



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

— A charitable institution limited by guarantee registered in Hong Kong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1100395
Complainant:	Swatch Ltd.
Respondent:	Xufei Wang

1. The Parties and Contested Domain Name

The Complainant is:

SWATCH LTD
94, Rue Jakob Stampfli, CH 2502
Bienne, Switzerland

The Respondent is:

Xuefie Wang
1-3-601 Qian Jiang Qi Yuan
Tai Pingmen Road
Hangzhou, Zhejiang
PRC

The domain name at issue is:

eswatch.com

which is registered with GoDaddy.com, Inc

2. Procedural History

On 26 September 2011, Complainant, through its authorized agent (see Complainant's "Power of Attorney"), communicated with the Hong Kong office of the Asian Domain Name Dispute Resolution Center (hereinafter referred to as "ADNDRC-HK") concerning the domain name <ESWATCH.COM>. After an exchange of communications with Complainant, ADNDRC-HK contacted the registrar of the disputed domain name, GoDaddy.com, Inc. by e-mail dated 3 October 2011. GoDaddy.com, Inc. replied by e-mail dated 4 October 2011 stating that the registrant of the contested domain name is Xufei Wang with the identical address as the Respondent above. The disputed domain name, according the GoDaddy.com, Inc.'s e-mail, was created on 29 June 2007 and is registered through GoDaddy.com, Inc.

An exchange of e-mails occurred concerning the Complainant's compliance with Section 11 of the Rules for Uniform Domain Name Dispute Resolution Policy (hereinafter referred to as

“Rules”) approved by ICANN: the language of the administrative proceeding shall be the language of the Registration Agreement.

On 17 October 2011, the Complainant, through its authorized agent, transmitted an English version of its Complaint on the prescribed Form C to the ADNDRC-HK in accordance with the Uniform Domain Name Dispute Resolution Policy (hereinafter referred to as “Policy”) adopted by the Internet Corporation for Assigned Names and Numbers (hereafter referred to as “ICANN”), the Rules, and the Asian Domain Name Dispute Resolution Center Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (hereinafter referred to as “Supplemental Rules”).

On or about 17 October 2011, ADNDRC-HK notified the Respondent in this matter by e-mail of the complaint filed by the Complainant. ADNDRC-HK forwarded the hard copies of the relevant documents to the Respondent by courier. Respondent acknowledged, by e-mail dated 21 October 2011, receipt of the courier delivery and noted that Respondent did not receive the e-mail transmission of the Complaint. By e-mail dated 21 October 2011, ADNDRC-HK re-sent its e-mail of 17 October 2011.

By e-mail dated 6 November 2011, Respondent attached its Response to the Complaint. ADNDRC-HK duly forwarded this Response to the Complaint the following day, as this Response was deemed to be received within the specified time period.

On 14 November 2011, the undersigned, a potential Panelist for this dispute, confirmed his availability to act as a Panelist and his ability to act independently and impartially between the parties to this dispute. Subsequently, on 18 November 2011, ADNDRC-HK via several e-mails: appointed the undersigned as the sole Panelist in this dispute; transmitted the documents; and, requested that a decision to be rendered by 4 December 2011.

The Panel finds that it was properly constituted and appointed in accordance with the Rules and the Supplemental Rules. Therefore, this Panel has jurisdiction over this domain name dispute. The proceeding is in English, being the language of the Domain Name Registration and Service Agreement, pursuant to Paragraph 11(a) of the Rules, and in consideration that there is no express agreement between the Parties to the contrary.

3. Factual Background

3.1 For Complainant

Complainant, Swatch Ltd, is a subsidiary of The Swatch Group Ltd, which is one of the largest watch makers internationally, including but not limited to such brands as: Bregue, Blancpain, Glashütte, Omega, Rado, Longines, Tissot, and Swatch. Complainant launched its first <SWATCH> brand watch approximately 25 years ago in the PRC. (Complainant’s Exhibit 12 and Exhibit 6) Complainant has obtained approximately current 55 trademark registrations in the PRC.

Complainant states that it has owned the Chinese trademark registration for <SWATCH> since September 1985 and said registration is valid until September 2015. (Complainant’s Exhibit 2) Complainant states that it has been using the registered domain name <SWATCH.COM> since June 1996. (Complainant’s Exhibit 5) Complainant further states

that it owns the international trademark registration for <ESWATCH>, with a Registration Date of 7 April 2008 and a Priority Date of 28 November 2007. (Complainant's Exhibit 3).

3.2 For Respondent

Respondent filed its Form R Response in a timely manner contending that it registered the domain name <ESWATCH.COM> on 29 June 2007, a date preceding the Complainant's Registration Date of 7 April 2008 with a Priority Date of 28 November 2007 for the trademark <ESWATCH>.

4. Parties' Contentions

4.1 For Complainant

The Complainant's contentions may be summarized as follows:

- Disputed domain name is identical or confusingly similar. The disputed domain name, being the letter <E> immediately preceding the Complainant's domain name <SWATCH> is identical or confusingly similar to Complainant's trademarks.
- Respondent has no legitimate interests in the disputed domain name. Related to the foregoing, the brand name <SWATCH> was well-established and well-known prior to the Respondent's registration of the disputed domain name. Further, Complainant contends that Respondent is not making a legitimate, non-commercial use of the disputed domain name.
- Bad faith. The disputed domain name is confusingly similar to Complainant's brand and Respondent's purpose of registering the disputed domain name is for the purposes of profit or commercial gain in excess of the registration costs. (Complainant's Exhibits 11-14)

4.2 For Respondent

The Respondent's contentions may be summarized as follows:

- The definition of the word <SWATCH> is dissimilar to the brand <SWATCH>. (Respondent's Exhibit 1)
- The use of the letter <E> in connection with another word or brand is a common combination in domain name usage. (Respondent's Exhibit 2)
- Consequently, Respondent's registration of the domain name <ESWATCH.COM> is based upon website development and common combination of domain name usage.
- There is no similar content or product information such as to confuse or mislead the public with <ESWATCH.COM> and <SWATCH> brand watches. (Respondent's Exhibit 3)
- There is no evidence of cyber-squatting or attempting to sell the domain name. (Respondent's Exhibit 4)
- The domain name <ESWATCH.COM> was registered by Respondent *before* Complainant's registration.

5. Findings

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

- i. That the domain name of the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and,
- ii. That the Respondent has no rights or legitimate interest in respect of the domain name; and,
- iii. That the domain name has been registered and used in bad faith.

Based upon the pertinent requirements under the Policy, Rules and the Supplemental Rules, the Panel in this matter shall determine whether Complainant satisfies each of the foregoing criteria.

5.1 Respondent's domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights.

Respondent claims that "e+one word" is a commonly used combination in domain usage, citing to examples such as <eBay.com>, <eLong.com>, and <eName.com>. (Respondent's Exhibit 2) This assertion ignores prior decisions in similar disputes. The disputed domain name is <ESWATCH.COM>. Apart from the generic top-level domain suffix <.COM>, the disputed domain name is comprised of <ESWATCH> which combines Complainant's mark with the prefix <E>. The disputed domain name contains Complainant's mark in full with the addition of the prefix <E> which appears to have no substantial meaning other than to perhaps indicate an association of some kind with an electronic or cyber version of a complainant's mark for e-commerce purposes.

The Panel in the case of *Trendy International Investment Limited v Pri*, Beijing ADNDRC Case No: -CN-1100433 (2011), found that the majority of disputed domain name <E-OCHIRLY.COM> to be comprised of two separate sub-parts: <E> and <OCHIRLY>. The first sub-part is not sufficiently distinctive to differentiate the disputed domain name from the Complainant's registered trademark. The second sub-part of the disputed domain name is identical to the Complainant's registered trademark <OCHIRLY>, "except for the lower case letters that has nearly no effect on distinguishing the disputed domain name and the Complainant's prior trademark." The <.COM> merely indicates the registration of the disputed domain name under the gTLD and is not distinctive. The Panel in *Trendy International Investment* concluded that the only distinctive and identifying part of the disputed domain name is <OCHIRLY>.

The case of *Lacoste SA v Eyu Lang*, Beijing ADNDRC Case No: CN-1000375 (2011) addressed the instance where the letters <IN> were inserted before <LACOSTE> to create the domain name <INLACOSTE.COM>. The panel in that dispute determined that the addition of a prefix having no substantive meaning but to restate the connection with the legitimate trademark holder does not preclude a finding of "confusingly similar to a trademark in which Complainant has rights".

Likewise and for similar reasons, in the case of *Alibaba Group Holding Limited v Xushien*, Hong Kong ADNDRC Case No: HK-11000373 (2011), the panel ordered the disputed domain name <E-ALIBABA.NET> be transferred to the Complainant. See also the decisions

in *Hitachi, Ltd v. Ningbo Hitachi Garment & Apparel Co., Ltd.*, Beijing ADNDRC Case No: CN-1100439 (2011) (ordering the transfer of the disputed domain name <NBHITACHI.COM> to the Complainant); *Swatch Ltd v Jianyu Zhang*, Hong Kong ADNDRC Case No. HK-1000299 (ordering the transfer of the disputed domain name <SWATCH.PRO> to the Complainant; and, *精工爱普生株式会社 v. Hua Xiao Hao*, Beijing ADNDRC Case No: CN-1100438 (2011) (ordering the transfer of the disputed domain name <OKEPSON.COM> to the Complainant).

This Panel agrees with the analyses contained in the above cited cases. This Panel finds that <ESWATCH.COM> is comprised of two sub-parts: <E> and <SWATCH> where the former sub-part contributes little if any distinctiveness to the mark. This Panel finds the latter sub-part is identical or confusingly similar to Complainant's trademark and would cause confusion among the consuming public with Complainant's trademark. Complainant has met the first requirement under Paragraph 4(a) of the Policy.

Respondent's other defense is that its registration of <ESWATCH.COM> pre-dates that of Complainant's registration of <ESWATCH>. (Respondent's Exhibit 5) In consideration of the above finding, the Panel need not address this claim in detail. The Panel accepts Complainant's evidence that it legitimately holds the international registration for <ESWATCH> and that Complainant's trademark registration of <SWATCH> pre-dates that of Respondent. This will be further addressed below.

5.2 Respondent has no rights or legitimate interest in respect of the domain name.

For the purposes of Paragraph 4(a)(ii), Paragraph 4(c) of the Policy provides that a Respondent may establish rights to or legitimate interests in the disputed domain name by demonstrating any of the following:

- i. before any notice to the Respondent, the Respondent's 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. the Respondent has been commonly known by the domain name, even if the Respondent has acquired no trademark or service mark rights; or,
- iii. the Respondent is 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.

Although a Complainant has the ultimate burden of proving all three elements of Paragraph 4(a) of the Policy, previous panels have consistently held that Paragraph 4(c) shifts the burden of proof to a Respondent once a Complainant has established a *prima facie* showing. *Document Technologies, Inc. v International Electronic Communications Inc.*, WIPO Case No. D2000-0270; *Inter Ikea System BV v Isaac Goldstein*, Hong Kong ADNDRC Case No. HK-000320 (2010); *Trendy International Investment Limited v Pri*, Beijing ADNDRC Case No: CN-1100433 (2011); and, *Seiko Epson Corp v Yao Fenglei*, Beijing ADNDRC Case No. 1000370 (2010). This Panel will follow established precedent.

Complainant has established, in its Exhibit 8, that as at 25 July 2011, the <ESWATCH.COM> web site contained links to other watch manufacturers as well as a link to a site enabling the purchase of the domain name <ESWATCH.COM>. Respondent's Exhibit 3, showing the <ESWATCH.COM> site to be "under construction" is undated. As

such, it is unclear to this Panel when, during Respondent's four-year registration of the disputed domain name, this evidence was obtained or produced and hence is of uncertain reliability. Consequently, the Complainant's evidence is preferred. As discussed above, Complainant has made a *prima facie* showing of infringement of its trademark.

It is thus for Respondent to meet the burden of establishing one or more of the criteria contained in Paragraph 4(c) of the Policy.

The first of these criteria concerns the use of, or demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services. Respondent does not appear to claim, nor has Respondent provided any evidence, that the disputed domain name is being used in connection with a *bona fide* offering of goods or services. Respondent has not produced evidence of any demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. Respondent's Exhibit 3 showing the web site of the disputed domain name to be "under construction" is insufficient.

The second of these criteria requires Respondent to have been commonly known by the domain name, even if Respondent has acquired no trademark or service mark rights. Respondent has produced no evidence that it has been commonly known by the domain name <SWATCH> or <ESWATCH> even though the latter has been registered by Respondent since June 2007.

The third and last of these criteria requires Respondent to prove 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. Respondent has failed to produce any evidence which can satisfy this criteria.

For the foregoing reasons, this Panel finds that Complainant has satisfied the second element of Paragraph 4(a) of the Policy, *i.e.*, Respondent has no rights or legitimate interests in the disputed domain name.

5.3 The domain name has been registered and used in bad faith.

Complainant in the present case has not authorized Respondent to use the <SWATCH> name or any derivations or permutations thereof in any way. Furthermore, Complainant is required to demonstrate that Respondent's actions amount to bad faith.

A Complainant is required to establish a Respondent's bad faith as set out under Paragraph 4(a)(iii) of the Policy. Additionally, Paragraph 4(b) of the Policy sets out circumstances, in particular but without limitation, which shall be considered as evidence of the registration and use of a domain name in bad faith:

- i. circumstances indicating that a Respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to a Complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of said Respondent's documented out-of-pocket costs directly related to the domain name; or

- ii. a Respondent has 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 said Respondent has engaged in a pattern of such conduct; or
- iii. a Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- iv. by using the domain name, a Respondent has intentionally attempted to attract, for commercial gain, Internet users to said Respondent's web site or other on-line location, by creating a likelihood of confusion with a Complainant's mark as to the source, sponsorship, affiliation, or endorsement of said Respondent's web site or location or of a product or service on said Respondent's web site or location.

The Panel in *Inter Ikea System BV v Isaac Goldstein*, Hong Kong ADNDRC Case No. HK-000320 (2010) noted that the foregoing examples of bad faith are not exhaustive. The principal purpose of the Policy is to "curb the abusive registration of domain names in circumstances where the registrant is seeking to profit from and exploit the trademark of another." (citing to *Telstra Corporation Limited v Nuclear Marshmallows*, WIPO Case No. D2000-003 and *Match.com, LP v Bill Zag and NWLAWS.ORG*, WIPO Case No. D2004-0230)

This Panel adopts the analysis used in the *Inter Ikea System BV v Isaac Goldstein* case:

... Respondent registered the Disputed Domain Name in bad faith because the Trademark is distinctively identifying the Complainant and the Respondent could not have failed to know of the Trademark before registering the Disputed Domain Name.

In the absence of any evidence provided by the Respondent legitimizing his use of the Disputed Domain Name, the Panel cannot conclude otherwise than by stating that the registration and use of the Disputed Domain Name was made in bad faith. See *Aventis Pharmaceuticals Products Inc. v. PBS Publishing LLC*, WIPO Case No. D2003-0122.

... Respondent registered the Disputed Domain Name and uses it for the purposes of monetary gain by providing links to sites which are unrelated to the ones of the Complainant or are in some cases even competing with the products of the Complainant. Such use of the Disputed Domain Name can only be explained by the intent of the Respondent to attract Internet traffic by capitalizing on the Complainant's Trademark. This type of use of the Disputed Domain Name constitutes sufficient evidence of the bad faith of the Respondent under paragraph 4(b)(iv) of the Policy. See *Rhino Entertainment Company v DomainSource.com, Inc.*, WIPO Case No. D2006-0968 and *Imperial Chemicals Industries PLC v RareNames*, WIPO Case No. D2006-0124

Complainant has developed the <SWATCH> brand into an internationally known brand, e.g., through extensive investment, advertising, sponsorship and other publicity. <SWATCH> has established name recognition or brand recognition. (Complainant's Exhibit 6) As a result, the consumer has come to recognize and associate the <SWATCH> trademark with Complainant. Complainant has produced proof that the <ESWATCH> site provides links to competitors such as Rolex, Tissot, Tag Heuer, Seiko, etc. (Complainant's Exhibit 8)

Respondent has not challenged Complainant's evidence as to the name recognition of Complainant's trademark. Respondent has provided evidence that its registration of

<ESWATCH> occurred prior to Complainant's international registration of the same but this evidence does not address the issue of Respondent's knowledge of the <SWATCH> brand name recognition or trademark. Respondent did not adduce evidence that it was unaware of the existence of Complainant or its products at the time of registration. Respondent has failed to prove its legitimate use of the <ESWATCH> web site. This Panel may and does conclude that the registration and use of the disputed domain name was made in bad faith. *Inter Ikea System BV v Isaac Goldstein*, Hong Kong ADNDRC Case No. HK-000320 (2010)

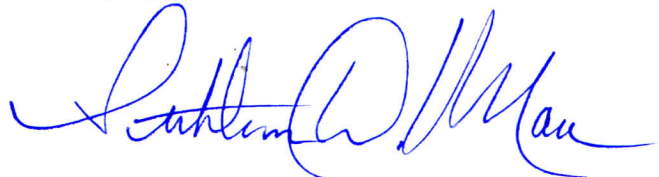
Additionally, this Panel notes that the disputed domain name is for sale as shown on the web site of <ESWATCH.COM> and that the web site contains no substantive content. (Complainant's Exhibit 8) Respondent challenges this allegation and offers as evidence a short exchange of e-mails on 1 September 2011 declining the sale of <ESWATCH.COM>. (Respondent's Exhibit 4) As this exchange of e-mails occurred after Complainant's Cease and Desist Letter of 26 July 2011 (Complainant's Exhibit 12), this Panel is inclined to dismiss Respondent's evidence as self-serving rather than coincidental. This is particularly so as Respondent's evidence (Respondent's Exhibit 3) did not indicate to the public that the dispute domain name was available for sale.

For the foregoing reasons, this Panel finds that Complainant has established bad faith pursuant to Paragraph 4(a)(iii) of the Policy.

6. Panel Decision

For the reasons set out in the foregoing paragraphs, this Panel is satisfied that Complainant has sufficiently proved the existence of all three elements of Paragraph 4(a) of the Policy. Accordingly, the Panel orders the transfer of the disputed domain name to Complainant.

Panelist:



Dated: 2 December 2011