



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1600901
Complainant:	KKBOX Taiwan Co., Ltd.
Respondent:	nop
Disputed Domain Name(s):	<kkboxmusic.com>

1. The Parties and Contested Domain Name

The Complainant is KKBOX Taiwan Co., Ltd., of 1F., No. 19-3 SanChong Road, NanGong District, Taipei, Taiwan.

The Respondent is nop, of No. 156-3, Sec. 1, Zhongshan Rd, New Taipei City, Banqiao Dist, 220, US.

The domain name at issue is <kkboxmusic.com>, registered by Respondent with Tucows, Inc., of 96 Mowat Avenue, Toronto, Ontario, M6K 3M1, Canada.

2. Procedural History

On 21 September 2016, the Complainants submitted a Complaint in the English language to the Hong Kong Office of the Asian Domain Name Dispute Resolution Center (the ADNDRC) and elected this case to be dealt with by a one-person panel, in accordance with the Uniform Domain Name Dispute Resolution Policy (the Policy) approved by the Internet Corporation for Assigned Names and Numbers (ICANN), the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules), and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the ADNDRC Supplemental Rules). On 21 September 2016, the ADNDRC sent to the complainants by email an acknowledgement of the receipt of the complaint. All correspondence to and from the ADNDRC described herein was in the English language.

On 21 September 2016, the ADNDRC transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same date, the Registrar transmitted by email to the ADNDRC its verification response. On 27 September 2016, the ADNDRC notified the Complainant of deficiencies of the Complaint. On 28 September 2016, the Complainant submitted to the ADNDRC the amended Complaint.

On 29 September 2016, the ADNDRC transmitted the Complaint to the Respondent and notified the Respondent of the commencement of the action and requested the Respondent

to submit a Response within 20 calendar days. Since the Respondent failed to submit a Response within the specified period of time, the ADNDRC notified the Respondent's default on 20 October 2016.

Since the Respondent did not mention the Panel selection in accordance with the time specified in the Rules, the ADNDRC Supplemental Rules, and the Notification, the ADNDRC informed the Complainants and Respondent that the ADNDRC would appoint a one-person panel to proceed to render the decision.

Having received a Declaration of Impartiality and Independence and a Statement of Acceptance on 24 October 2016, the ADNDRC notified the parties that the Panel in this case had been selected, with Prof. ZHAO Yun acting as the sole panelist. The Panel determines that the appointment was made in accordance with Rules 6 and Articles 8 and 9 of the Supplemental Rules. On 24 October 2016, the Panel received the file from the ADNDRC and should render the Decision within 14 days.

Pursuant to Paragraph 11 (a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding. The language of the current disputed domain name Registration Agreement is English, thus the Panel determines English as the language of the proceedings.

3. Factual background

For the Complainant

The Complainant in this case is KKBOX Taiwan Co., Ltd., a corporation registered in Taiwan. The registered address is 1F., No. 19-3 SanChong Road, NanGong District, Taipei, Taiwan. The authorized representative in this case is Mayer Brown JSM.

For the Respondent

The Respondent, nop, is the current registrant of the disputed domain name <kkboxmusic.com> according to the Whois information. The registered address is No. 156-3, Sec. 1, Zhongshan Rd, New Taipei City, Banqiao Dist, 220, US.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

The Complainant is known as KKBOX, and operates its business through a number of subsidiaries and affiliates (collectively referred to as the "KKBOX Group"). The KKBOX Group was first established in Taiwan in 2004. It is headquartered in Taiwan, with offices located in Japan, Hong Kong, Thailand, Malaysia and Singapore. The KKBOX Group is the leading provider in Asia of music streaming services. It has support from more than 500 international major and local independent music labels, and features 20 million legal tracks, including the

most comprehensive Asian-Pop music library. The KKBOX Group's music streaming service is currently available in Taiwan, Hong Kong, Japan, Singapore, Malaysia and Thailand, and currently has over 10 million users. Its investors include the KDDI Group (Japan's second largest telecommunications company), HTC Corporation, Taiwan's Chunghwa Telecom and Singapore's GIC (Singapore's sovereign wealth fund).

The growth and success of the Complainant have garnered a significant amount of media attention and resulted in a high public profile for the Complainant and its brand globally, particularly in Taiwan. Among them are articles published in some of the world's most highly respected and well-read newspapers and magazines.

The Complainant's services have always been carried on, supplied and marketed continuously and substantially under and/or by reference to the KKBOX Trade Marks registered in various jurisdictions around the world. The Complainant first started using the "KKBOX" brand in 2004. Since then, the KKBOX Trade Marks have acquired distinctiveness through extensive use by the Complainant in commerce, so that the KKBOX Trade Marks are immediately recognizable to consumers as being associated with the Complainant and its business.

The disputed domain name was registered on 8 February 2016. The disputed domain name currently resolves to a website that replicates the Complainant's official website at <kkbox.com> via framing.

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that in the administrative proceeding, the Complainant must prove that each of the following three elements is present:

- i) The disputed domain name(s) is/are identical or confusingly similar to a trademark or service mark in which the Complainant has rights:

The Complainant and its affiliates have obtained trademark registrations for the KKBOX brand in many jurisdictions around the world, including Taiwan, Hong Kong and Singapore. The Taiwan Intellectual Property Office has also officially recognized the Complainant's "KKBOX" trade mark as a well-known trade mark. Therefore, the Complainant has established that it has rights in the KKBOX Trade Marks, including "KKBOX" in Taiwan, which it first registered and first began using in 2004.

The disputed domain name (<kkboxmusic.com>) incorporates the Complainant's "KKBOX" trade mark in its entirety. The only difference between the disputed domain name and the Complainant's "KKBOX" trade mark is the inclusion of "music" as a suffix. The Complainant submits that "music" is a generic word which is descriptive of the Complainant's services. As a result, the suffix "music" does not negate the confusing similarity between the disputed domain name and the Complainant's "KKBOX" trade mark.

Further, it is established that in making an enquiry as to whether a trade mark is identical or confusingly similar to a domain name, the domain extension, in this case <.com>, should be disregarded. The Complainant accordingly submits that it has proved that the disputed domain name is identical and/or confusingly similar to its registered trademarks in which the Complainant has rights or interests for the purpose of paragraph 4(a)(i) of the Policy.

- ii) The Respondent has no rights or legitimate interests in respect of the domain name(s):

Since their first use by the Complainant in 2004, the KKBOX Trade Marks have acquired distinctiveness through their extensive use by the Complainant and its affiliated companies in commerce, so that the KKBOX Trade Marks, including the “KKBOX” mark, are immediately recognizable to consumers as being associated with the Complainant, its affiliates, and their business.

The Respondent registered the disputed domain name on 8 February 2016 – 12 years after the “KKBOX” trade mark was first registered and used by the Complainant. The Complainant has not licensed, consented to or otherwise authorized the Respondent’s use of its KKBOX Trade Marks for any reason whatsoever, nor is the Respondent an authorized representative or partner of the Complainant.

Given the fame of the KKBOX Trade Marks, coupled with the fact that it is a made-up word uniquely associated with the Complainant, and the Complainant’s adoption and first use of the KKBOX Trade Marks significantly predates the Respondent’s registration and use of the disputed domain name, has the practical effect of shifting to the Respondent the burden of proof in establishing that it has rights and/or legitimate interests in the disputed domain name.

There is no evidence to suggest that the Respondent has been commonly known by the disputed domain name. The Respondent’s name does not reflect or correspond with the disputed domain name, and there is no justification or apparent need for the Respondent to use “kkbox” in the disputed domain name.

Further, to the best of the Complainant’s knowledge and information, the Respondent does not own any trade mark registrations reflecting or corresponding to the disputed domain name in Taiwan (where the Respondent is apparently domiciled). It is logical to presume that Taiwan would be the first jurisdiction in which the Respondent would seek to register a trade mark corresponding to the disputed domain name, since the Respondent is allegedly domiciled in Taiwan.

The disputed domain name currently resolves to a website that replicates the Complainant’s official website at <kkbox.com> via framing. This cannot amount to a right or legitimate interest in respect of the disputed domain name, as such use of the disputed domain name (which is confusingly similar to the Complainant’s trade marks in which it has prior registered rights) will inevitably mislead users into believing that it is associated with the Complainant and may unfairly divert users, enabling the Respondent to make a commercial gain (e.g. pay-per-click revenue) or otherwise disrupt the Complainant’s business.

The Complainant accordingly submits that it has proved that the Respondent has no right or legitimate interest in respect of the disputed domain name for the purpose of paragraph 4(a)(ii) of the Policy.

- iii) The disputed domain name(s) has/have been registered and is/are being used in bad faith:

The Respondent has no rights or legitimate interests in the disputed domain name, which is in itself evidence of bad faith. The disputed domain name does not reflect or correspond to the Respondent’s own name, and the Complainant’s “KKBOX” trade mark is a coined term that has no meaning other than in relation to the Complainant and its business. This lends support to the presumption that the Respondent knew about the Complainant’s KKBOX Trade Marks at the

time he registered the disputed domain name, and that the Respondent's registration was motivated solely to take advantage of the Complainant's reputation in the KKBOX Trade Marks and thereby make undue profits.

Furthermore, the Complainant began using the "KKBOX" trade mark in 2004 – 12 years before the disputed domain name was registered. The "KKBOX" trade mark has acquired distinctiveness through its extensive use for several years by the Complainant, so that the mark is immediately recognizable to consumers as being associated with the Complainant and its business. The Respondent is also located in Taiwan, where the Complainant is particularly well-known and where the Complainant's "KKBOX" mark has been recognized by the Taiwan Intellectual Property Office as a well-known mark. It is therefore inconceivable that the Respondent was not aware of the Complainant's KKBOX Trade Marks at the time he registered the disputed domain name.

As stated in *Alibaba Group Holding Limited v. Giovanni Tosi*, WIPO Case No. DES2014-0020, the Expert held that: "it is more than likely that the Respondent was well aware of the Complainant and its use of its ALIEXPRESS mark, given the Complainant's widespread use of the mark in connection with its online activity. Accordingly, the Expert finds that the Respondent's registration and use of the disputed domain name that incorporates the Complainant's ALIEXPRESS mark in its entirety with a minor misspelling constitutes bad faith...The Expert determines that in the present case, bad faith is shown in that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's mark...The fact that the disputed domain name currently resolves to a parked website with advertisement links does not change the Expert's findings above but is a further indication of bad faith." This same reasoning can be applied in this case, where the disputed domain name is set to resolve to a website that replicated the Complainant's official website at <kkbox.com> via framing.

It is well established that the Respondent's registration and use of the disputed domain name must involve mala fides where the registration and use of it was and continues to be made in the full knowledge of the Complainant's prior rights in the KKBOX Trade Marks, and in circumstances where the Respondent did not seek permission from the Complainant, as the owner of the trade marks, for such registration and use.

Due to: (i) the confusing similarity between the disputed domain name and the KKBOX Trade Marks; (ii) the fact that the Respondent's name does not in any way correspond to the disputed domain name; and (iii) the Respondent had to have been aware of the Complainant and its KKBOX Trade Marks (for the reasons stated above), the Respondent's use of the disputed domain name to resolve to a website that replicates the Complainant's official website at <kkbox.com> via framing is clearly in bad faith. As stated in earlier decisions, "there is no reasonable explanation for such use of the disputed domain name except that the Respondent seeks to exploit the reputation and goodwill of the Complainant's marks by attracting Internet traffic to the Respondent's website or to mislead customers to believe that the Complainant is in some way associated with the Respondent's website".

In these circumstances of blatant misappropriation of the Complainant's "KKBOX" brand, there can be no possible grounds on which to find that the Respondent's registration and use of the disputed domain name has been otherwise than in bad faith in order to attract and increase the number of Internet users to the disputed domain name, for commercial gain, by creating a likelihood of confusion with the Complainant's "KKBOX" mark.

The Complainant accordingly submits that it has proved that the Respondent has registered and is using the disputed domain name in bad faith for the purposes of paragraph 4(a)(iii) of the Policy.

The Complainant requests that the disputed domain name be transferred to the Complainant.

B. Respondent

The Respondent failed to submit a Response within the specified time period.

5. Findings

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 in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

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

A) Identical / Confusingly Similar

The Complainant is a company registered in Taiwan providing music streaming services. It was first established in 2004 with physical presence in several Asian countries. “KKBOX” was first registered as trademark in Taiwan in November 2004. The registration date is much earlier than the registration of the disputed domain name (i.e. 8 February 2016). Since then, “KKBOX” has been registered as trademark in several other jurisdictions. The Panel has no problem in finding that the Complainant enjoys the prior rights in the trademark “KKBOX”.

The disputed domain name is “kkboxmusic.com”. The suffix “.com” only indicates that the domain name is registered under this gTLD and is not distinctive. The main part of the domain name (“kkboxmusic”) consists of two sub-parts (“kkbox” and “music”). The first sub-part (“kkbox”) is the same as the Complainant’s trademark. The second sub-part (“music”) is a generic English word and thus is not distinctive; it is exactly something closely related to the services provided by the Complainant (music streaming services).

The addition of a generic word “music” to the Complainant’s trademark “KKBOX” cannot effectively differentiate the main part of the disputed domain name from the Complainant’s trademark; on the contrary, such a combination strengthens the links between the disputed domain name and the Complainant since “music” is closely related to the Complainant’s services. It is further noted that “KKBOX” is not a common word and specifically designed to represent the Complainant’s services. As such, the disputed domain name will be easily mistaken to be owned by the Complainant or at least have some connections with

the Complainant. Therefore, the disputed domain name is confusingly similar to the Complainant's trademark "KKBOX".

Accordingly, the Panel holds that the Complaint fulfills the condition provided in Paragraph 4(a)(i) of the Policy.

B) Rights and Legitimate Interests

The Complainant contends that the Respondent does not have rights to or legitimate interests in the disputed domain name. The Complainant has never authorized the Respondent to use the trademark or the disputed domain name. The Complainant's assertion is sufficient to establish a *prima facie* case under Policy 4(a)(ii), thereby shifting the burden to the Respondent to present evidence of its rights or legitimate interests.

The Respondent has failed to show that the Respondent has any rights or legitimate interests in respect of the disputed domain name. No evidence has shown that the Respondent is using or plans to use the domain name for a *bona fide* offering of goods or services. The Respondent is not commonly known by the domain name. The evidence submitted by the Complainant further shows that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name. The act of registering the disputed domain name does not automatically endow any legal rights or interests with the Respondent.

The Panel therefore finds that the Complaint fulfills the condition provided in Paragraph 4(a)(ii) of the Policy.

C) Bad Faith

Under Paragraph 4(b) of the Policy, the following are relevant examples a Panel may take as evidence of registration and use 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 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 Complainant, as a leading provider in Asia of music streaming services, was established in 2004 and registered the trademark "KKBOX" in Taiwan in the same year. It has been using this trademark for its services since then. Apart from Taiwan, "KKBOX" was also registered as trademark in several other jurisdictions, including Hong Kong and Singapore. The evidence

shows that the Taiwan Intellectual Property Office has officially recognized the Complainant's trademark "KKBOX" as a well-known trademark. "KKBOX" is not a common English word or a name commonly used in business. Through extensive use, promotion and advertisement, the public has come to recognize and associate the Complainant's trademark as originating from the Complainant and no other.

The fact that the website of the disputed domain name resolves to a website that replicated the Complainant's official website at <kkbox.com> via framing is obvious to all that the Respondent is well aware of the existence of the Complainant and its trademark "KKBOX". The action of registering the disputed domain name per se has constituted bad faith. The above action of resolving the website of the disputed domain name to the Complainant's official website will mislead the consumers to believe that the website of the disputed domain name belongs to the Complainant or at least has some connections with the Complainant. This is exactly the type of bad faith use of the disputed domain name as envisaged in Paragraph 4(b) of the Policy, i.e. the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the website or other on-line location, by creating a likelihood of confusion with the Complainant's trademark as to source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

The Panel concludes that the Respondent has registered and used the domain name in bad faith. Accordingly, the Panel finds that the Complaint satisfies the condition provided in Paragraph 4(a)(iii) of the Policy.

6. Decision

Having established all three elements required under the ICANN Policy, the Panel concludes that relief should be granted. Accordingly, it is ordered that the disputed domain name <kkboxmusic.com> should be transferred from the Respondent to the Complainant.

Prof. ZHAO Yun
Panelist

Dated: 7 November 2016