

ADMINISTRATIVE PANEL DECISION

Olive & Orange Limited, Orla Kiely, and Diarmuid Jonathan (D.J.) Rowan v.
xia li
Case No. D2023-0652

1. The Parties

The Complainants are Olive & Orange Limited, United Kingdom (the “First Complainant”), Orla Kiely, United Kingdom (the “Second Complainant”), and Diarmuid Jonathan (D.J.) Rowan (the “Third Complainant”), United Kingdom, represented by Stobbs IP Limited, United Kingdom.

The Respondent is xia li, China.

2. The Domain Name and Registrar

The disputed domain name <orlakielyshop.com> is registered with Gname.com Pte. Ltd. (the “Registrar”).

3. Procedural History

The Complaint in English was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 13, 2023. On February 13, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 14, 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 and contact information in the Complaint. The Center sent an email communication to the Complainants on February 14, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint in English on February 15, 2023.

On February 14, 2023, the Center sent an email in English and Chinese to the Parties regarding the language of the proceeding. The Complainants requested that English be the language of the proceeding on February 15, 2023. The Respondent did not comment on the language of the proceeding.

The Center verified that the Complaint together with the amended 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 February 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 12, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 13, 2023.

The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on March 20, 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 First Complainant is a company established in the United Kingdom and the Second and Third Complainants are directors of the First Complainant. The Second and Third Complainants own the trademark applications and registrations for the ORLA KIELY mark, which they licensed to the First Complainant. The First Complainant operates an online retail at the domain name <orlakiely.com>. The Complainants' joint business is the commercialization of a wide range of ORLA KIELY-branded products with bold prints, such as bags, accessories (e.g., wallets and sunglasses) and homeware (e.g., kitchenware and furniture).

The Complainants provide evidence that the Second and Third Complainants own an international trademark portfolio for ORLA KIELY, including, but not limited to, United Kingdom trademark registration number UK00003008025, registered on October 25, 2013 for the ORLA KIELY word mark, and International trademark registration number 1232039, registered on May 8, 2014 for the ORLA KIELY word mark, designating, *inter alia*, China and the United States of America. The Complainants also provide evidence that they have a significant online presence and a large amount of followers on social media platforms.

The disputed domain name was registered on October 25, 2022, and is therefore of a later date than the abovementioned trademarks of the Complainants. The Complainants submit evidence that the disputed domain name directs to an e-commerce website, prominently displaying the ORLA KIELY word mark and logo, apparently reproducing some of the Complainants' images, and purportedly offering for sale ORLA KIELY-branded products.

5. Parties' Contentions

A. Complainants

The Complainants essentially contend that the disputed domain name is confusingly similar to their trademarks for ORLA KIELY, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered, and is being used in bad faith.

The Complainants claim that their trademarks are distinctive and have acquired a significant reputation, and submit company information, marketing materials and social media information. The Complainants particularly contend that the Respondent uses the disputed domain name to link it to a website which imitates the Complainants' website, and purposefully and prominently displays the ORLA KIELY trademark and product images. The Complainants state that there are no justifications for such use of their trademarks in the disputed domain name, and contend that such use does not confer any rights or legitimate interests in respect of the disputed domain name. The Complainants also argue that the Respondent had actual knowledge of the ORLA KIELY mark before and at the time of the registration of the disputed domain name, and that it was registered with prior knowledge of the Complainants' marks. The Complainants contend that the Respondent has registered the disputed domain name in order to prevent the Complainants, from reflecting their marks in a corresponding domain name. The Complainants also contend that the

Respondent attempted to attract Internet users for commercial gain to his or her website, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of such website, constituting bad faith under Policy, paragraph 4(a)(iii).

The Complainants request that the disputed domain name be transferred to the Complainants.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

6.1 First Preliminary Issue: Consolidation of Complainants

The Complaint was filed by multiple Complainants and the Panel therefore has to assess whether the consolidation of Complainants may be permitted in this administrative proceeding. In this regard, the Panel refers to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the "[WIPO Overview 3.0](#)") which states in section 4.11.1: "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."

The Panel has carefully reviewed all elements of this case, giving particular weight to the following elements: the Second and Third Complainants are the owners of a series of registered trademarks for ORLA KIELY, the First Complainant is the licensee of the ORLA KIELY trademarks and commercializes products bearing such marks, and the Second and Third Complainants are directors in the First Complainant. As such, the Panel concludes that all Complainants are the target of common conduct by the Respondent and all have common grievances regarding the use of the ORLA KIELY trademarks in the disputed domain name by the Respondent. The Panel accepts that permitting the consolidation would be fair and equitable to all Parties involved and would safeguard procedural efficiency. The Panel therefore grants the request for consolidation of the Complainants.

6.2 Second Preliminary Issue: Language of the Proceeding

Pursuant to paragraph 11(a) of the Rules, 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 proceeding.

According to the Registrar's verification response, the language of the Registration Agreement for the disputed domain name is Chinese. Nevertheless, the Complainants filed the Complaint and the amended Complaint in English, and requested that English be the language of the proceeding. The Panel notes that the Respondent did not comment on the language of the proceeding and did not submit any arguments on the merits of this proceeding.

The Panel has carefully considered all elements of this case, and considers the following elements particularly relevant: the Complainants' request that the language of the proceeding be English; the lack of comment on the language of the proceeding and the lack of response on the merits of this proceeding by the Respondent (the Panel notes that the Respondent was invited in a timely manner by the Center in both Chinese and English to present his or her response and arguments in either Chinese or English, but chose not to do so); the fact that the disputed domain name contains the Complainants' trademark in its entirety and that the disputed domain name is written in Latin letters and not in Chinese characters; the fact that the website linked to the disputed domain name is exclusively in English, from which the Panel deduces that the Respondent is capable of understanding and communicating in English; and, finally, the fact that Chinese as

the language of this proceeding could lead to unwarranted delays and costs for the Complainants. In view of all these elements, the Panel grants the Complainants' request, and decides that the language of this proceeding shall be English.

6.3 Discussion and Findings on the Merits

The Policy requires the Complainants to prove three elements:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainants have rights;
- (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.

Based on the evidence and arguments submitted, the Panel's findings are as follows:

A. Identical or Confusingly Similar

The Panel finds that the Complainants have shown that they have valid rights in the mark ORLA KIELY, based on their intensive use and longstanding registration of the same as trademarks.

As to confusing similarity of the disputed domain name with the Complainants' marks, the Panel considers that the disputed domain name consists of two elements, namely the Complainants' ORLA KIELY trademark, followed by the word "shop". According to the [WIPO Overview 3.0](#), section 1.7, "where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing". The Panel concludes that the disputed domain name contains the entirety of the Complainants' trademarks for ORLA KIELY, which remains easily recognizable in the disputed domain name. The Panel also notes that the applicable generic Top-Level Domain ("gTLD") (".com" in this case) is viewed as a standard registration requirement, and may as such be disregarded by the Panel, see in this regard the [WIPO Overview 3.0](#), section 1.11.1.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainants' registered trademark for ORLA KIELY, and that the Complainants have satisfied the requirements of the first element under the Policy.

B. Rights or Legitimate Interests

On the basis of the evidence and arguments submitted, the Panel finds that the Complainants make out a *prima facie* case that the Respondent is not, and has never been, an authorized reseller, service provider, licensee or distributor of the Complainants, is not a *bona fide* provider of goods or services under the disputed domain name and is not making legitimate noncommercial use or fair use of the disputed domain name. The Panel also notes that the Respondent is not commonly known by the disputed domain name. As such, the Panel finds that the burden of production regarding this element shifts to the Respondent (see [WIPO Overview 3.0](#), section 2.1). However, no evidence or arguments have been submitted by the Respondent in reply.

Furthermore, upon review of the facts and evidence provided by the Complainants, the Panel notes that the disputed domain name directs to an e-commerce website which is being passed off as a website operated by the Complainants, by prominently showing the Complainants' ORLA KIELY logo and word mark, by imitating the Complainants' official website design, by using some of the Complainants' product images (thereby also likely violating their copyrights in such images) and by purportedly offering for sale ORLA KIELY-branded products, without any disclaimer as to the Respondent's absence of any relationship with the Complainants. The Panel agrees with the Complainants that these elements show that the Respondent's

intention was not to be a *bona fide* provider or reseller of goods or services under the disputed domain name, nor making a legitimate noncommercial use or fair use of the disputed domain name. Instead, it is clear that the Respondent's intention was to obtain unlawful commercial gain from creating confusion by incorporating the Complainants' intensively used and promoted ORLA KIELY trademark into the disputed domain name.

Furthermore, the Panel considers that the nature of the disputed domain name, being confusingly similar to the Complainants' trademarks for ORLA KIELY and containing the word "shop", carries a risk of implied affiliation and cannot constitute fair use, as it effectively impersonates or suggests sponsorship or endorsement by the Complainants (see [WIPO Overview 3.0](#), section 2.5.1).

On the basis of the foregoing, the Panel considers that none of the circumstances of rights or legitimate interests envisaged by paragraph 4(c) of the Policy apply, and that the Complainants have satisfied the requirements of the second element under the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the registration of the disputed domain name was clearly intended to take unfair advantage of the Complainants' intensively used and promoted trademark, by using such trademark in its entirety in the disputed domain name, to mislead and divert unsuspecting Internet users to the website linked to the disputed domain name. Given the intensive use and promotion of the ORLA KIELY trademark by the Complainants and the use of the Complainants' ORLA KIELY trademark on the website at the disputed domain name, the Panel finds that the registration of the disputed domain name clearly targeted such trademark, and that the Respondent knew of the existence of the Complainants' trademarks at the time of registration of the disputed domain name. In the Panel's view, the preceding elements establish the bad faith of the Respondent in registering the disputed domain name.

As to use of the disputed domain name in bad faith, the Complainants provide evidence that the disputed domain name directs to an e-commerce website which is being passed off as being a website operated by the Complainants, by prominently showing the Complainants' ORLA KIELY logo and word mark, by imitating the Complainants' website design, by using some of the Complainants' images (thereby also likely violating their copyrights in such images) and by purportedly offering for sale ORLA KIELY-branded products, without any disclaimer as to the Respondent's absence of relationship with the Complainants. The Panel concludes that such use constitutes an intentional attempt to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainants' marks as to the source, affiliation, or endorsement of the disputed domain name. This constitutes direct evidence of the Respondent's bad faith under paragraph 4(b)(iv) of the Policy. The Panel therefore finds that it has been demonstrated that the Respondent has used, and is using the disputed domain name in bad faith.

Finally, the Respondent failed to provide any response or evidence to establish his or her good faith or absence of bad faith. The Panel therefore finds that the Complainants have satisfied the requirements of the third element under 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 <orlakielyshop.com> be transferred to the Second and Third Complainants.

/Deanna Wong Wai Man/

Deanna Wong Wai Man

Sole Panelist

Date: March 29, 2023