Asian Domain Name Dispute Resolution Centre

ADNDRC (Hong Kong)

**(Hong Kong Office)**

**ADMINISTRATIVE PANEL DECISION**

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| **Case No.** | **HK-1701015** |
| **Complainant:** | **CC Information Limited** |
| **Respondent:** | **Shaun Kraft (CompareAsia Group Limited)** |
| **Disputed Domain Name(s):** | **< hongkongcard.co >, < hongkongcard.net >, < hongkongcard.org >, < hongkongloan.co >, < hongkongloan.net > & < hongkongloan.org >** |

## 1. The Parties and Contested Domain Name

The Complainant is CC Information Limited, a company incorporated in Hong Kong.

The Respondent is Shaun Kraft of CompareAsia Group Limited, also a company incorporated in Hong Kong.

The six domain names at issue are < hongkongcard.co >, < hongkongcard.net >, < hongkongcard.org >, < hongkongloan.co >, < hongkongloan.net > & < hongkongloan.org > ("Disputed Domain Names").

## 2. Procedural History

On August 24, 2017, the Complainant's representative submitted a Complaint in English language to the Hong Kong Office of Asian Domain Name Dispute Resolution Centre ("ADNDRC").

On August 25, 2017, ADNDRC transmitted by email to the Registrar, Instra Corporation Pty, Ltd., a request for registrar verification in connection with the Disputed Domain Names. On August 28, 2017, the Registrar transmitted by email to ADNDRC confirming that the Respondent is the registrant of the Disputed Domain Names.

On August 31, 2017, ADNDRC transmitted the Notification of Deficiency to the Complainant.

On September 5, 2017, the Complainant submitted a revised Complaint to the ADNDRC.

On September 7, 2017, ADNDRC transmitted the Complaint to the Respondent by email and informed the Respondent of the 20-day period to file a Response. However, no Response has been filed.

On October 3, 2017, ADNDRC informed the parties of the appointment of Mr. William Law as the sole panelist and the decision would be rendered on or before October 17, 2017.

## 3. Factual background

The Complainant was founded in 2006 and specializes in advertising and marketing online via social media platforms and through its informative online portals, which includes **<hongkongcard.com>** and **<hongkongloan.com>**.

The Complainant is engaged in the business of online matching of loan applicants and loan institutions via domain names **<hongkongloan.com>** since as early as March 22, 2002. Complainant currently is the registered owner of **<hongkongloan.com>** and is one of the leading businesses in the industry.

The Complainant is engaged in the business of online matching of credit card applicants and credit card issuing institutions via domain names **<hongkongcard.com>** since as early as July 28, 2004. Complainant is currently the registered owner of **<hongkongcard.com>** and is one of the leading businesses in the industry.

The Complainant owns the following trademarks in Hong Kong:

"HONGKONGCARD.COM" (Registration No. 302217591); and "HONGKONGLOAN.COM" (Reg. No. 302332700) for "advertising" in Class 35.

Since as early as Respondent, namely, CompareAsia Group Limited is a for-profit private company incorporated in Hong Kong on September 5, 2013, formerly known as "Nova SC Four Limited". Respondent is the owner of six <6> domain names.

In or about February, 2015, Respondent approached the Complainant for a potential offer to acquire the Complainant. Said negotiations concluded unsuccessfully in March, 2015. Please refer to "Attachment 4" about the communication of negotiations via email.

On or about July 2, 2015 the Respondent registered two Disputed Domain Names **<hongkongcard.hk>** and **<hongkongloan.hk>** with HKNDR. And, on July 17, 2016, the Respondent registered six more Disputed Domain Names.

## 4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

**(i) The identifiable portion of the Disputed Domain Name is identical with the trademarks and service marks in which the Complainant has rights**

The Complainant maintains that it owns statutory and common law rights in the "HONGKONGLOAN.COM" and "HONGKONGCARD.COM" marks by virtue of its extensive use of these marks in commerce and by virtue of its registrations and applications for the mark in Hong Kong where the Respondent is located.

The Complainant contends that there is very little difference to no substantive difference between Complainant's marks "HONGKONGLOAN.COM", "HONGKONGCARD.COM" and the Disputed Domain Names in this complaint . The Disputed Domain Names confuses consumers into believing that such domain name or the Respondent's site to MONEYHERO.COM where all Disputed Domain Names are currently redirecting to is the site for the Complainant.

The Complainant contends that the Disputed Domain Names are confusingly similar to the Complainant's marks "HONGKONGLOAN.COM" and "HONGKONGCARD.COM", and that the Respondent has intentionally tried to create such confusion in bad faith.

**(ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name or the major portion of it**

The Complainant submits that the Respondent cannot establish any legitimate rights in the term "HONGKONGLOAN", "HONGKONGCARD" and the Disputed Domain Name. The Respondent is trying to trade on the goodwill created by the Complainant in its trade marks "HONGKONGLOAN.COM" and "HONGKONGCARD.COM". In addition, neither the Respondent or anyone affiliated with the Respondent, has ever sought or obtained a license from the Complainant to use the trade marks "HONGKONGLOAN.COM" and "HONGKONGCARD.COM" or the Disputed Domain Name, nor has the Respondent attempted to file any trade mark applications for the marks "HONGKONGLOAN" and "HONGKONGCARD" in Hong Kong in connection with any goods or services, as a legitimate trade mark owner would.

The Respondent's complete lack of any registration and lack of even an attempt to register such rights in "HONGKONGLOAN" and "HONGKONGCARD" demonstrates that the Respondents in fact has no legitimate rights in the marks and in the Disputed Domain Names.

**(iii) The Disputed Domain Name has been registered and is being used in bad faith**

In relation to the element of bad faith, the Respondent has registered the eight (8) domain names in order to prevent the Complainant, who is the owner of the service mark from reflecting the mark in a corresponding

domain name, and that the Respondent has engaged in a pattern of such conduct.

Bad faith is imputed as the Respondent has registered the Disputed Domain Names primarily for the purpose of disrupting the business of a competitor. By using the Disputed Domain Names, 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 registration and use of a domain names corresponding to or similar to the service marks of an established company, such as the Complainant, in order to direct users to the site or to misdirect traffic to other websites constitutes bad faith.

Even if, *arguendo*, the Respondent obtained registration for marks "HONGKONGLOAN" or "HONGKONGCARD", it is established in other common law jurisdictions that "although there is no source confusion in the sense that consumers know they are patronizing [the junior user] rather than [the senior user], there is nevertheless initial interest confusion in the sense that, by using [the senior user's mark] to divert people looking for [the senior user's goods] to its web site, [the junior user] improperly benefits from the goodwill that [the senior user] developed in its mark." See *Brookfield Communications, Inc. v. West Coast Entertainment Corp.* 174 F.3d 1036, 1062 (9th Cir. 1999)

Well-established trade mark law also recognizes that using another's trade mark in order to confuse consumers into visiting a website that is unaffiliated with the trade mark owner also constitutes trade mark infringement, even if the customer realizes that there is no connection with the trade mark owner by the time he or she actually makes a purchase. See *Playboy Enters., Inc. v. Netscape Communications Corp.*, 354 F.3d 1020, 1025 (9th Cir. 2004).

Respondent has registered the Disputed Domain Names in a manner calculated to improperly trade on the goodwill of the Complainant's trade marks, and such use constitutes trade mark infringement.

Given the Complainant's longstanding use of its marks "HONGKONGLOAN" and "HONGKONGCARD", its websites at www.hongkongoan.com and www.hongkongcard.com, and its position as a leader in the for-profit issuer-applicant matching business, the Respondent must have been well aware of the association of the Complainant's marks with the Complainant and of the goodwill associated with the Complainant's marks when it registered and began using the disputed Domain Names in 2015. Evidence present in the record, including but not limited to the Respondent's e-mail communications with the Complainant, also demonstrate that Respondent was fully aware of the Complainant's competitive advantages in the business.

**The Respondent's registration of the Disputed Domain Name disrupted the business of the Complainant**

There is no evidence indicating that the Respondent has registered the Disputed Domain Names primarily for the purpose of selling, renting, or otherwise transferring the Disputed 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.

There is no doubt that the registration of the Disputed Domain Names has effectively prevented the owner of the trademarks "HONGKONGLOAN.COM" and HONGKONGCARD.COM" in Hong Kong from reflecting the marks in a corresponding domain name. The Respondent has engaged in a pattern of such conduct because the Respondent has registered a number of domain names substantially identical to the marks "HONGKONGLOAN.COM" and "HONGKONGCARD.COM", including the following domain names all re-directing to the Respondent's site at MONEYHERO.COM:

1. HONGKONGCARD.HK
2. HONGKONGLOAN.HK
3. HONGKONGLOAN.ORG
4. HONGKONGCARD.ORG
5. HONGKONGCARD.NET
6. HONGKONGCARD.CO
7. HONGKONGLOAN.NET
8. HONGKONGLOAN.CO

B. Respondent

The Respondent has not filed any submission within the prescribed time.

## 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 Complainant 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

The distinctive part of the Disputed Domain Names are "hongkongcard" and "hongkongloan", which are quite similar to the registered trademarks of the Complainant in Hong Kong, which is a composite of a device and "HONGKONGCARD.COM" and "HONGKONGLOAN.COM". For the purpose of UDRP, the design elements of a registered trademark shall be largely disregarded. (*See WIPO Jurisprudential Overview 3.0*) The date of the trademark registrations in Hong Kong pre-dates the date of registration of the

Disputed Domain Names by a few years. The Complainant has been marketing and promoting its services using the websites www.hongkongcard.com and www.hongkongloan.com for more than a decade in Hong Kong and has since acquired reputation. As such, with no evidence to the contrary, I am satisfied that the Complainant has civil rights or interests in the marks "hongkongcard" & "hongkongloan", and that such distinctive part of the Disputed Domain Names are confusingly similar to such marks.

**B) Rights and Legitimate Interests**

The Complainant, as the registrant of two trademark registrations, submitted that it has never licensed or granted any rights to the Respondent. The Respondent has the burden of proof to establish that it has rights or legitimate interests in the Disputed Domain. However, since the Respondent defaulted in contesting the Complainant's allegations, with no evidence to the contrary, I accept the Complainant's submissions that:

(1) the Respondent's use of the Disputed Domain is not in connection with a bona fide offering of goods or services;

(2) the Respondent has not been commonly known by the Disputed Domain Name, but the Complainant; Further there has been no evidence to show that the Respondent has acquired any trademark or service mark rights and/or reputations in connection with the mark.

I am therefore satisfied that the Respondent has no rights or legitimate interest to register and use the Dispute Domain Names.

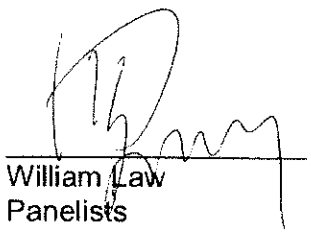
**C) Bad Faith**

According to the materials submitted by the Complainant, the registration of the Disputed Domain Names was due to an aborted business buyout. The Complainant also asked the panelist to rule on trademark infringement. Although it is very attractive for a panelist to make ruling on trademark infringement, it is not the original design of ICANN to allow panelists to make any findings other than Paragraph 4(a) of UDRP for many good reasons. I am therefore not empowered to embark a mini trial on trademark infringement. I do not rely heavily on the email communication evidence submitted by the Complainant as the subject matter is not relevant. But, I am satisfied that the Respondent, also a company incorporated in Hong Kong, should be well aware of the business of the Complainant at the time of registration of the Disputed Domain Names.

In addition, the Disputed Domain Names re-direct visitors to www.moneyhero.com.hk , a commercial website which the Complainant has no dealings with. As such, I am satisfied that the Respondent has registered and is using the Disputed Domain Names in bad faith with an intention to create confusion amongst consumers to attract them to his website.

## 6. Decision

In conclusion, the Complainant has satisfied all the 3 grounds laid down in Article 4(a) of the ICANN Policy. I therefore order that the Dispute Domain Names **< hongkongcard.co >, < hongkongcard.net >, < hongkongcard.org >, < hongkongloan.co >, < hongkongloan.net > & < hongkongloan.org >** be **transferred** to the Complainant.



William Law
Panelists
Date: October 16, 2017