Complainant: ESMOD  
Respondent: DOMSON DOMSON  
Case Number: DHK-1000063  
Contested Domain Name: <ESMOD.HK>  
Sole Panellist: Vivien Chan

1. Parties and Contested Domain Name

The Complainant is a fashion design school originally founded in 1841 in France and now has a network of 20 schools around the world including Beijing, Lyon, Paris, Tokyo...etc.

The Respondent is the registered holder to the domain name ESMOD.HK as indentified by the record of HKDNR’s WHOIS function at http://www.hkdnr.hk as stipulated and marked “A” to the list of supporting documents attached to Form A of the Complaint.

The domain name under dispute is <ESMOD.HK> (“Disputed Domain”).

2. Procedural History

a) On 21 December 2010, agent for the Complainant filed the Complaint (in English) with the Hong Kong International Arbitration Centre (“HKIAC”);

b) The Panel was informed by HKIAC that it has duly requested the relevant domain registry to confirm that the Respondent was the Registrant of the Disputed Domain and for other factual information. Further, upon checking with the domain name registry, the application to register the Disputed Domain was filed in Chinese and the Complaint shall be filed in Chinese;

c) HKIAC then informed the Complainant to file the Chinese translation of the Complaint with HKIAC;

d) Subsequently on 6 January 2011, agent for the Complainant filed the Chinese translation of the Complaint with HKIAC, which was served to the Respondent by HKIAC by email on the same day. HKIAC has indicated to the Respondent that it had 15 business days to file a response.;

e) On 9 February 2011, the HKIAC appointed Vivien Chan to serve as the Sole Panellist (“the Panel”) in this case having received the appropriate declarations of independence and no conflict to act;

f) The Panel made the following directions on 28 February 2011, which was
distributed by HKIAC to both parties on 1 March 2011, that:

i. to facilitate the parties, the language of proceedings shall be in English and a decision will therefore be made in English ("Language of Proceedings");

ii. the Panel noticed that apart from a copy of decision of ADNDRC Case No. CN-10000369 marked “B” in Chinese (being item 6 of the List of supporting documents), the Complainant did not file any evidence in proofing the Complainant’s use of the mark “ESMOD”, in Hong Kong or elsewhere. The Panel then offered the Complainant an opportunity to submit the evidence of use of the mark “ESMCD” for consideration, if the Complainant considered it necessary;

iii. if the parties disagreed with the Language of Proceedings, or if the Complainant would like the Panel to consider the extent of use of the mark “ESMOD”, it should reply before 14 March 2011. At the time of filing the evidence, a copy of such evidence (if any) shall be sent to the Respondent for reply within 14 days upon receipt of such documents.

iv. The Panel reserved to deliver the Decision upon receipt of the further evidence, if any, from both parties.

g) On 14 March 2011, the Complainant filed a reply and the supplemental evidence with the HKIAC, which was then forwarded to the Panel and the Respondent on the same day.

h) The Respondent did not file any reply or evidence in this case.

3. Evidence submitted

The Panel has considered the following evidence in this case:

a) the Form A (Complaint in accordance with the HKIAC Supplemental Rules) and the enclosures filed by the Complainant;

b) Printouts of Google search result showing information relating to the Complainant;

c) Magazines and newspaper cuttings;

d) An admission letter and a photograph taken at a signing ceremony in China;

e) Search report conducted at the National Library of China; and


4. Factual Background
a) The Complainant owns a trademark registration for “ESMOD” under Registration No. 300439687 in Hong Kong, with a registration date of 15 June 2005. The said registration covers the following services:
   “Class 41
   Teaching, education, day and evening classes, correspondence courses and training; all provided for designers, semi-skilled worker in interfacing clothes, pattern makers, pattern designers and cutters and all relating to specialities relating to seaming, technical and artistic teaching schools; publishing.”

b) The Disputed Domain was registered on 16 September 2010.

5. Parties' Contentions

The Complainant

a) The Complainant alleges that the Disputed Domain, i.e. ESMOD is identical or confusingly similar to the trademark which the Complainant has secured registration. Apart from the suffix “.hk”, it is identical to the ESMOD word mark held by the Complainant in Hong Kong.

b) The Complainant has a long history of use of the ESMOD trademark as the name of its design school, originally in France, and now has 20 schools around the world including Beijing, Lyon, Paris, Tokyo...etc.

c) The Complainant has also submitted evidence including the certificate of incorporation of the Complainant, being the same owner to the trademark Registration No. 300439687 in Hong Kong. The Complainant has also submitted evidence to prove that

- it has secured registration of the mark ESMOD as a trademark in many jurisdictions by international registration or national registration;
- when conducting searches at the internet search engines, such as google, the results of ESMOD” link to the Complainant;
- it has maintained an official website as www.esmod.com for its school in France, and www.ESMODBeijing.com for its school in Beijing.

d) Although the Complainant did not produce evidence to prove use or fame of its mark in Hong Kong per se, the Complainant has used the mark by setting up a
school in many countries nearby to Hong Kong, such as Beijing and Tokyo and there were a lot of publicity regarding the school in Beijing.

e) The Panel is satisfied that the Complainant is the first fashion school established in France, and founded in 1841 (http://en.wikipedia.org/wiki/Esmod). From the evidence supplied by the Complainant, it has acquired distinctiveness in the mark ESMOD through its long and/or extensive use so that the mark is recognizable to consumers as being associated with the Complainant and its business.

f) The Respondent did not file any reply or evidence to rebut the Complainant’s complaints. The Respondent has no registered trade mark rights which reflect the Disputed Domain, nor does the Disputed Domain reflect the Respondent’s name. There is no evidence before the Panel showing any possible means by which the Respondent has used the Disputed Domain. There is also no evidence before the Panel regarding the place of domicile of the Respondent, and/or whether the Respondent has actual knowledge of the presence of the Complainant or its trademark registrations for ESMOD. There is also no evidence showing the reasons why the Disputed Domain is being chosen by the Respondent.

g) As to the Complainant’s allegations that the Respondent was acting in bad faith (as mentioned in Paragraph 3 of Schedule Two attached to the Complaint), the Panel finds that there is no direct evidence to prove such allegations.

h) However, the absence of response from the Respondent is not fatal for the Panel to make a decision of the dispute in this nature.

i) The Respondent did not provide proof that the Disputed Domain is being used by it at all, or any proof of the Respondent’s intention to use the Disputed Domain genuinely and in good faith at this moment;

j) By virtue of Clause 3.6 (a) of the Registration Agreement, the Respondent has warranted that the use of the Disputed Domain will not infringe or otherwise violates the trademark rights of other third party. Although the Complainant has used the mark ESMOD as a design school and in providing training, education to designers or semi-skilled worker in interfacing clothes ... etc., the Disputed Domain is identical to the mark of the Complainant.
The Panel will not be able to comment on whether the two kinds of goods/services used by the Complainant and by the Respondent, if any, are similar to each other without taking into account the specific mode of operation and the extent of use by each party. In the Panel’s view, a board and generic approach will be adopted in Hong Kong in deterring similarity and confusion, based on the basic principles as set out in the classical cases of Sabel BV v Puma AG [1998] R.P.C. 199, Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] R.P.C. 117 and adopted, in Guccio Gucci SpA v Gucci [2009] 5 HKLRD 28. In particular, the Panel found in this particular case that:

i. The likelihood of confusion must be appreciated globally, taking account of all the relevant factors.

ii. The matter must be judged through the eyes of the average consumer of the goods in issue, who is deemed to be reasonably well informed and reasonably observant and circumspect.

iii. In order to assess the degree of similarity between the marks concerned one must determine the degree of visual, aural or conceptual similarity between them and, where appropriate, evaluate the importance to be attached to those different elements taking into account the nature of the goods in question and the circumstances in which they are marketed.

iv. The visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components. The perception of the marks in the mind of the average consumer plays a decisive role in the overall appreciation of the likelihood of confusion.

v. There is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it.

vi. Appreciation of the likelihood of confusion depends upon the degree of similarity between the goods. A lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa.
vii. Mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purpose of the assessment. But the risk that the public might believe that the respective goods come from the same or economically linked undertakings does constitute a likelihood of confusion within the meaning of the section.

**The Respondent**

The Respondent did not file any response or evidence in this case.

(k) Based on the evidence available to the Panel now, the Panel is of the view that the use of the Disputed Domain by the Respondent will likely cause confusion among the consumers as to the origin of goods or services. The Respondent has not proved its case to the contrary. The use, if any, of the Disputed Domain by the Respondent will likely violate the trademark rights of the Complainant.

6. Conclusions

(a). Identical/confusing similarity
The Complainant registered the trademark ESMOD in Hong Kong on 15th June 2005 with a registration number 300439687. That registration is currently valid. The Disputed Domain reproduces the Complainant’s trademark with only the necessary addition of the suffix “.hk”. The Panel agrees that the Disputed Domain is confusingly similar to the Complainant’s trademark, under the Policy and is confusingly similar to the trademark ESMOD owned by the Complainant in Hong Kong.

(b). Rights or Legitimate Interests of Respondent
The Respondent did not file any reply or evidence within the stipulated time.

(c). Bad faith
The Complainant’s trademark ESMOD was registered and widely known in many places, and through the internet, the website and news about the ESMOD mark can be accessible by users in Hong Kong. The Respondent has not provided any justifiable to reasons to convince the Panel that why it has any legitimate right to use the Disputed Domain.

7. Decision
The Complainant has proved its case. It has a registered Hong Kong trademark in ESMOD, and the Dispute Domain is identical and confusing similar to it. The Respondent has shown no rights or legitimate interest in the name. It is concluded that the registration of the Dispute Domain by the Respondent will dilute the goodwill in ESMOD and will cause damage to the Complainant, and that the Respondent registered the Disputed Domain in bad faith.

For all the above reasons, the Panel orders that the Disputed Domain <ESMOD.HK> be transferred to the Complainant.

Dated 7th April 2011

Vivien Chan
Sole Panellist

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