ADMINISTRATIVE PANEL DECISION  
Case No. DCN-1700759

Complainant: JLB Brands Ltd  
Respondent: 孙洪洲 (Sun Hong Zhou)  
Domain Name: <oliviaburton.cn>  
Registrar: 易介集团北京有限公司

1. Procedural History

The Complaint was filed with the Hong Kong International Arbitration Centre (“HKIAC”) on 21 July 2017.

On 21 July 2017, the HKIAC acknowledged the Complainant’s Complaint Form (the “Complaint”).

On 21 July 2017, the HKIAC wrote to 浙江贰贰网络有限公司 (the Registrar listed at the Complainant’s Complaint Form) to request the Registrar to verify details of the domain name <oliviaburton.cn> (the “Disputed Domain Name”).

On 21 July 2017, 浙江贰贰网络有限公司 wrote to the HKIAC verifying that 易介集团北京有限公司 shall be the Registrar. On 24 July 2017, 易介集团北京有限公司 (the “Registrar”) wrote to the HKIAC confirming that the Respondent is listed as the registrant of the Disputed Domain Name and provided the Respondent’s contact details.

On 25 July 2017, the HKIAC notified the Complainant on the deficiencies of the Complaint, the Complainant’s Authorized Representative, SILKA Law AB has revised and filed the updated Complaint to the HKIAC on 27 July 2017.

On 27 July 2017, the HKIAC acknowledged that the Complaint satisfies the formal requirements of the China Internet Network Information Center (the “CNNIC”) Domain Name Dispute Resolution Policy (the “Policy”), the Rules of Procedure under the Policy (the “Rules”) and the HKIAC Supplemental Rules (the “Supplemental Rules”) and on 28 July 2017, the HKIAC formally notified the Respondent of the Complaint and requested the Respondent to submit its response to the Complaint in accordance with the Policy, the Rules and the Supplemental Rules on or before 21 August 2017.

On 14 August 2017 the HKIAC wrote to Dr. Timothy Sze enquiring from Dr. Timothy Sze as to whether he is available to act as a Panelist and if so whether he is in a position to act independently and impartially between the Complainant and the Respondent (the “Parties”).

On 14 August 2017, Dr. Timothy Sze wrote to the HKIAC confirming his ability to act.
On 14 August 2017 the HKIAC wrote to the Parties informing the parties that Dr. Timothy Sze (the “Panelist”) has been appointed in accordance with the Policy, the Rules and the Supplemental Rules in respect of the Disputed Domain Name.

The Panelist is of the view that the Panel was properly constituted and that the Panelist has acted impartially in reaching its conclusion.

**Language of the Proceedings**

The Complainant requested using English to be the language of the proceedings based on the following reasons: 1) the Complainant is a British company based in London and conducts its business primarily in English; the Complainant’s authorized representative is a Swedish law firm based in Stockholm; should translation be required, this would lead to undue delay and substantial expense on the part of the Complainant, and would go against the spirit behind the creation of Domain Name Dispute Resolution Service; and 2) no prejudice would be caused to the Respondent in accepting the Complaint in English as the Respondent’s domain name comprise English words, the word “olivia burton” has no literature meaning in Chinese; and 3) the Respondent is operating the website of the Disputed Domain Name in English.

In its email of 28 July 2017, the HKIAC advised the Respondent of the Complainant’s language request and invited the Respondent to submit a response regarding the Complainant’s language request on or before 4 August 2017 for the Panel’s consideration.

On 4 August 2017, the following message was received “按照仲裁規則請使用中文重新發送一份” (translation by the Panel: “Please resend [the Complaint Form] in Chinese language in accordance to the Arbitration rules”) from email address 306050743@qq.com to the HKIAC.

On 15 August 2017, the Panel has issued the Administrative Panel Order Number 1 via the HKIAC to the parties, that 1) the Respondent shall be responsible for the translation and its related expenses of the translation of the Complaint and related appendices; and 2) the deadline for the Respondent to submit its response to the Complaint has been extended to 31 August 2017 [5:00pm]; and 3) if the Respondent has file its response in relation to the matter on hand in Chinese before the deadline, the Panelist shall render his decision in Chinese; if the Respondent has chosen not to take part in these proceedings and the HKIAC has not receive any response from the Respondent on or before the extended deadline, the Panelist shall render his decision in English.

Pursuant to Article 31 of the Rules provides the Panel with a broad discretion with respect to the conduct of the proceedings. It is important to ensure fairness to the Parties and the maintenance of an inexpensive and expeditious process of resolving domain name disputes.

All communications from the HKIAC in these proceedings have been sent to the Parties in both the Chinese and English languages, and the Respondent has been given the opportunity to file submissions in the language of his preference.

Some elements of the Infringing Website are in the English language [the Complainant stated in its Complaint that “while much of the page {Infringing Website} is in Chinese characters, the top of the page is branded with ‘www.oliviaburton.cn’ … and English-
language words are displayed throughout the website"], which demonstrates the likely possibility that the Respondent is proficient in the English language.

The Respondent has chosen not to take part in these proceedings and based on the above circumstances, the Panelist finds it is not foreseeable that the Respondent would be unduly prejudiced, should the language of the proceedings be conducted in English.

Having considered all matters herein, the Panelist determines under paragraph 11(a) of the Rules that the language of the proceedings shall be English.

2. Factual background

A. Complainant

The Complainant, JLB Brands Limited was founded in 2012, Olivia Burton is the accessories brand established by ex-fashion buyers and best friends Jemima and Lesa. Having met on their first day at the London College of Fashion, the best friend duo co-founded Olivia Burton after they struggled to find a watch they wanted to wear. Named after Lesa’s great aunt, who continued to be a constant source of inspiration and support for the young entrepreneurs, the brand went on to launch its first collection with the prestigious Harvey Nichols, resulting in an immediate reaction and an instant sell-out. Overflowing with personality, femininity and timeless charm, Olivia Burton lovingly create all of their designs in their London studio. Combining vintage inspiration with fashion forward trends, each piece embodies the brand’s signature style.

B. Respondent

The Respondent is an individual with an email address of 306050743@qq.com and its registered address is: 江宿运遇宿县塘轨镇镇西组 3 号 (Zip: 223600). The Registrar provides the following telephone number: 15506115888.

C. The Disputed Domain Name

The disputed domain name was registered on 3 March 2016.

D. The website at the Disputed Domain Name

The Dispute Domain Name has been resolved to a parking page and offered for sale (the “Infringing Website”).

3. Parties’ Contentions

A. Complainant

Launched in 2012, Olivia Burton is the accessories brand established by ex-fashion buyers and best friends Jemima and Lesa. Having met on their first day at the London College of Fashion, the best friend duo co-founded Olivia Burton after they struggled to find a watch they wanted to wear. Named after Lesa’s great aunt, who continued to be a constant source of inspiration and support for the young entrepreneurs, the brand went on to launch its first collection with the prestigious Harvey Nichols, resulting in an immediate reaction and an instant sell-out. Overflowing with personality, femininity and timeless charm, Olivia Burton lovingly create all of their designs in their London studio. Combining vintage inspiration with fashion forward trends, each piece embodies the brand’s signature style.
The Complainant’s contentions may be summarized as follows:

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 and interests

OLIVIA BURTON is a trading name of JLB Brands Limited. In China Olivia Burton is sold via http://www.thebeastshop.com/. Complainant also has presence via the Chinese social media site Weibo. Through the official website www.oliviaburton.com, the merchandise is shipped to for example Hong Kong and Taiwan.

Complainant is also active in marketing its time pieces across multiple social media sites such as Facebook, Instagram, Weibo, Tumblr, Twitter, Pinterest, see Annex 4.

<table>
<thead>
<tr>
<th>Platform</th>
<th>Direct link</th>
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<tbody>
<tr>
<td><img src="https://www.facebook.com/OliviaBurtonWatches" alt="Facebook" /></td>
<td><a href="https://www.facebook.com/OliviaBurtonWatches">https://www.facebook.com/OliviaBurtonWatches</a></td>
</tr>
<tr>
<td><img src="https://www.instagram.com/oliviaburtonwatches/" alt="Instagram" /></td>
<td><a href="https://www.instagram.com/oliviaburtonwatches/">https://www.instagram.com/oliviaburtonwatches/</a></td>
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<tr>
<td><img src="https://www.pinterest.com/oliviaburtonldn/" alt="Pinterest" /></td>
<td><a href="https://www.pinterest.com/oliviaburtonldn/">https://www.pinterest.com/oliviaburtonldn/</a></td>
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</tbody>
</table>

Complainant owns several trademarks consisting or containing the word “OLIVIA BURTON” both at an international level, including China where the Respondent resides. “hereinafter referred to as the trademark”, see Annex 5 for trademark extracts.

**Overview of relevant registered trademarks**
<table>
<thead>
<tr>
<th>Trademark</th>
<th>Date of Registration</th>
<th>Registration number</th>
<th>Type of registration</th>
</tr>
</thead>
<tbody>
<tr>
<td>OLIVIA BURTON LONDON</td>
<td>February 12, 2013</td>
<td>1163350</td>
<td>International (designated China)</td>
</tr>
<tr>
<td>OLIVIVA BURTON</td>
<td>October 14, 1998</td>
<td>1214392</td>
<td>Chinese national</td>
</tr>
<tr>
<td>OLIVIA BURTON</td>
<td>July 7, 2015</td>
<td>14580985</td>
<td>Chinese national</td>
</tr>
</tbody>
</table>

Complainant also owns various registrations for domain names that include its registered trademark such as: www.oliviaburton.com, oliviaburton.com.cn, oliviaburton.net.cn, oliviaburton.org.cn, oliviaburton.com.tw, see Annex 6 for a list of sample domain names owned by the Complainant. Complainant uses these domain names to connect to websites through which it informs potential customers about its products.

**Identical or confusingly similar**

The domain name oliviaburton.cn ("hereinafter referred to as the Domain Name") directly and entirely incorporates Complainant’s trademark. The Domain Name would be perceived by internet users as descriptive of a website where they could find information about Complainant’s well-recognized jewellery. See as an example the WIPO Overview on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"), paragraph 1.2., as well as the recent International Business Machines Corporation v. Sledge, Inc. / Frank Sledge WIPO Case No. D2014-0581 where the Panel stated that “In addition, it is generally accepted that the addition of country code top-level suffix in the domain name (e.g., “.cn” and “.com.cn”) are to be disregarded under the confusing similarity test.” Also see HKIAC Case, No. DCN-1500631 Bayer AG v. HUO Gai Zhen where the Panel didn’t elaborate further on the actual .com.cn extension and regarded the disputed domain name to be identical to the Complainant’s mark. Based on the above, the Domain Name is regarded to be identical to Complainant’s registered trademark.

**ii. Holder of the disputed domain name has no legitimate right or interest over the domain name or the major part of the domain name**

Complainant has not found that the Respondent is commonly known by the Domain Name. The WHOIS information is the only evidence in the WHOIS record which relates the Respondent to the Domain Name. It identifies the registrant as 孙洪洲 which is not similar to the Domain Name. The Respondent has not provided Complainant with any evidence of its use of, or demonstrable preparations to use the Domain Name in connection with a bona fide offering of goods or services consistent with having rights or legitimate interest in the name “Olivia Burton”. When entering the terms in Google and Baidu search engine, all of the returned results point to Complainant’s official website and news articles about Complainant’s business activity all around the globe including the Chinese market. The Respondent could easily perform a similar search before registering the Domain Name.
and would have quickly learnt that the trademark is owned by the Complainant and that the Complainant has been using its trademark in China and other countries around the world see Annexes 7.

There is no evidence that the Respondent has a history of using, or preparing to use, the Domain Name in connection with a bona fide offering of goods and services. It is clear that the Complainant has become a distinctive identifier associated with the term “Olivia Burton” and that the intention of the Domain Name is to take advantage of an association with the business of the Complainant.

The website:
The Domain Name is pointing to a website that lists the Domain Name for sale, see Annex 8. Clearly, the Respondent is not known by the Domain Name, nor does the Respondent claim to have made legitimate, non-commercial use of the Domain Name. The Complainant would like to emphasize that the statute of limitations imposed by the China Internet Network Information Centre favours the Respondent. The Domain Name was registered on March 3, 2016 and it can be assumed that the Respondent will continue to passively hold the domain name until March 3, 2018 when the Complainant will be barred from bringing a Complaint under the CNDRP. Once this deadline expires, the Respondent will be in a position to increase the sale’s price further to sell the domain name on the domain aftermarket, leaving Complainant with very little recourse other than to purchase the ransomed Domain Name or undergo the costly and lengthy formalities involved in initiating litigation in China.

All circumstances combined suggests that the Respondent has no legitimate interest in the Domain Name. The registrant’s name 孙洪洲 does not reflect or resemble the Domain Name string. Searches undertaken does not show that the Respondent has any registered trademark rights or company registration in the name Olivia Burton.

iii. The Holder of disputed domain name registers or uses the disputed domain name in bad faith.

Since the registration of the Domain Name the Domain Name has been listed for sale. Compare with HKIAC Case No. DCN-1600677 Boehringer Ingelheim International GmbH v. 杨智 which listed the disputed domain name for sale via the SEDO marketplace. The Panel held that: “In light of the Respondent’s use of the Website in the manner described above, and the offer for sale of the disputed domain name via the SEDO domain marketplace, the Panel finds the requisite element of bad faith has been satisfied, under Article 9 of the Policy.” The same argumentation is applicable in the present case.

In the current case it is clear that the Respondent has registered the Domain Name in bad faith by intentionally adopting Complainant’s widely known marks in violation of Complainant’s rights. Panels have found that the apparent lack of so-called active use (e.g., to resolve to a website) of the domain name without any active attempt to sell or to contact the trademark holder (passive holding), does not as such prevent a finding of bad faith, but all circumstances of the case must be examined to determine whether the Respondent is acting in bad faith. In the current case, examples of what may be cumulative circumstances found to be indicative of bad faith include the Complainant having a well-known trademark that predates the registration of the Domain Name. It would not be reasonable to expect the Complainant to wait until the Domain Name is being ‘actively used’ to cause significant damage to its brand in order to fulfill the bad faith use requirement; such an interpretation
would go against the interpretations of the policy. Therefore, Complainant avers that regardless of the fact that the Domain Name is currently not in use, the circumstances surrounding this inaction is equivalent to passive holding constituting use of the domain name in bad faith (See; Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003).

To summarize, the confusingly similar nature of the Domain Name to the Complainant's trademark, the purpose of preventing the Complainant from reflecting the mark in corresponding Domain Name under the ccTLD .cn further demonstrates lack of good faith. In addition, Respondent has had ample time to activate the Domain Name to demonstrate that the use would not constitute bad faith use. Such has not occurred. Finally, Complainant's international and Chinese trademark registrations predate Respondents Domain Name registration and it is highly unlikely that the Respondent was not aware of the rights Complainant has in the trademarks and the value of said trademarks, at the point of the registration. Consequently, the Respondent should be considered to have registered and to be using the Domain Name in bad faith.

B. Respondent

The Respondent did not file any response to the Complainant’s contentions.

All the Respondent said in his email messages to the HKIAC is as follows:

On 4 August 2017, the following message was received "按照仲裁規則請使用中文重新發送一份" (translation by the Panel: "Please resend [the Complaint Form] in Chinese language in accordance to the Arbitration rules") from email address 306050743@qq.com to the HKIAC.

On 16 August 2017, the following message was received “这个并非我们授权和委托的” (translation by the Panel: "We [the Respondent] has not agreed to nor authorized anyone to negotiate nor discuss [a settlement with the Complainant]") from email address 306050743@qq.com to the HKIAC.

4. Findings

Article 8 of CNDRP provides that a complaint against a registered domain name shall be supported if 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 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. With reference to the complaint and the attached documents, the Panel of this case considers that:-
Identical or Confusing Similarity

The Complainant has rights in “Olivia Burton” (the “Trade Mark”) acquired through use and registration which incidentally predates that date of registration of the Disputed Domain Name [3 March 2016]. As numerous administrative panels have recognized that “the incorporation of a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to the complainant’s registered mark” [see Rolex Watch U.S.A., Inc v. Spider Webs Ltd., WIPO Case No. D2001-0398 dated 2 July, 2001]. The Disputed Domain Name is identical to the Trade Mark and the Respondent is taking advantage of internet users’ interest by capitalizing on a trademark owner’s goodwill in its mark for the purpose of diverting internet traffic to the Infringing Website thus disrupting the Complainant’s business [see TracFone Wireless, Inc. v. PIPHY Productions, WIPO Case No. D2006-1459 dated 18 January, 2007].

The Panelist therefore holds that the Complaint fulfills the first condition of Article 8 of the Policy.

Rights or Legitimate Interests of the Respondent

Article 10 of the Policy provides a list of non-exhaustive circumstances any of which is sufficient to demonstrate that a Respondent has rights or legitimate interest in the Disputed Domain Name:

(i) Before any notice to the Respondent 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 (as an individual, business, or other organization) has been commonly known by the domain name even if the Respondent has acquired no trade mark or service mark rights; or
(iii) The Respondent is making a legitimate non-commercial 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.

From the Complaint, there is no evidence shown that the Complainant had authorized, licensed, or permitted the Respondent to register or use the Disputed Domain Name or to use the Trade Mark. As mentioned above the Complainant had prior rights in the Trade Mark which precedes the Respondent’s registration [3 March 2016] of the Disputed Domain Name.

There is also no evidence to show that the Respondent is or has ever been commonly known by the Trade Mark [see LEGO Hong Kong Limited v. ITRAVEL Limited, HKIAC Case No. DHK-1400110; WhatsApp Inc. v. T Lam, HKIAC Case No. DHK-1300100 and Conair Corp. v. Tom Lee CCTV Limited, HKIAC Case No. DHK-1400108].

In fact the Respondent is not making a protected non-commercial or fair use of the Disputed Domain Name and this may give the impression that the Respondent is not operating any bona fide or legitimate business which may give it rights in the Disputed Domain Name. By incorporating the Complainant’s Trade Mark into its Uniform Resource Locator (commonly known as “URL”), the Respondent uses the Disputed Domain Name to
mislead and divert internet users which may in the long term tarnish the Trade mark of the Complainant, which the Complainant has over the years developed considerable goodwill.

From the above, there is a strong *prima facie* case that the Respondent has no rights or legitimate interest in the Disputed Domain Name and the burden is thus on the Respondent to produce evidence to rebut this presumption.

Given that the Respondent failed to submit a response, as such the Respondent has failed to show that it has acquired any Trade Mark rights in respect of the Disputed Domain name or that the Disputed Domain Name is used in connection with a *bona fide* offering of goods or services. To the contrary, there has been no evidence adduced to show that the Respondent is making a legitimate non-commercial or fair use of the Disputed Domain Name.

As such, the Panelist finds that the Complaint fulfils second condition of Article 8 of the Policy.

**Bad Faith**

Under Article 9 of the Policy, any of the following circumstances may amount to evidence of the registration and use of a domain name in bad faith:

(i) The Disputed Domain Name holder has registered or acquired the domain name for the purpose of selling, renting or otherwise transferring the domain name to obtain unjustified benefits;

(ii) The Disputed Domain Name holder registered the domain name in order to prevent the owners of the name or mark from reflecting the name or the mark in a corresponding domain name, provided that the domain name holder has been engaged in a pattern of such conduct;

(iii) The Disputed Domain Name holder has registered or acquired the domain name for the purpose of damaging the Complainant’s reputation, disrupting the Complainant’s normal business or creating confusion with the Complainant’s name or mark so as to mislead the public;

(iv) Other circumstances which may prove the bad faith.

It is well settled among administrative panels that the Respondent’s method of infringement, through the use of the Complainant’s exact Trade Mark to attract internet users to its Infringing Website demonstrates bad faith use under the Policy [see *Popular Enters., LLC v. Am. Consumers First et al.*, WIPO Case No. D2003-0742 and *Ameriquest Mortgage Co. v. Phayze Inc.*, WIPO Case No. D2002-0861].

The Respondent’s actions will have a significant impact on the Complainant’s Trade Mark, as the use of the Disputed Domain Name for the purpose of selling would directly harm the reputation and goodwill of the Complainant which in turn will affect its business development in the long term.

Also the Respondent has not provided full contact information on the CNNIC Whois database. By supplying incomplete or misleading contact information on a Whois database is further evidence of bad faith registration [see *Maxtor Corp. v. Shenyang Shixin Co., Ltd.*, 

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HKIAC Case No. DCN-0300001 and *Home Dir., Inc. v. HomeDirector*, WIPO Case No. D2000-0111].

In light of the Respondent’s use of the Infringing Website in the manner described above, and the offer for sale of the Disputed Domain Name via the Infringing Website, the Panelist finds the requisite element of bad faith has been satisfied, under Article 9 of the Policy.

5. **Decision**

For all the foregoing reasons, in accordance with Article 14 of the Policy and Article 37 of the Rules, the Panelist orders that the Disputed Domain Name <oliviaburton.cn> be transferred to the Complainant.

Panelist: Timothy Sze

Date: 18 September, 2017