



Asian Domain Name Dispute Resolution Centre

hongkong

(Hong Kong Office)

### ADMINISTRATIVE PANEL DECISION

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<b>Case No.</b>	HK-2101433
<b>Complainant:</b>	Gemological Institute of America, Inc.
<b>Respondent:</b>	Generations Jewelry Co. Ltd
<b>Disputed Domain Name(s):</b>	<gia520.com>

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

1. The Complainant is Gemological Institute of America, Inc., of 5345 Armada Drive, Carlsbad, California USA.
2. The Respondent is Generations Jewelry Co, Ltd of Taipei City, Taiwan, ROC.
3. The domain name at issue is <gia520.com>, registered by WEBCC of 410 North Bridge Road, Singapore, 188726.

#### 2. Procedural History

4. The Complainant filed this complaint with the Asian Domain Name Dispute Resolution Centre (ADNDRC) (Hong Kong Office) on 09 March, 2021.
5. A copy of the Complaint was sent to the Respondent on 12 March 2021.
6. The Respondent failed to respond within 20 calendar days as required under paragraph 5 of the UDRP Rules and on 02 April 2021 was held as being in default.
7. On 04 April 2021, after confirming that he was able to act independently and impartially between the parties, the ADNDRC appointed David Allison as the sole Panelist in this matter.

#### 3. Factual background

8. The Complainant is a worldwide famous non-profit institution dedicated to research and education in the field of gemology and jewelry arts. It is not only a training institution, but also the most authoritative and widely followed institution on jewelry appraisal. It has developed the International Diamond Grading System and the Four Cs (cut, clarity, color, and carat weight) as a standard to compare and evaluate the quality

of diamonds. “GIA”, as the trade name and house trademark of the Complainant, has been used for decades. It has acquired a high fame with regard to gem, diamond, gemology and other relevant goods and services worldwide.

9. The Complainant has filed and registered an extensive range of trademarks for the “GIA” trademark worldwide. A sample of the Complainant’s registered marks includes:

	<b>Jurisdiction</b>	<b>Trademark</b>	<b>Registration Date</b>	<b>Goods/Services</b>
1)	USA	GIA	June 4, 2002	Class 14: Jewelry, pearls, etc.
2)		GIA	July 25, 2000	Class 42: Gemological services, namely grading precious gems and registering precious gems.
3)	Canada	GIA	May 1, 2002	Class 42: Gemological services, namely grading precious gems and registering precious gems.
4)	EU	GIA	June 13, 2000	Class 42: Gemological services, namely grading precious gems and registering precious gems.
5)	Singapore	GIA	April 25, 2000	Class 42: Gemological services, namely grading, identification, inscribing, analysis of, reporting on, and registering gems, pearls and jewelry.
6)	Taiwan	GIA	September 1, 2000	Class 42: Gemological services, namely grading precious gems and registering precious gems.
7)	Hong Kong	GIA	April 17, 2001	Class 42: Gemological services, namely grading of precious gems. Class 45: Registration services relating to precious gems.
8)	Mainland China	GIA	May 6, 1999	Class 42: Gemological services, namely grading precious gems and registering precious gems.

10. Of particular relevance to this matter, is the Complainant’s registration of the GIA mark in Taiwan from 01 September 2000, some 10 years prior to the Respondent filing for the disputed domain name.
11. The Complainant also owns the top-level domain name <gia.edu> which was first registered on 30 March 1996.
12. The Respondent failed to file a Response within the deadline. Accordingly, little is known about the Respondent besides the fact that the disputed domain name was registered on 04 May 2010, the website to which the disputed domain name resolves is apparently concerned with the sale and grading of diamonds, and that the Respondent has been unsuccessful in several attempts to register “GIA” related trademarks with the Taiwan Trademark Registry due to the obvious similarity with the Complainant’s registered and well-known GIA marks.

#### **4. Parties’ Contentions**

13. Complainant:

The Complainant's contentions may be summarized as follows:

- i. The disputed domain name is confusingly similar to the trademarks GIA owned by the Complainant.
- ii. The Respondent has registered and used the disputed domain name in bad faith, most clearly illustrated by its reference to the Complainant's marks and business on its website which are designed to suggest to consumers some form of association or authorization from the Complainant where none exists.

14. Respondent:

The Respondent did not file a submission within the deadline.

## **5. Findings**

15. 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**

16. The Complainant has adduced sufficient evidence to demonstrate that it has clear trademark rights to the mark "GIA" in a number of jurisdictions, including Mainland China in 1999 and the USA in 2000. Importantly, the Complainant has proved that it has registered rights over the GIA mark in Taiwan, (which is also the respondent's home territory) from 01 September 2000. The Complainant has also provided abundant relevant evidence, including decisions from the relevant Trademark Registries, to demonstrate that the GIA mark is either well-known or that it has a relatively high reputation among the relevant public. As such, the Panel finds that the Complainant has sufficient rights and interests in the GIA mark.

17. When comparing the Complainant's marks and the disputed domain name, it is clear that they are confusingly similar. The '520' element after the "GIA" element would be ignored by consumers and does not constitute a distinctive element. Consumers seeing the "520" would likely conclude that it is merely a sub-domain or related domain of the main "GIA" domain name. Accordingly, when the distinctive element of the Disputed Domain name (ie GIA) is compared with the Complainant's trademarks, it is obvious that they are confusingly similar.

18. Accordingly, the Panel has no hesitation in holding that the Complainant's mark and the disputed domain name are confusingly similar. Thus, the first element is satisfied.

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


19. The Complainant argues that the Respondent has no rights or legitimate interests in the disputed domain name.
20. The disputed domain name resolves to a website which shows a variety of diamond products. It also uses the wording “Diamond Grading (sic) Certificate” on its homepage, suggesting that the website has something to do with diamond grading and certification – ie the exact business of the Complainant.
21. The term GIA is not used anywhere throughout the disputed website, or to refer to any legitimate use or business. The only use of GIA on the disputed website is a reference to the Complainant and the Complainant’s business, apparently in an attempt to demonstrate a connection or authorization between the Respondent and the Complainant where no such connection exists.
22. As the Respondent has not responded to the Complaint and based only on the website, it appears that there is no legitimate reason for the respondent to use the “GIA” element in relation to its business. Therefore, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name and thus, the second element is satisfied.

## **C) Bad Faith**

23. To establish the third element, the Complainant must establish that the Respondent both registered and used the disputed domain name in bad faith. In this case, and as discussed above, the use of the disputed domain name by the Respondent is likely to confuse consumers as to the actual owner of the “GIA” mark and is also likely to disrupt the Complainant’s legitimate business. Upon review of all of the evidence, it appears to the Panel that this was the intention of the respondent in registering the disputed domain name and this in itself is sufficient to establish bad faith.
24. Further, as the Respondent is in the same general business as the Complainant, and given the Complainant’s worldwide fame and reputation in the diamond industry, it is almost certain that the Respondent would have been well aware of the Complainant and its business before it registered the disputed domain name. Furthermore, the direct reference to the Complainant and its business on the disputed website reinforces the impression that the Complainant is attempting to suggest a connection between the Complainant and the respondent’s business where none exists.
25. Upon review of all of the circumstances the conclusion is clear; the Respondent has engaged in bad faith and therefore, the Panel concludes that the third element is made out.

**6. Decision**

26. The Panel finds that the Complainant has satisfied all three elements of UDRP paragraph 4(a). Accordingly, the Panel orders that the disputed domain name <**gia520.com**> be transferred to the Complainant.

A handwritten signature in blue ink, appearing to read 'D Allison', is positioned above a horizontal line.

David Allison  
Panelist  
Dated: 13 April 2021