



## IN THE MATTER OF

**The Domain Name Dispute Resolution Policy, adopted by the Hong Kong Domain Name Internet Registration Corporation Limited ("HKIRC") on 22 February 2011 (the "Dispute Resolution Policy");**

**The HKIRC Domain Name Dispute Resolution Policy Rules of Procedure, approved by the HKIRC on 22 February 2011 (the "Rules of Procedure"); and**

**The HKIAC Supplemental Rules effective from 1 March 2011 (the "Supplemental Rules").**

Complainant:                               NORMALU SA  
Respondent:                                 FRANCE BARRISOL (HONGKONG) INDUSTRIAL CO., LIMITED  
Case Number:                               DHK-1200083  
Disputed Domain Name:                 barrisol.com.hk  
Panel:                                        Peter Bullock (Sole Panelist)

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### **1. Parties and Disputed Domain Name**

The Complainant is NORMALU SA with a registered address at Route de l'EDF, F-68680 KEMBS, France. The Respondent is FRANCE BARRISOL (HONGKONG) INDUSTRIAL CO., LIMITED with a registered address at JIA DING QU CAOANLV3652HAO201812, China. The Disputed Domain Name is "barrisol.com.hk" which was created on 4 May 2011.

### **2. Procedural History**

A complaint in this matter was filed with the Hong Kong International Arbitration Centre (the "HKIAC") on 17 July 2012 (the "**Complaint**"). The HKIAC notified the registrar of the Disputed Domain Name of the proceedings by email on 20 July 2012. On 23 July 2012, the registrar notified the HKIAC that the proper respondent to the dispute is the Respondent. On 30 July 2012 the Complainant filed its amended Complaint, receipt of which was acknowledged by the HKIAC on 31 July 2012.

The HKIAC sent a notification of commencement of proceedings and the Complaint along with its exhibits to the Respondent by email on 31 July 2012 to four separate email addresses.

The Respondent sent email responses in the Chinese language with attachments to the HKIAC on 15 and 16 August 2012. However none of these email responses or their attachments were filed using the HKIAC's Form B as required by Article 7(1) of the Supplemental Rules. The HKIAC acknowledged receipt of the Respondent's emails on 16 August 2012 and informed the Respondent of the requirement under Article 7(1) of the Supplemental Rules.

On 17 August 2012, the Respondent replied by email in the English and Chinese languages to the HKIAC, again without using Form B. On the same day, the HKIAC acknowledged receipt of the Respondent's email and reiterated the requirements under Article 7(1) of the Supplemental Rules. The HKIAC also highlighted that the language of the proceedings is English under

Paragraph 11 of the Rules of Procedure and reminded the Respondent to copy in the Complainant on all communications from the Respondent to the HKIAC as required by Paragraph 2(h) of the Rules of Procedure, which the Respondent had not complied with. The Respondent replied on the same day in the English and Chinese languages stating that it would translate the relevant documents to send to the HKIAC.

No response by the Respondent using the required Form B was submitted on or before the prescribed deadline of 21 August 2011. The HKIAC informed the Respondent of the same by email on 22 August 2012. The Respondent therefore did not file a response in accordance with the Supplemental Rules.

On 28 August 2012, the HKIAC informed the parties by email that the Sole Panelist had been appointed to the Panel.

On 30 August 2012, the HKIAC highlighted a potential issue to the Sole Panelist, which was previously raised by the registrar by email on 23 July 2012, regarding the Panel's jurisdiction in granting a transfer of the domain name to the Complainant's legal representative. The Complainant requested that the Disputed Domain Name be transferred to the Complainant's legal representative because the Complainant is not a Hong Kong registered company as required by Paragraph 3.6 of the Domain Name Registration Policies, Procedures and Guidelines. The Panel's powers in granting remedies to a Complainant are limited to the transfer or cancellation of the Disputed Domain Name to the Complainant under Paragraph 4(i) of the Dispute Resolution Policy. Therefore prima facie, the Disputed Domain Name should not be transferred to the Complainant's legal representative. However, the Panel refers to *Schonbek Worldwide Lighting, Inc. v Rich point Hong Kong Development* (HKIAC Case No. DHK-1200076), where the panel's order to transfer a ".com.hk" domain name to the foreign complainant's legal representative was enforced by the registrar. This previous ruling and subsequent enforcement demonstrates that the Panel has the requisite jurisdiction to transfer the Disputed Domain Name to the Complainant's legal representative.

### **3. Factual Background**

#### *3.1 For Complainant*

The Complainant is a company founded in 1967 that has a strong reputation for its stretched-ceilings products. After obtaining its first patent and registering its trade marks incorporating "BARRISOL" in France in 1975, the Complainant has been exporting its products and the BARRISOL brand worldwide and has now become one of the world's leading manufacturers and designers of stretched-ceilings. The Complainant has received numerous prizes and awards for its BARRISOL brand and its products have been used by renowned designers and architects.

The Complainant has installation partners for its BARRISOL products in 29 locations in Asia. The Complainant has been supplying BARRISOL stretched-ceilings in Hong Kong since 1995 through its former distributor, Punfet (Europe) Company Limited and its current distributor, Eurasia Architectural Products Limited which was appointed in 2005.

The Complainant has been operating the websites "www.barrisol.com" and "www.barrisol.fr", amongst others, for over 10 years.

The Complainant is the registered owner of the trade mark "BARRISOL" in Hong Kong, effective 24 December 1996 (the "**Trade Mark**").

#### *3.2 For Respondent*

The Respondent registered the Disputed Domain Name on 4 May 2011.

#### **4. Parties' Contentions**

##### *4.1 For Complainant*

The Complainant asserts the following:

- The Disputed Domain Name "barrisol.com.hk" contains a mark which is identical to the Trade Mark.
- The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name on the grounds that the Respondent: (i) has never been authorised to sell products or to operate an online store under the BARRISOL brand; (ii) has neither acquired trade mark nor service mark rights in the Disputed Domain Name; (iii) has not made a legitimate non-commercial or fair use of the Disputed Domain Name; and (iv) has no connection or affiliation with the Complainant and has received no licence or consent, express or implied from the Complainant to use its Trade Mark.
- The Respondent has used the Disputed Domain Name in bad faith in order to: (i) lead the public into the mistaken belief that the website of the Disputed Domain Name is an official website of the Complainant; and (ii) intentionally attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's marks.

##### *4.2 For Respondent*

The Respondent did not file a response.

#### **5. Discussion and Findings**

Paragraph 4(a) of the Dispute Resolution Policy sets out the grounds that the Complainant must demonstrate in order to succeed in its complaint:

- (i) the domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the domain name has been registered and is being used in bad faith; and
- (iv) the domain name is registered by an individual person who does not meet the registration requirements for that individual category of domain name.

##### **(1) Identical / Confusingly Similar**

The Complainant contends that the Disputed Domain Name is identical to the Trade Mark. The Panel agrees with the Complainant on its contention as the Disputed Domain Name wholly incorporates the Trade Mark. Thus, the Panel finds the Complainant has satisfied the first condition under Paragraph 4(a) of the Dispute Resolution Policy.

##### **(2) Rights and Legitimate Interests**

Paragraph 4(d) of the Dispute Resolution Policy sets out the way in which the Respondent can prove it had rights or legitimate interests in the Disputed Domain Name, including:

- 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 in Hong Kong; or

- The Respondent (as an individual, business, or other organisation) has been commonly known by the domain name, even if no trade mark or service mark rights has been acquired in Hong Kong; or
- The Respondent has trade mark or service mark rights over the mark that is identical to the domain name the Respondent is holding; or
- The Respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.

The Complainant owns the Trade Mark in Hong Kong which is identical to the word used in the Disputed Domain Name. The Respondent owns no such trade mark in Hong Kong which is identical to the Disputed Domain Name.

In addition to the Trade Mark registered in Hong Kong in 1996, the Complainant registered "BARRISOL" as a trade mark in the People's Republic of China ("**PRC**") in 1997. The Complainant's BARRISOL trade marks have therefore been registered in Hong Kong and the PRC since 1996 and 1997 respectively. On the other hand, the Respondent only registered the trade marks "BARRISOL BAROQUE" and "巴力" in the PRC in 2007 and 2012 respectively (both trade mark registrations were unsuccessfully opposed by the Complainant). The Respondent was incorporated in 2007 and the Disputed Domain Name was registered in 2011. The Complainant therefore has prior rights to and extensive use of the BARRISOL mark which predates the Respondent's interest in and use of the same mark by over a decade. In the WIPO case *PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.) and EMS COMPUTER INDUSTRY (a/k/a EMS)* (Case No. D2003-0696), the complainant's rights or interests predated those of the respondent's, and the panel held that the burden of proof shifted to the respondent. The Panel therefore finds that the burden of proof shifts to the Respondent to show that it has a legitimate interest or right in the Disputed Domain Name. The Respondent has not filed a response and has therefore not adduced any evidence to support such a legitimate interest or right.

As mentioned above, the BARRISOL trade marks are in good standing in Hong Kong, the PRC and worldwide and the Complainant has maintained this presence for over a decade before the Respondent's registration of the Disputed Domain Name. Therefore the Respondent is likely to have been aware of the BARRISOL marks and brand long before it registered and started operating the Disputed Domain Name.

Given that the Respondent ought to have known about the BARRISOL brand and offered goods similar to those offered by the Complainant, it cannot be said that the Respondent was involved in a bona fide offering of goods and services using the Disputed Domain Name.

The fact that the Respondent's registrations of the Disputed Domain Name, company name and trade marks in the PRC contain the BARRISOL word mark strongly suggests that the Respondent did so with a view to misleadingly diverting customers from the Complainant.

After considering the evidence and given that no further response has been provided by the Respondent, the Panel finds the Respondent to be using the Disputed Domain Name illegitimately with the intent of commercial gain to mislead consumers.

### **(3) Bad Faith**

In paragraph 4(b) of the Dispute Resolution Policy, a number of circumstances are illustrated as evidence of registration and use of a domain name in bad faith. These are as follows:

- any circumstances indicating that the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trade mark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name; or

- the Respondent registered the domain name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or
- the Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, internet users to the Respondent's web site 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 web site or location or of a product or service on the Respondent's web site or location.

The Respondent registered the Disputed Domain Name and has used the website of the Disputed Domain Name (the "**Website**") in a way that misleads internet users. As discussed above, the Disputed Domain Name incorporates the Trade Mark in its entirety without addition or modification.

On the Website, the Trade Mark and its logo device are used as part of the Website's "BARRISOL BAROQUE" logo. There are pictures of stretched-ceilings on the Website which are similar, and in one case appears to be identical to a picture on the Complainant's website. The Website is clearly attempting to sell these goods for commercial gain. There is no disclaimer on the Website that the Respondent is not an authorised distributor for the Complainant.

The decision of *Normalu v Shanghai Pinpoint Network-Tech co., Ltd / Honchie*, (WIPO Case No. D2012-0864) involved the Complainant and concerned the websites "www.barrisolstar.com" and "www.barrisol-fabric.net". It cannot go unnoticed that one of the respondents in that case, Shanghai Pinpoint Network-Tech co., appears to be the operator and/or user of the current Disputed Domain Name. This is evidenced from the "contact us" page on the Website which lists Shanghai Pinpoint Network-Tech co. as the contact company in the PRC. The infringing websites in that case employed the use of the Trade Mark within the "BARRISOL BAROQUE" logo and the company name, where the panel found the respondents to be acting in bad faith.

Furthermore, the Panel considers that it is highly unlikely that the Respondent, who appears to be operating in the same market of products and who has chosen to incorporate the BARRISOL trade marks in the Disputed Domain Name, its company name and PRC trade marks, was unaware of the Complainant's BARRISOL marks and brand. In *Dr. Ing. H.c F. Porsche AG v. Rojeen Rayaneh*, (WIPO case No. D2004-0488), the registration of a well-known trade mark of which the respondent to a dispute must reasonably have been aware was held to constitute bad faith. On this point, the Panel finds the Respondent has acted in bad faith.

The Complainant has presented adequate evidence to demonstrate that the Respondent has registered and used the Disputed Domain Name in bad faith in accordance with paragraph 4(b) of the Dispute Resolution Policy.

#### **(4) Domain name registration by an individual person**

The Disputed Domain Name is registered by the Respondent and is not registered by an individual person, hence this requirement does not apply to the current case.

## **6. Decision**

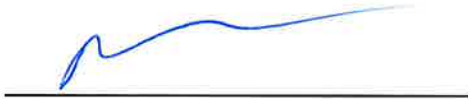
In light of all the foregoing and in accordance with Paragraph 4(a) of the Dispute Resolution Policy, the Panel holds that the Disputed Domain Name "barrisol.com.hk" contains a mark which is identical to the Trade Mark; the Respondent has no right to or legitimate interest in the

Disputed Domain Name; and the Disputed Domain Name was registered and used in bad faith by the Respondent.

Finally, as discussed above, the Complainant is not a Hong Kong company and the Panel has a discretion as to whether the Disputed Domain Name should be transferred or cancelled. Considering the worldwide reputation of the BARRISOL brand and the use of the BARRISOL trade marks by the Complainant, the Panel decides that the domain name "barrisol.com.hk" be transferred to the Complainant or its solicitors in Hong Kong Messrs. Hogan Lovells, so as to avoid a third party registering the Disputed Domain Name for improper purposes.

Dated: 11 September, 2012.

Hong Kong



Peter Bullock