



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1801068
Complainant:	Tencent Holdings Limited
Respondent:	Kevin Zheng
Disputed Domain Name(s):	<qqfamily.com>

1. The Parties and Contested Domain Name

The Complainant is Tencent Holdings Limited, of 29/F, Three Pacific Place No 1 Queen's Road East Wanchai, Hong Kong.

The Respondent is Kevin Zheng, of Room 601, Hua Yuan, Qing Tou Qu, GuangDong 500000, China.

The domain name at issue is <qqfamily.com>, registered by Respondent with Name.com, Inc., of Denver CO 80206, United States.

2. Procedural History

The Complainant filed the Complaint with the Hong Kong Office of Asian Domain Name Dispute Resolution Centre (ADNDRC) on 1 February 2018, in accordance with the Uniform Policy for Domain Name Dispute Resolution, approved by the Internet Corporation for Assigned Names and Numbers (ICANN) on 24 October 1999 (the Policy), the Rules for Uniform Domain Name Dispute Resolution Policy, approved by ICANN Board of Directors on 28 September 2013 (the Rules) and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy effective from 31 July 2015 (the Supplemental Rules).

On 2 February 2018, the Hong Kong Office confirmed receipt of the Complaint. On the same date, the Hong Kong Office sent an email to Name.com, Inc. (the Registrar of the Domain Name) requesting verification in connection with the relevant information of the Domain Name at issue. On 3 February 2018, the Registrar of the Domain Name confirmed that the Respondent is Kevin Zheng and the Domain Name is registered with Name.com, Inc.

On 13 February 2018, the Hong Kong Office sent the Respondent a written notice of complaint which involved a notification that a complaint concerning the Domain Name <qqfamily.com> was submitted against the Respondent and a requirement to submit a

Response within 20 days from 13 February 2018, and forwarded the Complaint (along with its Annexes) to the Respondent pursuant to the Policy, paragraph 4 of the Rules and paragraph 6 of the Supplemental Rules. The formal date of the commencement of the administrative proceeding on was 13 February 2018.

On 14 February 2018, the Hong Kong Office received the Response filed in Chinese from the Respondent and also his request that Chinese be used as the language for the proceeding. In the Response, the Respondent elected a 3-member panel for this matter.

On 15 March 2018, the Hong Kong Office appointed Mr. Jonathan Agmon as the Presiding Panelist, Dr. Timothy Sze and Mr. Raymond Ho as Co-Panelists for this Domain Name dispute; and notified the Complainant and the Respondent of the appointment. Prior to the appointment the panelists had respectively submitted to the Hong Kong Office their Declaration of Impartiality and Independence in compliance with Article 7 of the Rules. On the same date, the case file was transmitted to panelists.

On 19 March 2018, the Complainant filed a request for submitting a supplemental document, which forms a Reply to the Response.

On 20 March 2018, the Respondent filed a request for submitting a supplemental document, which forms additional arguments in reply to the Reply.

On 29 March 2018, the Hong Kong Office informed the parties that the decision of the Panel on this matter will be issued by 12 April 2018.

3. Factual background

The Complainant, Tencent Group, was founded in 1998 and is listed on the Hong Kong Stock Exchange. It is one of the largest Internet service providers in China and consequently in the world.

The Complainant provides Internet, mobile and telecommunication services and online advertising. The Complainant operates leading Internet platforms in China, including QQ (QQ Instant Messenger), WeChat, QQ.com, QQ Games, QQ Music, Qzone, Paipai and Tenpay. The Complainant's official website, www.qq.com, ranks No. 2 in China and No. 9 worldwide.

Complainant's QQ instant messenger is one of the leading instant messaging software in China. The Complainant started expanding its business throughout Asia and the USA in 2009, and QQ software was launched in the English, French and Japanese languages to serve multilingual users. Currently, the monthly active QQ user accounts amount to 843 million while at its peak concurrent users reach 272 million.

The Complainant and its group registered and holds, among others, the following QQ trademarks in China and other territories:

Chinses Registration No. 1796586 for the trademark QQ, filed on March 15, 2001 and registered on 28 June 2002.

Chineses Registration No. 3091477 for the trademark QQ, filed on February 6, 2006 and registered on 14 July 2003.

Chineses Registration No. 3508823 for the trademark QQ, filed on 4 2001 and registered on 7 January 2005.

Hong Kong Registration No. 200308280AA for the trademark QQ, filed on 28 September 2001 and registered on the same day.

United States Registration No. 2938524 for the trademark QQ, filed on 10 January 2010 and registered on 5 April 2005.

Singapore Registration No. T0115806J for the trademark QQ, filed on 10 May 2001 and registered on 5 October 2001.

Since 2006, the Complainant's QQ mark has been recognized as well-known trademark by Chinese courts, the China Trademark Office and the China Trademark Review and Adjudication Board.

In September 2011, the Complainant was awarded the Trademark Innovation Award by the World Intellectual Property Organization and the China State Administration for Industry and Commerce commending the Complainant's trademarks.

The Respondent registered this domain name on 8 December 2004. The Respondent transferred the disputed domain name from Godaddy.com to Name.com on 5 April 2016.

The disputed domain name currently resolves to web site showing the following statement in the English and Chinese language.

声明:

QQFamily.com域名注册于2004年, 取自Cute Cute Family的谐音, 最初作为一个非盈利性的Lotus技术论坛使用, 其后一直用作本人私人邮箱域名使用。

本人从未将域名用于盈利用途, 此域名已经长期停用网站解析, 仅预留mx记录, 用于收发邮件。

本人持有本域名接近14年, 基本个人良好意愿(Good Faith)使用, 本人持有此域名非盈利目的, 且属于私人使用用途。从未向任何机构或个人索取任何利益。

联系本人, 请使用: kevin.zheng#qqfamily.com (请将#替换为@)。仅供私人联系, 本人过去、现在及将来无意将此域名用于商业用途。

STATEMENT

QQFamily.com, name from the homophony of Cute Cute Family, was registered in 2004. It was used for a non-profit technical forum for IBM Lotus Notes / Domino at the very begging. Later then, it stopped from website resolve and has been used just as my personal e-mail domain with only mx records leaving.

I've been used QQFamily.com in good faith for almost 14 years. All is just for my private use. I never ever use it for profit and never ask any financial benefit from a company or person.

For personal contact, please e-mail me: kevin.zheng#qqfamily.com (Please replace # into @). This e-mail only for personal contact usage, I was and will not using this domain for business propose in the past, at now, or in the future.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. The Complainant argues that it is the owner of numerous trademark registrations for the mark QQ in various designations, including in China.
- ii. The Complainant further argues that the disputed domain name has incorporated the component QQ in its entirety and it is confusingly similar to its QQ trademark, and that the addition of the word "family" could not avoid the finding of confusing similarity.
- iii. The Complainant further argues that the overall impression conveyed by the disputed domain name is confusingly similar to the Complainant's QQ mark, and that Internet users will be misled to believe that the source and affiliation of the disputed domain name is related to the Complainant and/or its business.
- iv. The Complainant further argues that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the Respondent has created and/or maintained the disputed domain name without the Complainant's consent, and that the Respondent is not related to the Complainant, nor was he authorized by the Complainant to use the disputed domain name or the QQ trademark.
- v. The Complainant further argues that the Respondent has registered and is using the disputed domain name in bad faith, since the Respondent must have known about the Complainant's rights in the QQ trademark long before the registration of the disputed domain name.

B. Respondent

The Respondent's contentions may be summarized as follows:

- i. The Respondent argues that disputed domain name was originally registered by him in 2004 and has been held by the respondent since its registration. The Respondent further argues that the disputed domain name has been in continuous use since 2004, and not since 2016 as the complainant contends.
- ii. The Respondent also contends that he was not influenced by the Complainant's QQ marks. The origin of the disputed domain name is the name "Cute Cute Family", and its purpose was to run a non-profit Lotus technology forum on <lotusfans.com> and later became his personal email address for non-profit use.
- iii. The Respondent argues that the Complainant launched its brand name QQ family 12 years after the Respondent registered the disputed domain name in December 2004 and that the evidence presented after 2004 should be disregarded.

- iv. The Respondent claims that the QQ trademark 2002 registration provided by the Complainant is a device mark covering clothing and not a word mark and therefore cannot be used to support the Complainant's trademark rights.
- v. The Respondent argues he has never used the disputed domain name in bad faith, has never profited from the disputed domain name, has been using it for emails without harm to the Complainant, and has no intention to sell it. The Respondent denies all the contentions made by the Complainant alleging wrong doing and ulterior motives with respect to the disputed domain name. The Respondent states that the Complainant launched the brand "QQFAMILY" only in 2016, some 12 years after the registration of the disputed domain name.
- vi. The Respondent states that after receiving the Complaint he has posted the statement, at the top of the webpage, emphasizing that the domain name is for private use only and is being used without an intent to profit therefrom. The statement provides as follows: "QQFamily.com, name from the homophony of Cute Cute Family, was registered in 2004. It was used for a non-profit technical forum for IBM Lotus Notes / Domino at the very begging. Later then, it stopped from website resolve and has been used just as my personal e-mail domain with only mx records leaving. I've been used QQFamily.com in good faith for almost 14 years. All is just for my private use. I never ever use it for profit and never ask any financial benefit from a company or person. For personal contact, please e-mail me: kevin.zheng#qqfamily.com (Please replace # into @) This e-mail only for personal contact usage, I was and will not using this domain for business propose in the past, at now, or in the future."

C. Complainant's Supplemental Filing

The Complainant Supplemental Filing may be summarized as follows:

- i. The Complainant QQ mark was launched, reached notoriety in China well before the disputed domain name was registered by the Respondent. The Complainant, at the time, under the QQ mark, was listed in the Hong Kong Stock Exchange and by 2004 its website under the domain name <qq.com> was listed as one of the top 5 websites by market value.
- ii. The Respondent failed to show it has rights or legitimate interests under UDRP paragraph 4(c) because he did not use the disputed domain name, has held it in a passive manner, has not made any bona fide preparations to use it, and is not commonly known by the disputed domain name.
- iii. As a Chinese national, by 2001, the Respondent should have known or knew of the rights of the Complainant in the QQ mark in view of its massive media presence. The Respondent misstated that it did not use the disputed domain name for commercial purposes as he did sell third party software under the disputed domain name from 2007 through 2011 and has since held the disputed domain name passively.

D. Respondent's Supplemental Filing

The Respondent Supplemental Filing may be summarized as follows:

- i. The Respondent reiterated that it was the owner of the disputed domain name since 2004.
- ii. The Respondent argued that the Complainant purchased its <qq.com>.
- iii. That as an individual user, it is impossible for him to fight against the large and powerful listed company.
- iv. The Respondent stated in the first response that <QQFamily.com> was derived from the pronunciation of Cute Cute Family. At the first beginning of selection of a domain name, it had been intended to use CuteFamily.com or QFamily.com whose pronunciation was similar to CuteFamily.com, however, both domain names had been registered (CuteFaimly.com was registered in 2003 and QFamily.com was registered in 2001). In the end, QQFamily.com was used as an eclectic name. The reason for not choosing CuteCuteFamily.com was because it was too long. This was a relatively subjective process, it couldn't be supported by any evidence.
- v. The Respondent also argues that in terms of common sense, it is untenable for an individual to register a domain name in "bad faith" 14 years in advance in order to wait for possible benefits in the future or harm the interests of the complainant.
- vi. Furthermore, the Respondent argued that he has been using the disputed domain name as his main email account, where thousands of emails were stored. <QQFamily.com> was originally utilized as a Lotus technology forum. As an IBM Lotus expert, the Respondent states, it was quite normal for his to use <QQFamily.com> as a domain name for sending and receiving email.
- vii. The Respondent reiterated that the disputed domain name has only been used as an e-mail domain name in the past 7-8 years and that any use made by the Respondent of the QQ mark was for testing only and finally that there are other domain names with the letters "qq" in them and allowing the Complainant's case will mean that it may take any domain name with the letters "qq" therein at any time.

5. Discussion and Findings

5.1. Language of the Proceeding

Paragraph 11 of the Rules provides that:

“(a) 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 Registration Agreement for the disputed domain name is English. In the Reply to the Response, objected to the Respondent use of the Chinese language and requested that the language of the proceedings be English.

The Respondent did not respond to this request but continued to correspond in the Chinese language.

The Panel cites the following with approval:

“Thus, the general rule is that the parties may agree on the language of the administrative proceeding. In the absence of this agreement, the language of the Registration Agreement shall dictate the language of the proceeding. However, the Panel has the discretion to decide otherwise having regard to the circumstances of the case. The Panel’s discretion must be exercised judicially in the spirit of fairness and justice to both parties taking into consideration matters such as command of the language, time and costs. It is important that the language finally decided by the Panel for the proceeding is not prejudicial to either one of the parties in his or her abilities to articulate the arguments for the case.” (Groupe Auchan v. xmxzl, WIPO Case No. DCC2006-0004).

The Panel finds that in the present case, the following should be taken into consideration upon deciding on the language of the proceeding:

- (i) the disputed domain name consists of Latin letters, rather than Chinese characters;
- (ii) the Respondent used the English language in the website under the disputed domain name;
- (iii) the Respondent submitted some of the Annexes to his Response in the English language;
- (iii) the Complainant may be unduly disadvantaged by having to conduct the proceeding in the Chinese language;
- (iv) the Respondent did not object to the Complainant’s request that English be the language of the proceeding.

Upon considering the above, the Panel determines that English be the language of the proceeding. However, in order to save time and expense for both parties, the Panel accepts the submissions by the Respondent written in the Chinese language.

5.2 Substantive Issues

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.

Paragraph 12 of the Rules provides that the Panel, in its sole discretion, may request further statements or documents from either of the Parties. Unsolicited supplemental filings should not be necessary. As the Panel in *Grove Broadcasting Co. Ltd v. Telesystems Communications Limited*, WIPO Case No. D2000-0703, stated, in a different context: "A Complainant should 'get it right' the first time and should have provided all the information necessary to prove its case from the material contained in the Complaint and its annexes alone. There is no right of reply under the Rules."

The Panel did not find that the Supplemental Filings provided evidence that could not have been produced in the first instance, except the evidence, which is associated with the continuous ownership of the disputed domain name by the Respondent and the evidence stemming therefrom. The Panel therefore accepted and considered such evidence only and will not address any additional evidence. The Panel would like to add that even if it had taken into consideration all the remaining evidence, the outcome of this particular case would have been the same.

A) Identical / Confusingly Similar

Pursuant to the Policy, paragraph 4(a)(i), a complainant must prove that a disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights. In line with such requirement, a complainant must prove its trademark or service mark right and the similarity between the disputed domain name and its trademark or service mark.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. As the evidence shows, the Respondent is indeed the owner of the disputed domain name since the year 2004. However, the Complainant is the owner of prior to 2004 trademark registrations for the mark QQ in various designations, including in China where the Respondent resides. For example, Chinese Registration No. 1796586 for the trademark QQ, filed on March 15, 2001 and registered on 28 June 2002 and more. The registered QQ marks are either word marks or logo marks where the QQ element is prominent and distinctly clear.

The disputed domain name <qqfamily.com> reproduces entirely the Complainant's QQ trademark with the addition of the components "family" and the gTLD suffix ".com". The generic word family does not avoid a confusing similarity to the Complainant's QQ trademarks. Also, the gTLD ".com" is without legal significance in the present case since the use of a TLD is technically required to operate a domain name.

Therefore, the addition of the term "family" and the gTLD suffix ".com" does not have the capacity to distinguish the disputed domain name from the Complainant's QQ registered trademarks and is disregarded when comparing the disputed domain names with the Complaint's trademarks. See *Volkswagen AG v. Todd Garber*, WIPO Case No. D2015-2175; *Dassault (Groupe Industriel Marcel Dassault) v. Ma Xiaojuan*, WIPO Case No. D2015-1733; *Lego Juris A/S v. Chen Yong*, WIPO Case No. D2009-1611; *Dr. Ing. H.c. F. Porsche AG v. zhanglei*, WIPO Case No. D2014-0080; *Cummins Inc. v. DG Lanshan Mechanical Electrical Equipment Co., Ltd.*, ADNDRC Case No. HK-1000286

Furthermore, the mark QQ is inherently distinctive mark which will attract Internet users' attention. The evidence provided by the Complainant also shows that the QQ mark has accumulated a considerable reputation by 2004 when the Respondent registered the disputed domain name. Reproduction of the Complainant's QQ trademark in its entirety in the Domain Name in itself establishes that the Domain Name is confusingly similar to the Complainant's trademarks. See EAuto, L.L.C. v. Triple S. Auto Parts d/b/a Kung Fu Yea Enterprises, Inc., WIPO Case No. D2000-0047,

The Panel therefore finds that the disputed domain name <qqfamily.com> is confusingly similar to the Complainant's registered marks. Accordingly, the Complainant has proven the element required by the Policy, paragraph 4(a)(i).

B) Rights and Legitimate Interests

Once the Complainant establishes a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names, the burden of production shifts to the Respondent to show that it has rights or legitimate interests in respect to the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 3.0"), paragraph 2.1.

In the present case, the Complainant's prior QQ trademark registrations demonstrate *prima facie* that the Respondent lacks rights or legitimate interests in respect of the disputed domain name.

The Panel finds that the Complainant has established a *prima facie* case in this regard, *inter alia*, due to the fact that the Complainant has not licensed or otherwise permitted the Respondent to use the Complainant's trademarks or a variation thereof and the evidence presented indicates that the Respondent is not engaged in a *bona fide* offering of goods or services.

Given the notoriety of the QQ mark at the time of the Respondent registered the disputed domain name, the Respondent must clearly show rights or legitimate interests once the burden has shifted. However, the Respondent's arguments did not provide a reasonable explanation or evidence to show any rights or legitimate interests in the complainant's QQ trademarks to rebut the Complainant's *prima facie* case.

The Respondent is not known by the disputed domain name, his argument that the letters "qq" and the word "family" were selected to correspond to "cute cute family" was not supported by evidence, is without basis and is rejected by the Panel.

The Respondent failed to show how the disputed domain name is associated with himself. Further, the Respondent all but admitted that it has not made use of the disputed domain name for the past 7-8 years apart from using the disputed domain name as an email address, though the evidence provided only showed a single email exchange between the Respondent and the relevant registrar in respect of renewal of the disputed domain name. As such, the Panel finds that the evidence does not support that the Respondent did use the disputed domain name as his email throughout the 14 years or even during any substantial period of time since he registered the disputed domain name. The Respondent has not shown any demonstrable preparations to use the disputed domain name in connection with

a bona fide offering of goods or services supported by relevant pre-complaint evidence. Accordingly, the Respondent has failed to show that he has rights or legitimate interests in respect of the disputed domain name.

The Panel finds that on the balance of probabilities, the Complainant has proven the element required by the Policy, paragraph 4(a)(ii).

C) Bad Faith

The Complainant must show that the Respondent registered and is using the disputed domain name in bad faith (Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy provides circumstances that may evidence bad faith under paragraph 4(a)(iii) of the Policy.

The Respondent's main contention is that he registered the disputed domain name in good faith and without knowing about the Complainant's QQ trademarks. The Complainant brought evidence to show that the QQ trademark gained notoriety in China, where the Respondent resides, well before he took the disputed domain name.

The Complainant has submitted evidence that shows that the Respondent registered the disputed domain name after the Complainant registered the QQ trademark in China. The Complainant has owned a registration for the QQ trademark since the year 2001, while the Respondent first registered the disputed domain name in December 2004. Well before the Respondent registered the disputed domain name, the Complainant QQ web site was one of the top 5 web sites in China. It is inconceivable that the Respondent was not aware of the Complainant's QQ mark when he registered the disputed domain name.

Moreover, the Complainant was listed in the Hong Kong Stock Exchange on 16 June 2004 a few months before the Respondent registered the disputed domain name. At that time, the evidence shows, the QQ mark was already a famous trademark in China.

The Respondent's contention that the idea for the registration of <qqfamily.com> stems from the words "cute cute family" pronunciation and that it was intended for use as a non-profit "Lotus" technology discussion forum is implausible and was not supported by any evidence. The English words "cute cute" do not correspond with the letters "qq". No evidence was provided to tie IBM's Lotus technology with the disputed domain name. No evidence was provided to show that the Respondent used the disputed domain name in association with a blog or any other non-bad faith use apart from one email to a renewal service, which on the balance is rejected as being insufficient to show legitimate use.

In addition, the disclaimer posted by the Respondent on the dormant site after the Complaint was brought, stating that it is only used for private use does not assist the Respondent's case when bad faith has been shown by other means and is made post filing of the Complaint. (see *Yahoo! Inc. v. Aman Anand, Ravi Singh, Sunil Singh, Whois Privacy Corp., Domains By Proxy, LL, WIPO Case No. D2016-0461.*) The WIPO Overview 3.0, paragraph 3.7 provides that where the overall circumstances of a case point to the respondent's bad faith, the mere existence of a disclaimer cannot cure such bad faith. In effect, panels have considered the respondent's use of a disclaimer as an admission by the respondent that users may be confused.

The Respondent's reported address is in Shenzhen where the Complainant's headquarters are located is an additional contradiction to the contention that he registered the disputed

domain name without knowledge of the Complainant. The Complainant is one of the largest companies in Shenzhen and the Panel finds it very difficult to believe it was not readily recognized in 2004 by Chinese Internet users and by Shenzhen residents in particular. Based on the above, and the fact that the QQ trademark was registered and famous by December 2004, it is reasonable to infer that the Respondent knew of the Complainant's QQ trademark rights at the time of the registration of the disputed domain name. As such, and having regard to all the relevant circumstances, the Panel find that the present case is exceptional and would amount to opportunistic bad faith on the part of the Respondent.

It is generally accepted by panelists that if on the totality of the evidence, there is no creditable reason for taking a well-known or famous trademark for registration as a domain name it can be irresistibly inferred that it is bad faith registration and bad faith use of the domain name. The circumstance of this case are such that taking into account the totality of the evidence (as opposed to the bare assertions made) there is no creditable reason for the Respondent to have registered the Complainant's well-known and famous QQ trademark.

Finally, the Respondent raised an argument stating that the Complainant delayed in bringing these proceedings because the disputed domain name was registered by the Respondent in 2004. It has long been established that delay between the registration of a domain name and the filing of a complaint neither bars a complainant from filing such case, nor from potentially prevailing on the merits. It is now well established that trademark owners cannot reasonably be expected to permanently monitor every instance of potential trademark abuse, nor to instantaneously enforce each such instance they may become aware of, particularly when cybersquatters face almost no (financial or practical) barriers to undertaking domain name registrations. See WIPO Overview 3.0, paragraph 4.17 and the cases cited therein. Notably, in this case, the Respondent did not argue nor show any detrimental reliance on the delay despite its length, and the Panel rejects the Respondent's argument of unreasonable delay under the particular circumstances of this case.

Based on the evidence that was presented to the Panel, the Panel finds that the disputed domain name was registered and is being used in bad faith.

6. Decision

For the foregoing reasons, in accordance with Paragraph 4(a) of the Policy and Paragraph 15 of the Rules, the Panel orders that the disputed domain name <qqfamily.com> be transferred to the Complainant.

Raymond HO
Panelist

Jonathan Agmon
Presiding Panelist

Dr. Timothy Sze
Panelist

Dated: 10 April 2018