



Asian Domain Name Dispute Resolution Centre

hongkong

(Hong Kong Office)

## ADMINISTRATIVE PANEL DECISION

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<b>Case No.</b>	HK-2101572
<b>Complainant:</b>	KONINKLIJKE PHILIPS N.V.
<b>Respondent:</b>	Cheryl Wu
<b>Disputed Domain Name(s):</b>	<philipssmartmask.com>

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### 1. The Parties and Contested Domain Name

The Complainant is KONINKLIJKE PHILIPS N.V., of HIGH TECH CAMPUS 5, 5656 AE EINDHOVEN, THE NETHERLANDS (“**Complainant**”).

The Respondent is Cheryl Wu, of 3F, No. 663, Xuecheng Rd, New Taipei City, Shulin Dist, Taiwan (“**Respondent**”).

The domain name at issue is <philipssmartmask.com> (“**Disputed Domain Name**”), registered by the Respondent with Wild West Domains, LLC (E-mail address: abuse@wildwestdomains.com ; Phone number: +1.4806242505) (“**Registrar**”).

### 2. Procedural History

On 1 December 2021, the Complainant submitted a complaint in English (“**Complaint**”) to the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (“**Centre**”) pursuant to the Uniform Domain Name Dispute Resolution Policy approved by the Internet Corporation for Assigned Names and Numbers (“**ICANN**”) on 24 October 1999 (“**Policy**”), the Rules for the Policy approved by the ICANN Board of Directors on 28 September 2013 (“**Rules**”) and the Asian Domain Name Dispute Resolution Centre Supplemental Rules for the Policy and the Rules effective from 31 July 2015 (“**Supplemental Rules**”).

On 2 December 2021, the Centre notified the Registrar by email in respect of the Complaint and requested for a verification in connection with the Disputed Domain Name and a lock to be placed on the Disputed Domain Name. On the same day, the Centre sent an email to the Complainant, amongst other things, to request for a copy of the Registration Agreement of the Concerned Registrar incorporating the ICANN Policy (“**Registration Agreement**”). The Complainant subsequently responded by email and provided a copy of the Registration Agreement. On the same day, the Registrar provided the requested information in respect of the Disputed Domain Name to the Centre by email, and confirmed that a lock has been placed on the Disputed Domain Name.

On 3 December 2021, the Centre sent a Notification of Deficiencies of the Complaint to the Complainant by email pursuant to Article 4 of the Rules, and notified the Complainant that the information of the then respondent in the Complaint was different from the Whois information provided by the Registrar, and that the Complainant had 5 calendar days (i.e. by 8 December 2021) to rectify the deficiency.

On 4 December 2021, the Complainant sent an email to the Centre to provide an updated Complaint.

On 7 December 2021, the Center confirmed with the Complainant by email that the Complaint was in administrative compliance with the Policy and the Rules. The Centre, on the same day, formally notified the Respondent of the Complaint and the deadline of 27 December 2021 to file a Response, and the proceedings commenced on 7 December 2021. On the same day, the Centre sent another email to the Respondent enclosing the Complaint.

On 8 December 2021, the Registrar sent an email to the Centre to request a PDF version of the Complaint, and the Centre responded on the same day entertaining the request.

On 22 December 2021, the Respondent sent an email to the Parties, but did not enclose any formal Response.

The Respondent did not submit any Response to the Centre by the stipulated time limit within 20 calendar days as required under paragraph 5 of the Rules (i.e. by 27 December 2021).

On 28 December 2021, the Centre sent an email to the Parties to confirm that the Centre did not receive a Response from the Respondent within the required time limit (i.e. by 27 December 2021).

On 31 December 2021, the Centre appointed Ms Li Yee Man, Rosita as sole Panelist in this matter. The Panelist accepted the appointment and sent an email to the Centre to confirm that she could act as a sole Panelist in the Complaint and was in the position to act independently and impartially between the Parties. On the same day, the Centre informed the Parties by email that Ms Li had been appointed as the sole Panelist pursuant to the Policy, the Rules and the Supplemental Rules.

### **3. Factual background**

#### **3.1. Complainant**

The Complainant is the proprietor of the following registered trademarks:

- the International trademark word registration No. 310459 for PHILIPS registered on March 16, 1966, for goods and services of classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 14, 15, 16, 17, 19, 20, 21, 28, 31 and 34. In the designated list of goods in class 10, there are “Hospital and laboratory facilities, surgical and medical devices” (installations d’hôpitaux et de laboratoires, instruments chirurgicaux et médicaux);
- the International trademark figurative registration No. 991346 for PHILIPS registered on June 13, 2008, for goods and services of classes 3, 5, 7, 8, 9, 10, 11, 14, 16, 18, 20, 21, 25, 28, 35, 36, 37, 38, 41, 42, 44, 45. In the designated list of

- goods in class 10, there are “Surgical, medical, dental and veterinary instruments and apparatus”;
- the Taiwan trademark registration No. 01462244 for PHILIPS 003, 005 ,007, 008, 009, 010, 011, 014, 016, 018, 020, 021, 025, 028, 035, 036, 037, 038, 041, 042, 044, 045. In the designated list of goods in class 010 there are “Surgical, medical, dental and veterinary appliances and instruments” (外科、內科、牙科和獸醫用器具及儀器); and
  - the Taiwan trademark figurative registration No. 01902820 PHILIPS SHIELD EMBLEM (Device) 003, 005, 007, 008, 009, 010, 011, 014, 016, 018, 020, 021, 024, 025, 026, 028, 035, 036, 037, 038, 041, 042, 044, 045. In the designated list of goods in class 010, there are “Surgical, medical, dental and veterinary appliances and instruments” (外科、內科、牙科和獸醫用器具及儀器).

### 3.2. Respondent

The Respondent registered the Disputed Domain Name on 29 July 2021.

The Respondent, in her email communication dated 22 December 2021, claimed that she set up a small company and was in the business of selling masks.

The Respondent did not file any formal Response within the required time limit.

## 4. **Parties’ Contentions**

### 4.1. Complainant

The Complainant’s contentions may be summarized as follows:

- (i) The Complainant is the owner of well-known trademarks PHILIPS worldwide, and its main website is available at [www.philips.com](http://www.philips.com). The well-known status of the PHILIPS trademark has been confirmed time and again by different domain name dispute resolution centers and their panelists.
- (ii) The disputed domain name “philipssmartmask.com” contains the Complainant’s trademark and service mark “Philips”, additional generic terms of ‘smart’ and “mask”, and the generic top-level domain “.COM”. The first part, “philips”, is identical with the Complainant’s well-known trademark “Philips”. The second part of the disputed domain name, “smartmask” is a descriptive term referring to the personal protection equipment, a mask, that is technologically enabled, hence becomes “smart”. The addition of this descriptive term “smartmask” does not change the overall impression of the designation as being connected to the Complainant and its trademark and more likely strengthens the likelihood of confusion between the disputed domain name and Complainant’s trademark as the masks (or similar products) are part of the Complainant’s products portfolio, especially its Fresh Air Mask that was developed to incorporate extreme comfort, innovative functionality and contemporary design. Philips branded masks are offered for sale through an authorized network of distributors (such as Well Healthcare Co., Ltd. in Taiwan) in the relevant market.
- (iii) Furthermore, the addition of the generic top-level domain “.COM” does not change the overall impression of the designation as being connected to Complainant’s trademark.

- (iv) The trademark 'PHILIPS' is clearly recognizable within this disputed domain name. The disputed domain name reproducing the PHILIPS trademark in its entirety in combination with a descriptive or dictionary word is regarded as confusingly similar to PHILIPS trademark for which the Complainant enjoys exclusive trademark rights.
- (v) Respondent has no trademark rights, license or authorization whatsoever to use the trademark 'PHILIPS'. Complainant has not authorized, licensed or permitted the Respondent to register or use the disputed domain name or to use the trademark 'PHILIPS' or the other copyright protected materials.
- (vi) The Respondent has no official commercial connection whatsoever with the trademark owner.
- (vii) The Respondent has not accurately and prominently disclosed any relationship with the trademark holder on the connected website.
- (viii) The Respondent disclosed on the connected website that "the goods are legally imported from Philips dealers in China and a complete one-year warranty is provided" (商品來自中國飛利浦經銷商合法進口輸入，並且提供完整一年保固) right under "About us" (關於我們). Furthermore, below the information of "About us" in the connected website what is displayed is "Philips Brand Story" (飛利浦品牌故事), saying that "Royal Philips of the Netherlands is a multidisciplinary company dedicated to enhancing people's lives through meaningful innovation in the areas of healthcare, quality of life and lighting, and is a leader in cardiology, acute and home healthcare, energy-efficient lighting solutions and new lighting solutions. It is also a leader in men's shaving and oral health care." (荷蘭皇家飛利浦公司 (Royal Philips of the Netherlands) 是跨足多元科技領域的企業，致力於在醫療保健、優質生活和照明領域，透過有意義的創新提升人們生活，為心臟科、急症及家庭醫療照護、節能照明解決方案和新式照明解決方案領域的翹楚，在男士刮鬍修容和口腔保健方面也位居領導地位。). These sentences are copied from the Complainant's regional website for Taiwan, philips.com.tw. The connected website explicitly associates itself with the Complainant. Such information is not authorized by Philips and is not in compliance with market regulations. And this information falsely suggests any sponsorship, endorsement by, or other affiliation with, the manufacturer and trademark owner.
- (ix) The Respondent has not acquired trademark or service mark rights and the Respondent's use and registration of the Disputed Domain Name was not authorized by the Complainant. In the absence of any license or permission from the Complainant to use its trademark, no actual or contemplated bona fide or legitimate use of the disputed domain name could reasonably be claimed.
- (x) The Complainant holds trademark rights for PHILIPS since at least 1966, and it is well known in its field of activity. The Respondent has actual and full knowledge of the trademark 'PHILIPS' at the time of registration of this Disputed Domain Name, given the worldwide fame of the trademark 'PHILIPS' and the reputation of the brand and company for providing high quality products in the field of healthcare and personal care, which relates to the masks offered for sale in Covid-19 situation. It is inconceivable that the Respondent was not aware of the Complainant's well-known trademark 'PHILIPS' at the time it registered the Disputed Domain Name.

- (xi) The Respondent has unfairly created an impression of any commercial connection with the Complainant's reputable brand and company registered and is using the trademark 'PHILIPS' and company assets owned by Philips without authorization.
- (xii) The website connected to the Disputed Domain Name copies the logos of design awards that were awarded to the Complainant. In this way, the Respondent strengthens its false association with the Complainant.
- (xiii) The contact email address contains the same name 'Philipssmartmask', incorporating the trademark 'PHILIPS' in combination with the product name.

#### 4.2. Respondent

The Respondent, in her email communication dated 22 December 2021, put forward that, amongst other things, she did not understand English, and pursuant to the translation by her friends, she understood the gist of [the Complaint]. The Respondent further claimed that the products sold on the website that the Disputed Domain Name resolved to were genuine products, and she did not intend to enter into any dispute resolution proceedings.

The Respondent did not file a Response to the Complainant's contentions within the required time limit.

### 5. **Findings**

#### 5.1. Administrative Issue

##### (i) *Language of Proceedings*

Paragraph 11(a) of the Rules provides that “[u]nless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceedings”.

The Panel notes that a copy of the Registration Agreement was provided in the Complainant's email dated 2 December 2021, and the said Registration Agreement was in English.

The Registrar in its email to the Centre dated 2 December 2021 also confirmed that the Registration Agreement was in English.

Paragraph 10(d) of the Rules provides that “[t]he Panel shall determine the admissibility, relevance, materiality and weight of the evidence”.

The Panel notes that the Respondent, in her email communication dated 22 December 2021, put forward that, amongst other things, she did not understand English, and pursuant to the translation by her friends, she understood the gist of [the Complaint]. However, the Respondent neither filed a formal Response within the required time limit nor expressly objected to use of English as the language of proceedings.

Having considered the circumstances of the proceedings and given that there was no contention on the issue between the Parties, the Panel determines that the proceedings should be conducted in English.

## 5.2 Substantive Issues

Paragraph 4(a) of the Policy provides that each of the following three findings must be made in order for a Complainant to prevail:

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

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

It has been well established that “.com” in a generic top-level domain does not form part of the relevant assessment. The Panel will only consider the former part of the Disputed Domain Name (i.e. “philipssmartmask”).

The Complainant demonstrated that it was the proprietor of trademarks incorporating “PHILIPS” at the time of the registration of the Disputed Domain Name and of the filing of the Complaint.

As pointed out by the Complainant, the Disputed Domain Name fully incorporated the Complainant's “PHILIPS” mark. The Panel considers that, as the Complainant's entire trademark can be clearly identified in the Disputed Domain Name, the additional words or terms therein do not prevent the Panel to conclude the Disputed Domain Name is confusingly similar to the Complainant's trademarks.

Accordingly, the Panel is of the view that the Disputed Domain Name is confusingly similar to the Complainant's trademarks and the Complainant has satisfied Paragraph 4(a)(i) of the Policy.

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

The Panel notes that the Complainant provided evidences showing that the Disputed Domain Name resolved to a website offering the sale of masks. The Complainant suggested that the said website used materials that were copied from the Complainant's website, and put forward that the Respondent has no official commercial connection with the Complainant and falsely suggested any sponsorship, endorsement by, or other affiliation with the relevant manufacturer and the trademark owner (i.e. the Complainant). Considering the aforesaid, the Panel is of the view that the Respondent did not use the Disputed Domain Name in connection with a bona fide offering of goods and services. The Panel also concludes that the Respondent did not make a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark at issue.

The Panel takes into account that the Complainant's "PHILIPS" trademarks were registered, and the corresponding goodwill and reputation were accrued years before the registration of the Disputed Domain Name. The Panel also notes that the Complainant did not authorize, license or permit the Respondent to register or use the Disputed Domain Name, or use the trademark "PHILIPS". There is no evidence put forward to support that the Respondent had been commonly known by the Disputed Domain Name.

The above suggests, to the least, none of the non-exhaustive "defenses" specifically listed in Paragraph 4(c) of the Policy was met.

The Respondent, in her email dated 22 December 2021, claimed that the products offering for sale in the website which the Disputed Domain Name resolved to was provided by an authorized distributor, so as the images used in the said website. However, the Respondent neither provided any supporting documents nor file any formal Response. There was no evidence being put forward by the Respondent to the Panel for a determination that the Respondent has rights and legitimate interests in the Disputed Domain Name.

Having considered all circumstances, the Panel considers that the Respondent has no rights and legitimate interests in respect of the Disputed Domain Name.

Accordingly, the Panel is of the view that Paragraph 4(a)(ii) of the Policy was satisfied.

(iii) *Bad Faith*

For the same reasons set out in 5(ii) above, strong inferences can be drawn against the Respondent that the Disputed Domain Name were registered and had been used in bad faith.

The Panel notes that in the Respondent's email dated 22 December 2021, she admitted that she "mistakenly used the Disputed Domain Name" and "immediately closed down the website after receiving the [Complaint]".

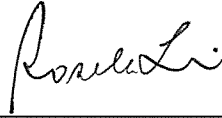
The Panel also notes that the Complainant put forward evidences to support the website that the Disputed Domain Name resolved to offers for sale a mask that the Complainant likewise is selling online on its official website. The Complainant also put forward (with evidences) that its copyrighted materials and trademarks were being used on the said website without authorization.

Having considered the above, the Panel considers that the Respondent registered the domain name primarily for the purpose of disrupting the business of a competitor. In addition, by using the Disputed Domain Name, the Respondent intentionally attempted to attract, for commercial gain, Internet users to her website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of her website or of the product(s) on her website.

Accordingly, the Panel is of the view that Paragraph 4(a)(iii) of the Policy was satisfied.

**6. Decision**

For the reasons set out above and pursuant to Paragraph 4(i) of the Policy and Paragraph 15 of the Rules, the Panel orders that the registration of the domain name <philipssmartmask.com> be transferred to the Complainant.



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Li Yee Man, Rosita  
Sole Panelist

Dated: 14 January 2022