

DISPUTE RESOLUTION SERVICE

DRS 07638

Decision of Independent Expert

DECKERS OUTDOOR CORPORATION

and

YUAN CHEN

1. The Parties:

Complainant: Deckers Outdoor Corporation
Represented by: Greer, Burns & Crain, Ltd
Address: 300 S. Wacker Drive, Suite 2500
Chicago
Illinois
Postcode: 60606
Country: United States of America

Respondent: Yuan Chen
Address: Meiyuan Road
Putian
Postcode: 351100
Country: China

2. The Domain Name(s):

(1) kissugg.co.uk; (2) goodugg.co.uk; (3) hellougg.co.uk; (4) gpbugg.co.uk;
(5) uggshow.co.uk

3. Procedural History:

The Complaint was received by Nominet on 17 August, 2009. Nominet checked the Complaint and validation was confirmed on 18 August, 2009. Nominet duly sent notifications of the Complaint to the Respondent, by both letter and by e-mail on 18 August, 2009, noting that the Dispute Resolution Service had been invoked and that the Respondent had 15 days (until 9 September, 2009) to submit a Response. All the emails sent to the Respondent's email addresses resulted in delivery failure notifications, in each case reportedly because the message size, with all the attachments, exceeded mail service limits. The hardcopy sent to the Respondent's designated mailing address was sent by recorded delivery and no indication of non-delivery had been received as of 20 October, 2009 when the Expert prepared this Decision. No Response of any kind was received from the Respondent by the 9 September, 2009. On 10 September, 2009, Nominet notified the parties accordingly, including by emails to the Respondent (to which no delivery failure notifications were received), and invited the Complainant to pay the fee to obtain a Full or a Summary Expert Decision pursuant to paragraph 7 of the Nominet Dispute Resolution Service Policy ("the Policy") and Paragraph 21 of the Nominet Dispute Resolution Service Procedure ("the Procedure"). The fee for a Full Decision was duly received by Nominet on 16 September, 2009.

Nominet then invited the undersigned, Keith Gymer ("the Expert"), to provide a decision on this case and, following confirmation to Nominet that the Expert knew of no reason why he could not properly accept the invitation to act in this case and of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality, Nominet duly appointed the undersigned as Expert with effect from 30 September, 2009.

Whilst ultimately the Expert has been able to take a Decision in this case, the case has raised some concerns, which have required additional time and effort to resolve, delaying the issuance of the final Decision.

Firstly, the sheer volume of Exhibits attached to the Complaint (90 Exhibits in all) resulted in all of the email notifications sent to the Respondent's various email addresses being undelivered because the message size with attachments exceeded normal mail limits, including for Gmail. Nominet's attempt to email the Complaint and Exhibits to the Expert also bounced for the same reason.

The Expert was therefore concerned that the Respondent may not have been properly made aware of the Complaint, because of the excessive number and total size of the attachments, and not simply because the email addresses might have been invalid. The Expert sought confirmation from Nominet that the mailed copy of the Complaint had not been returned, and that subsequent email notifications (e.g. notification of Respondent Default) to the Respondent's addresses had not bounced (not having excessive numbers of attachments).

Upon enquiry and further investigation, the Expert has been satisfied that the Respondent would have been aware of the Complaint, even if belatedly, and would still have had plenty of time to raise late objections if it wished to do so. No communications of any kind having been received from the Respondent, even several weeks after the Notification of Respondent Default, the Expert has considered it appropriate to proceed to take this Decision in any event.

In the interest of avoiding email bounces, due to size and number of attachments, when notifying future Complaints, the Expert understands that Nominet will send an initial Notification of the Complaint to the Respondent without the attachments. (All Complaint documents can be accessed online through a domain registrant's Nominet Account, so it is not essential that these be attached to an email notification.)

4. Factual Background

The Complainant, Deckers Outdoor Corporation, is an international footwear business. One of its more well-known brands is UGG, used for sheepskin boots and shoes and related products, of Australian origin. It has a website at www.uggaustralia.com through which UK consumers may purchase UGG products.

The Complainant owns (or controls) various Trade Mark registrations for the mark UGG, including, *inter alia*, US 3,050,925 registered as of 24 January, 2006, and Community Trade Mark 1409721 dating from 3 December, 1999.

According to the minimal information available from the current Nominet WHOIS record, the Domain Names are each registered in the name of Yuan Chen at the address given above, although it is not clear whether this name is a natural person or a business name. The Domain Name gbpugg.co.uk was first registered as of 12 September, 2008. The other four Domain Names each appear to have first been registered as of 30 August, 2008.

5. Parties' Contentions

Complainant:

The Complainant has asserted that:

1. The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name (Policy Paragraph 2a(i)); and
2. The Domain Name, in the hands of the Respondent, is an Abusive Registration (Policy Paragraph 2a(ii)).

In support of its case, the Complainant made extensive assertions and allegations, which were supported by a very large number of Exhibits, most of which were, in the Expert's view, unnecessary and irrelevant. The following is an abbreviated selection of relevant extracts from the Complaint:

What Rights you are asserting?

I. THE COMPLAINANT HAS RIGHTS IN RESPECT TO A NAME OR MARK WHICH IS IDENTICAL OR SIMILAR TO THE DOMAIN NAME

Complainant Deckers Outdoor Corporation is a footwear manufacturer that builds niche lifestyle brands into global market leaders. Through its UGG Australia

product line, a name by which Deckers is known in the trade, Deckers sells sheepskin boots, slippers, shoes, purses and other products under the UGG® brand. Deckers has well established rights in the UGG mark dating back to at least 1979 as evidenced by its many trademark registrations, worldwide fame as a leader in luxury sheepskin footwear, and dozens of successful enforcement actions against infringers. The disputed domain name [*sic*] includes Complainant's UGG mark in its entirety.

A. Complainant has Worldwide Registrations for the UGG Trademark

Complainant holds over 100 registrations for the trademark UGG (and stylized variations) with dates of use going back to 1979 in more than 100 countries around the world, including the United Kingdom (U.K. Registration No. 2373334) and European Community (E.C. Reg. No. 001409721; E.C. Reg. No. 006335632). (Exh. 2, List of Deckers trademarks worldwide; Exh. 3, Copies of Selected Trademark Registration Certificates; Exh. 4, Declaration of Constance Rishwain). Many of these marks are also incontestable.

B. Complainant's UGG Mark is Famous Worldwide, Including in the U.K.

Complainant's UGG mark is famous with consumers around the world for footwear, and particularly for sheepskin footwear.

...

The U.K. is Complainant's largest market outside of the U.S. (Exh. 4, Rishwain Declaration). UGG sales in the UK for the period 2003 - 2008 have grown steadily and exceed £10 million pounds, with 2008 UGG sales in the UK far exceeding any prior year. (Id.).

...

UGG brand marketing and sales over the internet are key to Complainant's business. Since at least 1999, Complainant has operated a website at where it promotes and sells genuine UGG brand footwear, including to U.K. consumers. (Exh. 16, website; Exh. 4, Rishwain Declaration). Complainant also uses other domain names which redirect to this location, including several TLD domains with examples including and . (Exh. 4, Rishwain Declaration). Complainant's website is extraordinarily successful, with 2008 ecommerce UGG sales totaling over £42 million (\$60 million US). (Exh. 1 at 40; Exh. 4, Rishwain Declaration).

...

C. Complainant's Rights in the UGG Mark are Evidenced by over 100 Successful Enforcements Against Infringers Around the World, including in the U.K.

Complainant has successfully enforced its rights in the UGG mark against well over 100 infringers, counterfeiters and other third parties in countries around the world, including the U.K. Complainant's rights in the UGG mark have been upheld in

numerous lawsuits against infringers and counterfeiters, trademark oppositions, domain name disputes and other enforcements in countries including the U.S., the U.K., Ireland, France, Germany, the Netherlands, Canada, Korea, China, Australia, Panama, Brazil, and others. (Exh. 87, Declaration of Thomas R. Fitzsimons).

Due to the fame of the UGG brand, third parties seeking to trade on Complainant's goodwill have previously registered unauthorized domain names that include UGG to promote sheepskin boots not made by Deckers. Deckers has successfully enforced its UGG trademark against these unauthorized domain names in many countries, including the U.K. Such examples include:

...

- Complainant has also been successful in having numerous <.co.uk> TLD websites suspended based on unauthorized use of the UGG mark. (Id.).

...

Deckers has also successfully brought numerous domain name actions against infringing domains, resulting in the transfer of dozens of infringing <...co.uk> and <...com> TLD domain names that included the UGG mark to Deckers. See, e.g., Deckers Outdoor Corporation v. Original UGG, DRS 06347 (Nominet April 20, 2009); Deckers Outdoor Corporation v. Rongchun Huang and Yuan Chen, FA248979 (Nat. Arb. Forum April 10, 2009); UGG Holdings, Inc. v Barclay, FA216873 (Nat. Arb. Forum Feb. 6, 2004); UGG Holdings, Inc. v Barclay, FA217320 (Nat. Arb. Forum Feb. 4, 2004); UGG Holdings, Inc. v Sharpe, FA227667 (Nat. Arb. Forum Mar. 9, 2004); UGG Holdings, Inc. v Roussos, FA335441 (Nat. Arb. Forum Nov. 8, 2004); UGG Holdings, Inc. v WebQuest.com, Inc., FA335456 (Nat. Arb. Forum Dec. 8, 2004); Deckers Outdoor Corp. v Bills Distribution, FA358035 (Nat. Arb. Forum Dec. 20, 2004); Deckers Outdoor Corp. v Choi, FA362468 (Nat. Arb. Forum January 10, 2005) (note that many of these actions were brought by Deckers' **former wholly owned subsidiary UGG Holdings, Inc.**).

Why is the domain name an Abusive Registration?

II. THE DOMAIN NAME, IN THE HANDS OF THE RESPONDENT, IS AN ABUSIVE REGISTRATION.

In the instant case, Respondent operates a massive counterfeit enterprise using the domain names , , , [sic] and (collectively "Respondent's Domain Names"). All of Respondent's Domain Names incorporate Complainant's UGG® mark in its entirety and are used to sell Counterfeit UGG® brand boots. See Exh. 89 – whois information for Respondent's Domain Names; Exh. 90 – Printout of Respondent's Websites linked to the Domain Names. (At the time of writing this complaint, , [sic] and were being used to sell counterfeit UGG product. [sic] was previously used to sell counterfeit UGG products. see Exhibit 90.) The registrant name for all five of Respondent's Domain Names is listed as Yuan Chen, Meiyuan Road, Putian, 351100, CN. Id. No email address or telephone number is provided. Id. Many of the websites also contain a virtually identical layout. Additionally, Complainant successfully filed a UDRP Action earlier this year where 32 domain names owned by Yuan Chen were transferred to Complainant. Deckers Outdoor Corporation v. Rongchun Huang and Yuan Chen, FA248979 (Nat. Arb. Forum April 10, 2009)

Respondent's Domain Names make unauthorized use of Complainant's trademarks and copyrighted images to illegally sell counterfeit UGG boots. The use of Respondent's Domain Names to sell counterfeit UGG boots is clearly an attempt to disrupt Complainant's business and free-ride upon the fame and extensive goodwill that Complainant's UGG mark enjoys with the consuming public. Under these circumstances, it is manifestly clear that the Respondent's use of the Domain Name is an abusive registration.

A. Registrant used the Domain to Sell Counterfeit UGG® Boots and to Infringe Complainant's Copyrights in Violation of the Law.

Respondent's Domain Names are used to sell counterfeit UGG brand boots and to display unauthorized reproductions of Complainant's copyrighted works in contravention of U.K., U.S., and other national laws. (Exh. 87, Fitzsimons Declaration; Exh. 90, printout of Respondent's websites). Not only is this illegal, but this also disrupts Complainant's business by redirecting Internet users searching for Complainant's site or Complainant's genuine UGG products to the infringing Respondent's Domain Names where counterfeit UGG boots are sold. (Exh. 87, Fitzsimons Declaration). Respondent's Domain Names are therefore being used to create the inaccurate impression that counterfeit goods offered at the website are sold by the Complainant or under its authority – to the Respondent's commercial advantage. Previous Nominet decisions clearly establish that sales of counterfeit goods can only represent an unfair disruption of the Complainant's business and, therefore, is indicative of an abusive registration. See Pfizer, Inc. v. Pfizer-Viagra, DRS 03244 (Nominet February 14, 2006).

Additionally, in about November, 2008, an investigation was initiated in China regarding the counterfeit sales being conducted over the Respondents' websites located at the Respondents Domain Names. (Exh. 87 - Fitzsimons Declaration). This investigation identified several locations in Putian, China being used by the operators of the Respondents' websites at which manufacture, storage and/or shipment of significant quantities of counterfeit UGG brand footwear was taking place. Id. On or about February 13, 2009 a raid was conducted by Chinese authorities of these locations in Putian, China, and more than 1,000 pair of counterfeit UGG brand footwear along with over 4,000 counterfeit UGG footwear boxes were seized. Id. Respondent's massive counterfeit operation of UGG footwear in connection with Respondent's Domain Names is evidence of an abusive registration.

B. The Registration is Abusive Because Respondent is not Authorized by Complainant to Use its UGG® Mark in the Domain Name or to Use Complainant's Copyrighted Works.

Respondent's Domain Names incorporate Complainant's UGG mark in its entirety. Respondent has no trademark or trade name rights to UGG and is not an authorized retailer or licensee of Complainant. (Exh. 87, Fitzsimons Declaration). Complainant has not authorized Respondent's use of the UGG trademark. The registration of Respondent's Domain Names is therefore abusive. See Seiko Epson Corp. v. Inkking, DRS 01796 (Nominet July 30, 2004)(use of a domain including

complainant's trademark is abusive registration); *Vodafone Group Plc v. Knights Indep. Traders*, DRS 00445 (Nominet August 8, 2002)(same).

Respondent's Domain Names are also an abusive registration because the Respondent uses Complainant's copyright protected images on its websites without permission. See *Terex Corporation v. A.T. Agency*, DRS 00999 (Nominet August, 28, 2003).

C. The Registration is Abusive Because Respondent's Use of the Domain Name Deceives Consumers into Believing that the Domain Name is Registered, Operated, Authorized by, or Otherwise Connected with Complainant.

Incorporating Complainant's UGG mark in its entirety into Respondent's Domain Names incorrectly implies that the sites are the home of an authorized seller of authentic UGG® footwear, if not Complainant themselves, and consumers are likely to be confused as to the source, sponsorship, or affiliation of the website with Complainant. See *Hitachi v. Logic Europe*, DRS 01771 (Nominet July 27, 2004); *Nokia v. Just Phones*, DRS 0058 (Nominet January 7, 2002).

D. The Registration is Abusive Because Respondent Registered the Domain Name Primarily for the Purpose of Unfairly Disrupting Complainant's Business.

Due to the fame of Complainant's trademarks and trade name as well Respondent's sales of counterfeit UGG boots, it can be inferred that Respondent has both constructive and actual knowledge of Complainant's UGG mark at the time of registration. *Taylor Woodrow Plc v. M Davis*, DRS 002283 (Nominet March 3, 2005). Respondent's Domain Names were carefully chosen to take the most effective advantage of the famous UGG brand. Because Respondent is selling counterfeit UGG brand goods, it is clear that Respondent's primary purpose in registering Respondent's Domain Names was to target actual and potential UGG customers in an effort to unfairly draw them away from Complainant's website to Complainant's commercial detriment. See *Compaq Trademark BV v. Balata.com LLC*, DRS 02455 (Nominet May 9, 2005).

How would you like this complaint to be resolved?

Transfer.

Respondent:

No Response of any kind was received from the Respondent.

6. Discussions and Findings

General

Paragraph 2 of the Policy requires that, for the Complainant to succeed, it must prove to the Expert, on the balance of probabilities, both that it has Rights in

respect of a name or mark which is identical or similar to the Domain Name; and that the Domain Name, in the hands of the Respondent, is an Abusive Registration as defined in Paragraph 1 of the Policy.

Complainant's Rights

The Complainant in this case has asserted that it has Rights in the UGG trademark and that this mark should be considered similar to each of the Domain Names because they each include the UGG mark in its entirety.

The Expert has had several concerns about this Complaint, which has evidently been put together from previous complaints and was unfortunately not fully adapted to take account of the differences or the changes which have taken place, even in the Complainant's ownership of its relevant registrations, since the earlier Complaints.

The establishment of Rights under the Policy is not a high hurdle. Rights are broadly defined:

Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning;

Thus, it would be quite sufficient to provide current details from an official register of one live trade mark registration, for example, for the relevant mark, in the Complainant's name.

The Complainant provided an extensive listing (Exh. 2) of its trade mark registrations around the world incorporating the UGG mark, which were stated to be "valid and subsisting" (Exh. 4 – Rishwain Declaration). This was supplemented (at Exh. 3) by copies of a number of registration certificates for the UGG mark in plain text and stylised forms.

However, in the Expert's view, the listing was potentially misleading and contained obvious errors. For example, for the United Kingdom, five registrations were included, but it was not made clear that three of these were actually Community Trade Mark (CTM) registrations, another was a UK designation of an International Registration and only one was actually a UK National registration. CTM registration numbers were included in the listing both under the "European Community" and for each Member State. CTM registration 4686994 was erroneously shown throughout as having application number 3894623.

Additionally, a number of the certificates submitted (in Exh. 3) actually showed the registrations to be held in the name of UGG Holdings, Inc. rather than in the name of the Complainant itself. This was the case for the Certificate provided for CTM 3894623, for example.

The Expert was quickly able to check on the CTM register himself to confirm that in fact this CTM registration is now actually held in the Complainant's name, so an assignment has obviously taken place at some stage since the Certificate was issued, but no explanation of this was given in the Complaint or Exhibits. As far as the Expert could ascertain, the only pertinent reference was in the final paragraph

of Part I of the Complaint where UGG Holdings, Inc. is referred to as a “former wholly owned subsidiary” (see highlighted text in the extracts from the Complaint above). On the face of it, this would have meant that the relevance of the Certificates in the name of UGG Holdings, Inc., could have reasonably been questioned by the Expert.

The DRS is intended to provide a low-cost, quick means for addressing straightforward cases of Abusive Registration. Experts cannot be expected to routinely investigate apparent anomalies in a Complainant’s evidence.

In this case, since Exh. 3 does include a copy of the Certificate of Registration for US trademark registration 3,050,925 for the mark UGG, which is in the Complainant’s own name and predates the dates of registration of all of the Domain Names, the Expert accepts this as sufficient on its own to support the Complainant’s claim of Rights under the Policy in respect of the name and mark UGG.

The Complaint also included a huge number of Exhibits apparently supporting the Complainant’s claims in respect of fame of the UGG brand. In the context of this Complaint, the Expert considers this evidence to have been substantially irrelevant, only serving unnecessarily to add to the time required to deal with the Complaint and to delay the Decision as a consequence.

That the Complainant has Rights in UGG, however, is only part of the test to be met under Paragraph 2.a.i of the Policy.

The Domain Names at issue in this case are not for UGG alone. They are: (1) kissugg.co.uk; (2) goodugg.co.uk; (3) hellougg.co.uk; (4) gpbugg.co.uk; (5) uggshow.co.uk

The domain suffix “.co.uk” is not pertinent to an assessment of the similarity of these Domain Names to the name or mark in which the Complainant has Rights, but the Complainant’s Rights are in UGG, and not in “kissugg”, “goodugg”, “hellougg”, “gpbugg” or “uggshow” as such.

Taken in isolation, it is not immediately obvious that such words should necessarily be considered similar to UGG, simply because they include “the Complainant’s UGG mark in its entirety”, which is the Complainant’s argument.

Would the Complainant consider more familiar words like “smuggler”, “hugging”, “muggle”, “bugging” to be similar to UGG on that basis? Surely not.

It would therefore have been helpful for the Complainant to have explained its case in rather more detail.

On the Expert’s own analysis, “kissugg”, “goodugg”, “hellougg”, “gpbugg” or “uggshow” are not recognised ordinary English words. However, it is a reasonable expectation that an English reader would deconstruct them into recognisable parts where possible, and would be likely to perceive them respectively as “kiss UGG”, “good UGG”, “hello UGG”, “gbp UGG” and “UGG show”.

The words “kiss”, “good”, “hello” and “show” would then probably be seen simply as descriptive or laudatory references to UGG; and “gbp” as a recognised common way of referring to British Pounds (Sterling).

There might conceivably be some who would argue that “goodugg” might alternatively be seen as “goo-dugg” and “gbpugg” as “GB-pugg”.

However, in the Expert’s opinion, what tilts the balance substantially in favour of the Complainant’s case, is the evidence of how the Domain Names are actually being used. The Complainant has asserted that the “Domain Names were carefully chosen to take the most effective advantage of the famous UGG brand.” One might question whether the choice was to take “the most effective advantage”, but the evidence is certainly sufficient to convince the Expert that the Domain Names were, at the very least, chosen to make reference to the UGG mark.

In that context, the distinctiveness of the UGG element relative to the associated, descriptive and subordinate elements in each of the Domain Names leads the Expert to support the view that the Complainant has relevant Rights in UGG, and that UGG can reasonably be considered similar to each of the Domain Names at issue, pursuant to Paragraph 2.a.i of the Policy.

Abusive Registration

The Complainant also has to show that the Domain Name is an Abusive Registration. Paragraph 1 of the Policy defines “Abusive Registration” as a Domain Name which either:

was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant’s Rights; OR

has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights.

A non-exhaustive list of factors which may be evidence that a Domain Name is an Abusive Registration are set out in Paragraph 3a of the Policy.

From the Complainant’s submissions and supporting evidence, it is clear that at least the following examples are potentially applicable in this case:

3a. A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:

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

...

C. for the purpose of unfairly disrupting the business of the Complainant;

ii. 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;

iii. The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;

...

The factors listed in Paragraph 3 of the Policy are only intended to be exemplary and indicative. They are not definitive. It is Paragraph 1 of the Policy, which provides the applicable definition as indicated above.

However, given the strength of the unchallenged evidence submitted by the Complainant in this case, the Expert has no difficulty concluding that the Domain Names are each and all Abusive Registrations for the purposes of the Policy.

The Complaint and Fitzimons Declaration (Exh. 87), with the evidence of how the websites under each of these Domain Names are being used (Exh. 90) and the reference to previous UDRP Case: *Deckers Outdoor Corporation v. Rongchun Huang and Yuan Chen*, FA248979 (Nat. Arb. Forum April 10, 2009), leave the Expert in no doubt that all of the factors exemplified in Paragraph 3.a.i, ii and iii above are present.

Accordingly, the Expert concludes that each of the Domain Names in the hands of the nominal Respondent is an Abusive Registration, pursuant to Paragraph 2.a.ii of the Policy.

7. Decision

As will have been apparent from the Expert's observations elsewhere above, the sheer volume of Exhibits and submissions in this Complaint have also added, unnecessarily in this Expert's opinion, to the time and effort needed to deal with this dispute. The Expert appreciates that a Complainant will want to present a strong case, but the "kitchen sink" approach, which seems to have been adopted here, of throwing everything available into the Complaint, is surely disproportionate and not appropriate for proceedings of this nature.

It is preferable that a Complainant should select, and present, its best and most relevant argument and focus on the evidence appropriate to the most pertinent jurisdiction. A more focussed approach would have assuredly facilitated a speedier conclusion in this case.

Nevertheless, having concluded that the Complainant does have Rights in respect of a name or mark, which is similar to each of the Domain Names, and that each of the Domain Names, in the hands of the Respondent, is an Abusive Registration, the Expert determines that the Domain Names (1) kissugg.co.uk; (2) goodugg.co.uk; (3) hellougg.co.uk; (4) gpbugg.co.uk; (5) uggshow.co.uk should all be transferred to the Complainant.

Signed
KEITH GYMER

Dated: 28 October, 2009