

Arbitration Panel Decision
Case No: DHK-1100070

Complainant:	AATC TRADING AG
Respondent:	Hong Kong ALAIA Industrial Co., Limited
Disputed domain name:	alaia.com.hk
Registrar:	Hong Kong Domain name Registration Company Limited

1. Procedural History

The Complainant in this case is AATC TRADING AG, a company organized under the laws of Switzerland, whose address is Hinterbergstrasse 22, 6330 Cham, Switzerland. Its authorized representative in these proceedings is Mr. William Hang, LAW ATL Law, 15/F, Fook Lee Commercial Center, 33 Lockhart Road, Wanchai, Hong Kong.

The Respondent is Hong Kong ALAIA Industrial Co., Limited, a company organized under the laws of Hong Kong, whose address is Flat 3, 9/F, Block R, Amoy Gardens, Ngau Tau Kok, Kowloon, Hong Kong.

The Domain name in dispute is <alaia.com.hk>.

The Registrar of the Domain name is Hong Kong Domain name Registration Company Limited, which is located in Hong Kong (the "Registrar").

On November 9, 2011, the Complainant submitted a Complaint in English to the Hong Kong International Arbitration Center (the "HKIAC") and elected this case to be dealt with by a one-person panel, in accordance with the Hong Kong Domain name Dispute Resolution Policy (the "Policy"), the Hong Kong Domain name Dispute Resolution Rules of Procedure (the "Rules") and the HKIAC Supplemental Rules (the "HKIAC Supplemental Rules").

On November 9, 2011, the HKIAC formally notified the Registrar of the disputed domain name of the proceedings by email. On November 10, 2011 the Registrar acknowledged this notification by email confirming its registration of the domain name at issue and including its WHOIS information.

On November 10, 2011, the registrar transmitted by email to the HKIAC its verification response confirming that the Respondent is listed as the registrant and providing the contact details. On the same day, the HKIAC confirmed the receipt of the Complaint.

On November 11, 2011, In accordance with paragraph 4(a) of the Rules, the HKIAC formally notified the Respondent of the Complaint. The Respondent was informed that it had fifteen (15) business days to submit a Response.

No response from the Respondent was filed with the HKIAC on or before the prescribed deadline (December 2, 2011).

Subsequently, on December 9, 2011, the HKIAC requested the undersigned, Prof. FAN Kun, to indicate the ability to act as sole Panelist and if so confirm ability to act independently and impartially. On the same day, the undersigned responded in affirmative on all points.

On 9 December 2011, the HKIAC notified the parties that the Panel in this case had been selected, with Prof. FAN Kun acting as the sole panelist. On that same date, the Panel received the file from HKIAC.

2. Factual Background

2.1. For the Complainant

The Complainant, AATC Trading AG, is a private company incorporated in Switzerland whose business, since 1983, consists in design and sale of high quality luxury apparel, including ready to wear clothing and couture, bags, shoes and accessories. The Complainant's products are designed by Mr. Azzedine Alaïa. The Complainant explains that these products can be bought worldwide in department stores and boutiques and through e-commerce businesses that have express permission to sell the complainant's products; they can also be purchased in the Azzedine Alaïa retail store in Paris.

The Complainant states that it is well established internationally, with a loyal customer base around the world and that it markets its products all over the world. The Complainant adds that it regularly features in a multitude of online and hardcopy publications including Vogue, Elle, The Financial Times and many more. As a result of promotion and widespread sales, the Complainant considers that the brand ALAÏA has acquired an exclusive reputation in luxury fashion and accessories and, through this global reputation, the Complainant has built up significant goodwill in the ALAÏA brand.

The Complainant is the owner of numerous registered trademarks for "ALAÏA", "A ALAÏA" or "ALAÏA PARIS", and has provided copies some registered trademarks, including:

	Registration Nos.	Class of the Nice classification	Date of registration	Expiry date
Hong Kong	No 19870161	25	January, 27, 1984	January, 27, 2015
Hong Kong	No. 300562518	3 (make-up and cosmetics products) and 18	January, 10, 2006	January, 9, 2016
European Union (Community Trade Mark)	No. 2613461	3, 9, 14, 18, 25, 35	March, 13, 2002	March, 13, 2012
European Union (Community Trade Mark)	No. 921277	3, 18, 25	January, 19 2007	January, 19 2017
International registration designating several countries	No. 773126 No. 628953 No. 484337	3, 9, 18, 24, 25	December 6, 2001	December 6, 2011

The disputed domain name <alaia.com.hk> was registered on September 7, 2005.

The disputed domain name leads Internet users to a website dedicated to advertisement for cosmetic products.

2.2. For the Respondent

Respondent has failed to file a response in this matter.

3. The Parties' Contentions

3.1. Complainant

Complainant raised the following contentions:

- i. The Domain name <alaia.com.hk> is identical to the Trade Mark "ALAÏA" of the Complainant except that "ï" is a Latin letter "i" with diaeresis, which is usually expressed in the form of "i" in typing a domain name.
- ii. The fact that the name of the Respondent, "Hong Kong ALAIA Industrial Co., Limited", is almost identical to the Complainant's registered Trade Marks will constitute an act of actionable passing off claim. The Respondent will not be able to demonstrate that his conduct satisfies any of the conditions in paragraph 4(d) of the Policy.
- iii. The Respondent has deliberately registered the disputed domain name <alaia.com.hk> which is identical to the Complainant's famous trademark "ALAÏA", with an intention of causing confusion to the public that the Respondent and/or the Respondent's website is related to or authorized by the Complainant and/or the Complainant's website and diverting the traffic of the web-users.

- iv. The Respondent has been using the website www.alaia.com.hk which contains the domain name at issue in selling un-related skin care and cosmetic products such as “Rufin” and “Bionatural”.

3.2. Respondent

The Respondent has not filed a response to the allegations.

4. The Opinion of the Panelist

4.1. Respondent in Default

Article 2(a) of the Policy provides:

“[b]y applying to register a Domain name, or by asking the Registrar to maintain or renew a Domain name registration, the Registrant represents and warrants to the Registrar and HKIRC that the statements that the Registrant made in the Registration Agreement or provided to the Registrar in the course of processing the Domain name application are complete and accurate”.

The Complainant has been formally notified to the Respondent through the contacts the Respondent provided when it registered the disputed domain name.

Article 5(e) of the Rules provides:

“[i]f a Respondent does not submit a timely Response, in the absence of exceptional circumstances as determined by the Provider at its sole discretion, the Arbitration Panel shall decide the dispute based upon the Complaint and the evidence submitted therewith.”

The Panel finds that no exceptional circumstances exist. Accordingly, the Panel will decide the dispute based upon the Complaint and the evidence submitted therewith.

4.2. The Language of the Proceedings

Paragraph 11(a) of the Rules provides:

“Unless otherwise agreed by the Parties, the language of the arbitration proceedings shall be in English for English .hk domain name, and in Chinese for Chinese .hk domain name or .香港 domain name, subject always to the authority of the Arbitration Panel to determine otherwise, having regard to all the circumstances of the arbitration proceeding” (emphasis added).

Moreover, the website on which the disputed domain name leads the internet users provides an English version. In these circumstances, the Panel considers that the Respondent is able to understand the language of the Complaint and the Proceedings.

Additionally, English is one the official languages in Hong Kong, where the Respondent is domiciled, according to information he provided in the WOIS records.

In light of the above, the Panel determines that the language of the arbitration proceedings shall be English.

4.3. Burden of Proof

Pursuant to paragraph 4(a) of the Policy, the Complainant has the burden of proving:

“(i) the Registrant’s Domain name is identical or confusingly similar to a trademark or service mark in Hong Kong in which the Complainant has rights; and

(ii) the Registrant has no rights or legitimate interests in respect of the Domain name; and

(iii) the Registrant’s Domain name has been registered and is being used in bad faith, and

(iv) if the Domain name is registered by an individual person, the Registrant does not meet the registration requirements for that individual category of Domain name”.

Given the fact that the Respondent is not an individual but a company, the latest condition (iv) is irrelevant.

4.4. Analysis

1. Identical or Confusing Similarity

Article 4(a)(i) of the Policy expressly takes in account only trademarks and service marks registered in Hong Kong.

Therefore, in the present case, the trademarks records provided by the Complainant concerning trademarks registered outside Hong Kong are irrelevant for the purpose of the disputed domain name <alala.com.hk>.

The Complainant has provided evidence that it is the owner of two trademarks registered in Hong Kong:

Registration Nos.	Class of the Nice classification	Date of registration	Expiry date
No 19870161	25	January, 27, 1984	January, 27, 2015
No. 300562518	3 (make-up and cosmetics products) and 18	January, 10, 2006	January, 9, 2016

Given the fact that the second trademark (No. 300562518) was registered (January 10, 2006) after the registration of the domain name at issue <alaia.com.hk> (September 7, 2005), and as far the Complainant does not provide any material likely to prove that this trademark is effectively used in Hong Kong, the Panel is not in a position to take it into account for the purpose of establishing the first element.

Nevertheless, the record of the first trademark (No. 1987016) shows that it was registered in 1984, years before the disputed domain name (2005).

The Panel finds that the Complainant has a Hong Kong trademark on the word “ALAIA” and has proven that the domain name at issue <alaia.com.hk> is identical to its Hong Kong trademark “ALAIA”.

2. Rights or Legitimate Interests of the Respondent

It is well established that, once the Complainant establishes a *prima facie* case that the Respondent lacks rights or legitimate interests in the domain name at issue, the burden of evidence shifts to the Respondent to show that it has rights or legitimate interests in respect to the disputed domain name.

In the present case, the Complainant states that the Respondent is not entitled to or otherwise authorized or licensed by the Complainant in whatsoever means to use the trademark in any goods or services, and points three arguments in that sense.

First, the Complainant provides copies of the Hong Kong Companies registry showing that “Hong Kong ALAIA Industrial Co., Limited” (namely, the Respondent) has been deregistered in December 2008 and, as a consequence, has been dissolved.

Second, the Complainant contends that, *“even if the Respondent had not been deregistered, the Respondent would not be able to demonstrate that his conduct satisfies any of the conditions in paragraph 4(d) of the Policy”*. In the same vein, the Complainant asserts that *“any use of the name “ALAIA” by the Respondent would constitute an act of actionable passing off claim, citing several well-known passing off cases”*.

Third, the Complainant ensure that if it had known about the Respondent before its deregistration, the Complainant would have sought the court for an order to restraint the use of the “ALAIA” trade name by the Respondent.

In the Panel’s view, the Complainant has in a credible way alleged that Respondent has no rights or legitimate interests in respect of the domain name at issue.

In his part, Respondent has failed to show that it has any rights or legitimate interests in respect of the domain name at issue.

This entitles the Panel to infer that Respondent has no rights or legitimate interests in respect of the domain name at issue.

3. Registration and use in Bad Faith

The Complainant argues that the Respondent:

“has deliberately registered the disputed domain name which is identical to the Complainant’s famous trademark “ALAIA”, with an intention of causing confusion to the public that the Respondent and/or the Respondent’s website is related to or authorized by the Complainant and/or the Complainant’s website and diverting the traffic of the web-users.

has been using the website www.alaia.com.hk which contains the disputed domain name in selling un-related skin care and cosmetic products such as “Rufin” and “Bionatural”.

The Complainant concludes that *“the public will likely be confused into believing that the Respondent and/or the Respondent’s website is related to or authorized by the Complainant”*. Similarly, it also points extensive use and advertisement of the “ALAIA” trademark, as well as its fame and distinctiveness.

In the present case, it is indisputable that the Respondent registered the disputed domain name years after Complainant registered its first Hong Kong trademark.

Furthermore, [§ 1.1. of the “WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition \(“WIPO Overview 2.0\)”](#) finds that if the goods and/or services for which the trademark is registered are considered irrelevant for the purpose of finding rights in a trademark under the first element, *“such factors may bear on a panel’s determination whether the respondent has registered and used the domain name in bad faith under the third element of the UDRP”*. Even though the Policy applicable to the present proceedings defers from the UDRP, some opinions of the WIPO Overview 2.0 can still be taken into account. Here, by the time the Complaint was filed, the website www.alaia.com.hk made the promotion of cosmetics products. Then, if the Panel is not in a position to take into account the Hong Kong trademark No. 300562518 registered in 2006 for the purpose of establishing the first element, the Panel can take it into consideration for the purpose of establishing the bad faith in the use of the disputed domain name. The Panel believes that the choice to use the disputed domain name to promote cosmetics products — which are often associated to luxury goods —, is not hazardous and constitute a supplementary evidence likely to prove the bad faith of the Respondent.

In light of the above, the Panel determines that the domain name at issue was registered and is being used in bad faith.

5. Decision

For all of the foregoing reasons, the Panel decides that the domain name registered by Respondent is confusingly similar to the mark in which the Complainant has rights, that the Respondent has no rights or legitimate interests in respect of the domain name at issue, and that the Respondent's domain name has been registered and is being used in bad faith.

Accordingly, pursuant to Paragraph 3 of the Policy, the Panel requires that the registration of the domain name <alaia.com.hk> be transferred to the Complainant.

FAN Kun
Sole Panelist

Dated: December 31, 2011