Asian Domain Name Dispute Resolution Centre

ADNDRC hong kong

**(Hong Kong Office)**

**ADMINISTRATIVE PANEL DECISION**

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| **Case No.** | HK-2301722 |
| **Complainant:** | LULULEMON ATHLETICA CANADA INC. |
| **Respondent:** | zhang fang |
| **Disputed Domain Name(s):** | <lulu-tw.com> |

## 1. The Parties and Contested Domain Name

The Complainant is LULULEMON ATHLETICA CANADA INC. (加拿大露露樂檬運動用品有限公司), of 1818 CORNWALL AVENUE, VANCOUVER, V6J1C7, CANADA (加拿大溫哥華 V6J1C7 康沃爾大道 1818 號).

The Respondent is zhang fang, of Changshashibaiyunqu, changshashi, China (中國長沙市白雲區).

The domain name at issue is <lulu-tw.com>, registered by Respondent with Internet Domain Service BS Corp, of OCEAN CENTRE, MONTAGU FORESHORE, EAST BAY STREET, NASSAU, THE BAHAMAS P.O. BOX SS-19084.

## 2. Procedural History

On February 24, 2023, the Complainant submitted a Complaint by email to the Hong Kong Office ("HK Office") of the Asian Domain Name Dispute Resolution Centre ("ADNDRC") by email and elected this case to be dealt with by a single-member panel, pursuant to the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for the UDRP (the "Rules"), and the ADNDRC Supplemental Rules to the Internet Corporation for Assigned Names and Numbers (ICANN) UDRP. In the same email, the Complainant requested for the language of proceedings to be traditional Chinese. On the same day, the HK Office sent to the Complainant by email an acknowledgment of the receipt of the Complaint and Annexes. On the same day, the HK Office notified the Registrar of the Complaint by email and the Registrar replied to the HK Office informing the contact information of the Respondent.

Subsequently, on February 27, 2023, the HK Office informed the Complainant that the information of the Respondent in the Complaint was different from the WHOIS information provided by the Registrar. On the same day, the HK Office informed the Complainant that according to Article 11(a) of the Rules, the language of proceedings shall be the language of the Registration Agreement (i.e., English), subject to the authority of the

Panel to decide otherwise, having regard to the circumstances of the administrative proceeding. On March 1, 2023, the Complainant submitted its amended Complaint and reasons for using traditional Chinese as the language of proceedings to the HK Office. On March 2, 2023, the HK Office confirmed receipt of the Complainant's views on the language of proceedings. On March 2, 2023, the HK Office confirmed to the Complainant that the Complaint is in administrative compliance with the Policy and Rules. On the same day, the HK Office forwarded by email the Complaint together with the Annexes to the Respondent and requested the Respondent to respond to the email on the language of proceedings. The due date of the Response by the Respondent was March 22, 2023. The Respondent did not file a Response and on March 23, 2023, the HK Office informed the Parties of the Respondent's default in response. On the same day, the HK Office sent a panelist appointment invitation to Li Yee Man Rosita and received a declaration of independence and impartiality from Li Yee Man Rosita on March 24, 2023. On March 24, 2023, the HK Office appointed Li Yee Man Rosita as the sole panelist in this matter.

## 3. Factual background

The Complainant is LULULEMON ATHLETICA CANADA INC. (加拿大露露樂檬運動用品有限公司). The Complainant submits that it was founded in 1998 and opened its first physical store in Vancouver in 2000, primarily engaging in businesses related to yoga clothing, sportswear, sports bags and yoga mats.

The Complainant submits that:-

- The Complainant became well known as "Canada's No. 1 Professional Sports Brand" and the first choice for many yoga/sports consumers due to their yoga clothes' and sportswear's tight-fitting, comfortable and breathable features.
- The Complainant is the proprietor of the following trade marks (collectively, the "**Complainant's Marks**"):-
    - PRC Trade Mark Registration No. 1939499 for "LULULEMON" in class 25, registered on October 28, 2002. The goods covered under this registration are "shorts; tight-fitting short vests; coats; jackets (clothing); underwear; sports pants; sports shirt; clothing; T-shirt; shirt; trousers; skirt; dresses; sandals; boots; shoes; sports shoes; cap; socks" (短褲; 緊身短背心; 外套; 夾克（服裝）; 內衣; 運動褲; 運動衫; 服裝; T 恤; 襯衫; 褲子; 裙子; 禮服; 涼鞋; 靴; 鞋; 運動鞋; 帽; 襪);
    - PRC Trade Mark Registration No. 6119417 for "LuLuLemon" in class 18, registered on March 7, 2014. The goods covered under this registration are "cowhide; handbags; wallets; leather pads; leashes; backpacks; umbrellas; walking sticks; animal collars; pet clothing" (牛皮; 手提包; 錢包; 皮墊; 牽繫皮帶; 背包; 傘; 手杖; 動物項圈; 寵物服裝);
    - PRC Trade Mark Registration No. 1939495 for "  " in class 25, registered on October 14, 2003. The goods covered under this registration are "T-shirts; underwear; outerwear; clothing; shorts; dresses; camisoles; jackets (clothing); shirts; skirts; trousers; sports shirts; sports pants; sandals; sports shoes; boots; shoes; caps; socks)" (T 恤衫; 内衣; 外套; 服装; 短裤; 礼服; 紧身短背心; 茄克(服装); 衬衫; 裙子; 裤子; 运动衫; 运动裤; 凉鞋; 运动鞋; 靴; 鞋; 帽; 袜);

- Taiwan Trade Mark Registration No. 01119845 for "LULULEMON" in class 25, registered on September 16, 2004. The goods covered under this registration are "Clothing, namely: T-shirts, shirts, trousers, shorts, skirts, dresses, sports shirts, sports pants, vests, underwear, socks, jackets, coats, hats; boots, namely: shoes and sandals" (衣服，即：T恤，襯衫，褲子，短褲，裙子，洋裝，運動衫，運動褲，背心，內衣，襪子，夾克，外衣，帽子；靴鞋，即：鞋子及涼鞋); and

- Taiwan Trade Mark Registration No. 01767268 for " " in class 25, registered on May 1, 2016. The goods covered under this registration are "Clothing, namely: T-shirts, shirts, trousers, shorts, skirts, dresses, sports shirts, sports pants, vests, underwear, socks, jackets, coats, hats; boots, namely: shoes and sandals" (衣服，即：T恤，襯衫，褲子，短褲，裙子，洋裝，運動衫，運動褲，背心，內衣，襪子，夾克，外衣，帽子；靴鞋，即：鞋子及涼鞋).

The Disputed Domain Name was registered on October 7, 2022, and the Complainant submits that it resolves to a website in Chinese which uses the Complainant's Marks and the images of products listed on the website also bear the Complainant's Marks.

The Respondent is zhang fang of Changshashibaiyunqu, changshashi, China (中國長沙市白雲區). The Respondent did not file a Response to the HK Office.

## 4. Parties' Contentions

### A. Complainant

The Complainant's contentions may be summarized as follows:

i. The Disputed Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights.

The Complainant submits that it was established on 12 January 1999 under the company name "LULULEMON ATHLETICA INC.". The name was changed to the current company name, "LULULEMON ATHLETICA CANADA INC.", in 2007. The Complainant contends that since its establishment, it has been using "LULULEMON" as its trade name, and as such, the Complainant has prior trade name rights to "LULULEMON". The Complainant also contends that through the long-term publicity and use of the Complainant's Marks in China and Taiwan, the Complainant's Marks have acquired a high reputation among the relevant public.

The Complainant further submits that their stock code "LULU" which is the abbreviation of their trade name "LULULEMON" has been widely used by consumers in China and Taiwan to refer to the Complainant and has established a certain level of reputation in the industry of yoga clothing and related-products. The Complainant submits that many consumers would call and refer to the Complainant by "LULU". Hence, the Complainant contends that the Complainant enjoys the prior trade name rights to "LULU" (the "**Complainant's Trade Name**").

The Complainant submits that the Disputed Domain Name fully incorporates the Complainant's Trade Name, which is the abbreviation of the Complainant's "LULULEMON" marks, and will lead to public confusion. The Complainant further submits that the letters "tw" in the Disputed Domain Name is the abbreviation of Taiwan, and that its use as a suffix in the Disputed Domain Name does not render it distinctive. The Complainant submits that the distinctive part of the Disputed Domain Name is "lulu", which is the Complainant's Trade Name and the abbreviation of the Complainant's "LULULEMON" marks.

The Complainant submits that ordinary consumers who see the Disputed Domain Name being comprised of "lulu" and "tw" will easily be mistaken that the Disputed Domain Name is the domain name of the Complainant's branch company in Taiwan and that the products and services provided on the website of the Disputed Domain Name are originated from the Complainant's Taiwan branch, resulting in public confusion.

The Complainant also referred to China National Intellectual Property Administration trade mark proceedings initiated by the Complainant against the PRC Trade Mark Applications for "LULULEMON" and "lulufit", in support of the well-known reputation of the Complainant's "LULULEMON" marks and the distinctiveness of the word element "LULU" in the Complainant's Trade Name in China.

ii. The Respondent has no rights or legitimate interests in the Disputed Domain Name.

The Complainant submits that the Respondent's trade name is not associated with "lulu" in any way and that no trade mark for "lulu" or "lulu-tw" in class 25 was registered on the China National Intellectual Property Administration and the Taiwan Intellectual Property Office register. The Complainant submits that the Respondent has no trade mark registrations under its name. As such, the Complainant contends that the Respondent does not have rights or legitimate interests in the Disputed Domain Name.

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

The Complainant submits that in the website under the Disputed Domain Name website, the Respondent refers to itself as the "LULULEMON official website" ("LULULEMON 官網") and includes multiple hyperlinks for "LULULEMON official website" ("LULULEMON 官網") which divert users to the Dispute Domain Name website leading users to mistake the Disputed Domain Name website as the Complainant's official Taiwan website.

The Complainant further submits that the Respondent had, without authorization, widely used the Complainant's Marks on various pages of the Disputed Domain Name website, as well as on the yoga clothing and related products listed on the website. The Complainant submits that the Disputed Domain Name website also published many articles about the Complainant. The Complainant contends that such wide use of the Complainant's Marks and the Complainant's Trade Name

and misleading articles further cause users to believe that the Disputed Domain Name website is the Complainant's official Taiwan website.

The Complainant submits that the Respondent is a repeated infringer whereby the Respondent had previously registered the domain name <lulu-lemon.com.tw> and <lulu-taiwan.com>, maliciously advertising them as the Complainant's official websites in Taiwan and selling counterfeit yoga products. The Complainant contends that these two domain names no longer contain infringing content, but that <lulu-taiwan.com> can still be directed to the Disputed Domain Name website. The Complainant submits that the Disputed Domain Name website has been suspended for investigation into its sale of counterfeit "LULULEMON" yoga products.

Considering the above, the Complainant submits that the Respondent registered the Disputed Domain Name fully aware of the reputation of the Complainant's Marks and the Complainant's Trade Name in the yoga clothing and supplies industry and uses it to sell counterfeit yoga-related goods on the Disputed Domain Name website clearly shows their malicious intention to free ride on the Complainant's LULULEMON brand. The Complainant submits that such acts can easily mislead the consumers and cause great harm to the consumers and the interest of the Complainant.

### B. Respondent

The Respondent did not file a Response to the Compliant within the required time limit.

## 5. Findings

### 5.1 Administrative Issue

*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 proceeding*".

The Panel notes that a copy of the Registration Agreement was provided in the Annexes of the Complaint, and the said Registration Agreement was in English. The Registrar in its email to the HK Office of February 24, 2023, also confirmed that the Registration Agreement was in English.

The Panel notes the Complainant's reasons as set out the email of the Complainant's representative dated March 1, 2023 for requesting the language of the proceedings be in traditional China and the reasons, amongst other things, are that the Complaint is based mainly on the Complainant's Taiwan trade mark registrations; the language on the Disputed Domain Name's website is traditional Chinese; and the Respondent is likely to be a Chinese individual. However, the Panel also notes that the Respondent did not file a

Response and did not agree nor disagree with the change of the language of the proceedings. Given that the Complainant is based in Canada and the Panel does not require the Complainant to translate its submissions and annexures to English, there should be no prejudice placed on the Complainant to keep the language of proceeding as English.

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

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.

**A. Identical / Confusingly Similar**

It has been well established that generic Top-Level Domains such as ".com" in a domain name does not typically form part of the relevant assessment in the test of confusing similarity. The Panel will accordingly consider the Second-Level Domain of the Disputed Domain Name (i.e., "lulu-tw").

The Complainant demonstrated that it is the proprietor of the Complainant's Marks prior to the registration of the Disputed Domain Name and the filing of the Complaint.

According to the case ***Chiu Tsen Hu v. Andy Rose*** (ADNDRC Case No. HK-1500719, 16 April 2015), the Panel of the case decided that "*registration of a trademark [is] not a prerequisite in domain name disputes*", and notwithstanding that a complainant has not registered its trade name, if it had been using the trade name continuously in relation to its business it could be sufficient to demonstrate the complainant had rights to it to initiate a proceeding.

The Panel has considered the evidence submitted by the Complainant, including the articles and website excerpts showing use of "LULU" /"露露" (English transliteration: lulu) as the abbreviation of the Complainant, which demonstrate the public's reference to the Complainant as "LULU" and "LULU" as the stock code of the Complainant. The Panel is prepared to find that the Complainant has established rights to the Complainant's Trade Name which has been widely used in relation to their business and used by the public as an abbreviation of, or reference to, the Complainant's LULULEMON brand.

The Panel has also considered the various decisions of the China National Intellectual Property Administration submitted by Complainant with regard to contentions against third party trade marks incorporating "lulu" in China. The Panel notes that there are number of decisions where the China National Intellectual Property Administration expressed that "lulu" in the Complainant's "LULULEMON" trade mark is a distinctive

element for identification. The incorporation of "lulu" in the third party's marks (as covered in the decisions) would cause confusion on the part of the public. The Panel is of the view that as far as trade mark rights are concerned, the decisions have shown and prove that the Complainant has established that "lulu" is distinctive and the Complainant has a right in the term "lulu" which is the front part of the Complainant's "LULULEMON" trade mark. Although the decisions are rendered by the China National Intellectual Property Administration and not by any authorities in Taiwan where the Disputed Domain Name is supposed to be targeting, the Complainant has provided evidence to show that Taiwan consumers also recognize the term "lulu" as the abbreviation of the brand name "LULULEMON" of the Complainant. The Panel is of the view that the Complainant has trade name rights in "lulu".

The Panel notes that the Disputed Domain Name incorporates the Complainant's Trade Name in its entirety with the addition of the geographical indicator "-tw". The Panel accepts that the letters "tw" is a known country/area abbreviation of Taiwan in English, and finds that the use of "-tw" as a suffix in the Disputed Domain Name does not contribute to any distinctiveness to distinguish, or prevent a finding of confusing similarity between, the Disputed Domain Name from the Complainant's Trade Name.

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

**B. Rights and Legitimate Interests**

The Panel notes that as at the date of this decision, the Disputed Domain Name resolves to an error page. That said, the Panel has reviewed the notarized screen captures of the Disputed Domain Name website submitted by the Complainant, the Panel accepts the Complainant's submission and evidence that, at the time when the Complaint was prepared, the Disputed Domain Name resolved to a website in Chinese, which displayed the Complainant's Marks on various pages of the website and on images of yoga-related products. The Panel also finds that the Disputed Domain Name resolved to a website which appeared to be selling yoga-related products bearing the Complainant's LULULEMON brand. The Panel notes that the Complainant did not authorize the Respondent to use the Complainant's Marks and/or the Complainant's Trade Name.

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 as the references made to the Complainant's Marks in the Disputed Domain Name website and the use of the Complainant's Mark on the yoga-related products offered in the Disputed Domain Name website were all without the Complainant's permission. The Panel concludes that the Respondent did not make a legitimate non-commercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's Marks and the Complainant's Trade Name.

The Panel notes that the Complainant did not authorize the Respondent to use the Complainant's Marks and/or the Complainant's Trade Name. The Panel further notes that the Respondent has failed to provide any evidence or submit any arguments to demonstrate that it had rights or legitimate interests in the Disputed Domain Name. No

evidence was given by the Respondent to prove that it had authorization from the Complainant to use the Complainant's Marks or the Complainant's Trade Name and/or register a domain name which incorporates the Complainant's Trade Name, or any similar term to "LULULEMON" or "LULU".

Accordingly, the Panel is of the view that the Respondent does not have rights or legitimate interests in respect of the Disputed Domain Name and that paragraph 4(a)(ii) of the Policy has been satisfied.

**C. Bad Faith**

It is well established that the registration of a domain name which is identical or confusingly similar to a famous or widely-known trade mark by an unaffiliated entity can by itself create a presumption of bad faith. The Panel is prepared to find that the registration of a domain name which is identical or confusingly similar to a famous or widely known trade name by an unaffiliated entity similarly creates a presumption of bad faith.

The Complainant's LULULEMON brand was established since 1999 and the Panel accepts that the Complainant has been operating its business under names which incorporate the term "LULULEMON". The Panel notes that the Complainant's Marks were registered prior to the registration of the Disputed Domain Name. The Panel accepts that the Complainant's LULULEMON brand is recognized for their yoga clothing and related goods and enjoys a high reputation amongst the relevant public. In view of the trade mark decisions submitted by the Complainant together with the online article on the use of "LULU" as the Complainant's stock code and reference to the brand, the Panel accepts that the Complainant's Trade Name is distinctive and well known by the relevant public in reference to, and as an abbreviation for, the Complainant and the Complainant's LULULEMON brand. Considering the reputation of the Complainant's LULULEMON brand, the Complainant's Marks, and the distinctiveness of the Complainant's Trade Name, it would not be possible for the Respondent to claim they were unaware of the Complainant's LULULEMON brand, the Complainant's Marks or the Complainant's Trade Name, or that the choice in domain name was coincidental.

Further, considering the composition of the Disputed Domain Name, in particular, the incorporation of the geographic indicator "-tw" as a suffix to the Complainant's Trade Name in the Disputed Domain Name, which corresponds to the Complainant's area of activity in Taiwan, the Panel is prepared to infer that the Respondent knew, or should have known, that its registration of the Disputed Domain Name would be confusingly similar to the Complainant's Trade Name. Accordingly, the Panel finds that the Respondent registering a domain name confusingly similar to the Complainant's Trade Name is a clear indicator of bad faith.

The Panel notes that the Complainant did not authorize the Respondent to use the Complainant's Marks and/or the Complainant's Trade Name on the Disputed Domain Name website. Considering the appearance and use of the Disputed Domain Name website, while it was still active, to sell goods purporting to be under the LULULEMON brand, the Panel is prepared to find that the Respondent has attempted to pass off as the official Taiwan website of the Complainant and/or pass off as being

affiliated with the Complainant, to benefit from the reputation and goodwill of the Complainant's LULULEMON brand.

Having considered the above, the Panel considers that the Respondent registered and used the Disputed Domain Name primarily for the purpose of attempting to attract, for commercial gain, Internet users to their website by creating confusion with the Complainant's trade mark as to the source, sponsorship, affiliation, or endorsement of their website or of the product(s) on their website to the Complainant. This constitutes evidence of bad faith under paragraph 4(b)(iv) of the Policy.

In view of the foregoing and the Respondent's clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the domain name, the Panel is of the view that paragraph 4(b)(iii) of the Policy has been satisfied.

## 6. Decision

For the foregoing reasons, in accordance with paragraph 4(i) of the Policy and paragraph 15 of the Rules, the Panel orders that the Disputed Domain Name, <lulu-tw.com>, be transferred to the Complainant.

Li Yee Man Rosita
Panelist

Dated: April 7, 2023