



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

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Decision Submission

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Version
 Decision ID DE-0900217
 Case ID HK-0800237
 Disputed Domain Name www.長江基建.com
 Case Administrator Ricky Wong
 Submitted By Shaojie Chi
 Participated Panelist

Date of Decision 17-04-2009

Language Version : English

The Parties Information

Claimant Cheung Kong Infrastructure Holdings Limited
Respondent ng River (Ji Jian) Trading

Procedural History

On December 8, 2008, the Complainant submitted its Complaint in English to the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (the “Centre”), in accordance with the Uniform Domain Name Dispute Resolution Policy (the “Policy”) adopted by the Internet Corporation for Assigned Names and Numbers (“ICANN”) on August 26, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”) approved by ICANN on October 24, 1999, and Asian Domain Name Dispute Resolution Center Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “ADNDRC Supplemental Rules”) being effected on February 28, 2002. The Center confirmed the receipt of the Complaint on December 11, 2008.

On December 11, 2008, the Center notified the Registrar of the dispute, asking for the confirmation on the disputed domain name, and the latter confirmed the registration information on December 12, 2008.

On December 12, 2008, the Center conveyed the Complaint to the Respondent; and notified the party several times of making defense, but received no answer. On January 29, 2009, the Center notified the Complainant that no answer was received by the Center; and on the same day received a message from the Respondent asking for the resending of the Complaint and the extension of the deadline for making the defense to February 28, 2009.

After several email communications with the disputing parties, the Center decided to extend the time limitation for the Respondent to make the defense to February 18, 2009, and notified the parties of the decision on February 6, 2009.

The Respondent submitted its defense on February 16, 2009, and the Center notified the Complainant of the receipt of the defense on February 23, 2009.

The Center notified the parties of the commencement of the proceeding and the claims had been confirmed

and forwarded; and notified ICANN and Registrar of the start of the proceedings.

As the disputing parties request for a one-expert Panel to make the decision, the Center communicated with the parties for the constitution of the Panel and recommended 5 candidates for the parties' choice. In accordance with the rules indicated in the communications with the disputing parties, and having received a Declaration of Impartiality and Independence and a Statement of Acceptance from Mr. Chi Shaojie, the Center informed the Complainant and the Respondent of the appointment of Mr. Chi to be the sole panelist to render the decision on the case before April 6, 2009.

The sole panelist finds that the panel was properly constituted and appointed in accordance with the Rules and the ADNDRC Supplemental Rules.

The disputing parties submitted supplemental documents stating their views, arguments, comments, statements or defenses, etc., and the Center conveyed all the materials to the opposite party.

The Panel confirmed receipt of all the email or hard-copy documents dispatched by the Center.

The procedural language is English, as being the language of the Domain Name Registration and Service Agreement, pursuant to Paragraph 11(a) of the Rules.

Factual Background

For Claimant

The Complainant contends that it is a limited company incorporated in Bermuda on June 24, 1996, and registered in Hong Kong as an overseas company on July 1, 1996. The Complainant was listed on the Stock Exchange of Hong Kong in July 1996. The Complainant's business name is Cheung Kong Infrastructure Holding Limited (长江基建集团有限公司). As of December 31, 2007, the Complainant's market capitalization was approximately HK\$ 65 billion. As the Complainant is a member of the Cheung Kong Group and focuses on infrastructure and related business, the Complainant adopted “长江基建集团有限公司”, “长江基建集团” and “长江基建” as its service marks / trade-name since June 1996. The Complainant has extensive involvement in infrastructure business in China, Hong Kong and overseas countries ever since its incorporation. The Complainant claims rights in the service marks/names “长江基建集团有限公司”, “长江基建集团” and “长江基建”. The major part of the disputed domain name is identical to the Complainant's entitled service marks/names, and the Respondent has no linkage to the word “长江基建” and enjoys no rights and legitimate interests in relation to the disputed domain name. The Respondent registered and used the disputed domain name in bad faith. For the foregoing reasons, the Complainant requests the Panel to make a ruling on the transfer of the disputed domain name.

For Respondent

The Respondent argues that the Complainant does not have any registered mark in relation to the disputed domain name. The Respondent's name is Long River (Ji Jian) Trading Inc. (长江基建贸易有限公司), and by careless mistake, was registered as “ng River (Ji Jian) Tradeing”. Both Long River (长江) and Ji Jian (基建) are generic terms. “长江基建” is the key component of the Respondent's name. The Complainant fails to prove that it owns a registered mark in relation to “长江基建”, and it is a key factor in talking on the issue of identity or confusing similarity of the Complainant's registered mark and the disputed domain name. Also, the Respondent did not register and use the disputed domain name in bad faith. As it is, the Respondent request the Panel to reject the claims by the Complainant's.

Parties' Contentions

Claimant

The Complainant's essential contentions include:

The Complainant claims rights in the service marks/names “长江基建集团有限公司”，“长江基建集团” and “长江基建”；

The major part of the disputed domain name is identical to the service marks/names claimed by the Complainant;

The Complainant has never empowered the Respondent to register and use the claimed service marks/names; and the latter has no rights or legitimate interests in relation to the disputed domain name;

The disputed domain name is linked to a web-page providing search service, indicating the registration of the disputed domain name has no purpose other than to create confusion that such registration is endorsed by the Complainant and thereby attracting internet users to visit the Respondent's website thinking that it is related to the Complainant.

Respondent

The Respondent's essential arguments are:

The Complainant fails to prove that it has any registered service mark;

Both “长江” and “基建” are generic terms to which the Complainant has no exclusive right;

The Respondent's trade name includes “长江” (Long River) and “基建” (Ji Jian) ; the Respondent has the rights and legitimate interests in using the two words as its domain name;

The company and its director (a Taiwanese) did not have any knowledge of the Complainant before and after the domain name purchase.

Since the Chinese IDN domain names traffic has been minimal, so claiming that the Respondent is confusing the public, attracting traffic, riding on reputations or for commercial gains …… are all groundless.

Findings

One of the Pre-requisites for the Respondent to register the disputed domain name through the Registrar is to accept the Policy as the binding regulations. As mentioned, the Policy applies to this dispute. It is stipulated in the Paragraph 4(a) of the Policy, when claiming back the domain name registered by the Respondent, the Complainant has to prove each and all of the following:

- (i) That the domain name of 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.

Based itself upon the stipulations under the Policy, what the Panel needs to do is to find out whether each and all of the above-mentioned facts can be established by the Complainant. If the answer is yes, the Panel makes final award in accordance with the fact-finding and the relevant stipulations under the Policy, the Rules and the ADNDRC Supplemental Rules. If not, the claims by the Complainant shall be rejected.

Identical / Confusingly Similar

Pursuant to Paragraph 4(a) (i) of the Policy, the Complainant has to prove that the domain name is identical or confusingly similar to a trademark or service mark in which it has rights. The Panel notices that the Complainant does not claim any REGISTERED trademark or service mark in this case; and the essential contest by the Respondent is that the Complainant does not have any registered mark, thus having no exclusive right on the disputed domain name containing the Chinese characters “长江基建” .

It is necessary to point out that while making a decision on whether the Complainant meets the first requirement under Paragraph 4(a)(i), the Panel has to fully understand the essential meaning as stipulated. The Paragraph 4(a)(i) says: “your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.” It is significantly noticeable that what the Complainant needs to prove is not the fact of REGISTRATION OF A MARK, but A MARK IN WHICH IT HAS RIGHTS. As is known to all, First-to-Use and First-to-File are the two major principles adopted nowadays by different

nations or regions in establishing trademark mechanism. That may be the underlying factor in making the wording of the Paragraph 4(a)(i) of the Policy. It is comparatively easier for the Complainant to prove its rights on a mark by registration certificate. But it is not the ONLY way to prove the Complainant's claimed rights on a mark. In present case, the Complainant claims its rights on service mark “长江基建集团” or “长江基建” by submitting evidences certifying that the marks have been extensively used in its service to the customers in China, Hong Kong and some other countries or regions. Based upon the exhibits by the Complainant, the Panel holds that before the registration of the disputed domain name, the Complainant has been using the mark “长江基建集团” or “长江基建” in its business activities, in which the Complainant may claim rights, e.g. by the standard of the case-law jurisdiction.

It has to emphasize that the Panel is not discussing the issue that WHETHER THE MARK “长江基建集团” or “长江基建” CLAIMED BY THE COMPLAINANT COULD BE ENFORCED UNDER THE LAWS OF EITHER CHINESE OR OTHER JURISDICTIONS, but the issue that WHETHER THE COMPLAINANT CAN PROVE THAT IT HAS RIGHTS ON THE CLAIMED MARK “长江基建集团” or “长江基建”. The gap is that when discussing the former issue, specific national or regional law shall be governing, which usually adopts either the principle of First-to-use or that of First-to-file; while talking on the latter issue, both of the two principles, i.e. First-to-Use and First-to-File, need to be taken into consideration in making judgment on the issue whether the Complainant is entitled to a trademark or service mark in which it has rights.

As held by the Panel, the Complainant is in a position to claim rights on the alleged mark “长江基建集团” or “长江基建” by reason that it establishes that prior to the registration of the disputed domain name it had been extensively using the mark in providing service to its customers in China, Hong Kong and some other nations and regions. What the Panel needs to do next is to identify whether the disputed domain name is identical or confusingly similar to the mark claimed by the Complainant.

As demonstrated, the differences between the disputed domain name and the Complainant-claimed mark is “.com”. Since this is a dispute relating to the registration of a domain name, “.com” has generally no significant meaning in making the judgment on the identity or confusing similarity of the disputed domain name and the mark claimed by the Complainant. Taking out the “.com” component, it is apparent that the identifying part of the disputed domain name is confusingly similar to the service mark “长江基建集团” as claimed by the Complainant, due to fact that the Chinese characters “集团” reveal the business scale of the Complainant's and has no substantive impact on the Complainant's trade name “长江基建”. If one compares the identifying part of the disputed domain name with the claimed service mark “长江基建” of the Complainant's, the identity is self-explanatory. Based upon this fundamental fact, the Panel holds that the disputed domain name is identical to the service mark in which the Complainant has rights by the fact held by the Panel. Since the Policy asks for either “identity” OR “confusingly similarity”, the Panel holds that the Complainant meets the first requirement set forth under Paragraph 4(a)(i) of the Policy.

Rights and Legitimate Interests

Paragraph 4(c) of the Policy stipulates how the Respondent can effectively demonstrate rights or legitimate interests in respect of the disputed domain name. The Respondent alleges that its company name is “长江（基建）贸易有限公司” [Long River (Ji Jian) Trading Inc.]. Therefore, it does have rights and legitimate interests in respect of the domain name at issued. The Respondent submitted the Certificate of Incorporation, and also cites the WIPO case 2007-0477 as saying that Respondent has a legitimate right or interest is enough, it does not need to be a better interest, to support its allegation of rights and legitimate interests. As per the allegations by the Respondent's, the Panel is of the following opinions:

1. There is meaningful necessity to make clear of the legal nature of the current proceedings. As noted in the Point 2 in the Preface of the Policy, “This policy has been adopted by all accredited domain-name registrars for domain names ending in .com, ……” As mentioned in Paragraph 4(a) of the Policy, “you are required to submit to a mandatory administrative proceeding in the event that a third party (a ‘Complainant’) asserts to the applicable Provider, in compliance with the Rules of Procedure, that ……” Obviously, when making registration of a domain name, the registrant is required to include the Policy in the Registration Agreement as part of its contractual obligation in making registration of a domain

name. As it is, the proceeding for the resolution of the dispute on a registered domain name should be regarded as part of the whole proceedings for the domain name registration. That is to say, when a dispute on a registered domain name arises, an independent and impartial panel is requested to decide to which party it is suitable to give the disputed domain name.

2. The Panel attends to the facts that either of the disputing parties cited preceding awards made by panels constituted by this or other domain name dispute resolution institutions. As indicated in the Policy, the proceeding for the resolution of the dispute on a registered domain name is sort of Mandatory Administrative Proceeding that is different from the arbitration or court proceedings. There is no stipulation in the Policy saying that precedents shall be taken as binding criteria on the follow-up decisions. Speaking of citation of precedents, either of the disputing parties may cite precedents in its favor. It is understandable that each award was made by specific panelist(s) based upon his or her professional experiences and personal comprehension on the stipulations under the Policy, thus the fundamental reasoning of the precedents may be different or even adverse. It is clear that this Panel shall not be bound by any other existing awards on domain name disputes, and will make a final award on the present case based fully upon its comprehension of what is stipulated under the Policy and the reasoning of its own.

3. The Panel understands that the orientation and the primitive consideration of the Policy are to protect the rights and legitimate interests of the appropriate right-holders of the registered domain names, as well as those of the web-users'. From this perspective, while judging if the Complainant meets the second requirement set forth under Paragraph 4(a)(ii), the Panel should take all relevant factors into consideration. In the present case, both of the disputing parties claim rights and legitimate interests in relation to the disputed domain name based upon their trade names. Under the circumstances, what the Panel needs to do is to identify which of the reasons by the parties prevails, which should be different from the term "better interest" cited by the Respondent from a WIPO case.

4. The Complainant alleges and proves that its registered company name is Cheung Kong Infrastructure Holding Limited, and its Chinese equivalent is 长江基建集团有限公司 as shown in the Certificate issued by the Business Registration Authorities in Hong Kong. Out of which the words Cheung Kong is the Cantonese pronunciation of the Chinese characters 长江; the word Infrastructure can be translated into Chinese characters 基建; and the English words Holding Limited are the equivalents of the Chinese characters 集团有限公司, indicating the business scale and the organizational pattern of the registered.

On the other hand, the Respondent alleges and proves that its registered company name is Long River (Ji Jian) Trading Inc. The Chinese name of the Respondent's in the Certificate of Incorporation is "长江（基建）贸易有限公司". As is globally known, the English equivalent of the Chinese characters 长江 is Yangtse River but not Long River. The word "Ji Jian" sounds to be phonetic spelling of the Chinese characters "基建" from the mainland-based Chinese perspective. As a matter of fact, the Respondent made the business registration in Samoa, the mother tongue of which country is NOT Chinese; thus people there know the Respondent by the name of Long River that is absolutely NOT the Yangtse River as is shown in most of the Chinese-English bilingual dictionaries and known to people world-wide. As to the word "Ji Jian", no English-speaking people can link it to the Chinese characters "基建", and most probably, they do not understand the meaning of the word "Ji Jian".

As held by the Panel, the Complainant's original registered business name is Cheung Kong which is the equivalent of the Chinese characters 长江 by Cantonese pronunciation. What is more, the Complainant registered its name in Hong Kong under both the English and the Chinese words that are equivalent. Undoubtedly, the Complainant is known world-wide as Cheung Kong, and known in Cantonese-or—Mandarin-speaking areas as Cheung Kong or 长江.

Based upon the above facts and from the perspective of fundamental function of the NAME, and in view of the general consideration of the interests of the web-users, the Panel comes to the conclusion that the Complainant should deserve to be known as "长江基建" on the web-site.

5. The Complainant registered its business name using the words Cheung Kong Infrastructure (长江基建) more than 10 years earlier than the Respondent started to use its name Long River (Ji Jian) (长江基建). It

should be emphasized that we are NOT talking about whether the Respondent is entitled to the use of its company name containing the words Long River (Ji Jian) (长江基建), but whether it has rights or legitimate interests in respect of the domain name containing the Chinese characters 长江基建. Obviously, the Complainant is entitled to the trade name Cheung Kong Infrastructure (长江基建) more than 10 years prior to the coming into being of the Respondent. Since what the Panel needs to do is to make a judgment on which party has rights or legitimate interests IN RESPECT OF THE DOMAIN NAME, it is significant to make a conclusion primarily from the point-of-view of NAMES, owing to the fact that trade name is the party's name in real business world, and the domain name is the party's name on web-site; and the web-users may easily find out on web-site what they intend to find out in real business world in case of the identity of the two names. In this sense, the party whose names in real business world and on the web-site are identical should be held as the one who has rights and legitimate interests in relation to a domain name in dispute.

6. The Respondent argues that both the word Cheung Kong (长江) and the word Infrastructure (基建) are generic words. It is true when separate the two with each other, e.g. when people see the term Cheung Kong (长江), what they may think of is most probably the Yangtse River; while people see the term “基建”, they may think of the infrastructure construction. That is to say, when people see the two terms separately, they may hardly link either of the two to the Complainant. Nevertheless, it will be totally different when people see the combination of the two separate terms, i.e. the integrated term of Cheung Kong Infrastructure (长江基建). As proved by the Complainant, it is known in Hong Kong and the Mainland as “长江基建集团”. In this case, when people see the term Cheung Kong Infrastructure (长江基建), they may naturally think of the Complainant. On the other hand, since the disputed domain name is “长江基建.com”, people in the place where the Respondent made the business registration can hardly understand the meaning of the Chinese characters, due to the fact that NOT many people in Samoa understand Chinese; and people in Hong Kong or Mainland China can hardly link the domain name to the Respondent, or they may misunderstand that the user of the domain name may have certain linkage to the Complainant.

7. The Paragraph 4(c) of the Policy specially mentions 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 preparation 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 Respondent did not prove any of the above-mentioned situation. Hence, the Panel can hardly resort to the stipulation under Paragraph 4(c) to hold that the Respondent has rights or legitimate interests in relation to the domain name at issue.

For all the foregoing reasons, the Panel is in a hard position to hold that the Respondent has rights or legitimate interests in relation to the domain name at issue; and further holds that the Complainant meets the second requirement set forth under Paragraph 4(a)(ii).

Bad Faith

To claim back the disputed domain name, the Complainant also has to establish the fact of bad faith on the part of the Respondent as set forth in the Paragraph 4(a)(iii) of the Policy. First and foremost, the bad faith reflects the subjective desire of the registrant of the disputed domain name at the time of making the registration. As demonstrated by the Complainant, its trade name and the marks used in the business activities are well-known either in China (incl. Hong Kong) or in other places in the world. Linguistically and phonetically, the term “长江基建” is NOT a common Chinese term that may be easily searched out in the Chinese dictionaries. Obviously, the term “长江基建” was created intentionally by the Complainant to distinct itself from other business operators in the market. Years of market operation make

the Chinese characters “长江基建” familiar to the majority of the relevant customers in China and other areas. Based upon this fundamental fact, the Panel thinks that the Respondent knew, or at least should have known, the reputation and value of the Chinese characters “长江基建”. The Respondent argues that both it and its Taiwanese director did not know the Complainant before the present case; but fails to put forward any logical and reasonable explanations. The simple question is, since the term “长江基建” is not a term used in the daily life or business activities in China or other Chinese-speaking areas, and not a term which can be accessible in most of the Chinese dictionaries, how the Respondent thought of such a term as its trade name in its business; in particular, its business is TRADING which has nothing to do with “Ji Jian” (基建). That is to say, the probability of the coincidence that the Respondent creates the identifying part of the disputed domain name without knowing the Complainant is much low; at least the Panel does not see to the contrary.

As held by the Panel, the disputed domain name is identical, or at least confusingly similar, to the trade name and the marks that the Complainant may claim rights, and the Respondent has no rights or legitimate interest in the disputed domain name. The holding itself becomes the base for the Panel’s holding of the Respondent’s bad faith in registration, because it reveals the subjective desire of the Respondent to make use of the Complainant’s reputation to gain unfair commercial interests. It is necessary to point out, in terms of the “Unfair Commercial Gains”, what the Panel has to be based is NOT to be a proved fact, but sort of likelihood or possibility presumed by the panelist’s logical thinking based upon all the needed factors. The simple logical thinking is, what is the explanatory bona fide purpose of the Respondent’s at the time of making the registration of a domain name with a term as its identifying part that is NOT general and can not be accessible in any Chinese dictionaries, and the probability of the Respondent’s independent creation of the term is near to zero?

Under the Paragraph 4(b) of the Policy, the following circumstances, in particular, shall be considered as the bad faith in the registration or use of a domain name, “……. (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complaint’s mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or a product or service on your web site or location; ……” The Complainant submits and proves that the Respondent has directly hyper-linked the disputed domain name to a web-site that has nothing to do with the Complainant. As a matter of fact, the only Chinese characters on the web-page are “长江基建”. Naturally, lacking of any indication making the inter-net users think otherwise, the web-users may be misled to link the Respondent to the Complainant, and so far, the Panel sees no evidences or any logical explanations that may lead the Panel to think to the contrary. Thus, the Panel has full reason to hold that the disputed domain name was used in bad-faith.

Since the Panel comes to see the bad faith of the Respondent’s in the registration and use of the domain name at issue, the Panel comes to the conclusion that the Complainant meets the requirement set forth under Paragraph 4(a)(iii) of the Policy.

Based upon all the foregoing findings, the Panel rules that the Complainant fulfills the conditions provided in Paragraph 4(a)(i)(ii) (iii) of the Policy, thus its claims shall be held.

Status

www.长江基建.com Domain Name Transfer

Decision

In light of all the fact-findings and in accordance with Paragraphs 4(a), 8(a) of the Policy and 5(e) of the Rules, the Panel holds:

a) That the disputed domain name “长江基建.com” is identical, or at least confusingly similar, to the mark “长江基建集团” or “长江基建” which was used by the Complainant in its business activities at

least 10 years prior to the registration of the disputed domain name and to which the Complainant has rights;
and

- b) That the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- c) That the domain name was registered and subsequently used by the Respondent in bad faith.

As such and as requested by the Complainant in its Complaint, the Panel rules that the registration of the domain name “長江基建.com” be transferred to the Complainant.

Chi Shaojie
Sole Panelist-
Dated: April 15, 2009