

## **ADMINISTRATIVE PANEL DECISION**

Swarovski Aktiengesellschaft v. 胡仁武 (Seagull.HU)

Case No. D2022-2193

### **1. The Parties**

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

The Respondent is 胡仁武 (Seagull.HU), China.

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

The disputed domain name <swarovskipen.com> is registered with Alibaba Cloud Computing (Beijing) Co., Ltd. (the "Registrar").

### **3. Procedural History**

The Complaint in English was filed with the WIPO Arbitration and Mediation Center (the "Center") on June 16, 2022. On June 16, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 17, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on June 20, 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 amendment to the Complaint in English on June 22, 2022.

On June 20, 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 June 22, 2022. The Respondent did not comment on the language of the proceeding.

The Center verified that the Complaint together with the amendment to 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 in English and Chinese of the Complaint, and the proceedings commenced on June 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 17, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 18, 2022.

The Center appointed Joseph Simone as the sole panelist in this matter on July 20, 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, Swarovski Aktiengesellschaft, is a leading company in the jewelry industry with more than 120 years of history.

The Swarovski group has 34,500 employees. Its products, which are sold in approximately 170 countries, include, among other things, crystal jewelry stones and crystalline semi-finished goods for the fashion, home accessories, collectibles, and lighting.

The Complainant has an extensive global portfolio of trade marks including the term "swarovski", including the following:

- China Trademark Registration for SWAROVSKI No. 384001 in Class 14, registered on July 30, 1987;
- International Trademark Registration for SWAROVSKI No. 857107 in Classes 2, 3, 6, 8, 9, 11, 14, 16, 18, 19, 20, 21, 24, 25, 26, 28, 34, 35, and 41, registered on November 3, 2004; and
- International Trademark Registration for SWAROVSKI No. 528189 in Classes 8, 9, 11, 14, 18, 21, 25, and 26, registered on September 6, 1988.

The Complainant through its authorized entity owns the domain names <swarovski.com> and <swarovski.net>.

The disputed domain name was registered on July 8, 2019.

According to screenshots provided by the Complainant, at the time of filing the Complaint, the disputed domain name resolved to a website undergoing scheduled maintenance. At the time of this decision, the disputed domain name resolves to an error page provided by the Registrar.

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

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

The Complainant asserts that it has prior rights in the SWAROVSKI trade marks and that it is a leading player in its fields of business.

The Complainant further notes that the disputed domain name registered by the Respondent is identical or confusingly similar to the Complainant's SWAROVSKI trade marks, and the addition of the generic Top-Level Domain ("gTLD") ".com" does not affect the analysis as to whether the disputed domain name is identical or confusingly similar to the Complainant's trade marks.

Meanwhile, the addition of the English dictionary word “pen” is insufficient to distinguish the disputed domain name from the Complainant’s SWAROVSKI trade marks.

The Complainant asserts that it has not authorized the Respondent to use the SWAROVSKI mark, and there is no evidence to suggest that the Respondent has used, or undertaken any demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services.

The Complainant also asserts that there is no evidence suggesting that the Respondent has any connection to the SWAROVSKI mark in any way, and that there is no plausible good faith reason for the Respondent to have registered the disputed domain name, especially considering the relevant circumstances. The Complainant therefore concludes that the registration and any use of the disputed domain name whatsoever must be in bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **A. Language of Proceedings**

In accordance with paragraph 11(a) of the Rules:

“[...] the language of the administrative 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.”

In this case, the language of the Registration Agreement for the disputed domain name is Chinese. Hence, the default language of the proceeding should be Chinese.

However, the Complainant filed the Complaint in English, and requested that English be the language of the proceeding, asserting *inter alia* that:

- the Complainant is not familiar with the Chinese language, and to proceed in the Chinese language the Complainant would have to retain specialized translation services at a cost that is likely to be higher than the overall cost of the present proceeding; and
- the disputed domain name resolves to a website with the following message in English: “Maintenance mode, Sorry for the inconvenience. Our website is currently undergoing scheduled maintenance. Thank you for your understanding.”

The Respondent was notified in both Chinese and English of the language of the proceeding and the Complaint and did not comment on the language of the proceeding or submit any response.

Considering the circumstances in this case, the Panel has determined that the language of the proceeding shall be English, and the Panel has issued this decision in English. The Panel further finds that such determination would not cause any prejudice to either Party and would ensure that the proceeding takes place with due expedition.

### **B. Identical or Confusingly Similar**

The Panel acknowledges that the Complainant has established rights in the SWAROVSKI trade mark in many jurisdictions around the world.

Disregarding the generic Top-Level Domain (“gTLD”) “.com”, the disputed domain name incorporates the Complainant’s trade mark SWAROVSKI in its entirety. Thus, the disputed domain name should be regarded as confusingly similar to the Complainant’s SWAROVSKI trade mark. The additional term “pen” does not prevent a finding of confusing similarity.

The Panel therefore finds that the Complainant has satisfies the requirements of paragraph 4(a)(i) of the Policy in establishing its rights in the SWAROVSKI trade mark and in showing that the disputed domain name is confusingly similar to its mark.

### **C. Rights or Legitimate Interests**

Pursuant to paragraph 4(c) of the Policy, the complainant is required to establish a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such *prima facie* case is made out, the respondent bears the burden of producing evidence in support of its rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant may be deemed to have satisfied paragraph 4(a)(ii) of the Policy. See [WIPO Overview 3.0](#), section 2.1.

The Complainant asserts that it has not authorized the Respondent to use its trade marks and there is no evidence to suggest that the Respondent has used, or undertaken any demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services.

Thus, the Complainant has established its *prima facie* case with satisfactory evidence.

The Respondent did not file a response and has therefore failed to assert factors or put forth evidence to establish that it enjoys rights or legitimate interests in the disputed domain name. As such, the Panel concludes that the Respondent has failed to rebut the Complainant’s *prima facie* showing of the Respondent’s lack of rights or legitimate interests in the disputed domain name, and that none of the circumstances of paragraph 4(c) of the Policy is applicable in this case.

Therefore, there is no evidence adduced to show that the Respondent, prior to the notice of the dispute, has used or has demonstrated its preparation to use the disputed domain name in connection with a *bona fide* offering of goods or services. There is also no evidence adduced to show that the Respondent has been commonly known by the disputed domain name or the Respondent is making a legitimate noncommercial or fair use of the disputed domain name.

Accordingly, and based on the Panel’s findings below, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

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

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular, but without limitation, shall be considered as evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant (the owner of the trade mark or service mark) or to a competitor of that complainant, for valuable consideration in excess of the respondent’s documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the respondent registered the domain name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) circumstances indicating that the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) circumstances indicating that the respondent is using the domain name to intentionally attempt to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on its website or location.

The examples of bad faith registration and use set forth in paragraph 4(b) of the Policy are not meant to be exhaustive of all circumstances in which bad faith may be found. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). The overriding objective of the Policy is to curb the abusive registration of domain names in circumstances where the registrant seeks to profit from and exploit the trade mark of another party. See *Match.com, LP v. Bill Zag and NWLAWS.ORG*, WIPO Case No. [D2004-0230](#).

For reasons discussed under this and the preceding heading, the Panel believes that the Respondent's conduct in this case constitutes bad faith registration and use of the disputed domain name.

When the Respondent registered the disputed domain name, the SWAROVSKI trade marks were already widely known and directly associated with the Complainant's activities. UDRP panels have consistently found that the mere registration of a domain name that is confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely known trade mark by an unaffiliated entity can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

Given the extensive prior use and fame of the Complainant's marks, in the Panel's view, the Respondent should have been aware of the Complainant's marks when registering the disputed domain name.

The Respondent has provided no evidence to justify its choice of the term "swarovski" in the disputed domain name. Moreover, the addition of the dictionary term "pen" directly targets one of the Complainant's fields of business. In light of the foregoing, it would be unreasonable to conclude that the Respondent – at the time of the registration of the disputed domain name – was unaware of the Complainant's trade mark.

The Complainant's registered trade mark rights in SWAROVSKI for its products and services predate the registration date of the disputed domain name. A simple online search (e.g., via Google and Baidu) for the term "swarovski" would have revealed that it is a world-renowned brand.

The Panel is therefore of the view that the Respondent registered the disputed domain name with full knowledge of the Complainant's trade mark rights.

As the disputed domain name has been resolving to an inactive website, it is necessary to consider whether the currently inactive status of the disputed domain name prevents a finding of bad faith under the doctrine of passive holding. The factors usually considered material to such an assessment have been set out in a number of earlier decisions of UDRP panels, including in *Johnson & Johnson v. Daniel Wistbacka*, WIPO Case No. [D2017-0709](#). Each of these considerations points to the Respondent's passive holding of the disputed domain name being in bad faith. Specifically; (i) the Complainant's SWAROVSKI mark is distinctive and well-established, (ii) the Respondent has failed to submit a response to the Complaint or provide any evidence of good-faith use, (iii) the Respondent has provided false or incomplete contact information in light of the courier's inability to deliver the Center's written communication, and (iv) there is no conceivable good faith use to which the disputed domain name could be put by the Respondent.

The Panel therefore finds the Respondent to have registered and used 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 <swarovskipen.com> be transferred to the Complainant.

*/Joseph Simone/*

**Joseph Simone**

Sole Panelist

Date: August 3, 2022