



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

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Decision Submission

English Print

Decision ID	DE-0600081
Case ID	HK-0600090
Disputed Domain Name	www.winghangbank.com
Case Administrator	Dennis CAI
Submitted By	Peter Bullock
Participated Panelist	Peter Bullock
Date of Decision	18-08-2006

The Parties Information

Claimant	WING HANG BANK, LIMITED
Respondent	Richard Feldman

Procedural History

The Complainant is Wing Hang Bank, Limited of 161 Queen's Road Central, Hong Kong. The Respondent is an individual named Richard Feldman giving an address GPO Box 2000, Central, Hong Kong. The contested domain name is "winghangbank.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 25 May 2006 in the prescribed form, received by HKIAC on 26 May 2006.

The HKIAC notified the Registrar of the Disputed Domain of the proceedings by email on 29 May 2006. The Registrar acknowledged this notification by email of 31 May 2006 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 9 June 2006 to the address (rfeldman@netvigator.com) provided by the Respondent as its contact email as Administrative Contact (according to the Registrar's email of 31 May 2006);
- by the HKIAC by Local Courier Post to the Respondent's address at GPO Box 2000, Central, Hong Kong, sent on 8 June 2006.

This constitutes valid service of these proceedings upon the Respondent.

No Response was filed with the HKIAC on or before the prescribed deadline 27 July 2006.

The Panel was appointed on 9 August 2006, with papers being delivered to the Panelist on 9 August 2006.

Factual Background

For Claimant

The Complainant was founded in 1937 but commenced operation as a limited company upon incorporation on 11 April 1960 and has been carrying on banking and related businesses since the granting of a banking licence in 1960. Its businesses are retail banking, corporate banking, foreign exchange and treasury services, offshore banking, consumer finance, share brokerage services, insurance amongst others. In July 1993, the Complainant was publicly listed in Hong Kong on The Hong Kong Stock Exchange's Main Board.

At the end of 2005, the Complainant's total assets and shareholders' funds amounted to HK\$104.3 billion and HK\$8,316 million respectively. In 1998, at the time of registration of the Disputed Domain it already had total assets of HK\$48,445

million and shareholders' funds of HK\$4,407 million. In 1998 it had 30 branches and representative offices in Hong Kong and China with a subsidiary business in Macau with 13 branches. In terms of number of branches it has grown by more than 50% in Hong Kong since 1998.

It has obtained registration of the trade mark Wing Hang Bank, Limited ("Mark") on 10 August 1998 in Hong Kong, 19 April 1999 in Macau and in China on 14 February 2000. It has registered 23 domain names, one of which (winghangbank.hk) contains the full rendition of its trade mark.

The Complainant's claim is based primarily on the contention that the Disputed Domain is identical or confusingly similar to the Mark.

For Respondent

The Respondent registered the Disputed Domain on 4 September 1998.

Parties' Contentions

Claimant

The Complainant asserts that the Disputed Domain (winghangbank.com) is identical or confusingly similar to the Complainant's Mark (Wing Hang Bank, Limited). The Disputed Domain reproduces the exact English name of the Complainant without the word "Limited", and when ".com" is ignored.

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

- the Complainant has not granted any rights or licence to the Respondent to use the Mark
- of the existence of the Complainant's prior registration of the Mark in Hong Kong, and if necessary the Complainant's prior common law rights to the Mark dating back to 1960
- there is no reason why the Respondent might reasonably be said to have any prior rights or legitimate interests in registering or using the Disputed Domain.

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

- Section 97 of the Banking Ordinance of Hong Kong makes it a criminal offence for a person, without the consent of the Hong Kong Monetary Authority to use the word "bank" in the description or name under which such person is carrying on business in Hong Kong. Section 20(1) (c) and (d) of the Companies Ordinance of Hong Kong disallows companies from registering a name the use of which by the company shall constitute a criminal offence.
- The Disputed Domain was registered in 1998 but the Respondent's website is still undergoing construction. The Complainant concludes in the circumstances the Respondent registered the Disputed Domain for the purpose of cybersquatting.
- Given the Complainant's substantial recognition in Hong Kong, and the fact the Respondent is based in Hong Kong, 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.
- The Respondent failed to respond substantively to the Complainant's Solicitors' cease and desist letters of 7 March and 7 April 2006.

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.

The Disputed Domain is identical, or if not 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 "Wing Hang Bank, Limited", 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. The Respondent has made no substantive use of the Disputed Domain.

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 Complainant must show bad faith on the part of the Respondent at the time of registration, which was on 4 September 1998. Although the Complainant's Hong Kong trade mark registration had only recently been granted at that time, it already had 30 branches and a Stock Exchange listing in Hong Kong. It clearly had had common law rights in the Mark for many years before 1998. As a Hong Kong resident the Respondent can be taken to have known this.
- (ii) The Respondent also shown bad faith at the time of registration by giving false or misleading information within his registration details. Al's Diner is a famous (and uproarious) bar in the Lan Kwai Fong entertainment district and can be presumed not to be the launching place for a bank regulated by the Hong Kong Monetary Authority.
- (iii) As the Respondent appears to have breached, or would breach if the Disputed Domain were used for business purposes, section 97 of the Banking Ordinance, bad faith can be derived from this also.

(iv) The Respondent's actions may be characterised as simply passive. The Panel must therefore 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) for the Respondent to make active use of the Disputed Domain would be illegal under Hong Kong law (unless he were a registered bank); 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.winghangbank.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 winghangbank.com should be transferred to the Complainant.

Dated 18 August 2006.

Hong Kong

Peter Bullock

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