



## ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

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### Decision Submission

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Version  
 Decision ID DE-0900210  
 Case ID HK-0800216  
 Disputed Domain Name www.梦特娇.net  
 Case Administrator Dennis CAI  
 Submitted By Lulin Gao  
 Participated Panelist

Date of Decision 17-03-2009

Language Version : English

#### The Parties Information

**Claimant** (1) BONNETERIE CEVENOLE (2) MONTAGUT FAR EAST LTD.  
**Respondent** Foshan Shiwan Xinkedi Ceramic Co., Ltd

#### Procedural History

The Complainants of this case are BONNETERIE CEVENOLE with the address at 1001 Av. De Le Republique-07500 Guilherand Granges, France and MONTAGUT FAR EAST LTD. with the address at Units 02-05, 23A/F., K. Wah Centre 191 Java Road, North Point, Hong Kong. Their authorized representative is Derek Lau.

The Respondent of this case is Foshan Shiwan Xinkedi Ceramic Co., Ltd. with the address at Fenghuang Rd Shiwan Foshan City Foshan 528000, Guangdong, China.

The Disputed Domain Name is梦特娇.net. The Registrar of the Disputed Domain Name is Melbourne IT, Ltd.

A Complaint, made pursuant to the Uniform Domain Name Dispute Resolution Policy ( “Policy” ) implemented by the Internet Corporation for Assigned Names and Numbers ( “ICANN” ) on 24 October 1999, and under ICANN Rules for Policy and Asia Domain Name Dispute Resolution Center ( “ADNDRC” ) Supplemental Rules for Policy, was filed by the Complainants on 22 October 2008. Meanwhile, the Complainants request ADNDRC Hong Kong Office’ s assistance in urging the Registrar to furnish the information of the Respondent and the language of the registration agreement. On 30 October 2008, the ADNDRC Hong Kong Office requested the Registrar by email for the provision of information at their WHOIS database in respect of the Disputed Domain Name, and the registration information was provided by the Registrar on 8 December 2008. Having received the reply email from the Registrar, the Complainants revised the Complaint Form accordingly.

Having verified that the Complaint satisfied the formal requirements of the Policy, the ADNDRC Hong Kong Office issued to the Respondent on 31 January 2009, a Notification of the Commencement of the Proceedings to email address of the Respondent, advising the Respondent to submit a Response to the

Complaint within 20 days scheduled time (on or before 23 February 2009).

On 3 March 2009, the ADNDRC Hong Kong Office notified the Complainants that it had not received the Response from the Respondent within the required period of time and would shortly appoint Panelist(s) for this matter.

On 4 March 2009, the ADNDRC Hong Kong Office informed the parties by email that Dr. Lulin Gao would be the sole Panelist of this case and the Panel should render the Decision on or before 18 March 2009.

## Factual Background

### For Claimant

#### Background of Complainant

(1) The 1st Complainant is a company incorporated in France (see Attachment 1 for the company registration information) and commenced business in 1925. It has engaged in the business of designing, manufacturing, marketing, selling, and the wholesale and retail of a series of goods, including clothing, footwear, leather goods and handbags, in many countries worldwide (see Attachment 2 for the catalog of goods sold by the Complainant).

#### “MONTAGUT” Trademark of the Complainant

(2) The 1st Complainant is the registered proprietor of the registered trade marks “夢特嬌”，“梦特娇”，“MONTAGUT”，“flower device” and/or the combination thereof (“the Registered Trade Marks”) in France, the PRC, Hong Kong, and elsewhere. Please see Attachments 3 to 5 for evidence of the registration or application for registration of the Registered Trade Marks by the 1st Complainant in Hong Kong, the PRC, and France. For registration of the Registered Trade Marks in other countries, please see Attachment 6. The list is not exhaustive. Further information and evidence on registration in other countries can be provided if deemed necessary by the expert panel.

(3) The registered trade marks “夢特嬌” and “梦特娇” have been recognized by the Trademark Office under the State Administration for Industry and Commerce of the People’s Republic of China (“CTMO”) as well-known trademarks after a series of trademark opposition proceedings in year 2004, which held that the said registered trade marks meet the requirements of well-known trademarks as stipulated under Article 14 of the Trademark Law of the People’s Republic of China. Please see Attachment 7 for the publication of the well-known trademark status of the said registered trade marks in the CTMO Gazette.

(4) The 2nd Complainant is a company incorporated in 1971 in Hong Kong and is owned by the shareholders of the 1st Complainant (see Attachment 8 for the company registration information of the 2nd Complainant). It is the sole agent and representative of the 1st Complainant in the PRC, Hong Kong and Macau, and is the only company duly authorized by the 1st Complainant to manufacture, market and sell goods bearing the Registered Trade Marks and other trademarks of the 1st Complainant (see Attachment 9 for the certificate of sole agency appointing the 2nd Complainant as the 1st Complainant’s sole agent).

#### Use of the Registered Trade Marks by the Complainants

(5) The Complainants and their distributors and licensees have used the Registered Trade Marks extensively in their businesses and operations. The Registered Trade Marks have not only been used on their goods, but also on their publications and documents, such as packagings, advertisements, promotional materials, invoices and receipts. The Registered Trade Marks were used as early as 1960 in France, the 1980s in Hong Kong, and the mid-1980s in the PRC. Please see Attachment 10 for evidence of the use of the Registered Trade Marks.

(6) The Complainants have invested a huge amount of resources in the promoting the Registered Trade

Marks and their goods bearing the Registered Marks in the PRC, Hong Kong, and other countries and regions worldwide through various media, such as television, radio, newspapers and magazines, light-box advertising, outdoor advertising, and press releases, etc. The Complainants have spent not less than HK\$20,000,000.00 each year in their marketing and promotion campaign in Hong Kong and the PRC. Please see Attachment 11 for evidence of some of the advertisements of the Registered Trade Marks.

#### Registration of Domain Names Containing the Registered Trade Marks

(7) Since 2000, the 2nd Complainant has registered a series of “.hk” and “.cn” domain names, Chinese keywords (中國通用網址), and network real name (中國網絡實名), including, inter alia, “夢特嬌時裝.中国 / 梦特娇时装.中国”, “夢特嬌時裝.cn / 梦特娇时装.cn”, “夢特嬌.中国 / 梦特娇.中国”, “夢特嬌.cn / 梦特娇.cn”, “夢特嬌時裝 / 梦特娇时装”, and “夢特嬌服飾 / 梦特娇服饰”. Please see Attachment 12 for details of the above registrations, and Attachment 13 for a list of the registration of “.hk” and “.cn” domain names, and Chinese keywords and network real names. These domain names, keywords and network real names are all linked to the website of the 1st Complainant at [www.montagut.com](http://www.montagut.com) (see Attachment 14). The website has both traditional Chinese and simplified Chinese versions which facilitate promotion of the goods of the Complainants to the Internet users in the PRC.

(8) As mentioned in paragraph 3 above, the Registered Trade Marks of the Complainants are well-known. As such, there are numerous attempts to take advantage of the goodwill in the Registered Trade Marks. For example, the “montagut.cn” domain name was once registered by a third party under bad faith. Subsequently, the Complainants lodged a complaint under case no. DCN-0500025 with the Hong Kong International Arbitration Centre on 7 July 2005 against the then registrant of the “montagut.cn” domain name. The expert panel adjudicated on the transfer of the said domain name to the Complainants. Please see Attachment 15 for the decision of the case. In another instance, the “梦特娇.com” domain name was also registered by another third party under bad faith. The Complainants lodged a complaint under case no. HK-0800207 with the Hong Kong International Arbitration Centre (ADNDRC Hong Kong Office) on 25 September 2008 against the then registrant of the “梦特娇.com” domain name. The expert panel adjudicated on the transfer of the said domain name to the Complainants. Please see Attachment 15A for the decision of the case. It is obvious that the Registered Trade Marks are so well-known that domain names containing the word “夢特嬌” or “MONTAGUT” frequently become targets of bad faith registration. Therefore the Complainants have been actively monitoring and protecting domain names relating to their Registered Trade Marks.

(9) When the Complainants tried to apply for registration of the domain name “梦特娇.net” ( “Disputed Domain Name” ) earlier in order to link the Disputed Domain Name to their websites, they found that the Disputed Domain Name had already been registered. This prohibits the Complainants from applying for registration of and linking the Disputed Domain Name to their own websites.

#### Background of the Respondent

(10) According to the registration information of the Disputed Domain Name as provided by the Registrar, the address and the name (Foshan Shiwan Xinkedi Ceramic Co., Ltd) of the Respondent show that the Respondent is a ceramic company in Guangdong Province of the PRC (see Attachment 16 for the registration information of the Disputed Domain Name). In fact, the Respondent was sued by the 1st Complainant for trademark infringement in 2006 before Changsha Intermediate People’s Court of Hunan Province of the PRC, and judgment was delivered on 26 April 2006 whereby the Respondent was ordered to cease the infringing acts and the 1st Complainant was awarded statutory damages of RMB500,000. (see Attachment 17 for the judgment of the court).

#### Disputed Domain Name Registered by the Respondent

(11) The Respondent registered the Disputed Domain Name with ICANN through Melbourne IT Ltd.. The dominant part of the Disputed Domain Name is identical to “梦特娇” of the Registered Trade Marks owed by the Complainants. Further, the three Chinese characters “梦特娇” of the dominant part of the Disputed Domain Name are not the company name of the Respondent, nor are related to the Respondent in any manner.



Name.

The Respondent has registered and used the Disputed Domain Name in bad faith

(7) As mentioned in paragraphs 2 to 6 above, the “Montagut” / “夢特嬌” names have high reputation throughout the world including the PRC. The Complainants commenced business in the PRC in the mid-1980s, and have spent huge sum of money each year in promoting their products and brands. The Complainants have registered the Registered Trade Marks in the PRC, Hong Kong, Macau and many other countries and regions throughout the world, and their registered trade marks “夢特嬌” and “梦特娇” have been recognized by the CTMO as well-known trademarks in year 2004 in accordance with Article 14 of the Trademark Law of the People’s Republic of China. As an enterprise in the PRC, it is most unlikely that the Respondent is unaware of the name of the Complainants and their Registered Trade Marks. In fact, as mentioned in paragraph 10 above, the Respondent was sued by the 1st Complainant for trade mark infringement in 2006 and was ordered to cease the infringing acts. Yet it continues to maintain its registration of the Disputed Domain Name. This clearly shows that the Disputed Domain Name was registered in bad faith.

(8) The Disputed Domain Name is in no way related, either directly or indirectly, to the enterprise name of the Respondent. The Respondent’s motive in registering the Disputed Domain Name is very suspicious. The distinctive part of the Disputed Domain Name registered by the Respondent is identical to the company name of the 1st Complainant and the distinctive part of the Registered Trade Marks owed by the Complainants. Further, the Respondent registered the Disputed Domain Name without notifying the Complainants and without the prior consent or authorization of the Complainants.

(9) The “Montagut” / “夢特嬌” names have high reputation throughout the world including the PRC, and these names are the respective English and Chinese company names of the 2nd Complainant. The Registered Trade Marks are unique marks of high distinctiveness, and are not ordinary words. Therefore the use of the word “梦特娇” (the simplified Chinese version of the Chinese characters “夢特嬌”) by the Respondent as the sole or dominant part of the Disputed Domain Name is likely to cause confusion, and to mislead the public into associating the Respondent and/or the Disputed Domain Name with the Complainants, thereby causing damage to the Complainants.

(10) The Respondent has not used the Disputed Domain Name ever since registration. It is obvious that the registration of the Disputed Domain Name by the Respondent is not for legitimate commercial use.

(11) Such acts of the Respondent have prevented the Complainants from registering domain names related to their Registered Trade Marks. The registration of the Disputed Domain Name by the Respondent has hindered the Complainants from registering its own domain name in relation to their Registered Trade Marks, and has caused damage to the interests of the Complainants.

(12) Even if the Respondent intends to link the Disputed Domain Name to its website or other website, given the fact that the distinctive part of the Disputed Domain Name is identical to the “梦特娇” mark of the Complainants which was held to be a well-known trademark in the PRC, the Respondent will take advantage of the reputation of the Registered Trade Marks to attract visitors and to increase the hitting rate of their websites, and to mislead the Complainants’ consumers into believing that the goods listed on the Respondent’s websites are associated with the Complainants. Therefore, the registration and use of the Disputed Domain Name by the Respondent is of bad faith.

Cases in Support of the Arguments that the Registration by the Respondent is in Bad Faith

(13) Under paragraph 4(a)(iii) of the Uniform Domain Name Dispute Resolution Policy ( “Policy” ), the domain name must have been “registered” AND is being “used” in bad faith. The followings cases decided under the Policy support the arguments why the registration and the use of the Disputed Domain Name is both in bad faith.

(14) In Telstra Corporation Limited v. Nuclear Marshmallows (WIPO Case No. D2000-0003)(see

Attachment 19), it was held that even if the respondent is not undertaking a positive action in relation to the domain name in dispute, the acts of passive holding of the domain name, in certain circumstances, and after considering specific facts of individual case, could amount to the domain name being used in bad faith (see paragraphs 7.9 to 7.11 of the panel decision of Attachment 19). In the present case, the Respondent must be aware that the “梦特娇” part of the Disputed Domain Name is identical to the Registered Trade Marks of the Complainants. As mentioned in paragraph 9 and paragraphs 22 to 25 above, the Respondent has never used the Disputed Domain Name after registration, which prevents the Complainants from registering it, thereby causing damage to the Complainants. Therefore the Respondent has registered the Disputed Domain Name in bad faith.

(15) In *Wal-Mart Stores, Inc. v. Thomson Hayner d/b/a Wireless Revolution d/b/a Latin Technologies* (WIPO Case No. DAS2002-0001)(see Attachment 20), it was held that it is difficult to believe that the respondent was unaware of the fame of the complainant’s service mark, therefore the passive holding of the domain name by the respondent constitutes bad faith itself (see paragraphs 6C of the panel decision of Attachment 20).

(16) In *Mondich and American Vintage Wine Biscuits, Inc. v. Shane Brown d/b/a Big Daddy’s Antiques* (WIPO Case No. D2000-0004)(see Attachment 21), it was held that since the respondent has done nothing with the domain name for over two years, it is possible to infer from this failure of use that the domain name was registered without a bona fide intent to make good faith use (see paragraphs 4 to 8 of the panel decision of Attachment 20).

(17) In *Pharmacia & Upjoin AB v Dario H. Romero* (WIPO Case No. D2000-1273)(see Attachment 22), it was held that if it would be difficult to assume any use of the domain name of the respondent which would not amount to infringement of the complainant’s rights in its trademarks, the registration of the domain name itself would be considered as registration in bad faith (see paragraph 3 of page 7 of the panel decision of Attachment 22). In the present case, any use of the Disputed Domain Name by the Respondent would amount to infringement of the 1st Complainant’s rights in its well-known trademark. Therefore the registration of the Disputed Domain Name by the Respondent was made in bad faith.

(18) In *DuPont v. Beijing Cinet Information Systems Company Limited* (杜邦公司 v. 北京國網信息有限公司)(The No. 1 Intermediate People’s Court of Beijing Municipality of the PRC Civil Case YiZhongZhiChuZi No. 11 of 2002)(see Attachment 23), the court followed the decisions of WIPO Case No. D2000-1273. In this case, the court accepted that the “DU PONT” trademark of the complainant is a well-known trademark, and held that the use of the domain name “dupont.com.cn” by the respondent would mislead the public into believing that the registrant of the domain name is associated with the “DU PONT” trademark which will confuse the public. On the other hand, if the respondent does not use the domain name “dupont.com.cn” after registration, it eventually will prevent the complainant from using its well-known trademark in its domain name for conducting business activities on the Internet. The respondent is well aware that “DU PONT” is the enterprise name and trademark of others, therefore the court held that its registration of the domain name is in bad faith (see paragraph 3 of page 8 of the judgment of Attachment 23).

(19) As the “夢特嬌” name enjoys high reputation throughout the world including the PRC, and the “夢特嬌” mark and “梦特娇” mark have been recognized by the CTMO as well-known trademarks, it is most unlikely that the Respondent is unaware that “梦特娇” is a well-known trademark. On the other hand, the domain name “梦特娇.com” is in no way related to the Respondent. As such, the use of the Disputed Domain Name would amount to infringement of the 1st Complainant’s rights in its trademarks. Therefore, according to the principles decided in the above cases, even if the Respondent has not used the Disputed Domain Name, the registration itself is in bad faith.

#### Request of the Complainants

(20) Based on the above grounds, the Complainants humbly request that the expert panel adjudicates the case in favour of the Complainants and orders that the Disputed Domain Name be TRANSFERRED from the Respondent to the 2nd Complainant.





any other purposes. The Panel finds that the Complainants have already fulfilled the burden of proof required by the second condition under Paragraph 4(a) of the Policy, thus the burden of proof regarding “rights or legitimate interests” is generally on the party making the defense in the dispute resolution of a domain name, the Respondent.

The Respondent has not filed any response and failed to demonstrate it has any rights or legitimate interests in respect of the Disputed Domain Names. Based on the default and the evidence in the Complaint, it is presumed that the Respondent has no rights or legitimate interests in the Disputed Domain Names.

Further, in light of “夢特嬌”, being the trademark that has been registered and extensively used by the Complainants for a long term, instead of the generic word, the Respondent would not legitimately choose unless seeking to create an impression of an association with the Complainants, thus the Panel can fathom no possible legitimate connection or interest between the Respondent and the Disputed Domain Names.

Accordingly, the Panelist finds that the Complainant has satisfied the second condition under Paragraph 4(a) of the Policy.

### **Bad Faith**

The Complainants also need to establish the Respondent’s bad faith as set forth in the Paragraph 4(a)(iii) of the Policy. Under Paragraph 4(b) of the Policy, the following circumstances in particular shall be considered as evidence of the registration and use of a domain name in bad faith:

- (i) Circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) You have 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 you have engaged in a pattern of such conduct; or
- (iii) You have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) By using the domain name, you have intentionally attempted to attract, for commercial gain, internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

First of all, the evidence submitted by the Complainants shows that the Complainants’ trademarks have achieved a high reputation around the world through a long history of use and widespread promotional activities, and “夢特嬌” and “MONTAGUT” have been recognized by the Chinese Authority for Trademark as well-known trademarks. Given this, the Panel finds it difficult to accept that the Respondent registered the Disputed Domain Name without knowledge of the existence of the Complainants and their trademarks. What’s more, considering that the Complainants’ trademark is inherently distinctive and that the Respondent has never had any rights or legitimate interests in the said trademark, the Panel holds that it could not be a mere coincidence but a malice that the Respondent registered a domain name that is identical or confusingly similar to the Complainants’ trademark.

Second, as demonstrated above, the Respondent should be aware of the Complainants and their trademarks, while the Respondent has registered the Disputed Domain Name that consists of the Complainants’ trademark only, thereby inevitably preventing the Complainants from reflecting its trademark in such corresponding domain name.

Third, the Complainants claim that the Respondent has not used the Disputed Domain Name ever since registration, and according to the evidence submitted by the Complainants, the panel finds that the web page shows nothing on display at the Dispute Domain Name. With respect to this point, referring to many similar WIPO cases, the Panel holds that bad faith conditions may not be limited to the above four conditions according to the Policy, and in certain circumstances, it is possible for passive holding by the Respondent to



amount to the domain name being used in bad faith. Considering the Complainants' trademarks are widely known as evidenced by its substantial use and promotion, and have been recognized by the Chinese Authority for Trademark as well-known trademarks, while the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the domain name, the panel may infer that the Respondent has no real intension of active use of the Disputed Domain Name, and such acts of the Respondent have constituted the passive holding of the Disputed Domain Name, which amounts to the domain name being used in bad faith.

In light of all of the above circumstances, the Panel concludes that the Complainants have met the third condition under Paragraph 4(a) of the Policy.

### **Status**

www.梦特娇.net                      Domain Name Transfer

### **Decision**

For all the forgoing reasons, the Panel has decided that the Complainants have proved sufficiently the three elements of Paragraph 4(a) of the Policy. Accordingly, the Panel directs that the Disputed Domain Name be transferred to the 2nd Complainant.

Panelist: Gao Lulin  
Dated: 17 March 2009