



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

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Decision Submission

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Version
 Decision ID DE-0800185
 Case ID HK-0800180
 Disputed Domain Name www.李嘉誠.com
 Case Administrator Dennis CAI
 Submitted By Yun Zhao
 Participated Panelist

Date of Decision 30-12-2008

Language Version : English

The Parties Information

Claimant Complainant (1): Li Ka Shing; Complainant (2): Li Ka Shing Foundation
Respondent Nomi Nee

Procedural History

On 31 July 2008, the Complainants submitted a Complaint in the English language to the Hong Kong Office of the Asian Domain Name Dispute Resolution Center (the ADNDRC) and elected this case to be dealt with by a one-person panel, in accordance with the Uniform Domain Name Dispute Resolution Policy (the Policy) approved by the Internet Corporation for Assigned Names and Numbers (ICANN), the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules), and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the ADNDRC Supplemental Rules). On 15 August 2008, the ADNDRC sent to the complainants by email an acknowledgement of the receipt of the complaint and reviewed the format of the complaint for compliance with the Policy, the Rules and the ADNDRC Supplemental Rules. All correspondence to and from the HKIAC described herein was in the English language.

On 15 August 2008, the ADNDRC transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On 18 August 2008, the Registrar transmitted by email to the ADNDRC its verification response, confirming that the Respondent is listed as the registrant and providing the contact details. On 26 September 2008, the ADNDRC transmitted the Complaint to the Respondent and notified the Respondent of the commencement of the action. On 11 October 2008, the Respondent requested to extend the time limit for filing the Response. On 15 October 2008, the Complainants transmitted by email their comments on the extension. On 16 October 2008, the ADNDRC notified both parties of the extension of filing of a Response to 15 November 2008. The Respondent filed a Response with the ADNDRC on 14 November 2008. The ADNDRC forwarded the Response to the Complainant on 17 November 2008. The Complainant filed a Reply to the Response on 18 November 2008. The ADNDRC forwarded the Reply to the Respondent on 25 November 2008. The Respondent submitted further comment to the Reply on 16 December 2008. The Complainant filed a further reply on 17 December 2008.

Since the Respondent also elected to have the Complaint to be decided by one panelist, the ADNDRC informed the Complainants and Respondent that the ADNDRC would appoint a one-person panel to proceed to render the decision in accordance with the Policy, the Rules and the ADNDRC Supplemental Rules.

Having received a Declaration of Impartiality and Independence and a Statement of Acceptance, the ADNDRC notified the parties that the Panel in this case had been selected, with Dr ZHAO Yun acting as the sole panelist. The Panel determines that the appointment was made in accordance with Rules 6 and Articles 8 and 9 of the Supplemental Rules.

On 17 December 2008, the Panel received the file from the ADNDRC and should render the Decision within 14 days, i.e., on or before 31 December 2008.

Pursuant to Paragraph 11 (a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding. The language of the current disputed domain name Registration Agreement is English, thus the Panel determines English as the language of the

proceedings.

Factual Background

For Claimant

The Complainants in this case are LI Ka Shing and Li Ka Shing Foundation. The 1st Complainant is the Chairman of Cheung Kong (Holdings) Limited and Hutchison Whampoa Limited. The 1st Complainant ranks 11th on Forbes Billionaires List 2008. The second Complainant was set up by the 1st Complainant, with a mission to enhance the impact of his philanthropy. The registered address of both Complainants is as follows: 7th Floor, Cheung Kong Center, 2 Queen' s Road Central, Hong Kong.

For Respondent

The Respondent, Nomi Nee, is the current registrant of the disputed domain name <李嘉诚.com > according to the Whois information.

Parties' Contentions

Claimant

1. The Disputed Domain Name is identical or confusingly similar to a trade mark or service mark to which the Complainants have rights

The 1st Complainant, who was born in Chiu Chow, China in 1928, ranks 11th on Forbes Billionaires List 2008. The 1st Complainant is the Chairman of Cheung Kong (Holdings) Limited and Hutchison Whampoa Limited. Cheung Kong (Holdings) Limited is the flagship of the Cheung Kong group which has business operations in 57 countries around the world and employs about 260,000 staff. In Hong Kong along, the Group includes 8 listed companies with a combined market capitalization of approximately HK\$817 billion. Based in Hong Kong, the Cheung Kong Group' s businesses encompass diverse areas. The 1st Complainant is a strong believer in synergy—the power of combined efforts. The Times in the United Kingdom and Ernst & Young UK jointly named the 1st Complainant as the Entrepreneur of the Millennium at the turn of the century.

In recognition of the 1st Complainant' s philanthropic efforts and his contribution to society, he has received many Honorary Doctorates and honorary titles around the world.

The 1st Complainant considers education and medical care to be the twin pillars of national welfare. At the same time he also realizes that his contribution as an individual can only be limited. To achieve the greatest good, the 1st Complainant began to make strategic contributions to education and medical care projects in Hong Kong and China. In 1980, the 1st Complainant set up the 2nd Complainant, deliberately choosing a name incorporating the personal name of the 1st Complainant, with a mission to enhance the impact of his philanthropy. To date, the 2nd Complainant has supported numerous charitable activities with nearly HK\$10 billion. The two complainants have undertaken many major donation projects in education, medical, culture, community welfare in Hong Kong and China. Apart from Hong Kong and China, the Complainants have also undertaken charitable projects in other countries.

Since 1980, the Complainants have been using “李嘉诚基金会” extensively as a service mark/trade name for the activities and “李嘉诚” as a personal name. The 2nd Complainant is the registered proprietor of the service mark “李嘉诚基金会” in Hong Kong and China.

The Complainants claim rights in the service mark/name “李嘉诚基金会” and the personal name “李嘉诚”. As a result of the extensive and long period of use of the above names by the Complainants, the above names have been well-recognized by the public to be distinctive of and identified with the Complainants but none other. Substantial goodwill and reputation has subsisted in the above names. One can also find countless publications and reports on the Internet about the Complainants. As such, the Complainants undoubtedly have rights in the above names. Prior to the date of registration of the Disputed Domain Name and on 6 December 2006, Cheung Kong (Holdings) Limited, of which the 1st Complainant is the chairman, has registered the domain names “李嘉诚基金会.cc” and “李嘉诚基金会.net” for and on behalf of the Complainants.

The major part of the Disputed Domain Name is identical to the service mark/trade name and personal name of the Complainants.

2. The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name

The Respondent is not in any way related to the Complainants, nor was the Respondent authorized by the Complainants to use the mark/name “李嘉诚”. On or before the registration date of the Disputed Domain Name (14 June 2008), the 1st Complainant has been using the personal name for over 70 years; the 2nd Complainant was established with a name incorporating the service

mark/trade name “李嘉诚基金会” and has already registered the service mark “李嘉诚基金会” in Hong Kong and China; the 2nd Complainant has widely used the service mark/trade name “李嘉诚基金会” and the 1st Complainant has widely used the personal name “李嘉诚基金会”; substantial good will and reputation subsisted in the above names, which have been identified by the public as the service mark/trade name of the 2nd Complainant and the personal name of the 1st Complainant.

3. The Disputed Domain Name has been registered and is being used in bad faith

The 1st Complainant has been using “李嘉诚” as his personal name for almost 80 years and the 2nd Complainant has been established in Hong Kong for more than 20 years before the date of registration of the Disputed Domain Name and has been using the service mark/trade name “李嘉诚基金会” ever since. Substantial reputation and goodwill has already been subsisted in the above names. Undoubtedly, the Complainants have prior rights in the above names. As such, it could not be a coincidence for the Respondent to register a domain name which is exactly identical to the major portion of the Complainants’ service mark/trade name and the personal name, taking into account that the Respondent has never had any rights or legitimate interests in the said mark/name. It is believed that the Respondent registered the Disputed Domain Name in order to confuse the public that the Respondent’ s act is authorized by the Complainants. It is clear that the Respondent had acted in bad faith when it made the application for registration of the Disputed Domain Name in 2008. Further, the Complainants noted that the Disputed Domain Name was not put into active use by the Respondent but is merely linked to a webpage providing information search services. This indicates that the registration has no purpose other than to create confusion that such registration is endorsed by the Complainants and thereby attracting Internet users to visit the Respondent’ s website thinking that it is related to the Complainant.

In accordance with Paragraph 4(b)(i) of the Policy, the Complainants request the Panel to issue a decision to transfer the Disputed Domain Name to the 2nd Complainant.

Respondent

Although the Respondent is the legal registrant of the domain name, it is actually the nominee of 李嘉诚（合营）有限公司 who is the real and beneficial owner of the disputed domain name.

1. Complainant’ s claimed right to trademark or service mark

The domain name is not identical or confusingly similar to a trademark or service mark in which the Complainants claim to have rights. Needless to say, it is of course understood that the 1st Complainant has been using his own name extensively for long period as a personal name. This assertion is meaningless as it is a universal rule for everyone unless he/she does not have a personal name. A personal name, however, is not equivalent to a service mark/trademark. It is also strange to read that the 1st Complainant claims he has right to his personal name. The fact that 1st Complainant is using “李嘉诚” as his personal name is not unique nor exclusive.

It is believed that the 2 Complainants have willful intention to avoid meeting the request and even to cause confusion. By putting the word “李嘉诚” but failing to provide copy of mark “李嘉诚” registration certificate, such presentation style by the Complainant might confuse and mislead the reader that “李嘉诚” is a trademark/service mark the Complainant has right, which is definitely not the case. The fact that the 2nd Complainant has a registered mark reading as “李嘉诚基金会” cannot prohibit anyone from using the word “李嘉诚”, by just looking at its use as a personal name, at least 14300 people are using daily and have been using it for long period of time, the word “李嘉诚”, and the 1st Complainant is just 1 of the 14300.

“李嘉诚” is simply not a mark, nor could the Complainant prove that they have such mark registration. Both Complainants do not own any mark reading exactly as “李嘉诚” which is the substance of the dispute. The mark owned by the 2nd Complainant cannot prohibit others from using the word “李嘉诚”.

2. Respondent’ s & Beneficiary’ s rights/interests

The Respondent’ s nominee status has been there before and since the domain name’ s registration and is not one alleged/modified after its receiving the Complainant. 李嘉诚公司 instructed its nominee, the Respondent, to register the domain name on behalf of, and hold the domain name as nominee in trust for 李嘉诚公司. 李嘉诚公司 and/or the Respondent, therefore has/have absolute and/or priority right/interests in the domain name as the major part of the domain name “李嘉诚” is also the key component of 李嘉诚公司’ s own name. If the Complainants claim to have rights and interests on the domain name on the ground that their names are similar/identical to the domain name, it follows that the 李嘉诚公司 and/or the Respondent definitely should have the same rights and interests on the domain name by the same token. Indeed 李嘉诚公司 and/or the Respondent should even have the absolute, priority and established rights and interests to the domain name it has already registered. This is sufficient and solid proof that 李嘉诚公司 and/or the Respondent have rights to and legitimate interests in the domain name.

The act of 李嘉诚公司 and/or the Respondent registering the domain name is also a logical, reasonable and legitimate one. 李嘉诚公司 is engaged in a wide scope of business, including the provision of advertising and information searching services. So 李嘉诚公司 and/or the Respondent registered the name for the bona fide offering of goods or services is within its business scope, and this is another conclusive evidence that 李嘉诚公司 and/or the Respondent has the rights/interests in the domain name.

3. ungrounded accusation of bad faith by Complainant

There are 4 circumstances that may show bad faith in one’ s registration and use of a domain name in bad faith. However, the Complainants fail to put up another evidence showing 李嘉诚公司 and/or the Respondent has/have met exactly 1 or more of the 4

cited circumstances. The closest accusation in the Complaint is not exactly what the circumstance under the Policy is describing. The subject matter of the circumstances includes (1) an intentional attempt to attract internet traffic; and (2) the creation of confusion a complainant's mark.

Regarding the first one, there has never been any intention or attempt to attract traffic by virtue of the domain name itself. Actually the natural type-in and linked traffic was expected to be minimal by 李嘉诚公司 and/or the Respondent even before he domain name was registered, indeed the actual traffic has been proven to be minimal. 李嘉诚公司 and/or the Respondent also has/have not used nor intended to use any means to boost and/or drive traffic to the domain name and/or its website.

Regarding the second, this cannot be established as the 2 Complainants do not own “李嘉诚” as a mark, the substance for the dispute, there will be no issue of mark confusion. Additionally, confusion cannot happen without mass traffic to the domain name and/or its website.

Failing to put up a relatively stronger case under the policy, the followings are other even-weaker accusations by the Complainants: (i) the Respondent has never had any rights or legitimate interests in the mark and registered the domain name in order to confuse the public that its act is authorized by the Complainant; and (ii) the Respondent acted in bad faith when it made the application for registration of the domain name in 2008.

李嘉诚公司 and/or the Respondent does/do have rights or legitimate interests in the domain name and do not need authorization from the Complainant in registering the domain name. The Complainants themselves do not own any mark and no issues of confusion and authorization can be established. 李嘉诚公司 and/or the Respondent declare they registered and use the name for own business in good faith and have done nothing in bad faith on the domain name.

The Respondent requested the Panel to deny the Complaint.

Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: “A Panel shall decide a complaint on the basis of the statements 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 should prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- 1) 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
- 2) the Respondent has no rights or legitimate interests in respect of the domain name; and
- 3) the domain name has been registered and is being used in bad faith.

Identical / Confusingly Similar

The evidence submitted by the Complainants shows that the 2nd Complainant owns the service mark “李嘉诚基金会” in China. “李嘉诚” is the distinctive part of this service mark. The panel thus finds that the Complainants hold legitimate trademark rights in “李嘉诚基金会” and its major part “李嘉诚”.

It is true that a personal name is not equivalent to a mark. However, while the Policy does not specifically protect personal names, in situations where an unregistered personal name is being used for trade or commerce, the Complainant can establish common law trademark rights in the name. “李嘉诚”, as a personal name of the 1st Complainant, has been extensively used in many charitable and/or commercial activities by the Complainants. The Panel decides that registration of the personal name “李嘉诚” as a registered trademark or service mark is not necessary and that the name “李嘉诚” has sufficient secondary association with the Complainants that common law trademark rights do exist.

As the suffix “.com” only indicates that the domain name is registered under this gTLD and is not distinctive, the Panel has no problem in finding that the disputed domain name <李嘉诚.com> is identical with the Complainant's trademark “李嘉诚” and is confusingly similar to “李嘉诚基金会”.

The Panel therefore holds that the Complaint fulfills the condition provided in Paragraph 4 (a)(i) of the Policy

Rights and Legitimate Interests

The Complainants contend that the Respondent does not have rights to or legitimate interests in the Disputed Domain Name. The Complainants' assertion is sufficient to establish a prima facie case under Policy 4 (a)(ii), thereby shifting the burden to the Respondent to present evidence of its rights or legitimate interests.

The Respondent submitted that 李嘉诚公司 is the real and beneficial owner of the disputed domain name. However, the Respondent failed to provide any evidence to substantiate the above submission. While submitting that the actual traffic of the

disputed domain name website has been proven to be minimal (below 5 monthly), the Respondent failed to show that the Respondent has been commonly known by the domain name. The Respondent has also failed to submit any evidence to prove that the Respondent has any rights or legitimate interests in respect of the Disputed Domain Name in other possible circumstances, i.e. use of the domain name in connection with a bona fide offering of goods or services and/or a legitimate noncommercial or fair use of the domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. The act of registering the Disputed Domain Name and the Respondent's like/dislike do not automatically endow any legal rights or interests with the Respondent.

The Panel therefore finds that the Complaint fulfills the condition provided in Paragraph 4(a)(ii) of the Policy.

Bad Faith

Under Paragraph 4 (b) of the Policy, the following are relevant examples a Panel may take as evidence of registration and use 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 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.

It is to be noted that the above provision is a non-exhaustive list exemplifying the element of bad faith. Evidence has sufficiently shown that the 1st Complainant has been very well recognized in Hong Kong and other parts of the world and that the 2nd Complainant's service mark has achieved a strong reputation through extensive use. As such, the public has come to recognize and associate the Complainants' mark and personal name as originating from the Complainants and no other. This entitles the Panel to infer that the Respondent should be aware of the existence of the Complainants. The action of registering the disputed domain name per se has constituted bad faith.

The Respondent has made no active use of the disputed domain name so far. As the evidence shows, the domain name is simply linked to a website providing information search services. The Respondent's argument as to the business in providing advertising and information searching services is not convincing. The Respondent failed to submit any evidence showing the work having done so far for the use of the disputed domain name. Prior Panels have already discussed the passive holding of a domain name and found that this can constitute bad faith use (WIPO Case No. D2000-0003).

In conclusion, the Panel finds that the Respondent has registered and used the domain name in bad faith. Accordingly, the Panel finds that the Complaint satisfies the condition provided in Paragraph 4 (a) (iii) of the Policy.

Status

www.李嘉誠.com

Domain Name Transfer

Decision

Having established all three elements required under the ICANN Policy, the Panel concludes that relief should be granted. Accordingly, it is ordered that the <李嘉誠.com> domain name should be TRANSFERRED from the Respondent to the 2nd Complainant.

ZHAO Yun
Sole Panelist

DATED:22 December 2008