



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

— ADNDRC is a charitable institution limited by guarantee registered in Hong Kong

Decision Submission

English Print

Decision ID	DE-0300007
Case ID	HK-0200015
Disputed Domain Name	www.hklawsoc.org
Case Administrator	Iris Wong
Submitted By	Edward Charles Chiasson QC
Participated Panelist	Edward Charles Chiasson QC
Date of Decision	12-02-2003

The Parties Information

Claimant	The Law Society of Hong Kong
Respondent	Domain Strategy Inc.

Procedural History

On December 24, 2002, the Complainant submitted its Complaint to the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (the "ADNDRC" or 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 Disputes (the "Rules"), and ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy Disputes (the "ADNDRC Supplemental Rules"). The Complainant sought a single person panel.

On December 27, 2002, the Centre received the required filing fee from the Complainant and confirmed the receipt of the Complaint and on the same day the Centre forwarded a copy of the Complaint to the Respondent by on-line system and email as well as a copy of the Complaint by on-line system and email to the Registrar of the domain name in dispute, eNom Inc., 16771 NE 80th St., Suite 100, Redmond, WA, 98052, United States of America.

The Respondent did not file a Response with the Centre.

Having received on January 29, 2003, a Declaration of Impartiality and Independence and a Statement of Acceptance from Edward C. Chiasson, Q.C., on January 27, 2003 the Centre informed the Complainant and the Respondent that Edward C. Chiasson, Q.C. was appointed as the sole Panellist in this matter.

On January 29, 2003, the Centre transferred the case file to the Panellist by post.

The Panelist finds that the Administrative Panel was properly constituted and appointed in accordance with the Rules and the ADNDRC Supplemental Rules.

The Panellist has not received any further requests from the Complainant or the Respondent regarding other submissions, waivers or extensions of deadlines. There is no need, as an exceptional matter, to hold any in-person hearings as necessary for deciding the Complaint, as provided for in Paragraphs 12 and 13 of the Rules.

The language of the proceeding is English, it being the language of the Domain Name Registration and Service Agreement, pursuant to Paragraph 11(a) of the Rules, and there being no express agreement to the contrary by the parties.

Factual Background

For Claimant

The following information derives from the Complaint.

The Complainant is the professional association for solicitors in Hong Kong and was incorporated as a company limited by guarantee in 1907 under the laws of Hong Kong.

The objectives of the Complainant as set out in its Memorandum and Articles of Association include, inter alia:

- establishing and promoting a high standard of work and ethical practice in the legal profession in Hong Kong;
- ensuring compliance with laws and regulations affecting Hong Kong solicitors; and
- guiding solicitors on professional practice matters and representing the views of the legal profession to the government and other bodies, etc.

The Complainant is the only body (both locally in Hong Kong and internationally) empowered by the Legal Practitioners Ordinance (Chapter 159 of the Laws of Hong Kong) to regulate and administer matters relating to solicitors and foreign lawyers in Hong Kong (collectively referred to as the “Members”). The Complainant performs, inter alia, the following:

- the issue of annual practicing certificates to the Members;
- investigation into allegations of professional misconduct by the Members;
- prosecution of allegations of professional misconduct;
- making rules for the conduct and continuing professional education of Hong Kong solicitors and trainee solicitors and arranging and maintaining a compulsory professional indemnity scheme for Hong Kong solicitors.

No other person, body or organization is entitled to exercise the same powers.

For almost a century, the Complainant has been performing and exercising the above-mentioned objectives and powers under its service mark “The Law Society of Hong Kong” or the abbreviations “Hong Kong Law Society” or “HK Law Soc.”

The Complainant also serves members of the public in various aspects, which include issuing statements expressing the stance of Hong Kong solicitors on various important public issues, providing legal education to the members of the public and advising the Hong Kong Government on different legal issues. The marks constantly appear in local newspapers, magazines and journals.

The Complainant releases various publications including the “Hong Kong Lawyer”, which is the official journal of the Complainant and also pamphlets or brochures educating the members of the public on different legal topics, examples of which are, “Purchase of Residential Premises”, “Termination of Employment Agreement”, “Why make a Will?”, etc. All of the above publications are available for viewing and collection by the public at the office and website of the Complainant, at various law firms in Hong Kong and at the “Law Week” which is an annual event organized by the Complainant for the public.

In order to facilitate the performance of its objects and to give the general public greater access to information regarding the Complainant and its Members and to provide information of interest to the general public, the Complainant registered the domain name www.hklawsoc.org.hk with the Hong Kong Domain Name Registration Company Limited on December 27, 1996 and had it resolve to the official website of the Complainant on May 5, 1997 (“the Official Website”).

The Official Website contains a wide range of information regarding the Complainant, including the history of the Complainant, its Members and general discussions and information on different legal subjects.

The Complainant is well recognized by foreign legal professions as the sole body representing Hong Kong solicitors in Hong Kong. The Complainant frequently liaises with foreign law societies and professionals on legal issues which are of common interest. It organizes joint functions, such as forums and exchange trips with the law societies of other countries including Mainland China.

The direct English translation of the Complainant’s Chinese name, “香港律師會”, is “Hong Kong Lawyer Society”. It is commonly referred to by many people as “Hong Kong Law Soc” or “HK Law Soc”.

On October 30, 2002, it came to the Complainant’s attention, via an email from a member, that on April 9, 2001 the

Respondent had registered the subject domain name, with the Registrar, Enom Inc.

As of the date of filing the Complaint, the subject domain name has not resolved to a website, but the Respondent has directed the subject domain name to other sites. As of November 11, 2002 the subject domain name was directed to a pornographic site and as of November 15, 2002, it was directed to an online dating, matching site.

The Complainant is no way related to or connected with the Respondent. There are no statements disclaiming any connection and/or association with the Complainant on the websites.

The Respondent is the registrant of over 4,000 domain names all of which redirect to a pornographic website.

For Respondent

The Respondent did not participate in this proceeding.

Parties' Contentions

Claimant

The Complainant asserts that based on the long history and unique character of the Complainant and also on the extensive long usage and frequent appearance of “The Law Society of Hong Kong” or the abbreviations “Hong Kong Law Society” or “HK Law Soc.” in various arenas, the Complainant has gained a renowned reputation among the people in Hong Kong and foreign countries. It states that people generally associate the words in italics with the Complainant and they constitute service marks. The subject domain name is identical or confusingly similar to the Complainant’s marks and it is essentially identical to its website, www.hklawsoc.org.hk.

The Complainant notes that the Respondent is not associated with the Complainant and is not authorized by it to use its marks. It asserts that the use of the subject domain name to link users to a pornographic web site is not legitimate and states that the Respondent makes a practice of so doing.

Bad faith is said to be evidenced by the fact that the subject domain name leads to a pornographic site. In addition, it is asserted that the Respondent’s use of the subject domain name creates a likelihood of confusion with the Complainant’s marks as to the source, sponsorship, affiliation or endorsement of the Respondent’s web site or location of the Respondent’s product or services. The Complainant also relies on the fact that the Respondent has engaged in a similar practice on many occasions.

Respondent

The Respondent did not participate in this proceeding.

Findings

Identical / Confusingly Similar

The Policy requires a complainant to establish that:

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

The Complainant refers to previous domain name dispute decisions. While these are neither controlling nor binding of the Administrative Panel, reference to them can be of assistance.

This dispute must be resolved in the context of the Policy based on the information provided to the Administrative Panel.

Identical / Confusingly Similar

The Complainant relies on its long and widespread use of the words “Hong Kong Law Society” and words related thereto to support its contention that it has a service mark.

The Complainant asserts that the subject domain name is identical or confusingly similar to its marks, but there is a distinction between the two concepts and they are assessed using different criteria. Reference also is made to the Complainant’s web site, but it is merely a use which the Complainant makes of its marks.

It is clear that the Complainant has established a common-law right to the words “Hong Kong Law Society” and words associated therewith. Its web site demonstrates a use which is consonant with its activities and responsibilities. The subject domain name differs from the web site only by the deletion of hk, which is of no consequence.

Objectively, users of the internet would associate the subject domain name with the Respondent.

The Administrative Panel is satisfied that the Complainant has met the requirements of paragraph 4(a)(i).

Rights and Legitimate Interests

The Complainant rightly relies on some of the usual indicia of an absence of a legitimate interest: non-authorization; no relationship with the Complainant; etcetera. It also contends that using the subject domain name to link to a pornographic web site evidences the lack of a legitimate interest in the subject domain name.

A respondent is not obliged to participate in a domain name dispute and its failure to do so does not constitute an admission of the facts and propositions asserted by a complainant, but the failure to participate leaves a respondent vulnerable to the inferences that flow naturally from the assertions of the complainant and the tribunal will accept as established assertions by the complainant that are not unreasonable.

Using a domain name to direct users to a pornographic web site is not per se illegitimate or lead automatically to a conclusion that the registrant does not have a legitimate interest in the domain name under review.

In this case, the only use of the subject domain name has been to direct users to other sites. Those sites are pornographic. The fact that the subject domain name is confusingly similar to the Complainant’s marks and the lack of any link between the Respondent and the Complainant adds weight to the Complainant’s position. The Respondent has done nothing to offset that weight.

The Administrative Panel is satisfied that the Complainant has met the requirements of paragraph 4(a)(ii).

Bad Faith

A finding that a respondent does not have a legitimate interest in a domain name that is confusingly similar to the mark of another does not automatically lead to a finding of bad faith, but the facts that support the finding are relevant to the bad faith issue.

Standing alone, the fact that the Respondent uses the subject domain name to direct users to a pornographic web site is not per se bad faith, but in context, it raises an inference of bad faith. The context includes the notoriety of the Complainant’s name and marks.

Although the circumstances of this case could lead to confusion in the mind of users as to the sponsorship etcetera of the Respondent’s web site, considering the nature of the Respondent, such confusion is not likely, but there is a risk that the reputation of the Complainant could be denigrated or that it could be open to public ridicule.

Similar fact information must be approached with caution, but in this case it is asserted that the Respondent has undertaken similar conduct with respect to over 4,000 domain names. The Respondent has provided nothing to offset the weight of this information.

The Administrative Panel is satisfied that the Complainant has met the requirements of paragraph 4(a)(iii).

Status

www.hklawsoc.org

Domain Name Transfer

Decision

Based on the information provided to it and on its findings of fact, the Administrative Panel concludes that the Complainant has established its case.
The Complainant asks that the subject domain name be transferred to it. The Administrative Panel so orders.

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