

**Hong Kong Office****ADMINISTRATIVE PANEL DECISION****Case No. HK - 1100328****Complainants : (1) Chickeeduck International Limited****(2) Chickeeduck Distribution Limited****(3) Chickeeduck Retail (Hong Kong) Limited****Respondent: Swanbourne Inc****1. The Parties and Contested Domain Name**

The Complainants are (1) Chickeeduck International Limited , (2) Chickeeduck Distribution Limited and (3) Chickeeduck Retail (Hong Kong) Limited, all companies incorporated in Hong Kong (together “the Complainant”), represented by Messrs Robin Bridge & John Liu, Solicitors, Hong Kong.

The Respondent is Swanbourne, Inc of 1002, Tai Yau Building, 181 Johnston Road, Wanchai, Hong Kong.

The contested domain name is <chickeeduck.com>, registered by Respondent with Dotster, Inc.

**2. Procedural History**

The Complaint was filed with the Hong Kong office of the Asian Domain Name Dispute Resolution Center (“the Center”) on January 5, 2011. On January 6, 2011 the Center transmitted by email to Dotster, Inc. a request for registrar verification in connection with the domain name at issue. On January 27, 2011 Dotster, Inc transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (“the Policy”), the Rules of Procedure under the Policy (“the Rules”) and the Center’s Supplemental Rules.

In accordance with the Rules, the Center formally notified the Respondent of the Complaint and the proceedings commenced on February 10, 2011. In accordance with the Rules, the due date for Response was March 2, 2011.

No Response was received by the Center.



## ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

— A charitable institution limited by guarantee registered in Hong Kong

The Center appointed The Honourable Neil Anthony Brown QC as panelists in this matter on April 20, 2011. The Panel finds that it was properly constituted and has acted impartially in reaching its conclusion.

### **3. Factual background**

The Complainant is a large and successful business manufacturing and distributing children's clothing under the label CHICKEEDUCK and it has done so since 1990. The Complainant's group operates in Hong, China and internationally. Its CHICKEEDUCK brand has become famous as a result of the success of the business and the popularity of its products marketed under that name

The Complainant has registered the domain name <chickeeduck.com.hk> which it uses to support its own website that promotes its brand and products.

The Complainant has registered a series of trademarks for CHICKEEDUCK in Hong Kong, China and internationally, its first trademark being Hong Kong TM Registration No.199200666 for CHICKEEDUCK, registered on August 21, 1990. The Complainant's trademarks are hereinafter referred to collectively as "the Complainant's registered CHICKEEDUCK trademark". The Complainant has spent large sums of money promoting and protecting its registered CHICKEEDUCK trademark.

The Respondent registered the disputed domain name on October 4, 1999.

### **4. Parties' Contentions**

#### **A. Complainant**

The Complainant alleges that the disputed domain name should no longer be registered with the Respondent, but that it should be transferred to the First Complainant, Chickeeduck International Limited.

It contends that this should be done because, within the meaning of paragraph 4 of the Policy, the disputed domain name is identical or confusingly similar to the Complainant's registered CHICKEEDUCK trademark, that the Respondent has no rights or legitimate interests in the disputed domain name and that it has been registered and subsequently used in bad faith. The Complainant maintains that it can prove all three of these requirements and that the appropriate remedy is to transfer the disputed domain name to the Complainant.

In support of its case on the first of these three elements, the Complainant relies on its registered CHICKEEDUCK trademark, to which reference has already been made. It then says that the disputed domain name is confusingly similar to the trademark as the spelling of that word in the domain name is the same as the spelling of the same word in the trademark.



## ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

— A charitable institution limited by guarantee registered in Hong Kong

The Complainant then contends, to establish the second element, that the Respondent has no rights or legitimate interests in the disputed domain name because the facts show an obvious intention by the Respondent to benefit from the reputation of the Complainant's registered CHICKEEDUCK trademark and to use it in an illegitimate and inappropriate way, as the mark is famous and there can be no legitimate purpose that could justify the Respondent's registering it. Moreover, the Complainant contends that it has never authorized the Respondent to use its trademark in a domain name or anywhere else.

The Complainant also contends that the disputed domain name was registered and is being used in bad faith. It contends that this so because the Respondent registered the disputed domain name incorporating the Complainant's registered CHICKEEDUCK trademark without any permission from the Complainant and has passively held it since then. The Complainant contends that these activities of the Respondent constitute bad faith registration and use within the meaning of paragraph 4(b) of the Policy and within the general meaning of bad faith.

### **B. Respondent**

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

### **5. Discussion and Findings**

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In that regard, the Panel also notes that the fact that a respondent has not made a formal submission does not avoid the necessity of examining the issues and of doing so in the light of the evidence. The onus remains on the complainant to make out its case and past UDRP panels have said many times that despite the absence of a submission from a respondent, a complainant must nevertheless show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

However, as the Panel will illustrate later, it is possible to draw inferences from the evidence that has been submitted and in some cases from silence. Indeed, paragraph 14 of the Rules incorporates both of those notions into the procedures of the Panel.

The Panel therefore turns to discuss the various issues that arise for decision on the facts as they are known.

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- (i) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and



## ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

— A charitable institution limited by guarantee registered in Hong Kong

(ii) The Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) The disputed domain name has been registered and is being used in bad faith.

It is to be noted that paragraph 4 of the Policy provides that the Complainant must prove that each of the three elements is present. The Panel will therefore deal with each of these requirements in turn.

### A. Identical or Confusingly Similar

The Panel accepts the evidence submitted by the Complainant that it owns the Complainant's registered CHICKEEDUCK trademarks to which reference has been made, that those trademarks are all current and that it has rights in those marks. For reasons of completeness the Panel adds that the fame of the CHICKEEDUCK mark, as shown by the extensive evidence adduced on behalf of the Complainant, is such that in addition to its registered trademarks, the Complainant also established a common law or unregistered trademark in the word CHICKEEDUCK prior to the disputed domain name having been registered on October 4, 1999.

The Panel also finds that the disputed domain name is identical to the Complainant's registered and common law CHICKEEDUCK trademarks .The spelling of the substantial part of the domain name is the same as that of the mark and it would be pronounced the same. It has also long been held that minor features such as suffixes like the gTLD suffix ".com" cannot negate identicity between a domain name and a trademark where it otherwise exists, as it does in the present case.

For these reasons, the Panel finds that the domain name is identical to the Complainant's registered CHICKEEDUCK trademark and that the Complainant has made out the first of the three elements that it must establish.

### B. Rights or Legitimate Interests

Under paragraph 4(a) (ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name. But by virtue of paragraph 4(c) of the Policy, it is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

(i) before any notice to you [Respondent] 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 [Respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or



## ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

— A charitable institution limited by guarantee registered in Hong Kong

(iii) you [Respondent] 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.

Thus, if the respondent proves any of these elements or indeed anything else that shows it has a right or interest in the disputed domain name, the complainant will have failed to discharge its onus and the complaint will fail. The Panel's task in deciding if a respondent has any rights or legitimate interests in a domain name is made more difficult when the respondent is in default and does not file a response or any other form of submission. The Respondent in the present case was given notice that it had until March 2, 2011 to send in its Response, that it would be in default if it did not do so and that, by virtue of paragraph 14 of the Rules, the Panel might draw appropriate inferences from that default.

It is also well established that a complainant must first establish a *prima facie* case that the Respondent has no right or legitimate interest in the disputed domain name and that, if that *prima facie* case is made out, the onus is then on the Respondent to rebut it.

The Panel, after considering all of the considerable evidence and arguments put forward by the Complainant, finds that the Complainant has made out a *prima facie* case. That *prima facie* case comes about because of the following considerations:

- (i) the Complainant's registered CHICKEEDUCK trademark is well known internationally and has been so for many years;
- (ii) the trademark is the mark of the well-known manufacturer and distributor of children's clothing of the same name, a company with an extensive and prominent presence in Hong Kong where the Respondent is apparently domiciled as well as elsewhere;
- (iii) the Respondent chose this prominent name for its domain name thus raising the inference in the minds of the Internet public that the domain name, if used, would lead to the online facility of the Complainant;
- (iv) the Respondent was not authorized by the Complainant to use the CHICKEEDUCK name or mark in a domain name or anywhere else; and
- (v) the foregoing facts raise the inference that the Respondent has both registered the disputed domain name and would use it for an illegitimate purpose.

The Respondent has not made any attempt to rebut this *prima facie* case by filing a Response or by any other means and the Panel therefore concludes that the Respondent has no rights or legitimate interests in the domain name.

The Panel finds that the Complainant has therefore made out the second of the three elements that it must establish.



## C. Registered and Used in Bad Faith

The Complainant must prove on the balance of probabilities both that the domain name was registered in bad faith and that it is being used in bad faith: *Telstra Corporation Limited v. Nuclear Marshmallows*, [WIPO Case No. D2000-0003](#).

Further guidance on how to implement this requirement is to be found in paragraph 4(b) of the Policy, which sets out four circumstances, any one of which shall be evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive.

The four specified circumstances are:

- (i) circumstances indicating that the respondent has registered or 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 the respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has 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 the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, respondent has intentionally attempted to attract, for commercial gain, Internet users to respondent's 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 the respondent's website or location or of a product or service on the site or location.

The Complainant relies on all of the provisions of paragraph 4(b) of the Policy and also on the general notion of bad faith, which it is clearly entitled to do, for there have been many UDRP decisions that have held that bad faith is not limited to the factors set out in paragraph 4(b) of the Policy.

The Panel finds that the evidence submitted by the Complainant makes out a strong case that the Respondent both registered and, by way of passive holding, is using the domain name in bad faith. That is so for the following reasons.

First, the evidence shows that the Respondent has registered as a domain name the Complainant's well known CHICKEEDUCK trademark, suggesting that the domain name was registered for the illegitimate purpose of trading off the name and reputation of the Complainant for commercial purposes and thus in bad faith, for the Respondent clearly had the Complainant in mind when it



## ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

— A charitable institution limited by guarantee registered in Hong Kong

registered the domain name without permission. As the Complainant has shown, the registration of such a well-known trademark as CHICKEEDUCK without any permission is indicative of bad faith. In the absence of any explanation from the Respondent, the Panel finds that the Respondent registered the disputed domain name in bad faith.

Secondly, the evidence adduced by the Complainant raises the inference that the Respondent registered the domain name with the intention either of trying to sell it or using it in the manner described in paragraph 4(b)(ii), (iii) and/or (iv) of the Policy. It is true that the disputed domain name does not resolve to an active website, but the only inference open on the facts is that its intentions were wholly illegitimate and designed to harm the interests of the Complainant. That is so because, as the Complainant argues, there can be no valid or legitimate reason why the Respondent would want to register the disputed domain name.

Moreover, in the opinion of the Panel, this is an appropriate case to apply the principle in *Telstra Corporation Limited v. Nuclear Marshmallows*, *supra* to the effect that, as it was put in *DCI S.A. v. Link Commercial Corporation*, [WIPO Case No. D2000-1232](#):

“In view of all of the above, the Administrative Panel follows the rulings set out in the decision case No. D2000-0003, *Telstra Corporation Limited vs. Nuclear Marshmallows* in finding that the passive holding of the domain name by the Respondent amounts to the Respondent acting in bad faith. The Administrative Panel concludes that the Respondent holds the domain name in bad faith.”

As the Complainant has shown, the decision in *Telstra Corporation Limited vs. Nuclear Marshmallows* (*supra*) has been followed in *Sino-Forest Corporation v. Shenzhen South China Network C. Ltd.* ADNDRC Case NO. HK-1000308.

The present case is a good example of passive holding of a domain name which, as has been illustrated by those decisions, constitutes bad faith registration and use for the purposes of the Policy.

Accordingly, for those reasons the Panel concludes that the case presented by the Complainant and the UDRP decisions it has cited show that the Respondent registered and used the domain name in bad faith within the meaning of paragraph 4 (b) of the Policy and within the general concept of bad faith.

The Complainant has accordingly made out the third of the three elements that it must establish.

### 6 . Decision

The Complainant has made out its case and has requested that the disputed domain name be transferred to the First Complainant. The Panel finds that the First Complainant is the appropriate party to whom the domain name should be transferred. For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the



## ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

— A charitable institution limited by guarantee registered in Hong Kong

disputed domain name <chickeeduck.com> be transferred to the First Complainant, Chickeeduck International Limited.

The Hon Neil Brown QC

Sole Panelist

Dated: May 2, 2011