



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

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### Decision Submission

English Print

Decision ID DE-0500047  
 Case ID HK-0500064  
 Disputed Domain Name www.cathypacific.com  
 Case Administrator Dennis CAI  
 Submitted By Peter Bullock  
 Participated Panelist

Date of Decision 13-07-2005

### The Parties Information

**Claimant** Cathay Pacific Airways Limited  
**Respondent** Cathypacific Web Master

### Procedural History

The Complainant is Cathay Pacific Airways Limited of 8th Floor, North Tower, Cathay Pacific City, 8 Scenic Road, Hong Kong International Airport, Lantau, Hong Kong. The Respondent is an entity listed as "Cathypacific Web Master" which, on obtaining the contested domain gave an address at General Delivery, Georgetown, Grand Cayman, GT KY. The contested domain name is "cathypacific.com" ("Disputed Domain"). A Complaint in this matter was filed with the Hong Kong International Arbitration Centre ("HKIAC"), the Hong Kong Office of the ADNDRC, dated 24 May 2005 in the prescribed form, received by HKIAC on 25 May 2005.

The HKIAC notified the Registrar of the Disputed Domain of the proceedings by email on 26 May 2005. The Registrar acknowledged this notification by email of the same day confirming its registration of the Disputed Domain and including its WHOIS information.

The Complaint was served upon the Respondent in the following ways:

- by the HKIAC by email on 25 May 2005 to the address (managerdomains@gmail.com) provided by the Respondent as its contact email as Technical and Administrative Contact (according to the Registrar's WHOIS details updated at 26 May 2005);
- by the HKIAC by TNT Express Post to the Respondent's address in Grand Cayman, sent on 26 May 2005, although that parcel proved to be undeliverable as the address given by the Respondent was an invalid mailing address.

This constitutes valid service of these proceedings upon the Respondent.

No Response was filed with the HKIAC on or before the prescribed deadline (22 June 2005).

The Panel was appointed on 8 July 2005, with papers being delivered to the Panelists on 8 July 2005.

### Factual Background

#### For Claimant

The Complainant was founded on 24 September 1946 and is an international airline based in Hong Kong. It offers scheduled passenger and cargo services to 92 destinations around the world. It carries approximately one million

passengers each month and is listed on the Stock Exchange of Hong Kong.

The Complainant has registered the mark "CATHAY PACIFIC" ("Mark") and other marks incorporating "CATHAY PACIFIC" in respect of a wide range of goods and services throughout the world. The Complainant has also used and advertised these marks extensively throughout the world for over 50 years. The Complainant registered the domain name "CATHAYPACIFIC.COM" on 15 September 1995. The Complainant's claim is based primarily on the contention that the Disputed Domain is confusingly similar to the Mark.

### For Respondent

The Respondent registered the Disputed Domain (or, possibly, renewed a registration in respect of the Disputed Domain) on 10-03-2003.

### Parties' Contentions

#### Claimant

The Complainant asserts that the Disputed Domain (cathypacific.com) is confusingly similar to the Complainant's Mark (CATHAY PACIFIC) and obviously a deliberate misspelling of the Mark.

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

- there is no evidence of any use of or demonstrable preparations for use by the Respondent of the Disputed Domain or a name corresponding to the Disputed Name in connection with a bona fide offering of goods or services;
- the use to which the Disputed Domain is currently put is to join an advertising scheme offered by DomainSponsor.com for parked domains by which Internet users typing the Disputed Domain are diverted to a page operated by DomainSponsor.com populated with advertisements and advertising links, but which does not provide any goods or services by itself;
- there is no evidence, from the WHOIS report or otherwise, that the Disputed Domain is the name of the Respondent or the Respondent has been commonly known by the Disputed Domain, and there is no reason why the Respondent might reasonably be said to have any rights or legitimate interests in registering or using the Disputed Domain.

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

- Given that the name / mark "CATHAY PACIFIC" is an invented mark and not a term commonly used in the English language, it is obvious that the Respondent is riding on the reputation of the Complainant and uses the Disputed Domain deliberately to attract, for commercial gain (according to Domain Sponsor's business plan, disclosed in the Complaint), Internet users to DomainSponsor.com's page populated with advertising links.
- Given the Complainant's substantial fame throughout the world, it is most unlikely that the Respondent is unaware of the Complainant's rights in the Mark. The Complainant relies on *Telstra Corporation Limited - v- Nuclear Marshmallows (D2000-0003)* in this regard. Indeed the DomainSponsor.com landing page directs Internet users to other sites using the Mark "CATHAY PACIFIC".
- As the said landing page also directs users to websites of other airlines and air ticketing agents, in view of the similarity of the Disputed Domain and the Mark and the Complainant's Domain Name, it is very likely some of the Complainant's customers will enter the Respondent's website by mistake and will be referred to websites of other airlines and agents, causing disruption to the Complainant's business and prejudicing the Complainant's interests.
- The Respondent failed to respond to the Complainant's Solicitors' cease and desist letters of 13 and 21 April 2005.

#### Respondent

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

### Findings

#### Identical / Confusingly Similar

#### A. Respondent in Default

The 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. Discussion and Findings

According to Paragraph 4a of the 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.

#### Identical/confusing similarity

The Disputed Domain is confusingly similar to the Mark, in which the Complainant has rights covering a large number of jurisdictions.

The Panel finds the Complainant has satisfied the first condition under Paragraph 4(a) 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. Clearly the Complainant does have a legitimate interest in the Mark "CATHAY PACIFIC", and the Panel can fathom no possible legitimate connection or interest between the Respondent and the Disputed Domain. The Respondent has not answered these allegations and the Panel has no reason to doubt the veracity of the Complaint. Use by merely incorporating advertisements and advertising links does not constitute a legitimate use in connection with a bona fide offering of services such as to defeat a domain name complaint. Reference is made to *Multimatic, Inc. - v- Heinz Jakob/Effekta*, eResolution decision, AF-0264, in which it was decided that:

"The Panel believes that, in general, far more is needed to show use or proper preparation for such use, on which legitimacy can be predicated, than merely linking, through a third-party site, a contested domain name to a page containing a list of links. If this is all that is generally necessary, then such inconsequential efforts will effectively blunt section 4(c) of the Policy and provide a ready and convenient escape mechanism for all would-be respondents holding domain names that rightfully should belong to others."

In light of and applying the above, the Respondent's use in this case does not qualify as a legitimate or bona fide use of the disputed Domain Name.

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

#### Bad Faith

(i) The Respondent's use of the DomainSponsor.com landing page to "monetize" its holding of the Disputed Domain results, or may result, in the Respondent profiting financially from its use of a name confusingly and calculatingly similar to the Complainant's Mark. Worse still, the said landing page presents Internet users with a choice of purchasing flights from other airlines than the Complainant and non-affiliated agencies. As such it is a wrongful dilution of the Complainant's trade mark rights. This constitutes bad faith on the part of the Respondent.

(ii) In case the Respondent's actions may be characterised as simply passive, which the Panel does not accept, the Panel will address the question of whether an unexplained domain registration in respect of the name of a renowned business can be found to have been registered and to be being used in bad faith without further evidence of bad faith. This was examined in the decision *Telstra Corporation Limited - v- Nuclear Marshmallows* WIPO Case No. D2000-0003. The decision contained the following:

"7.7 Has the Complainant proved that the domain name "has been registered in bad faith" by the Respondent? In light of the facts established in paragraphs 4.6 to 4.8, the Administrative Panel finds that the Respondent does not conduct any legitimate commercial or non-commercial business activity in Australia. In light of the facts established in paragraphs 4.6 to 4.8, the Administrative Panel further finds that the Respondent has taken deliberate steps to ensure that its true identity cannot be determined and communication with it cannot be made. Given the Complainant's numerous trademark registrations for, and its wide reputation in, the word <TELSTRA>, as evidenced by the facts established in paragraphs 4.2 to 4.5, it is not possible to conceive of a plausible circumstance in which the Respondent could legitimately use the

domain name <telstra.org>. It is also not possible to conceive of a plausible situation in which the Respondent would have been unaware of this fact at the time of registration. These findings, together with the finding in paragraph 7.2 that the Respondent has no rights or interests in the domain name, lead the Administrative Panel to conclude that the domain name <telstra.org> has been registered by the Respondent in bad faith.

7.8 Has the Complainant proved the additional requirement that the domain name "is being used in bad faith" by the Respondent? The domain name <telstra.org> does not resolve to a web site or other on-line presence. There is no evidence that a web site or other on-line presence is in the process of being established which will use the domain name. There is no evidence of advertising, promotion or display to the public of the domain name. Finally, there is no evidence that the Respondent has offered to sell, rent or otherwise transfer the domain name to the Complainant, a competitor of the Complainant, or any other person. In short, there is no positive action being undertaken by the Respondent in relation to the domain name.

7.9 This fact does not, however, resolve the question. As discussed in paragraph 7.6, the relevant issue is not whether the Respondent is undertaking a positive action in bad faith in relation to the domain name, but instead whether, in all the circumstances of the case, it can be said that the Respondent is acting in bad faith. The distinction between undertaking a positive action in bad faith and acting in bad faith may seem a rather fine distinction, but it is an important one. The significance of the distinction is that the concept of a domain name "being used in bad faith" is not limited to positive action; inaction is within the concept. That is to say, it is possible, in certain circumstances, for inactivity by the Respondent to amount to the domain name being used in bad faith.

7.10 This understanding of paragraph 4(a)(iii) is supported by the actual provisions of the Uniform Policy. Paragraph 4(b) of the Uniform Policy identifies, without limitation, circumstances that "shall be evidence of the registration and use of a domain name in bad faith", for the purposes of paragraph 4(a)(iii). Only one of these circumstances (paragraph 4(b)(iv)), by necessity, involves a positive action post-registration undertaken in relation to the domain name (using the name to attract custom to a web site or other on-line location). The other three circumstances contemplate either a positive action or inaction in relation to the domain name. That is to say, the circumstances identified in paragraphs 4(b)(i), (ii) and (iii) can be found in a situation involving a passive holding of the domain name registration. Of course, these three paragraphs require additional facts (an intention to sell, rent or transfer the registration, for paragraph 4(b)(i); a pattern of conduct preventing a trade mark owner's use of the registration, for paragraph 4(b)(ii); the primary purpose of disrupting the business of a competitor, for paragraph 4(b)(iii)). Nevertheless, the point is that paragraph 4(b) recognises that inaction (eg. passive holding) in relation to a domain name registration can, in certain circumstances, constitute a domain name being used in bad faith. Furthermore, it must be recalled that the circumstances identified in paragraph 4(b) are "without limitation" - that is, paragraph 4(b) expressly recognises that other circumstances can be evidence that a domain name was registered and is being used in bad faith.

7.11 The question that then arises is what circumstances of inaction (passive holding) other than those identified in paragraphs 4(b)(i), (ii) and (iii) can constitute a domain name being used in bad faith? This question cannot be answered in the abstract; the question can only be answered in respect of the particular facts of a specific case. That is to say, in considering whether the passive holding of a domain name, following a bad faith registration of it, satisfies the requirements of paragraph 4(a)(iii), the Administrative Panel must give close attention to all the circumstances of the Respondent's behaviour. A remedy can be obtained under the Uniform Policy only if those circumstances show that the Respondent's passive holding amounts to acting in bad faith."

Following Telstra and applying its reasoning to the circumstances of this particular Complaint, the Panel has concluded that the passive holding of the Disputed Domain by the Respondent amounts to the Respondent acting in bad faith in its registration and using the Disputed Domain in bad faith. The particular circumstances of this case which lead to this conclusion are:

- (1) the Complainant's trade mark has a strong reputation and is widely known in Hong Kong;
- (2) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the Disputed Domain;
- (3) the Respondent has taken active steps to conceal its true identity, by giving a false contact address; and
- (4) taking into account all of the above, it is not possible to conceive of any plausible actual or contemplated active use of the Disputed Domain by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trade mark law.

#### Status

www.cathypacific.com

Domain Name Transfer

## Decision

Based on the above analysis, the Panel decides that: (1) the Disputed Domain is confusingly similar to a mark 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 3 (c) of the Policy, and at the Complainant's request, the Panel decides that the Disputed Domain cathypacific.com should be transferred to the Complainant.

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