ADMINISTRATIVE PANEL DECISION

1、Procedural History

On 17 January 2008, the Complainant submitted a Complaint in the English language to the Hong Kong International Arbitration Center (the HKIAC) and elected this case to be dealt with by a single-member panel. On 26 January 2008, the HKIAC sent to the complainant by email an acknowledgement of the receipt of the complaint. All correspondence to and from the HKIAC described herein was in the English language.

On 26 January 2008, the HKIAC transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. With no response from the Registrar, the HKIAC requested for assistance from the CNNIC on 19 February 2008. On 20 February 2008, the CNNIC transmitted by email to the HKIAC its verification response, confirming that the Respondent is listed as the registrant and providing the contact details. On 8 March 2008, the HKIAC transmitted the Complaint to the Respondent and notified the Respondent of the commencement of the action.

The Respondent failed to submit a Response within the required period of time. On 9 April 2008, the HKIAC notified the Respondent’s default.

Having received a Declaration of Impartiality and Independence and a Statement of Acceptance, the HKIAC notified the parties on 11 June 2008 that the Panel in this case had been selected, with Dr ZHAO Yun acting as the sole panelist. The Panel determines that the appointment was made in accordance with the CNNIC Domain Name Dispute Resolution Policy, its Rules and the HKIAC Supplemental Rules.

On 11 June 2008, the Panel received the file from the HKIAC and should render the Decision within 14 days, i.e., on or before 25 June 2008.

According to Article 6 of the CNNIC Policy, the language of the domain name dispute resolution policy shall be Chinese, unless otherwise agreed by the parties or determined by the Panel. The Complainant submitted the Complaint in English. The Respondent, however, did not oppose to the language used by the Complainant. The verification response from the CNNIC shows that the
Respondent is registered in the US and obviously has no problem in understanding the English language. The Panel, in consideration of the circumstances of this administrative proceedings and having regard to the fact that there is no express opposition submitted by the parties, determines English as the language of the proceedings.

2. Factual Background

For the Complainant

The Complainant, Dooney & Bourke, Inc., is a foreign company and has the registration address as follows: One Regent Street, P.O. Box 841 Norwalk, Connecticut 06856, the United States of America. The Complainant is the owner of the trademark “Donney & Bourke” in many countries and regions, including China.

For the Respondent

The Respondent, MicroInfo Investments Ltd. (Mark Kenneth), is the current registrant of the disputed domain names <dooney.cn/dooney.com.cn> according to the Whois information.

3. Parties’ Contentions

Complainant

The Complainant, founded in 1975, is a company specializing in fashion accessories and leather goods. Over the past years, the Complainant has invested a considerable amount of resources in developing and promoting the brand “Dooney & Bourke” and its abbreviated form “Dooney” (hereinafter collectively referred to as the “Dooney Marks”). The Complainant frequently places advertisements in various international fashion magazines. By reasons of the aforesaid matters and the extensive sales and promotion of the Complainant’s products in the world, the Dooney Marks have become a worldwide famous brand and have acquired reputation and goodwill amongst the public in the world including China.

The Complainant has obtained registration of the Donney Marks in different forms in various countries since at least 1985. In China, the Complainant has filed applications for the Dooney Marks since at least 20 October 1993. The Marks have been registered since 21 April 1995 in Class 18. In 1996, the Complainant registered the domain name www.dooney.com. It has since been and is still operating its official website at this domain name. Through the Complainant’s official website, the Complainant promotes the Dooney Marks and distributes information in relation to its brand, products, services and business to the general public in the world. In 1998, the Complainant registered the domain names www.dooneybourke.com and www.dooneyandbourke.com. Both domain names are arranged to be redirected to the Complainant’s official website at www.dooney.com.

On 10 March 2007, the Respondent registered the disputed domain names. The disputed domain names consist exclusively of the word “Dooney” and are the corresponding <.cn> domain names of the Complainant’s Dooney Domain Names. However, there are no direct or indirect relationships at all between the Complainant and the Respondent, and the Complainant has never authorized the Respondent to use the word “Dooney” or to register the disputed domain names. The dates on which the Complainant started to use and first applied to register the Dooney Marks and the Dooney domain names are far earlier than the date of registration of the disputed domain names. Online trademark searches have revealed that the Respondent has never registered or
applied to register any trademarks in at least China, USA, Hong Kong, Taiwan, European Union and Australia. The Respondent is not therefore entitled to any registered trademark rights in the word “Dooney”. Searches against the Respondent’s name and email address have shown that the Respondent has repeatedly registered a large number of domain names for the purpose of putting them up for auction or sale. Up to the time of filing the complaint, the Respondent has not put the disputed domain names in actual use. On the contrary, the Respondent has put the disputed domain names up for auction at namerich.cn i.e. the sponsoring registrar through whom the Respondent registered the disputed domain names.

Identical/Confusing Similarity

The Complainant has acquired legitimate interest in the Dooney Marks through various means. The disputed domain names are identical or similar to the Complainant’s Dooney Marks and Domain Names, and are likely to cause confusion amongst the public.

No Rights or Legitimate Interests in Respect of the Domain Names

The Respondent is unable to establish any legitimate interest in the dispute domain names. In particular, the Respondent has never used or applied to register the word “Dooney” in respect of any goods or services anywhere in the world. That said, any applications filed by the Respondent would have been rejected or opposed to anyway, since the Complainant is the true owner of the Dooney Marks. The Complainant has never authorized the Respondent to use its Dooney Marks or to register the disputed domain names.

Domain Name Registered and Used in Bad Faith

The sole purpose of the Respondent in registering the disputed domain names is to sell, rent or transfer them to the Complainant (or its competitors) with a view to obtaining illegal benefits. The Respondent has not put the disputed domain names in actual use but has put them up for auction. The Respondent has repeatedly registered domain names in which other entities clearly enjoy legitimate interest. Apparently, the intention of the Respondent is to prevent the right owners from using their names or marks as domain names and to obtain illegal benefits from them. The Respondent is clearly a cybersquatter engaging in the business of domain names trading, and the disputed domain names are obviously one of the domain names which the Respondent has registered in bad faith and with a view to selling them to obtain illegal benefits.

The Complainant approached the Respondent on 2 October 2007 to notify the Respondent of the Complainant’s rights in the Dooney Marks and Dooney brand. However, the Respondent replied on 14 November 2007 and demanded the Complainant to pay him 10,000 US dollars for the disputed domain names.

The word “Dooney” does not carry any dictionary meaning and it is definitely not a common surname in China where the Respondent is located. On the contrary, the Complainant has, since 1975, been using the Dooney Marks and has acquired substantial reputation and goodwill in the fashion industry and in the world including China. It is therefore impossible that the Respondent could have created and registered the disputed domain names without any knowledge of the Complainant’s rights, interest and reputation.

In accordance with the CNNIC Policy and on the basis of the reasons stated above, the panel is requested to render a decision transferring the disputed domain names to the Complainant.
Respondent

The Respondent failed to submit a Response within the required period of time.

4. Findings

In accordance with Article 8 of the CNNIC Policy, in order to succeed in the administrative proceeding and obtain an order that a domain name should be cancelled or transferred, the Complainant should prove each of the following three elements:

1) the disputed domain name is identical with or confusingly similar to the Complainant’s name or mark in which the Complainant has civil rights or interests; and
2) the disputed domain name holder has no rights or legitimate interests in respect of the domain name or major part of the domain name; and
3) the disputed domain name holder has registered or is using the domain name in bad faith.

Identical/Confusingly Similar

The Complainant’s enterprise name is “Dooney & Bourke, Inc.”, which has been registered in the United States of America since 1975. “Dooney” is the substantial part of its trade name “Dooney & Bourke Inc.” in its registered enterprise name. The evidence submitted by the Complainant shows that the Complainant owns the trademarks “Dooney & Bourke”. The Complainant registered the trademark in various countries as early as in 1985. The trademark has been registered in China since 1995 in Class 18. Accordingly, “Dooney & Bourke” enjoys trademark protection in China since 1995, much earlier than the registration date of the disputed domain names in 2007. “Dooney” constitutes a substantial part of the trademark and the main part of the Complainant’s official website; it is an abbreviated form for the trademark “Dooney & Bourke”. Evidence shows that the Complainant has been in extensive use and promotion of the trademark and its abbreviated form “Dooney”.

As the suffix “.cn/.com.cn” only indicates that the domain name is registered under this ccTLD and is not distinctive, the Panel has no problem in finding that the disputed domain names <dooney.cn/dooney.com.cn> are identical or confusingly similar to the Complainant’s trademark “Dooney & Bourke” and its abbreviated form “Dooney”.

The Panel therefore holds that the Complaint fulfills the first condition provided in Article 8 of the CNNIC Policy

Rights and Legitimate Interests

The Complainant contends that the Respondent does not have rights to or legitimate interests in the disputed domain names. The Complainant also submits that the Respondent has not been authorized to use the trademark. The Complainant’s assertion is sufficient to establish a prima facie case, thereby shifting the burden to the Respondent to present evidence of its rights or legitimate interests.

The Respondent, who did not file a Response, did not dispute the above contention and has failed to show that the Respondent has any rights or legitimate interests in respect of the disputed domain names. In view of the evidence submitted, the Panel cannot but hold that the Respondent does not have rights or legitimate interests in the disputed domain names.
The Panel therefore finds that the Complaint fulfills the second condition provided in Article 8 of the CNNIC Policy.

**Bad Faith**

Under Article 9 of the CNNIC Policy, the following are relevant examples a Panel may take as evidence of registration and use in bad faith:

(i) the purpose of registering or acquiring the domain name is to sell, rent or otherwise transfer the domain name registration to the complainant who is the owner of the name or mark or to a competitor of that complainant, and to obtain unjustified benefits; or

(ii) the disputed domain name holder registered the domain name in order to prevent the owners of the name or mark from reflecting the name or the mark in a corresponding domain name, provided that the domain name holder has been engaged in a pattern of such conduct; or

(iii) the disputed domain name holder has registered or acquired the domain name for the purpose of damaging the Complainant’s reputation, disrupting the Complainant’s normal business or creating confusion with the Complainant’s name or mark so as to mislead the public; or

(iv) other circumstances which may prove the bad faith.

The evidence shows that the Respondent put the disputed domain names for auction and offered to sell the disputed domain names to the Complainant at the price of US$ 10,000, which is higher than the registration fee defined by the China Internet Network Information Center (CNNIC). This is exactly the first typical examples of bad faith as defined in the CNNIC Policy: to sell or transfer the domain name to the Complainant who is the owner of the name or mark and to obtain unjustified benefits. Furthermore, it should be mentioned that the Respondent has not made any use of the disputed domain names since the registration in March 2007. Passive holding of domain names may be also evidence to show the Respondent’s bad faith in registering the disputed domain names.

In conclusion, the Panel finds that the Respondent has registered and used the disputed domain names in bad faith. Accordingly, the Panel finds that the Complaint satisfies the third condition provided in Article 8 of the CNNIC Policy.

**5. Decision**

Having established all three elements required under the CNNIC Policy, the Panel concludes that relief should be granted. Accordingly, it is ordered that the disputed domain names <dooney.cn/dooney.com.cn> should be TRANSFERRED from the Respondent to the Complainant.

ZHAO Yun
Sole Panelist

DATED: 16 June 2008