

# HONG KONG INTERNATIONAL ARBITRATION CENTRE

## **.hk Domain Name Dispute Resolution**

### ARBITRATION PANEL DECISION

#### **Case No. DHK-1200085**

---

---

**Complainant:** Salvatore Ferragamo, S.p.A.

**Respondent:** Duan Zuochun

**Case Number:** DHK-1200085

**Domain Name:** <ferragamo.hk>

**Panelist:** M. Scott Donahey

---

---

#### **I. Procedural History**

The complainant in this case is Salvatore Ferragamo, a company organized under the laws of Italy, whose address is Via Mercalli 201 – Osmannoro, 50019 Sesto Fiorentino-Firenze, Italy (“Complainant”). Its authorized representative in these proceedings is IP Gurus, Uttar Pradesh, India.

The respondent is Duan Zuochun, an individual, whose address is not listed in Whois and whose email address is given as King@duan.org.cn (“Respondent”). Complaint, Annex 1. Respondent has not appointed any representative in these proceedings.

The domain name in dispute is <ferragamo.hk>. The Registrar of the domain name is Web Commerce Communications Limited, which is located in Kuala Lumpur, Malaysia (the “Registrar”).

On 17 December 2012, pursuant to the Hong Kong Domain Name Registration Company Limited (“HKDNR”) Domain Name Dispute Resolution Policy (“the Policy”), the HKDNR Domain Name Dispute Resolution Policy Rules of Procedure (“the Rules”) and Hong Kong International Arbitration Centre Supplemental Rules (“the HKIAC Supplemental Rules”), the Complainant submitted a complaint in the English language to the Hong Kong International Arbitration Centre (the “HKIAC”), and elected this case to be dealt with by a one-person panel. On 18 December 2012, the HKIAC sent to the complainant by email an acknowledgement of the receipt of the complaint and reviewed the format of the complaint for compliance with the Policy, the Rules and the HKIAC Supplemental Rules. On the same date the HKIAC sent a copy of the complaint to the Registrar, and requested that the Registrar verify that the Respondent was the registrant of the domain name at issue and that the Registrar confirm the contact details. Also on the same date the Registrar confirmed that the Respondent was the registrant of the domain name at issue. All correspondence to and from the HKIAC described herein was in the English language.

On 24 December 2012 the HKIAC notified the Respondent of the commencement of the action.

On 18 January 2013, the HKIAC notified the Complainant that the Respondent had failed to submit a Response.

Since the Respondent did not file a response in accordance with the time specified in the Rules the HKIAC Supplemental Rules, and the Notification, the HKIAC informed Complainant and Respondent by email about the default, stating that, as Respondent did not file a response within the required time, the HKIAC would appoint the panelist to proceed to render the decision, in the absence of a response by Respondent.

On 25 January 2013, the HKIAC notified the parties that the Panel in this case had been selected, with M. Scott Donahey acting as the sole panelist. The Panel determines that the appointment was made in accordance with the Supplemental Rules. On that same date, the Panel received the file from HKIAC.

## **II. Factual Background**

### *A. For the Complainant*

Complainant is the holder of numerous trademark registrations including Hong Kong trademark registrations for the marks FERRAGAMO and SALVATORE FERRAGAMO and related marks, which marks have been in continuous use in Hong Kong since at least the 1970s. Complaint, Annex 6. Complainant is an Italian fashion house established in Italy in 1927. Complainant is the purveyor of luxury goods. Complainant sells such fashion items as shoes, purses, clothing, glasses, and other fashion accessories for the person and the home. The marks are registered in connection with these types of goods. Complaint, Annex 6. Complainant has advertised the mark extensively. Because of the long history of sales and advertising using the FERRAGAMO mark (Complaint, Annexes 4 and 5), the Complainant is known as the source of the luxury goods associated with the mark to the general public around the world, including in Hong Kong. Complainant currently sells its goods from at least nine outlets in Hong Kong in alone.

Respondent registered the domain name at issue on 20 September 2011. Complaint, Annex 1. Respondent has not used the domain name at issue to resolve to a web site, and when one attempts to access a web site one receives an error message. Complaint, Annex 8

### *B. For the respondent*

Respondent has failed to file a response in this matter.

### **III. Parties' Contentions**

#### *A. The Complainant*

Complainant asserts that the domain name at issue is identical or confusingly similar to Complainant's FERRAGAMO and SALVATORE FERRAGAMO marks, in that the domain name at issue is comprised of the FERRAGAMO mark with the addition of the ccTLD *.hk* and incorporates the FERRAGAMO mark.

Complainant further alleges that Respondent has no rights or legitimate interests in respect of the domain name, and that Respondent's domain name has been registered in bad faith and is being used in bad faith.

#### *B. The Respondent*

The respondent has not filed a response to the allegations.

### **IV. Findings**

#### *A. Respondent in Default*

The Rules, Paragraph 5(e) provides that “[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.

#### *B. The Language of the Proceedings*

Rule 11,a of the *.hk* Procedural Rules provides as follows:

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,

As the domain name is an English *.hk* domain name, and as the Registration Agreement attached as Annex 10 to the Complaint, the Complaint, and the correspondence in the file are all in English, the Panel determines that the language of the arbitration proceedings shall be English.

#### *C. Burden of Proof*

Under paragraph 4(a) of the Policy, Complainant has the burden of proving

- 1) 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
- 2) the Registrant has no rights or legitimate interests in respect of the Domain Name; and
- 3) the Registrant's Domain Name has been registered and is being used in bad faith, and
- 4) 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.

## **V. Analysis**

### *A. Identical or Confusing Similarity*

The Panel finds that the domain name <ferragamo.hk> is identical to Complainant's registered FERRAGAMO marks and is confusingly similar to Complainant's registered SALVATORE FERRAGAMO marks and the related family of marks.

### *B. Rights or Legitimate Interests of the Respondent*

Complainant has in a credible way alleged that Respondent has no rights or legitimate interests in respect of the domain name at issue. Respondent has failed to show that Respondent 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. *Alcoholics Anonymous World Services, Inc. v. Lauren Raymond*, WIPO Case No. D2000-0007; *Ronson Plc v. Unimetal Sanayi ve Tic. A.S.*, WIPO Case No. D2000-0011. Accordingly, the Panel finds that Respondent has no rights or legitimate interests in respect of the domain name.

### *C. Bad Faith*

In the present case, Respondent registered the domain name at issue decades after the trademarks of Complainant had been in continuous use and after Complainant had established outlets and retail stores in Hong Kong, and long after Complainant's marks had attained worldwide notoriety. Granted, Respondent apparently has not used the domain name at issue to resolve to a web site. However, where, as in the present case, Complainant's mark is famous, the domain name at issue is identical to Complainant's mark, and Respondent has failed to respond to Complainant's allegations, under the holding in *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003, this constitutes passive registration and use in bad faith. Accordingly, the Arbitration Panel determines that the domain name at issue was registered and is being used in bad faith.

### *D. Registration Requirements*

Respondent, an individual, has failed to submit any evidence that he is a resident of

HKSAR in the form required by Article 3.5 of the *.hk* Domain Name Registration Policies, Procedures and Guidelines, Version 1.0, effective 22 February 2011.

//

//

## **VI. Decision**

For all of the foregoing reasons, the Panel decides that the domain name registered by Respondent is identical 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 <ferragamo.hk> be transferred to the Complainant.

---

M. Scott Donahey  
Sole Panelist

DATED: 18 February 2013