



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

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Decision Submission

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Version
Decision ID DE-0800177
Case ID HK-0800214
Disputed Domain Name www.szectattoo.com
Case Administrator Dennis CAI
Submitted By Yun Zhao
Participated Panelist

Date of Decision 04-12-2008

Language Version : English

The Parties Information

Claimant Chow Pui Sze
Respondent evangelo costadimas

Procedural History

On 15 October 2008, the Complainant 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 21 October 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 22 October 2008, the ADNDRC transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same date, the Registrar transmitted by email to the ADNDRC its verification response. On 22 October 2008, the ADNDRC requested the Complainant by email to revise the Complaint form for correcting certain deficiencies and resubmit on or before 28 October 2008. On 23 October 2008, the Complainant resubmitted the revised Complaint and the ADNDRC confirmed the receipt of the Complaint on the same date.

On 31 October 2008, the ADNDRC transmitted the Complaint to the Respondent and notified the Respondent of the commencement of the action. The Respondent filed a Response with the ADNDRC on 23 November 2008. The ADNDRC confirmed the receipt of the Response and transmitted the Response to the Complainant on 24 November 2008. The Complainant submitted Supplemental Submissions on 24 November 2008 and 27 November 2008 respectively. The Respondent submitted Supplemental Responses on 25 November 2008 and 26 November 2008.

Since the Respondent also elected to have the Complaint to be decided by one panelist, the ADNDRC informed the Complainant 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 28 November 2008, the Panel received the file from the ADNDRC and should render the Decision within 14 days, i.e., on or before 15 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 Complainant in this case is Chow Pui Sze, the registered address is as follows: 1/F, 170 Wellington Street, Kau U Fong, Central, Hong Kong.

For Respondent

The Respondent, evangelo costadimas, is the current registrant of the disputed domain name <szectattoo.com> according to the Whois information.

Parties' Contentions

Claimant

In mid-2006, the Complainant and the Respondent commenced a romantic relationship. In around January 2007, the Complainant instructed the Respondent, acting as the agent of the Complainant, to register for the domain www.szectattoo.com to promote the business of the Complainant. The Complainant has reimbursed the Respondent for the registration charge. Unfortunately, owing to the nature of their relationship, no documentary evidence is available. An email from the Respondent in April 2007 shows that the Respondent has also helped the Complainant to provide the content of the domain. Since the registration of the domain, the Complainant has adopted it in all marketing efforts, including incorporating the domain in the business card, emails, advertisements, and work samples for clients. In around

November 2007, the relationship between the Complainant and the Respondent has terminated on bad terms. The Complainant registered for the domain www.szectattoo.hk as it was not apparent whether the Respondent will release the disputed domain back to the Complainant. The Complainant had to arrange for new business cards to be printed and to change all existing reference to the disputed domain.

Notwithstanding that the Complainant had to go through these burdensome arrangements and incur additional fees, the existence of both domains is certainly confusing for existing and potential clients. Throughout the time, the Respondent has admitted that he is still in control of the disputed domain. Since around May 2008, the Complainant found out that various contents have been put on the disputed domain, including links to other tattoo studios and different photos of the Complainant accompanied by suggestive wordings, updated from time to time. These contents cause confusion to the existing and potential customers of the Complainant and adversely affect the business of the Complainant. The Complainant is almost certain that the Respondent has provided the personal blog of the Respondent. In addition, the Complainant also found out that the domain www.szectattoo.com.hk has been registered in January 2008 and is automatically redirected to the disputed domain. The Complainant believes that the domain is controlled by or acting on the instructions of the Respondent.

Save and except to the extent that the Respondent helped register and set up the domain and has taken some photographs of the work of the Complainant, the Respondent has never at any time participated in or assisted with the tattoo business. The Complainant has always operated as a sole proprietor, one-person business, without any partners or assistants. The Complainant does not comment on the issue of copyright as this is not the appropriate forum.

(1) The Domain Name is identical or confusingly similar to a trademark or service mark in Hong Kong in which the Complainant has rights. The Complainant has been carrying on a trade with the trade name Sze. C Tattoo. The domain is identical or similar to the service mark in Hong Kong in which the Complainant has carried business and accordingly has the rights to.

(2) The Respondent has no rights or legitimate interests in respect of the domain name. The Complainant has always operated as a one-person proprietorship. The Respondent has never used or prepared to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services in Hong Kong. The Respondent has never commonly known by the domain name. The Respondent was not making any legitimate non-commercial or fair use of the domain name, his act was calculated to misleadingly divert consumers or to tarnish the mark of the Complainant.

(3) The domain name has been registered and is being used in bad faith. At the time of registration, the Respondent acted as an agent of the Complainant with proper authority. This authority has been revoked by the Complainant and therefore the Respondent should transfer the domain name back to the Complainant. As evidenced by the correspondence between the Respondent and the Complainant, the Respondent has since May 2008 been acting in bad faith and using the domain name to cause damage to the Complainant and her business. The Respondent does not have the authority to hold the domain name. Although the Respondent has not offered to sell or rent the domain name to the Complainant, the Respondent has asked to transfer the domain name in exchange of which the Complainant has to meet the Respondent in person for 10 minutes. The Respondent has been using the domain name so that the Complainant is not able to reflect her trademark in the domain name. It is submitted that the Respondent has also registered and/or procured for the registration of the domain www.szectattoo.com.hk thereby constituting the engagement in a pattern of such conduct. As could be seen from the evidence, the Respondent is using the domain name to disrupt the business of the Complainant, although the Complainant is not a competitor of the Respondent. Although the Respondent derives no commercial gain from using the domain name, it is apparent that the Respondent is using the domain name to create a likelihood of confusion with the Complainant's mark, by linking the domain to other tattoo studios and also creating contents which do not manifestly relate to the services of the Complainant.

The Complainant has further comments on the content displayed at the disputed domain. There is a "disclaimer" on the front page stating that the content of the domain is fictional and not intended to defame. Notwithstanding the disclaimer, visitors to the domain may be misled into thinking that the Complainant provided such "fictional content" to the domain. There is a "tattoo counter" which purportedly records the numbers of tattoos that the Complainant has given to clients during certain periods. Visitors to the domain will be misled into thinking that the content was provided by a tattoo artist, in particular the Complainant. An article "fly fly little wing" is posted on the domain which contains a pencil sketch and a photograph of a tattoo, both of which are original work created by the Complainant. There are links which redirect to the email address, which is unrelated to the Complainant. The domain name itself being identical to the business name of the Complainant, and the foregoing analysis shows that the content of the domain was calculated to mislead visitors to the domain to think that the domain was operated by 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 Complainant.

Respondent

The Complainant's attorneys have deemed it wise to drag the personal and private details of the relationship into the dispute. They have conveniently disclosed only what would be damaging and left out any details or evidence that would shine a bad light on the Complainant. The Respondent intends to prove that the Complainant does not have the rights to dispute the domain name because the Respondent is making a legitimate noncommercial 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 disputed domain is not being used in bad faith, as it has nothing to do at all with a tattoo business. It is a site in the form of a blog that the Respondent, as a practicing artist, uses to express artistically and is a form of art therapy healing with regard to the angst and grief resulting from the end of the romantic relationship. It neither advertises tattoo services nor does it provide commentary on tattoo shops. The blog entries form part of a narrative that develops into a story in which some of the figures belong to the tattoo community. It is neither defamatory nor attempting to confuse the Complainant's clients, as it clearly states in every page that it is a work of fiction. There are no price lists, no sample designs, no studio rules, no aftercare instructions. It is so utterly different from a commercial tattoo website and so dissimilar in both structure and content from the Complainant's site that it cannot possibly confound any of her existing clients nor perspective clients.

(1) Legal right to the domain name-intended partnership: it was the idea and initiative of the Respondent to register the domain. The Respondent did so as a partner of the Complainant and not under her request or as her agent. In January 2007, the Complainant noticed a drop in business. The Respondent became concerned and investigated. Both parties discussed ways of countering and decided on setting up a tattoo+photography partnership. The Respondent conceived of the .com domain name and proceeded to register and paid for as her partner. The Respondent hosted the website for a year without compensation. The Respondent redesigned the layouts, formats and style of the website to give it a more professional appearance. The Respondent helped in the Complainant's studio with dozens of chores. The Respondent provided personal credit card and ordered supplies from online supplies. The Respondent took these risks because he considered himself as partner and would have never done so if he was merely an agent.

(2) Regarding confusion over the domain name: when running a Google or Yahoo search, the name of the website and title is displayed, clearly indicating the difference. Furthermore, the Respondent has setup a Disambiguation Page, which clearly shows both websites with explanation to guide users in their selection.

(3) Copyright infringement: the Respondent photographed Miss Sherry. The Complainant liked the photo and placed in her front page. The Respondent informed her she no longer has permission to use the image, however, the Complainant continues to disregard.

(4) Legitimate noncommercial use of the domain name: it was the Respondent's idea to register the domain name in January 2007. The Complainant registered this domain name as her trademark after 20 months. The Respondent has offered for sale to the Complainant but has been ignored. For fairness, the Respondent setup a transparent way of checking the website statistics. Although most of the search engine referrals come from the key words 'Sze+Tattoo', it is evident that the majority of the visitors continue to access the website via saved bookmark or through email link sharing. The number of repeat visitors indicates that this website enjoys substantial popularity. Of the 9 blog entries, only two make a passing reference to tattoos. There is also an enigmatic tattoo counter. The rest of the blog entries have no mention of tattooing whatsoever. The blog entries contain clues to a narrative that only the Complainant, her new suitor and some very close friends would be able to decode. The disputed domain name website does in no way disrupt, defame the Complainant and her business. If anything, it widens her popularity which can draw more clients.

(5) Running business illegally: the Complainant has been illegally operating a tattoo business since around 2003. The Complainant began to occupy the premises of her current studio around August 2005 and is still operating in this location. The Complainant did not have the legal right to own and operate a business prior September 2008. The Complainant is in breach of Hong Kong law, for having operated a business without ever declaring revenue and therefore has paid no income taxes.

(6) False statements made by the Complainant: the Respondent has offered to sell the domain name to the Complainant. The Complainant would have it appear that the Respondent was harassing her.

(7) Personal and private details of the relationship with the Complainant: the Complainant started a new romantic relationship in the summer of 2007. The disputed website was visited by many and the Respondent learnt about the Complainant's past, stories of infidelity and back stabbing. The Complainant does not need to run a tattoo business.

The Respondent requests the Panel to make a decision solely on the facts with regard to the operation of the disputed domain as it pertains to the Complainant's business.

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 initial consideration of the Panel is whether the Complainant had sufficiently alleged the existence of common law trademark rights in her Complaint. The evidence submitted by the Complainant shows that the Complainant has been operating a tattoo business under the name of Sze. C Tattoo since around 2003. Although registering the business in September 2008, the Complainant has been continuously using the name of Sze. C Tattoo to promote her business since 2003. The registration of her name as a registered trademark or service mark is not necessary for the trademark and/or business name protection. It is sufficient that the Complainant should satisfy the Panel that she has rights in common law trademark or sufficient rights to ground an action for passing off. The Panel therefore decides that the Complainant holds legitimate trademark rights in "Sze. C".

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 <szectattoo.com> is confusingly similar to the Complainant's trademark "Sze. C".

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 submits that has the legal right to use the domain name on the grounds that it was his idea and initiative to register the domain. However, the act of registering a domain name per se does not automatically give rights or legitimate interests to the Registrant. The partnership claimed by the Respondent was not substantiated by any evidence. No evidence has been able to show that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services, or that the Respondent has been commonly known by the domain name.

The Respondent contends that he is making a legitimate noncommercial use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. This argument does not stand. The mere redirection of the domain name to other websites, even if the services offered under these websites were noncommercial and fair, would not establish a noncommercial or fair use of the domain name. Otherwise, it would be extremely easy for every registrant of a domain name to establish a legitimate interest under the Policy by simply redirecting his domain name to a website providing noncommercial or fair content. The Respondent's use of the domain name does not establish rights under the Policy, accordingly.

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.

Evidence has sufficiently shown that the Respondent is well aware of the existence of the Complainant and her trademark for the business. The action of registering the disputed domain name per se has constituted bad faith. The registration of the disputed domain name has effectively prevented the Complainant, the owner of the trademark, from reflecting the mark in a corresponding domain name.

The evidence shows that the Respondent has contacted the Complainant for the sale of the disputed domain name at the price of HKD 10000. This is the typical evidence of registration and use in bad faith by the Respondent, as envisaged by the Policy: the Respondent has registered or acquired the domain name for the purpose of selling the domain name registration to the Complainant who is the owner of the trademark or service mark, for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name.

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.szectattoo.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 <szectattoo.com> domain name should be TRANSFERRED from the Respondent to the Complainant.

ZHAO Yun
Sole Panelist

DATED: 1 December 2008