



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1600838
Complainant:	Promgirl LLC
Respondent:	Kathaleen Hosle
Disputed Domain Names:	<lovepromgirl.com> <promgirl.cc>

1. The Parties and Contested Domain Names

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

The authorized representative of the Complainant is Kelly Hay, 1441 Broadway, 21st Floor, New York, NY 10018, USA.

The Respondent is Kathaleen Hosle, of 514 W Commonwealth Ave., Fullerton, CA 92832, USA.

The domain names at issue are <lovepromgirl.com> and <promgirl.cc>, registered by the Respondent with GoDaddy.com, LLC (www.godaddy.com).

2. Procedural History

The Complaint was received by the Hong Kong office of the Asian Domain Name Dispute Resolution Centre (the "Centre") on January 19, 2016, and its receipt was acknowledged the same day. On January 19, 2016, the Centre sent an email to the Registrar, GoDaddy.com LLC, requesting verification of the registrant of each of the disputed domain names. On January 20, 2016, the Registrar replied by email to the Centre confirming that the Respondent is listed as the registrant of the disputed domain names and providing the registrant contact details.

On January 20, 2016 the Complaint was reviewed by the Centre and found to be in administrative compliance with the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

On January 20, 2016, pursuant to the Policy, Article 4 of the Rules and Article 6 of the Supplemental Rules, a Notification of the Commencement of the Proceedings was sent to the Respondent by emails addressed to service@promgirl.cc; samjoy001@yahoo.com; postmaster@lovepromgirl.com; and postmaster@promgirl.cc, advising the date for submission of a Response to the Complaint was not later than February 9, 2016.

A Response was not received by the due date and on February 12, 2016 a Notice of Respondent Default was sent to the Respondent.

On February 29, 2016 the Parties were notified by email of the appointment of Dr. Clive Trotman as sole Panelist in this case.

3. Factual background

The Complainant

The Complainant supplies mainly dresses for young people from a number of designers and manufacturers. Since its beginning as a small business in 1998 the Complainant has grown to the scale of having shipped over 300,000 orders to customers in the USA, Canada, Europe, Asia and South America with global sales of over US\$50 million in 2014.

The Complainant uses the trademark PROMGIRL and has also registered a number of domain names incorporating PROMGIRL and PROM, including <promgirl.com> registered on January 22, 1999.

The Respondent

No information of significance is available about the Respondent except for the contact details provided for the purpose of registration of the disputed domain names. According to the Complainant, the Respondent sells similar products to the Complainant through the use of the disputed domain names.

The disputed domain name <promgirl.cc> was registered on May 8, 2013 and <lovepromgirl.com> was registered on April 8, 2015.

4. Parties' Contentions

A. The Complainant

The Complainant's contentions may be summarized as follows:

Under a Trademark License Agreement ("Agreement") effective April 1, 2010, between Prom, LLC, the Licensor, and the Complainant as Licensee, the Complainant was granted a non-exclusive license to use the trademark PROMGIRL, United States Patent and Trademark Office (USPTO) registration number 4112378, subject to the conditions and limitations stipulated in the Agreement. Paragraph 7.2 of the Agreement reads: "If anyone else is using a mark which is the same as or confusingly similar to the Mark, Licensee may take whatever action it deems appropriate, including the institution of any action or

proceeding against the user, to assure the discontinuance of the use of the allegedly infringing mark.”

The Complainant states that it owns the trademark PROMGIRL with design, registration number 4109452.

The Complainant has produced copies of registration documents for the trademarks:

PROMGIRL, service mark, USPTO, principal register, registered March 13, 2012, registration number 4112378, class 35, registrant Prom, LLC;

PROMGIRL, word with a tiara over the letter “O”, USPTO, principal register, registered March 6, 2012, registration number 4109452, class 25, registrant Promgirl, LLC.

The Complainant contends that the disputed domain names are identical or confusingly similar to the Complainant’s trademarks. The trademark PROMGIRL is the prominent and distinctive part of the disputed domain name <lovepromgirl.com> and the connotations of the additional word “love” add to the confusing similarity. The trademark PROMGIRL is effectively identical to the disputed domain name <promgirl.cc>.

The Respondent does not have rights or legitimate interests in respect of the disputed domain names. The Respondent has never been authorized in any way to use the Complainant’s trademark. The word PROMGIRL is not a word in ordinary usage and has no meaning except as the Complainant’s trademark.

The disputed domain names are not in use for a *bona fide* offering of goods or services. Internet users searching for the Complainant’s website are likely to be diverted to the Respondent’s websites by confusion.

The Respondent’s website <promgirl.cc> redirects to <lovepromgirl.com>.

The Complainant says that the disputed domain names have been registered and are being used in bad faith. The disputed domain names <lovepromgirl.com> and <promgirl.cc> were registered respectively 14 years and 16 years after the Complainant’s registration of its own domain name <promgirl.com> on January 22, 1999. The Respondent, operating in the same business as the Complainant, is most unlikely to have been unaware of the Complainant’s trademark.

The Respondent has intentionally attempted to attract, for commercial gain, Internet users to the disputed domain names by confusion with the Complainant as to the source or endorsement of the corresponding websites. The Complainant has ascertained that certain fashion images appearing on the websites of the disputed domain names are the copyrighted images of another company that have been used legitimately on the Complainant’s own website. The dresses offered by the Respondent are counterfeit versions of the originals. A Google Transparency Report for <lovepromgirl.com> contains 17 copyright removal requests and a Google Transparency Report for <promgirl.cc> contains 138 copyright removal requests, from various copyright owners.

The Complainant requests the transfer to itself of the disputed domain names.

B. The Respondent

The Respondent has not replied to the Complainant's contentions.

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 must prove that it has rights in a trademark to which each disputed domain name is confusingly similar. Some inconsistency envelopes the Complainant's assertion of its trademark rights. The reproduced Trademark License Agreement exhibits trademark number 4109452, PROMGIRL with tiara, as being the one licensed to Promgirl, LLC by Prom, LLC, on whose behalf the Agreement is signed by "PromGirl, Inc., Its Manager". Trademark number 4109452 PROMGIRL is in fact registered to Promgirl, LLC, whereas trademark number 4112378 is registered to Prom LLC, according to the registration documents. It is the latter trademark number, 4112378, that the Complainant asserted it had licensed from Prom, LLC.

The USPTO registration documents will be treated as definitive. Since the Complaint is brought in the name of Promgirl, LLC, which is the registrant of record of trademark number 4109452 PROMGIRL word with tiara, it is sufficient to proceed on the basis that the Complainant has the required trademark rights in terms of paragraph 4(a)(i) of the Policy.

The disputed domain name <promgirl.cc> is found to be effectively identical to the word element of the Complainant's trademark PROMGIRL, since the top level directory, in this instance ".cc", may generally be disregarded in the determination of confusing similarity.

The disputed domain name <lovepromgirl.com> is found to be confusingly similar to the Complainant's trademark because it features the trademark PROMGIRL in its entirety. Furthermore the prefix "love", in the context of the Complainant's trademark and its association particularly with young female fashions and clothing, is found not to be distinguishing but to exacerbate confusing similarity.

The Panel finds for the Complainant in the terms of paragraph 4(a)(i) of the Policy.

B. Rights and Legitimate Interests

The Complainant has asserted a *prima facie* case to the effect that the Respondent does not have rights or legitimate interests in respect of the disputed domain names. The

Respondent has not been licensed or authorized in any way to use the Complainant's trademark, which appears to be a constructed word.

Paragraph 4(c) of the Policy provides for the Respondent to establish rights or legitimate interests in a disputed domain name by demonstrating:

- “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 above circumstances are without limitation and rights or legitimate interests may be established by the Respondent alternatively to the satisfaction of the Panel.

The Respondent has not made any showing under paragraph 4(c) of the Policy. The disputed domain names lead to websites that, according to the evidence, display copyright promotional photographs of clothing that have been appropriated from another website without permission. The offering of goods through the disputed domain names is therefore found not to qualify as *bona fide*. There is no indication that the Respondent has been known by the disputed domain names, and their use is clearly not noncommercial.

On the evidence and on the balance of probabilities, the Panel finds for the Complainant under paragraph 4(a)(ii) of the Policy.

C. Bad Faith

The Complainant is required to prove under paragraph 4(a)(iii) of the Policy that the disputed domain names have been registered in bad faith and are being used in bad faith. Paragraph 4(b) of the Policy lists four alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

- “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 website or location or of a product or service on your website or location".

The provisions of paragraph 4(b) of the Policy are illustrative and bad faith may be found otherwise by the Panel. Paragraph 4(b)(iv) of the Policy is pertinent.

The Redirect Checker (www.redirect-checker.org), viewed by the Complainant, confirmed that the disputed domain name <promgirl.cc> redirects to <lovepromgirl.com>. Screen captures of the website of <lovepromgirl.com> show that the Respondent is in the business of offering for sale dresses and clothing for young women in particular. The website pages of the disputed domain names are richly illustrated and heavily promotional, for example, "The 2015 PROM collection - new styles added daily! - up to 70% off". Most merchandise is double-priced, showing purported price reductions, with a shopping cart facility and reference to various credit cards and methods of payment.

Thus, the disputed domain names are found to be in use for commercial gain. In order to do business the Respondent must attract Internet visitors and for that purpose has evidently appropriated the trademark PROMGIRL that characterizes the Complainant's existing US\$50 million turnover business. On the evidence and on the balance of probabilities, the Respondent is found to have used the disputed domain names in bad faith with the intention to attract Internet visitors by confusion, at least initially, with the Complainant's trademark within the meaning of paragraph 4(b)(iv) of the Policy. The Respondent is further found, on the balance of probabilities, to have registered the disputed domain names for the bad faith purpose for which they have been use.

Accordingly the Panel finds the disputed domain names to have been registered and used in bad faith under paragraph 4(a)(iii) of the Policy.

6. Decision

In accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain names <promgirl.cc> and <lovepromgirl.com> be transferred to the Complainant.

Dr. Clive Trotman
Panelist

Dated: March 8, 2016