



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

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| Case No. | HK-1700963 |
| Complainant: | WONG TO YICK WOOD LOCK OINTMENT LIMITED |
| Respondent: | Chun Hoi CHEUNG |
| Disputed Domain Name(s): | <wong-to-yick.com> |

1. The Parties and Contested Domain Name

The Complainant is WONG TO YICK WOOD LOCK OINTMENT LIMITED, of 4/F., MAI SHUN IND. BLDG, 18-24, KWAI CHEONG RD., KWAI CHUNG, N.T. Hong Kong.

The Respondent is Chun Hoi CHEUNG, of No. 141, Cheung Sha Wan Road, Sham Shui Po, Kowloon, Hong Kong.

The domain name at issue is <wong-to-yick.com>, registered by Respondent with GoDaddy.com, LLC, whose email address is abuse@godaddy.com.

2. Procedural History

The present complaint (the “Complaint”) was filed with the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (the “Centre”) on 6 April 2017 in accordance with the Uniform Domain Name Dispute Resolution Policy (the “Policy”) which was adopted by the ICANN and came into effect on 24 October 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”) which became effective on 28 September 2013 and the Supplemental Rules thereof (the “Supplemental Rules”) which came into effect on 31 July 2015.

On 7 April 2017, the Centre transmitted by email to the Registrar, GoDaddy.com, LLC, a request for registrar verification in connection with the domain name at issue and confirmed the receipt of the Complaint and case filing fee. On 8 April 2017, the Registrar made the verification to the Centre that the registrant of the domain name at issue is Chun Hoi CHEUNG. The Registrar confirmed that the Policy applies to the Disputed Domain Name and pointed out that the language used in the Registration Agreement is English.

On 10 April 2017, the Centre sent the formal Complaint Notice to the Respondent and requested the Respondent to reply within 20 days (on or before 30 April 2017) in accordance with the Rules and the Supplemental Rules and forwarded the Complaint and

all the Annexes thereof. The procedures for this case formally commenced on 10 April 2017.

On 2 May 2017, the Centre issued a Default Notice and confirmed that the Respondent did not file a formal reply with the Centre, within the required time limit for filing a reply.

On 4 May 2017, the Centre sent a Notice of Panelist Appointment to Ms. Vivien Chan as Panel candidate for the current case, and the Panel candidate considered that it was properly constituted and submitted the acceptance notice as well as a statement of impartiality and independence on 5 May 2017.

On 5 May 2017, the Centre notified both parties and the Panel Ms. Vivien Chan by email that Ms. Vivien Chan be the sole panelist for arbitrating this case. The Centre then formally transferred the case to the Panelist. The Panelist agreed to deliver her decision with respect to the Disputed Domain Name on or prior to 19 May 2017.

3. Factual background

Background information of the Complainant

Incorporated under the laws of Hong Kong, the Complainant claims that it and its predecessors had, at all material times, been in the business of manufacturing and marketing medicated balm or oil under the name “Wong To Yick Wood Lock Medicated Balm 黃道益活絡油”.

Prior to the date of the registration of the Disputed Domain Name, the Complainant has, inter alia, registered the following marks in Hong Kong (the “Complainant’s Marks”):-

| Jurisdiction | Registration No. | Facsimile of Mark | Date of Registration |
|--------------|------------------|--|----------------------|
| Hong Kong | 1995B09582 |  | 07-12-1991 |
| Hong Kong | 300721764 |  | 14-09-2006 |
| Hong Kong | 300057041 |  | 01-08-2003 |

Background information of the Respondent

The Respondent, Chun Hoi CHEUNG, of No. 141, Cheung Sha Wan Road, Sham Shui Po, Kowloon, Hong Kong, registered the Disputed Domain Name on 7 September 2012. The Respondent did not file any reply or other materials with the Centre.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. The Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights:

The Complainant contends that the Disputed Domain Name is identical to the Complainant's name and the Complainant's Marks. The Respondent had promoted and sold ointments with the prominent use of the marks “**黃道益**” and “Wong To Yick” at the website hosted by the Disputed Domain Name. Accordingly the Complainant submits that this leads to mistaken identification among the relevant public.

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

The Complainant puts forward that the Respondent is not affiliated with, sponsored by, endorsed by, or even known to the Complainant. Further, the Complainant has not licensed or otherwise authorized to sell the Complainant's product.

Complainant further states that the website hosted by the Disputed Domain Name includes the following statement:

“绿本堂大药店从 10 年代理香港黄道益以来，开设第一家网上黄道益专卖旗舰店，本着产品第一，服务至上的目标，深受大陆用户的喜爱。”

Which translated into English would be:

“Since year [20]10 being the distributing agent of Hong Kong Wong To Yick, Lv Ben Tang Pharmacy has opened the first Wong To Yick flagship store online, with the goal of promoting superior product and providing optimal services, the store is well received by the Mainland users”.

(the “Statement”)

The Complainant asserts that the above statement is willfully misleading and implied that the Respondent had a relationship with the Complainant. Further, information of the Complainant, images of the Complainant's product, details regarding the authenticity of the Complainant's product as well as links for making purchases were uploaded to the website hosted by the Dispute Domain Name, which did not describe itself truthfully, as having no relationship with the Complainant or the Complainant's Marks.

- iii. The Disputed Domain Name has been registered and is being used in bad faith:

The Complainant claims that the bad faith can be established based on the following grounds:

- (1) The Complainant has extensively used and promoted its product over the years and as a result, established a strong reputation and goodwill. The Respondent, being in the same trade of selling medicated balm or oil should be aware of the Complainant, its product and the Complainant's Marks. In spite of the above, the Respondent had registered the Disputed Domain Name and hosted a website selling medicated balm or oil by making reference to images of the Complainant's product.
- (2) The Respondent has claimed in the Statement to be the authorized distributing agent of the Complainant, which is denied by the Complainant.
- (3) Photos uploaded onto the website hosted by the Disputed Domain Name are identical to those on the Complainant's website. Together with information on ways to verify the authenticity of the Complainant's product and links to purchasing product, the Respondent intends to convey the message that the product sold on the website hosted by the Disputed Domain name are genuine and authorized.

From the above, the Complainant asserts that it can be seen that the Respondent intended to cause confusion and deception amongst members of the public, using the Complainant's trade name and the Complainant's marks with a view of taking unfair advantage of the power of attraction, reputation and prestige of the Complainant's Marks. As such, the Complainant submits that the Respondent has registered/used the Disputed Domain Name in bad faith.

B. Respondent

The Respondent did not submit any reply.

5. Findings

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that each of three findings must be made in order for a complaint to prevail:

- i. Respondent's domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- ii. Respondent has no rights or legitimate interests in respect of the domain name; and
- iii. Respondent's domain name has been registered and is being used in bad faith.

A) Identical / Confusingly Similar

Pursuant to the Paragraph 4(a)(i) of the Policy, the complainant must prove that a disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.

From the trademark registrations certificates and records from various jurisdictions, such as Hong Kong and the People's Republic of China, the Panel accepts that the Complainant has the trademark right over "WONG TO YICK" and "黃道益"-formative trademarks.

The Disputed Domain Name is <wong-to-yick.com>. Comparing the Complainant's Marks and the Disputed Domain name, the Dispute Domain Name wholly incorporates the Complainant's "WONG TO YICK" trademark. The addition of the hyphen "--" between the words of the Disputed Domain Name and the gLTD ".com" do not confer to the whole a new meaning involving the absence of risk of confusion with the trademark (*See WIPO Case France Telecom SA v. France Telecom Users Group, D2000-0074.*).

Based on the above, the Panel finds that the Disputed Domain Name is identical or confusingly similar to the Complainant's Marks. Accordingly, the Complainant has satisfied the element required by Paragraph 4(a)(i).

B) Rights and Legitimate Interests

Once the Complainant establishes a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name, the burden of production shifts to the Respondent to show that it has rights or legitimate interests in respect to the disputed domain name. (*See Edgwell Personal Care Brands LLC v. jifeifeil, Case No. HK-1600855*)

In the present case, the Complainant has demonstrated prima facie that the Respondent lacks rights or legitimate interests in respect of the Disputed Domain Name and the Respondent has failed to assert any such rights or legitimate interests.

The Panel noted that the Complainant, as the legitimate right holder, indicated that the Complainant has not licensed or otherwise permitted the Respondent to use the Complainant's trademarks or a variation thereof. The Complainant pointed out that the retail chain stores that are authorized to sell its product are listed on its official website (www.wongtoyick.com.hk). The Panel noted that the Respondent is not named on the list of authorized retail sellers.

The Respondent has not submitted any substantive Response to the Complaint and did not provide any explanation or evidence to show any rights or legitimate interests in the Disputed Domain Name sufficient to rebut the Complainant's prima facie case. Nevertheless, screenshots of the Disputed Domain Name provided by the Complainant has shown that the Respondent has promoted the Complainant's product through the website hosted by the Disputed Domain Name. The evidence presented indicates that the Respondent is not engaged in a bona fide offering of goods or services. Such use by the Respondent cannot be a basis for the Respondent to claim rights or legitimate interests over the Disputed Domain Name either.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

C) Bad Faith

The Complainant must show that the Respondent registered and is using the Disputed Domain Name in bad faith (Paragraph 4(a)(iii) of the Policy). Paragraph 4(b) of the Policy provides circumstances that may evidence bad faith under paragraph 4(a)(iii) of the Policy: “the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the Respondent has registered or acquired the Disputed 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 Disputed Domain Name; or
- (ii) the Respondent has registered the Disputed 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 Disputed Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent’s web site 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 web site or location or of a product or service on the Respondent’s web site or location.”

The Complainant has evidenced that its product has acquired high fame and reputation through the extensive sale and promotion of the product, supported by the invoices evidencing the sales turnover of the product and the expenses spent on advertising the product.

The Complainant has submitted evidence, which shows that the Respondent registered the Disputed Domain Name long after the Complainant registered its trademark.

Considering the goodwill of the Complainant’s product, the Respondent is clearly aware of the Complainant before the date of registration of the Disputed Domain Name, and would have known that registering a domain name that is confusingly similar and identical to the Complainant’s trademark may be beneficial to its operation.

At the website hosted by the Disputed Domain Name, notwithstanding that it is not related to the Complainant, the Respondent included the following materials:-

1. References to the Complainant’s product;
2. Claiming to be the authorized distributing agent of the Complainant;
3. Photos identical to those of the Complainant’s website.

As such, the Panel finds that the Respondent has registered the Disputed Domain Name primarily for the purpose of disrupting the business of a competitor and that the Disputed Domain Name was registered and is being used by the Respondent with knowledge of the Complainant and in bad faith with the intent to create an impression of an association with the Complainant and profit therefrom. The Respondent’s actions therefore constitute bad faith as the registration was to attract, for commercial gain, Internet users to the website hosted by the Disputed Domain Name, by creating a likelihood of confusion with the

Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the product sold on the website hosted by the Disputed Domain Name, satisfying Paragraphs 4b(iii) and 4b(iv) of the Policy.

The Complainant further relied on the decision of Deputy High Court Judge Ken Yee in *Wong To Yick Wood Lock Ointment Limited v Wintex Medicine Trading Ltd* ((unrep.) HCA 1950/2014 (the "Decision"). The Panel considers that this evidence is not relatable to the present case given that the matter concerned in the Decision was a trademark, as opposed to domain name in the present case.

Nevertheless, having regard to the circumstances of this case, the Panel finds that the above evidence is sufficient to show bad faith of the Complainant and accordingly, the Complainant has met its burden to establish the element under Paragraph 4(a)(iii) of the Policy.

6. Decision

Pursuant to Paragraph 4 of the Policy and Article 15 of the Rules, the Panel orders that the Disputed Domain Name <wong-to-yick.com> be transferred to the Complainant.

Vivien Chan
Sole Panelist

Dated: 19 May 2017