

## **ADMINISTRATIVE PANEL DECISION**

**Swarovski Aktiengesellschaft v. Liu Chan Yuan**  
**Case No. D2022-0597**

### **1. The Parties**

The Complainant is Swarovski Aktiengesellschaft, Liechtenstein, represented by LegalBase (Pvt) Limited, Sri Lanka.

The Respondent is Liu Chan Yuan, China.

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

The disputed domain name <swarovskistoreonline.com> is registered with Internet Domain Service BS Corp (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on February 21, 2022. On February 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 22, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 of the Complaint, and the proceedings commenced on February 23, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 15, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 16, 2022.

The Center appointed Gareth Dickson as the sole panelist in this matter on March 18, 2022. 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 global jewellery company founded more than 120 years ago in Austria, producing crystal jewellery stones and crystalline jewellery goods amongst other items.

The Complainant is the owner of a number of trade mark registrations for SWAROVSKI (the “Mark”) around the world, including:

- China trade mark registration number 384001, registered on July 30, 1987; and
- United States of America trade mark registration number 1739479, registered on December 15, 1992.

The disputed domain name was registered on December 27, 2020 and currently directs Internet users to a webpage featuring an online shop which purports to offer the Complainant’s products for sale.

#### **5. Parties’ Contentions**

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

The Complainant argues that it has rights in the Mark by virtue of its ownership of various trade mark registrations for the Mark around the world. It contends that the disputed domain name is confusingly similar to the Mark since it incorporates the Mark (which is recognisable within the disputed domain name) with the addition of the descriptive terms “store” and “online”, under the generic Top-Level Domain (“gTLD”) “.com”.

The Complainant confirms that the disputed domain name was registered by the Respondent without its permission and that the Respondent is not a licensee of the Complainant. It alleges that the Respondent has been using the disputed domain name with the intention to divert Internet users to the website for his/her own commercial gain and/or to give the false impression that the website is commercially linked to the Complainant, contrary to the fact and thereby creating a likelihood of confusion with the Mark, with the intention to benefit from the Complainant’s goodwill and reputation.

The Complainant contends that the Respondent is purporting to be an authorized seller of the Complainant’s products, not only by using the disputed domain name, but also by use of other trade marks belonging to the Complainant’s across the website, including its SWAN trade mark.

The Complainant submits that there is no evidence to suggest that the Respondent: has been commonly known by the disputed domain name; is making, or intends to make, a legitimate noncommercial or fair use of it (the services offered on the Respondent’s website, accessible via the disputed domain name, having been commercial in nature); or has ever used or demonstrated preparations to use it in connection with a *bona fide* offering of goods or services.

The Complainant submits that the Respondent must have known of the Complainant and the Mark when he/she registered the disputed domain name. The Mark, according to the Complainant, has acquired distinctiveness and is well known throughout the world. The Respondent’s own use of the disputed domain name (and of the Complainant’s logo on the website) to offer the Complainant’s products for sale further confirms that the Respondent knew of the Mark and the Complainant’s interest in it when he/she registered the disputed domain name and that he/she registered it in bad faith.

Together, the Complainant submits that the Respondent registered and is using the disputed domain name in bad faith.

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

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

## 6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant bears the burden of proving that:

- (a) the disputed domain name is identical or confusingly similar to a trade mark or service mark 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.

These criteria are cumulative. The failure of the Complainant to prove any one of these elements means the Complaint must be denied.

### A. Identical or Confusingly Similar

The Panel accepts that the Complainant is the owner of, and therefore has rights in, the Mark.

Section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") provides that: "[I]n cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."

Section 1.8 of the [WIPO Overview 3.0](#) further provides that: "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element."

The Panel therefore finds that the disputed domain name is confusingly similar to the Mark, since the disputed domain name incorporates the Mark in its entirety. The addition of the phrase "store online" in the disputed domain name does not prevent a finding of confusing similarity, nor does the use of the gTLD ".com".

Accordingly, the Panel finds that the disputed domain name is confusingly similar to a trade mark in which the Complainant has rights.

### B. Rights or Legitimate Interests

Although a complainant is required to demonstrate that a respondent has no rights or legitimate interests in respect of the domain name, as explained in section 2.1 of the [WIPO Overview 3.0](#), the consensus view of previous UDRP panels is that where a complainant establishes a *prima facie* case that the respondent lacks rights or legitimate interests the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The use of a third party's trade mark to offer genuine goods or services can in some circumstances be evidence of a *bona fide* offering of goods and services and thus constitute a right or legitimate interest in a domain name (also see section 2.8.1 of the [WIPO Overview 3.0](#). For the purposes of the Policy, those circumstances have been set out in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) ("*Oki Data*"), which sets out four requirements which must all be met for the use to be considered legitimate.

These requirements may be stated briefly as follows:

- The Respondent must actually be offering the goods or services at issue;
- The Respondent must use the site to sell only the trade marked goods;
- The site must accurately and prominently disclose the Respondent's relationship with the trade mark owner; and
- The Respondent must not try to corner the market in all domain names, thus depriving the trade mark owner of reflecting its own mark in a domain name.

Even assuming that the goods offered by the Respondent via the disputed domain name are genuine goods first put on the market by the Complainant or with its consent, the Respondent cannot benefit from *Oki Data* since the Respondent does not appear to have accurately and prominently disclosed the lack of any relationship between it and the Complainant, notwithstanding that a commercial relationship will be inferred by the Respondent's use of the Complainant's trade mark in the disputed domain name.

The Complainant has also confirmed that the Respondent is not an authorised retailer and there is no association between the Respondent and the Complainant. Such use of the Complainant's Mark in the disputed domain name does not amount to a *bona fide* offering of goods and services nor is it a legitimate noncommercial or fair use of the disputed domain name and, as such, is evidence of the Respondent's bad faith.

In the current proceeding, the Complainant has established its *prima facie* case. The evidence before the Panel is that the Mark is neither generic nor descriptive but enjoys a degree of inherent distinctiveness that makes a coincidental adoption by the Respondent highly unlikely. The Complainant states that it has not given the Respondent permission to use the Mark, in a domain name or otherwise, and submits that the Respondent has not been commonly known by the disputed domain name.

There is no evidence that the Respondent has acquired any common law rights to use the Mark, is commonly known by the Mark or has chosen to use the Mark in the disputed domain name in any descriptive manner or is making any use of the disputed domain name that would establish rights or legitimate interests as a result of a legitimate noncommercial or fair use of it.

By not participating in these proceedings, the Respondent has failed to refute the Complainant's *prima facie* case that it has met its burden under the second UDRP element.

As clearly stated in section 2.1 of the [WIPO Overview 3.0](#), "a panel's assessment will normally be made on the basis of the evidence presented in the complaint and any filed response. The panel may draw inferences from the absence of a response as it considers appropriate, but will weigh all available evidence irrespective of whether a response is filed". Having reviewed and weighed the available evidence, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

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

The Panel notes that the Mark has already been found by previous UDRP panels to be distinctive and to have a reputation, rather than being a descriptive or generic term.

The Panel also notes that the disputed domain name was registered many years after the Mark was registered and that the Complainant has been using the Mark for over 100 years. The Panel therefore accepts that the disputed domain name was chosen by reference to the Mark.

As a result, and in the absence of evidence from the Respondent that the confusing similarity of the disputed domain name to the Mark is coincidental, the Panel must conclude that the Respondent knew of the Complainant's rights in the Mark when he/she registered the disputed domain name.

The Panel therefore finds that the Respondent's registration of the disputed domain name was in bad faith since it attempted to appropriate for the Respondent, without the consent or authorisation of the Complainant, rights in the Complainant's Mark.

The disputed domain name is also being used in bad faith, being used for a commercial purpose that involves using the Mark to redirect Internet users (in particular those seeking the Complainant) to an alternative seller, whilst representing that there is a connection to the Complainant.

Therefore, and on the basis of the information available to it, the Panel finds that the Respondent's use of the Mark in the disputed domain name is without justification and is inconsistent with the Complainant's exclusive rights in the Mark. Consideration of these and other factors militates in favour of a finding of bad faith.

The Panel finds that the Respondent has registered and is using the disputed domain name in bad faith.

## **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 disputed domain name, <swarovskistoreonline.com>, be transferred to the Complainant.

*/Gareth Dickson/*

**Gareth Dickson**

Sole Panelist

Date: April 1, 2022