



Hong Kong International Arbitration Centre

香港國際仲裁中心

**.hk Domain Name Dispute Resolution**

**ARBITRATION PANEL DECISION**

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<b>Case No.</b>	0107-0002
<b>Complainant:</b>	Lycos Asia (HK) Limited
<b>Respondent:</b>	Times Agency

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**1. THE PARTIES AND CONTESTED DOMAIN NAME**

The Complainant is **Lycos Asia (HK) Limited**, a company with a registered office at 12/F, New World Tower 2, 18 Queen's Road Central, Hong Kong.

The Respondent is **Times Agency**, a firm with an address at Room 1415, Hollywood Plaza, 610 Nathan Road, Mongkok, Kowloon, Hong Kong, operated by one Lei Soi Iong.

The contested domain name is "**www.lycos.com.hk**".

**2. PROCEDURAL HISTORY**

A Complaint in this matter was filed with the Hong Kong International Arbitration Centre (HKIAC) on 20 July 2001. A Response from the Respondent was not received by the HKIAC within the required period of time. On 23 August 2001 the HKIAC contacted Peter Bullock enquiring as to his availability to act as an arbitrator in this matter. On 24 August 2001 Mr. Bullock confirmed his availability.

The parties were given 7 days to object to Mr. Bullock's appointment. No adverse comment having been received from the parties, Mr. Bullock's appointment was confirmed on 1 September 2001. The Form A Complaint and supporting documents were sent to the Panel on 3 September 2001.

**3. FACTUAL BACKGROUND**

The Complainant is the local subsidiary company of a US corporation named Lycos, Inc. ("Lycos, Inc.") which has a licence (dated 16 June 1995) from Carnegie Mellon University for the perpetual worldwide use of the trade mark "Lycos". The Lycos trade mark has been widely registered in various jurisdictions. There are also pending trade mark applications for the trademark "Lycos" in Clauses 9 and 42 of the Hong Kong Trade Marks Registry.

The trade mark applications in Hong Kong were made on behalf of Carnegie Mellon University (as Applicant) as far back as 7 October 1997. They have not progressed to completion. Lei Soi Iong (the individual behind the Respondent firm herein) filed two trade mark applications for "Lycos, lycos, LYCOS" in Classes 1 and 38 on 21

March 2000 and 3 May 1999 respectively. The Complainant alleged that the Respondent's "Lycos, lycos, LYCOS" applications were filed solely to substantiate its right to use its registration of the lycos.com.hk domain name. The Complainant alleges that Lei Soi Iong had no intention to use the purported "Lycos, lycos, LYCOS" trade marks but merely to use them to establish a basis upon which he could claim a legitimate right to the Domain Name. In the event, and following Opposition filed by Carnegie Mellon University to Lei Soi Tong's trade mark applications both "Lycos, lycos, LYCOS" applications were withdrawn.

#### **4. PARTIES' CONTENTIONS**

The Complainant contends (1) that the Respondent has no legitimate right to use and register the trade mark 'Lycos' and the domain name lycos.com.hk in Hong Kong and (2) that the Respondent has registered the said domain name in bad faith so as to prevent the legitimate owner and user to use and register its domain name in Hong Kong.

The Respondent has not filed any Response to the allegations in the Complaint.

#### **5. DISCUSSION AND FINDINGS**

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "An Arbitration Panel shall decide a Complaint on the basis of the statements and documents submitted to it and in accordance with the Dispute Resolution Policy, the Rules of Procedure, the Provider's Supplementary Rules and the law which the Arbitration Panel deems applicable". In view of the registered addresses of the parties and the Hong Kong country code domain involved, the Panel shall apply the rules and principles set out in decisions of the Courts of Hong Kong.

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

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

On the basis of the papers first submitted herein the Panel finds that:

- iv. the disputed domain name is identical to a trade mark in Hong Kong in which Lycos, Inc. has rights. The disputed domain name wholly incorporates and is identical to Carnegie Mellon University's trademark "Lycos" and also Carnegie's domain name "lycos.com" save for the geographical designation ".hk";
- v. the Complainant has alleged and the Respondent has failed to deny that the Respondent has no legitimate interests in respect of the domain name at issue. In addition, the Panel has been unable to independently discern any legitimate interest in respect of the domain names at issue;

- vi. the Respondent has failed to deny the Complainant's allegation that the Respondent's trade mark applications for "Lycos, lycos, LYCOS", which have in any event been withdrawn, and which are the only evidence before the Panel of use of the disputed domain name, was a bad faith attempt to justify the Respondent's registration of the disputed domain name. Following Lycos, Inc.'s Complaint against the Respondent's registration of the disputed domain names in Hong Kong on 15 October 1999, the HKNIC has put the use of the disputed domain name on "Hold" status (neither the date that the disputed domain name was originally registered nor the date that it was put on "Hold" is known to the Panel). In the absence of any representation or submission by the Respondent within these proceedings or otherwise as to the absence of 'bad faith', the Panel finds sufficient evidence of bad faith in registration and use of the disputed domain name.

In light of the above, and as the Complainant is Lycos Asia (HK) Limited, not Lycos, Inc. the Panel on 7 September 2001 (pursuant to clauses 10(a) and (b) of the Rules) gave the parties an opportunity to supply documents addressing the following issues:

"whether Lycos Asia (HK) Limited is authorised to use the "lycos" trade mark in Hong Kong, and whether Lycos Asia (HK) Limited has established the lycos mark in Hong Kong."

The Panel imposed a deadline of 4:00 p.m. on 14 September 2001 which was extended, with respect to the Complainant, until 22 September 2001 at the request of those representing the Complainant.

A further submission was made on behalf of the Complainant on 22 September 2001.

This further submission contained inter alia copies of the following documents:

- vii. a certification on behalf of Lycos, Inc. by its Chief Executive Officer dated 21 September 2001 that Lycos Asia (HK) Limited is authorised to register and hold the disputed domain name, albeit for the ultimate benefit of Lycos, Inc.;
- viii. extracts from a Licence Agreement dated 15 November 1999 between Lycos, Inc. and Lycos Asia Pte Ltd. (now named Lycos Asia Limited ("LAL")) granting LAL (1) the right to use the Lycos marks inter alia in Hong Kong (as and when the marks are registered as trade marks), and (2) the right to grant sub-licenses; and
- ix. a letter agreement between the Complainant and LAL confirming that (1) LAL granted the Complainant a licence to use the "Lycos" trademark in Hong Kong and that (2) it will at all times deal with the disputed domain name according to the instructions given by Lycos, Inc.

The Complainant also submitted newspapers evidencing use in Hong Kong of the Lycos mark by those licensed by Carnegie Mellon University and copy documentation from the Hong Kong Intellectual Property Department showing that the specification for the "Lycos" trade mark application is acceptable and need not

be amended.

On the basis of the further submission by the Complainant I accept both that the Complainant is authorised to use the "Lycos" trade mark in Hong Kong and that there is sufficient evidence of established use of the "Lycos" mark in Hong Kong to justify granting this application.

## 6. **ARBITRATION DECISION**

For all the foregoing reasons, the Panel decides that the domain name lycos.com.hk registered by the Respondent is confusingly similar to the marks in which the Complainant has rights, that the Respondent has no rights or legitimate interests in respect of the domain names at issue, and that the Respondent's domain names have been registered and have been used (or but for the "Hold" order would be used) in bad faith. Accordingly, pursuant to Paragraph 4(h) of the Policy, the Panel requires that the registration of the domain name lycos.com.hk be transferred to the Complainant.

The Complainant's application for reimbursement of costs and disbursements is denied. The Complainant's attention is drawn to Article 15(5) of the HKIAC Supplemental Rules.

Peter Bullock  
Arbitrator Panelists

Dated: 5 October 2001