



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

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Decision Submission

English Print

Decision ID DE-0500050
 Case ID HK-0500066
 Disputed Domain Name www.ascotsports.com
 Case Administrator Dennis CAI
 Submitted By Ian Barker
 Participated Panelist

Date of Decision 29-07-2005

The Parties Information

Claimant Pintas Consulting Group Sdn Bhd
Respondent hong ong

Procedural History

The Complainant submitted a Complaint to the Asian Domain Name Dispute Resolution Centre (Hong Kong Office) (“The Centre”) on 4 June 2005.

On 6 June 2005, the Registrar confirmed by email to the Centre that the domain name <ascotsports.com> is registered with it and that the Respondent is the current registrant of the name. The Respondent is bound by Tucows Inc.’ s registration agreement and has therefore agreed to resolve domain name disputes brought by third parties in accordance with ICANN’ s Uniform Domain Name Dispute Resolution Policy (“the Policy”).

On 9 June 2005, a Notice of Complaint was sent to the Respondent by email. The Notice did not require the Respondent to submit a response “at this moment” , but invited him to register with the ADNDRC system, or to contact the Centre’ s office to obtain the Complaint documents and to provide contact details. The Complainant advised the Centre that it had served a copy of the Complaint on the Respondent by registered post.

On 9 June 2005, the same Notice was sent by courier by the Centre to the Respondent at the address in Yardley, Pennsylvania supplied by the Registrar. It was not delivered, the courier reporting on 13 June 2005 “delivery address incorrect/incomplete/missing” .

On 16 June 2005, the Centre emailed to the Respondent at both the administrative and technical contact addresses as supplied by the Registrar, a Notification of Commencement of Proceedings setting a deadline of 20 days from that date for the filing of a Response. The Notification advised the Respondent about how to file a Response. The Respondent did not file a Response within the stipulated time. He was advised of this fact by the Centre on 7 July 2005.

On 12 July 2005, the Respondent emailed the Centre saying that he only knew about the case a few days ago and had accessed the case file “only yesterday” . He said that he could not submit a Response because no documents were found when he clicked on. On 11 July 2005, the Centre advised the Respondent how he could access the case, but that since the due date for filing a Response had passed, any later submissions would be acceptable only if the Panelist allowed them. Nothing further has been heard from the Respondent.

On 13 July 2005, the Centre appointed the Honourable Sir Ian Barker QC to be sole Panelist in this administrative proceeding.

Although the Respondent could not be served with relevant documents at the address he provided to the Registrar, the Panelist is satisfied that the Respondent knew of the administrative proceeding because he was served with a copy of the Complaint by the Complainant and because of his communication with the Centre.

Factual Background

For Claimant

The Complainant is a private limited company, incorporated in Malaysia in 1987. In 1988 and 1989, as the holder of the only “Sporting Bookie licence” from the Malaysia Ministry of Finance, it operated 3 betting centres in Malaysia which screened live telecasts of horse races in Australia and the United Kingdom which could be viewed by punters on the premises. Because of the then political climate, the Complainant suspended its licence in 1990 on condition that it would have first refusal if the Government were to reissue such licences in the future.

In 1999 it applied to the Ministry for the reissue of the licence. The Complainant does not say whether its application for reissue was successful. On 24 April 2005 an associated company applied to the authorities in the Isle of Man for a restricted betting licence.

The Complainant applied on 9 May 2005 for registration of the trademark Ascotsports in Malaysia. It registered the domain name <ascot.com.my> on 6 November 2003.

For Respondent

The Respondent has no submissions.

Parties' Contentions

Claimant

The Complainant's contentions may be summarized as follows:

a. The Complainant has acquired a common law right on the brand “ASCOTSPORTS”. Through the extensive use and promotion of the Ascotsports brand and the wide publication of Ascotsports trademark in the daily newspapers since 1988, the Complainant has established substantial goodwill over the Ascotsports trademark. The disputed Domain Name is identical to the Complainant's common law mark of “ASCOTSPORTS”.

b. The disputed Domain name bears no resemblance or nexus to the Respondent's name or business. The Respondent does not provide any goods or services using the “ASCOTSPORTS” or “ASCOT” names. The Respondent has not made preparation to use nor has he used the disputed Domain Name commercially or otherwise. Hence, the Respondent has no rights or legitimate interests in the said disputed Domain Name.

c. The Respondent has registered and has used the disputed Domain Name in bad faith for to the following reasons:

i) The Complainant on 16 May 2005 sent to the Respondent by way of courier a Letter of Request for Transfer of the disputed Domain Name to the Complainant. The letter was returned undelivered: the Respondent's address was marked as “Incorrect Address” by the courier company. The Respondent has provided false contact details to the Registrar in order to avoid detection. If the Respondent were sincere in creating an internet presence for his business, the Respondent could have easily done so by creating a genuine website using one of the many website services offered on the internet. Providing fictitious entity information to the Registrar demonstrates bad faith on the Respondent.

ii) Despite having prior knowledge of the Complainant's existence and reputation in Malaysia, the Respondent has deliberately and unjustifiably chosen the Complainant's common law mark for his domain name. By only displaying the phrase “ascotsports.com COMING SOON!” in his website, the Respondent has not provided any evidence of use of the Complainant's Domain Name.

iii) By using the Complainant's Domain Name and displaying the phrase “ascotsports.com COMING SOON!” in his website, the Respondent has intentionally attempted to attract for commercial gain, internet users to the Respondent's future 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 the Respondent's website, products or services making the internet users believe they would be visiting a website of the Complainant.

iv) The Respondent has registered the Complainant's Domain Name in order to prevent the Complainant, as owner of the common law mark, from reflecting the mark in a corresponding domain name.

v) The Respondent has registered the disputed Domain Name primarily for the purpose of disrupting the business of the Complainant.

Respondent

The Respondent has no submissions.

Findings**Identical / Confusingly Similar**

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

- a. Respondent's domain name must be identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- b. Respondent has no rights or legitimate interests in respect of the domain name; and
- c. Respondent's domain name has been registered and is being used in bad faith.

A) Identical / Confusingly Similar

The disputed domain name is identical to the word "Ascotsports". The Complainant has no registered trademark for this word and therefore has to rely on an alleged common law mark in order to establish that it has right in a trademark. If it cannot so establish, the Complainant must fail the first hurdle.

Despite the assertions in the Complaint, the only pieces of evidence annexed thereto, supporting the existence of a common law mark are:

- a. advertisements in a newspaper in 1990 for "Ascotsports" for live horse races in UK and Australia.
- b. Copies of the licence application in the Isle of Man;
- c. Newspaper clippings in 1988, 1989 and 1990 about the Complainant's outlets.

Trade names or marks which have, through usage, become distinctive of the owner's goods or services may be protectable as common law marks because they have acquired a secondary meaning. Another way of looking at whether a common law mark has been established is to enquire whether the person with the competing mark is "passing-off" the alleged common law mark. See *BAA plc v Larkin* case (WIPO D2004-555) where the Panel said:

"As noted by the Panelist in *Julian Barnes v, Old Barnes Studios Limited*, WIPO Case No. D2001-0121... "This involves understanding what is meant by "passing off" because the easiest way of defining a common law trademark is to say that it is an unregistered mark used by its proprietor in the course of trade, the unauthorized use (or imitation) of which by another trader will lead to "passing off".

Passing off is a tort based upon the proposition that it is unlawful to represent contrary to fact that one's goods or services are the goods or services of another. "Commonly, such misrepresentations are made by using a name or mark which identifies the Claimant was otherwise a symbol of his goodwill. (ibid). the above quotations are taken from one of the numerous cases there the common-lawmark attached to a popular author. There are similar cases in respect of pop stars and sporting personalities.

See similar comments about common-law marks in *Luis Cobos v. West, North* WIPO Case No. D2004-0182. "To succeed the Complainant would have to establish a reputation and goodwill in the United Kingdom under his name. He would have to prove that the third party's use of his name would be likely to lead to deception in the market place, and he would have to prove a likelihood of consequential damage to his goodwill."

In *Anson Enterprises, L.C. v Sharon McGall* (WIPO D2001-083) the Panel stated that evidence of a secondary meaning for a mark, sufficient to justify a finding of a common law trademark "includes length and amount of sales under the mark, the nature and extent of advertising, consumer surveys and media recognition". The Panel found that a bare claim of use of the mark since 1992 plus a statement that the Complainant's gross sales exceeded \$7 million and a web page was inadequate.

Extensive use of a common law mark, for example, was demonstrated in *BroadcastAmerica.com v Quo* (WIPO DTV2000-0001). There, the Complainant used its unregistered mark in offering internet broadcast services to users worldwide. More than 500 individual radio stations and 67 television stations in the United States and 9 other countries employed the Complainant as their exclusive internet broadcast outlet. More than 2 million individual internet users accessed audio and video programming through a website operated by the Complainant. Supplementary evidence from the Complainant showed immense exposure to its brand or mark. It was little wonder, therefore, that the Panel found a

common law service mark, despite the absence of a registered trademark.

Given the fairly high tests for proving a common law mark, the Panel is of the opinion that the Complainant has not proved a mark which is entitled to protection under the Policy. The parties live in different countries. There is no evidence to show that a resident of Pennsylvania, USA would know about the Complainant's activities in either Malaysia or the Isle of Man. The evidence presented by the Complainant is insufficient to bear the inference of a common law mark. Referring to Anson Enterprises (Supra) there was nothing like the evidence needed to show a common law mark. See also Capstar Radio Operating Company v Sterling Davenport (NA7 0505000473842) for another example of inadequate proof offered for a common law mark.

The name "Ascotsports" has hardly a worldwide reputation like Coca-Cola or McDonalds, for example. If anything, the word "Ascot" is probably associated by most with the famous racecourse of that name in England, rather than with an offcourse betting establishment in Malaysia. There is also the point that the Complainant's trading activities appeared to have been confined to 1988 - 90.

Rights and Legitimate Interests

see above

Bad Faith

see above

Status

www.ascotsports.com

Complaint Rejected

Decision

Accordingly, in the Panel's view, the Complainant has not made out the first criterion under the Policy and the Complaint must fail.

Whilst it is therefore unnecessary to consider the other two criteria, the Panelist points out that it could be difficult here to infer bad faith registration (as distinct from bad faith use) where the mark is not well-known outside of a particular country and the Respondent is in a distant country. See, for example, V2 VermögensZentrum AG v Anything.com (WIPO D2000-0527).

The Complaint is dismissed.

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