



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

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Decision Submission

English Print

Decision ID	DE-0300008
Case ID	HK-0300020
Disputed Domain Name	www.hktdc.com
Case Administrator	Iris Wong
Submitted By	Hong Xue
Participated Panelist	Hong Xue

Date of Decision	14-03-2003
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The Parties Information

Claimant	Hong Kong Trade Development Council
Respondent	T.W. Kahl

Procedural History

On 23 January 2003, the Claimant submitted its Complaint 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 Disputes (the "Rules"), and ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy Disputes (the "ADNDRC Supplemental Rules"). On 24 January 2003, the Centre received the required filing fee from the Claimant.

On 28 January 2003, the Centre confirmed the receipt of the Complaint and forwarded a copy of the Complaint to the Respondent by the Centre's on-line system and email as well as a copy of the Complaint by the Centre's on-line system and email to the Registrar of the domain name in dispute, Hangang Systems, Inc., 17th Floor, Special Construction Center, 395-70, Shindaebang-Dong, Dongjak-Gu, Seoul, Korea.

On 5 February 2003, the Centre received an email (in English) from the Respondent to request that the language of the proceeding be in Korean because the disputed domain name was registered with a Korean Registrar and, therefore, according to the Respondent, the language of the Registration Agreement was Korean. The Respondent requested that the Complaint be re-submitted in Korean in accordance with the Rules, Paragraph 11 (a) and (b).

On 7 February 2003, the Centre replied to the Respondent by email that the Panel would have the discretion in deciding the language to be used in the proceeding in accordance with the Rules, Paragraph 11 (a). The Centre's email also pointed out that the Registrar of the disputed domain name has an English version of the Registration Agreement. The Centre suggested the Respondent to prepare the Response in Korean and English pending the formation of the Panel who may decide the language of the proceeding in accordance with the Rules, Paragraph 11 (a).

The Respondent did not submit a Response.

Having received a Declaration of Impartiality and Independence and a Statement of Acceptance from Dr. Hong Xue on 4 March 2003, the Centre informed the Claimant and the Respondent that Dr. Hong Xue was appointed as the sole Panelist in this matter.

On 4 March 2003, the Centre transferred the case file to the Panelist by post, and the Panelist confirmed the receipt of the file.

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

The Panel, in accordance with the Rules, Paragraph 11 (a), determines that the language of the proceeding should be English. Although the disputed domain name was registered with a Korean Registrar, the Respondent did not provide any evidence to prove that the language of the Registration Agreement is in Korean. Further, the Panel finds that the Respondent's web page at the disputed domain name is in English and the Respondent has showed his ability of using English in the communications with the Centre. The Panel, having regard to all the above circumstances, determines English as the language of the proceeding (*1).

Factual Background

For Claimant

The Claimant is Hong Kong Trade Development Council, located at 38/F, Office Tower, Convention Plaza, 1 Harbour Road, Wanchai, Hong Kong.

The word “hktc” was trademarked and registered by the Claimant in China under Class 35 (registration No. 1659613) and class 38 (Registration No. 1635868).

The word mark “HKTDC” was also registered by the Claimant in China under Class 16 (Registration No. 735394), Class 35 (Registration No. 779437), and Class 41 (Registration No. 775719).

For Respondent

The Respondent has not submitted the Response to describe himself. According to the Complaint furnished by the Claimant, the Respondent is T. W. Kahl, located at #204-101, YD-101, HeukSeok-1Dong, DongJak-Gu, Seoul, Korea.

Parties' Contentions

Claimant

The Claimant, Hong Kong Trade Development Council (HKTDC), is a statutory body incorporated in Hong Kong since 1966 with the mission to create and facilitate opportunities in international trade for Hong Kong companies. Ever since the Council has been incorporated under the Hong Kong Trade Development Council Ordinance, the Council has been performing its mission for over 30 years. After many years of development, Hong Kong Trade Development Council has been awarded with a good reputation both locally in Hong Kong and internationally and it is customary for the business community both within and outside of Hong Kong to refer to the Hong Kong Trade Development Council as “the hktc”. In fact the word mark “hktc” has gradually become the service mark of the Council, which not only represents the organization itself but also its services and functions. In addition, the Council has been using a graphical representation of “HKTDC” as its logo since its incorporation until 1996, which has built up a worldwide recognition that “hktc” represents the Hong Kong Trade Development Council.

A corporate name might acquire intellectual property rights over time as goodwill is accumulated in the name through business practice and reputation.

The Claimant believes that the domain name <www.hktc.com> is a unique service and reflects the identity and functions of its organization. The Claimant argues that another organization using the domain name <www.hktc.com> would project a wrong impression that such other organization is the Council or represents the Council, both of which are not true.

The domain name <www.hktc.com> was registered by “Han Kook Trade Center” on March 28, 2000. In May 2002, the Claimant filed a Complaint against the registrant at that time with Asia Domain Name Dispute Resolution Centre under Case ID HK-0200002. That Complaint was filed on the basis of the following: the registrant had contacted the Claimant for resale of the domain name on April 10, 2002 and therefore the registrant was using the name in bad faith in that (1) the primarily purpose of acquiring the name was for selling, and (2) the registrant had directed the URL to a pornographic site, which prevented the Claimant from reflecting its true service to the business community.

Although the Panelist in that case ruled verdict was in favor to the Claimant (Decision ID DE-0200002), the domain name could not be transferred to the Claimant after the ruling because the then Registrar permitted the registrant to transferred the domain name <hktc.com> to a new registrant (the Respondent in this case) in May 2002 and a new Registrar (Doregi.com) on May 27, 2002 even though the then Registrar had been notified by the Centre of the pending Dispute. The Claimant argues that the registrant transferred the domain name in May 2002 deliberately to avoid transfer of ownership to the Claimant when he was informed about the Complaint on May 10, 2002 by the Claimant and as a

result, in the Claimant’ s view, the current Respondent has no right to the domain name <hktdc.com>.

In accordance with the Uniform Domain Name Dispute Resolution Policy and for the reasons mentioned above, the Claimant requests the Panel to issue a decision that the disputed domain name <www.hktdc.com> be transferred to it.

Respondent

The Respondent did not submit a Response.

Findings

Identical / Confusingly Similar

In accordance with the Policy, Paragraph 4 (a) (i), the Claimant must prove that the disputed domain name is identical or confusingly similar to the trademark or service mark in which the Claimant has rights. In the Panel’ s view, the Claimant has proved that it owns the registrations for the marks “hktdc” and “HKTDC” . In addition, the Panel is of the opinion that the Claimant has also proved that, by reason of the extensive use, promotion and advertising of the business by reference to the mark “hktdc” , it enjoys the substantial goodwill and reputation in the use of the said mark. Having been used in business since 1966, “hktdc” has been recognized worldwide representing the Claimant. The disputed domain name <hktdc.com> differs from Claimant’ s mark “hktdc” only to the extent of the addition of “.com” . However, the generic top level domain designator “.com” can by no means distinguish the disputed domain name from the Claimant’ s mark. The Panel, therefore, opines that the disputed domain name is identical to the Claimant’ s mark.

Rights and Legitimate Interests

The Claimant submits that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent, who did not file a Response, did not dispute this contention nor provide information as to its interests to use the disputed domain name.

The Policy presents the Claimant, under Paragraph 4(a) (ii), with the burden of proving that the Respondent has no rights or legitimate interests in respect of the disputed domain name. However, given the difficulty of excluding all possible interests the Respondent may have in a name, the Panel believes it proper to consider whether the Respondent has demonstrated its rights or legitimate interests in the disputed domain name in accordance with Paragraph 4(c) of the Policy in the overall evaluation of the evidence presented in this case (see Wal-Mart Stores, Inc. v. Lars Stork, WIPO Case No.D2000-0628).

There are three ways under the Policy, Paragraph 4(c), by which the Respondent can demonstrate to the Panel that it has rights or legitimate interests in respect of the disputed domain name. However, given that the Respondent has not filed a response, no evidence has been presented by the Respondent to show that Respondent is “commonly known by the disputed domain name” (Paragraph 4(c) (ii) of the Policy) or “making a legitimate noncommercial or fair use of the disputed domain name” (Paragraph 4 (c) (iii) of the Policy).

Neither can the Panel find that the Respondent is using or preparing to use the disputed domain name in a bona fide offering of any goods or services (Paragraph 4 (c) (i) of the Policy), for the Respondent’ s webpage at the address <www.hktdc.com> has no substantial content but merely an announcement that says “welcome to hktdc.com …Han Kook Trade Delivery Center…Under Construction” .

Thus, in view of all the evidence submitted, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Bad Faith

In accordance with the Policy, the Claimant must prove that the Respondent has registered and is using the disputed domain name in bad faith (Paragraph 4 (a) (iii) of the Policy).

Paragraph 4(b) of the Policy specifies four types of circumstances that could be evidence of the registration and use of a domain name in bad faith. They include: (i) circumstances indicating that the holder of the domain name has registered or has 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 the holder’ s documented out-of-pocket costs directly related to the domain name; or (ii) the holder of the domain name has 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 the holder has

engaged in a pattern of such conduct; or (iii) the holder of the domain name has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the holder of the domain name has intentionally attempted to attract, for commercial gain, Internet users to his web site 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 his web site or location or of a product or service on his web site or location. However, Paragraph 4(b) of the Policy expressly recognizes that other circumstances can be evidence that a domain name was registered and is being used in bad faith.

In *Telstra Corporation Limited v. Nuclear Marshmallows* (WIPO Case No.D2000-0003)(*2), it was ascertained that passive holding of a domain name may be sufficient to constitute bad faith prescribed in the Policy, Paragraph 4(b), taking into consideration the overall context of the Respondent's behavior. When evaluating the likelihood of bad faith in the form of passive holding, the panel should find out whether the Respondent's actions, although not falling within any of the circumstances prescribed in the Policy, Paragraph 4 (b), clearly indicates bad faith so that it is not possible to conceive of any plausible active use of the disputed domain name by the Respondent that would be illegitimate, and not being a passing off, an infringement of consumer protection legislation, or an infringement of the Claimant's rights under trademark law.

In the present case, the disputed domain name was registered by "Han Kook Trade Data Center" on 28 March 2000. On 10 May 2002, the Claimant filed a Complaint against Han Kook Trade Data Center with the Centre (Hong Kong Trade Development Council v. Han Kook Trade Data Center, ADNDRC HK 02-00002). On 13 May 2002, the Centre notified both parties and the then Registrar of the <hktdc.com> domain name of the commencement of the proceeding. However, notwithstanding the pendency of the then proceedings on 27 May 2002, "Han Kook Trade Data Center" transferred the disputed domain name registration to the Respondent of the present case, "Han Kook Delivery Center" which was a serious violation of the Policy, Paragraph 8 (a) and (b). Moreover, the Registrar was changed. How the previous Registrar and the current Registrar allowed this to happen is open to serious question and the Panelist understands that the matter has been referred to ICANN. On 10 June 2002, although having on 27 May, 2002 transferred the disputed domain name registration to the Respondent of the present case, the then Respondent, Han Kook Trade Data Center sent an email to the Centre requesting that the language of the proceeding be Korean on the grounds that the registration agreement was in Korean.

On 3 August 2002, the then Panel concluded that the disputed domain name had been registered and used in bad faith by Han Kook Trade Data Center, because (i) SY Lee, the administrative contact person of the disputed domain name had offered to sell the domain name "hktdc.com" for USD 1,500 to the Claimant and, (ii) the URL of the disputed domain name had been directed to a pornographic site. The Panel, therefore, ordered the disputed domain name be transferred to the Claimant (Hong Kong Trade Development Council v. Han Kook Trade Data Center, ADNDRC HK 02-00002). That decision however, could not be enforced, because the disputed domain name had been transferred during the proceeding to the Respondent of the present case.

Obviously, Han Kook Trade Data Center circumvented the Policy and the proceeding by deliberately transferring the disputed domain name registration to the Respondent of the present case. In the Panel's view, the Respondent's holding of the disputed domain name is the continuity of the cybersquatting activity of Han Kook Trade Data Center. Taking into consideration the overall context of the case, it's unimaginable that the Respondent, Han Kook Trade Delivery Center, has been totally unaware of the blatant deceptive acts of Han Kook Trade Data Center. In particular, Han Kook Trade Data Center pretended to participate in the proceeding of Hong Kong Trade Development Council v. Han Kook Trade Data Center, ADNDRC HK 02-00002, even after having transferred the disputed domain name registration to the Respondent; and the Respondent's "name on its inactive webpage the name, "Han Kook Trade Delivery Center", which is merely one word different from "Han Kook Trade Data Center". Thus, the Panel holds that the Respondent acquired and uses the disputed domain name with full knowledge of the Claimant's mark and the cybersquatting acts of Han Kook Trade Data Center. Further, the Respondent did not provide any evidence to prove any good faith use of the disputed domain name.

The Panel, therefore, concluded that the Respondent's passive holding of the disputed domain name demonstrates that it has received the transfer, registered and is using the disputed domain name in bad faith.

Status

www.hktdc.com

Domain Name Transfer

Decision

In view of the circumstances and facts discussed above, the Panel concludes that the disputed domain name

“hktdc.com” is identical to the mark owned by the Claimant, that the Respondent has no rights or legitimate interest in the disputed domain name and that the disputed domain name has been registered and used in bad faith. Therefore, pursuant to Paragraphs 4 (i) of the Policy and Paragraph 15 of the Rules, the Panel orders that the domain name “hktdc.com” be transferred to the Claimant, namely, Hong Kong Trade Development Council.

(*1) See eNamix, Inc. v. Li Yen Chun, WIPO Case No.D2001-1499; Desco Von Schultess AG v. Daniel Fernandez, WIPO Case No.D2001-1140.

(*2) See similar decisions in Ingersoll-Rand v. Frank Gully, d/b/a Advcomren, WIPO Case No.D2000-0021; Guerlain, S.A. v. Peikang, WIPO Case No.D2000-0055; Compaq Computer Corp. v. Boris Beric, WIPO Case No.D2000-0042; Association of British Travel Agents Ltd. v. Sterling Hotel Group Ltd., WIPO Case No.D2000-0086; Sanrio Co. Ltd. and Sanrio, Inc. v. Lau, WIPO Case No.D2000-0172; 3636275 Canada, dba eResolution v. eResolution.com, WIPO Case No.D2000-0110; Marconi Data Systems, Inc. v. IRG Coins and Ink Source, Inc., WIPO Case No.D2000-0090; Stralfors AB v. P D S AB, WIPO Case No.D2000-0112; InfoSpace.com, Inc. v. Ofer, WIPO Case No.D2000-0075.

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