

**HONG KONG INTERNATIONAL ARBITRATION CENTRE**

**.hk Domain Name Disputed Resolution**

**ARBITRATION PANEL DECISION**

**Case no. DHK-1300090**

---

Complainant : Tommy Bahama Group, Inc.  
Respondent : Xiaole Shen  
Domain Name : <tommybahama.hk>  
Panelist : Gabriela Kennedy

---

**1. The Parties**

The Complainant is Tommy Bahama Group, Inc. of the United States of America ("USA").

The Respondent is Xiaole Shen of the People's Republic of China ("PRC").

**2. The Domain Name and Registrar**

The disputed domain name <tommybahama.hk> (the "Disputed Domain Name" and/or "Website") is registered with Hong Kong Domain Name Registration Company Limited (the "Registrar").

**3. Procedural History**

The Complaint was filed with the Hong Kong International Arbitration Centre (the "Centre") on 16 January 2013. On 17 January 2013, the Centre transmitted by email to the Registrar, a request for registrar verification in connection with the Disputed Domain Name. On the same day, the Registrar transmitted by email to the Centre its verification response confirming that the Respondent is listed as the registrant and providing the contact for the Disputed Domain Name.

On 25 January 2013, the Centre transmitted by email to the Complainant, a request for a copy of the Complaint to be served on the Hong Kong Internet Registration Corporation Limited ("HKIRC") and to indicate whether the Complaint has been served on the Respondent. On 28 January 2013 the Complainant confirmed that a copy of the Complaint and the annexures have been served on the HKIRC and the Respondent.

The Centre verified that the Complaint satisfied the formal requirements of the Domain Name Dispute Resolution Policy for .hk and .香港 domain names (the "Policy") and the Domain Name Dispute Resolution Policy for .hk and .香港 domain names Rules of Procedure (the "Rules").

In accordance paragraphs 2(a) and 4(a) of the Rules, the Centre formally notified the Respondent of the Complaint, and the proceedings commenced on 30 January 2013. In accordance with the Rules, paragraph 5(a), the due date for the Response was 25 February 2013. The Respondent did not submit a formal Response by 25 February 2013.

The Centre appointed Gabriela Kennedy as the sole panelist in this matter on 7 March 2013. The Panel finds that it was properly constituted.

#### **4. Factual Background**

The Complainant is a company based in the USA which, under the "TOMMY BAHAMA" trade mark, has been offering a wide range of goods and services including clothing, furniture, cosmetics, jewellery as well as restaurant services in 7 countries. The Complainant operates over 100 retail stores and 14 restaurants in the USA alone. The "TOMMY BAHAMA" trade mark is registered in 67 countries and in 22 different international classes, with the oldest of those registrations dating back to 1993. In Hong Kong, the Complainant currently has four trade mark registrations for the "TOMMY BAHAMA" trade mark, the earliest registration dating 4 August 1997. The Complainant is also the registrant of a number of gTLDs and ccTLDs including <tommybahama.com> and the <tommybahama.com.hk>, and many other domain names in 30 other country code extensions incorporating the "TOMMY BAHAMA" trade mark.

The Respondent is an individual and has been operating the Website through a corporate alter ego called Best Holding Ltd ("Best Holding"). According to the Complainant's submission, the Respondent, via the Website, has been claiming to be the owner and developer of the "TOMMY BAHAMA" brand ("Representations"). The Disputed Domain Name was registered on 4 May 2012 and resolves to a website used to offer goods such as clothing, cosmetics, accessories and furniture under the "TOMMY BAHAMA" trade mark, being goods similar to those which are sold by the Complainant.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant's contentions can be summarised as follows:

- (a) The Disputed Domain Name is confusingly similar to the Complainant's "TOMMY BAHAMA" trade mark, in which the Complainant has rights:
  - (i) the Complainant is the registered owner of the "TOMMY BAHAMA" trade mark globally, including Hong Kong; and
  - (ii) the Disputed Domain Name is identical to the "TOMMY BAHAMA" trade mark as it incorporates the "TOMMY BAHAMA" trade mark in its entirety.
- (b) The Respondent does not have rights or legitimate interests in the Disputed Domain Name:
  - (i) the Complainant has extensive use of the "TOMMY BAHAMA" trade mark since 1993 and has registered the "TOMMY BAHAMA" trade mark in PRC and Hong Kong in 1997;
  - (ii) through its alter ego Best Holding, the Respondent applied for a Hong Kong trade mark registration over "TOMMY BAHAMA" on 16 May 2012 in classes relating to bags/luggage, goods for infants, toys, food and beverages. This application encountered objection from the Registrar of the Trade Marks office on the basis of similarity to existing trade marks ("Hong Kong Pending Mark");
  - (iii) the Respondent, through Best Holding, also applied for nine PRC trade mark registrations over "TOMMY BAHAMA" in classes relating to bedding,

cosmetics, electronics, bags/luggage, kitchen items, jewellery and accessories, with the earliest date of application being 20 August 2010 ("PRC Pending Marks"). These applications are being opposed by the Complainant;

- (iv) the Respondent does not own any trade marks for "TOMMY BAHAMA", is not commonly known by the name "TOMMY BAHAMA", has not done business under that name and the Complainant has not authorised the Respondent to own or use any domain name incorporating the "TOMMY BAHAMA" trade mark;
  - (v) the Respondent was well aware of the Complainant at the time it registered the Disputed Domain Name as evidenced by the Representations;
  - (vi) the words contained in the "TOMMY BAHAMA" trade mark are not commonly used together and are not descriptive of the goods and services offered under the mark. It is inconceivable that the Respondent could come up with the name "TOMMY BAHAMA" independently without knowing and considering the association with the Complainant;
  - (vii) the Respondent offers goods similar to those sold by the Complainant and applies the "TOMMY BAHAMA" trade mark to those goods which are not genuine "TOMMY BAHAMA" products ("Infringing Goods"); and
  - (viii) the Respondent is intentionally exploiting user confusion by diverting internet users away from the Complainant's website to the Respondent's Website.
- (c) The Disputed Domain Name has been registered and is being used in bad faith:
- (i) the Respondent has offered to sell the PRC Pending Marks to the Complainant for US\$600,000;
  - (ii) the Respondent registered the Disputed Domain Name for commercial gain by attempting to prevent the Complainant from reflecting the "TOMMY BAHAMA" trade mark in a corresponding domain name; and
  - (iii) by registering the Disputed Domain Name and offering the Infringing Goods, the Respondent is aiming to disrupt the business of the Complainant and trade off the reputation of the Complainant.

## **B. Respondent**

The Respondent did not submit a formal Response to the Complainant's contentions.

The fact that the Respondent has not submitted a Response does not automatically result in a decision in favour of the Complainant. However, the failure of the Respondent to file a Response may result in the Panel drawing certain inferences from the Complainant's evidence. The Panel may accept all reasonable and supported allegations and inferences following from the Complaint as true (see *Standard Perpetual Precious Metals Limited v. Jiaren Wu*, HKIAC Case No. DHK-1200080, *Entertainment Shopping AG v. Nischal Soni, Sonik Technologies*, WIPO Case No. D2009-1437 and *Charles Jourdan Holding AG v. AAIM*, WIPO Case No. D2000 0403).

## **6. Discussion and Findings**

According to paragraph 4(a) of the Policy, to succeed in the Complaint, the Complainant has the burden of proving all of the following:

- (a) the Disputed Domain Name is identical or confusingly similar to a trade mark or service mark in Hong Kong in which the Complainant has rights;
- (b) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (c) the Disputed Domain Name has been registered and is being used in bad faith.

#### **A. Identical or Confusingly Similar**

The Panel accepts that the Complainant has rights in respect of the "TOMMY BAHAMA" trade mark on the basis of its various registrations for the trade mark around the world dating from 1993, including a Hong Kong registration since 1997.

It is a well-established rule that in making an enquiry as to whether a trade mark is identical or confusingly similar to a domain name, the domain extension, in this case <.hk> should be disregarded (see *VeriSign, Inc. v. Kristopher Kent Harris*, HKIAC Case No. DHK-0700012 and *Rohde & Schwarz GmbH & Co. KG v. Pertshire Marketing, Ltd*, WIPO Case No. D2006-0767).

The Disputed Domain Name is identical to the "TOMMY BAHAMA" trade mark. The Panel accordingly finds that the Disputed Domain Name is identical or confusingly similar to the "TOMMY BAHAMA" trade mark in which the Complainant has rights, and that paragraph 4(a)(i) of the Policy is satisfied.

#### **B. Rights or Legitimate Interests**

The Panel accepts that the Respondent is not a licensee nor is it associated with the Complainant in any way that could give rise to any licence, permission or other right by which the Respondent could own or legitimately use the Complainant's "TOMMY BAHAMA" trade mark. The Panel further accepts that the Respondent has not become commonly known by the Disputed Domain Name. The Complainant's "TOMMY BAHAMA" trade mark is very well-known and has been used in the USA and elsewhere since 1993, which is well before the registration of the Disputed Domain Name on 4 May 2012. Accordingly, the Panel is of the view that a *prima facie* case is established and it is for the Respondent to prove he has rights or legitimate interests to the Disputed Domain Name. As the Respondent did not submit a Response to the Complainant's contentions, the Panel will assess the case based on the reasonable inferences that can be drawn from the Complainant's evidence.

The Respondent does not appear to have any trade mark rights in respect of the Disputed Domain Name and does not appear to have been commonly known by the Disputed Domain Name. Thus, the only way for the Respondent to acquire rights or legitimate interests in the Disputed Domain Name for the purposes of 4(a)(ii) of the Policy would be through use of the Disputed Domain Name in connection with a *bona fide* offering of goods or services, or for legitimate non-commercial purposes.

Prior panelists have found that there can be no legitimate interest in the sale of counterfeit or infringing goods (*Farouk Systems, Inc. v. QYM*, WIPO Case No. D2009-1572). From the evidence presented by the Complainant, the Respondent has been trading off the goodwill attached to the Complainant's mark by offering the Infringing Goods for sale. This cannot amount to a *bone fide* offering of goods or services nor can it be considered a

legitimate non-commercial fair use of the domain name. Furthermore, the offer of Infringing Goods on the Website will certainly create confusion amongst Internet users as to the origin of the goods offered for sale and sold on the Website, and the Website itself.

The Panel notes that the Respondent currently has a Hong Kong Pending Mark which encountered objection by the Hong Kong Trademarks Registry and nine PRC Pending Marks, which the Complainant is opposing. It is widely accepted that the mere fact a trade mark has been applied for or obtained by a Respondent will not be an absolute bar to the Complainant's action if the application was not made for a legitimate or *bona fide* purpose (*Chemical Works of Gedeon Richter Plc v Covex Farma S.L., WIPO Case No. D2008-1379*). As a result, even if the Hong Kong Pending Mark and PRC Pending Marks were approved by their respective registries (which is unlikely), in the Panel's opinion, the marks were registered in order to seek an unfair advantage of the Complainant's prior "TOMMY BAHAMA" trade mark rights and to legitimize the Respondent's actions by circumventing the Policy. Accordingly, the Respondent's rights or legitimate interests in the Disputed Domain Name have not been established.

Consequently, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy in respect of the Disputed Domain Name.

### **C. Registered and Used in Bad Faith**

Given the Complainant's widely known "TOMMY BAHAMA" trade mark, the Respondent's Representations, and the Respondent's offer of Infringing Goods on the Website, the Panel is satisfied that the Respondent had full knowledge of the fame attached to the Complainant's mark and the Complainant's right to the mark at the time he registered the Disputed Domain Name. In view of the Panel's finding that the Respondent has no rights or legitimate interests in the Disputed Domain Name, it follows that the Disputed Domain Name was registered in bad faith.

The Panel is also of the view that the Respondent registered the Disputed Domain Name solely in an attempt to hijack the Complainant's well-known brand and to trade off the reputation of the Complainant's "TOMMY BAHAMA" trade mark as if it were his own. The Complainant produced evidence of the Respondent stating on the Website that "Best Holding Limited will be re-launching the already established brand TOMMY BAHAMA in China in the near future" and that it is "actively searching for investors for franchising to increase the strength of TOMMY BAHAMA's appeal in China". In the absence of any legitimate interests, the Respondent's use of the Website for the purpose of offering Infringing Goods and for taking over the Complainant's brand, is viewed as an intentional attempt to confuse the consumer as to the origin of the "TOMMY BAHAMA" trade mark for commercial gain.

In addition, during the Complainant's opposition of the Respondent's PRC Pending Marks, the Respondent offered to sell the PRC Pending Marks for no less than US\$600,000. The Panel accepts that this is akin to cases involving domain name registrants offering to sell disputed domain names for an extortionate sum (*The British Broadcasting Corporation v Jaime Renteria* ICANN Case No. D200-0050 and *Drexel University v David Brouda* Case No. D2001-0067). Paragraph 4(b)(i) of the Policy states that a respondent registering a domain name primarily for the purpose of selling the domain name to the complainant for an amount in excess of the respondent's out of pocket costs, is evidence of bad faith (see *Orange Brand Services Limited v. Wang Hui*, HKIAC Case No. DHK-1200078).

Having regard to the above, the Panel finds that the Complainant has satisfied paragraph 4(a)(iii) of the Policy in respect of the Disputed Domain Name.

## **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 be transferred to the Complainant.

**Gabriela Kennedy**

Sole Panelist

Date: 28 March 2013