



# ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

— A charitable institution limited by guarantee registered in Hong Kong

## IN THE MATTER OF

The Uniform Domain Name Dispute Resolution Policy, approved by the Internet Corporation for Assigned Names and Numbers (ICANN) on 24 October 1999 (the "Policy");

The Rules for Uniform Domain Name Resolution Policy, approved by ICANN on 30 October 2009 (the "Rules"); and

The Asian Domain Name Dispute Resolution Centre ("ADNDRC") Supplemental Rules or the Policy and the Rules as effected on 28 February 2002 (the "Supplemental Rules").

Complainant: Sekisui Chemical Co Ltd

Respondent: Lo Kwok Chuen (trading as Railship Technology Company in  
Hong Kong)

Case Number: HK-1100383

Contested Domain Name: sekisui.com

Panel Member: Peter Bullock

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### 1. The Parties

The Complainant is Sekisui Chemical Co. Ltd of 2-3-17 Toiranomon, Minato-ku Tokyo 105-8450 Japan, represented by Wilkinson & Grist.

The Respondent is Lo Kwok Chuen, trading as Railship Technology Company of Room 1, 26/F Block B, Tak Bo Gardens, Ngau Tau Kok Road, Kowloon, Hong Kong.

### 2. Domain name and registrar

The disputed domain name <sekisui.com> (the "Domain Name") is registered with Tucows Inc (the "Registrar").

### 3. Procedural History

The Complaint was filed with the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (the "ADNDRC") on July 21, 2011. On July 22, 2011, the ADNDRC transmitted by email to Registrar a request for registrar verification in connection with the Domain Name. On July 22, 2011, the Registrar transmitted by email to the ADNDRC its verification response confirming that the Respondent is listed as registrant and providing the contact details. On July 25, 2011, the Registrar informed the ADNDRC that the domain name in dispute had been placed on Registrar Lock. While the functionality of the website is not affected, no transfer, suspension, or other modification occurs to the registration records of the Registrar and no change will be effected to the ownership or Registrar for the duration of the dispute. The ADNDRC verified that the Complainant satisfied the formal requirements of the Policy, the Rules and the Supplemental Rules.



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In accordance with the Rules, paragraphs 2(a) and 4(a), the ADNDRC formally notified the Respondent of the Complaint, and the proceedings commenced on July 25, 2011. In accordance with the Rules, paragraph 5(a), the due date for Response was August 14, 2011. The Response was filed with the ADNDRC on August 13, 2011.

The ADNDRC appointed Peter Bullock as the sole panelist in this matter on August 30, 2011. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the ADNDRC, to ensure compliance with the Rules, paragraph 7.

#### 4. Factual Background

The Complainant, Sekisui Chemical Co Ltd, was established in Japan in March 1947 under the name of "Sekisui Sangyo Co Ltd". The Complainant and its group of companies have become a global conglomerate specialising in a wide range of business including high performance plastics, urban infrastructure and housing. The Complainant's group of companies spread over Asia, Europe, North America, Central and South America as well as Oceania.

The Complainant incorporated a subsidiary company SEKISUI (Hong Kong) Limited in January 1976. SEKISUI (Hong Kong) Limited deals with various products of the Complainant marketed under the trademark/name "SEIKISUI" and operates a website at [www.sekisui.com.hk](http://www.sekisui.com.hk).

Since 1947, the Complainant and most of its associated companies have been using "SEKISUI" as trademark/name for the purpose of its business. The Complainant is the registered proprietor of the "SEKISUI" series of trademarks in various countries including Japan, China, Hong Kong, European Union and United States, covering various classes of goods and services. The Complainant is the registered owner of the following trademark registrations in Hong Kong, where the registrations are prior to the registration date of the Domain Name.

- Hong Kong registration SEKISUI (word mark) no. 19690351 registered on 13 March 1969 in class 1
- Hong Kong registration SEKISUI (word mark) no. 196903054 registered on 13 March 1969 in class 16
- Hong Kong registration SEKISUI (word mark) no.19690356 registered on 13 March 1969 in class 17
- Hong Kong registration SEKISUI (word mark) no. 19690358 registered on 13 March 1969 in class 19
- Hong Kong registration SEKISUI (word mark) no. 199604228 registered on 10 May 1996 in class 6

The Complainant has also registered domain names consisting of or comprising the trademark SEKISUI such as <[sekisui.co.jp](http://sekisui.co.jp)>, <[sekisuichemical.com](http://sekisuichemical.com)>, <[sekisui.com.hk](http://sekisui.com.hk)>, <[sekisui.com.tw](http://sekisui.com.tw)>, <[sekisui.com.sg](http://sekisui.com.sg)>, <[sekisui-corp.com](http://sekisui-corp.com)>, <[sekisui-spr.com](http://sekisui-spr.com)> amongst others.

The Domain Name was registered on 8 June 1996 by the Respondent's brother. The Domain Name, the Panel is informed, together with 19 other domains, was transferred to the Respondent from his deceased brother's estate in April 2008. On December 2010, the Respondent joined the OpenSRS Parked Pages Program ("Program") operated by OpenSRS, the reseller services group of the Registrar. It is asserted by the Respondent that when he agreed to take part in the Program, a customised page containing contextual ads was displayed on the domain. The ads generate revenue whenever a visitor clicks on one of the links, and that



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revenue is shared between OpenSRS and the Respondent. The revenue will be added to the account of Respondent at the end of each month. It is asserted by the Respondent that even though the domain displays content that is not created by the Respondent, the domain still belongs to the Respondent. The projected sum in the year of 2011 for the Respondent received through the Program for the 20 domains registered under his name is US\$154.30, which is asserted to be less than the Registrar's annual fee.

In response to the letter sent by the Complainant dated April 19, 2011, the Respondent replied that he had not been operating the website under the Domain Name but was merely parking the Domain Name with the Registrar, and that the Registrar was using the Domain Name for advertisements. On April 26, 2011, the Respondent issued instructions to disable the Program for the Domain Name and the Domain Name is not currently linked to OpenSRS Parked Pages Servers.

As at the date of the Complaint was filed, no use was being made by the Respondent of the Domain Name.

### 5. Parties' Contentions

#### 5.1 Complainant

The Complainant contends that the major part of the Domain Name is identical to the trademark "SEKISUI" of the Complainant.

The Complainant also contends that the Respondent is not in any way related to the Complainant, nor was the Respondent authorised by the Complainant to use the mark/name "SEKISUI". Neither the trade name of the Respondent "Railship Technology Company" nor its proprietor's name Mr. Lo Kwok Chuen contains "SEKISUI". Therefore the Complainant submits that the Respondent has no rights or legitimate interest in respect of the Domain Name.

The Complainant contends that it was established in Japan for more than 50 years before the date of registration of the Domain Name, with its subsidiary incorporated in Hong Kong for more than 20 years before the date of registration. The reputation and goodwill already subsisted in the Complainant's trademark/trade name "SEKISUI" in Hong Kong and worldwide in its fields of business. The Complainant submits that it has prior rights in the trademark/name "SEKISUI". It could not be a coincidence for the Respondent (or his brother) to register a domain name which is exactly identical to the Complainant's trademark/name "SEKISUI".

The Complainant avers that at the time the Complainant discovered that the Domain Name was registered by the Respondent, the Domain Name was directed to a website containing various links to websites relating to chemical products, which is one of the major business areas of the Complainant. Complainant has demanded the Respondent to cease using the Domain Name by cease and desist letter dated April 19, 2011.

The Complainant contends that the Respondent did not use the Domain Name, nor had the Respondent made demonstrable preparations to use the Domain Name in connection with a bona fide offering of goods or services. The Complainant submits that such passive holding of the Domain Name amounts to bad faith use. The Complainant further submits that the intention of the Respondent is to free-ride on the reputation of the Complainant and to create confusion that the Respondent's act is authorised by the Complainant or that the Respondent is connected with the Complainant or the Domain Name is sponsored or affiliated with the Complainant.



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The Complainant further avers that it conducted a further WHOIS search on 1 June 2011 and the status was "pending transfer". The Complainant submits that Respondent intended to transfer the Domain Name for unjustified benefit.

### 5.2 The Respondent

The Respondent asserts that he has never approached anyone (including the Complainant) with a view of selling the Domain Name and has never kept the domains for the purpose of selling.

The Respondent avers that, under the Program, he has no control of any of the content related to the parked web pages and has not been involved or invited to become involved in any stage of the web page design. The Respondent submits that Page 1 and Page 4 of the brochure of the Program proves that the Domain Name is linked to generic pages for parking domain names registered by multiple domain-name holders, and is not related to any active web page related to the Respondent at all. The Respondent contends that he had taken immediate steps on April 26, 2011 to disable the Program for the Domain Name, once he received the letter from Complainant dated April 19 2011.

The Respondent contends that the Domain Name has been inactive ever since it was registered in Hong Kong in 2008. It is submitted that registration of the Domain Name by the Respondent was not intended to make a profit and the Respondent does not have anything to sell. The Respondent denied the allegation that the Respondent acted in bad faith when it made the application for registration for the Domain Name in 1996 as it was his deceased brother, not him, who registered for the domain.

The Respondent submits that passively holding domains does not equate to registering and using domains in bad faith.

## 6 Discussion and Findings

Paragraph 4(a) of the Policy requires the Complainant to prove the following:

- (a) that 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
- (b) that the respondent has no right or legitimate interests in respect of the domain name; and
- (c) that the domain name has been registered and is being used in bad faith.

Each of these requirements will be dealt with separately.

### 6.1 Identical or confusingly similar

The Domain Name is identical to the trademark SEKISUI in respect of which the Complainant has established and maintained at all material times trademark rights in Hong Kong and many other countries.

The Complainant has established this element.

### 6.2 Rights or Legitimate Interests



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The Panel is satisfied that the Respondent does not have rights or legitimate interests in the Domain Name. Under paragraph 4(c) of the Policy, the Respondent may demonstrate that it has rights or legitimate interests in the domain name in issue by showing one or more of the following circumstances:

- (i) its use of, or preparation to use, the contested domain name in connection with a bona fide offering of wares or services;
- (ii) the fact that it has been commonly known by the domain name; and
- (iii) its legitimate non-commercial or fair use of the domain name.

The Respondent does not appear to have any connection or affiliation with the Complainant, which has not licensed or otherwise authorised the Respondent to use or apply for any domain name incorporating Complainant's trademarks. Respondent does not appear to make any legitimate use of the domain names for his own commercial or non-commercial activities. There is no record that the Respondent has been known under the Domain Name. The Respondent has not provided evidence of any each circumstance, nor of any other such circumstances which would suggest a right or legitimate interest.

The Complainant has established this element.

### **6.3 Registered and used in bad faith**

Pursuant to Rule 4(a)(iii) of the Policy, the Complainant must establish both bad faith registration and bad faith use. Paragraph 4(b) of the Policy lists examples of four circumstances that would amount to evidence of the registration and use of a domain name in bad faith by the respondents:

- (i) circumstances indicating that the respondent had registered the domain name primarily for the purpose of selling, renting or otherwise transferring it to the complainant or its competitor for consideration;
- (ii) the respondent registered the domain name in order to prevent the complainant from reflecting its trademark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct;
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor;
- (iv) by the use of the domain name, the respondent has intentionally attempted to attract, for commercial gain, internet users to its domain name or other on-line location. The objective would be create confusion with the complainant's mark and so suggest that the respondent is a source, sponsorship, affiliation or endorsement of its service or product.

The examples of bad faith registration and use set forth in paragraph 4(b) of the Policy are not meant to be exhaustive of all circumstances from which such bad faith may be found. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003. The overriding objective of the Policy is to curb the abusive registration of domain names in circumstances where the registrant is seeking to profit from and exploit the trademark of another. *Match.com, LP v. Bill Zag and NWLAWS.ORG*, WIPO Case No. D2004-0230.

The Complainant asserts that the Domain Name was used to provide various links to websites relating to chemical products, which is one of major business areas of the Complainant. In the



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absence of any, or any proper, explanation by the Respondent, of this allegation (supported by a screen shot), this alone constitutes bad faith. The panel finds no adequate explanation by the Respondent.

The Complainant further submits that a passive holding of the Domain Name by the Respondent amount to bad faith use. This latter indication of bad faith is also made out. The Respondent clearly sought some advantage by refusing to transfer the Domain Name to the Complainant when responding to Wilkinson & Grist's letter of April 19 2011, when he wrote "No one stop your client for owing (sic) any asset in a free market but there is no free lunch!" It is also noted that, in addition to the Domain Name, the Respondent had (as at November 30 2010) 19 further domains parked with the Registrar. In his evidence the Respondent saw fit to redact the names of these domains. The natural inference to be drawn is that some or all of these other domains are identical or confusingly similar to well-known marks.

The Complainant has satisfied the bad faith element also.

### 7. Decision

The Panel finds that the Domain Name is identical to the trademark or service mark in which the Complainant has rights, that the Respondent has no rights or legitimate interests in respect of the Domain Name and the Domain Name have been registered and used by the Respondent in bad faith.

Accordingly, the Panel directs that the Domain Name <sekisui.com> should be transferred to the Complainant.

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Peter Bullock  
Sole Panelist

Date: 16 September 2011