



Asian Domain Name Dispute Resolution Centre

(Hong Kong Office)

**ADMINISTRATIVE PANEL DECISION**

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<b>Case No.</b>	<b>HK-1500806</b>
<b>Complainant:</b>	<b>Pandora A/S</b>
<b>Respondent:</b>	<b>Xavier Besset (阿兜)</b>
<b>Disputed Domain Name(s):</b>	<b>&lt;pandora-bijoux.net&gt;</b>

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**1. The Parties and Contested Domain Name**

The Complainant is Pandora A/S, of Hovedvejen 2, DK-2600 Glostrup, Denmark. The Complainant's Authorized Representative in these administrative proceedings is Alan Chiu, Partner, Messrs. Hogan Lovells, whose address is 11/F., One Pacific Place, 88 Queensway, Hong Kong SAR, P.R. China.

The Respondent is Xavier Besset (阿兜), whose registered address is 858 Rue Saint Guillaume, Paris, Taiwan, 9240 China.

The domain name at issue is <pandora-bijoux.net>, registered by Respondent with Xinnet Technology Corporation, of Level 3, Block A2, Sino-I Campus No. I, Disheng West Street, Beijing Economic and Technological Development Zone, Beijing 100076, P.R. China.

**2. Procedural History**

On 22 October 2015, the Complainant submitted a Complaint to the Hong Kong Office of the Asian Domain Name Dispute Resolution Center ("ADNDRC"), pursuant to the Uniform Domain Name Dispute Resolution Policy ("Policy") adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN") on 24 October 1999. On that same day, the ADNDRC confirmed receipt of the Complaint. The Complainant elected that this case to be dealt with by a one-person panel.

On 23 October 2015, the ADNDRC transmitted by email to the Registrar, Xinnet Technology Corporation, a request for registrar verification in connection with the disputed domain name. On the same day, the Registrar transmitted by email to the ADNDRC its verification response in Chinese, confirming that the Respondent is listed as the Registrant and that the language of the registration agreement is the Chinese language.

On 9 November 2015, the ADNDRC advised the Complainant by email that, given that the language of the registration agreement is Chinese, therefore, pursuant to paragraph 11 of the Rules, the language of the proceedings would ordinarily be Chinese. The ADNDRC

requested that the Complainant submit its Complaint in the language of the registration agreement on or before 14 November 2015 or, alternatively, that the Complainant provide reasons why English should be used as the language of the administrative proceeding by that date.

On 12 November 2015, the Complainant submitted a request, in Chinese as well as English, that English be used as the language of the administrative proceeding for the following reasons:

**The Respondent has the ability to understand English**

Though the registration agreement is in Chinese, the Respondent, Xavier Besset, does not appear to be someone from Mainland China, judging from the registrant name and address. The Respondent also provided an invalid address of 858 Rue Saint Guillaume, Paris, Taiwan, 9240 China, so it is unclear where the Respondent is from. The content of the website connected to the disputed domain name is predominantly in French with parts of it in English. For example, the Respondent's website, as captured on page 11 of Annex 7 of the Complaint, uses the descriptions "sweetheart complete", "five stars", "silver charms", and "eternally complete" on the bracelets which is clearly in English and not in French. This shows that the Respondent has a working knowledge of the English and French languages and would have no difficulties in communicating in English.

**Translation would incur expense and delay filing**

The Complainant is a company headquartered in Denmark and is unable to communicate in Chinese. All the materials such as the Complainant's trade mark records, annual report, cease & desist letter, etc. provided to us and communications between us and the Complainant are in English. Therefore, to require all documents to be submitted in Chinese would incur substantial expenses and cause undue delay in the filing of the proceedings.

Furthermore, we submit that English is the most widely spoken language in the world and having the proceedings administered in English would make the proceedings easy for both of the parties. We respectfully refer you to the case *Dolce & Gabbana S.r.l. v Qing Liao* D2013-1761 (WIPO December 18 2013), where the complainant, Dolce & Gabbana S.r.l., a company incorporated in Italy, filed a complaint against Qing Liao, a Chinese national, regarding the domain name <dolcegabbanafrance.net>. The registration agreement was in Chinese, however the panel took into consideration reasons including that (a) the disputed domain name includes the Latin characters "dolcegabbana" and the English word "france" rather than Chinese script; (b) the website at the disputed domain name is a mainly English or French based website and contains some English words, such as "promotions", "sale", "leather handbag"; and (c) English is the most widely spoken international auxiliary language which is widely-known all over the world, and a language that makes the proceeding easy for both of the parties, and thus determined that the choice of English as the language of the proceeding is fair to both parties.

On 23 November 2015, the ADNDRC transmitted a Written Notice of Complaint, written in both Chinese and in English, forwarding the Complaint along with annexures to the Respondent, requesting that the Respondent submit a Response within 20 calendar days. The Notice specified the due date for the Response as being on or before 13 December 2015. By separate email on 23 November 2015, written in both Chinese and English, the ADNDRC notified Respondent of Complainant's request that English be used as the language of these proceedings and invited Respondent's comments in relation to the request.

Thereafter, on 15 December 2015, the ADNDRC confirmed in an email to the parties that it had not received a Response from the Respondent within the required period of time.

Having received a Declaration of Impartiality and Independence and a Statement of Acceptance, the ADNDRC notified the parties that the panel in this case had been selected, with Mr. David KREIDER acting as the sole panelist. The Panel determines that the appointment was made in accordance with Rules 6 and Articles 8 and 9 of the Supplemental Rules.

On 15 December 2015, the Panel received the file from the ADNDRC and should render the Decision on or before 29 December 2015, if there are no exceptional circumstances.

In view of the Respondent's default and failure to submit timely a response to the Complaint or an objection to the Complainant's request, the panel, having discretion in the matter, agrees to the Complainant's request that English be used as the language of these administrative proceedings.

### **3. Factual background**

PANDORA designs, manufactures and markets hand-finished and modern jewelry made from genuine metals at affordable prices. Much of the company's success stems from their corporate structure. PANDORA operates and manages a vertically integrated business model from in-house design and manufacturing to global marketing and direct distribution in most markets. PANDORA employs more than 12,400 people worldwide of whom approximately 8,600 are located in Gemopolis, Thailand. PANDORA is publicly listed on the NASDAQ Copenhagen stock exchange in Denmark. In 2014, PANDORA's total revenue was DKK 11.9 billion (Approximately EUR 1.6 billion).

In 2000 PANDORA launched the extremely popular charm bracelet concept in the Danish market. Women everywhere quickly embraced the concept of affordable, personalized luxury and, in 2003, PANDORA introduced its jewelry to the United States and Canada, followed by Germany and Australia in 2004. Since then PANDORA has grown rapidly to become a truly international company.

PANDORA's products are sold in more than 90 countries on six continents through approximately 9,600 points of sale including approximately 1,400 concept stores. The North American market is PANDORA's largest, with the line currently sold in more than 2,200 fine jewelry and gift stores. PANDORA's line includes the ever-popular charm bracelets along with rings, necklaces and customizable earrings. In 2005 PANDORA opened a large scale, six-story, fully owned manufacturing facility in Thailand. In 2008, a

second manufacturing facility was opened in the same area, followed by the third and fourth facility in 2010, further strengthening the unique production setup.

PANDORA is a recognizable and global brand. This tremendous brand recognition has helped PANDORA establish a strong Internet presence through its websites, specifically in the United States. According to Alexa.com PANDORA's primary website, <www.pandora.net> is ranked 6,468 in the United States, with a global rank of 7,768. According to Compete.com, the website <www.pandora.net> received over 286,000 unique visitors in June 2015.

PANDORA A/S, (along with its subsidiaries), is the owner of "PANDORA" trademark registrations across various jurisdictions, including registrations in the People's Republic of China, the earliest of which was effective as of 17 September 2012.

#### 4. Parties' Contentions

##### A. Complainant

The Complainant's contentions may be summarized as follows:

**The disputed domain name(s) is/are identical or confusingly similar to a trademark or service mark in which the Complainant has rights:**

By virtue of its trademark and service mark registrations, the Complainant is the true owner of the Complainant's Marks, see *United Way of America v. Alex Zingaus*, FA 1036202 (NAF Aug 30 2007) ("Panels have long recognized Complainant's registration of a mark with a trademark authority is sufficient to confer rights in the mark pursuant to paragraph 4(a)(i) of the Policy".) Furthermore, a complainant is not required to register its marks within the country of the respondent in order to protect its rights in those marks, see the *Renaissance Hotel Holdings, Inc. v Renaissance Cochin*, FA 932344 (NAF April 23 2007) (finding that it does not matter whether the complainant has registered its trademark in the country in which the respondent resides, only that it can establish rights in some jurisdictions).

When comparing the Disputed Domain Name with the Complainant's Marks, the relevant comparison to be made is between only the second-level portion of the Disputed Domain Name and the Complainant's Marks, see the *Rollerblade, Inc. v McCrady*, 02000-0429 (WIPO June 28, 2000) finding that the top-level domain, such as ".net" or ".com", does not affect the domain name for the purpose of determining whether it is identical or confusingly similar.

The Disputed Domain Name can be considered as capturing, in its entirety, the Complainant's PANDORA trademark and simply adding the French generic term "bijoux" (which means "jewelry") to the end of the trademark does not negate the confusing similarity between the Disputed Domain Name and the Complainant's Mark under paragraph 4(a)(i) of the Policy, and the Disputed Domain Name must be considered confusingly similar to the Complainant's Mark. It is well established that the addition of generic or descriptive terms is not sufficient to overcome a finding of confusing similarity, see *The Royal Bank of Scotland Group plc v Domain Admin c/o InTrust Domain Names*, FA 1347010 (NAF Nov 1, 2010) ("the disputed domain name incorporates all of complainant's RBS mark while adding the generic term "credit" and the generic top-level

domain ".com". The addition of a generic term and gTLD fails to distinguish respondent's domain name from complainant's mark"). The addition of a generic term and gTLD fail to distinguish respondent's domain name from complainant's mark"). See also *Homer TLC, Inc. v Whois Guard*, FA 0619597 (NAF Feb. 14, 2006) (finding that the addition of common words to complainant's registered mark did not negate the confusing similarity).

Additionally, the Respondent's use of the Disputed Domain Name contributes to the confusion. The Respondent uses the Disputed Domain Name to redirect Internet users to the websites <pandorabijouxfra.com> and <fr-pandora.org>, both of which give the impression of being associated with the Complainant by displaying the Complainant's PANDORA trademark and logo prominently on their websites. Additionally, the redirected websites are visually similar to the Complainant's official website and the Respondent is using the said websites to sell, what appears to be, the Complainant's jewelry products when in fact they are counterfeit goods. Such use suggests that the Respondent intended the Disputed Domain Name to be confusingly similar to the Complainant's Marks as a means of furthering consumer confusion and as part and parcel of the Respondent's counterfeiting scheme. In a previous case involving a respondent's domain name that sought to imitate the complainant's website, a panelist found that such use was evidence that the domain name was confusingly similar to the mark in questions. See *The Gaming Board for Great Britain v Gaming Board*, D2004-0739 (WIPO Oct 18, 2004) "the way in which the Respondent has used the domain name [<gbgamingboard.org>] suggests that the Respondent intended users of the Respondent's website to believe that the website at the disputed domain name was associated with the Complainant".

The Complainant accordingly submits that it has proved that the Disputed Domain Name is confusingly similar to the registered trademarks in which the Complainants has rights or interests for the purpose of Paragraph 4(a)(i) of the Policy.

**The Respondent has no rights or legitimate interests in respect of the domain name(s):**

The granting of registrations by the Office for Harmonization in the Internal Market (OHIM), United States Patent & Trademark Office (USPTO) and the Trademark Office of the State Administration for Industry & Commerce of the People's Republic of China to the Complainant for the PANDORA trademark is prima facie evidence of the validity of the term "PANDORA" as a trademark, or the Complainant's ownership of this trademark, and of the Complainant's exclusive right to use the PANDORA trademark in commerce on or in connection with the goods and/or services specified in the registration certificates.

The Respondent is not sponsored by or affiliated with the Complainant in any way.

The Complainant has not given the Respondent permission to use the Complainant's Marks in any manner, including in domain names.

The Respondent is not commonly known by the Disputed Domain Name, which evinces a lack of rights or legitimate interests. Where "the WHOIS information suggests that the Respondent is known as an entity other than the trademark associated with the Complainant, and the Complainant has not licensed, authorized, or permitted the Respondent to register domain names incorporating the Complainant's ...mark," a Panel

should find that the Respondent is not commonly known by the Disputed Domain Name. See *United Way of America v Alex Zingaus*, FA 1036202 (NAF Aug. 30, 2007).

The Respondent is not using the Disputed Domain Name for a bona fide offering, or for a legitimate noncommercial or fair use. Instead, the Respondent uses the Disputed Domain Name to redirect Internet users to the commercial websites <pandorabijouxfra.com> and <fr-pandora.org> which prominently displays the Complainant's PANDORA trademark and logo and offers counterfeited versions of the Complainant's products. Past Panels have concluded that a respondent's efforts to sell counterfeit product under the guise of a complainant's brand, trademarks, and/or logos amounts to neither a bona fide offering of goods or services pursuant to paragraph 4(c)(i) of the Policy, nor a legitimate noncommercial or fair use pursuant to paragraph 4(c)(iii) of the Policy. See *eluxury.com Inc. v WangJunJie*, FA 1075554 (NAF Nov. 30, 2007) concluding that the sale of counterfeit products is evidence that the respondent does not make a bona fide offering of goods or services or a legitimate noncommercial or fair use of a disputed domain name. See also *F. Hoffmann-la Roche AG v Fred*, D2006-0246 (WIPO May 28, 2006) "the respondent's use of the domain name in order to redirect Internet users to a website devoted to sale of complainant's TAMIFLU products and various other pharmaceuticals and thus capitalize on complainant's mark is not a bona fide use pursuant to paragraph 4(c)(i) of the Policy".

Further, the redirected websites at the Disputed Domain Name clearly attempted to imitate as the Complainant's official France website. Such attempt to pass itself off as the Complainant is further evidence that the Respondent lacks right and legitimate interests under Policy 4(a)(i) in the Dispute Domain Name. See *FatWallet, Inc. v. www.fatyourwallet.com a/k/a Fat YourWallet*, FA 1296996 (NAF Jan. 27, 2010), ("respondent's attempt to pass itself off as the complainant is further evidence that respondent lacks rights and legitimate interests under Policy 4(a)(i) in the disputed domain name").

The Respondent registered the Disputed Domain Name on 10 January 2015, which is significantly after the Complainant's registration of <pandoragroup.com> on 18 June 2004 or the date they took ownership of <pandora.net> in January 2010.

The Complainant accordingly submits that it has proven that the Respondent has no rights or legitimate interests in respect of the Dispute Domain Name for the purposes of paragraph 4(a)(ii) of the Policy.

**The disputed domain name(s) has/have been registered and is/are being used in bad faith:**

The Complainant and its PANDORA trademark are known internationally, with trademark registrations across numerous countries. The Complainant has marketed and sold its goods and services under this trademark since May 2008, which is well before the Respondent's registration of the Disputed Domain Name on 10 January 2015.

By registering a domain name that captures, in its entirety, Complainant's famous PANDORA trademark while adding the generic term "bijoux" (meaning "jewelry" - the core product of the Complainant) to the end of the trademark, the Respondent has created a domain name that is confusingly similar to the Complainant's Mark, as well as its <pandora.net> domain. As such, the Respondent has demonstrated a knowledge of and

familiarity with the Complainant's brand and business. In addition, the websites displayed at the Disputed Domain Name seeks to pass themselves off as the Complainant by prominently displaying the Complainant's PANDORA trademark and logo, while offering for sale counterfeit versions of the Complainant's products. In light of the facts set forth within this Complaint, it is "not possible to conceive of a plausible situation in which the Respondent would have been unaware of" the Complainant's brands at the time the Disputed Domain Name was registered. See *Telstra Corp Ltd. v Nuclear Marshmallows*, D2000-0003 (WIPO) Feb 18, 2000).

ICANN policy dictates that bad faith can be established by evidence that demonstrates that "by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] website..., 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 [Respondent's] website or location", see paragraph 4(b)(iv) of the Policy. Here, the Respondent creates a likelihood of confusion with the Complainant and its trademarks by using a confusingly similar domain name to host a website which redirects Internet users to other websites that prominently displays the Complainant's PANDORA trademark and logo, and attempts to profit from such confusion by offering for sale counterfeit version of the Complainant's products. As such, the Respondent is attempting to cause consumer confusion in a nefarious attempt to profit from such confusion. The impression given by the Disputed Domain Name and the redirected websites would cause consumers to believe that the Respondent is somehow associated with the Complainant when, in fact, it is not. The Respondent's actions create a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the Disputed Domain Name, and the Respondent is thus using the fame of the Complainant's Marks to improperly increase the traffic to the website listed at the Disputed Domain Name for the Respondent's own commercial gain. It is well established that such conduct constitutes bad faith. See *World Wrestling Fed'n Entm't, Inc. v Ringside Collectibles*, D2000-1306 (WIPO Jan 24, 2001) concluding that the respondent registered and used the <wwfaction.com> domain name in bad faith because the name resolved to a commercial website that the complainant's customers were likely to confuse with the source of the complainant's products, especially because of the respondent's prominent use of the complainant's logo on the site.

The Respondent's use of the Disputed Domain Name constitutes a disruption of the Complainant's business and qualifies as bad faith registration and use under paragraph 4(b)(iii) of the Policy because the Respondent's domain name is confusingly similar to the Complainant's Marks and the website at the Disputed Domain Name is being used to offer counterfeit goods. Past Panels have confirmed that such use is evidence of bad faith registration and use. See *Louis Vuitton Malletier S.A., L.L.C. v David*, FA 1138296 (NAF Mar 5, 2008) concluding that the complainant's business is disrupted by the respondent's registration and use of the disputed domain name for the purpose of selling counterfeit products.

Furthermore, the Disputed Domain Name can only be taken as intending to cause confusion among internet users as to the source of the Disputed Domain Name, and thus, the Disputed Domain Name must be considered as having been registered and used in bad faith pursuant to paragraph 4(b)(iv) of the Policy, with no good faith use possible. More specifically, where the Disputed Domain Name captures the Complainant's PANDORA trademark in its entirety while simply adding the generic term "bijoux" to the end of the trademark and is being used to redirect to imitated websites which mimics the

Complainant's PANDORA trademark and logo while offering for sale counterfeit versions of the Complainant's products, there is no plausible good faith reason or logic for the Respondent to have registered the Disputed Domain Name, and "...the only feasible explanation for the respondent's registration of the disputed domain name is that the respondent intends to cause confusion, mistake and deception by means of the disputed domain name. Accordingly, any use of the disputed domain name for an actual website could only be in bad faith", see *Vevo LLC v Ming Tuff*, FA 1440981 (NAF May 29, 2012).

Finally, the Complainant, through REACT, complained to the Respondent and the Respondent's Internet Service Provider (ISP) about the Disputed Domain Name by an email dated 16 September 2015. This indicates the Respondent was at least aware of a source of objection to his domain name and his failure to respond is evidence of bad faith registration and use. See *Mars, Inc. v Vanilla, Ltd.* D2000-0586 (WIPO Sept 1, 2000), "one expects that a good faith registrant would provide some reply to reasonable inquiries".

The Complainant accordingly submits that it has proven that the Respondent has registered and is using the Dispute Domain Name in bad faith for the purposes of paragraph 4(a)(iii) of the Policy.

#### B. Respondent

The Respondent's contentions may be summarized as follows:

The Respondent, Xavier Besset (阿兜), has defaulted and failed timely to submit a response to the Complaint.

### 5. Findings

The ICANN Uniform Domain Name Dispute Resolution 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

The Complaint asserts that the Disputed Domain Name can be considered as capturing, in its entirety, the Complainant's PANDORA trademark. Simply adding the French generic term "bijoux" (which means "jewelry") to the end of the trademark, does not negate the confusing similarity. Moreover, the Complainant maintains a physical presence in France and also operates a French language version of its website for selling its jewelry. Finally, visitors to the Disputed Domain Name are redirected to websites that are visually similar to the Complainant's official website through which the Respondent sells counterfeit jewelry products that are similar in appearance to the Complainant's jewelry products. The Panel has no difficulty finding that the requirement of paragraph 4(a)(i) of the Policy is satisfied under these facts.



## **B) Rights and Legitimate Interests**

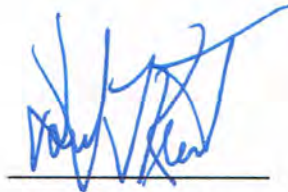
The Respondent is not using the Disputed Domain Name for any bona fide commercial offering, or for a legitimate noncommercial or fair use. Rather, the Respondent uses the Disputed Domain Name to redirect Internet users to the commercial websites <pandorabijouxfra.com> and <fr-pandora.org>, which prominently display the Complainant's PANDORA trademark and logo and offers counterfeited versions of the Complainant's products. Respondent's attempts to pass itself off as Complainant, or an affiliate of Complainant, evidences Respondent's lack of any right or legitimate interest in respect of the domain name. The second element of the Policy has been established.

## **C) Bad Faith**

The Panel finds that Respondent registered and is using the Disputed Domain Name in bad faith to intentionally mislead public Internet users for its own commercial gain.

## **6. Decision**

It is ORDERED that the <pandora-bijoux.net> domain name be TRANSFERRED to the Complainant.



David L. Kreider  
Panelist

Dated: 18 December 2015