



(Hong Kong Office)

**ADMINISTRATIVE PANEL DECISION**

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<b>Case No.</b>	<b>HK-1701040</b>
<b>Complainant:</b>	<b>Fubon Financial Holdings Co., Ltd (富邦金融控股股份有限公司)</b>
<b>Respondent:</b>	<b>Domain Admin, Domain Privacy Guard Sociedad Anónima Ltd.</b>
<b>Disputed Domain Name(s):</b>	<b>&lt;fubonbank.com&gt;</b>

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**1. The Parties and Contested Domain Name**

The Complainant is Fubon Financial Holdings Co., Ltd (富邦金融控股股份有限公司), of No.237, Section 1, Jianguo South Road, Da'an District, Taipei Taiwan (中国台湾台北市大安区建国南路 1 段 237 号).

The Respondent is Domain Admin, Domain Privacy Guard Sociedad Anónima Ltd. of #729, AZ Business Center, Avenida Perez, Chitre, Panamá, Panama 0395.

The domain name at issue is fubonbank.com registered by Respondent with PDR Ltd. d/b/a of PublicDomainRegistry.com ("Registrar").

**2. Procedural History**

On 10 November 2017, the Complainant filed a Complaint in this matter with the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre ("ADNDRC-HK"). On 13 November 2017, the ADNDRC-HK confirmed receipt of the Complaint and requested the Complainant to submit the case filing fee.

On 13 November 2017, the ADNDRC-HK notified the Registrar of the Disputed Domain Name of the proceedings by email.

On 14 November 2017, the Registrar acknowledged the email of ADNDRC-HK confirming that the Disputed Domain Name is registered with the Registrar, that Domain Admin, Domain Privacy Guard Sociedad Anónima Ltd. is the holder of the Disputed Domain Name, that the Internet Corporation for Assigned Names and Numbers Uniform Domain Name Dispute Resolution Policy ("the Policy") is applicable to the Disputed Domain Name, the language of the Disputed Domain Name is English as provided by the WHOIS information in relation to the Disputed Domain Name and confirmed that the Disputed Domain Name is under Registrar lock status.

On 24 November 2017, the ADNDRC-HK sent a Written Notice of Complaint (“Notification”), together with the Complaint, to the email address of the Respondent’s nominated registrant contact for the Disputed Domain Name (as recorded in the WHOIS database). The Notification gave the respondent twenty (20) calendar days to file a Response (i.e. on or before 14 December 2017).

The Panel comprising of Dr. Shahla F. Ali as a single panelist was appointed by the ADNDRC-HK on 28 December 2017. The papers pertaining to the case were delivered to the Panel by email on the same day.

### **3. Factual background**

The Complainant, Fubon Financial Holdings Co., Ltd (富邦金融控股股份有限公司) contends that it was founded in 1961 and that after over thirty years’ development, the Complainant and its Fubon marks have achieved a high reputation in the financial services industry. At present, the Complainant contends that it has become a first-class financial institution in Asia, whose business scope covers various financial services, including but not limited to insurance services, banking services, security services, etc. Its major subsidiaries include Fubon Life, Taipei Fubon Bank, Fubon Bank (HK), Fubon Bank (China), Fubon Insurance, Fubon Securities.

In addition, the Complainant claims that it owns trademark registrations for the “Fubon” trademark in various jurisdictions including in Taiwan, China and the U.S.A. Among the Fubon trademarks, the Complainant first registered its “Fubon” mark in Taiwan on 1 February 1992.

The Respondent, Domain Admin, Domain Privacy Guard Sociedad Anónima Ltd., registered the disputed domain name on 3 June 2000. The Respondent did not file a Reply with the ADNDRC-HK.

### **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 claims that it owns prior trademark rights in the “Fubon” trademark in various jurisdictions in Asia and North America. For instance, it obtained its registration for the “Fubon” trademark in Taiwan on 1 February 1992 and in the U.S.A. on 6 April 1999, long before the registration date of the Disputed Domain Name.

The Complainant claims that the identifier of the Disputed Domain Name < fubonbank.com > is “fubonbank” and that given that 1) the “fubon” part of the domain is identical to the Complainant’s Fubon marks; 2) “bank” is an English word and it is not distinctive; and 3) the Complainant’s Fubon marks are used on

various financial services, including banking services, therefore, the composition of “fubonbank” will easily cause confusion regarding the origin of the services amongst the relevant public or confuse the public into mistakenly thinking that there is affiliation between the Complainant and the Respondent.

The Complainant also contends that according to the announcement issued by Hong Kong Monetary Authority on October 4, 2017, the disputed domain name was previously reported by Fubon Bank (Hong Kong) Limited (a subsidiary of the Complainant in Hong Kong) as being suspected of comprising a fraudulent website.

- ii. The Respondent has no rights or legitimate interests in respect of the domain name:

The Complainant claims that the Disputed Domain Name was registered by the Respondent on 2 June 2000, long after most application and registration dates of its “Fubon” trademarks. It contends that its Fubon trademarks have acquired significant online recognition in Asia, North America and Europe. The Complainant claims that it has no prior connection with the Respondent, nor has it authorized the Respondent to use its mark in the Disputed Domain Name.

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

The Complainant claims that the bad faith can be shown based on the following grounds: 1) the long history and high degree of fame enjoyed by the Complainant and its trademarks, including in East Asia, China and North America; 2) the filing dates of the Complainant’s marks long before the registration date of the Disputed Domain Name; 3) the incorporation of the Complainant’s well known trademark in its entirety in the Disputed Domain Name and 4) that according to the announcement issued by Hong Kong Monetary Authority on October 4, 2017, the disputed domain name was previously reported by Fubon Bank (Hong Kong) Limited (a subsidiary of the Complainant in Hong Kong) as being suspected of comprising a fraudulent website. More specifically, the website held itself out as the official website of Fubon Bank (Hong Kong) Limited, which is the subsidiary of the Complainant in Hong Kong with the official website [www.fubonbank.com.hk](http://www.fubonbank.com.hk).

## B. Respondent

The Respondent’s contentions may be summarized as follows:

The Respondent did not submit a 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 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 Complainant has established its right to the "Fubon" trademarks by submitting trademark registration certificates and records in a number of jurisdictions including in Taiwan, the United States and Mainland China. The disputed domain name <fubonbank.com> contains three elements: "fubon" and "bank" and top-level domain "com". Numerous UDRP precedents have established that the top-level domain does not have trademark significance, conferring no distinctiveness to the domain name sufficient to avoid user confusion. Similarly, "bank" is not a distinctive word and is merely descriptive. The addition of this term does nothing to minimise the risk of confusion. There is a long line of authorities on the UDRP which make it clear that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.

The only distinctive part of the disputed domain should be "fubon", which is identical to the Complainant's "Fubon" trademark and trade name. This striking resemblance will no doubt mislead consumers into believing that the website is operated by or associated with the Complainant. There is no doubt that the Disputed Domain Name < fubonbank.com > completely incorporates the Complainant's "Fubon" trademark which is the distinctive part of the Disputed Domain Name, and such incorporation makes the Disputed Domain Name confusingly similar with the Complainant's trademark.

In conclusion, the Panel finds that the Complainant has satisfied the Paragraph 4(a)(i).

#### **B) Rights and Legitimate Interests**

As the owner of the "Fubon" trademarks, the Complainant has confirmed that it has no prior connection with the Respondent in any way, nor has it authorized the Respondent to use its trademarks in the Disputed Domain Name.

In determining whether the Respondent has any legal right and interest in the Disputed Domain Name, the mere registration of the Disputed Domain Name by the Respondent itself is not sufficient to prove that it owns legal rights and interests thereof; otherwise, "all registrants would have such rights or interests, and no complainant could succeed on a claim of abusive registration" - See: Adobe Systems Incorporated v. Domain OZ, WIPO Case No.: D2000-0057.

In the present case, the Respondent failed to provide evidence indicating that it has been commonly known by the Disputed Domain Name, nor has been making a legitimate noncommercial or fair use thereof.

In conclusion, the Panel finds that the Complainant has satisfied the Paragraph 4(a)(ii).

#### **C) Bad Faith**

In determining whether the Respondent has registered or used the Disputed Domain Name in bad faith, paragraph 4(b) of the Policy sets down four (4) factors which the Panel will need to examine. The four (4) factors are as follows:

“Evidence of Registration and Use in Bad Faith. For the purposes of Paragraph 4(a)(iii), 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 you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your web site or location or of a product or service on your web site or location.”

Given the extensive reputation of Fubon Bank in Asia and North America, the Respondent must have been aware of the Complainant's prior rights and interest in the Disputed Domain Name given the Complainant's reputation in the mark “Fubon” as of the date that the Respondent registered the Disputed Domain Name.

According to the Complainant, The Hong Kong Monetary Authority issued an announcement on October 4, 2017, noting that the disputed domain name was previously reported by Fubon Bank (Hong Kong) Limited (a subsidiary of the Complainant in Hong Kong) as being suspected of comprising a fraudulent website. More specifically, the website presented itself as the official website of Fubon Bank (Hong Kong) Limited, which is the subsidiary of the Complainant in Hong Kong with the official website [www.fubonbank.com.hk](http://www.fubonbank.com.hk). The fact that the website featured the name “Fubon” in relation to a website bearing the Complainant's registered trademarks, makes it clear that the Respondent knew of the Complainant's trademark and registered the Disputed Domain Name in an attempt to attract internet traffic to the website on the mistaken belief that it is associated with the Complainant's business.

No evidence has been provided showing that the Respondent sought the permission of the Complainant to use its mark, nor any evidence showing that the Complainant gave such permission to the respondent.

Given the above findings, the Panel is of the view that the Respondent registered and used the contested domain name in bad faith.

## **6. Decision**

Pursuant to Paragraph 4(i) of the Policy and Article 15 of the Rules, the Panel orders that the disputed domain name < fubonbank.com > be transferred to the Complainant.

/s/ Shahla F. Ali

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Dr. Shahla F. Ali  
Panelist

Dated: 8 January 2018