



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

— ADNDRC is a charitable institution limited by guarantee registered in Hong Kong

Decision Submission

[English](#)
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Version
 Decision ID DE-0900239
 Case ID HK-0800235
 Disputed Domain Name www.李嘉诚.com
 Case Administrator Ricky Wong
 Submitted By Timothy Sze
 Participated Panelist

Date of Decision 21-09-2009

Language Version : English

The Parties Information

Claimant (1) Li Ka Shing (李嘉诚) ; (2) Li Ka Shing Foundation Limited. (李嘉诚基金会)

Respondent Lee . Jia . Cheng (Co-Run) Ltd. (李.嘉.诚 (合营) 有限公司)

Procedural History

The Complainants of this case are: (1) Li Ka Shing (李嘉诚) ; and (2) Li Ka Shing Foundation Limited (李嘉诚基金会) ; its address is at 7th Floor, Cheung Kong Center, 2 Queen's Road Central, Hong Kong. The authorized representatives of the Complainants in the proceedings is Wilkinson & Grist; their address is at 6th Floor, Prince's Building, 10 Chater Road, Central, Hong Kong, email: iprop@wilgrist.com. The 1st Complainant is the founder and chairperson of the 2nd Complainant. The Complainant's representative proposes to refer the 1st Complainant and the 2nd Complainant collectively as one.

The Respondent is Lee . Jia . Cheng (Co-Run) Limited (李.嘉.诚 (合营) 有限公司) , its address is in Guangzhou, contact email is: LeeJiaChengJV@gmail.com.

The disputed domain name is <李嘉诚.com>. The registrar/agency of the disputed domain name is eNom, Inc., 15801 NE 24th Street, Bellevue, WA 98009, USA, email: legal@enom.com.

On 25 November, 2008, the Complainants submitted a Complaint in English 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 5 December, 2008, ADNDRC acknowledge the receipt of complaint and transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On 22 January, 2009, the Registrar transmitted by email to the ADNDRC its verification response, confirming that the Respondent is listed as the registrant and providing the contact information. On 22 January, 2009, the ADNDRC transmitted the Complaint to the Respondent and notified the Respondent of the commencement of the action and requested the Respondent to submit a Response

within 20 calendar days.

On 9 February 2009, two days before the due day of filing the response, the Respondent requested for an extension based on long Chinese New Year holiday, having obtained the comments from the Complainant, the ADNDRC extended the deadline of filing the response to 29 February 2009.

The Respondent filed the response to the ADNDRC on 28 February 2009 and 10 March 2009, respectively. On 14 April 2009, the Complainant submitted to the ADNDRC a reply to Respondent's response. On 17 April 2009 and 28 May 2009, the Respondent require the ADNDRC to grant further extension for filing the response to the Complainant's reply to 31 August 2009. On 11 June 2009, the ADNDRC notified the parties that the ADNDRC is confirming the availabilities of the Panel and will appoint a panel to deal with the case.

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. Timothy Size ("Panel"), acting as the sole panelist. The Panel determines that the appointment was made in accordance with Rules 6 and Article 8 and 9 of the Supplemental Rules.

On 3 August 2009, the Panel received the file from the ADNDRC and should render the Decision within 14 days. The Panel did not request for Supplemental Filing and/or did not find the need for any, neither from the Complainant nor the Respondent, however, in the interests of natural justice it has read them. On 18 August, the ADNDRC informed the parties that the Respondent may file supplemental filing on or before 7 September 2009, decision of the Panel shall be rendered on or before 21 September 2009. The Respondent transmitted a number of informal or unsolicited communications to the ADNDRC, the Panel, a number of individuals and organizations from 5th August to 18th September, 2009.

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, the emails transmitted by the Respondent is in English, thus the Panel determines English as the language of the proceedings.

Factual Background

For Claimant

(a) 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 part of the Cheung Kong Group which has business operations in 57 countries around the world and employs about 260,000 staff. The Group includes 8 listed companies with a combined market capitalization of approximately HK\$687 billion in Hong Kong.

On 6 August 1980, the 1st Complainant set up the 2nd Complainant, choosing a name incorporating the personal name of the 1st Complainant, with a mission to enhance the impact of his philanthropy through two objectives: to nurture a culture of giving and to foster creativity, constructive engagement, and sustainability through supporting capacity empowerment focused projects. To date, the 2nd Complainant and other private charitable Foundations established by the 1st Complainant have supported numerous charitable activities with grants, sponsorships and commitments of more than HK\$10 billion. The 1st and 2nd Complainants are hereinafter collectively referred to as "the Complainant" .

(b) Since 1980, the Complainant has been using “李嘉誠基金會” (Li Ka Shing Foundation) as a service mark/trade name for those activities mentioned in paragraph (a) above. The Complainant is the registered proprietor of the following service marks in Hong Kong and the Mainland China:-

Hong Kong

Service Mark: 李嘉誠基金會/ Registration No.: 300150533/ Date of Registration: 4 April 2003 / Class: 36;

Service Mark: 李嘉誠基金會/ Registration No.: 300150542/ Date of Registration: 4 April 2003 / Class: 41;

Service Mark: 李嘉誠基金會/ Registration No.: 300168039/ Date of Registration: 4 April 2003 / Class: 42, 43, 44;

Service Mark: 李嘉誠基金會/ Registration No.: 301064015/ Date of Registration: 4 March 2008 / Class: 16, 24, 25, 36, 41, 42, 43, 44;

China

Service Mark: 李嘉誠基金會/ Registration No.: 1547916/ Date of Registration: 28 March 2001 / Class: 36;

Service Mark: 李嘉誠基金會/ Registration No.: 1511808/ Date of Registration: 21 January 2001 / Class: 41;

Service Mark: 李嘉誠基金會/ Registration No.: 1583975/ Date of Registration: 7 June 2001 / Class: 42;

(c) The Complainant claims rights in the service mark/name “李嘉誠基金會” (Li Ka Shing Foundation) and the personal name “李嘉誠” (Li Ka Shing). As a result of the extensive and long period of use of the service mark/name “李嘉誠基金會” and the personal name “李嘉誠” by the Complainant, such service marks/names have been well-recognised by the public to be distinctive of and identified with the Complainant but none other. Substantial goodwill and reputation has subsisted in the service mark/trade name “李嘉誠基金會” as well as the personal name “李嘉誠”. One can also find countless publications and reports on the internet about the Complainant by reference to the service mark/trade name “李嘉誠基金會” and the personal name “李嘉誠”. As such, the Complainant undoubtedly has rights in the service mark/trade name “李嘉誠基金會” and the personal name “李嘉誠”.

(d) 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 “李嘉誠基金會.cc” and “李嘉誠基金會.net” for and on behalf of the Complainant.

For Respondent

Lee . Jia . Cheng (Co-Run) Ltd. (李.嘉.誠 (合營) 有限公司), is the current registrant of the Disputed Domain Name <李嘉誠.com> according to the Whois information. The registered address of the the Respondent is in Guangzhou, contact email is: LeeJiaChengJV@gmail.com.

Parties' Contentions**Claimant**

I. The Disputed Domain Name is identical or confusingly similar to a trade mark or service mark to which the Complainant has rights

(a) 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 alone, the Group includes 8 listed companies with a combined market capitalization of approximately HK\$687 billion. Based in Hong Kong, the Cheung Kong Group's businesses encompass such diverse areas as property development and investment, real estate agency and estate management, hotels, telecommunications and e-commerce, finance and investments, retail, ports and related services, energy,

infrastructure projects and materials, media, and biotechnology. The 1st Complainant is a strong believer in synergy - the power of combined efforts. This belief is reflected in his naming his company “Cheung Kong Holdings” after the Yangtze River, a great river that flows through China and aggregates countless streams and tributaries. 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 20th Century.

(b) In recognition of the 1st Complainant’s philanthropic efforts and his contributions to society, Mr. Li has received Honorary Doctorates from the University of Cambridge, the University of Calgary in Canada, Peking University, and the University of Hong Kong, among others. Mr. Li, a Justice of the Peace, has also received the Grand Officer of the Order Vasco Nunez de Balboa from Panama, The Commander in the Leopold Order from Belgium, Knight (Commander of the Order) of the British Empire, the Grand Bauhinia Medal of Hong Kong, and the Commandeur de la Légion d’Honneur from the French Government.

(c) 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, Mr. Li would first have to build a successful career. As his business blossomed, the 1st Complainant began to make strategic contributions to education and medical care projects in Hong Kong and China. On 6 August 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 through two strategic objectives: to nurture a culture of giving and to foster creativity, constructive engagement, and sustainability through supporting capacity empowerment focused projects. To date, the 2nd Complainant and other private charitable Foundations established by the 1st Complainant have supported numerous charitable activities with grants, sponsorships and commitments of more than HK\$10 billion.

The 1st and 2nd Complainants are hereinafter collectively referred to as “the Complainant” .

(d) Major donation projects undertaken by the Complainant include but are not limited to the following:-

(i) Education

China

- established Shantou University
- established Cheung Kong Graduate School of Business
- launch education and medical development programmes in Western China
- implemented Cheung Kong Scholars Programme
- donated US\$10 million towards the establishment of a Future Internet Technology Research Centre at Tsinghua University
- from 1994 to 1999, made contributions to help build and repair 70 primary schools in the poor rural areas of Chaozhou

Hong Kong

- donation to the University of Hong Kong
- donated HK\$100 million to Polytechnic University to promote the further development of continuing education opportunities for working adults to upgrade their professional skills
- donation toward the purchase of a 3,100 metre venue as the Open University's learning centre on Hong Kong Island which is the largest personal donation ever received by the University

(ii) Medical

China

- donated HK\$2 million (more than a quarter million U.S. dollars) in 1984 to the China Disabled Persons' Federation (CDPF) and another HK\$105 million (US\$13.4 million) in 1991 to help provide rehabilitation services for the 163,000 disabled persons
- established the “Heart of Gold” Hospice Service Program
- supported the construction of the Zhongren Nursing Home
- donation made to the Chaozhou Central Hospital

Hong Kong

- helped finance five homes for the elderly in Hong Kong
- funded the Li Ka Shing Specialist Clinics at the Prince of Wales Hospital
- donated the Li Ka Shing Physiotherapy Building at the Duchess of Kent Children's Hospital

(iii) Culture

China

- made a number of donations and coordinated many projects for the preservation of historical monuments and cultural relics
- supporter of The National Ballet of China from 1994 to 2002

Hong Kong

- made a number of donations and coordinated many projects for the preservation of historical monuments and cultural relics
- donation to the Hong Kong Philharmonic Orchestra

(iv) Community Welfare

China and Hong Kong

- used a “Just in Time Fund” to offer timely and direct relief in natural catastrophes, special and emergency situations, and work-related injuries and deaths of civil servants, in the hope of encouraging further support from private and public
- supported Changing Young Lives Foundation’ s work with disadvantaged children in China and Hong Kong and Mainland China through long-term, sustainable projects

(e) Apart from China and Hong Kong, the Complainant has also undertaken charitable projects in other overseas countries including but not limited to U.S.A., Canada, Singapore, United Kingdom, Australia, the Netherlands, France, Malaysia, Sri Lanka, India, Indonesia, Thailand, Pakistan, Sweden, Spain, Panama and Bahamas.

(f) Since as early as 1980, the Complainant has been using “李嘉誠基金會” extensively as a service mark/trade name for those activities mentioned in paragraph (d) above. The Complainant is the registered proprietor of, inter alia, the following service marks in Hong Kong and China:-

Hong Kong

Service Mark: 李嘉誠基金會/ Registration No.: 300150533/ Date of Registration: 4 April 2003 / Class: 36;

Service Mark: 李嘉誠基金會/ Registration No.: 300150542/ Date of Registration: 4 April 2003 / Class: 41;

Service Mark: 李嘉誠基金會/ Registration No.: 300168039/ Date of Registration: 4 April 2003 / Class: 42, 43, 44;

Service Mark: 李嘉誠基金會/ Registration No.: 301064015/ Date of Registration: 4 March 2008 / Class: 16, 24, 25, 36, 41, 42, 43, 44;

China

Service Mark: 李嘉誠基金會/ Registration No.: 1547916/ Date of Registration: 28 March 2001 / Class: 36;

Service Mark: 李嘉誠基金會/ Registration No.: 1511808/ Date of Registration: 21 January 2001 / Class: 41;

Service Mark: 李嘉誠基金會/ Registration No.: 1583975/ Date of Registration: 7 June 2001 / Class: 42;

(g) The Complainant claims rights in the service mark/name “李嘉誠基金會” and the personal name “李嘉誠”. As a result of the extensive and long period of use of the service mark/name “李嘉誠基金會” and the personal name “李嘉誠” by the Complainant, such service marks/names have been well-recognized by the public to be distinctive of and identified with the Complainant but none other. Substantial goodwill and reputation has subsisted in the service mark/trade name “李嘉誠基金會” as well as the personal name “李嘉誠”. One can also find countless publications and reports on the internet about the Complainant by reference to the service mark/trade name “李嘉誠基金會” and the personal name “李嘉誠”. As such, the Complainant undoubtedly has rights in the service mark/trade name “李嘉誠基金會” and the personal name “李嘉誠”.

(h) 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 “李嘉誠基金會.cc” and “李嘉誠基金會.net” for and on behalf of the Complainant.

(i) The major part of the Disputed Domain Name is identical to the service mark/trade name of the 2nd Complainant and the personal name of the 1st Complainant.

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

(a) Although the name of the Respondent is indicated to be Lee . Jia . Cheng (Co-Run) Inc in the “Whois Lookup” searches, the Complainant had caused searches to be conducted with the Guangzhou Administrative Authority of Industry and Commerce. The searches failed to reveal any business or company registered under a name incorporating the words “李嘉誠”. Further searches were caused to be conducted respectively with Guangzhou Administrative Authority for Industry and Commerce and Shenzhen Administrative Authority for Industry and Commerce. Such searches again failed to reveal any entity or business operating under the name “李 . 嘉 . 誠 (合營) 有限公司” in Guangzhou and Shenzhen as at the date of the search. Attempts were made by the Complainant to find out more about the Respondent on the Internet by using the keywords “Lee . Jia . Cheng (Co-Run) Inc”, “LeeJiaChengJV” and “李 . 嘉 . 誠 (合營) 有限公司” for the searches. The Internet searches did not reveal any information about the Respondent at all. The Complainant has reasons to believe that Lee . Jia . Cheng (Co-Run) Inc does not in fact exist and is a pseudo name made up by the Respondent solely for the purpose of holding the Disputed Domain Name.

(b) The Complainant noted that the Disputed Domain Name has never been put into use by the Respondent. Before the date of filing the Complaint, the Respondent was not using or had it made demonstrable preparation to use the Disputed Domain Name in connection with a bona fide offering of goods or services.

(c) The Respondent is not in any way related to the Complainant, nor was the Respondent authorized by the Complainant to use the mark/name “李嘉誠”.

(d) On or before the registration date of the Disputed Domain Name, i.e. 26 May 2008:-

(i) The 1st Complainant has been using “李嘉誠” as his personal name for almost 80 years;

(ii) The 2nd Complainant was established with a name incorporating the service mark/name “李嘉诚基金会”；

(iii) The 2nd Complainant has already registered the service mark “李嘉诚基金会” in Hong Kong and China;

(iv) The 2nd Complainant has widely used “李嘉诚基金会” as its service mark/trade name and the 1st Complainant has widely used “李嘉诚” as his personal name;

(v) Substantial goodwill and reputation subsisted in the service mark/trade name “李嘉诚基金会” and the personal name “李嘉诚”；

(vi) The service mark/trade name “李嘉诚基金会” has been identified by the public as the service mark/trade name of the 2nd Complainant belonging to the 1st Complainant, and “李嘉诚” has been identified as the personal name of the 1st Complainant;

(vii) Cheung Kong (Holdings) Limited has registered the domain names “李嘉誠基金會.cc” and “李嘉誠基金會.net” for and on behalf of the Complainant.

Further as:-

(i) the Respondent does not exist at all under the names “Lee . Jia . Cheng (Co-Run) Inc” and/or “李 . 嘉 . 诚 (合营) 有限公司” and such names are only pseudo names made up by the Respondent to register the Disputed Domain Name;

(ii) the Respondent is not commonly known by the Disputed Domain Name; and

(iii) the Respondent does not use the Disputed Domain Name in connection with a bona fide offering of goods or services nor has the Respondent made any demonstrable preparations to do so;

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

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

(a) 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 Complainant’ s service mark/trade name “李嘉诚基金会” and the personal name “李嘉诚” . Undoubtedly, the Complainant has prior rights in the service mark/trade name “李嘉诚基金会” and the personal name “李嘉诚” . 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 Complainant’ s service mark/trade name “李嘉诚基金会” and the personal name “李嘉诚” , taking into account that the Respondent has never had any rights or legitimate interests in the said mark/name and that the Respondent does not exist under such a name at all. 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 and is related to the Complainant. It is clear that the Respondent had acted in bad faith when it made the application for registration of the Disputed Domain Name in May 2006.

(b) Further, the Complainant noted that the Disputed Domain Name has never been put into use by the Respondent. Such passive holding of the Disputed Domain Name further demonstrates that the Disputed Domain Name is and has been used by the Respondent in bad faith.

(c) This indicates that the registration and use of the Disputed Domain Name has no purpose other than to create confusion that such registration and use is endorsed by the Complainant and thereby attracting Internet users to visit the Respondent's website thinking that it is related to the Complainant and/or the act of the Respondent is endorsed by the Complainant.

Respondent

The Respondent has filed several submissions on 28th February, 2009; 10th March, 2009; 7th September, 2009 and 8th September, 2009.

The Respondent's contentions specifically to the statements and allegations contained in the complaint and include all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name as follows:

I. Paragraph 4(a)(i) of the Policy - Complainant's claimed right to trademark or service mark and identicalness / confusing similarity

The Respondent contends that the disputed domain name is not identical nor confusingly similar to a trademark or service mark in which the Complainant (1st Complainant and 2nd Complainant) claim to have rights for the purposes of Paragraph 4(a)(i) of the Policy.

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 as emphasized in Form C. This assertion is meaningless as it is a universal rule for everyone unless he/she does not has a personal name. A personal name, however, is not equivalent to a service mark / trade mark, the substance of a valid domain name complaint.

It is also strange to read that the 1st Complainant claims he has right to his personal name “李嘉誠”. The fact that 1st Complainant is using “李嘉誠” as his personal name is not unique nor exclusive. Appendix 1 is a search showing some 14,300 people are using “李嘉誠” as his/her personal name. Why should the 1st Complainant, being only 1 of the 14,300, has monopolized/exclusive/prior right in using the word “李嘉誠” especially “李嘉誠” is not a trade mark / service mark he has right.

Under Item 7 in Form C, a complainant is asked to specify the trade mark / service mark it has right and to provide copy of registration certificate. It is believed that the 2 complainants have wilful intention to avoid meeting the request and with wilful intention even to cause confusion. By putting the word “李嘉誠” as well under Item 7 in Form C but failing to provide copy of mark “李嘉誠” registration certificate, such presentation style by the Complainant might confuse and mislead the reader that “李嘉誠” is a registered trade mark / service mark the Complainant has right, which is definitely not the case.

The fact that the 2nd Complainant has a registered trade mark / service mark reading as “李嘉誠基金會” cannot prohibit anyone from using the word “李嘉誠”. Not to mention other possible uses of the word “李嘉誠”, by just looking at its use as a personal name, at least 14,300 people (per Appendix 1) are using daily and have been using it for long period of time, the word “李嘉誠”, and 1st Complainant is just 1 of the 14,300.

“李嘉誠” is simply not a trade mark / service mark, nor could the Complainant proves they have such mark registered. Both 1st Complainant and 2nd Complainant do not own any trade mark / service mark reading exactly as “李嘉誠” which is the substance of the dispute.

The Complainant therefore do not enjoy a monopoly over the words “李嘉誠”.

Although Complainant has led some evidence of its substantial business success and reputation primarily in Hong Kong, Complainant has nonetheless failed to introduce evidence sufficient to demonstrate that it has acquired common law trademark rights in “李嘉誠” alone.

As of particular importance, is the fact that nowhere in the Complaint does Complainant make reference to having registered trademarks of exactly “李嘉誠”, let alone ones which predate the registration of the domain name.

Pursuant to ZZounds Music, LLC. v. Zounds c/o Mark LaForge, NAF Claim Number: FA0610000817093:

“In order for Complainant to satisfy the requirements of Policy ¶ 4(a)(i), the Panel must find trademark rights that pre-date the registration of the disputed domain name.

Complainant in this case has not even referred to any registered trademarks of exactly “李嘉誠”. Respondent’s purchase and registration of the subject domain name therefore must be assumed to clearly pre-date any rights which Complainant may have acquired as a result of its trademark registrations. Accordingly, it is submitted that in the absence of any evidence of Complainant’s registered trademark rights which pre-date Respondent’s rights, the Complaint must be dismissed, as in Jensen Research Corporation v. Future Media Architects, Inc., CPR File No. 00 0310.

Although a complainant in a proceeding such as this might establish common law rights which pre-date the disputed domain name, Complainant in this case has failed to do so. The Complainant in this case has only led evidence as to the reputation and success of the Complainant and their and/or their close affiliates, but has not led any particular evidence that could demonstrate that the term “李嘉誠” alone is identified exclusively with the Complainant.

A one or two word difference between marks, or possibly nothing more than a variant of the term, may be sufficient to distinguish between a domain name and a trademark so as to avoid confusion. As noted in America Online, Inc. v. Megaweb.com, Inc., NAF Case File No. A0504000463099:

‘In “the Internet context, consumers are aware that domain names for different Web sites are quite often similar, because of the need for language economy, and that very small differences matter.” Entrepreneur Media, Inc. v. Smith, 279 F.3d 1135,1147 (9th Cir. 2002).

A primary difference between domain names and trademarks is that only one entity is able to use a single domain name; whereas many different entities are capable of using the same trademark, albeit for different goods or services. Given the scarcity of useful and recognizable domain names, the Panel may choose to consider whether a possible confusing similarity between a domain name and mark may be trumped by the competing need to allow for diversified registrants and uses of such domain names. ‘

Accordingly, there are such significant differences between Complainant’s trademark of “李嘉誠基金會” and the disputed domain name, that the domain name is not confusingly similar. Unless the disputed domain name is, for instance, “李嘉誠基金會.com”, it should not cause confusion according to the aforesaid cited principle.

Further, in the case of Sallie.com, the Complainant held the trademark for “SALLIE MAE”, but not for “SALLIE”, alone. Accordingly, the Panel found that the Complaint should be dismissed, because although there was similarity, there was no confusing similarity between the domain name and Complainant’s trademark (See Sallie Mae, Inc. v. Michele Dinoia, WIPO Case No. D2004-0648). It is therefore respectfully submitted that in this case, the Panel should find that the domain name, although arguably similar in some respects to the Complainant’s trademark of “李嘉誠基金會” (noting the absence of proof of common law rights), is not confusingly similar to “李嘉誠”.

Hence, the Complainants are not eligible to make a claim on “李嘉誠.com” under paragraph 4(a)(i) of the Policy. If the 1st Complainant can make a such a claim under paragraph 4(a)(i) of the Policy of having interest in the domain name 李嘉誠.com simply because he is called 李嘉誠 and be awarded with the domain name, there are other 14,299 eligible candidates as well, and why should the 1st Complainant, being 1 of the 14,300, be treated specially and awarded the interest and domain name among the 14,300 李嘉誠!?

Complainant do not own any right (even common law rights as not evident / submitted) and the “李嘉誠基金會” is not confusingly to “李嘉誠” or “李嘉誠.com” per cases cited above.

II. Paragraph 4(a)(ii) of the Policy - Respondent’ s rights / interests in the domain name

In order to succeed under Paragraph 4(a)(i)(ii) of the UDRP, Complainant must prove that the Respondent has no rights or legitimate interests in respect of the domain name. In *Borges, S.A., Tanio, S.A.U. v. James English*, (WIPO Case No. D2007-0477) it was confirmed that:

“Respondent need only show that he has “a” legitimate right or interest - which is what he has done. Respondent does not need to show that his rights or legitimate interests are better (however measured) than those of Complainant.” [Quotation emphasis in original]

李嘉誠公司 the Respondent was started by 3 partners, who formed a joint venture / partnership in limited company mode. It is common to see companies using names of their shareholders / directors as the corporate names and this is exactly the case for 李嘉誠公司.

李嘉誠公司 as defined earlier, stands for 李.嘉.誠(合營)有限公司 (copy of Certificate of Incorporation see Appendix 2). Instead of using a super long company name and keeping the partners’ full names confidential, the 3 partners chose their respective names’ key identifiers as the key component for the company’ s name, namely 李、嘉 and 誠, and again this is very popular practice in the commercial world for joint ventures using partners’ names key identifiers in their business names. “合營” or “Co-Run” is just secondary component in the company name for highlighting the joint venture /partnership nature of the company, and “有限公司” or “Ltd” is the compulsory affix in the company name registration (“Inc” in whois is just a careless typo of “Ltd”), the remaining “.”, “(“ and “)” are just punctuation.

李嘉誠公司 is thus not a pseudo name but has been repeatedly speculated and emphasized on the contrary by Complainant by providing their researches and searches, 李.嘉.誠(合營)有限公司 does exist! Obviously all speculations by the Complainant regarding the name, searches …should fail and be dismissed accordingly.

As domain name registration and for own use is common for corporation, 李嘉誠公司 managed to purchase and register the domain name 李嘉誠.com, which contains all registerable characters of the key component of its name, by late 2007.

李嘉誠.com consists of all registerable characters of all key name identifiers of 李嘉誠公司’ s partners, the major part of 李嘉誠.com - 李嘉誠 is also identical to the major component to the company’ s name, it follows that 李嘉誠公司 has legitimate rights / interests on the words “李嘉誠” .

Since the key component of the company’ s name is 李嘉誠, obviously the company is commonly known to be “李嘉誠” . “Commonly known” does not need to be very well-known. In *中行.com* (CN-0700176, complaint rejected), the Panel wrote,

“The Respondent’s possibly strongest argument for its right over the disputed domain name is that it is named “中行” and commonly known by that name.”

Let us also look at the decision and reasoning in the 李嘉誠.com decided case (case HK-0800180) a bit. In that decided case,

(i) the disputed domain name' s legal owner and registrant was Nomi Nee per whois record;

(ii) both Nomi Nee and 李嘉誠公司 claimed and confirmed their beneficiary-principal relationship, regarding the disputed domain name, so 李嘉誠公司 should be the real and beneficial owner of the disputed name; and

(iii) the Response was prepared and submitted by 李嘉誠公司 in the capacity as Nomi Nee' s principal & representative and was accepted by the Centre and the Panel.

However, the Panel in that decided case still wrote in the Findings that,

“The Respondent submitted that 李嘉誠公司 is the real and beneficial owner of the dispute domain name. However, the Respondent failed to provide any evidence to substantiate the above submission.”

Given (i) ~ (iii) above, it can be derived that,

a) the legal ownership of the disputed domain name has been proven, and;

b) the principal-beneficiary relationship regarding the disputed domain name has also been disclosed, confirmed & endorsed.

It follows that the only possible & logical reason for the Panel still writing the above comment to not accept 李嘉誠公司 as the real and beneficial owner of the dispute domain name was the failure by the Respondent in providing the real existence proof of 李嘉誠公司.

It follows that should the then Respondent, i.e. we, had filed the Certificate of Incorporation of 李嘉誠公司 in that decided case, as we have done now in Appendix 2, the Panel would definitely have accepted the submission that “李嘉誠公司 is the real and beneficial owner of the dispute domain name” based on the above logic and grounds.

As the then Panel put the aforesaid comment in his own “Findings - Rights and Legitimate Interests” session, which represents the basis, reasoning and grounds for decision, once he had accepted the submission that 李嘉誠公司 is the real and beneficial owner of the disputed domain name, there is no reason that he would not logically and sensibly concluding that 李嘉誠公司 had rights and legitimate interests in the disputed domain name 李嘉誠.com.

Another example. In 中行.com (CN-0700176), BANK OF CHINA LIMITED the Complainant even has long been holding a registered, identical, decades-long, predating and very well-known trademark of “中行” reading exactly to the disputed domain name, however, from the Panel' s decision (where the Complainant' s domain name claim against ZHONG HANG L. the Respondent was rejected), it is observed that a party' s name bearing the key components of the disputed name can be a conclusive evidence of having right over the disputed name, the case' s Panel wrote,

The Respondent's possibly strongest argument for its right over the disputed domain name is that it is named "中行" and commonly known by that name. The Panel finds that the Respondent's claimed name is shown in different Latin forms, including "Zhong Hang L." (see Whois search page), "Zhang Hong" (see the Response, 7.1) and "Zhong Hang". Despite the discrepancies on the Latin spelling of the Respondent's claimed name, the Panel pays high attention to the Respondent's claimed name in Chinese, allegedly "李中行". To prove such claim, the Respondent submitted the email communications with the third parties, online forum registration and most importantly, an ID card.

The Respondent' s name, as shown in Appendix 2, clearly reads as “李.嘉.誠(合营)有限公司” and contains the key component identical to the major part of the disputed domain name 李嘉誠.com, just like in 中行.com case, the

Respondent's name “李中行” bears the key component of 中行.com. Our name proof is accordingly one of the strongest arguments for 李嘉诚公司 having right over 李嘉诚.com.

The act of 李嘉诚公司 purchasing and registering the disputed domain name containing the key component of its 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 purchased 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 under Paragraph 4(c)(i) of the Policy.

III. Paragraph 4(a)(iii) of the Policy - No bad faith registration AND use

李嘉诚公司 has right in the name as proven earlier in this Response with cited decided cases and do not need to get any authorization / endorsement from the Complainant in registering and using the name.

Besides, the Respondent's registration and use of the domain name have not caused any confusion. The Complainant do not enjoy monopoly over the words “李嘉诚” as domain name is in scarcity, 李嘉诚公司 purchased and registered the domain name in good faith. The mark the Complainant have - “李嘉诚基金会” is not confusingly similar to “李嘉诚”, both have been substantiated earlier in this Response quoting previous decided cases.

Besides, 李嘉诚公司 has done nothing to attract internet traffic, indeed, Internationalized Domain Names (IDNs) are not expected to be fully operational yet until 2009 *, confusion (of whatever nature, not restricted to mark confusion and parties confusion) cannot happen without meaningful traffic to the domain name and/or its website. The actual traffic has been proven to be minimal (monthly average below 3) and cannot cause any confusion as speculated by the Complainant.

* See: "Could IDN's Be Here In 2009", Domain Name News, April 13, 2008:
<http://www.domainnews.com/en/general/could-idns-be-here-in-2009.html>.
 See also: http://en.wikipedia.org/wiki/Internationalized_domain_name

Also, the not-yet active use or passive holding of a domain name does not necessarily constitute to bad faith. As Internationalized Domain Names (IDNs) are not expected to be fully operational yet until 2009 and are not generating impressive traffic yet, the Respondent did not feel any urgency to attach the domain name to an operational web site. Certainly 李嘉诚公司 never believed for a moment that any party would complain regarding their registration or delayed usage of the domain name.

In 中行.com (CN-0700176), passive holding & no relevant uses of the disputed domain name were found by the Panel:

“According to the Respondent's statement, the domain name has been forwarded to its Whois page since acquisition (see the Appendix 6 to the Response). Any domain name has the retrievable registration information recorded in the Whois database. Showing the domain name's registration information recorded at the Registrar's website does not constitute any relevant use.”

The major part of the domain name 中行.com is even identical (not just confusingly similar) to the Complainant's well-known trademark “中行”, however, the Panel still concluded that there is no bad faith in the Respondent's registration and passive holding & no relevant uses of the domain name.

“The Complainant makes several contentions on the Respondent's bad faith. The Respondent makes rebuttals against each. Through assessing the submissions from both Parties carefully, the Panel finds the Complainant's contentions are unconvincing. It is not proven that the Respondent has made any use of the domain name, or ever attempts to sell or otherwise transfers the domain name registration, or registers several domain names so as to show a pattern of conduct.

“The Panel therefore determines that the Complainant fails to established the third and final element stipulated in paragraph 4(a)(iii) of the Policy which is necessary for a finding that the Respondent has engaged in abusive domain name registration.”

Even for domain names forwarded to pay-per-click, they are also not in bad faith, not to say domain names not in active use or in passive holding as in the current case. The unanimous 3-member panel in *McMullen Argus Publishing Inc. v. Moniker Privacy Services/Jay Bean, MDNH, Inc.*, (WIPO Case No. D2007-0676 – July 2007) ruled that:

“Complainant must do more than just show pay-per-click use to establish bad faith. Contrary to Complainant’ s assertions, pay-per-click websites are not in and of themselves unlawful or illegitimate, e.g., *Terana, S.A. v. RareNames, WebReg*, WIPO Case No. D2007-0489; *Fratelli Carli S.p.A. v. Linda Norcross*, WIPO Case No. D2006-0988. Complainant has provided little evidence (as opposed to allegations of counsel) that Respondent selected the disputed domain name for a free ride upon Complainant’ s mark. Complainant has made no showing that consumers and Internet users have been or are likely to be confused or to associate Respondent’ s services with Complainant’ s, and the Panel’ s examination of the parties’ respective websites bears out this observation. There is no obvious imitation of Complainant or its services. Complainant has made no showing of a “pattern” of cybersquatting that might bring the case under paragraph 4(b)(ii) of the Policy.”

To establish bad faith registration, Complainant must show that Respondent knew not only of Complainant but also that Respondent ‘must have registered the Domain Name “with Complainant’ s trademark in mind” ’ (*Jet Marques v. Vertical Axis*, WIPO Case No. D2006-0250, unanimous panel). The Respondent in the current case did not have any of the Complainant’ s trademarks in mind when purchasing and registering the disputed domain name.

There are also no registration and use in bad faith by the Respondent exactly under Paragraph 4(b) (i) ~ (v) of the Policy evident to and submitted by the Complainant. Hence, there is no bad faith exactly under Paragraph 4(b) (i) ~ (v) of the Policy. The Panel in *中行.com’ s* (CN-0700176) wrote in the decision,

“Although the Policy, Paragraph 4 (b), does not limit the circumstances that may prove the registration and use of a domain name in bad faith, the Panel believes that, unless in extraordinary scenarios and for the protection of well-known marks, no bad faith be found beyond the circumstances specifically listed in (i)-(iv) of the Paragraph 4 (b) of the Policy.”

The Respondent in no way whatsoever used the domain name to trade off of Complainant’ s purported trademark rights. Accordingly, there is absolutely no evidence that Respondent registered or used the domain name in bad faith.

Finally, Respondent never offered to sell the domain name to Complainant or in any way attempted to interfere with its business. It was only after years of continued and undisturbed registration of the domain name, did Complainant suddenly pop up, unprovoked, and wrongfully claimed that Respondent’ s property really belonged to it.

Complainant’ s intention and ulterior motives to be free-rider, speculator and opportunist is obvious when looking at their recent attempt to file complaints targeting on geographical and generic names as in *長江.com*, *长江.com* and *长江.net* (for *長江.net*, it does not exist as it is not registerable due to the current system is prohibiting languages variant registration when one version has been registered, i.e. the existence of *长江.net* makes *長江.net* non registerable in the current system). The current Complainant targeting on words (*李嘉城* and *李嘉誠*) that can be used as personal or corporation names is just another proof of the Complainant’ s bad faith motives. The bad faith intention and motives of the Complainant in the current Complaint seem to tell certain gossips about the Complainant extracted earlier in this

Response are convincing and existent.

Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of a disputed domain name, the Complainant must demonstrate each of the following:

(i) the Domain Name is identical or confusingly similar to a trademark 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.

Under paragraph 15(a) of the Rules,

“A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”

The kind of Decisions a Panel conducting a gTLD domain name dispute may render are limited. That is, a Panel might decide in one of two ways - (a) that the Complaint is not justified, in which case the existing registered gTLD domain name holder shall be entitled to retain the gTLD domain name in question; or (b) the Panel may decide that the Complaint is justified in which case the Panel will order that the domain name in dispute should be cancelled or transferred to the Party which brought the Complaint.

It should be noted that if a Panel, which conducts a gTLD domain name dispute administrative proceeding finds that a Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding, the Panel is required to state in its Decision that this was the case.

The Panel noted that the Respondent made a number of unsolicited communications or statements to the ADNDRC, the Panel, a number of individuals and organizations during the administrative proceeding. In accordance with the Rules, paragraph 10(d), the Panel exercises its discretion not to accept and consider these communications nor reproduce them here. Neither of these matters had any prejudicial effect upon the Panel and have no bearing on the case in hand.

The Panel will deal with each of the requirements in turn but, before doing so, it is necessary to consider a number of procedural aspects to this case, and in that context the question of the Provider, formation and constitution of the Panel, identification of the Respondent in this case. What follows is a somewhat lengthy discussion, but the conclusions reached enable the rest of the case to be decided relatively easily. It is then necessary briefly to comment the issues brought by the Respondent.

The role of the ADNDRC

The Asian Domain Name Dispute Resolution Centre (ADNDRC) has been appointed by the Internet Corporation for Assigned Names and Numbers (ICANN) as one of four (4) dispute resolution providers in the world and the only one in Asia for disputes involving gTLD domain names. As such, the ADNDRC, through one of its three offices (Beijing, Hong Kong or Seoul) administers the administrative proceedings brought under the Uniform Domain Name Dispute Resolution Policy (UDRP) in accordance with the Uniform Domain Name Dispute Resolution Policy Rules of Procedure and the ADNDRC's own Domain Name Dispute Supplemental Rules.

The steps in the administrative proceeding process

Generally speaking, the steps are as follows:-

1 The Complainant files a Complaint with the one of the three offices (either Hong Kong, Beijing or Seoul, at the choice of the Complainant), of the Asian Domain Name Dispute Resolution Centre (ADNDRC);

2 The relevant office of the ADNDRC notifies the registered holder of the gTLD domain name in question of the Complaint and sends a copy of the Complaint to the registered holder;

3 the registered holder of the gTLD domain name in question files a Response;

4 the relevant office of the ADNDRC selects the Panel of one or three persons, as the case may be, which will conduct the administrative proceeding in respect of the disputed gTLD domain name and which will make a determination in regard to the dispute;

5 the Panel conducting the administrative proceeding renders its Decision;

6 if the Decision of the Panel conducting the administrative proceeding requires that the gTLD domain name in question be cancelled or transferred, the Decision is implemented.

The formation of the Panel

The Panels which conduct gTLD domain name disputes are composed of one (1) or three (3) Panelists, as the case may be. The ADNDRC maintains a list of Panelists who the ADNDRC considers to be independent, reputable, knowledgeable, experienced, impartial and suited to undertake the task of deciding disputes in respect of gTLD domain names. The ADNDRC selects the Panelists to sit on a Uniform Domain Name Dispute Resolution Policy Panel on a case-by-case basis in light of the following criteria:- the nature of the dispute, the availability of the Panelist(s), the identity of the Parties, the independence and impartiality of the Panelist (s), any stipulations in the relevant Registration Agreement and any suggestions made by the Parties themselves in accordance with Paragraph 6 of the ADNDRC Uniform Dispute Resolution Policy Rules of Procedure and if, appropriate Paragraph 8 of the ADNDRC's Domain Name Dispute Supplemental Rules.

A Panel to conduct a gTLD domain name dispute is appointed after the date on which a Response is duly filed or, if the Response, is not filed in a timely manner, after the last date the Response was supposed to have been filed. Prior to an appointment, a proposed Panelist must declare in writing to the relevant Office of the ADNDRC any circumstances which could give rise to any justifiable doubt as to the Panelist's impartiality or independence or prevent a prompt resolution of the dispute in question. If, at any stage during an administrative proceeding, new circumstances arise that could give rise to justifiable doubt as to the impartiality or independence of a Panelist, the Panelist in question shall promptly disclose such circumstances to the relevant Office of the ADNDRC, in which event the relevant Office of the ADNDRC shall have the discretion to appoint a substitute Panelist. Unless the Parties otherwise agree, no person shall serve as a Panelist in a dispute in which that person has any interest which, if a Party knew of it, might lead the Party to think that the Panelist might not be impartial or independent.

Recourse of the Party against the Decision rendered by the Panel

Paragraph 4(k) of the Policy states that the administrative proceedings called for under the UDRP shall not prevent either a Complainant or a domain name holder (the Respondent) from submitting the dispute to a court of competent jurisdiction before the administrative proceeding is commenced or after the administrative proceeding is concluded. According to Paragraph 18 (b) of the Uniform Domain Name Dispute Resolution Rules of Procedure in the event that a Party initiates any legal proceeding during the pendency of an administrative proceeding in respect of the domain name which is the subject of the administrative proceeding, such Party shall promptly notify the Panel and the relevant Office of the ADNDRC. Paragraph 18 (a) of the Uniform Domain Name Dispute Resolution Rules of Procedure states that in the event that any legal proceeding is initiated prior to or during an administrative proceeding in respect of the domain name which is the subject of the administrative proceeding, the Panel appointed to deal with the administrative proceeding in question shall have the discretion to decide whether to suspend or terminate the administrative proceeding, or to continue to a Decision.

It should be noted that if a Panel decides that a domain name registration should be cancelled or transferred, the Registrar of the domain name in question will wait ten (10) business days (as observed in the location of the principal office of the

Registrar) after the Registrar is informed by the relevant Office of the ADNDRC of the Panel's Decision before implementing the Decision. The Registrar will implement the Decision, unless it receives from the domain name holder (the Respondent) during the ten (10) business day period, official documentation (such as a copy of a complaint, file-stamped by the clerk of the relevant court) that the domain name holder (the Respondent) has commenced a lawsuit against the Complainant in a jurisdiction to which the Complainant has submitted in accordance with Paragraph 3(b)(xiii) of the Uniform Domain Name Dispute Resolution Rules of Procedure. If the Registrar receives such documentation within the said ten (10) business day period, the Registrar will not implement the Panel's cancellation or transfer Decision, and the Registrar will take no further action, until the Registrar receives (i) evidence satisfactory to it of a resolution between the Parties; (ii) evidence satisfactory to the Registrar that the domain name holder's (the Respondent's) lawsuit has been dismissed or withdrawn; or (iii) a copy of an order from such court dismissing the domain name holder's (the Respondent's) lawsuit or ordering that the domain name holder (the Respondent) does not have the right to continue to use the domain name in question.

Registrar delay

The Panel notes in this case the ADNDRC notified the Registrar on the 5th, 30th December, and 21st January 2009, and the ADNDRC only got the response from the Registrar on the 22nd January 2009, this is the more than 30 days delay on the part of the Registrar to respond to the ADNDRC's request for registrar verification. No explanation or apology was offered by the Registrar to the Center in relation to that delay. The Panel is surprised to note that it took so long for the Registrar to respond to that request. Any such delay in responding to a verification request simply plays into the hands of cybersquatters, particularly if the cybersquatter is using the domain name(s) concerned for the purposes of pay per click advertising.

In order for the UDRP process as a whole to function efficiently under paragraph 4 of the Rules, timely registrar verification is essential and all the more so given the now apparently wide-spread offering by registrars and others of privacy and proxy registration services which may obscure the identity and contact information of any underlying "true" registrant. In the current case before the Panel, the address given for the registrants are not identical, but the Panel is of the view that nevertheless there is sufficient evidence before it to enable it to find that the Domain Names are in reality controlled by the same entity.

Laches

The Respondent's argues that the Complainant's failure to timely file or back date the filing date to the Centre, that otherwise object to the Respondent's use of the disputed Domain Names should prevent the Complainant from now contesting such use. This argument raises the issue of laches.

The registration agreement between the Respondent and the Registrar requires the registrant to consent to the jurisdiction of Federal and state courts located in King County, Washington, the United States, where, the Panel notes that, the Respondent may rely on the doctrine of laches (undue delay in asserting a legal claim, resulting in prejudice to the respondent).

The Panel concludes that the equitable defense of laches does not apply in this Policy proceeding. The remedies under the Policy are injunctive rather than compensatory in nature, and the concern is to avoid ongoing or future confusion as to the source of communications, goods, or services. See *The Hebrew University of Jerusalem v. Alberta Hot Rods*, WIPO Case No. D2002-0616; *The E.W. Scripps Company v. Sinologic Industries*, WIPO Case No. D2003-0447 (the Policy does not contemplate a defense of laches, which is inimical to the Policy's purposes). See also *Tom Cruise v. Network Operations Center/ Alberta Hot Rods*, WIPO Case No. D2006-0560 (finding no meaningful precedent under the Policy for refusing to enforce trademark rights based on delay in bringing a complaint).

Identical / Confusingly Similar

The Panel initially addresses the question of whether the Complainant has established common law trademark or service mark rights in his personal name, "李嘉诚" (Li Ka Shing). As noted by the Panel in *Israel Harold Asper v. Communication X Inc.*, WIPO Case No. D2001-0540, in cases involving business persons, complainants have been found to have common law marks in their names in circumstances where the name has been used as a marketable commodity, for a fee to promote another's goods or services, or for direct commercial purposes in the marketing of the complainant's own goods or services.

Merely having a “famous” name is not sufficient to establish common law trademark or service mark rights in the name. The Policy itself inherently makes a distinction between the protection afforded trademark rights and rights arising under the law of publicity which has been discussed in further details in several UDRP cases. See *Israel Harold Asper v. Communication X Inc.*, WIPO Case No. D2001-0540, well known individuals have the right to control commercial exploitation of their names and likenesses. See *Bi-Rite Enterprises, Inc., Et Al. V. Bruce Miner Company, Inc., Et Al.*, 757 F.2d 440 (1st Cir. 1985). To be entitled to protection under the Policy, a personal name must function as a trademark, and for common law trademark rights to exist, the Complainant’s personal name must have come to be recognized by the public as a symbol which identifies particular goods or services with a single source.

The Respondent admits that the Complainant is famous.

Then the next question becomes whether the “李嘉诚” (Li Ka Shing) and/or “李嘉诚基金会” (Li Ka Shing Foundation) name is used by the Complainant in trade and commerce.

The Complaint is brought in the name of the Li Ka Shing and Li Ka Shing Foundation, a charity established by Mr. Li. The record reflects that Mr. Li has established trademark and service mark rights in his name through registration and use as a source indicator. At a minimum, the “李嘉诚基金会” (Li Ka Shing Foundation) mark is entitled to a presumption of validity by virtue of its registration with the Mainland China and Hong Kong Intellectual Property Department. See *EAuto, L.L.C. v. Triple S. Auto Parts d/b/a Kung Fu Yea Enterprises, Inc.*, WIPO Case No. D2000-0047. Mr. Li has authorized the use of the “李嘉诚基金会” (Li Ka Shing Foundation) mark with the charity that he founded in his name.

Accordingly, the Panel concludes that the Complainant has rights in the “李嘉诚基金会” (Li Ka Shing Foundation) mark for purposes of bringing this action under the Policy. The Panel finds that the Complainant has established trademark rights in the mark “李嘉诚基金会” (Li Ka Shing Foundation), by virtue of Hong Kong Trademark Registration Nos.: 300150533, 300150542, 300168039, 301064015 and China Trademark Registration Nos.: 1547916, 1511808, 1583975.

The Panel further notes that the Respondent has not directly challenged the Complainant’s rights in the mark, but has instead claimed not to have monopoly useage that the “李嘉诚” (Li Ka Shing) name was being used as a mark.

The Respondent argues that the trademark rights of the Complainant should not prohibit anyone from the using the word “李嘉诚” (Li Ka Shing) for which the “李嘉诚基金会” (Li Ka Shing Foundation) trademark was registered, and should not extend to a domain name use the word “李嘉诚” (Li Ka Shing) that linked to a non-competitive business. The Respondent also argues that the Complainant should prove the trademark rights of the substance of the disputed domain name, “李嘉诚” (Li Ka Shing). The Panel finds that this analysis may be relevant to traditional arguments for trademark infringement, the analysis is not relevant to the concept of confusing similarity under paragraph 4(a)(i) of the Policy.

The threshold question under the Policy is simply whether the trademarks in question and the disputed domain name are confusingly similar. It is obvious that the domain name is identical to the registered marks of the Complainant, except for the addition of the ending “基金会(foundation)” and “.com”. It is well established that the specific top level of the domain name such as “.com” does not affect the domain name for the purpose of determining whether it is identical or confusingly similar to a trademark (see *Magnum Piering, Inc. v. The Mudjackers and Garwood & Wilson, Sr.*, WIPO Case No. D2000-1525, *Rollerblade, Inc. v. Chris McCrady*, WIPO Case No. D2000-0429, *Auchan v. Web4comm Srl Romania*, WIPO Case No. DRO2005-0001; and *OSRAM GmbH, v. web4COMM SRL Romania*, WIPO Case No. DRO2005-0004).

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

Rights and Legitimate Interests

As noted above, once the complainant makes a prima facie showing under paragraph 4(a)(ii) of the Policy, paragraph 4 (c) shifts the burden of proof to the respondent to come forward with evidence of rights or legitimate interests in a disputed domain name.

The Panel is persuaded from the record of this case that a prima facie showing under paragraph 4(a)(ii) has been made. It is undisputed that the Respondent has not been authorized to use the Complainant's "李嘉誠" and/or "李嘉誠基金會" mark.

Nevertheless, the Respondent admits the registration of two domain names that are identical to the Complainant's mark, <李嘉誠.com> and <李嘉誠.com> (See ADNDRC, DHK-0800180) and has used those domain names to attract Internet users to a website from which the Respondent may generate pay-per-click advertising. The Respondent makes no claim to have ever been commonly known by either of the disputed domain names.

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights to or legitimate interests in the disputed domain names by demonstrating any of the following:

- (i) before any notice to it of the dispute, the respondent's 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) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent is 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 Respondent argues that he has established rights or legitimate interests in the disputed Domain Names under paragraph 4(c)(iii) of the Policy based on the "not-yet active use or passive holding of a domain name does not necessarily constitute to bad faith. As Internationalized Domain Names (IDNs) are not expected to be fully operational yet until 2009 and are not generating impressive traffic yet". The language of paragraph 4(c)(iii) of the Policy unambiguously requires a respondent to be "making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers." The Panel further notes that Paragraph 4(c)(iii) of the Policy only concerns active websites that practice genuine, noncommercial useage, and nor insubstantial use of the disputed domain name that are clearly not active or unsubstantiated averment.

The Panel accepts the Complainant's claims that the Respondent has never engaged in a substantial business activity under the "李嘉誠" name or anything similar. Although the Respondent has provided a copy of Certification of Incorporation Change of Name issued by the Republic of Seychelles dated 28th August 2007. Further, if one has registered a company with genuine intention to engage in business, how can he/she not active or passive holding of a domain name for more than two years? Especially the Respondent claim their business scope are wide, including the provision of advertising and information searching services, to which the active interaction of a website may be highly desired.

Accordingly, it has not as a consequence of such activity established a right or legitimate interest in this term.

In view of the foregoing, the Respondent has failed to demonstrate that the disputed Domain Names are being used without intent for commercial gain, and as such the Respondent in the Panel's opinion cannot successfully invoke paragraph 4(c)(iii) of the Policy. See *Helen Fielding v. Anthony Corbert aka Anthony Corbett*, WIPO Case No. D2000-1000. For the reasons discussed above the Panel does not believe that the Respondent is making a legitimate noncommercial or fair use of the disputed domain names within the contemplation of paragraph 4(c)(iii) of the Policy. See *Tom Cruise v. Network Operations Center / Alberta Hot Rods*, WIPO Case No. D2006-0560.

The Respondent also claims rights or legitimate interests based on the registration and use of the company name, Lee . Jia . Cheng (Co-Run) Ltd. (李嘉誠(合營)有限公司). However, there is evidence in the record of the Mr. Li's use of his name as an indicator of his goods and services prior to the Respondent's registration of the disputed Domain Names. In any event, the Panel also is persuaded by the circumstances surrounding the domain name registrations that the Respondent's aim was to take advantage of existing or prospective trademark rights in the "李嘉誠" mark. See e.g., *General Growth Properties, Inc., Provo Mall L.L.C. v. Steven Rasmussen/Provo Towne Centre Online*, WIPO Case No. D2003-0845.

Accordingly, the Panel finds that the Respondent has no right or legitimate interest in the Disputed Domain Name and that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

Bad Faith

The Panel finds in this case that the Domain Names have been registered and used in bad faith, as it is use in bad faith within the scope of paragraph 4(b)(iv) of the Policy where the registrant chose the domain name in question because of its similarity to a mark or name of another person in the hope and expectation that that similarity will result in an increased number of Internet users being drawn to that page (see for example *Express Scripts, Inc.*, WIPO Case No. D2008-1302).

In this case the Complainant has put forward evidence of the extensive activities of the Complainants and the substantial reputation of the 1st Complainant, "李嘉诚". In short, it is fair to say that previous cases show the Respondent to be a serial cybersquatter that appears to have adopted a business model that involves the exploitation of the trade mark rights of others with a cynical disregard for those rights.

Further, there is the use of the Registrar's WhoIs privacy services to hide the Respondent's identity and the use of different names to disguise the fact that the domain names are controlled by the same entity. As this Panel described in *First SBF Holding, Inc. v. XC2*, WIPO Case No. D2008-0409, the use of a WhoIs privacy service ordinarily does not of itself justify a finding of bad faith, but it can in some cases be a factor that points in that direction. In this case, it seems to be an integral part of the scheme that the Respondent has devised to take advantage of the rights of others.

In the circumstances, the Complainant has made out the requirements of paragraph 4(a)(iii) of the Policy.

Status

www.李嘉诚.com 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 <李嘉诚.com> be transferred to the 2nd Complainant.

Timothy Sze
Sole Panelist
21st September, 2009