

ADMINISTRATIVE PANEL DECISION

ONO International Limited and Annoushka Limited v. Ning Shi
Case No. D2022-3301

1. The Parties

The Complainants are ONO International Limited, United Kingdom (the “First Complainant”); and Annoushka Limited, United Kingdom (the “Second Complainant”), represented by Lewis Silkin LLP, United Kingdom.

The Respondent is Ning Shi, China.

2. The Domain Name and Registrar

The disputed domain name <annoushka.com> (the “Disputed Domain Name”) is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 5, 2022. On September 6, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On September 8, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 of the Complaint, and the proceedings commenced on September 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 5, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 6, 2022.

The Center appointed Flip Jan Claude Petillion as the sole panelist in this matter on October 10, 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

ONO International Limited, the First Complainant, is the holding company of Annoushka Limited, the Second Complainant, which manufactures and sells fine jewellery.

The First Complainant is the owner of several trademarks consisting of the sign ANNOUSHKA, such as the following:

- ANNOUSHKA, United Kingdom word mark registered with the United Kingdom Intellectual Property Office (“UKIPO”) on November 26, 2008, under number UK00904215596 in classes 14 and 18;

- ANNOUSHKA, European Union word mark registered with the European Union Intellectual Property Office (“EUIPO”) on November 26, 2008, under number 004215596 in classes 14 and 18.

The Disputed Domain Name was registered on May 11, 2022, and resolves to a website which appears to offer products identical or at least similar to the products manufactured and sold by the Second Complainant.

5. Parties’ Contentions

A. Complainant

The Complainants consider the Disputed Domain Name to be confusingly similar to a trademark in which they claim to have rights.

The Complainants further claim that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. So far as the Complainants are aware, the Respondent does not own any registered rights in any trademarks which comprise part or all of the Disputed Domain Name. The Complainants claim that they did not give their consent for the Respondent to use their mark in the Disputed Domain Name, and that the Respondent is not commonly known by the Disputed Domain Name. Also, according to the Complainants, the use of the Disputed Domain Name to advertise and sell counterfeit goods cannot constitute a legitimate noncommercial interest in the Disputed Domain Name, nor can it constitute use of the Disputed Domain Name in connection with a *bona fide* offering of goods. The Complainants also claim that the Disputed Domain Name triggers a clear inference of affiliation to the Complainants’ marks.

Finally, the Complainants claim that the Disputed Domain Name was registered and is being used in bad faith. According to the Complainants, the Respondent was aware of the reputation of the Complainants’ business under the ANNOUSHKA trademark when the Disputed Domain Name was registered. The Complainants contend that the Respondent has used the Disputed Domain Name in bad faith insofar as until at least September 5, 2022, it pointed to a website that is used to intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainants’ mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website and / or of products on the Respondent’s website.

B. Respondent

The Respondent did not reply to the Complainants’ contentions.

6. Discussion and Findings

6.1. Preliminary Procedural Issue: Multiple Complainants

In the present case, the Complaint was filed by two Complainants. While the Policy and Rules do not directly contemplate the consolidation of multiple complainants in a single administrative complaint, numerous panels have found that in certain circumstances such a consolidation may be permitted.

In assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation (see section 4.11.1 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

In the case at hand, the Complainants claim that the First Complainant is the (IP) holding company of the Second Complainant and that the Respondent's registration and use of the Disputed Domain Name in bad faith affects the Complainants equally. This claim has not been contested and the Panel finds that the link between both Complainants can also be inferred from the evidence provided, albeit indirectly.

The Panel therefore finds that it is sufficiently established that the Complainants have a specific common grievance against the Respondent and that it would be equitable and procedurally efficient to consolidate the Complainants.

6.2. Substantive elements of the Policy

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

The onus is on the Complainants to make out their case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainants must show that all three elements set out in paragraph 4(a) of the Policy have been established before any order can be made to transfer the Disputed Domain Name. The standard of proof is the balance of probabilities.

Thus, for the Complainants to succeed they must prove, within the meaning of paragraph 4(a) of the Policy, that:

- (i) The Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainants have rights; and
- (ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (iii) The Disputed Domain Name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements.

A. Identical or Confusingly Similar

To prove this element, the Complainants must first establish that there is a trademark or service mark in which they have rights. The First Complainant has clearly established that it has trademark rights in the sign ANNOUSHKA. The First Complainant's ANNOUSHKA trademark has been registered and extensively used in connection to the Second Complainant's jewellery business.

A trademark owner's affiliate such as a subsidiary of a parent or of a holding company, or an exclusive trademark licensee, is considered to have rights in a trademark under the UDRP for purposes of standing to file a complaint (see section 1.4 of the [WIPO Overview 3.0](#)). The Panel therefore finds that both

Complainants established trademark rights in the ANNOUSHKA trademark for purposes of standing to file the Complaint.

The Disputed Domain Name incorporates the Complainants' ANNOUSHKA trademark in its entirety, merely adding the word "shop".

As stated at section 1.8 of the [WIPO overview 3.0](#), where the relevant trademark is recognizable within the Disputed Domain Name, the addition of other terms would not prevent a finding of confusing similarity. In this case, the Panel finds that the confusing similarity is obvious as the addition of this one word does not prevent the Complainants' ANNOUSHKA trademark from being recognizable within the Disputed Domain Name.

Additionally, it is well established that the generic Top-Level Domain ("gTLD") ".com" may be disregarded when considering whether the Disputed Domain Name is confusingly similar to a trademark in which the Complainants have rights.

In light of the above, the Panel considers the Disputed Domain Name to be confusingly similar to the Complainants' ANNOUSHKA trademark.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainants have the burden of establishing that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

As established by previous UDRP panels, it is sufficient for the Complainants to make a *prima facie* showing that the Respondent has no rights or legitimate interests in the Disputed Domain Name in order to place the burden of production on the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)).

The Panel observes that the Respondent does not appear to be commonly known by the Disputed Domain Name and that the Respondent does not seem to have acquired trademark or service mark rights (there being no Response or evidence of any such rights). According to the information confirmed by the Registrar, the Respondent is named "Ning Shi". There are no indications that a connection between the Complainants and the Respondent exists or existed.

Where a domain name consists of a trademark plus an additional term, UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner (see section 2.5.1 of the [WIPO Overview 3.0](#)). The Disputed Domain Name matches the Complainants' ANNOUSHKA trademark except for the addition of the word "shop", which can be easily linked to the Second Complainant's retail business. Therefore, the Panel finds that the Disputed Domain Name carries a risk of implied affiliation with the Complainants and cannot constitute fair use, especially given the circumstances of this case as further explained below.

Beyond looking at the domain name and the nature of any additional terms appended to it, UDRP panels assess whether the overall facts and circumstances of the case, such as the content of the website linked to the disputed domain name and the absence of a response, support a fair use or not (see sections 2.5.2 and 2.5.3 of the [WIPO Overview 3.0](#)).

The Disputed Domain Name appears to refer to a website purporting to sell products identical or at least similar to the Complainants' products at discounted prices. The Panel observes that the Complainants' mark is mentioned numerous times on this website, including on the products depicted. The website linked to the Disputed Domain Name even includes product pictures copying the stylized version of the Complainants' mark as used on the Complainants' official products. Moreover, the website does not accurately and prominently disclose the Respondent's relationship with the Complainants. The Panel finds that the above elements are clear indications of illegal activity using the Disputed Domain Name. UDRP panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods,

phishing, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent (see section 2.13 of the [WIPO Overview 3.0](#)).

The Respondent had the opportunity to demonstrate rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the *prima facie* case established by the Complainants has not been rebutted.

Therefore, the Panel finds that the Complainants have established that the Respondent has no rights or legitimate interests in the Disputed Domain Name. In light of the above, the Complainants succeed on the second element of the Policy.

C. Registered and Used in Bad Faith

The Complainants must prove on the balance of probabilities both that the Disputed Domain Name was registered in bad faith and that it is being used in bad faith (see section 4.2 of the [WIPO Overview 3.0](#) and, for example, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) and *Control Techniques Limited v. Lektronix Ltd*, WIPO Case No. [D2006-1052](#)).

Paragraph 4(b) of the Policy provides a non-exhaustive list of factors, any one of which may demonstrate bad faith. Among these factors demonstrating bad faith registration and use is the use of a domain name to intentionally attempt to attract, for commercial gain, Internet users to a 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 website or location or of a product or service on the website or location.

In the present case, the Panel finds it inconceivable that the Respondent was unaware of the Complainants and their rights in the ANNOUSHKA mark when it registered the Disputed Domain Name:

- some of the Complainants' ANNOUSHKA marks predate the registration of the Disputed Domain Name by almost 15 years;
- the website linked to the Disputed Domain Name mentions the Complainants' word mark and even uses the stylized version used on the Complainants' products on the products offered for sale;
- the website linked to the Disputed Domain Name purports to sell discounted products of the Second Complainant.

As a result, the Respondent must have had knowledge of the Complainants' rights at the time of registering the Disputed Domain Name. The Panel finds that the Respondent's awareness of the Complainants' trademark rights at the time of registration suggests bad faith (see *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#); *BellSouth Intellectual Property Corporation v. Serena, Axel*, WIPO Case No. [D2006-0007](#), where it was held that the respondent acted in bad faith when registering the disputed domain name, because widespread and long-standing advertising and marketing of goods and services under the trade marks in question, the inclusion of the entire trade mark in the domain name, and the similarity of products implied by addition of a telecommunications services suffix suggested knowledge of the complainant's rights in the trade marks).

Given that the use of a domain name for *per se* illegitimate activity such as impersonation/passing off can never confer rights or legitimate interests on a respondent, such behavior is manifestly considered evidence of bad faith (see section 3.1.4 of the [WIPO Overview 3.0](#)).

The Respondent uses the inherently misleading Disputed Domain Name to resolve to a website which appears to offer products identical or at least similar to the Complainants' products at discounted prices. As mentioned above, this website mentions the Complainants' trademark, including on the products offered for sale. In the Panel's view, this indicates that the Respondent has intentionally attempted to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainants' trademark.

By failing to respond to the Complaint, the Respondent did not take any initiative to contest the foregoing. Pursuant to paragraph 14 of the Rules, the Panel may draw the conclusions it considers appropriate.

Therefore, the Panel finds that, on the balance of probabilities, it is sufficiently shown that the Disputed Domain Name was registered and is being used in bad faith. In light of the above, the Complainants also succeed on the third and last element of the Policy.

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 <annoushka.com> be transferred to the First Complainant, ONO International Limited.

/Flip Jan Claude Petillion/

Flip Jan Claude Petillion

Sole Panelist

Date: October 24, 2022