



香港國際仲裁中心  
Hong Kong International Arbitration Centre

**.hk Domain Name Dispute Resolution**  
ARBITRATION PANEL DECISION

Complainant: Expedia, Inc  
Respondent: Chan Chun Wai  
Case Number: DHK-0500009  
Contested Domain Name: www.expedia.hk  
Panel Member: Anthony Wu

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## **1 Procedural History**

On 16 November 2006, the Hong Kong International Arbitration Centre (“HKIAC”) received a Complaint form in hard copies filed by Expedia, Inc (the “Complainant”) pursuant to the Hong Kong Domain Name Registration Company Limited (“HKDNR”) Domain Name Dispute Resolution Policy (“the Dispute Resolution Policy”), the HKDNR Domain Name Dispute Resolution Policy Rules of Procedure (the “Rules of Procedure”) and the HKIAC Supplemental Rules (the “HKIAC Supplemental Rules”). On the same day, the HKIAC received payment for Domain Name Dispute Complaint fee in connection with the case. On 17 November 2005, the Respondent and HKDNR were notified of the Complaint. On 24 November 2005, the Respondent was notified of the commencement of the Proceedings and the Respondent was asked to submit a Response to the Complaint. By email of 8 December 2005, HKIAC confirmed that the due date to submit a response was 15 December 2005. A response was submitted by Respondent within the required period of time.

On 6 January 2006, HKIAC pursuant to the Dispute Resolution Policy, the Rules of Procedure and the HKIAC Supplemental Rules appointed Mr. Anthony Wu as the Panelist in respect of the above domain name. and notified the parties of the appointment. All documents submitted by the parties were sent to the Panelist by letter dated 6 January 2006.

## **2 Factual Background**

### For the Complainant

According to the Complainant: “The Complainant, EXPEDIA INC., is a well-known travel agency around the world. The Complainant’s predecessor-in-interest is Microsoft Corporation.

Since at least as early as October 1996, the Complainant has been using the inherent distinctive mark EXPEDIA, as well as EXPEDIA.COM, on or in connection with a wide variety of goods and services, most notably travel agency through the web site EXPEDIA.COM, including providing access to airline, hotel, and rental car reservations, and allowing users to

obtain special rates and deals for such services. In addition, the goods and services offered by the Complainant under its EXPEDIA mark include, but are not limited to, providing travel information over the Internet; providing information in the fields of entertainment and education via the Internet and wireless networks; on-line retail store services featuring travel-related goods and services; restaurant services; making hotel, resort and car reservation and bookings; on-line sale of tickets to entertainment and sporting events; on-line sale of entrance passes to entertainment, cultural and educational venues; providing bulletin board and chat room services over the Internet; stationery, desk sets, calendars and greeting cards; clothing such as shirts, sweaters, jackets, bathrobes and coats; and a variety of toys, games and sporting goods.

The Complainant owns numerous valid and subsisting valid and subsisting registrations for the EXPEDIA mark worldwide.”

In Hong Kong, the Complainant presently owns registration for EXPEDIA as a trade/ service mark for the following goods and services:

1. services for providing food and drink; temporary accommodation; reservation and booking services for temporary lodging and for businesses providing food and drink; all included in Class 43. The registration period is from 24/12/2004 to 24/12/2014; and
2. (a) computer software; computer software relating to geographic maps, travel route information and recommendations, and travel information guides; all included in Class 9, (b) travel agency services and ticketing services; provision of electronic information concerning travel and travel destinations; all included in Class 39, and (c) educational services relating to travel and travel destinations; all included in Class 41. The registration period is from 26/10/1998 to 26/10/2015.

The Complainant also owns registration for the EXPEDIA LODGING mark for travel agency services for making reservations and bookings for temporary lodging; all included in Class 42. The registration period is from 17/02/2001 to 17/02/2008.

#### For the Respondent

The Respondent is an individual. According to the Respondent he is “the owner of the domain name expedia.hk” since May 2004.

### **3 Parties' Contentions**

#### The Complainant

Complainant contends that “Long prior to the Respondent's registration of the disputed domain name, the Complainant adopted, and has continuously used since that adoption, the inherently distinctive EXPEDIA mark for EXPEDIA goods and services that include providing information on travel-related goods and services, and allowing users to obtain special rates and deals on such services. The Complainant does business primarily over the Internet and is the most successful travel service on the Internet. The Complainant has invested many millions of dollars in advertising and promoting the EXPEDIA mark and has sold or licensed many hundreds of millions of dollars in its EXPEDIA goods and services under the EXPEDIA mark, including travel-related goods and services. In addition to its inherent distinctiveness, and as a result of the Complainant's extensive marketing efforts, substantial sales and the resulting success of its EXPEDIA goods and services, the EXPEDIA mark has become famous and represents extraordinarily valuable goodwill owned by the Complainant. Furthermore, the Complainant had advertised its EXPEDIA services in Hong Kong, while

such marks recognized by the ordinary Hong Kong consumers. Moreover, the Complainant has made a significant amount of sales to Hong Kong consumers. The Complainant believes that the Respondent has no reasonable excuse to register the disputed domain name; and the Respondent registered and used the domain name in bad faith.

1. The Respondent is not affiliated or related to the Complainant in any way, nor is the Respondent licensed by the Complainant or otherwise authorized to use the EXPEDIA mark;
2. The Respondent has no rights or legitimate interests in the disputed domain name or major part of the domain name; the Respondent has no reasonable excuses to prove there is some relationship between the disputed domain name and his business;
3. The disputed domain name is confusingly similar to the Complainant's EXPEDIA mark because the disputed domain name incorporates the entirety of the Complainant's EXPEDIA mark;
4. The EXPEDIA mark owns the distinctiveness and is registered by the Complainant, who believes that the Respondent plagiarizes such granted trademark by registering the disputed domain name.
5. Therefore, the acts of the Respondent should be prohibited by virtue of the Dispute Resolution Policy and the Rules of Procedure.”

#### The Respondent

The Respondent contends that: “I am the owner of the domain name “expedia.hk” since May 2004, the decision to register this domain name was made on year 2003 when the HKDNR just announced the plan to launch the 2nd level .hk domain names. I decided to register “expedia.hk” was because I was looking for a domain name for my website to host my personal medias, namely photos, videos and music. And show them to my friends and relatives locally and internationally. I did not even hear about “expedia” when I created the word “expedia” for my website with the meaning of “Experienced Media”, i.e. the media to show my experience. My website has been opened over one and a half year, it became well-known for my friends, colleagues and family members to browse my personal media files over the Internet.

I totally disagreed with what the Complainant stated in Form A about the popularity of their “expedia” brand name in Hong Kong. Although I am working in the information technology field for over 5 years and I am browsing the internet web pages everyday. I have never seen any advertisement from the Complainant’s company and I have never heard about the name “expedia” before the Complainant sent the first email to me. I did also check with many of my friends and business partners, none of them knew about the Complainant’s “expedia” travel website. I can send the Panel the list of person’s names if necessary. Therefore I can conclude that the name “expedia” is not commonly known in Hong Kong. I believe the Panel can verify this easily by asking any one of the local people.

According to the definition from the HKDNR, the second level .hk domain name is to be used by the general public. For commercial use, the company should register the .com.hk third level domain name. This indicates the Complainant should use the expedia.com.hk instead of expedia.hk for its commercial travel website. The Complainant’s complain to the HKIAC for this domain is purely because of the commercial benefit to the Complainant’s company, I believe the Complainant want to has a monopoly of the “expedia” domain names in all the countries. I think this is totally not fair to me and all other registrants of these domain names.

I never get any profit from selling or trading domain names. I never ask the Complainant to give me any benefit to exchange the ownership of the domain name “expedia.hk”. And I paid to HKDNR annually for the continuous ownership of the domain name. I did not use the domain name in bad faith because:

1. I am continuously using the domain name to host my website since year 2004, and update the contents in the website periodically. My purpose of registering this website is neither to occupy it nor to make profit.
2. I never state that in my “expedia.hk” website or in any form that this domain name has a relationship with the Complainant’s EXPEDIA mark. I have no intension to create confusion.
3. The nature of my website is totally different from what the Complainant’s company is doing on the Internet according to the Complainant’s description in Form A. “expedia.hk” is a non-commercial, personal interest only website.
4. The Internet users can easily distinct between “expedia.hk” and “expedia.com” because the style and outlook of the websites are totally different. I believe that my domain name and website is not making confusion for the Complainant’s mark.
5. I am happy to put a sentence in my website for the Complainant to indicate the correct domain name of the Complainant’s travel website if the Complainant believes that this can help.”

#### **4 Findings**

##### **1 Identical/confusing similar**

The Complainant produced letters of the Intellectual Property Department of the Hong Kong Administrative Region Government and Certificates of Registration of the EXPEDIA and EXPEDIA LOGING marks evidencing the registrations as referred to by the Complainant. The Panel finds that EXPEDIA is a trade and service mark which the Complainant has rights. By comparing the disputed domain name with the mark of the Complainant, they are clearly identical. It is well established that, for the purpose of comparing names, the suffix comprising the top level domain (.hk in this instance) is disregarded. The requirements of Paragraph 4(a)(i) of the Dispute Resolution Policy are met with.

##### **2. Rights or Legitimate Interests**

The Complainant did not deal with the Requirements under Paragraph 4(a)(iii) of the Dispute Resolution Policy as a separate requirement. It was stated as one of the grounds that the Respondent has no reasonable excuse to register the disputed domain name; and the Respondent registered the domain name in bad faith that “The Respondent has no rights or legitimate interests in the disputed domain name or major part of the domain name; the Respondent has no reasonable excuses to prove there is some relationship between the disputed domain name and his business”.

In the case of Société pour l’ Oeuvre et la Mémoire d’ Antoine de Saint Exupéry – Succession Saint Exupéry – D’ Agay v. Perlegos Properties, Case No. D2005-1085, it was said that “it is consensus view among Panelists that if Complainant makes a *prima facie* case that the Respondent has no rights or legitimate interests, and Respondent fails to show one of the three circumstances under Paragraph 4(c) of the Policy, then the Respondent may lack a legitimate interest in the domain name.” The Panel also agrees with and adopts the approach.

Complainant contends that the Respondent has neither a license nor any other permission to use the trademark or the service mark of Expedia which is under copyright protection in Hong Kong. This appears to be accepted by the Respondent to be the position. The Panel thus

finds that the Complainant has made out a *prima facie* case showing that the Respondent has no rights or legitimate interests in the disputed domain name.

The burden of going forward with the evidence now shifts to Respondent having regard to Paragraph 4(c) of the Dispute Resolution Policy.

Under Paragraph 4(c), it is provided that:

“Any of the following circumstances, in particular but without limitation, if found by an Arbitration Panel to be proven based on its evaluation of all evidence presented to it, shall demonstrate your rights or legitimate interests to the Domain Name for purposes of Paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a bona fide offering of goods or services in Hong Kong; or
- (ii) you (as an individual, business, or other organisation) have been commonly known by the Domain Name, even if you have acquired no trade mark or service mark rights in Hong Kong; or
- (iii) you are making a legitimate non-commercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.”

The Respondent did not specifically set out the particular ground under Paragraph 4(c) that he seeks to rely. From the contention advanced by the Respondent, Subparagraph (i) is inapplicable here.

As noted above, according to the Respondent, he was looking for a domain name for his website to host his personal medias, namely photos, videos and music for showing them to his friends and relatives locally and internationally. The word expedia was created by him for his website since it was launched by him in May 2004. It was created with the meaning of experienced media, i.e. the media to show his experience.

His website became well-known for his friends, colleagues and family members to browse his personal media files over the internet. It appears to the Panel that the Respondent is seeking to rely on Subparagraphs (ii) and (iii).

The Respondent did not produce any evidence on his website to substantiate his assertion on the use. It is the consensus view of panelists that the Panel may look at the website linked to the disputed domain name to obtain more information of the Respondent and the website. The Panel did look at the website of the disputed domain name. It is a website with 46 slides. There is no mention of the Respondent and there are no descriptions of the slides or generally. The website was said to have been last updated on 18 May 2005 and the slides displayed were all taken in July 2004. There are no video or music files. The slides except one or two are all on sceneries or still objects. There is no way one can be certain when visiting the website that the website is a personal website of the Respondent. The website also appears to be rather inactive and certainly does not support the allegation of the Respondent that the contents were updated periodically. As the onus has shifted to the Respondent, the Panel finds that the Respondent has failed to prove sufficiently that he has become known by the domain name through regular browsing by his colleagues etc. The Respondent has not satisfied the requirements under Subparagraph (ii).

The Panel has also looked at the Complainant's website at expedia.com. It is by comparison a very substantial website providing a full range of travelling and related services as detailed by the Complainant. The Respondent alleges that he did not hear of Expedia until he was

approached by the Complainant. He also alleges that Expedia is not commonly known in Hong Kong. The fact is the Complainant has registered the mark in Hong Kong as early as 1998 and has been using the trade/service mark of EXPEDIA and the domain name expedia.com as early as October, 1996. This is well before the Respondent's registration of the domain name in dispute. Further, the Respondent alleges that he has been working in the information technology field and browsed the internet every day for the last 5 years, the Panel finds it most odd that the Respondent did not check to see if the word he had coined was being used by others. In the Panel's view, the Respondent has, again, failed to prove sufficiently that the word was coined by him and that he did not hear or see Expedia before he did so. The Respondent did not advance any other basis for using the disputed domain name. The Respondent has failed to prove the requirements under Subparagraph (iii).

The upshot is, the Panel concludes that the Respondent has no right or legitimate interests in the domain name and that requirements under Paragraph 4(a)(ii) have been met with by Complainant.

### **3. Bad faith**

It is provided under Paragraph 4 (b) of the Policy that:

"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 website 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 website or location or of a product or service on your website or location."

The onus of proof is on the Complainant to satisfy the Panel that one of the circumstances exists or otherwise there is bad faith in the registration and use of the domain name in dispute.

The Complainant did not categorically premise its contention on any of the circumstances of Paragraph 4 (b). In reviewing the Complainant's contentions, it seems to premise its claim primarily on the basis that Expedia is a registered mark and the Respondent is infringing the rights thereof; the mark is distinctive and the use of the mark would cause confusion.

It has been reckoned from time to time by panelists that the UDRP (the Dispute Resolution Policy is modeled on the UDRP) is designed to prevent clear cases of cybersquatting and is not designed to address all types of claims concerning the use of another's mark on the internet, including claims for trademark infringement. See *The Clorox Company v. Marble*

Solutions a/k/a Adam Schaefer, Case No. D2001-0923. The Complaint has to be considered in the terms of the Dispute Resolution Policy.

The Respondent's response primarily is that the website has been used as his personal website, he did not get any profit from selling or trading the domain name, and the website of the Complainant and that of the Respondent is easily distinguishable. On the available evidence, it appears to the Panel the domain name in dispute has indeed been used by the Respondent for personal and non-commercial use, albeit that it has been rather inactive. As no evidence was produced by the Complainant to show uses otherwise than a personal and non-commercial one or to address on issues pertinent to considerations under Paragraph 4(a)(iii) having regard to Paragraph 4 (b); and the onus of proof is on the Complainant to show bad faith in both the registration and use of the domain name, the Panels find s that the Complainant has failed to meet with the requirements of Paragraph 4(a)(iii).

## **6. Conclusions**

In view of the finding of the Panel that the Complainant has failed to prove that the registration and use by the Respondent has been in bad faith, that is the requirements under Paragraph 4(a)(iii) of the Dispute Resolution Policy, the Complaint is denied.

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Anthony Wu  
Arbitrator  
27 January 2006