



香港國際仲裁中心
Hong Kong International
Arbitration Centre

ADMINISTRATIVE PANEL DECISION

Case No.	DHK-1200075
Complainant:	Golla Oy
Respondent:	Yica International Group Co., Limited

1. The Parties and Contested Domain Name

The Complainant is Golla Oy, of Helsinki, Finland (“the Complainant”).

The Respondent is Yica International Group Co., Limited, Zhougeun Town, China (“the Respondent”).

The domain name at issue is <golla.com.hk> (“the Disputed Domain Name”) and was registered by Respondent with the Hong Kong Domain Name Registration Company Limited (“the Registrar”).

2. Procedural History

The Complaint was filed with the Hong Kong International Arbitration Center (“HKIAC”) on March 9, 2012. On March 9, 2012, the HKIAC transmitted by email to the Hong Kong Domain Name Registration Company Ltd a request for registrar verification in connection with the Disputed Domain Name. On March 12, 2012, the Hong Kong Domain Name Registration Company Ltd transmitted by email to the HKIAC its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The HKIAC verified that the Complaint satisfied the formal requirements of the HKDNR Domain Name Dispute Resolution Policy (the “Policy”), the HKDNR Domain Name Dispute Resolution Policy Rules of Procedure (the “Rules”), and the HKIAC Supplemental Rules (the “Supplemental Rules”).

The HKIAC formally notified the Respondent of the Complaint, and the proceedings commenced on March 20, 2012. Pursuant to art. 5 of the Rules, the due date for Response was April 16, 2012. No Response was filed with the HKIAC.

The HKIAC appointed Jacques de Werra as the sole panelist in this matter on April 20, 2012.

The Panel determines that its appointment was made in accordance with para. 6 of the Rules and Articles 8 and 9 of the Supplemental Rules.

3. Factual background

The Complainant is a Finish company which is in the business of designing, producing, marketing and selling of cases and bags for mobile electronic devices, such as mobile phones, laptop computers, iPads, mp3 players, digital cameras and game consoles. As a result of its partnership with various global companies in the consumer products in the telecom and technology industries (among which Nokia, Canon and Nikon), the Complainant has become a leader in global lifestyle brands for mobile technology cases.

The Complainant is the owner of many trademarks (i.e. more than 50 trademark applications and registrations), including the trademark No 301381806 registered in Hong Kong on July 10, 2009 for various goods and services in classes 9, 18 and 35 (hereafter the “Trademark”).

The Complainant is also the owner of many domain names containing the “Golla” element, including the domain name www.golla.com.

The Complainant is present on the Hong Kong market since 2007. As of October 2011, its products were available in over 100 outlets in Hong Kong.

The Disputed Domain Name was registered by the Respondent on October 27, 2011. It is used to sell counterfeit various “Golla” products, whereby the website associated to the Disputed Domain Name reproduces the logo and trademark used by the Complainant (particularly its red colour).

4. Parties’ Contentions

A. Complainant

The Complainant’s contentions may be summarized as follows:

- i. The Disputed Domain Name incorporates the Trademark in its entirety and is thus confusingly similar to the Trademark;
- ii. The Respondent has no right or legitimate interest in the Disputed Domain Name and it is not authorized or licensed to use the Trademark because Respondent is not affiliated with, licensed by the Complainant, and has not been given permission to use the Trademark by the Complainant. There is further no evidence that the Respondent which is based and registered in Hong Kong has registered a trademark “Golla” in Hong Kong; the Respondent was furthermore found to lack rights or legitimate interests in a previous domain name dispute relating to a famous third party trademark (Christian Dior);
- iii. The Respondent registered and uses the Disputed Domain Name in bad faith because it uses it to promote and sell products that infringe the Complainant’s Trademark in Hong Kong, whereby the term “Golla” has no dictionary meaning so that the Respondent had the Trademark in mind when registering the Disputed Domain Name as further confirmed by the fact that the website associated with the Disputed Domain Name features a logo which is identical to the Trademark of the Complainant.

B. Respondent

- i. The Respondent's did not file any response.

5. Findings

The 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 must be identical or confusingly similar to a trademark or service mark in Hong Kong 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 Panel is satisfied that the Complainant has rights to the Trademark in various jurisdictions, including in Hong Kong, and that its marketing efforts have created a strong brand recognition of the Trademark in many countries, including in Hong Kong.

A comparison between the Disputed Domain Name and the Trademark shows that the Disputed Domain Name is identical or at least confusingly similar to the Complainant's Trademark.

As a result, based on the rights of the Complainant in the Trademark and on the confusing similarity between the Trademark and the Disputed Domain Name, the Panel finds that the conditions of paragraph 4(a)(i) of the Policy are met.

B) Rights and Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights to or legitimate interests in the Disputed Domain Name by demonstrating any of the following:

- (i) before any notice to it of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Although the Complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, previous panels have consistently ruled that paragraph 4(c) of the Policy shifts the burden to the Respondent to come forward with evidence of a right or legitimate interest in the domain name, once the Complainant has made a *prima facie* showing. See

In the Panel's opinion, the Complainant has made a *prima facie* case against the Respondent. The Respondent indeed registered the Disputed Domain Name which includes the distinctive term "GOLLA" which has no dictionary meaning and is identical to the Trademark owned by the Complainant and uses it in connection with a website selling counterfeiting goods imitating the products of the Complainant.

The Complainant has also established that the Respondent has no right in the Disputed Domain Name (i.e. he is not the owner of any trademark corresponding to the Disputed Domain Name in China or in Hong Kong, which is the country where the Respondent appears to be based), that he is not authorized or licensed to use the Trademark by the Complainant and that the Respondent has not been commonly known by the Disputed Domain Name.

The Panel thus accepts the Complainant's *prima facie* showing and it is consequently up to the Respondent to come forward with evidence of a right to or legitimate interests in the Disputed Domain Name, which has not been done given Respondent's absence of participation in these proceedings.

Accordingly, the Panel finds that the Respondent has no right or legitimate interests in the Disputed Domain Name pursuant to paragraph 4(a)(ii) of the Policy.

C) Bad Faith

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name;
- (ii) circumstances indicating that the respondent 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 the respondent has engaged in a pattern of such conduct;
- (iii) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the respondent intentionally is using the domain name in an attempt to attract, for commercial gain, Internet users to its website 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 the respondent's website or location or of a product or service on its website or location.

The examples of bad faith registration and use set forth in paragraph 4(b) of the Policy are not meant to be exhaustive of all circumstances from which such bad faith may be found. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003. The overriding

objective of the Policy is to curb the abusive registration of domain names in circumstances where the registrant is seeking to profit from and exploit the trademark of another. See *Match.com, LP v. Bill Zag and NWLAWS.ORG*, WIPO Case No. D2004-0230.

In this case, the Panel holds that the Respondent registered the Disputed Domain Name in bad faith because the Trademark is distinctively identifying the Complainant and the Complainant's mobile technology products so that the choice of the Disputed Domain Name cannot be reasonably explained otherwise than as a reference to the Trademark of the Complainant. The Respondent's bad faith in the registration and use of the Disputed Domain Name is further confirmed by the fact that the Disputed Domain Name is used for the promotion and commercialization of products counterfeiting the Complainant's Trademark and products.

On this basis, the Panel has formed the view that the Respondent's intention in registering and using the Disputed Domain Name was to divert Internet users looking for information about the Complainant to a website other than the Complainant's in order to take advantage of the reputation that the Complainant has built up in the Trademark for commercializing fake products under the Complainant's Trademark. See, by analogy, *Chopard International S.A. v. Vladimit Kozlov*, WIPO Case No. D2007-1544.

For these reasons, the Panel considers that the Complainant has established that the Disputed Domain Name was registered and is being used in bad faith by the Respondent pursuant to paragraph 4(a)(iii) of the Policy.

6. Remedy

In its complaint, the Complainant has requested the administrative panel to issue a decision that the Disputed Domain Name (i) be transferred to the Complainant or alternatively (ii) be transferred to the Complainant's agent in Hong Kong if option (i) is not accepted, or (iii) be cancelled if options (i) and (ii) are not accepted.

The Complainant is not a commercial entity registered in Hong Kong so that it cannot be the owner of the Disputed Domain Name pursuant to the applicable regulations (i.e. art. 3.6 of the Domain Name Registration Policies, Procedures and Guidelines for .hk and .香港 domain names, Version 1.0 Effective 22 Feb 2011)¹, which excludes the remedy of the transfer of the Disputed Domain Name to the Complainant. However, it has been established above that the Complainant has met all substantive requirements under the Policy and the Rules in order to claim ownership of the Disputed Domain Name. As a result, the remedy of the cancellation of the Disputed Domain Name (which is claimed in last resort by the Complainant) would not be equitable for the Complainant given that it would lead to a situation in which the Complainant would face the risk of another abusive registration of the Disputed Domain Name by a Hong Kong unauthorized third party. On this basis, the Panel comes to the conclusion that the Disputed Domain Name shall be transferred to the Complainant's agent in Hong Kong as alternatively requested by the Complainant.

7. Decision

For all the foregoing reasons, in accordance with Paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name <golla.com.hk> be transferred to the

¹ https://www.hkirc.hk/pdf/form/RAP_Policies_Procedures_Guidelines_eng.pdf.

Complainant's agent in Hong Kong, whereby the Complainant shall diligently communicate to the Registrar and to the HKIAC the contact details of such agent upon receipt of this decision.

Jacques de Werra
Panelist

Dated: May 11, 2012