



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-0400024
Case ID	HK-0400044
Disputed Domain Name	www.citysuper.com
Case Administrator	Iris Wong
Submitted By	Matthew Laight
Participated Panelist	Matthew Laight David Sandborg Arthur Chang
Date of Decision	13-08-2004

The Parties Information

Claimant	City Super Limited
Respondent	C.K. Li

Procedural History

On 5 May 2004, the Complainant submitted the Complaint to the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (the “ADNRC” of 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 26 August 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 has sought a three-person Panel.

On 5 May 2004, the Centre confirmed to the Complainant receipt of the Complaint and forwarded a copy to the Respondent by on-line notification (without the Complaint attached) on 24 May 2004. The 20 day deadline for the Respondent to respond calculated from 24 May 2004 expired on 13 June 2004. The Respondent did not file a Response with the Centre.

On 18 June 2004, the Centre contacted the Respondent informing him that the Complainant has chosen a three-member Panel to decide the dispute and asking him to submit a list of three Panelists by 21 June 2004. The Respondent replied by email to say that he could not submit a response to the Complaint online since he was unable to access the URL adndrc.com from Guangzhou where he is living. The Centre responded saying that the due date for making a response had passed and that the Respondent must apply for an extension if he wanted to make a response to the case.

No further communication was made by the Respondent in this case and the Centre contacted the three Panelists on 8 July 2004.

On 12 July 2004 the Centre transferred the case file to the Presiding Panelist and the other Panelists by post. On 2 August 2004 the deadline for submitting the decision was extended to 8 August 2004 and a further extension of the deadline to 16 August 2004 was subsequently granted.

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

Factual Background

For Claimant

The following facts are asserted by the Complainant in the Complaint and have not been disputed. The Panel finds that these facts are proved.

The Complainant was established in 1996 and operates one of the largest superstores in Hong Kong, offering for sale a variety of goods such as food, household necessities, gifts, stationary, books, magazines and other lifestyle items.

The Complainant owns the domain name “citysuper.com.hk” and operates a website under this domain name offering online shopping services.

The Complainant has submitted evidence in the form of advertising materials and publications to show that it has established a substantial reputation and goodwill in the trade name “CITYSUPER”. The Complainant has also submitted evidence in the form of trade mark registration certificates to show that it owns various trade marks involving the word “CITYSUPER” in Classes 42 and 35 in Hong Kong.

The Complainant makes it clear that it is in no way related or connected with the Respondent.

On inspection by the Panelist on 5 August 2004 the Disputed Domain Name was found to resolve to no active website. Internet browsers are unable to find any website when the Disputed Domain Name is entered.

For Respondent

The Respondent did not respond to the Complaint or participate in these proceedings save for one email dated 18 June 2004 in the following terms:

Dear Dennis

I am living in Guangzhou and I cannot reach the URL adndrc.com.
Therefore I am not able to make response to the case through the web interface.

C.K. Li

Parties' Contentions

Claimant

The Claimant asserts that the Respondent has no connection with the trade name “CITYSUPER” and has no material or legal interest in the business activities of City Super Limited.

The Complainant asserts that the Respondent set up a simple one-page website under the Disputed Domain Name with no substantial function or content but containing only a few sentences and subsequently removed the website from the server when the Complainant contacted the Respondent about the dispute. The Claimant asserts that this shows a lack of bona fide use of the Disputed Domain Name by the Respondent.

The Claimant further asserts that the inclusion of the words “Welcome to CitySuper.com – enjoyable and healthy!....Have a nice day” in the scroll text of the Respondent’s one-page website indicated an intention to confuse customers into thinking that the website had a connection with the Complainant, since the Complainant has trained its sales staff to say “Thank you, have a nice day!” to every customer they serve.

Respondent

Save as outlined above, the Respondent did not participate in these proceedings.

Findings

Identical / Confusingly Similar

The Complainant relies on its registrations and use of various trade marks involving the word “CITYSUPER” (the “Mark”) and asserts that the Disputed Domain Name has incorporated the entirety of the Mark and that the Disputed Domain Name differs from the Complainant’s domain name “citysuper.com.hk” only by the deletion of “.hk”. The addition of the country code top level domain (ccTLD) name “.hk” is without legal significance since it does not serve to identify a specific service provider as a source of goods or services (see CBS Broadcasting Inc. v Worldwide

Webs, Inc., WIPO Case No.D2000-0834, where a similar finding was made in respect of the generic top-level domain (gTLD) name “.com”).

The Panel is satisfied that the Complainant has met the requirements of paragraph 4(a)(i) on the basis of the factual finding that the Complainant owns and uses the trade mark “CITYSUPER” .

Rights and Legitimate Interests

The Complainant asserts that the Respondent does not have any rights or legitimate interests in respect of the Disputed Domain Name because the Respondent originally set up only a one-page website under the Disputed Domain Name with no substantial function or content and subsequently removed the website from the server altogether after the Complainant contacted the Respondent complaining about the registration of the Disputed Domain Name. The Panel finds that the dormant state of the website is an indication that the Respondent has no legitimate interest in the Disputed Domain Name.

Furthermore, the Complainant has not authorised, licensed, endorsed or otherwise permitted the Respondent to register or use the Disputed Domain Name or to use the Complainant’ s “CITYSUPER” trade mark in relation to its business as a business name or otherwise.

The Complainant has prior rights in the “CITYSUPER” trade mark which precede the Respondent’ s registration of the Disputed Domain Name. The combination of the words “city” and “super” to form “citysuper” is not a common usage in the English language. The Complainant is well-known throughout Hong Kong under the trade mark and commercial name “CITYSUPER” to designate its superstores and online shopping services.

The Respondent is not commonly known by the Disputed Domain Name. It is highly likely that the Respondent is aware that “CITYSUPER” corresponds to a trade mark since, although the Respondent now claims to be living in Guangzhou, his place of residence at the time of registering the Disputed Domain Name was Hong Kong, as indicated by the WHOIS search result.

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

Bad Faith

The original one-page website which lacked substantial function or content and the subsequent dormant state of the Disputed Domain Name is evidence of bad faith on the part of the Respondent. The inclusion of the Complainant’ s slogan “Have a nice day!” in the original website indicates an intention on the part of the Respondent to confuse the public into thinking that the Disputed Domain Name has a connection with the Complainant. Furthermore, passive holding of a domain name that is identical or confusingly similar to a famous mark has been found to constitute bad faith in itself (Telstra Corporation Limited v Nuclear Marshmallows, WIPO Case No.D2000-0003). In deciding whether passive holding amounts to acting in bad faith the Panel should give close attention to all the circumstances of the Respondent’ s behaviour. In the present case, it appears that the passive holding of the site occurred immediately after the Complainant contacted the Respondent requesting transfer of the Disputed Domain Name. This strongly suggests that the Respondent does not have a bona fide intention to use the Disputed Domain Name. Therefore, the continuing passive holding of the Disputed Domain Name, which prevents the legitimate owner from using it, indicates bad faith.

The Respondent has no prior right to the mark “CITYSUPER” and no authorisation to use this mark in any form. The Respondent is an individual originally located in Hong Kong and is likely to know that this is a notorious mark in Hong Kong. The Complainant has submitted evidence to show that the name “CITYSUPER” is not commonly known and used as a word other than in relation to the Complainant’ s business.

The failure of the Respondent to reply to the Complainant’ s Cease and Desist letter and reminder indicate bad faith on the part of the Respondent. The Respondent has not given his full address and contact details for the registration record of the WHOIS database and responded only once to the emails of the Provider to say that he could not submit a response to the Complaint online and took no further part in these proceedings. These facts indicate a lack of good faith on the part of the Respondent.

The Panel is satisfied that the Complainant has met the requirements of paragraph 4(a)(iii) in showing bad faith registration and use of the Disputed Domain Name.

Status

www.citysuper.com

Domain Name Transfer

Decision

Based on the information provided to it and on its findings of fact, the Panel concludes that the Complainant has established its case.

The Complainant asks that the Disputed Domain Name be transferred to it. The Panel orders that the Disputed Domain Name be transferred to the Complainant.

[Back](#)

[Print](#)