



## ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

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### Decision Submission

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Decision ID	DE-0500043
Case ID	HK-0500059
Disputed Domain Name	www.hongkongjc.com
Case Administrator	Dennis Choi
Submitted By	Peter Bullock
Participated Panelist	Peter Bullock David Sandborg Jeffrey Elkinson
Date of Decision	12-04-2005

### The Parties Information

<b>Claimant</b>	The Hong Kong Jockey Club
<b>Respondent</b>	Shizuki Kishimoto

### Procedural History

A Complaint in this matter was filed with the Hong Kong Office of Asian Domain Name Dispute Resolution Centre (ADNDRC) dated 22 February 2005 in the prescribed form.

The Hong Kong International Arbitration Centre (HKIAC) as ADNDRC operator, notified the Registrar of the Disputed Domain of the proceedings by email of 22 February 2005. The Registrar thereupon locked the Disputed Domain, and confirmed the identity and contact details of the Registrant, Administrator, Technical Contact and Billing Contact of the Disputed Domain. The Registration Agreement is in the English language.

The Complaint was served upon the Respondent in a number of ways:

- by the HKIAC by email on 28 February 2005 to the address (tt@itpaic.com) provided by the Registrar as the contact email as Registrant and Administrator of the disputed domain name;
- by the HKIAC by TNT Express Post to the Registrar's given address, sent on 23 February 2005, and signed for by the recipient with an illegible signature and date;
- by the Complainant's solicitors by email on 21 February 2005 to tt@itpaic.com, which was returned undelivered immediately.

This constitutes valid service of these proceedings upon the Respondent.

No Response was filed with the HKIAC on or before the prescribed deadline (20 March 2005).

The three-member Panel was appointed on 24 March 2005, with papers being delivered to the Panelists on 29 March 2005.

### Factual Background

#### For Claimant

The Complainant holds a statutorily imposed monopoly for the provision of horse racing, sporting and betting entertainment in Hong Kong. It was founded in 1884 and since 1988 has organized international races and invited participants from various countries all over the world. It conducts the 'Mark Six' lottery, through wholly owned

subsidiary HKJC Lotteries Limited. It has, since 2003, launched a football betting service, conducted and administered by wholly owned subsidiary HKJC Football Betting Limited. The Complainant registered the trade mark "HKJC" ("Mark"), through its subsidiary HKJC (IP) Limited, in Hong Kong in Classes 16, 41, 42 and 43 on 30 June 2003, in respect of a variety of goods and services (including betting and gaming services). The Complainant had registered 248 domain names as at the date of the Complaint, many including or based around the letters "hkjc" or words "hongkong jockey club". A number of these domains are actively used as the Internet addresses for the Complainant's websites (or by way of redirection to those sites). Hong Kong citizens over the age of 18 can place bets online using the Complainant's official website.

The Complainant is a very substantial charitable benefactor within Hong Kong, with the result that numerous public facilities in the territory are named with the Complainant's English name "The Hong Kong Jockey Club" or its English abbreviation "Jockey Club".

### For Respondent

The Respondent registered the Disputed Domain on 2004-04-01.

### Parties' Contentions

#### Claimant

The Complainant asserts that the Disputed Domain (hongkongjc.com) is substantially similar to the Mark (HKJC), on the basis that it is globally accepted that Hong Kong is usually denoted by the abbreviation "HK". It contends that the public would be easily confused to treat the Disputed Domain to be an equivalent form of "HKJC.COM";

"HKJOCKEYCLUB.COM" or "HONGKONGJOCKEYCLUB.COM" which are domain names registered by the Complainant and used as the internet addresses of the Complainant's official website.

The Complainant further alleges that the Respondent has no rights or legitimate interests in respect of the Disputed Domain because:

- the Respondent has set up a website imitating the Complainant's official website [www.hongkongjockeyclub.com](http://www.hongkongjockeyclub.com), which is a direct copy of "almost the entire" site as it stood at 27 March 2004. The only discrepancies between the Respondent's website and the Complainant's (at 27 March 2004) are (1) no English version is provided in the Respondent's website; (2) no links are provided for certain items such as the Complainant's Annual Report and application forms (3) the access page for placing bets is different; and (4) the contact email address within the Respondent's website is [hongkong888888@sohu.com](mailto:hongkong888888@sohu.com) rather than [hotline@hkjc.org.hk](mailto:hotline@hkjc.org.hk). The Complainant exhibits to the Complaint copies of both versions of its website;

- the Disputed Domain is not the individual name of the Respondent.

Finally, the Complainant alleges that the Disputed Domain has been registered and used in bad faith. In support the Complainant relies on:

- the Respondent's copying of its official website and trade marks;

- the confusion, misrepresentation and deception caused to Internet users that the Respondent's website is the official one operated by the Complainant or the Respondent's website is in some way connected with or sponsored by or affiliated with the Complainant. In particular the Complainant refers to the use of a bogus email address for users' enquiries;

- the damage to the Complainant's betting business and associated goodwill that it claims occurs by reason of the outdated, but purportedly official, information being provided by the Respondent's website.

The Complainant's in-house lawyer sent a cease and desist letter to the Respondent on 17 November 2004 which went unanswered and ignored.

#### Respondent

The Respondent did not file a response within the stipulated time.

### Findings

#### Identical / Confusingly Similar

#### A. Respondent in Default

The Rules for Uniform Domain Name Dispute Resolution Policy as approved by ICANN on 24 October 1999 ("Rules"), Paragraph 5(e) provide that: "If a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint." The Panel finds no exceptional circumstances to exist, and will proceed to determine the dispute based upon the Complaint.

#### B. The Language of the Proceedings

Paragraph 11(a) of the Rules provides:

"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."

In the present case, the Disputed Domain was registered using the Roman alphabet. The Registrar is resident in the US, an English speaking country, and the Registrar's registration agreement is in English. The Complaint was drafted in English and the Complainant and two of the three Panel members are from Hong Kong, the third being from Bermuda, which countries include English as an official language. All correspondence amongst the Center, the Registrar, the parties and the Panel is in English.

The Respondent is a resident of Japan and the version of the Complainant's website which he has chosen to copy is the Chinese version. The Panel has received no request from any interested party to deal with the matter in any language other than English. The Panel determines that the language of these administrative proceedings shall be English. The Panel is able to understand those parts of the exhibits to the Complaint in Chinese without official translation.

#### C. Discussion and Findings

According to Paragraph 4a of the Uniform Domain Name Dispute Resolution Policy approved by ICANN on 24 October 1999 ("Policy") which is applicable hereto, the Complainant has the burden of proving that:

- (i) the Disputed Domain is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain; and
- (iii) the Disputed Domain has been registered and is being used in bad faith.

##### 1) Identical/confusing similarity

The relevant question is whether "HONGKONGJC.COM" is confusingly similar to the Mark "HKJC". The Complainant urges that, because "HK" is an acknowledged abbreviation of "Hong Kong" (which the Panel accepts) it follows that the two are "equivalent forms" of the same thing, or at least of HKJC.COM, which the Complainant has registered. The Complainant extends the same logic to claim that "HONGKONGJC.COM" is an "equivalent form" of "HKJOCKEYCLUB.COM" or "HONGKONGJOCKEYCLUB.COM", which are also registered by the Complainant.

We are persuaded that there is an obvious relationship between HKJC, the Mark, and HongKongJC - there is very little that separates the domain name and the Mark as in reality they are variations of the abbreviations that are used by the Mark holder. To that extent, they are confusingly similar.

However the Panel is entitled to rely on the following facts and matters in evaluating confusing similarity:

- the fact that the Complainant makes use of the Mark in its Annual Report and its websites;
- the fact that the Complainant has also registered the trade mark "HKJC Football" in a number of classes in Hong Kong and Macau, and makes use of "HKJC Football" in its advertising literature.

Having considered the above, the Panel finds that the Complainant has satisfied the first condition under Paragraph 4 of the Policy.

#### **Rights and Legitimate Interests**

The Complainant has alleged that the Respondent has no right or legitimate interest in respect of the Disputed Domain, it has raised an important allegation concerning a website imitating the Complainant's website being published by the Respondent. The Respondent has not answered this allegation and the Panel has no reason to doubt the veracity of the

**Complaint.**

Accordingly, the Panel finds that the Complainant has satisfied the second condition under Paragraph 4 of the Policy.

**Bad Faith**

Paragraph 4(b) of the Policy sets out the following two circumstances as examples, if found by the Panel to be present, of the registration and use of a domain name in bad faith:

"(iii) you have registered the domain name primarily for the purpose of 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 Panel accepts the overwhelming and unanswered evidence of (1) the Respondent's wrongful duplicate website and (2) his silence in the face of both the Complainant's cease and desist letter of 17 November 2004 and these proceedings, as satisfying the Complainant's burden of providing bad faith on the part of the Respondent.

**Status**

www.hongkongjc.com

Domain Name Transfer

**Decision**

Based on the above analysis, the Panel unanimously decides that: (1) the Disputed Domain is confusingly similar to marks in which the Complainant has rights; (2) the Respondent has no right or legitimate interest in respect of the Disputed Domain; and (3) the Respondent has registered and has used the Disputed Domain in bad faith. Accordingly, pursuant to Paragraph 4(i) of the Policy, and at the Complainant's request, the Panel decides that the Disputed Domain hongkongjc.com should be transferred to the Complainant.

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