



Asian Domain Name Dispute Resolution Centre

hong kong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.:	HK-2001374
Complainant:	Tencent Holdings Limited
Respondents:	Livon Biswas / Shubhankar Ghosh
Disputed Domain Names:	<midasbuy.live> <midasbuy.club>

1. The Parties and Contested Domain Names

The Complainant is Tencent Holdings Limited (“**Complainant**”), of P.O. Box 2681 GT, Century Yard, Cricket Square, Hutchins Drive, George Town, Grand Cayman, Cayman Islands.

The Respondents are Livon Biswas, of Pathuriya, Bangaon, West Bengal, 743297, India and Shubhankar Ghosh, of Parmadan N24PGS, Bongaon, West Bengal, 743297 India (collectively “**Respondents**”).

The domain names at issue are <midasbuy.live> and <midasbuy.club> (“**Disputed Domain Names**”), registered by Respondents with GoDaddy.com, LLC (“**Registrar**”), of 14455 N North Hayden Rd, Suite 219, Scottsdale AZ 85260, United States.

2. Procedural History

On 20 July 2020, the Complainant filed a Complaint involving the Disputed Domain Names <midasbuy.live> and <midasbuy.club> with the Hong Kong Office of Asian Domain Name Dispute Resolution Centre (“**Centre**”), pursuant to the Uniform Domain Name Dispute Resolution Policy (“**Policy**”) approved by the Internet Corporation for Assigned Names and Numbers (“**ICANN**”) on 24 October 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (“**Rules**”), approved by ICANN Board of Directors on 28 September 2013 and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (“**Supplemental Rules**”) effective from 31 July 2015.

On 21 July 2020, the Centre transmitted by email to the Registrar a request for confirmation of the WHOIS records of the Disputed Domain Name and other related information.

On 18 August 2020, the Registrar confirmed by email that it is the registrar of the Disputed Domain Names that were registered by the Respondents; and that the Policy is applicable

to the dispute relating to the Disputed Domain Names and the language of the Registration Agreement of the Disputed Domain Names is English and provided to the Centre the Respondents' email addresses and other WHOIS information of the Disputed Domain Names.

The Centre noted from the Registrar that the Disputed Domain Names were registered by two registrants respectively and informed the Complainant of the same. The Complainant requested the Centre to proceed with the complaint filed against two different Respondents and provided supporting documents to argue that the Disputed Domain Names were under common control. The Centre granted the Complainant's request based on the *prima facie* evidence provided by the Complainant and the Centre invited the Respondents to comment on this matter. The Respondents did not comment on this matter.

On 27 August 2020, in accordance with Articles 2(a) and 4(a) of the Rules, the Centre issued a Written Notice of the Complaint and formally notified the Respondent of the commencement of the proceedings in this dispute. In accordance with Article 5(a) of the Rules, the due date for the Respondents to submit a Response to the Complaint was 16 September 2020.

On 17 September 2020, the Centre issued a notification of the Respondent in Default, confirming that the Centre did not receive response forms from the Respondents in respect of the complaint concerning the Disputed Domain Names within the required time. One of Respondents, Shubhankar Ghosh, responded to the Complaint.

On 21 September 2020, the Centre appointed Ms. Nathalie Dreyfus as the sole panelist of the Panel in this matter. Prior to the appointment, the said sole panelist had submitted to the Centre her Statement of Acceptance and Declaration of Impartiality and Independence in compliance with Article 7 of the Rules.

A URS decision for URS Dispute (No. 7AAFBC12) was issued on July 17, 2020 for one of the Disputed Domain Names, i.e., <midasbuy.live>. Complainant has not commenced any other legal proceedings in respect of the other Disputed Domain Name, i.e., <midasbuy.club>.

3. Factual background

Complainant is Tencent Holdings Limited, a video game company, founded in 1998. It developed MidasBuy, a top-up center for video games, music, videos and other entertainment. Complainant uses the MidasBuy as a platform to develop other services.

Complainant has developed its platform through the website <https://midasbuy.com> that had an average monthly visit of more than 2 million, during the period from January to June 2020, and is the 5,932nd most popular website in India.

Complainant is the owner of the following trademarks:

- Hong-Kong figurative "MIDASBUY" trademark No. 305112053, of November 13, 2019 and registered in classes 35 and 36;
- Hong-Kong figurative "MIDASBUY" trademark No. 305119669, of November 21, 2019 and registered in class 42;

- EU figurative “MIDASBUY” trademark No. 018150428, of March 12, 2020 and registered in classes 35 and 36;
- EU figurative “MIDASBUY” trademark No. 018154572, of March 13, 2020 and registered in class 42;
- Indian figurative “MIDASBUY” trademark No. 4357373, filed on November 25, 2019, that is currently in status “accepted and advertised”, in classes 35 and 36;
- Indian figurative “MIDASBUY” trademark No. 4357374, filed on November 25, 2019, that is currently in status “accepted and advertised”, in class 42.

Complainant also owns several domain names such as <midasbuy.com> registered on June 5, 2018.

Respondents are Shubhankar Ghosh and Livon Biswas, respectfully the owners of the Disputed Domain Names <midasbuy.club> and <midasbuy.live>, respectively registered on June 20, 2020 and June 18, 2020 for a one year-period.

4. Parties’ Contentions

A. Complainant

The Complainant’s contentions can be summarized as follows:

- i. The disputed domain names are identical or confusingly similar to a trademark or a service mark in which the Complainant has rights:

Complainant states that it owned MIDASBUY figurative trademarks. It also argues that a figurative trademark cannot be reproduced in a disputed domain name, besides its figurative trademarks are mainly composed of the “MIDASBUY” sign, which is the textual element exclusively reproduced in the Disputed Domain Names.

Furthermore, Complainant argues that the TLDs should not be taken into consideration to establish the risk of confusion when comparing the Disputed Domain Names with Complainant’s trademark.

In addition, Complainant alleges that the past use of the Disputed Domain Name <midasbuy.live> and the current use of the Disputed Domain Name <midasbuy.club> contribute to the confusion with its trademark. They were or are resolving to a website that reproduce Complainant’s official website, which necessarily increase consumers’ confusion.

Considering the above elements, Complainant argues that the Disputed Domain Names are identical to its prior trademarks.

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

Complainant alleges that since it owned MIDASBUY trademarks, it benefits from an exclusive right to use this sign in connection with the designated goods and services.

Complainant also argues that Respondents are not sponsored by nor affiliated with Complainant in any manner, and that it did not give permission to register the Disputed Domain Names.

In addition, Complainant states that Respondents are not commonly known by the disputed domain names, which shows that they do not benefit from any legitimate interests. Furthermore, Respondents cannot claim that their names are somehow related to the Disputed Domain Names, in order to justify any legitimate interests.

Moreover, Complainant alleges that prior to the suspension of the Disputed Domain Name <midasbuy.live>, it was resolving to a website reproducing Complainant's official website. Once it has been suspended, following the URS decision, it redirected to <midasbuy.club> to the same copy of the official website. These replicas of Complainant's official website were obviously designed to make internet users believe that the Disputed Domain Names were linked to Complainant. Such a use of the Disputed Domain Names could not be seen as a *bona fide* offering of goods and services or a legitimate noncommercial or fair use.

Complainant also indicated that it owned trademarks rights (at least in the European Union and Hong Kong) in the sign MIDASBUY prior to the registration of the Disputed Domain Names, also in its main <midasbuy.com> domain name. It also argues that it filed Indian MIDASBUY trademarks prior to the Disputed Domain Names' registration.

Complainant concludes that Respondents have no rights or legitimate interests in the Disputed Domain Names.

iii. The disputed domain names have been registered and are being used in bad faith:

Complainant first points out that it owned trademark rights in the MIDASBUY sign across the world, prior to the Disputed Domain Names' registration.

Thus, Complainant considers that Respondents registered the Disputed Domain Names with the knowledge of Complainant's business. Respondents registered the Disputed Domain Names that reproduce identically the MIDASBUY trademark and the Complainant's <midasbuy.com> domain name to initially resolve to a website that was reproducing Complainant's official website. Consequently, this action implies bad faith.

Furthermore, Complainant states that Respondents are using the Disputed Domain Names in bad faith. First, both Disputed Domain Names were pointing to a website that was reproducing Complainant's official website, therefore creating a likelihood of confusion and attempting to profit from the latter. Respondents thus use the fame of the Complainant's trademark to improperly increase traffic to the Disputed Domain Names for commercial gain. Such use constitutes bad faith.

Complainant argues that it is not a use in good faith and considers the Disputed Domain Names have only been registered in order to cause confusion among internet users.

Thus, Complainant states that Respondents registered and used the Disputed Domain Names in bad faith.

B. Respondent

The Respondent's contentions can be summarized as follows:

Only one of the Respondents, i.e., Shubhankar Ghosh, answered to the Complaint, namely the Disputed Domain Name <midasbuy.club>'s registrant.

First, it stated that the website did not belong to him, without indicating to which Disputed Domain Name he was referring. However, he indicated that he was the "buy hosting" of the second registrant, i.e., Livon Biswas.

The same Respondent, i.e., Shubhankar Ghosh, then sent another email confirming that it deleted "all websites" and arguing that he was creating websites for the second registrant, i.e., Livon Biswas. He requested to close the file since he deleted "the website". It finally sent another email "*im buy the domain buy web site is not my*" that could be translated as "I bought the domain but the website is not mine".

Finally, on September 22, 2020, Respondent, i.e., Shubhankar Ghosh, sent an email indicating that he wished either to transfer the domain name or to delete it.

The second Respondent, i.e., Livon Biswas, did not respond to Complainant's contentions and is therefore in default.

5. Findings

Preliminary matter: multiple Respondents

"Where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties" (WIPO Case No. D2019-0117, *WhatsApp Inc., Instagram, LLC v. Naim Wekking, Jack Worli*).

In this case, Complainant has duly shown the Respondents were linked and in control of the Disputed Domain Names. The connection between the individuals that have been identified as Respondents in the Whois information is established: the Disputed Domain Names have been registered two days apart; Respondents are located very close to each other; the composition of the Disputed Domain Names is the same; they are registered with the same Registrar; they were pointing to a similar website. Furthermore, once the URS decision has been rendered against the disputed domain name <midasbuy.live>, the litigious website was deleted and the said domain name redirected through the other Disputed Domain Name <midasbuy.club>.

Furthermore, the only Respondent who replied to the Complaint, after Complainant submitted the amended Complaint confirmed that it had the control on the websites since he created the websites for his own domain name and for the other Respondent. The litigious websites linked to the Disputed Domain Names are not controlled by the same person.

Panel considers it is fair to consolidate Respondents, for the following reasons:

- Complainant showed there were close similarities in the Whois information between the Respondents;
- The Disputed Domain Names have been registered few days one after the other;
- The Disputed Domain Names are or were initially pointing to the same websites;
- The Disputed Domain Name <midasbuy.live> started to redirect through the other Disputed Domain Name <midasbuy.club> once the URS decision was rendered;

- One of the Respondents admitted that it was involved with the two websites, even if it was not the registrant of both of them.

Complainant requested the consolidation of the Respondents. Based on the procedural economy and as the consolidation is fair and equitable, the Panel therefore finds that the consolidation of this Complaint is justified.

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

Panel finds that Complainant has duly shown that he owns trademark rights in the MIDASBUY sign.

Firstly, Complainant showed it owned rights in the MIDASBUY sign, at least in Hong Kong and the European Union, and that it filed Indian trademarks that should be registered soon.

Furthermore, Complainant has also showed he owns the <midasbuy.com> domain name.

All rights of Complainant predate the Disputed Domain Names' registration.

Secondly, it is commonly considered that a Top-Level Domain ("TLD"), such as ".club" or ".live" shall be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark (see section 1.11 of the WIPO Overview 3.0). Previous Panels have considered as a rule that the addition of a TLD do not prevent a finding of confusing similarity (See for example WIPO Case No. D2019-0657, *Sanofi v. Jamey Kirkes* : "*The disputed domain name is identical to the Complainant's trademark SANOFI but for the gTLD ".dev", which is typically to be disregarded for the purpose of comparison.*").

Thirdly, the Disputed Domain Names <midasbuy.live> and <midasbuy.club> reproduce the Complainant's trademark identically and exclusively.

In accordance with Paragraph 4(a)(i) of the Policy, the Panel finds that the Disputed Domain Names are identical to Complainant's trademark.

B) Rights and Legitimate Interests

Complainant must first make a *prima facie* case that Respondents lack the rights and legitimate interests in the disputed domain names under Paragraph 4(a)(ii).

Complainant has duly demonstrated that he did not give any authorization or license to Respondents neither to use the MIDASBUY sign nor to register the Disputed Domain Names and that Respondents are not commonly known under the MIDASBUY sign. None of the information provided in the Whois of the Disputed Domain Names refers to this sign.

Furthermore, the Respondent that answered to the Complaint did not show he has rights or legitimate interests in the MIDASBUY sign, and the other Respondent is in default as he did not answer to the Complaint. Therefore, regarding those elements, Respondents have not demonstrated they have any rights or legitimate interests.

On the other side, Panel finds that there is no *bona fide* offering of goods and services or legitimate noncommercial or fair use. Initially, both Disputed Domain Names were resolving to a website imitating the Complainant's official website. Prior to this Complaint, Complainant filed a URS complaint against the Disputed Domain Name <midasbuy.live>. Following the decision, the website has been deleted and the said Disputed Domain Name started to redirect to the other Disputed Domain Name, <midasbuy.club>, which was still used for the same website.

A previous Panel has already stated that "*The disputed domain name incorporates the Complainant's trademarks and the website associated with the disputed domain name is used to sell products, in the course of commercial activity, under the Complainant's trademarks and imitating the Complainant's original website*" (WIPO Case No. D2019-3201, *BA&SH v. Domain Administrator, See PrivacyGuardian.org / Name Redacted*).

The Disputed Domain Names were or are offering paid services when imitating Complainant's official website. Those foregoing elements cannot be indicative of a *bona fide* offering of goods and services or a legitimate non commercial or fair use.

Thus, Panel finds that Complainant has established a *prima facie* case that Respondents lack the rights and legitimate interests in the Disputed Domain Names pursuant to Paragraph 4(a)(ii) of the Policy.

C) Bad Faith

Paragraph 4(a)(iii) of the Policy requires Complainant to demonstrate that the Disputed Domain Names were registered and are being used in bad faith.

Firstly, Complainant has duly shown its rights in the MIDASBUY sign and its reputation in the video games' field of activity.

Furthermore, the Disputed Domain Names were initially both imitating almost identically Complainant's official website. Once the website related to the Disputed Domain Name <midasbuy.live> was deactivated, it started redirecting to the second Disputed Domain Name which was still pointing to a website imitating almost identically Complainant's official website.

Panel considers that the Disputed Domain Names were registered in bad faith. Respondent had necessarily Complainant's business in mind and registered the Disputed Domain Names to benefit from Complainant's reputation and divert Internet users.

Panel therefore finds the Disputed Domain names were registered in bad faith.

Secondly, the Disputed Domain Names are or were pointing to a website imitating Complainant's official website for commercial gain. Indeed, it appears that Internet users were invited to register and to pay for some services. Respondents were therefore benefiting from Complainant's reputation in order to earn money.

Benefiting from Complainant's reputation for commercial gain is mainly considered by previous Panels as a use in bad faith. See for example : WIPO Case No. 2019-2134, *Birdies, Inc. v. Registration Private, Domains By Proxy, LLC / Fu Li* : *"the Respondent sought to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's BIRDIES trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website and the products purportedly offered therein, amounting to bad faith within the meaning of paragraph 4(b)(iv) of the Policy"*.

Such a use could not be considered as a use in good faith.

Furthermore, Respondents knew about the URS proceedings against the Disputed Domain Name <midasbuy.live> and about Complainant's rights. Once the website deactivated, the second Disputed Domain Name was used for a website imitating Complainant's official one. At this time, Respondents intentionally wished to keep the link to a litigious website.

Such a redirection in full knowledge of Complainant's rights is not a use in good faith.

Finally, neither Respondent tried to justify any rights or use in good faith, nor did Respondent who answered lately to the Complaint tried to proof any use in good faith.

Therefore, Panel finds that the Disputed Domain Names are used in bad faith.

Complainant has, therefore, satisfied the requirements of Paragraph 4(a)(iii) of the Policy.

6. Decision

For the foregoing reasons, in accordance with Paragraph 4(i) of the Policy and Paragraph 15 of the Rules, the Panel orders that the Disputed Domain Names must be transferred to the Complainant.

Nathalie Dreyfus
Panelist

Dated: October 12, 2020

