



## ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

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### Decision Submission

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Version  
 Decision ID DE-0800179  
 Case ID HK-0800182  
 Disputed Domain Name www.cheungkong.net  
 Case Administrator Dennis CAI  
 Submitted By Lyons Debrett G.  
 Participated Panelist

Date of Decision 11-12-2008

Language Version : English

#### The Parties Information

**Claimant** Cheung Kong (Holdings) Limited  
**Respondent** Paco Tse

#### Procedural History

The Complaint was filed with the Hong Kong office of the Asian Domain Name Dispute Resolution Centre (the "Centre") on July 31, 2008. On August 16, 2008, the Centre transmitted by email to GoDaddy a request for registrar verification in connection with the domain name at issue. On August 19, 2008 GoDaddy transmitted by email to the Centre its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Centre verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the 'Policy'), the Rules for Uniform Domain Name Dispute Resolution Policy (the 'Rules'), and the Centre's Supplemental Rules.

In accordance with the Rules, the Centre formally notified the Respondent of the Complaint, and the proceedings commenced on October 15, 2008. In accordance with the Rules, the due date for Response was September 25, 2008. The Respondent make informal email contact with the Centre on one occasion but did not ultimately submit a response. Accordingly, the Centre notified the Respondent's default on October 31, 2008.

On November 28, 2008 the Complainant filed with the Centre what it called a "Supplemental Complaint" which the Panel has read and taken into account in reaching its decision.

The Centre appointed Debrett G. Lyons as the sole panelist in this matter on November 26, 2008. The Panel finds that it was properly constituted and has acted impartially in reaching its conclusion.

#### Factual Background

##### For Claimant

1. The Complainant is part of the Cheung Kong Group of companies.
2. The Complainant was incorporated in Hong Kong in 1971 and since 1972 has done business under the names "Cheung Kong Holdings" and "Cheung Kong".
3. The Complainant registered the domain name <cheungkong.com> on December 13, 1995.
4. The Complainant has not licensed or otherwise permitted the Respondent to use the name "Cheung Kong" or to register or use any domain name incorporating the words "Cheung Kong".
5. There is no evidence of pre-Complaint contact between the parties.
6. The Complainant petitions the Panel to transfer the disputed domain name from the Respondent to the Complainant.

##### For Respondent

1. The Respondent registered the disputed domain name on October 4, 1998.
2. There is no active website corresponding to the disputed domain name.
3. The disputed domain name is offered for sale on a third party website.
4. There is no evidence of pre-Complaint contact between the parties.

## Parties' Contentions

### Claimant

The Complainant asserts trade mark rights in the words "Cheung Kong Holdings" and "Cheung Kong" and states that the disputed domain name is either identical, or confusingly similar to, those trade marks. The Complainant alleges that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant alleges that the Respondent registered and used the disputed domain name in bad faith.

The detail of the Complaint is included where necessary in Part 5 of this decision.

### Respondent

The Respondent did not reply to the Complainant's contentions.

## Findings

Notwithstanding the fact that the Respondent did not offer a response to the Complaint, the Rules instruct the Panel to "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."

According to paragraph 4(a) of the Policy, the Complainant must prove that:

- (i) the domain name 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 domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

The Panel is entitled to accept reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory (see *Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (Nat. Arb. Forum July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); see also *Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.")).

Having considered the Complainant's case and the available evidence, the Panel finds the following:

### Identical / Confusingly Similar

The Complainant states that it is the flagship company of the Cheung Kong Group with its principal business being in residential and commercial property in Hong Kong. The Complainant has registered several domain names which it uses in conjunction with that business including "cheungkong.com", "cheungkongholdings.com", "cheungkongholdings.net" and "cheungkongholdings.org". The evidence shows that not only has the Complainant itself received much media attention, but the Cheung Kong Group of which it is an important part is enormous, having 260,000 staff operating over 57 countries and a combined market capitalization in excess of HK\$817 billion.

Although there is no evidence put before the Panel of registered trade mark rights, the Panel has no hesitation in finding that the Complainant has common law rights in the trade marks acquired through use and reputation ( Policy ¶ 4(a)(i) does not require a trade mark registration with a national authority if it is shown that rights in the trade mark have accrued on a common law or unregistered basis because of widespread use and reputation. See *SeekAmerica Networks Inc. v. Masood*, D2000-0131 (WIPO Apr. 13, 2000) (finding that the Rules do not require that the complainant's trademark or service mark be registered by a government authority or agency for such rights to exist); see also *Great Plains Metromall, LLC v. Creach*, FA 97044 (Nat. Arb. Forum May 18, 2001) ("The Policy does not require that a trademark be registered by a governmental authority for such rights to exist.").

Moreover, applying the principles developed and now broadly accepted under the Policy, the Panel also finds the disputed domain name to be identical to the Complainant's trade mark "Cheung Kong". The disputed domain name wholly incorporates the Complainant's trade mark. The deletion of spaces between the three words and the addition of the gTLD, ".net" are both trivial and do nothing to defeat the Complainant's claim of identity of domain name and trade mark. The Panel follows the consensus view of panelists in earlier decisions under the Policy in holding that those differences do not prevent a finding of confusing similarity (see *Diesel v. LMN a/k/a L. M. Nordell*, FA 804924 (Nat. Arb. Forum Nov. 7, 2006) (finding <vindiesel.com> to be identical to complainant's mark because "simply eliminat[ing] the space between terms and add[ing] the generic top-level domain ("gTLD")

' .com' ... [is] insufficient to differentiate the disputed domain name from Complainant's VIN DIESEL mark under Policy ¶ 4(a)(i)"; see also Wal-Mart Stores, Inc. v Tauer, WIPO Case No. D2000-1076 affirming the same point; see also Rollerblade, Inc. v McCrady, WIPO Case No. D2000-0429 finding that the top level of the domain name such as ".net" or ".com" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar; see also Wal-Mart Stores, Inc. v MacLeod d/b/a For Sale, WIPO Case No. D2000-0662 holding confusing similarity when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other non-distinctive terms in the domain name).

The Panel finds that the Complainant has satisfied the first element of the Policy.

### **Rights and Legitimate Interests**

The Complainant has the burden to establish that the Respondent has no rights or legitimate interests in the domain name. Nevertheless, it is well settled that the Complainant need only make out a prima facie case, after which the onus shifts to the Respondent to demonstrate rights or legitimate interests (see Do The Hustle, LLC v. Tropic Web, WIPO Case No. D2000 0624; Hanna Barbera Prods., Inc. v. Entm't Commentaries, NAF Case No. 741828; AOL LLC v. Gerberg, NAF Case No. 780200). Paragraph 4(c) of the Policy states that any of the following circumstances which if found by the Panel to be proved based on its evaluation of the evidence, demonstrate rights or legitimate interests to a domain name for purposes of paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trade mark or service mark rights; or
- (iii) you are making 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 Complainant has established its trade mark rights. There is no evidence that the Respondent has similar rights, registered or not. The WHOIS data does not support any argument that the Respondent might be commonly known by the domain name. The Complainant has stated there to be no relationship between the parties. The Respondent is not using, nor has it made demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services. Indeed, as the Complainant notes, the offer to sell the domain name raises a reasonable inference that Respondent had no intention to use the domain name.

Based on those facts, the Panel finds a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. Since the Respondent made no reply, it has not discharged the onus which fell to it.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the domain name and so the second limb of the Policy is established.

### **Bad Faith**

Paragraph 4(b) of the Policy sets out the circumstances which shall be evidence of the registration and use of a domain name in bad faith. They are:

- (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 trade mark 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 trade mark 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.

What is noteworthy about paragraphs 4(b)(i)-(iv) is that they are cases of both registration and use in bad faith. Paragraph 4(b) is not exhaustive and other instances of bad faith might be in evidence but, in those instances, the Panel must be able to find both bad faith registration and bad faith use.

In this case, the Complainant does not cite any of paragraphs 4(b)(i)-(iv). Instead, it claims bad faith registration because of the overwhelming likelihood that the Respondent registered the disputed domain name in the knowledge of the Complainant's trade mark and its business. In the absence of evidence to the contrary, the Panel accepts that submission. In doing so the Panel makes the observation that there are cases under the Policy involving very well known marks where panelists have seemingly imputed a respondent with knowledge of the mark however the better understanding of those cases is that the panels have in fact applied a test of actual knowledge which, based on the balance of probability, so overwhelmingly favoured the complainant that it merely appears as if their decisions rest on constructive knowledge of the complainant's rights. The evidence in this case supports the finding that it is

more probable than not that the Respondent was aware of the Complainant's business.

Although there has been no use of the domain name, the Complainant argues that 'use in bad faith' because the Respondent is passively holding a domain name incorporating a well-known trade mark and because that domain name is offered for sale. The failure of the Respondent to reply incline this Panel to follow the many decisions that have found bad faith use through passive holding of a domain name in circumstances where no good faith use is conceivable.

The issue of so called 'passive holding' arises since the Respondent is not using the domain name. That issue is now well tested and in the leading case of *Telstra Corporation Limited v. Nuclear Marshmallows* WIPO Case No. D2000 0003, the panel decided that because of the repute of the complainant's trade mark, "it is not possible to conceive of any plausible actual or contemplated active use of the domain name 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 trademark law". On the evidence, the Panel adopts that same reasoning in this case and finds that the domain name was 'used' in bad faith.

Accordingly, the Panel finds that the third and final limb of the Policy is satisfied.

### Status

www.cheungkong.net                      Domain Name Transfer

### Decision

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name "cheungkong.net" be transferred to the Complainant.

Debrett G. Lyons  
Sole Panelist

Date: December 5, 2008