

Dispute Resolution Service

DRS 21720

Decision of an Independent Expert

Pierre Balmain S.A.S.

and

ZuoChun DUAN

1. Parties

Complainant: Pierre Balmain S.A.S.
44, rue François 1er
Paris
75008
France.

Respondent: ZuoChun DUAN
No.1 Zhuhai Avenue, Xiang Zhou Area
139-215, Phase 4 of Huafa New City
ZHUHAI
Guangdong
519000
China.

2. Domain Name

balmain.uk (the “Domain Name”)

3. Procedural Background

On 7th August 2019 the Complaint was lodged with Nominet UK Limited (“Nominet”) and it was validated on 8th August 2019. On 9th August 2019 Nominet sent the notification of the complaint letter to the Respondent by e-mail and post, advising the Respondent to log into Nominet’s Online Services to view the details of the Complaint, and giving the Respondent 15 business days within which to lodge a Response on or before 2nd September 2019. On 29th August 2019 Nominet sent the Respondent a Response reminder. No Response was received. On 3rd September 2019 Nominet sent the notification of No Response to the Parties. On 12th September 2019, the Complainant paid the appropriate fee for a Decision to be made by an Expert pursuant to paragraph 6 of Nominet’s DRS Policy (“the Policy”).

On 17th September 2019 Mr. Niall Lawless (“the Expert”) was appointed to act as Expert in this dispute and is required to give his Decision by 8th October 2019.

The Expert has confirmed that he is independent of each of the parties, and that to the best of his knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need to be disclosed as they might be of such a nature as to call in to question his independence in the eyes of one or both of the parties.

4. Outstanding Formal or Procedural Issues

There are no outstanding formal or procedural issues.

5. Factual background

The Complainant, Pierre Balmain S.A.S. based in France is an international brand retailing fashion garments, items, and accessories. Balmain has store locations in over 40 countries worldwide with boutiques in some of the largest cities in the world including Beijing, Dubai, Hong Kong, London, Paris and Shanghai. The Complainant owns the trademark registrations of BALMAIN in the member countries of the European Union, and numerous other countries around the world. The Complainant, also has a strong internet and retail presence through its primary website <www.balmain.com> as well as its various social media platforms including Facebook, Instagram, and Twitter. In 2015, Balmain had net sales of €58,418,162.

On 1st July 2019, the Respondent Duan ZuoChun registered the Domain Name.

6. The Parties' contentions

The Complainant

The Complainant seeks transfer of the Domain Name. The Complainant says that the Domain Name is an abusive registration under Nominet's DRS Policy because:-

- The Domain Name is identical to Complainants' BALMAIN trademark, and that by registering the Domain Name, the Respondent sought to benefit from the goodwill and reputation of the BALMAIN trademark, and that such would cause unfair disruption to Complainant's business.
- The Respondent is using the Domain Name to earn pay-per-click revenue by directing visitors away from the Complainant's business to a webpage containing advertising links to the Complainant's competitors.
- The Respondent's use of the Domain Name exploits the goodwill and the image of the Complainant's trademark, and will confuse users into believing that the Respondent is affiliated or associated with the Complainant.
- The Respondent registered the Domain Name for the purpose of selling, renting or otherwise transferring the Disputed Domain Name for valuable consideration in excess of the Respondent's documented out-of-pocket expenses.
- The Respondent has not been authorised, licensed or given permission by the Complainant to use the BALMAIN trademark in the domain name or in any other procedure.
- The Respondent has no rights or legitimate interests in the Domain Name.

The Respondent

The Respondent did not respond to the Complaint.

7. Discussions and Findings

7.1 General

The Policy requires that for a Complaint to succeed the Complainant must prove to the Expert on the balance of probabilities that:-

- i. the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- ii. the Domain Name, in the hands of the Respondent, is an Abusive Registration.

Rights include, but are not limited to, rights enforceable under English Law.

In order to show that the Domain Name is an Abusive Registration, the Complainant must prove, on the balance of probabilities, that the Domain Name either:-

- i. at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or
- ii. has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

7.2 Complainant's Rights

The Domain Name is identical to the name that the Complainant uses to trade under. The Complainant has provided evidence that it is recognised internationally as BALMAIN and has a strong global presence with store locations across 40 countries worldwide. The Complainant has numerous European Union and United States service marks incorporating the BALMAIN brand. These include the following European Union trademarks: No. 001262039 BALMAIN; No. 001266915 BALMAIN; No. 006566764 BALMAIN; No. 010618701 BALMAIN; No. 011745023 BALMAIN; and No. 016199391 BALMAIN. The Complainant uses the domain name <balmain.com> to link to its primary website which displays bespoke content depending on which country it is accessed from.

Accordingly, based on the evaluation of the evidence presented, the Expert decides that, the Complainant has Rights in respect of a name or mark that is identical to the Domain Name.

7.3 Abusive Registration

The Complainant says that the Domain Name controlled by the Respondent is an Abusive Registration under the Policy. Under paragraph 5 "Evidence of Abusive Registration" guidance is given as to what factors may be evidence that the Domain Name is an Abusive Registration.

"A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows :-

5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

5.1.1.1 for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

*5.1.1.2 as a blocking registration against a name or mark in which the Complainant has Rights; or
5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant;*

5.1.2 Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.”

Unfairly disrupting the Complainant’s business

On 25th June 2019, Nominet ended its ‘Right of Registration’ reserving .uk domains for individuals or organisations with .co.uk, .org.uk, or .me.uk domains. Nominet operates a "first-come, first-served" system of domain name registration and there is no requirement for the Respondent to show that he has Rights in the name (unlike the Complainant which must prove that in order to obtain a transfer of the domain name). The end of the ‘Right of Registration’ means that there is great opportunity for both the abusive and legitimate registration of the now generally available .uk domains.

The Complainant says that the Respondent’s registration of the Domain Name on 1st July 2019 is an abusive registration under the Policy because the Respondent is using the Domain Name to cause unfair disruption to the Complainant’s business. The Complainant says that the Respondent causes unfair disruption:-

- By earning pay-per-click revenue by directing visitors away from the Complainant’s business to a webpage containing advertising links to the Complainant’s competitors.
- Because the Domain Name is identical to the Complainants’ BALMAIN trademark, the Respondent is benefitting from the goodwill and reputation of the BALMAIN brand and trademark.

The Complainant says that it is not possible to conceive of a plausible situation in which the Respondent would have been unaware of the Complainant’s brand at the time the Domain Name was registered. The Complainant says that due to the fame and distinctiveness of the BALMAIN trademark, the Respondent knew, or at least ought to have known, of the existence of the Complainant’s trademark.

The Complainant says that the Respondent has specifically registered the Domain Name to ride on the Complainant’s rights taking undue advantage and causing detriment. In doing so, the Respondent must have realised, if not intended, that such would cause unfair disruption to Complainant’s business.

The Respondent has not responded to the Complainant's assertions.

The Complainant has demonstrated that it has a strong global presence with store locations across 40 countries worldwide, including 16 locations in China Mainland. The Complainant has also demonstrated that it has a strong online global presence through its primary website <www.balmain.com> which received an average of more than 36,000 unique visitors per month during a 13-month period ranging from January 2015 – January 2016.

The Complainant's reference to its visibility via social media platforms such as Facebook, Instagram, and Twitter is less relevant as evidence as these platforms are not generally accessible from China Mainland.

Notwithstanding this, and in the absence of any evidence to the contrary, I consider it unlikely that the Respondent arrived at the choice of the Domain Name at random. Before registering the Domain Name, any commercially aware Respondent would have conducted a search on the internet to look for other domain names that incorporate the term BALMAIN, or for other uses of the term BALMAIN.

I accept the Complainant's assertion that it is not plausible that the Respondent would have been unaware of the Complainant's brand at the time the Domain Name was registered. The Domain Name benefits from the prominence of the Complainant's brand and reputation as it would have existed on 1st July 2019, when the Domain Name was registered.

The Nominet Experts Overview says that *"unfair disruption of the Complainant's business by way of a domain name is very likely to constitute an abusive use of the domain name (DRS 02223 itunes.co.uk)"*.

It is enough for the Complainant to show that the 'abuse' occurred at any time during the 'life' of the Domain Name - so it may be that:-

- there was an 'unfair' motive when it was registered;
- there was an 'unfair' use after registration but it has now stopped;
- there was an 'unfair' motive at transfer;
- there is something 'unfair' going on now;
- the domain name is inherently 'unfair' (similar to the concept of an "instrument of fraud" in the Court of Appeal case One In a Million); or

- any combination of these.

The Complainant has demonstrated at Annex 4 to the Complaint ‘Screenshot of the Website Reachable through the Disputed Domain Name’ that the Respondent has used the Domain Name to resolve to a parking page made up of sponsored advertisement and links which could divert users to the Complainant’s competitors. This clearly takes advantage of the Complainant’s established reputation, and I accept that this is an unfair use of the Domain Name.

I decide that under the test at paragraph 5.1.1.3 of the Policy, the Domain Name has been used in a way which has been unfairly detrimental to the Complainant's Rights, and I decide that in the control of the Respondent the Domain Name is an Abusive Registration.

In light of this finding, it is unnecessary for the Expert to address the Complainant’s other contentions.

7.4 Conclusion

The Expert finds on the balance of probabilities that the Complainant has Rights in respect of a name or mark identical or similar to the Domain Name and the Complainant has proved, on the balance of probabilities, that the Domain Name in the hands of the Respondent is an Abusive Registration.

8. Decision

For the reasons set out in detail above, the Expert directs that the Domain Name be transferred to the Complainant.

Niall Lawless, Nominet Expert

18th September 2019