



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-2201593
Complainant:	Sabre Retail Fashion Limited c/o M/s S&P Legal Limited
Respondent:	Suncailong (孙才龙)
Disputed Domain Name(s):	<mintvelvetuk.com>
Sole Panelist:	Dr Stanley Lai, SC

1. The Parties and Contested Domain Name

The Complainant is Sabre Retail Fashion Limited, of St John's Place, Easton Street, High Wycombe, HP11 1NL, United Kingdom (the "**Complainant**"), c/o M/s S&P Legal Limited.

The Respondent is Suncailong (孙才龙), of Shanxisheng, Xixiangxian, Yanghezhen, Sunjiagoucun, Sizu 723500, China (the "**Respondent**").

The domain name at issue is <mintvelvetuk.com> (the "**Disputed Domain Name**"), registered by the Respondent with XIAMEN CHINASOURCE INTERNET SERVICE CO., LTD, of Nanhui County, Shanghai, Shanghai Municipality (the "**Registrar**").

2. Procedural History

The Complaint was filed with the Hong Kong office of the Asian Domain Name Dispute Resolution Centre (the "**ADNDRC**") on 1 February 2022. The ADNDRC acknowledged receipt of the Complaint on 5 February 2022, after submitting a request for the Registrar's verification in connection with the Disputed Domain Name on 4 February 2022. On 7 February 2022, the Registrar responded to the ADNDRC, confirming that (i) the Disputed Domain Name is registered with it, (ii) the Respondent is the registrant, (iii) the ICANN Uniform Domain Name Dispute Resolution Policy (the "**Policy**") (adopted by the ADNDRC) applied to the present dispute, and (v) the language of the registration agreement for the Disputed Domain Name was Chinese.

The ADNDRC informed the Complainant of a deficiency in the Complaint relating to the Respondent's information on 9 February 2022 and requested that the Complainant file an amended Complaint Form. The Complainant submitted an amended Complaint Form on 15 February 2022. The ADNDRC duly verified that the amended Complaint was in administrative compliance with the Policy and the Rules for the Policy (the "**Rules**") and

informed the Complainant of such administrative compliance on 16 February 2022. Formal notification of the Complaint was sent to the Respondent on the same day. This proceeding therefore commenced on 16 February 2022.

The ADNDRC also informed the Respondent of the Complainant's request that the proceedings be conducted in English via an email on 16 February 2022, and sought the Respondent's response regarding the language of the proceedings on or before 22 February 2022. No response has been received from the Respondent to date.

According to Article 5 of the Rules, the Respondent was required to file its response on or before 8 March 2022. The Respondent did not file a response within the required time period. On 9 March 2022, the ADNDRC notified the parties that the UDRP proceeding will proceed.

The ADNDRC appointed Dr. Stanley Lai, SC as the sole panelist for this matter on 11 March 2022. Dr. Stanley Lai, SC confirmed his availability to act as panelist and his ability to discharge his duties independently and impartially between the parties to this dispute.

The Panel has accordingly been properly constituted in accordance with the Rules and the Supplemental Rules.

A preliminary point that arises is whether the proceedings are to be conducted in English or Chinese. The default position under Article 11(a) of the Rules is that the language of the proceedings 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 proceeding. Although the language of the registration agreement for the Disputed Domain Name was Chinese, in its email dated 1 February 2022 enclosing the original Complaint, the Complainant requested that the proceedings be conducted in English, on the basis that additional costs would be incurred by the Complainant if the Complaint were to be translated, and that the Registrar is capable of conducting proceedings in English. The Panel notes that the present proceedings are not in fact conducted by the Registrar, but are before the ADNDRC. Nevertheless, it does not appear that conducting the proceedings in English will engender any prejudice to the Respondent. The Panel has also noted that the Respondent failed to provide any response within the stipulated deadline. The Panel also agrees with the Complainant that it would be inequitable and unnecessary, in the circumstances, to impose further costs upon the Complainant by requiring the translation of the Complaint. The Panel therefore determines that the proceedings shall be conducted in English.

3. Factual background

The Complainant is a company incorporated under the laws of the UK, and, according to the Complainant, is internationally known for design, fashion clothing, footwear and accessories, and has, in particular, developed a significant reputation as a designer both in the UK and abroad. The Complainant owns Mint Velvet Limited, which trades under the "Mint Velvet" brand at the top end of the retail market producing high quality products using the finest raw material and innovative techniques.

The Complainant was and is at all material times the owner of the following "Mint Velvet" trade marks:

- (i) "MINT VELVET" (the "**MV Word Mark**"); and



(ii) (the “MV Device Mark”).

(collectively, the “MV TMs”)

The MV TMs are registered as trade marks throughout the world, including in UK, EU, China, US, Iceland, Canada, New Zealand, Australia, Singapore, Malaysia, Thailand, Israel, Indonesia, UAE, Bahrain etc., and the said registrations cover a large range of goods and services in the following classes:

- (i) Class 14 for Jewellery; precious stones; watches; costume jewellery;
- (ii) Class 18 for Articles of leather and imitations of leather; trunks and travelling bags; travel cases; luggage; suitcases; holdalls; portmanteaux; valises; bags; handbags; shoulder bags; toilet bags; carrier bags; rucksacks; backpacks; bum bags; sports bags; casual bags; briefcases; attaché cases; music cases; satchels; beauty cases; carriers for suits, for shirts and for dresses; tie cases; notecases; document cases; wallets; purses; umbrellas; parasols; walking sticks; shooting sticks; parts and fittings for all the aforesaid goods;
- (iii) Class 25 for Clothing, footwear, headgear, belts; and
- (iv) Class 35 for The bringing together, for the benefit of others, of a variety of jewellery, precious stones, watches, costume jewellery, articles of leather and imitations of leather, trunks and travelling bags, travel cases, luggage, suitcases, holdalls, portmanteaux, valises, bags, handbags, shoulder bags, toilet bags, carrier bags, rucksacks, backpacks, bum bags, sports bags, casual bags, briefcases, attaché cases, music cases, satchels, beauty cases, carriers for suits, for shirts and for dresses, tie cases, notecases, notebook holders, document cases and holders, wallets, purses, umbrellas, parasols, walking sticks, shooting sticks, belts, clothing, footwear and headgear, enabling customers to conveniently view and purchase those goods from a general merchandise retail store or from a general merchandise Internet Website or from a general merchandise catalogue by mail order or by means of telecommunications; advertising services; promotional services; information and advisory services all relating to the aforesaid services.

The Complainant has stated that it has registered the MV TMs in the following jurisdictions:

- (i) Israel on 12 July 2010 covering goods in classes 18, 25 and 35;
- (ii) Australia on 15 March 2012 covering goods in classes 14, 18, 25 and 35;
- (iii) Singapore on 15 March 2012 covering goods in classes 14, 18, 25 and 35;
- (iv) Iceland on 15 March 2012 covering goods in classes 24, 25 and 27;
- (v) The UK on 18 October 2013 covering goods in classes 14, 18, 25 and 35;

- (vi) Through the World Intellectual Property Organisation on 9 April 2014, designating various countries including Indonesia and New Zealand, and covering goods in classes 14, 18, 25 and 35;
- (vii) European Union Intellectual Property Office on 6 March 2014, covering goods in classes 14, 18, 25 and 35;
- (viii) Malaysia on 11 April 2014 covering goods in classes 14, 18, 25 and 35;
- (ix) Thailand on 14 May 2014 covering goods in classes 14, 18, 25 and 35;
- (x) Canada on 4 April 2016 covering goods in classes 14, 16, 18, 25 and 35;
- (xi) The US on 26 December 2017 covering goods in classes 14, 18, 25 and 35;

However, the Panel notes that the Complainant has not annexed to the Complaint particulars of these registrations or copies of the trademark registration certificates, save for:

- (i) a printout from the UK Intellectual Property Office stating that the MV Device Mark is registered as of 18 October 2013 in Classes 14, 18, 25 and 35; and
- (ii) a EU Trade Mark and Designs Certificate of Registration certifying the registration of the MV Device mark as of 6 March 2014 in Classes 14, 18, 25 and 35.

The Complainant also claims that the MV TMs have gained a worldwide reputation after continuous extensive use and marketing throughout the world. According to the Complainant, searches for “MINT VELVET” on <www.google.com> and <www.google.com.hk> generated 64,300,000 results and 70,500,000 results respectively. However, no further evidence was annexed to the Complaint demonstrating such a worldwide reputation, or the degree to which the MV TMs have been used and marketed.

The Disputed Domain Name was registered on 9 January 2022 in the name of the Respondent. According to the Complaint, the website operated under the Disputed Domain Name (the “**Respondent’s Website**”) sells fake counterfeit MINT VELVET goods in large quantities (the “**Infringing Products**”). The Complaint also states that the Respondent’s Website uses images and models which are substantially similar to those used by the Complainant, as well as marks which are confusingly similar to the MV TMs. The Complainant has annexed to the Complaint a screenshot of the Respondent’s Website.

Based on what has been submitted to the Panel, the Respondent has not refuted any of the above claims.

- 4. The 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.

Should the complainant prove that each of these three elements are present, the remedies available to the complainant (at paragraph 4(i) of the Policy) are (i) the cancellation of the domain name in dispute, or (ii) the transfer of the domain name registration to the complainant. In the present case, the Complainant has sought an order that the Disputed Domain Name be transferred to the Complainant.

5. The Complainant's Contentions

The Complainant's contentions may be summarized as follows:

A. The Disputed Domain Name is identical or confusingly similar to trade marks in which the Complainant has rights

i. Trade marks in which the Complainant has rights

The Complaint made reference to a suite of trade marks that are owned by the Complainant in jurisdictions including Australia, Canada, the European Union, Iceland, Indonesia, Israel, Malaysia, New Zealand, Singapore, Thailand, the United Kingdom, and the United States of America.

However, as previously noted, the Complainant only annexed the following evidence of trade mark registrations that are owned by the Complainant:

- (i) a printout from the UK Intellectual Property Office stating that the MV Device Mark is registered as of 18 October 2013 in Classes 14, 18, 25 and 35; and
- (ii) a EU Trade Mark and Designs Certificate of Registration certifying the registration of the MV Device mark as of 6 March 2014 in Classes 14, 18, 25 and 35.

The Complainant also claimed that the MV TMs have gained a worldwide reputation by reason of continuous extensive use and marketing throughout the world. However, the Panel was not furnished with information such as sales figures and advertising or marketing expenditure which would substantiate these claims. Nevertheless, the Panel finds it appropriate to take notice of this assertion (taking note of the paucity of evidence filed in support of the same), in light of the absence of any response from the Respondent. The Complainant also relied upon the search results of Google searches conducted on <www.google.com> and <www.google.com.hk>. In my view, the number of hits on Google searches is not necessarily conclusive of the fact that the MV TMs possess a "worldwide reputation", as alleged by the Complainant. Nevertheless, the significant number of hits (64,300,000 results and 70,500,000 results respectively) does indicate that there is a certain degree of reputation that is currently enjoyed by the Complainant. The Complainant has also stated and listed the ownership of registered trade marks in various classes, spanning many jurisdictions. This information has not been disputed.

ii. The Disputed Domain Name is identical or confusingly similar to the Complainant's trade marks

The Complainant submissions are summarized as follows:

- (i) “www.mintvelvetuk” is the main part of the Disputed Domain Name, and “mintvelvet” is identical to the Complainant’s MV Word Mark;
- (ii) the relevant public would easily separate the Disputed Domain Name into “mintvelvet” and “uk”, with “mintvelvet” being the central and distinguishing element of the Disputed Domain Name;
- (iii) the website accessed through the Disputed Domain Name is blatantly selling fake counterfeit MINT VELVET goods in large quantities, which the Complainant submits is good evidence that the Dispute Domain Name is also viewed by the Respondent as “*the website for buying cheap MINT VELVET goods*”;
- (iv) the images and models used on the website accessed through the Disputed Domain Name are substantially similar to those used by the Complainant, which the Complainant submits is also evidence that the Respondent is promoting the website as the official MINT VELVET website.

According to the Complaint, the Disputed Domain Name can easily mislead consumers to mistakenly believe the Disputed Domain Name is owned or operated by the Complainant, or the Respondent has a certain relationship with the Complainant. The Disputed Domain Name is therefore confusingly similar to the Complainant’s trademark MINT VELVET.

B. The Respondent has no rights or legitimate interest in the Disputed Domain Name

The Complainant’s submissions in support of its assertion that the Respondent has no rights or legitimate interest in the Disputed Domain Name may be summarized as follows:

- (i) The Respondent has never been authorized by the Complainant to use the trademark MINT VELVET under any circumstances;
- (ii) The Respondent has no business relationship with the Complainant;
- (iii) The Respondent’s name, address and any other information are not linked with MINT VELVET;
- (iv) Searches conducted by the Complainant do not reveal that the Respondent has any other rights for MINT VELVET.

C. No bona fide offering of services / use of the Disputed Domain Name is in bad faith

The Complainant made the following arguments to demonstrate that the Disputed Domain Name had been registered and was being used by the Respondent in bad faith:

- (i) The website accessed through the Disputed Domain Name is blatantly selling fake counterfeit products bearing the Complainant’s registered trademark MINT VELVET. The goods sold on the website are also stated to be MINT

VELVET products. The Complainant annexed a screenshot of the website to the Complaint.

- (ii) It can be reasonably inferred that the Respondent was aware of the Complainant's prior rights to the MV TMs before the registration of the Disputed Domain Name, as the Respondent is using the Disputed Domain Name to sell fake counterfeit products bearing the Complainant's MV TMs, which have been extensively registered throughout the world long before the registration of the Disputed Domain Names.

6. Findings of the Panel

No response having been received from the Respondent within the time specified (8 March 2022) or at all, the Panel has proceeded to consider the merits of the Complaint as filed.

The Panel concludes that the Complainant has sufficiently made its case to warrant a transfer of the Disputed Domain Name from the Respondent to the Complainant.

(a) **The Disputed Domain Name is identical / confusingly similar to the MV TMs in which the Complainant has rights**

Despite the absence of documentation evidencing the various trade mark registrations owned by the Complainant, the Panel recognizes that trade mark registrations have been obtained in at least the UK and EU in respect of the MV Word Mark. In the absence of any response from the Respondent, the Panel also takes notice of the Complainant's other trade mark registrations that are allegedly owned by the Complainant apropos the MV TMs. The Panel also notes the evidence (in the form of the number of Google search results) that was tendered in support of the Complaint insofar as it purports to establish that the Complainant enjoys a certain degree of reputation arising from the use of the MV TMs. The Panel concludes that the Complainant has rights in the MV TMs, for the purposes of this proceeding.

The Panel also recognizes that the Disputed Domain Name is confusingly similar to the Complainant's MV Word Mark. In reaching this finding, the Panel notes that the Disputed Domain Name contains "mintvelvet" in its entirety. The Panel agrees with the Complainant that "mintvelvet" is the dominant and distinctive component of the Disputed Domain Name. The Panel also considers that the insertion of the word "uk" in the Disputed Domain Name is descriptive of a geographical origin or location and does not contribute any distinctiveness that would sufficiently distinguish the Disputed Domain Name from the MV Word Mark that is owned by the Complainant.

The Panel's conclusion is consistent with the views and findings of other UDRP panels, which have consistently held that domain names are identical or confusingly similar to a trade mark for purposes of the Policy "*when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name*": see, for example, *Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. D2000-0662.

It is also established that the addition of generic terms to a disputed domain name has little, if any, effect on a determination of confusing similarity between the domain name and the mark: *Quixtar Investments, Inc. v. Dennis Hoffman*, WIPO Case No. D2000-0253. Similarly,

the mere addition of a generic or descriptive term does generally not exclude the likelihood of confusion: *PRL USA Holdings, Inc. v. Spiral Matrix*, WIPO Case No. D2006-0189.

In this regard, suffixes which are country or city names (“paris”, “japan”, “korea”, “taiwan”, “china”, or in this case, “uk”) are non-distinctive and do not serve to distinguish a domain name in any significant way: *L’Oréal, Laboratoire Garnier et Compagnie, Lancôme Parfums et Beauté et Compagnie v. Zhao Ke, Zeng Wei, Zhu Tao, Yang Yong, Ma Yun, Ye Genrong, Ye Li, ChinaDNS Inc., DomainJet, Inc., Hao Domains Services*, WIPO Case No. D2011-1608.

For completeness, the Panel also notes that in making an enquiry as to whether or not a trade mark is identical or confusingly similar, the suffix “.com” is to be disregarded: *Rohde & Schwarz GmbH & Co KG v Perthshire Marketing Ltd* WIPO Case No. D2006-0762, a point which the Complainant had alluded to in the Complaint.

The Disputed Domain Name comprises the MV Word Mark in its entirety, together with a non-distinctive suffix denoting a place of origin or location as the ccTLD, “.uk”. The Panel therefore finds that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights i.e. the MV Word Mark.

(b) The Respondent has no rights and legitimate interests in the Disputed Domain Name

Given the portfolio of MV TMs that is claimed to be owned by the Complainant (and not refuted by the Respondent), with the first registration dating back to 2010 and predating the first entry of the Disputed Domain Name, the onus is on the Respondent to establish the latter’s rights and/or legitimate interests in the Disputed Domain Name: *PepsiCo Inc v Amilcar Perez Lista d/b/a Cybersor*, WIPO case No D2003-0174. No response having been filed by the Respondent, the Panel finds that the Respondent can claim no rights and/or legitimate interest in the Disputed Domain Name. The Respondent was given ample opportunity to file evidence of its own rights to the Disputed Domain Name, whether in the form of registered trade marks or otherwise, but elected not to and indeed failed to do so.

The Disputed Domain Name also resolves to a website purportedly selling MINT VELVET products that are produced by the Complainant, and clearly displaying marks which are identical to the MV TMs. However, on the Complainant’s evidence, the Respondent had never been authorized by the Complainant to use the MV TMs under any circumstances, nor does the Respondent have any business relationship with the Complainant. These assertions were likewise not refuted by the Respondent.

Similarly, an illegal use of another proprietor’s trade marks would not constitute a bona fide offering of goods or services: *Viacom International, Inc., Paramount Pictures Corporation, and Blockbuster Inc. v. TVdot.net, Inc. f/k/a Affinity Multimedia* WIPO Case No. D2000-1253. In the premises, and again without credible explanation or claimed defence (such as parallel importation), the Respondent is unable to claim to any rights or legitimate interest in the Disputed Domain Name.

(c) The Disputed Domain Name has been registered and is being used by the Respondent in bad faith

The Panel also finds that the Domain Name has been registered and is being used by the Respondent in bad faith.

The absence of a credible response meant that the absence of any rights and/or legitimate interests that the Respondent could lay claim to was itself evidence of bad faith. In the absence of any credible explanation to the contrary, the Panel finds that the website which operated under the Disputed Domain Name was directed at users intending to purchase the Complainant's products, who would perceive some form of business relationship between the website and the Complainant. It is reasonable to infer, in the absence of any credible or indeed any other explanation provided by the Respondent, that the registration and continued use of the Disputed Domain Name was intended to mislead internet users to perceive such a legitimate business relationship: *Croatia Airlines d.d. v Modern Empire Internet Ltd*, WIPO Case No. D2003-0455. The third limb is duly satisfied.

No response having been received from the Respondent by the stipulated deadline, or at all, the Panel finds that the Complainant has satisfied all 3 grounds of paragraph 4(a) of the Policy.

7. Decision

For the reasons stated above, the Panel is duly satisfied that the Complainant has sufficiently fulfilled the trinity of requirements as stated in paragraph 4(a) of the Policy.

The Disputed Domain Name is ordered to be transferred to the Complainant.



Dr. Stanley Lai, SC
Sole Panelist

Dated: 25 March 2022