

## **ADMINISTRATIVE PANEL DECISION**

OrotonGroup (Australia) Pty Ltd v. Wang TianJin  
Case No. D2022-4725

### **1. The Parties**

The Complainant is OrotonGroup (Australia) Pty Ltd, Australia, represented by Griffith Hack Lawyers, Australia.

The Respondent is Wang TianJin, China.

### **2. The Domain Names and Registrar**

The disputed domain names <orotonbag.com> and <orotonbags.com> (the “Domain Names”) are registered with Hongkong Kouming International Limited (the “Registrar”).

### **3. Procedural History**

The Complaint in English was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 9, 2022. On December 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On December 14, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on December 15, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint in English on December 16, 2022.

On December 15, 2022, the Center sent an email in English and Chinese to the Parties regarding the language of the proceeding. The Complainant confirmed its request that English be the language of the proceeding on December 16, 2022. The Respondent did not comment on the language of the proceeding.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent in English and Chinese of the Complaint, and the proceedings commenced on December 21, 2022. In accordance with

the Rules, paragraph 5, the due date for Response was January 10, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 11, 2023.

The Center appointed Karen Fong as the sole panelist in this matter on January 17, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

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

The Complainant is a design company founded in 1938 and it is today a well-established luxury brand. In the 1980s the company acquired the Polo Ralph Lauren license for Australia and New Zealand and became known as "OrotonGroup". In 1987, the Complainant was listed on the Australian Stock Exchange. As at 2017, the revenue for the Complainant was at AUD 123,205,000.

The Complainant operates a website "www.orothon.com" that is accessible via various domain names including <orothon.com.au>. The Complainant controls several domain names including <orothon.my>, <orothon.kr> and <orothon.cn>.

The Complainant owns numerous trade mark registrations for the trade mark OROTON around the world, such as in China, Australia, New Zealand, the United Kingdom and the United States of America, for example: United Kingdom Trade Mark registration No. 998301, registered on September 13, 1972 (collectively, the 'Trade Mark').

The Respondent registered <orothonbag.com> on December 5, 2022 and <orothonbags.com> on November 28, 2022.

At the time of the Complaint, the disputed domain name <orothonbags.com> redirected to the website at "www.orothonbag.com" (the "Website"). The Website displays the Trade Mark and replicates aspects of the Complainant's official website including text, photographs, colours and layout. The products offered for sale on the Website are the images that appear on the Complainant's website. These products offered for sale on the Website cost much less than the same items on the Complainant's website. At the time of drafting the decision, the Domain Names are inactive.

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

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

The Complainant contends that the Domain Names are confusingly similar to the Trade Mark, that the Respondent has no rights or legitimate interests with respect to the Domain Names, and that the Domain Names were registered and are being used in bad faith. The Complainant requests transfer of the Domain Names to the Complainant.

##### **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

#### **6. Discussion and Findings**

##### **A. General**

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the Domain Names, the Complainant must prove each of the following, namely that:

- (i) The Domain Names are 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 Names; and
- (iii) The Domain Names were registered and are being used in bad faith.

## **B. Language of the Proceeding**

The Rules, paragraph 11(a), provide that unless otherwise agreed by the parties or specified otherwise in the registration agreement, the language of the proceeding shall be the language of the registration agreement, subject to the authority of the panel to determine otherwise, having regard to the circumstances of the administrative proceeding. According to the information received from the Registrar, the language of the Registration Agreement for the Domain Name is Chinese.

The Complainant submits that the language of the proceeding should be English or in both English and Chinese as the Website is in English and the Respondent therefore must be conversant in English.

In exercising its discretion to use a language other than that of the Registration Agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both Parties, taking into account all relevant circumstances of the case, including matters such as the Parties' ability to understand and use the proposed language, time and costs.

The Panel accepts the Complainant's submission regarding the language of the proceeding. The Respondent has not challenged the Complainant's request and in fact has failed to file a response. The Panel is also mindful of the need to ensure the proceeding is conducted in a timely and cost effective manner. In this case, the Complainant may be unduly disadvantaged by having to conduct the proceeding in Chinese. The Panel notes that all of the communications from the Center to the Parties were transmitted in both Chinese and English. In all the circumstances, the Panel determines that English be the language of the proceeding.

## **C. Identical or Confusingly Similar**

The Panel is satisfied that the Complainant has established that it has registered rights to the Trade Mark.

The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the trade mark and the domain name to determine whether the domain name is confusingly similar to the trade mark. The test involves a side-by-side comparison of the domain name and the textual components of the relevant trade mark to assess whether the mark is recognizable within the domain name.

In this case, the Domain Names contain the Complainant's distinctive Trade Mark in its entirety together with the terms "bag" and "bags". The addition of these terms does not prevent a finding of confusing similarity between the Complainant's Trade Mark and the Domain Names. For the purposes of assessing identity and confusing similarity under paragraph 4(a)(i) of the Policy, it is permissible for the Panel to ignore the generic Top-Level Domain ("gTLD") which in this case is ".com". It is viewed as a standard registration requirement (section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))).

The Panel finds that the Domain Names are confusingly similar to the Trade Mark in which the Complainant has rights, and that the requirements of paragraph 4(a)(i) of the Policy therefore are fulfilled.

#### **D. Rights or Legitimate Interests**

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights or legitimate interests in the 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 trade mark 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 trade mark or service mark at issue.

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a domain name, it is well established that, as it is put in section 2.1 of [WIPO Overview 3.0](#), a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent does come forward with relevant evidence of rights or legitimate interests, the panel weighs all the evidence, with the burden of proof always remaining on the complainant.

The Complainant contends that the Respondent has not at any time been commonly known by the Domain Names. Further, the Respondent does not appear to hold any trade mark rights to the Domain Names. The offer for sale of discounted goods which appear to bear the Trade Mark on the Website suggests a connection, sponsorship, or endorsement by the Complainant, when this is not the case, and as such cannot be considered fair legitimate noncommercial use or fair use.

The Panel finds that the Complainant has made out a *prima facie* case, a case calling for an answer from the Respondent. The Respondent has not responded and the Panel is unable to conceive of any basis upon which the Respondent could sensibly be said to have any rights or legitimate interests in respect of the Domain Names.

The Panel notes the lack of any clarifying statement as to the Website's affiliation, or lack thereof, to the Complainant. This further reinforces the Panel's finding that such use cannot constitute fair use. Generally, the act of impersonating or selling heavily discounted goods indicates that the goods are highly likely to be counterfeit goods. Such acts can never confer rights or legitimate interests on a respondent. See section 2.13 of the [WIPO Overview 3.0](#).

The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Names. The fact that the Domain Names do not currently resolve to active websites does not obviate the Panel's finding of lack of rights or legitimate interests.

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

To succeed under the Policy, the Complainant must show that the Domain Names have been both registered and used in bad faith. It is a double requirement.

The Panel is satisfied that the Respondent was aware of the Trade Mark when it registered the Domain Names, given the reputation of the Trade Mark and the fact that it was registered substantially prior to registration of the Domain Names. The very incorporation of the Trade Mark in the Domain Names, use of images bearing the Complainant's goods, the display of the Trade Mark, the copying of sections of texts from the Complainant's website, and the offer for sale of most likely non-genuine OROTON products on the Website, confirm the Respondent's awareness of the Trade Mark. It is therefore implausible that the

Respondent was unaware of the Complainant when it registered the Domain Names.

[WIPO Overview 3.0](#), section 3.2.2, states as follows:

“Noting the near instantaneous and global reach of the Internet and search engines, and particularly in circumstances where the complainant’s mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant’s mark. Further factors including the nature of the domain name, the chosen top-level domain, any use of the domain name, or any respondent pattern, may obviate a respondent’s claim not to have been aware of the complainant’s mark.”

The above together with the fact that there is a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent’s choice of the Domain Names are also significant factors to consider. The Panel finds that the Respondent’s registration is in bad faith.

The Panel also finds that the use of the Domain Names is in bad faith. The products offered for sale on the Website are likely to be counterfeit OROTON products considering the substantial difference in prices and the fact that there is no relationship between the Parties. The use by a respondent of a domain name which includes a well-known trade mark to resolve to a website which offers and sells counterfeit products under that trade mark is evidence of bad faith registration and use. (See *Burberry Limited v. Jonathan Schefren*, WIPO Case No. [D2008-1546](#); and *Prada S.A. v. Domains for Life*, WIPO Case No. [D2004-1019](#)).

The content of the Website is calculated to give the impression that it has been authorized by or connected to the Complainant when this is not the case. The Website was set up to deliberately mislead Internet users that it is connected to, authorised by or affiliated with the Complainant. From the above, the Panel concludes that the Respondent intentionally attempted to attract, for commercial gain, by misleading Internet users into believing that the Respondent’s Website is and the products sold on it are those of or authorised or endorsed by the Complainant.

The Panel therefore concludes that the Domain Names were registered and have been used in bad faith under paragraph 4(b)(iv) of the Policy. The current non-use of the Domain Names does not change the Panel’s finding of the Respondent’s bad faith under paragraph 4(b)(iv) of the Policy.

## 7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Names, <orotonbag.com> and <orotonbags.com>, be transferred to the Complainant.

*/Karen Fong/*

**Karen Fong**

Sole Panelist

Date: January 31, 2023