



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

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Decision Submission

English Print

Decision ID DE-0600070
Case ID HK-0600078
Disputed Domain Name www.tvbclub.com
Case Administrator Dennis CAI
Submitted By Anthony Wu
Participated Panelist

Date of Decision 02-04-2006

The Parties Information

Claimant Television Broadcasts Limited
Respondent Chen Hua Zhong

Procedural History

On 27 January 2006, the Hong Kong Office of Asian Domain Name Dispute Resolution Centre (“ ADNDRC ”) received a hardcopy Complaint form in English filed by the Television Broadcasts Ltd (the “ Complainant ”) pursuant to the Uniform Domain Name Dispute Resolution Policy (the “ Policy ”) adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on 24-10-1999. On the same day, the Hong Kong Office of ADNDRC received payment for the required administrative fee in connection with the case.

The Registrar, Xin Net Technology Corporation, was notified of the Complaint on 26 January 2006. The Registrar was requested to confirm that the domain name at issue was registered by the Respondent with them. On 13 February 2006, Xin Net Technology Corporation confirmed that the disputed domain name was registered with it by Respondent.

On 4 February 2006, the Hong Kong Office of ADNDRC by email notified the Respondent of the Complaint and provided copy of the Complaint to the Respondent. On the 11 February 2006, the Hong Kong Office of ADNDRC served a notification of Commencement of the Proceedings on the Respondent and the Respondent was asked to submit a Response to the Complaint. The Respondent did not file any response.

On 6 March 2006, the Hong Kong Office of ADNDRC notified the parties that as a Response to the Complaint has not been submitted by the Respondent within the required time, the Case Administrator will shortly appoint Panelist for the matter.

On 18 March 2006 in, the Hong Kong Office of ADNDRC appointed Mr Anthony Wu to serve as Panelist and notified the parties of the appointment. All documents submitted by the parties were sent to the Panelist by letter on the same day.

Note: As the Complaint was lodged in English and the Respondent did not file a Response, the Panel, pursuant to Paragraph 11 of the Rules for the Policy, decides to use English in writing out this decision.

Factual Background

For Claimant

Complainant, Television Broadcasts Limited, commonly known as TVB, is the first wireless commercial television station in Hong Kong. It was first established in 1967. The principal activities of Complainant are television broadcasting, programme production and other broadcasting related activities such as programme licensing, video rental, audio and video products selling and distribution, etc. It is the largest producer of Chinese language programming in the

world.

Complainant's subsidiary, TVBI Company Limited ("TVBI"), is the world's largest distributor of Chinese-language programmes. TVBI and its sub-licensees supply Complainant's programmes to free-to-air broadcasters, cable and satellite television broadcasting service operators, video distributors and video-on-demand service providers worldwide and in particular, The People's Republic of China ("PRC") is one of TVBI's major video licensing market.

In 2005, TVBI begins to exploit the Video-On-Demand and Internet interactive media markets in PRC. TVBI has licensed Complainant's programmes to numerous Video-On-Demand and Internet Cafe service providers in PRC. A list of the names and the printed pages of the websites of TVBI's Video-On-Demand licensees in PRC are listed in Annex IV of the Complaint.

Complainant also offers sales of its programmes in the format of VCDs and DVD for online purchase via the "eShop" at its official webpage at <http://www.tvb.com> to people in various countries including but not limited to PRC, Australia, Canada, Europe, Hong Kong SAR, Macau SAR, Malaysia, New Zealand, Singapore and USA. The webpage address is at: <http://shop.tvb.com:8080/tvb/ShopVCD.do?zoneID=Z00000001>.

As at the date of the submission, Complainant and its subsidiary has registered 8 domain names bearing the mark "tvb", namely, "tvb.com", "tvb.com.hk", "tvb.com.au", "tvbihk.com.hk", "tvbs.net", "tvbusa.com", "tvbusa.us" and "tvb.co.uk". Copies of WHOIS report (requested on 4th January, 2006) of those domain name registrations are listed in Annex V of the Complaint.

In December 2004, Complainant set up another subsidiary company known as "TVB Club Limited". A copy of the Certificate of Incorporation and the Certificate of Change of Name are enclosed with the Complaint as Annex VI.

In November 2005, it came to Complainant's attention that Respondent had registered the disputed domain name www.tvbclub.com. Respondent has been using it as the name of its website, and has been using Complainant's trademark "TVB" in its website without Complainant's authorization. Respondent set up forums in the name of "TVB" in the website for online sharing of Complainant's programmes. Complainant sent an email to Respondent on 2nd November, 2005 requesting Respondent to delete all contents containing Complainant's programmes and to transfer the domain name in dispute to Complainant for its use as Respondent has infringed Complainant's copyright and jeopardized Complainant's trade rights.

Respondent made no response to Complainant's demand on 2 November 2005 for the transfer of the domain name in dispute.

For Respondent

Respondent did not reply to the Complaint.

Parties' Contentions

Claimant

(i) The domain name in dispute is confusingly similar to Complainant's service mark "TVB":
The domain name in dispute is "tvbclub.com", a generic top level domain. Complainant has reason to believe that by comparing the disputed domain name with Complainant's trademark "TVB", it clearly illustrates that the disputed domain name "TVB Club" is highly and confusingly similar to Complainant's registered trademark and service mark "TVB". The mark "TVB" has been used by Complainant for more than 38 years. Complainant first registered "TVB" as its trademark in Hong Kong in 1992 and "TVB" has been registered and/or applied for registration by Complainant in 14 jurisdictions worldwide. The disputed domain name "TVB Club" is also exactly the same as the company name of Complainant's subsidiary company, namely TVB Club Limited, set up in December, 2004.

Apart from the mark "TVB", Complainant has also registered numerous trademarks, such as "TVBS", "TVB8", "TVBA Value Club", "TVBJ", "TVBA", "TVBVideo" and "TVBS-E" in various jurisdictions and for various services. As a common characteristic, these marks all contain "TVB". Details of these registrations and its applications are listed in Annex VII of the Complaint.

In addition, TVBI owns a satellite television channel named "TVBJ" for broadcasting of Chinese-language television programmes in Australia & Singapore. Complainant's another subsidiary, The Chinese Channel (France) SAS, owns and operates a satellite television channel named "TVBS-E" for the Chinese speaking audiences in UK and Europe while satellite television channel "TVB8" caters for Chinese audiences in the Asia and Pacific region. Since 1997,

TVBI has been running a franchised video chain called “TVB Video” in Vancouver, Canada. In U.S.A., Complainant’s subsidiary TVB(USA) Inc., operates cable and satellite TV services to Chinese speaking audiences nationwide.

In such circumstances, Complainant’s name and trademark have been well known worldwide. Complainant enjoys service mark rights in the name “TVB” due to goodwill and reputation accumulated through extensive use and advertising promotion since its registration in the early 90s’ .

Respondent registered the domain name in dispute on 1st March, 2004 (as shown in Annex I of this Complaint). By setting up forums for Complainant’s programmes on its site, Respondent clearly shows that it is familiar with Complainant’s trade and Complainant’s trademark “TVB”. The domain name in dispute, “TVB Club” mainly comprises of the mark “TVB”. Although the word “club” is added after the word “TVB”, the disputed domain name should be seen as identical or confusingly similar with Complainant’s trademark “TVB” and other trademarks deriving from “TVB”, such as “TVB Video” (which also offers video rental and distribution services of Complainant), “TVB8” & “TVBA Value Club”. The disputed domain name is also exactly the same as the company name of Complainant’s subsidiary known as TVB Club Limited. All these could cause confusion to the public and mislead them to think that Complainant and/or its official web sites, such as www.tvb.com or www.tvbusa.com.us are associated with the domain name in dispute or that Complainant has authorized Respondent to use the trademark and/or service mark of Complainant. There is reason to believe that Respondent purposely and intentionally selected a domain name confusingly similar to Complainant’s domains and trademark in order to draw internet users to its website.

(ii) Respondent has no rights or legitimate interests in the registration of the domain name in dispute

Respondent uses the domain name in dispute for its website where it offers services that infringe the copyright of Complainant: Respondent has provided a forum named “影視&音樂” (“Video & Music”), where three other sub-forums namely, “TVB新片發佈區” (“TVB new series issue forum”), “TVB 劇集交流” (“TVB series exchange forum”) and “TVB補檔區” (“TVB Supplements files forum”) are found. Respondent provides such forums for its members to upload, download and distribute Complainant’s programmes and its other copyrighted materials illegally. The members of www.tvbclub.com are required to pay fees to Respondent and in return Respondent provides ftp servers for the members to download and view Complainant’s programmes. In order to tout potential members who are interested in Complainant’s programmes, Respondent even posts Complainant’s logo and trademark in its webpage.

A copy of the front page of the Respondent’s webpage at www.tvbclub.com/bbs/index.php is printed as Annex VIII of the Complaint.

Moreover, there is no evidence, from the WHOIS report or otherwise, that the disputed domain is the name of Respondent or Respondent has been commonly referred to as the disputed domain, and there is no reason why Respondent might reasonably be said to have any rights or legitimate interests in registering or using the disputed domain.

Further, by copying and using Complainant’s registered trademark and logo and by offering downloading of Complainant’s programmes without authorization, Respondent has infringed the copyright and other intellectual property rights of Complainant, as well as constituted passing-off under the Common Law.

(iii) Respondent has registered and used the domain name in bad faith

Complainant believes that Respondent has registered and used the domain name in dispute in bad faith.

Respondent is not any licensee of Complainant, yet, as referred earlier Respondent provides forums and ftp servers for the uploads, downloads and viewings of Complainant’s programmes. Respondent attempts to attract public to visit its website and register as its member by using Complainant’s trademark “TVB” and special highlights of “TVB” in the website.

By doing so, Respondent infringed Complainant’s copyright and committed passing off under Common Law.

Respondent distracted purchasers from Complainant, who, instead of buying video products or subscribing Video-On-Demand service authorized by Complainant, choose to pay Respondent for online downloading services after visiting <http://www.tvbclub.com> .

It is obvious that Respondent is riding on the reputation of Complainant and uses the domain in dispute deliberately to attract, for commercial gain, Internet users to the Respondent’s web site or other on-line location, by providing similar service and/or products of Complainant, and by creating a likelihood of confusion with Complainant’s mark and mislead the public to believe that the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s web site or location are associated with Complainant, or with its authorization.

Complainant has, in as early as 2nd November 2005, sent a letter of desist to Respondent via email and fax demanding its deletion of infringing contents and transfer of the domain name in dispute. Despite the successful delivery of the

email, Respondent fails to stop its using of the domain name in dispute and has refused to transfer the domain name in dispute to Complainant. This constitutes potent evidence of bad faith.

Respondent

Respondent did not respond to the Complaint.

Findings

Identical / Confusingly Similar

The Panel is satisfied that Complainant has rights over the trademark/service mark of “TVB”. There are overwhelming evidence. The mark has been used by the complainant for more than 38 years. It has become a distinctive identifier associated with Complainant or its goods and services. It was first registered as its trademark in Hong Kong in 1992 and a “TVB” has been registered and/or applied for registration by Complainant in 14 jurisdictions worldwide. When the mark “TVB” and the domain name in dispute are compared, the panel is also satisfied that the domain name in dispute is confusingly similar to the mark. The descriptive word “club” has been added to the word “tvb” which is identical to Complainant's mark. Also, the word “club” is a descriptive word. It is also descriptive of part of the business associated with Complainant. Complainant has set up a subsidiary company known as TVB Club Ltd in December 2004. Therefore, the combined word “tvbclub” is found to be confusingly similar to Complainant's mark of “TVB”.

Rights and Legitimate Interests

Paragraph 4 (a) of the policy requires the complainant to prove that the respondent has no right or legitimate interest in the disputed domain name. It is notoriously difficult for a complainant to disprove a negative of this sort. Consequently, panels have required a complainant to establish at the least a prima facie case under this heading and, if that is made out, an evidential onus shifts to the respondent to rebut the presumption of no rights or legitimate interests. See *Atlas Copco Aktiebolag v. Accurate Air engineering, Inc.* Case No. D2003-0070.

The assertion that the Respondent has no rights or legitimate interests in respect of the domain name in dispute requires consideration of the website of the respondent. Their website offers services that infringe the copyright of Complainant. Forums are provided for its members to upload, download and distribute Complainant's programmes and its other copyrighted materials, illegally. Members of the Respondent's website are required to pay fees to the Respondent. The website also posts Complainant's logo and trademark graphically. The details are set out by Complainant in the Parties' Contention above. In the absence of any rebuttal from Respondent, the Panel accepts that what Respondent is doing is illegal and unauthorised. In the circumstances, Complainant has made out a prima facie case that Respondent does not have any rights or legitimate interests in the disputed domain name.

The onus of proof shifts to the respondent and it is for the respondent to show that it has rights or legitimate interests in the disputed domain name. The respondent may discharge its onus of proof by showing the existence of one of the circumstances under Paragraph 4 (c) of the Policy.

Respondent did not respond to the Complaint and had not, therefore, produced any evidence or put forth any contention that it has rights or legitimate interests either relying on Paragraph 4 (c) of the Policy or otherwise.

It is the finding of the Panel that Complainant has satisfied the requirements under Paragraph 4 (a) (ii) of the Policy.

Bad Faith

It is provided under Paragraph 4 (b) of the Policy that:

“For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

(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 onus of proof is on Complainant to satisfy the Panel that one of the circumstances exists or otherwise there is bad faith in the registration and use of the domain name in dispute.

The complainant seeks to rely on Paragraph 4 (b) (iv) of the Policy.

On the evidence produced by Complainant, the Panel accepts that Respondent is riding on the reputation of Complainant and uses the domain in dispute deliberately to attract, for commercial gain, Internet users through the Respondent's website by providing similar service and/or products of Complainant. Also, Internet users would likely be confused by the Respondent's use of the disputed domain name with the Complainant's mark and would be misled as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or that the product or service on the Respondent's website are associated with Complainant or with its authorisation.

As Respondent did not respond and rebut, the Panel finds that Complainant has satisfied the requirements under Paragraph 4 (a) (iii) of the Policy.

Status

www.tvbclub.com

Domain Name Transfer

Decision

It is the finding of the Panel that all requirements of paragraph 4(a) are proved by Complainant. In paragraph 9 of the Complaint, Complainant sought to have the domain name in question transferred to it. Having regard to circumstances of the case, the Panel believes that it is appropriate to transfer the domain name www.tvbclub.com to Complainant and so orders.

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