

.hk Domain Name Dispute Resolution
ARBITRATION PANEL DECISION

Complainants: Guess?, Inc & GUESS? ASIA LIMITED

Respondent: HK HUAKAI SEA TRANSPORTATION LIMITED

Case Number: DHK-1400112

Disputed Domain Name: **guess.com.hk**

Panel Member: Karen Mills, J.D., F.CI Arb, KarimSyah Law Firm, Jakarta.

1. Parties and Disputed Domain Name

The Complainants are Guess?. Inc (hereinafter “**the First Complainant**”) and its Hong Kong subsidiary, Guess Asia Limited (“**the Second Complainant**”). The First Complainant has its registered office at 1444 South Almaeda Street, Los Angeles, California 90021, USA and the Second Complainant has its registered office at 788 Cheung Sha Wan Road, 11/F and Room 2002-5, Laws Commercial Plaza, Cheung Sha Wan, Kownloon, Hong Kong.

The Respondent, HK Huakai Sea Transportation Limited, according to WHOIS’ database has its registered office in Room 2 Unit A 14/f Shun On Comm Bldg 112-114 Des Voeux Rd CE Hong Kong.

2. Procedural History

Complainants filed a Complaint, dated 16 October, 2014, with the Hong Kong International Arbitration Centre (“**the HKIAC**”), through its counsel, Hogan Lovells Hong Kong. On 17 October 2014, the HKIAC transmitted by email to Web Commerce Communications Limited (“**the Registrar**”) for registrar verification

regarding the Disputed Domain Name. On the same date, the HKIAC received the reply from the Registrar in connection with its verification response confirming that the Respondent is listed as the Registrant of the Disputed Domain Name and also providing the contact details of the Respondent. The HKIAC verified that the Complainants satisfied the formal requirements of the Hong Kong Domain Name Registration Company Limited Domain Name Dispute Resolution Policy (“**the Dispute Resolution Policy**”).

On 18 November 2014 the HKIAC appointed Ms. Karen Mills as sole Panelist in this matter, who had, on the same date, confirmed her availability, freedom from conflict and ability to act impartially and independently, and the files related to the case were forwarded to this Panelist by HKIAC on the same date.

The Respondent was allowed 15 (fifteen) business days, from 24 October 2014 to 14 November 2014, by HKIAC to submit its Response but no response was received and thus the matter has been decided upon the submissions of the Complainants only.

3. Factual Background

For the Complainants

1. The First Complainant is officially known as Guess? Inc. a fashion brand company founded in 1981 and originating from the US. The First Complainant operates its business in Hong Kong through a subsidiary, Guess? Asia Limited, the Second Complainant in this case.
2. The First Complainant owns and has registered various trademarks around the world, consisting of the word “Guess”. In Hong Kong, Guess? Inc. has registered its trademarks one year after its establishment in 1981.
3. The First Complainant has been using its trademarks for advertisements of its products for more than 20 years and also has been using the word “Guess” in its website <*guess.com*>.
4. Besides *guess.com*, the First Complainant also owns some other regional domain names under which it operates its websites, such as, inter alia,

<guess.eu> registered since 20 March 2006, <guess.ca> registered since 8 November 2000, <guess.co.au> registered since 18 September 2010 and <guess.asia> registered since 21 November 2007.

According to the WHOIS database, the Disputed Domain Name is registered under the name of the Respondent. The Complainants claim that the Disputed Domain Name is identical or confusingly similar to Complainants' registered trademarks.

For the Respondent

1. The Respondent has not submitted any Response to the Complainants' Complaint within the time frame given by HKIAC.
2. The Complainants allege in the Complaint that, some time in May 2009, the Respondent registered the Disputed Domain Name with Web Commerce Communications Limited.

4. Parties' Contentions

The Complainants

The Complainants' contentions may be summarized as follows:

1. The Disputed Domain Name contains the Complainants' registered and well-known trademark and is thus identical to Complainants' trademark;
2. The Respondent has no right or legitimate interest in the Disputed Domain Name since the Respondent has no license, permission or other rights to use the Complainants' trademarks;
3. The Respondent registered and uses the Disputed Domain Name in bad faith as the Complainants allege that (i) the Guess name and trademark is well known internationally for fashion brands of the Claimant, (ii) the Respondent has intentionally registered the Disputed Domain Name for the purpose to sell the Disputed Domain Name for profit (this is indicated by the email address

for Respondent, as listed on WHOIS, which is “buyname@msn.com”) and (iii) the Disputed Domain Name has never resolved to an active website).

The Respondent

The Respondent did not file any response to Complainants’ Complaint and thus has not provided its own position.

5. Findings

According to Paragraph 4a of the HKDNR Domain Name Dispute Resolution Policy (the "**Policy**"), which is applicable hereto, the Complainants have the burden of proving that:

- (i) the Disputed Domain is identical or confusingly similar to a trade mark or service mark in Hong Kong in which the Complainants has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain; and
- (iii) the Disputed Domain has been registered and is being used in bad faith; and
- (iv) if the Disputed Domain Name is registered by an individual person, the Registrant does not meet the registration requirements for that individual category of Domain Name. (As the registrant of the Disputed Domain Name is no an individual, this is not applicable in this case.)

These elements are discussed below:

(1). Identical/confusing similarity

The Panel has been satisfied by the Complainants’ evidence on the ‘Guess’ trademarks registration, since a trademark registration is a form of *prima facie* evidence of the validity of the trademark (See *National Construction Rentals, Inc v. Toilets.com, Inc WIPO Case No.D2009-0147*). Furthermore, the Panel finds that the Disputed Domain name is clearly contains the full trademark of the Complainants, which is ‘Guess’ and the only difference between the Disputed Domain Name and Complainants’ website is the Country Code Top-Level Domain (ccTLD), which in

this case is <.com.hk>. It is well-established rule that the TLD shall not be counted as distinguishing element in similar or identical Disputed Domain Name (See *Vanguard Group, Inc v. Lorna Kang, Case No. D2002-1064 WIPO Case and A&F Trademark, Inc., Abercrombie & Fitch Stores, Inc., Abercrombie & Fitch Trading Co., Inc. v. Party Night, Inc. Case No. D2003-0172, WIPO Case*). “Guess” is a well known trademark and tradename, which the Complainants have registered widely throughout the world and the name “guess” as used by the Respondent is clearly identical with the Complainants’ trademark protected “guess” or, at the very least, confusingly similar.

The Panel therefore finds that the Disputed Domain Name is Identical/Confusingly similar to the Complainants’ trademarks.

(2). Rights or Legitimate Interests of Respondent

The Complainants have shown that the Respondent has never filed any trademark application in Hong Kong on ‘guess’ trademarks and that the Respondent does not have any relationship with the Complainants. No license or authorization has ever been granted by either of the Complainants to the Respondent to utilise Complainants’ trademarks on its website or for any other purpose. The Complainants have sufficiently provides evidence of of their trademarks and the usage of their trademarks on their products in their business for well more than 20 years.

As the Complainants have proven their rights on their trademarks in *prima facie*, consequently the burden of proof would be shifted to the Respondent to rebut the Complainants’ allegations and show that it has any right or legitimate interest in the Disputed Domain Name. This it has failed to do. Nor has this Panelist seen any indication that the Respondent has used the Disputed Domain Name, nor its base, “Guess”, in any manner whatsoever, other than in registering it with the applicable registrar, which registration is the subject of this dispute.

Since the Respondent did not provide any response, its failure to produce any evidence to establish its rights or legitimate interest leads the Panel to decide the

matter by inferences brought by the Complainant. (See *PepsiCo, Inc. v. Amilcar Perez Lista d/b/a Cybersor Case No. D2003-0174*).

Therefore, the Panel finds that the Respondent has no rights or Legitimate Interest with the Disputed Dispute Name.

(3). Bad faith

Complainant is the owner and operator of a major fashion brand, with thousands of stores around the world and it is inconceivable that the Respondent has not been aware of the Complainants' trademark. Furthermore, the Disputed Domain Name website does not seem have any relevancy with the word 'guess', nor does it directly offer any product or service whatsoever. In visiting the site this Panelist found that the Disputed Domain Name is being used to host only a pay-per-click domain-parking site. The domain parking practice is actually permitted by some UDRP decisions but in a condition where the domain name is registered and originally owned by the owner of the domain-parking site (See *Atos IT Services UK Limited v. Above.com Domain Privacy/ Nish Patel, Case No. D2013-0655 WIPO Case*). It would thus appear that the Respondent is exploiting the Complainants' well known brand name to mislead public to visit its domain-parking site in hopes that some will use it to visit other sites there listed, in order to profit from these "referrals", and, when based on a name which the Respondent has no right to use, such practice constitutes bad faith (See *Paris Hilton v. Deepak Kumar, Case No. D2010-1364 WIPO Case*). More telling is that the email address given by the Respondent in order to contact it is: "buyname@msn.com", certainly indicating that the intention of the Respondent in registering, and using, the Disputed Domain Name, is to try to sell it, either to its rightful owner(s) (Complainants) or to others, where it has no right to do so.

The Panel accordingly finds that the Disputed Domain Name has been registered and used in bad faith.

6. Conclusions

In summary, this Panelist concludes that the Disputed Domain Name, as registered by Respondent, is identical or confusingly similar to the trademarks

and other intellectual property in which the Complainants have rights; the Respondent has no legitimate right nor interest therein; and the said domain name was registered and used by the Respondent in bad faith. Therefore this Panel hereby directs that the Disputed Domain Name be forthwith transferred to the Complainants, or either of them.

A handwritten signature in blue ink, appearing to read "Karen Mills", is positioned above the typed name.

Karen Mills

Sole Panelist

24 November, 2014