

ADMINISTRATIVE PANEL DECISION

Case No. DCN-1600676

Complainant: GIGLIO S.P.A.
Respondent: 李黔
Domain Name: <giglio.com.cn>
Registrar: 浙江贰贰网络有限公司

1. Procedural History

On 7 March 2016, the Hong Kong International Arbitration Centre (the "Centre") received the Complaint filed by the Complainant in accordance with the CNNIC ccTLD Dispute Resolution Policy ("CND RP") issued by the China Internet Network Information Center ("CNNIC") and becoming effective on 21 November 2014, the CNNIC ccTLD Dispute Resolution Policy Rules ("CND RP Rules ") issued by the CNNIC and becoming effective on 21 November 2014, and the HKIAC Supplemental Rules to CNNIC ccTLD Dispute Resolution Policy ("Supplemental Rules"), issued by the Hong Kong International Arbitration Centre and becoming effective on 21 November 2014.

On 7 March 2016, 浙江贰贰网络有限公司 ("Registrar") confirmed with the Centre the registration details of the Disputed Domain Name.

On 15 March 2016, the Centre sent the Notice of Commencement of Proceedings to the Respondent informing the Respondent that the proceedings officially commenced and requested the Respondent to reply within 20 days (i.e. on or prior to 5 April 2016).

On 15 March 2016, the Centre forwarded to the Respondent the Complainant's request on the language of the proceedings.

On 14 April 2016, the Centre confirmed receiving no response from the Respondent within the specified time period.

On 20 April 2016, the Centre appointed Mr. Eugene Ito Low as the sole panelist.

Language of the Proceedings

The Complainant requested using English to be the language of the proceedings based on the following reasons: 1) the Disputed Domain Name is registered in ASCII characters using the Roman alphabet; 2) the Respondent is familiar with the English language as he tried to sell the Disputed Domain Name in English and replied to the Complainant's cease and desist letter in English; 3) English language is the language most widely used in international relations and is one of the working languages of the Centre; and 4) the Complainant is

located in Italy and has no knowledge of Chinese; the use of Chinese and any associated translation work in this case would impose a burden on the Complainant.

The Panel finds that the Respondent did reply to the Complainant on one occasion in English which demonstrated its ability to communicate in English. The Respondent was also given the opportunity to respond to the Complainant's language requirement but chose not to make any submissions. With a view to conducting these proceedings on a more cost-effective manner, the Panel decides, as an exception to the general mandate of Article 6 of the CNDRP and Article 8 of the Rules of the CNDRP, that the proceedings shall be conducted in English only.

2. Factual background

For the Complainant

The Complainant, GIGLIO S.P.A., is a company registered under the laws of Italy, and is engaging in ecommerce business worldwide.

For the Respondent

The Respondent is 李黔 with a contact email address 229813393@qq.com.

3. Parties' Contentions

A. Complainant

The Complainant's contentions are extracted as follows:

The Complainant is a company established on November 27, 1970, registered under the laws of Italy. Furthermore, starting from 1996 the Complainant is the owner of the domain name "giglio.com", an international famous ecommerce website selling clothing, shoes and accessories.

I. Identical or Confusing Similarity:

The Disputed Domain Name incorporates the Complainant's trade mark GIGLIO in its entirety. The addition of the gTLD does not impact on the confusing similarity analysis.

The Complainant owns the trademark registrations for "GIGLIO" in China (No. 14610907). Nevertheless the registration date of the trademark is July 21, 2015, which is later than the registration date of the Disputed Domain Name (March 13, 2014). There are CNDRP decision precedents finding that the first element to be satisfied, regardless of the fact that complainant may not have secured a trademark registration in China prior to the domain name being registered. This is because such panels interpret the "civil rights" provision under Article 8.1 of the CNDRP widely. For instance, the civil rights or interests defined in the CNDRP Policy is not limited to the exclusive rights of registered trademarks and the rights of enterprise names - it can also be interpreted as rights defined in the PRC Copyright Law, the

PRC Anti-Unfair Competition Law such as rights arising in unregistered trademarks - See CND RP Case Udacity, Inc. v. 叶林, DCN-1500656 and CND RP Case Giglio S.p.A. v. 林智茂, DCN-1500658. The "GIGLIO" trademark has been registered and used by the Complainant in connection with the company's commercial services for several years, and the mark has acquired extensive goodwill and a substantial reputation worldwide.

The Complainant is using and operating "GIGLIO" as its company name/trade name for a long time, and such use and operation thereof is not only much earlier than the registration of the Disputed Domain Name by the Respondent, but also its use has established a close connection between "GIGLIO" and the Complainant.

The Complainant started his business in the early 1970s and in 1996 on the web, through the international website www.giglio.com.

Therefore, the Complainant can be considered as owning rights to the "GIGLIO" trademark which has been used as its company name/trade name; and such civil rights should be protected under Chinese law, even if the company name/trade name was not registered as a trademark prior to the registration date of the Disputed Domain Name (See CND RP Case Remote Controlled Lighting Limited v. 廣州聚灿照明科技有限公司, DCN- 1500635).

II. Rights or Legitimate Interests of the Respondent:

The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Respondent has no connection with the Complainant, and has not been licensed or authorised by the Complainant to use its trademark in the Disputed Domain Name. Therefore, the Respondent's use of the Disputed Domain Name incorporating the wording is a deliberate attempt to trade off the Complainant's reputation in the "GIGLIO" mark.

The Respondent does not use the Disputed Domain Name with a *bona fide* offering of goods or service. The Disputed Domain Name is offered for sale also through the 4.CN Platform, which proves that the Respondent has no legitimate interest by maintaining the Disputed Domain Name.

III. Bad Faith:

The Respondent had registered and used the Disputed Domain Name in bad faith.

Firstly, a review of the website that the Respondent established for the Disputed Domain Name confirmed that the Respondent's purpose in registering the domain name is to sell or otherwise transfer the domain name registration, since the site resolve an unreachable page, and a website doesn't exist. Furthermore the

Respondent is trying to sell the Disputed Domain Name by direct email contact, asking the price of USD 3,000.00 to unknown to him customer and USD 20,000.00 to the Complainant, as answer to the Cease and Desist letter.

Secondly, the Respondent has a history of registering names or marks in which other persons have legitimate rights and interest as his own domain names with a purpose to prevent the owners of the names or marks from using such names and marks in which they have legitimate rights and interest on the Internet as their domain names. A domain name proprietorship search against the Respondent indicated that the Respondent has engaged in a pattern of conduct in registering numerous domain names for the monetization and/ or cybersquatting purposes. The search as of March 6, 2016 revealed that the Respondent email contact (229813393@qq.com) is associated with 1005 domains. It is practically impossible for any individual to make "a legitimate noncommercial use or fair use of" this high numbers of domain names. As a pattern, it is clear that the Respondent is seeking to profit from and exploit trademarks of another by pre-emptively registering the domain names.

Thirdly, the Respondent registered the domain name for the purpose of damaging the Complainant's reputation, disrupting the Complainant's normal business operation or creating confusion between him and the Complainant to mislead the public. The Respondent registered the Disputed Domain Name in order to prevent the Complainant from reflecting its "GIGLIO" trademark in a corresponding domain name, which eventually disrupted the Complainant's normal business operations.

B. Respondent

The Respondent did not submit any response within the specified time period.

4. Findings

Article 8 of CNDRP provides that a complaint shall be supported if all the following conditions are fulfilled:

- i. The Disputed Domain Name is identical with or confusingly similar to the Complainant's name or mark in which the Complainant has civil rights or interests;
- ii. The Disputed Domain Name holder has no right or legitimate interest in respect of the domain name or a major part of the domain name;
- iii. The Disputed Domain Name holder has registered or has been using the domain name in bad faith.

Article 7 of CNDRP states that the complainant and the respondent shall bear the burden of proof for their own claims.

First element: Identical or Confusing Similarity

The Complainant has submitted a copy of its trade mark registration certificate for the mark "GIGLIO" for China. The Disputed Domain Name <giglio.com.cn> completely incorporates the Complainant's mark "GIGLIO", and the Panel finds them identical or confusingly similar.

The Panel also noticed that the Complainant claimed that it was established in 1970, and started in 1996 operating an international ecommerce website under the domain name "giglio.com".

The Panel noticed that the registration date of the said trademark is 21 July 2015, which is later than the registration date of the Disputed Domain Name (i.e. 13 March 2014). However, this does not per se stop the Panel from finding that the Complainant has the necessary civil rights under the first element. This may however be a potential establishing bad faith registration under the third element of CNDRP which the Panel will address later.

In conclusion, the Panel finds that the Complainant has satisfied Article 8.1 of the CNDRP.

Second element: Rights or Legitimate Interests of the Respondent

The Complainant has confirmed that it has no connection with the Respondent, nor has it licensed or authorised the Respondent to use "GIGLIO" in the Disputed Domain Name.

The Respondent has not filed a response to show to the Panel whether and what rights it has in relation to the Disputed Domain Name.

In the circumstances, the fact that the website associated with the Disputed Domain Name Website is inactive as well as evidence provided by the Complainant that the Disputed Domain Name has been offered for sale through various channels, it is reasonable for the Panel to infer that the Respondent registered the Disputed Domain Name for the sole purpose of seeking profit through sale, and has no legitimate rights in the Disputed Domain Name.

In conclusion, the Panel considers that the Complainant has satisfied Article 8.2 of the CNDRP.

Third element: Bad Faith in Registration or Use

As discussed above, the Disputed Domain Name was registered before the Complainant's registration of the mark "GIGLIO" in China. While the Complainant contends that it has started business and has built up a worldwide reputation before the registration of the Disputed Domain Name, the Panel is unable to conclude that such rights of the Complainant extended into China before the registration of the Disputed Domain Name and to the extent that the registration of the Disputed Domain Name must have been done in bad faith, with awareness of the Complainant's rights in the mark in China.

However, the Panel finds that the Complainant has proved that the Disputed Domain Name has been used in bad faith, in particular that the Respondent had registered the Disputed Domain Name for the purpose of sale, based on the following evidence:

- 1) The Respondent had responded to enquiries to offer for sale the Disputed Domain Name for various amounts, including \$3,000(to an unknown enquirer) and \$20,000 (to the Complainant), apparently all in "dollars" terms;
- 2) Furthermore, the Disputed Domain Name is also listed for sale on a platform called 金名网 (4.cn), which is a domain marketplace;

The Panel is satisfied that the Respondent's passive holding/offer for sale falls within "bad faith", including the conduct as described in Article 9(1) of the CNDRP. There is no evidence put forward by the Respondent to show that the Respondent has put the Disputed Domain Name into actual use other than offering it for sale.

In conclusion, the Panel considers that the Complainant has satisfied Article 8.3 of the CNDRP.

5. Decision

The Panel orders that the Disputed Domain Name <giglio.com.cn> be transferred to the Complainant.

Panelist: Eugene Ito Low
Date: 4 May 2016