

## **ADMINISTRATIVE PANEL DECISION**

### **Akzo Nobel Coatings International B.V. v. wang gang qiang Case No. D2023-3588**

#### **1. The Parties**

The Complainant is Akzo Nobel Coatings International B.V., Netherlands (Kingdom of the), represented internally.

The Respondent is wang gang qiang, China.

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

The disputed domain name <hk-dulux.com> is registered with Gname.com Pte. Ltd. (the "Registrar").

#### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on August 25, 2023. On August 25, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 28, 2023, 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 (Redacted for privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 1, 2023, 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 September 18, 2023.

On September 1, 2023, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On September 18, 2023, the Complainant submitted a request that English be the language of the proceeding. 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 September 19, 2023. In accordance

with the Rules, paragraph 5, the due date for Response was October 9, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 10, 2023.

The Center appointed Francine Tan as the sole panelist in this matter on October 24, 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, Akzo Nobel Coatings International B.V., is a Dutch multinational company which produces paints and performance coatings. It is headquartered in Amsterdam.

One of the Complainant's main brands is DULUX, which was introduced in 1931 in the United Kingdom. DULUX is now an internationally available brand of paint. The Complainant is the registered owner of numerous trade mark registrations for DULUX / DULUX-formative marks in many jurisdictions. Its trade mark registrations for the mark DULUX include the following:

- China Trade Mark Registration No. 53073, filed on June 15, 1966;
- China Trade Mark Registration No. 1902944, filed on March 14, 2001, registered on August 7, 2002;
- China Trade Mark Registration No. 3278391, filed on August 19, 2002, registered on June 7, 2004;
- China Trade Mark Registration No. 11346741, filed on August 14, 2012, registered on January 14, 2014;
- China Trade Mark Registration No. 11346661, filed on August 14, 2012, registered on January 14, 2014;
- China Trade Mark Registration No. 12262453, filed on March 14, 2013, registered on August 21, 2014;
- Hong Kong, China Trade Mark Registration No. 19350016, filed and registered on July 11, 1934; and
- Hong Kong, China Trade Mark Registration No. 301167660, filed and registered on July 24, 2008.

The Complainant is the registered owner of the domain name <dulux.co.uk>, which has been operating since October 10, 1996.

The disputed domain name was registered on April 26, 2023.

The disputed domain name resolves to a webpage that contains images and video media of explicit and pornographic content.

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

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

The disputed domain name is identical or confusingly similar to the DULUX trade mark in which the Complainant has rights. The disputed domain name incorporates the DULUX trade mark in its entirety, with the addition of the letters and hyphen "hk-", which signifies "Hong Kong".

The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has no *bona fide* reason or evidence in support of its registration of the disputed domain name. It must be concluded that the Respondent had no "fair intention" when registering the disputed domain name.

The disputed domain name was registered and is being used in bad faith. The Respondent is operating a website which damages the Complainant's reputation and goodwill, which it built up over many years under the DULUX trade mark. The Respondent's conduct demonstrates the Respondent's knowledge of the Complainant and its DULUX trade mark.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1. Preliminary Issues**

#### **A. Language of the Proceeding**

The language of the Registration Agreement for the disputed domain name is Chinese. The Complainant requested that the language of the proceeding be English.

The Respondent did not comment on the language of the proceeding.

The Panel notes the following:

- (i) the Complainant is a Dutch company, and is unlikely to be familiar with the Chinese language;
- (ii) the disputed domain name consists of Latin characters rather than Chinese characters;
- (iii) the Respondent was provided with the relevant documents by the Center in both English and Chinese. However, no submissions were received from the Respondent in respect of the language of the proceedings; and
- (iv) requiring the Complaint to be translated into Chinese would result in the proceedings being unduly delayed.

Paragraph 11(a) of the Rules provides that:

"Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, 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 the exercise of the Panel's discretion, having considered the relevant factors and interests of the respective Parties, the Panel determines that it would be appropriate for English be the language of the proceeding. The disputed domain name consists of Latin characters instead of Chinese characters. The Respondent had been notified by the Center, in both Chinese and English, of the commencement of the proceeding, the language of the proceeding, and deadline for filing a Response. The Respondent therefore had the opportunity to object and/or propose to submit its Response in Chinese but did not do so. In the absence of any rebuttal argument or justification therefore by the Respondent, the Panel does not find it procedurally efficient to have the Complainant translate the Complaint into Chinese. There is ultimately nothing before the Panel which merits having the Complainant prepare and file a Chinese translation of the Complaint.

### **6.2 Substantive Issues**

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

The Complainant has established it has rights to the DULUX trade mark. The disputed domain name wholly incorporates the DULUX trade mark, with the addition of the prefix "hk-". It is well established that where the relevant trade mark is recognizable within the domain name in dispute, the addition of other terms (whether descriptive, meaningless, or otherwise) would not prevent a finding of confusing similarity. It is also a well-established principle that the addition and/or omission of hyphens in a domain name in dispute would not prevent a finding of confusing similarity. (See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 1.8.)

It is also well established that the addition of a Top-Level Domain such as “.com” serves a technical function and this element may typically be disregarded when assessing whether a domain name is identical or confusingly similar to a trade mark. (See [WIPO Overview 3.0](#), section 1.11)

The Panel finds that the disputed domain name is confusingly similar to the DULUX mark in which the Complainant has rights.

The Panel accordingly finds that the first element of paragraph 4(a) of the Policy has been satisfied.

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

The Panel finds that the Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant's registered DULUX trade marks predate the registration date of the disputed domain name by many years. The Complainant did not license nor authorize the Respondent to use the DULUX trade mark in a domain name. Neither is there any evidence that the Respondent is commonly known by the disputed domain name.

The disputed domain name contains a well-known trade mark associated with the Complainant and is used for a webpage which displays pornographic content. This fact indicates that the Respondent's basic intention is for commercial gain, to misleadingly divert Internet users and customers looking for the Complainant's goods or services and/or to tarnish the Complainant's DULUX trade mark.

Having established a *prima facie* case, the burden of production shifts to the Respondent to show that it has rights or legitimate interests in the disputed domain name. The Respondent did not file a Response and there is no evidence before the Panel of the existence of any rights or legitimate interests.

In the circumstances, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain name.

The Panel therefore finds that the second element of paragraph 4(a) of the Policy has been satisfied.

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

The Panel is persuaded in the circumstances of this case that the Respondent targeted the Complainant and its well-known DULUX trade mark. There is no other reason for the Respondent to have registered the disputed domain name except for the sole purpose of riding off the reputation and goodwill in the Complainant's DULUX trade mark, and to divert traffic from the Complainant's website to its own webpage.

The Respondent registered the disputed domain name long after the Complainant registered its DULUX trade mark, even in China where the Respondent is located. The Complainant's DULUX trade marks have been registered and used for many years. Given the inherent distinctiveness of the Complainant's DULUX mark and long-established reputation fostered by the Complainant therein, it is not conceivable that the Respondent did not know of the Complainant and its trade mark when it registered the disputed domain name.

The use of the disputed domain name for the offering of pornographic content is clearly intended to attempt to attract, for commercial gain, Internet users to the website by creating a likelihood of confusion with the Complainant's DULUX trade mark. Pursuant to paragraph 4(b)(iv) of the Policy, the Panel concludes that the disputed domain name was registered and is being used in bad faith. The Panel also finds that the use of the disputed domain name tarnishes the Complainant's DULUX trade mark.

The Panel therefore finds that the third element of paragraph 4(a) of the Policy has been satisfied.

## 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 <hk-dulux.com> be transferred to the Complainant.

*/Francine Tan/*

**Francine Tan**

Sole Panelist

Date: October 31, 2023