nevertheless chosen to register the Complainant’s well-known “Stella McCartney” trademark as the distinctive part of a domain name. It has long been held that registration of a well-known trademark by a party with no connection to the owner of the trademark and no authorization and no legitimate purpose to utilize the mark reveals bad faith (see: The Caravan Club v. Mrgsale, Case No. NAF/FA95314).

Further, the Disputed Domain Name was registered by “sdf hfdhdfg” belonging to an organization “ah fsdh” at the address “dsfsgdfhsdhh,dsfsgdfhsdhh, aerawrewfr, YN, 876345, CN”, with a non-existent email address “xxing0awe03@gmail.com”. It is abundantly clear that the Respondent has supplied false information when applying for the registration of the Disputed Domain Name. This is directly in contravention of:

- UDRP Paragraph 2 (“you hereby represent and warrant to us that (a) the statements that you made in your Registration Agreement are complete and accurate”); and
- the Registration Agreement (“User hereby undertakes that, the data provided by it in the domain name registration application shall be true, accurate and complete, and contain no misleading or false statements”).

This equally demonstrates that the Disputed Domain Name has been registered in bad faith, especially when the Respondent “has taken deliberate steps to ensure that its true identity cannot be determined and communication with it cannot be made” (see: *Telstra Corporation Limited v. Nuclear Marshmallows*, Case No. D2000-0003).

The Disputed Domain Name resolves to the Website which offers counterfeit Stella McCartney products. The Respondent clearly has intended to attract, for commercial gain, Internet users to the Website by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation or endorsement of the Website and related products. This clearly constitutes use in bad faith (see: *ZRT Laboratory, LLC v. Texas International Property Associates*, Claim Number: FA0701000907499).

Accordingly, it is submitted that the Disputed Domain Name has been registered and is being used in bad faith.

B. Respondent

The Respondent has not submitted any Response within the stipulated timeframe. Therefore, the Respondent is in default.

5. Findings

1. The Language of the Proceedings

The language of the Registration Agreement for the Disputed Domain Name is Chinese. Pursuant to Paragraph 11 of the Rules, in the absence of an agreement between the parties, or unless specified otherwise in the Registration Agreement, the language of the administrative proceedings shall be the language of the Registration Agreement i.e. Chinese.

Paragraph 11(a) of the Rules allows the Panel to determine the language of the proceedings having regard to all the circumstances. In particular, it is established practice to take Paragraphs 10(b) and (c) of the Rules into consideration for the purpose of determining the language of the proceedings. In other words, it is important to ensure fairness to the parties and the maintenance of an inexpensive and expeditious avenue for resolving disputed domain name disputes. Language requirements should not lead to undue burden being placed on the parties and undue delay to the proceedings: see **Whirlpool Corporation, Whirlpool Properties, Inc. v. Hui'erpu (HK) Electrical Appliance Co. Ltd.**, WIPO Case No. D2008-0293; **Solvay S.A. v. Hyun-Jun Shin**, WIPO Case No. D2006-0593.

The Complainant has requested that English be the language of the proceedings for the following reasons:

- (1) The Registration Agreement is published in both English and Chinese;
- (2) Given the fact that the Registration Agreement is also published in English, the circumstances warrant that the proceedings be conducted in English;
- (3) The Disputed Domain Name is in the English language and the contents of the website at the infringing Disputed Domain Name are entirely in English;
- (4) These circumstances present strong evidence that the Respondent is conversant and proficient in the English language.

The Respondent did not make any submissions to the language of the proceedings and did not object to the use of English as the language of the proceedings.

In exercising its discretion to use a language other than that of the Registration Agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs: see **Groupe Auchan v. xmxzl**, WIPO Case No. DCC2006-0004; **Finter Bank Zurich v. Shumin Peng**, WIPO Case No. D2006-0432.

The Panel finds that persuasive evidence has been adduced by the Complainant to suggest the likely possibility that the Respondent is conversant and proficient in the English language: see **Finter Bank Zurich v. Shumin Peng**, WIPO Case No. D2006-0432.

In view of the above, it is unlikely that the Respondent will be prejudiced, should English be adopted as the language of the proceedings.

Having carefully considered all the above matters, the Panel determines under Paragraph 11(a) of the Rules that English shall be the language of the proceedings.

2. Discussions and Findings

Paragraph 4(a) of the Policy provides that the Complainant must prove that each of these three elements are present:

- (i) the Respondent's domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the Respondent's domain name has been registered and is being used in bad faith.

A) Identical / Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainant to prove that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

Based on the “Stella McCartney” registered trademarks of the Complainant, the Panel finds that the Disputed Domain Name is identical or confusingly similar to the Complainant’s registered trademarks.

As noted, the Disputed Domain Name “StellaMcCartneyOutlet.com”, composes of “StellaMcCartneyOutlet” and “.com”.

The only difference between the Disputed Domain Name and the Complainant’s registered trademarks is the inclusion of the word “Outlet” as a suffix at the end of “StellaMcCartney”. The Panel agrees that the English word “Outlet” has a few meanings but when taken in the context of fashion and retail it means “a market for a commodity” or “an agency (as a store) through which a product is marketed”. It is thus a generic word related to fashion retail, which is an industry that the Complainant operates in.

It is well-established that in cases where the distinctive and prominent element of a Disputed Domain Name is the Complainant’s mark and the only addition is a generic term that adds no distinctive element, such an addition does not negate the confusing similarity between the Disputed Domain Name and the mark: see **LEGO Juris A/S v. huangderong**, WIPO Case No. D2009-1325.

No doubt, “.com” is a generic top-level domain name (gTLD) suffix. It is non-distinctive and is incapable of differentiating the Disputed Domain Name from the Complainant’s registered trademark : see **Pomellato S.p.A v. Tonetti**, WIPO Case No. D2000-0493. Hence, the gTLD “.com” is without legal significance as the use of a gTLD is technically required to operate domain names and it does not serve to identify the source of the goods or services provided by the registrant of a domain name.

The Panel is satisfied that the Complainant has complied with Paragraph 4(a)(i) of the Policy.

B) Rights and Legitimate Interests

The fact that the Complainant’s adoption and first use of the registered trademarks predates the Respondent’s Disputed Domain Name has the practical effect of shifting the burden of proof to the Respondent in establishing that it has legitimate rights and/or interests in the Disputed Domain Name : see **Amilcar Perez Lista d/b/a Cybersor**, WIPO Case No. D2003-0174.

As the Respondent is in default and has not filed any Response, in particular, the Respondent has not discharged the burden of proof under Paragraph 4(c) of the Policy.

Accordingly, the Panel is satisfied that the Complainant has complied with Paragraph 4(a)(ii) of the Policy.

C) Bad Faith

Paragraph 4 (b) of the Policy provides that:

“ Evidence of Registration and Use in Bad Faith. For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, 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.”

On the information before the Panel, the Panel finds that the Respondent registered the Disputed Domain Name in bad faith.

In reaching this conclusion, the Panel takes into account of a number of facts into consideration:

1. The Complainant has registered the “Stella McCartney” trademarks in Hong Kong and the PRC in long before the Disputed Domain Name was registered.

2. The Complainant’s “Stella McCartney” trademarks have been registered, advertised and used widely and intensively, and have become well-known amongst the consumers globally and in Hong Kong and the PRC. It has been held that registration of a well-known trademark by a party with no connection to the owner of the trademark and no authorization and no legitimate purpose to utilize the mark reveals bad faith: see **The Caravan Club v. Mrgsale**, Case No. NAF/FA95314.

3. The fact that the Respondent registered the Disputed Domain Name by using a false identity, “sdf hfdhdfg” belonging to an organization “ah fsdh” at the address “dsfsgdfhsdhh,dsfsgdfhsdhh, aerawrewfr, YN, 876345, CN”, with a non-existent email address xxing0awe03@gmail.com, all suggest that the Respondent pre-meditated to use false information to gain registration of the Disputed Domain Name and to avoid being located later. This equally demonstrates that the Disputed Domain Name has been registered in bad faith, especially when the Respondent “has taken deliberate steps to ensure that its true identity cannot be determined and communication with it cannot be made”: see **Telstra Corporation Limited v. Nuclear Marshmallows**, WIPO Case No. D2000-0003.

4. The Panel also accepts the fact that the Disputed Domain Name resolves to the website which offers counterfeit Stella McCartney products. The Respondent clearly has intended to attract, for commercial gain, internet users to the website by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation or endorsement of the website and related products. This clearly constitutes use in bad faith: see **ZRT Laboratory, LLC v. Texas International Property Associates**, Claim Number: FA0701000907499.

Accordingly, the Panel is satisfied that the Complainant has complied with Paragraph 4(a)(iii) of the Policy.

6. Decision

For the foregoing reasons, the Panel is satisfied that the Complainant has proved its case against the Respondent under Paragraph 4(a) of the Policy.

The Panel hereby orders that the Disputed Domain Name be transferred to the Complainant.

FONG Ho Yin
Sole Panelist

Dated: 20 August 2011