



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

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Decision Submission

English Print

Decision ID	DE-0500044
Case ID	HK-0400056
Disputed Domain Name	www.hongkongseaschool.com www.hongkongseaschool.org
Case Administrator	Dennis Choi
Submitted By	Anthony Wu
Participated Panelist	Anthony Wu
Date of Decision	13-04-2005

The Parties Information

Claimant	Hong Kong Sea School
Respondent	Shu Bon James Tam

Procedural History

On 23-11-2004, the Hong Kong Office of Asian Domain Name Dispute Resolution Centre (“ADNDRC”) received a Complaint form in electronic format filed by the Hong Kong Sea School (the “Complainant”) pursuant to the Uniform Domain Name Dispute Resolution Policy (the “Policy”) adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on 24-10-1999. On the same day, the Hong Kong Office of ADNDRC received payment for Domain Name Dispute Complaint fee in connection with the case. The Registrars, OnlineNic and Registrar.com, Inc were notified of the Complaint on 27-11-2004 and 26-11-2004 respectively. The Registrars were requested to confirm that the domain names at issue were registered by Respondent with them respectively. On 10-12-2004, the Hong Kong Office of ADNDRC served a notification of Commencement of the Proceedings on the Respondent and the Respondent was asked to submit a Response to the Complaint. A response was submitted by Respondent within the required period of time. On 29-11-2004, OnlineNic confirmed that the domain name of hongkongseaschool.com was registered with it by Respondent. On 1-12-2004, Register.com, Inc confirmed that it is the registrar of the domain name of hongkongseaschool.org and Respondent is the current registrant of the same.

On 12-1-2005, pursuant to the Hong Kong Office of ADNDRC Supplemental Rules, the Hong Kong Office of ADNDRC appointed Mr Anthony Wu to serve as Panelist and notified the parties of the appointment. All documents submitted by the parties were sent to the Panelist by letter dated 13-1-2005.

On 26-1-2005, the Case Administrator informed the Panelist of supplemental documents submitted by Complainant for direction by the Panelist. The Panelist directed that he would review the documents. The supplemental documents were forwarded to the Panelist with copy to Respondent on 27-1-2005. On 28-1-2005, the Case Administrator notified the Panelist of supplemental documents submitted by Respondent and asked for directions. The Panelist asked for the same to be forwarded to him and the same was forwarded to him on the same day. On 2-2-2005, the Panelist issued request, pursuant to Rule 11 and 12 of the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”) to the parties asking for additional documents, statements and translation of the Chinese documents that the parties had sought to rely on. However, the requests apparently did not reach the parties and the requests were reissued to the parties on 14-2-2005. By letter dated 23-2-2005, Complainant responded to the request and the same was received by the Panelist on 1-3-2005. By email dated 27-2-2005, Respondent responded to the request and gave comments on the documents provided by Complainant. On 7-3-2005, the Panelist asked for clarifications on the responses and further statements from the parties. On 14-3-2005, Respondent provided his further response. Complainant asked for time extensions to comply with the requests on 13-3-2005 and 18-3-2005. Complainant sent the clarifications and statements by letter dated 21-3-05 which was received by the Panelist on 25-3-2005.

Factual Background

For Claimant

Complainant is a boarding secondary School for boys aged 12 to 18 at Tung Tau Wan Road, Stanley, Hong Kong.

For Respondent

Respondent is an individual and was an employee of the School from 29th April 2002 to 17th May 2004. Two domain names, hongkongseaschool.org and hongkongseaschool.com, were registered on 29-9-2002 and 3-5-2003 respectively.

Parties' Contentions

Claimant

Complainant contends that Hong Kong Sea School is a registered service mark owned by the School. Both domain names incorporated the School's service mark which was registered under the Education and Manpower Bureau of the Hong Kong Government. Allegedly, after Respondent was employed, he was deployed with the task of developing an official website for the School. As part and parcel of this duty, Respondent registered the two domain names in question, in his own name, where he hosted the official website for the School. The websites bore the School's service mark and had been hosted for more than two years. It was a well recognised communication channels between the School and its students and parents and the public. Towards the end of Respondent's employment, he claimed ownership of the domain names, and that the obtaining of the domains was his private act. After the Respondent's resignation, he brought down the official website of the School on the domains without authorisation and replaced it with what he claimed an unofficial website of the School, which included aversive comments to the Schools. Complainant contends that the School has been using the current service mark (Hong Kong Sea School) since 1959 as a non-profit making organisation that provides secondary education to boys. As an employee of the School, Respondent should be well aware that the School has been a bona fide provider of service under its service mark well before the creation of the domain names. Secondly, as the Schools designated staff to construct an official website, Respondent should be aware that the creation of the domain names in question is for the purpose of hosting the School official website only. Upon termination of his employment his legitimate interests in and rights to the domains in question should cease, when his duties as the webmaster ceases. As an employee of Complainant, Respondent was expected to act on behalf and in the best interest of the School. Complainant contends that as a common practice of employment, anything done as part and parcel of an employee's duty is deemed as the works of the employer. The Respondent's claim that the registration was his private act was a breach of an employee's duty and could not be explained by a good motive. Further, the domain names which contains aversive comments against and false information about the School was an example that the domains are being used in bad faith.

Respondent

The contention of Respondent is that the acquisition of the domain names was his private act. The domain names were created and registered by him. The payment for the registration was also made by him. His website had been to provide School information such as photos, notice, news and discussion services to students and parents since it was constructed. He was well known for holding a private and voluntary website with unofficial school information amongst students and colleagues. He alleged that it was in June 2003 that he was instructed to be in charge of making an official website for the School. Notwithstanding, it is his contention that the acquisition of the domain names remains his personal and voluntary act. No one in the School had ever advised or instructed him to obtain the said domain names. He denied that the website at the domain names was the official website of the School. In his view, the School did not have an official website until the domain name of hongkongseaschool.edu.hk was created on 25-5-2004.

Findings

Identical / Confusingly Similar

Applicable Policy Provisions

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

- (i) That the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) That the Respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) That the domain name has been registered and is being used in bad faith.

Identical or confusing similarity

The Complainant has presented certificates of registration showing that the name Hong Kong Sea School has been registered as a limited company under the Companies Ordinance since 5-8-1967 with the word “limited” being omitted by licence granted by the Registrar of Companies. The Complainant has also been registered as a School under the Education Ordinance since 25-11-1981. The Panel finds that the domain names hongkongseaschool.com and hongkongseaschool.org are confusingly similar if not identical to Complainant’s mark of Hong Kong Sea School. The deletion of space between the four words makes an insubstantial difference to the appearance, pronunciation and meaning of the terms. The requirements of Paragraph 4(a)(ii) are met with.

Rights and Legitimate Interests

Under Paragraph 4 (c) of the Policy, it is provided that:

“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Complainant’s contention is that Respondent was the School’s designated staff to construct an official website and Respondent should be aware that the creation of the domain names in question is for the purpose of hosting the School official website only. Upon termination of his employment, his legitimate interests in and the rights to the domains in question should cease when his duties as the webmaster ceases.

In his reply in Form R with reference to Paragraph 4(a)(ii), Respondent contends that his use of the domains are in connection with a bona fide offering of services, including introduction of the School, informing students and parents of news in the School and showing private pictures he took in School activities. Also students used to communicate with him through the website hosted by the in-question domain names. He has been commonly known by the domain names amongst students and colleagues. Also, he is making a legitimate non-commercial and fair use of the domain name such as communicating with his students, colleagues and parents and publishing pictures he took, without intent for commercial gain to misleadingly divert others or to tarnish the trade mark or service mark in issue.

It is not in dispute that before the resignation of Respondent and the dispute broke out between Complainant and Respondent that the website had been used as a website of the School. Web pages of the website at hongkongseaschool.com were produced. While no copy of web pages have been produced by the Complainant in respect of hongkongseaschool.org, in Complainant’s response to the further request by the Panelist, Complainant confirmed that the domain name of hongkongseaschool.org granted access to the same website as hongkongseaschool.com. The web pages provided covered a home page, information notices, School details, connected websites, parents’ corner, students’ corner, teachers’ corner and a site map of the School. The information notices chronicled all the activities of the School. The School information section sets out a wide range of information on the School, including Principal’s Report, Annual Report of the School, Annual School Programme Plan, and School Development Plans. The address and contacts for the School, including the internet address of hongkongseaschool.com were also set out. I also note that the email address of the webmaster was given as webmaster@hongkongseaschool.org. There were also notices to parents, information on School fees, students’ club and online learning. As note above, while Respondent accepted that it was a website of the School, he contends that it was not an official website. It is the Panel’s finding that the website at hongkongseaschool.com was an official website of the School. As hongkongseaschool.org gave access to the same website, the same is therefore true of the latter.

Indeed, it has been accepted by Respondent that before his resignation from the School the contents of the websites were properties of the School, although he asserts that the domain names belong to him throughout. In response to the letter dated the 28th April 2004 from the Complainant's head of IT, Respondent admitted that he “is responsible for validity and accuracy of the content published on www.hongkongseaschool.com and www.hongkongseaschool.org, and all contents should be authorised by the School before they are present on the website. In other words, it means all content,

except the domain name, concerning the School is the properties of the School.”

Respondent however seems to dispute that the websites were used as such School website from their creation. As noted above, Respondent referred to him being only being instructed in June 2003 to be in charge of making official web pages for the School. The creation and registration of the domain names were his private act. I however note from the bundle of web pages submitted that the visitors’ counter of the web pages referred to a starting date of 1-12-2002. In order to clarify matters, the Panel’ s second request was issued to the parties. Complainant was however unable to trace the record on the launching date of the School website as it alleged that it was information held by Respondent who was the officer charged with the development of the website and he has produced no record. Respondent’ s response was equivocal. He replied that: “Until June 2003, I was asked to responsible for design the content of the website for the school. The school website content was stored on my personal domain.” It is the view of the Panel that there is nothing to contradict that the School website was up and running at least since 1-12-2002 as noted on the web pages.

Further, Complainant produced various documents to show that Respondent joined the Information Technology (IT) Department of the School in August 2005. In the minutes of a meeting on 30.8.02 of the IT Panel (chaired by the Head of IT and attended by Respondent) it was noted that Respondent was deployed to be the web administrator. There was also a later General staff meeting on 19.9.03, whereby the minutes set out the directives of the Principal that forthwith a Mr Chan was to assume the editorial role of the website, Respondent’ s involvement would be confined to technical support. While Respondent was not present in the latter meeting, the School’ s head of IT confirmed by statement that he had briefed Respondent on the directives. Respondent refused to accept the propriety of the relevant minutes. Whatever may be the basis of Respondent’ s contention, it is suffice to say that there is nothing to detract from the clear evidence in the web pages that the School website started its life from 1-12-2005, if not earlier. The documentary evidence, in particular the minutes are entirely consistent with this fact.

Having regard to the evidence on the use that the website at the domain names had been put to, the Panel does not accept Respondent’ s contention that the website had been his private and voluntary website with unofficial school information. As found by the Panel above, the website was up and running as an official School website as least since 1-12-2002 until it was brought down by Respondent when left in May 2004. The Panel finds that the association of Respondent with the domain names during the period were entirely in connection with his duties as the School’ s webmaster and no separate right or interests to the domain names been acquired by Respondent.

According to Respondent, the website has been redesigned by him when the original website content was returned to the School. Selected Web pages of the redesigned website were produced by Complainant. In examining the extract dated 21 June 2004, the Panel notes that it notified the temporary suspension of the Hong Kong Sea School website with an article apparently written by Respondent and some photographs of students. In extracts of later dates, there were a few more articles and in the extract in November 2004, the website made reference to it being a non-official website. It is clear that the unofficial website of the Respondent only came into being after the resignation of Respondent from the School in May 2004. The use contrary to the ongoing use of the website as an official website could not be said to be a legitimate non-commercial or fair use of the domain.

Further, in reply to the Panelist’ s request, it is the evidence of Respondent that before hongkongseaschool.org was used to store content relevant to the School, it was used to store the JGCRC (James College Graduate Common Room Committee) website of the University of York and on it was Respondent’ s resume for job hunting. These uses also would not confer right or interests to the domain names on Respondent.

The Panel is satisfied that Respondent has no right or legitimate interests in the domain names.

In Respondent’ s contention, he makes a distinction between domain names and websites. He asserted that “It is not the websites that I registered. I registered the domains.” Having resigned on 18 May 2004, Respondent took that he has right over the contents of the website and the right to prevent others from tampering with the contents at the website because the domain names were registered at his own initiative and the relevant fees and charges were paid by him. If Respondent’ s contention were correct, it would, without more, confer absolute right on registrants to hold onto domain names. Under the Policy, provided the requirements under Paragraph 4(a) are met with by complainants, transfer of domain names could be ordered.

The panel is satisfied that requirements under Paragraph 4(a)(ii) have been met with by Complainant.

Bad Faith

It is provided under Paragraph 4 (b) of the Policy that:

“For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the

trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
 (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
 (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.”

The Panel notes that in Respondent's letter dated the 26-4-2004 to Head of the School IT, he refers to "I suggest the school should obtain adequate information of hosting plan before making a prompt decision on 'buying' the domain that I currently own." Further, in Respondent's Form R in the Remedies Sought, Respondent remarked that "negotiation is possible for transferring of domain names if it could be conducted without the insulting and erroneous allegations against me mentioned in the complaint." It is not in dispute that the Complainant had been prepared to reimburse the fees and expenses of Respondent for the domain names. Respondent had however declined to claim reimbursement. In the concluding paragraph of Respondent's letter dated 26-4-04, he stated that "The school should have much consideration and deliberation before making a decision on what hosting service the school requires. Obviously, your suggestion to reimburse the domain name ... was inappropriate." It is the finding of the Panel that the letter of 26-4-04 of Respondent, reading the two extracts together, does suggest that Respondent was looking for consideration more than his out-of-pocket expenses. The Panel finds that the requirement of Paragraph 4(a)(iii) has been proven on the basis of Paragraph 4 (b) (i).

Further, having regard to the finding above that the domain names had been used as the official website of the school at least since 1-12-2002 and that Respondent was the very web administrator designated by the School as the webmaster of the website, the bringing down of the School official website by Respondent immediately upon his resignation for other uses evinced an intention to prevent Complainant from reflecting the Hong Kong Sea School mark in the corresponding domain name. While Respondent did not engage in a pattern of such conduct as required under Paragraph 4(b)(ii), and Paragraph 4(b)(ii) would not apply, the Panel is of the view that, the special circumstances of this case should be evidence that the retention of the registration for a separate use was a use in bad faith. The Panel notes that Paragraph 4 (b) of the Policy does not limit finding of bad faith in the use to the circumstances set out there.

The Panel is satisfied that the requirements of Paragraph 4(a)(iii) have been met with by Complainant.

Status

www.hongkongseaschool.com	Domain Name Transfer
www.hongkongseaschool.org	Domain Name Transfer

Decision

In paragraph 9 of the Complaint, Complainant sought to restore ownership and control of the domains in question to the School. In light of the findings made above and having regard to the remedies stipulated in Paragraph 4(i) of the Policy, the Panel orders that the domain names hongkongseaschool.com and hongkongseaschool.org be transferred to Complainant, The Hong Kong Sea School.

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