



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

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Decision Submission

English Print

Decision ID	DE-0500060
Case ID	HK-0500070
Disputed Domain Name	www.perfect2call.biz
Case Administrator	Dennis CAI
Submitted By	Loke Khoon Tan
Participated Panelist	Loke Khoon Tan
Date of Decision	22-11-2005

The Parties Information

Claimant	MediaRing Ltd
Respondent	John D'Souza

Procedural History

The complainant is MediaRing Ltd, a limited company incorporated under the laws of Singapore, whose address is 750A Chai Chee Road #05-01, Technopark @ Chai Chee, Singapore 469001, which uses the domain name <perfect2call.com> in its business (the “Complainant”). Its authorised representative in this proceeding is Kenneth Elchert. The respondent is John D’ Souza of A/212, Five Gardens, Rahatni Pune, Maharashtra 411017, India (the “Respondent”). The Respondent has not appointed any representative in this proceeding.

The domain name in dispute is <perfect2call.biz> (the “Disputed Domain”). The Registrar of the Disputed Domain is Go Daddy Software, Inc. of 14455 N. Hayden Rd., Suite 219, Scottsdale, AZ 85260, USA (the “Registrar”).

On 18 August 2005, pursuant to the Uniform Domain Name Dispute Resolution Policy (the “Policy”), the Rules for the Uniform Domain Name Dispute Resolution Policy (the “Rules”) and the Hong Kong International Arbitration Centre Supplement Rules (the “HKIAC Supplemental Rules”), the Complainant filed a complaint in the English language with the Hong Kong International Arbitration Centre (the “HKIAC”), an office of the Asian Domain Name Dispute Resolution Centre, and elected that the dispute be submitted to a single-member panel for resolution. The complaint was received by the HKIAC on 25 August 2005, and the HKIAC sent an acknowledgement to the Complainant by email on the same day. All correspondence to and from the HKIAC described herein is in the English language.

On 25 August 2005, the HKIAC informed the Registrar by email that a complaint had been filed against the Disputed Domain of the Respondent. The Registrar acknowledged receipt of the email the next day and confirmed its registration of the Disputed Domain. It also confirmed that the Respondent was named as the registrant of the Disputed Domain.

On 30 August 2005, the HKIAC sent via email to the Respondent at its administrative and technical contact address, as provided in the WHOIS database, at <ask7779@yahoo.co.in>, notice that a complaint had been filed against him. On the same date, the HKIAC sent by courier TNT a copy of the same complaint filed by the Complainant to the Respondent at the Respondent’s address of record, A/212, Five Gardens, Rahatni Pune, Maharashtra 411017, India.

On 3 September 2005, the Complainant notified the HKIAC via email that, following an attempt to send the complaint by courier FedEx to the Respondent at the address A/212, Five Gardens, Rahatni Pune, Maharashtra 411017, India, the materials were returned by FedEx as undeliverable. The Respondent confirmed by email on 5 September 2005 that he had not received the complaint via courier. In response, the HKIAC instructed the Complainant to deliver the materials by email. Accordingly, the materials were duly sent by the Complainant to the Respondent via three (3) separate emails on 8 September 2005.

On 16 September 2005, the HKIAC formally notified the Respondent by email of the commencement of this proceeding, and of its requirement that any response must be filed within twenty (20) calendar days.

On 7 October 2005, the HKIAC notified the Complainant by email that the Respondent had failed to submit a timely response.

On 25 October 2005, the HKIAC notified the parties by email of the appointment of Mr. Loke Khoon Tan as the sole panelist in this proceeding (the “Panel”).

On 26 October 2005, the Panel received from the HKIAC the file related to this proceeding.

Factual Background

For Claimant

The Complainant is a limited company incorporated in Singapore. It states that its wholly owned U.S. subsidiary, Mediating.com, Inc., owns a domain <perfect2call.com> (the “Complainant’s Domain”) which was registered in March 2002. (Annex ‘b’) It says it has been using the service mark “perfect2call” and the Complainant’s Domain to sell PC-phone services through resellers since 2002.

For Respondent

The Respondent is an individual residing in India, who registered with the Registrar the Disputed Domain in May 2005. (Annex ‘c’ and ‘d’) The Complainant states that the Respondent has since then been using the Disputed Domain for selling PC-phone services through resellers. The Complainant also states that Disputed Domain has copied the colour scheme, content and look and feel of the Complainant’s Domain.

Pursuant to Title 17, Section 512(c) of the United States Code, in July 2005, the Complainant filed a request with the Registrar to shut down the website to which the Disputed Domain resolved, on the grounds that the website’s content infringed the Complainant’s copyright. The Registrar subsequently complied with this request.

The Complainant alleges that, after the Registrant shut down the Respondent’s website, the Respondent moved the Disputed Domain to a different webhosting company, and that that this “new” website was again substantially similar to the Complainant’s website, with only minor and superficial modifications to the content, look and feel. (Annex ‘e’)

Parties' Contentions

Claimant

The Complainant asserts that the Disputed Domain is confusingly similar to the Complainant’s service mark “perfect2call.”

The Complainant also asserts that the Respondent should not have rights in respect of the Disputed Domain because:

1. The Complainant has been using the “perfect2call.com” mark since 2002 and designed its website and its content in May 2002, and the Respondent purposely and intentionally selected a mark that it knew to be identical to the Complainant’s “perfect2call” mark and a domain name confusingly similar to the Complainant’s Domain.
2. The Respondent copied the content of the Complainant’s website by using the same colours, background pictures, look and feel, and by offering the same kind of services (i.e., PC to phone services through resellers), thereby making its website appear virtually identical to the Complainant’s. The Respondent subsequently moved the Disputed Domain to another webhosting company with only minor and superficial modifications to the content, look and feel (e.g., by cropping one background photo and by adding droplets and lines to it).
3. The Respondent has no legitimate interest in “perfect2call,” and is using the mark only to cause confusion among customers of the Complainant’s Domain.
4. The Respondent has used the Disputed Domain and has registered it in bad faith, as evidenced by the following assertions of fact:

(i) in a 3 August 2005 telephone conversation with Ms. Janet Cun, the Complainant's Legal Officer, the Respondent asked how much the Complainant would be willing to pay to obtain the Disputed Domain;

(ii) the Respondent is using the mark and selected "perfect2call" as a domain name in order to confuse customers of the Complainant and/or to give them an easily remembered name based on the Complainant's mark;

(iii) prior to any conversation with the Complainant concerning its request for the Respondent to terminate use of the Disputed Domain, the Respondent already knew the names of numerous employees of the Complainant, and would speak only with Mr. William Tan, the Complainant's Senior Vice President, Worldwide Sales, regarding resolution of the dispute. The Complainant further asserts that these facts, when taken together, indicate the Respondent's selection of the Disputed Domain was not random, but intentionally designed to obtain an unfair advantage against the Complainant, to confuse customers as to the identity of the Respondent website, and to pass itself off as the Complainant;

(iv) when the Respondent initially registered the Disputed Domain, it provided the name "MedioRing.com, Inc." as registrant, and listed the former business address of the Complainant's US subsidiary, MediaRing.com, Inc., as its own address. It also listed slight variants of MediaRing.com, Inc.'s former telephone and fax numbers as Respondent's telephone and fax numbers. The Complainant submits that this is further evidence of bad faith and intentional attempt to deceive and to attract internet users to the Disputed Domain for the Respondent's own commercial gain with respect to sales of internet telephony services.

Respondent

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

Findings

Identical / Confusingly Similar

Paragraph 5(e) of the Rules provides 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 present in this matter, and will proceed to determine the dispute based upon the complaint.

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel shall employ in its resolution of the dispute: "A Panel shall decide a complaint on the basis of the statement and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following:

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

Identical or Confusingly Similar

The principal issue to be decided in this case is whether or not the Complainant has sufficient service mark rights to justify its complaint. It is noted that the Complainant has not provided evidence that it holds a registered service mark, but neither the Policy nor the Rules require that the service mark must be registered, only that the Complainant must have rights in it. In this respect, the Panel refers to the World Intellectual Property Organization's (WIPO) Final Report on the Internet Domain Name Process (April 30, 1999), paragraphs 149-150. In addition, it has been held in the following WIPO decisions that a complaint may proceed on the basis of common law rights:

SeekAmerica Networks Inc v Tariq Masood & Solo Signs (WIPO Case No: D2000-0131)
 Julia Fiona Roberts v Russell Boyd (WIPO Case No: D2000-0210)
 Jeanette Winterson v Mark Hogarth (WIPO Case No: D2000-0235)
 Monty and Pat Roberts v Bill Keith (WIPO Case No: D2000-0299)

The Panel therefore takes the view that the fact that the Complainant has no registered service mark for "perfect2call" is not fatal to its complaint.

The Panel notes that the Complainant has produced little evidence in support of its common law rights in the service mark "perfect2call". Nonetheless, uncontested evidence shows that it has used the service mark and the Complainant's Domain since 2002, and as such the Complainant does have rights to the unregistered service mark. In

IR Group Ltd v Young il Kim (HKIAC Decision ID: DE-0300010), the complainant relied on rights in its unregistered trading name but filed little evidence in support of its claims. The Panel in that case found, given that the “website [of the complainant in that case] is available for the world, including the Panelist, to see ... and given the use of it claimed by the complainant, the complainant has sufficient rights in the mark to be worthy of protection hereunder.” Similarly, the website of the Complainant in the instant case is available for the public to see, and together with the Complainant’s uncontested claim that it has used the mark since 2002, the Panel finds sufficient evidence that the Complainant has established its rights in the service mark “perfect2call.”

The Panel notes that the whole of the Complainant’s service mark is incorporated in the Disputed Domain. The only difference between the two is the addition of the “.biz” suffix in the Disputed Domain. In *Geoffrey, Inc. v Maverick Multimedia* (WIPO Case No: FA0112000102727), it was held that the use of the generic Top Level Domain “.biz” did not eliminate the confusing similarity between the mark and the contested domain name in that case, as the use of the “.biz” suffix was required of all parties desiring to register in the “.biz” domain. Given that the suffix “.biz” is merely instrumental to the use of the internet, the Panel finds that the Disputed Domain is confusingly similar to the service mark which the Complainant has rights.

Rights and Legitimate Interests

The Complainant alleges that the Respondent has no right or legitimate interest in respect of the Disputed Domain. It supports its allegation with various factual assertions, such as the prior use of the service mark by the Complainant, its earlier registration of the Complainant’s Domain, the direct copying of the Complainant’s website by the Respondent and the subsequent substantial similarity between the two websites. The Panel finds no reason to doubt the veracity of the allegations, and the Respondent has failed to respond to them. The Respondent’s failure to show that it has rights or legitimate interest in respect of the Disputed Domain entitles the Panel to infer that the Respondent indeed has no rights or legitimate interests in the Disputed Domain. See *Schroders v Katherine Stewart* (HKIAC Decision ID: DE-0500053) and *Pavillion Agency, Inc. v Greenhouse Agency Ltd.* (WIPO Case No: D2000-1221). Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain.

Bad Faith

Paragraph 4(b) of the Policy sets forth “in particular but without limitation” circumstances which “shall be evidence of registration and use of a domain name in bad faith,” which are as follows:

- i. circumstances indicating that the Respondent has registered or 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 Respondent’s documented out-of-pocket costs directly related to the domain name; or
- ii. the Respondent 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 Respondent has engaged in a pattern of such conduct; or
- iii. the Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- iv. by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent’s 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 the Respondent’s web site or location or of a product or service on the Respondent’s web site or location.

The Complainant has asserted the existence of facts supporting a finding of bad faith under (i) and (iv) of the above conditions. These include the Respondent’s alleged solicitation of an offer to purchase the Disputed Domain, the striking similarities between the content of the Disputed Domain and the Complainant’s Domain, the Respondent’s full knowledge of the management structure of the Complainant, and the provision of substantially the same contact information as the Complainant’s subsidiary by the Respondent. The Respondent has failed to respond to these allegations, and the Panel has no reason to doubt the veracity of the complaint. In *The Hong Kong Jockey Club v Shizuki Kishimoto* (HKIAC Decision ID: DE-0500043), the panel accepted that wrongful duplication of the complainant’s website by the respondent and his silence to the complainant’s allegations were sufficient proof of bad faith on the part of the respondent. Accordingly, the Panel accepts the unanswered evidence of the Complainant and finds that the Disputed Domain has been registered and is being used in bad faith by the Respondent.

Status

www.perfect2call.biz

Domain Name Transfer

Decision

For all the foregoing reasons, the Panel concludes that:

- i. the Disputed Domain is confusingly similar to the service mark “perfect2call” in which the Complainant has rights;
- ii. the Respondent has no right or legitimate interest in respect of the Disputed Domain;
- iii. the Respondent has registered and has used the Disputed Domain in bad faith.

Accordingly, pursuant to paragraph 4(i) of the Policy and 15 of the Rules, the Panel orders that the Disputed Domain be transferred to the Complainant.

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