

3.2 Pursuant to the Uniform Domain Name Resolution Policy (“ the Policy”) on 31.01.2012, ADNDRC HK requested the Registrar, Biz.com, Inc to confirm:

- (i) Whether it had received a copy of the Complaint;
- (ii) Whether the above domain name was registered by Bizcn.com, Inc;
- (ii) Whether the Respondent “Ryan Young” is the registrant of the disputed domain name;
- (iv) Whether the Policy is applicable to the current dispute;
- (v) The language of the Registration Agreement of the disputed domain name;
- (vi) The Whois information regarding the disputed domain name; and
- (vii) The status of the disputed domain name.

3.3 On 02.02.2012, the answer yes was given to questions (i), (ii), (iii) and (iv). As to (v), the language of the Registration Agreement was stated as Chinese. The Whois information are that the registrant contact is Ryan Young no.later@hotmail.com., the disputed domain name was registered on 19.10.2011 and the disputed domain name is to expire on 19.10 2012. Finally, the disputed domain name is placed on registrar-lock.

3.4 On 06.02.2012 ADNDRC HK acknowledged receipt of the Complaint and directed the authorized representative of the Complainant to provide a Chinese translation of the Complaint Form pursuant to paragraph 11 of the Rules for Uniform Domain Name Dispute Resolution Policy (“the Rules”).

3.5 On 11.02.2012, the authorized representative of the Complainant attached a supplemental submission to ADNDRC HK, setting out

therein the Complainant's arguments why the language of the proceedings should be in English.

- 3.6 On 15.02.2012, the Notice of Commencement of the Proceedings in both English and Chinese, the Complaint and the Annexures thereto were sent to the Respondent. The Respondent was further directed to file his Response to the Complaint on or before 06.03.2102 in accordance with the Rules and Supplemental Rules to ADNDRC HK and the Complainant.
- 3.7 On 07.03.2012, in the absence of any Response from the Respondent within the time specified, ADNDRC HK directed that the Case Administrator will appoint the sole panelist and that the proceedings was to continue in the absence of the Respondent.
- 3.8 The undersigned was appointed on 08.03.2012 as the sole panelists, the Claim and the Annexures were sent and the undersigned was directed to render a decision on or before 22.03.2012.
- 3.9 On 22.03.2012, upon an application and in accordance with Article 10.2 of the Supplemental Rules, the due date for the decision was extended to 29.03.2012.

4. Factual Background

The "ALEXANDER MCQUEEN" brand was founded by Lee Alexander McQueen in 1992 and it has become a respected fashion name. In December 2000, 51% of the brand was acquired by the Gucci Group. Its collections include women's ready-to-wear, men's ready-to-wear, accessories etc. In about 2004, the Complainant acquired the trademarks "ALEXANDER MCQUEEN". Alexander McQueen now operates various stores in New York, London, Milan, Las Vegas, Los Angeles and Japan, with its products available in Hong Kong and China.

The Complainant had the ALEXANDER MCQUEEN trademarks registered in various classes worldwide, including classes 3, 25, 18, 9 and 14 in China and classes 3, 9, 14, 18, 25 in Hong Kong. These classes cover apparel, shoes, handbags, glasses, jewellery and skin care products.

Alexander McQueen recognizes the importance of the Internet and operates an official website www.alexandermcqueen.com to tap into e-commerce and provide consumers with information on its latest products.

The Respondent registered the disputed domain name "alexandermcqueenonline.com" on 19.10.2011. It is alleged that the disputed domain name resolves to a website that offers Alexander McQueen products for sale and has the Alexander McQueen trademarks exhibited prominently on every page. The Complainant alleges that internet users attempting to access alexandermcqueenonline.com was redirected to the disputed domain name or another website www.girlshoez.com that carry luxury brand shoes, including Alexander McQueen shoes for sale.

5. Parties' Contentions

A. The Complainant

According to the Complainant:

- (i) the disputed domain name is confusingly similar to the Complainant's trademark "ALEXANDER MCQUEEN";
- (ii) the Respondent has no legitimate interests in respect of the disputed domain name as it has never been an authorized representative of Alexander McQueen, has never been licensed to use the "Alexander McQueen" trademark and has never been approved to resell Alexander McQueen products on web;
- (iii) the Complainant has reason to believe that the Respondent had not registered the disputed domain name in good faith to sell goods and services, as the disputed domain name resolves to infringing websites including girlshoez.com that purports to sell genuine Alexander McQueen products which the Complainant believes to be counterfeits.

B. The Respondent

The Respondent has not replied nor submitted his Response.

6. Discussion and Findings

6.1 Language of the Proceedings

It is necessary to first deal with the language of the proceedings. The Panel is cognizant that it has authority under paragraph 11 of the Rules to determine the language of the proceedings having regard to the circumstances. Paragraph 11(a) of the Rules stipulates that:

“Unless other wise agreed by the parties, or specified 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.”

Of course, the Panel is to exercise that discretion judiciously, and in all cases observe paragraph 10(b) of the Rules that the parties are to be treated with equality and are to be given a fair opportunity to present their cases.

In *Belersdorf AG v Good Deal Communications* (WIPO Case No. D2000-1759) it was said that the Respondent should normally receive notice of the proceedings in the language of the Registration Agreement so that it would not be prejudiced, for unless that is done *“Otherwise there is a risk that the Respondent may not appreciate the true nature of the proceeding and may be deprived of a fair opportunity to present its case”*.

In this case, the 15.02.2012 Notice of Commencement of the Proceedings was in both English and Chinese. The Respondent has had the opportunity to raise the issue of the language applicable to this administrative proceeding, but has chosen not to reply. In fact, the Respondent has not filed any Response. In the circumstance, the Panel concludes that the Respondent would not be prejudiced by the proceedings being conducted in English. This has the advantages of avoiding unnecessary translation and saving of costs. The Panel has come to this conclusion after reviewing the cases exhibited by the Claimant including *Lacoste Alligator S.A. v. Xinpeng Liu* (WIPO Case No. D2009-0629), *Finter Bank Zurich v. Shumin Peng* (WIPO Case No. D2006-0432), and others.

Further, as both the disputed domain name and the home and other pages of the websites to which it resolves are in the English language, it has been demonstrated, it is more likely than not, that the Respondent is proficient in English and capable of responding in English should it decides to do so.

Accordingly, the Panel agrees that the language of this proceeding shall be in English.

6.2 The disputed domain name is confusingly similar to the Complainant's mark

According to paragraph 4a of the Policy, the Complainant is to prove each of the following:

- (i) that the Respondent's domain name is identical or confusingly similar to the Complainant's trademark in which the Complainant has rights;
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.
- (iv) Evidence has been adduced that the trademark "ALEXANDER MCQUEEN" has been registered in China, Hong Kong and other jurisdictions.
- (v) Further, there is evidence that Alexander McQueen products have been advertised in Hong Kong and China from 2009 such as in Marie Claire, Cosmopolitan, Bazaar, City Magazine etc. and sold in Lane Crawford, Joyce Boutique and I.T. Hence, the Complainant has rights to the trademarks in that they have been registered, additionally common law rights to the name Alexander McQueen. At paragraph 6.12 of *Jeanette Winterson v. Mark Hogarth* (WIPO Case No. D2000-0235) the panelist there opined that "*para 4a of the Policy is not to be construed by reference to the criteria of registrability under English law [the Elvis Presley case] but more broadly in terms of the distinctive features of a person's activities. In other words, akin to the common law right to prevent unauthorized use of a name*". I agree. See also *Lucasfilm Ltd and Lucas Licensing Ltd v. Cupcake City and John Zuccarini* (WIPO Case No. D2001-0700).
- (vi) Having determined that the Complainant has rights in the mark "ALEXANDER MCQUEEN", the Panel is also satisfied that the disputed domain name is confusingly similar to the Complainant's mark for the reasons stated below.
- (vii) First, the Panel agrees that the adding of the alphabet "s" to alexandermcqueen" is insufficient to distinguish it from the Complainant's trademark. See *Foot Locker, Inc v. Blezin Widmaer* (National Arbitration Forum Case No. 113283) where the use of or

absence of punctuation marks does not alter the fact that a name is identical to a mark.

- (viii) Secondly, it has been held, and rightly so, that adding the word “*online*” is also insufficient to distinguish the main part of a disputed domain name from a registered trademark. I have been referred to similar instances where “*hermesonlinestore.com*” and “*debeeronline.com*” have been held to be confusingly similar. In *Microsoft Corporation v. J Holiday Co.* (WIPO Case No. D2000-1493), the panel observed that “*Generally, a user of a mark may not avoid likely confusion by appropriating another’s entire mark and adding descriptive or non-distinctive matter to it*”. So, the adding of descriptive matter such as “*shoesale*” to boss in HK-1100336 or “*handbagsale*” to longchamp in HK 1100369 have been held to be incapable of distinguishing.
- (ix) Thirdly, the generic high level suffix “.com” is non-distinctive and incapable of differentiating the disputed domain name from the Complainant’s registered mark. There are ample cases in this regard, including *Pomellato S.p.A. v. Richard Tonetti* (WIPO Case No. D 2000-0493).

Thus, the Panelist holds that the first condition, paragraph 4(a)(i) of the Policy has been met.

6.3 The Registrant has no right or legitimate interest in the disputed domain name

First, a justified inference from a non-response is lack of interest, which goes contrary with the lawfulness of one’s rights and ownership of the disputed domain name.

Secondly, the Respondent, a natural person, has never been known previously to be associated with the name Alexander McQueen in any capacity.

Thirdly, the absence of any response makes it impossible for this Panel to make any findings different from that stated in the Complaint. Whilst the Panel has the evidence as stated in the Complaint, none of the averments in the Complaint has been challenged by the Respondent. There is also no evidence to show that the Respondent is making a legitimate non-commercial or fair use of the disputed domain name.

In the circumstances, it is held that the second condition, paragraph 4(a)(ii) of the Policy has been met.

6.4 The Registrant registered and is using the disputed domain name in bad faith

Two limbs have to be proved: (i) registered in bad faith and (ii) use in bad faith. See *Telstra Corporation Limited v. Nuclear Marshmallows* (WIPO Case No. D 2000-0003)

Registered in Bad faith

It has long been held that registration of a well-known trademark by a party with no connection to the owner and no authorization reveals bad faith. See *Barney's Inc v. BNY Bulletin Board* (WIPO Case No. 2000-0059) and the *Caravan Club v. Mrgsale* (National Arbitration Forum Case No. 95314). Alexander McQueen is such a well-known trademark. Evidence was adduced that it was acquired in part by Gucci to the extent of 51% in December 2000.

Used in Bad Faith

Evidence was adduced that the disputed domain name resolves to infringing websites, including *Girlshoez.com* which offer counterfeit Alexander McQueen products. No doubt, the Respondent would have been aware of the fame of Alexander McQueen and its products, for it would not otherwise have registered the disputed domain name and offered similar, but counterfeit, products on web. Such intentional misuse is likely to confuse consumers and cannot amount to a bona fide offering of goods. See *Prada S.A. v. Domains for Life* (WIPO Case No. D 2004-1019) and *Madonna Ciccone p/k/a Modonna v. Dan Parisi and "Madonna.com"* (WIPO No. D 2000-0847). Additionally, such diversion of the business of the Complainant to obtain "unjustified benefits" cannot be said to constitute legitimate use of a domain name. See *Cheesecake Factory Inc. and the Cheesecake Factory Assets Co., LLC v. Say Cheesecake* (WIPO Case No. 2005-0766).

Further, the failure of the Respondent to reply to the Complaint at all supports the inference of bad faith. See *Bayerische Motoren Werke AG v. (This Domain is for Sale) Joshuathan Investments, Inc.* (WIPO Case No. D2002-0787) and *Inter-IKEA Systems B.V. v. Evezon Co Ltd.* (WIPO Case No. D2000-0437).

In the circumstances, it is held that the third condition, paragraph 4(a)(iii) of the Policy has been met.

7. Decision

Based on the above findings, the Panel finds that:

- (i) the disputed domain name is confusingly similar to the Complainant's trademark in which the Complainant has civil rights and interests;
- (ii) the Respondent has no right or legitimate interest in respect of the disputed domain name or major part of the domain name;
- (iii) the Respondent has registered the disputed domain name in bad faith.

Accordingly, pursuant to paragraph 4(i) of the Policy and paragraph 15 of the Rules, the Panel orders that the disputed domain name "alexandermcqueenonline.com" be transferred to the Complainant.

Dated 27 March 2012



Samuel WONG (Chat Chor)
Panelist